

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

UBIQUITI INC.
Petitioner

v.

XR COMMUNICATIONS, LLC D/B/A VIVATO TECH
Patent Owner

Inter Partes Review No. IPR2024-00148
Patent No. 10,594,376

**PETITIONER'S MOTION TO WAIVE THE TIME LIMIT FOR FILING A
MOTION FOR JOINDER PURSUANT TO 37 C.F.R. § 42.5(c)(3)**

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I. RELIEF REQUESTED

Petitioner Ubiquiti Inc. (“Petitioner” or “Ubiquiti”) respectfully requests that the Patent Trial and Appeal Board (“Board”), pursuant to 37 C.F.R. § 42.5(c)(3), waive the time limit for filing a motion for joinder specified in 37 C.F.R. § 42.122(b), and permit Ubiquiti’s filing of motion for joinder under 35 U.S.C. § 315(c) and 37 C.F.R. § 42.122(b), that would join IPR2024-00148 (filed by Ubiquiti) with IPR2022-00613, upon which the Board has instituted *inter partes* review of U.S. Patent No. 10,594,376 (the ’376 patent). The relief is warranted because granting this motion would serve the interests of justice.

II. STATEMENT OF RELEVANT FACTS

On March 3, 2022, Samsung, Google, and Cisco (collectively, the “Samsung Petitioners”) filed a petition for *inter partes* review challenging claims 1-34 of the ’376 patent. *See Samsung et al. v. XR Communications, LLC*, IPR2022-00613, Paper 5. In that petition, the Samsung Petitioners listed the following district court litigation as known related matters. The Board instituted trial for in the IPR2022-00613 proceeding on October 20, 2022. *See* IPR2022-00613, Paper 12.

Parties	Docket	District	Filing Date
<i>XR Communications, LLC v. Aruba Networks, LLC</i>	2:21-cv-04912	Central District of California	June 16, 2021
<i>XR Communications, LLC v. Belkin International, Inc.</i>	2:21-cv-4914	Central District of California	June 16, 2021

<i>XR Communications, LLC v. Netgear, Inc.</i>	2:21-cv-4942	Central District of California	June 16, 2021
<i>XR Communications, LLC v. D-Link Systems, Inc.</i>	8:21-cv-01063	Central District of California	June 16, 2021
<i>XR Communications, LLC v. Netgear, Inc.</i>	8:21-cv-1064	Central District of California	June 16, 2021
<i>XR Communications, LLC v. Ubiquiti Networks, Inc.</i>	8:21-cv-1065	Central District of California	June 16, 2021
<i>XR Communications, LLC v. Amazon.com, Inc. et al.</i>	6:21-cv-619	Western District of Texas	June 16, 2021
<i>XR Communications, LLC v. ASUSTeK Computer Inc.</i>	6:21-cv-622	Western District of Texas	June 16, 2021
<i>XR Communications, LLC v. Cisco Systems, Inc. et al.</i>	6:21-cv-623	Western District of Texas	June 16, 2021
<i>XR Communications, LLC v. Google LLC</i>	6:21-cv-625	Western District of Texas	June 16, 2021
<i>XR Communications, LLC v. Samsung Electronics Co., Ltd. et al.</i>	6:21-cv-626	Western District of Texas	June 16, 2021

In light of the Board’s decision to institute *inter partes* review of the ’376 patent, the district court in *XR Communications, LLC v. D-Link Systems*, No. 8:17-cv-00596 (C.D. Cal.) stayed its proceedings.¹ See EX-1034 (Order Granting Motion to Stay).

In November 2022, Eero LLC filed a petition for *inter partes* review of the ’376 patent (IPR2023-00174) and a motion to join the IPR2023-00174 proceeding with the IPR2022-00613 proceeding. Netgear and Aruba also filed a petition for

¹ On June 28, 2021, all the listed actions in the Central District of California, including the case against Ubiquiti, were consolidated into a lead case, *XR Communications, LLC v. D-Link Systems*, No. 8:17-cv-00596 (C.D. Cal.).

inter partes review of U.S. Patent No. 10,594,376 (IPR2023-00136) and a motion for joinder of the IPR2023-00136 proceeding with the IPR2022-00613 proceeding. Both petitions were substantively identical to the petition in IPR2022-00613.

On May 22, 2023, the Board joined both proceedings with IPR2022-00613, and ordered all further filings to be made in IPR2022-00613. *See* IPR2022-00613, Papers 7 and 8. Oral hearing was held on July 20, 2023. Between June and September 2023, various petitioners reached settlement agreements with XR. *See* IPR2022-00613, Papers 29, 37, and 49.

On September 29, 2023, XR and Netgear, the final petitioner in IPR2022-00613, filed a joint motion to terminate the IPR proceeding after reaching a settlement agreement. *See* IPR2022-00613, Paper 49. This was three weeks prior to the Board's statutory due date for entering a final written decision on October 20, 2023. *See* 35 U.S.C. § 316(a)(11).

