

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

UBIQUITI INC.
Petitioner

v.

XR COMMUNICATIONS, LLC
Patent Owner

IPR2024-00148

U.S. Patent No. 10,594,376

**PATENT OWNER'S PRELIMINARY RESPONSE AND
OPPOSITION TO MOTION FOR JOINDER**

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I. INTRODUCTION

Petitioner Ubiquiti Inc.'s ("Ubiquiti") petition for *inter partes* review of U.S. Patent No. 10,594,376 ("'376 patent") is being filed:

- two years and five months after Ubiquiti was first served with a complaint alleging infringement of the '376 patent;
- one year after the deadline to file a motion for joinder under 37 C.F.R. § 42.122(b); and
- when the IPR it seeks to join (IPR2022-00613) is no longer pending and was properly terminated because of settlement.

Given these undisputed facts, and as Ubiquiti acknowledges, its petition depends on a series of motions that must each be granted for the petition to be viable.

Specifically, Ubiquiti concurrently filed three motions:

1. Petitioner's Motion for Leave to File Motion to Reopen IPR2022-00613 (Paper 2)
2. Petitioner's Motion to Waive the Time Limit for Filing a Motion for Joinder Pursuant to 37 C.F.R. § 42.5(c)(3) (Paper 4)
3. Petitioner's Motion for Joinder of Proceedings (Paper 3)

But none of these motions have merit. They request relief that is both unprecedented and entirely unjustified based on the facts and circumstances of this case. For example, Ubiquiti fails to identify any relevant legal authority that supports either reopening a terminated IPR or retroactively excusing the deadline to seek joinder under 37 C.F.R. § 42.122(b) by one year (and after the IPR had been

terminated). Nor does Ubiquiti identify any compelling facts that support the extraordinary relief it seeks. For example, it fails to identify any misrepresentation by Patent XR Communications, LLC (“XR”) or error by the Board that could possibly justify unwinding the termination decision in IPR2022-00613. Nor does Ubiquiti even attempt to explain why it missed the deadlines to file an IPR under 35 U.S.C. § 315(b) and 37 C.F.R. § 42.122(b) or why excusing Ubiquiti from those deadlines by one year is supported by good cause.

The Board should summarily deny institution and each of Ubiquiti’s motions.

II. SUMMARY OF RELEVANT FACTS

A. District Court Proceedings

On June 16, 2021, Patent Owner XR Communications, LLC (“XR”) filed a complaint against Ubiquiti asserting infringement of the ’376 patent in the Central District of California. *XR Commc’ns., LLC v. Ubiquiti Networks Inc.*, 8:21-cv-01066, Dkt. 1 (C.D. Cal. June 16, 2021) Ubiquiti was served with the complaint on June 21, 2021. -1066 case, Dkt. 17 (Proof of Service). The case was subsequently consolidated into *XR Commc’ns., LLC v. D-Link Systems*, No. 8:17-cv-00596 (C.D. Cal.) (“-596 case”). The consolidated case included other CDCal cases involving the ’376 patent against Defendants NETGEAR (8:21-cv-01064), Aruba (2:21-cv-04912), and Belkin (2:21-cv-04914).

On September 1, 2022, Defendants moved to stay the CDCal cases pending IPRs filed by third-party petitioners, including IPR2022-00613 on the '376 patent. -596 case, Dkt. 394 (C.D. Cal.). XR opposed the stay. -596 case, Dkt. 481 (C.D. Cal. Sept. 12, 2022). XR argued that a stay was inappropriate because “None of Defendants Aruba, Belkin, NETGEAR, or Ubiquiti has filed an IPR on the '376 [patent].” *Id.* at 3. In reply, Defendants suggested that if the CDCal cases were stayed, they would seek to join any instituted IPR on the '376 patent. -596 case, Dkt. 511 at 8–9 (C.D. Cal., Sept. 19, 2022).

On October 26, 2022, and after IPR2022-00613 on the '376 patent was instituted, the district court granted Defendants’ motion to stay the CDCal cases pending the outcome of the '376 patent IPR. -596 case, Dkt. 548 (C.D. Cal. Oct. 26, 2022). The court ordered the parties to file a status report every 90 days and “within 14 days of final adjudication of the '376 IPR.” *Id.* at 3.

On October 17, 2023, the parties (Plaintiff XR and remaining Defendants Ubiquiti and Belkin) filed a joint status report. -596 case, Dkt. 566 (C.D. Cal., Oct. 17, 2023). The parties notified the court that IPR2022-00613 on the '376 patent terminated due to settlement and attached a copy of the termination decision. *Id.* at 1. The parties jointly represented that: “All IPRs have now concluded, and accordingly, the stay of this case should be lifted.” *Id.*

On December 4, 2023, the district court lifted the stay and set a scheduling conference. -596 case, Dkt. 568 (C.D. Cal., Dec. 4, 2023). The court subsequently set a schedule with the pretrial conference and trial to occur in June 2024. Dkt. 570.

B. IPR Proceedings

On March 3, 2022, Samsung, Google, and Cisco filed an IPR petition on the '376 patent. *Samsung et al. v. XR Comms., LLC*, IPR2022-00613 (“-613 IPR”), Paper 5. On October 20, 2022, the Board instituted IPR. Within one month of institution, other petitioners who wanted to join IPR2022-00613 filed motions for joinder and copycat petitions. NETGEAR and Aruba (which filed a petition in IPR2023-00136) and eero (which filed a petition in IPR2023-00174) were joined as petitioners. -613 IPR, Papers 25, 26. All petitioners except NETGEAR were subsequently terminated from the IPR based on settlement. -613 IPR, Papers 36, 40.

On September 29, 2023, XR and NETGEAR (the only remaining petitioner) filed a joint motion to terminate IPR2022-00613 in its entirety. -613 IPR, Paper 49. The joint motion was filed at least three weeks before the Board’s deadline to issue a final written decision. *Id.* at 2. The parties, XR and NETGEAR, represented that they have “fully resolved their disputes as to the ['376 patent].” The parties further represented the litigations between them had concluded and they did not contemplate any future litigation or proceeding on the '376 patent. *Id.* at 2-3. The parties further represented that termination would conserve time and expenses:

Termination is also appropriate because the Parties desire to resolve this IPR without incurring further time and expenses, including from filing or opposing motions for reconsideration, requests for Director review, and/or Federal Circuit appeals that may arise depending on the outcome of the final written decision. Terminating this IPR will obviate those disputes and also conserve the time and resources of the Board and the Patent Office.

Id. at 