On October 3, 2023, the Board terminated IPR2022-00613. *See* IPR2022-00613, Paper 52. In the order terminating IPR2022-00613, the Board notes that "the Parties state that the pending District Court litigation between them involving the '376 patent has been dismissed." *See id.*

Ubiquiti is filing concurrently with this motion: a motion for leave to file motion for reopening or reconsideration of IPR2022-00613, a petition for *inter*

partes review of the '376 patent (IPR2024-00148), and a motion for joinder of the petition with IPR2022-00613.

III. STATEMENT OF REASONS FOR RELIEF REQUESTED

Ubiquiti respectfully requests that the Board exercise its discretion, waive the time limit for filing a motion for joinder specified in 37 C.F.R. § 42.122(b), and grant joinder of the instant Petition and the IPR2022-00613 proceeding. After an *inter partes* review is initiated, parties not already involved in the matter may request to join. 35 U.S.C. § 315(c). Typically, requests to join must be filed within “one month after the initiation date” of the *inter partes* review in question. 37 C.F.R. § 42.122(b)(2). Requests that are filed late, however, “will be excused on a showing of good cause or upon a Board decision that consideration on the merits would be in the interests of justice.” 37 C.F.R. § 42.5(c)(3).

Ubiquiti’s petition and motion for joinder were filed more than “one month after the initiation date” of this *inter partes* review. *See* § 42.122(b)(2). Waiving the time limit of § 42.122(b)(2), however, would serve the interests of justice. Consequently, the Board should grant this motion. *See* § 42.5(c)(3) (“A late action *will* be excused . . . upon a Board decision that consideration on the merits would be in the interests of justice.” (emphasis added)).

“The public interest in the benefits of a patent system is best met by procedures that resolve administratively questions affecting patent validity.”

Perkins v. Kwon, 886 F.2d 325, 329 (Fed. Cir. 1989). In instituting *inter partes* review of the '376 patent pursuant to IPR2022-00613, the Board has found there exists “a reasonable likelihood” that a challenge to the patentability of claims 1-34 of the '376 patent would prevail. *See* IPR2022-00613, Paper No. 12 at 39. Now, at the eleventh hour, XR has contrived a termination by settling with the original petitioners in order to avoid substantive review of its few remaining claims that have not yet been invalidated or found unpatentable over the course of the past six years. Granting Ubiquiti’s motion for joinder would facilitate resolution of these substantial doubts over the patentability of claims 1-34 of the '376 patent, and will thus further the public interest in resolving these patentability issues via an efficient and balanced administrative procedure.

Furthermore, as the Board recognized in its order instituting *inter partes* review, there were and there remains multiple cases pending in federal court involving the '376 patent. At minimum, in the Central District of California, XR’s infringement claim against Belkin International, Inc. and Ubiquiti remain pending. *See* IPR2022-00613, Paper 12 at 2-3.

The existence of continued litigation involving the '376 patent is a highly pertinent fact in considering the interests of justice in this case. The Board routinely considers whether there are other proceedings involving the same contested patent and unrelated parties in making determinations to terminate a

trial after it has been instituted. Indeed, in numerous orders terminating trial following a settlement, the Board has stressed the absence of any litigation under the patent involving third-parties as one of the justifications for terminating the proceeding. *See, e.g., Macauto v. BOS GmbH & KG*, IPR2012-00004, Paper 23 at 2 (Feb. 20, 2013) (termination warranted where the parties “represented that no other actions [we]re pending.”); *Vestcom Int’l v. Grandville Printing Co.*, IPR2013-00031, Paper 27 at 2 (May 6, 2013) (terminating proceedings where “parties have not identified any other related matters.”). Thus, while the Board generally “expects that a proceeding will terminate after the filing of a settlement agreement,” PTAB, Consolidated Trial Practice Guide 86 (Nov. 2019), termination may be inappropriate in light of “related district court action in which infringement of the involved patent has been alleged.” *Applied Voice & Speech Techs. v. IPVX Patent Holdings, Inc.*, IPR2013-00216, Paper No. 10 at 2 (July 15, 2013).

The existence of multiple district court litigation involving ’376 patent was a powerful factor supporting a decision to institute the *inter partes* review in the first place. Indeed, the district court litigation in *XR Communications, LLC v. D-Link Systems*, No. 8:17-cv-00596 (C.D. Cal.) was stayed in view of the Board’s decision to institute trial in the IPR2022-00613 proceeding. The interests of justice in the present circumstances plainly would be best served by allowing

Ubiquiti to join *inter partes* review proceeding IPR2022-00613, and pursue a final decision from the Board regarding the patentability of claims 1-34 of the '376 patent. That, in turn, supports granting Ubiquiti's motion for an extension of time to enable the Panel to consider Ubiquiti's late-filed motions for joinder.

IV. CONCLUSION

For all of these reasons, Ubiquiti respectfully requests that the Board, pursuant to 37 U.S.C. § 42.5(c)(3), waive the time limit for filing motions for joinder, and consider Ubiquiti's concurrently filed petition in IPR2024-00148 and motions to reopen and join with IPR2022-00613.

Dated: November 10, 2023

Respectfully submitted,

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CERTIFICATE OF SERVICE

I certify that on November 10, 2023, I caused a true and correct copy of the foregoing Motion For Waiver of Time Limit For Filing A Motion For Joinder to be served via overnight delivery on the Patent Owner at the following correspondence address of record as listed on PAIR:

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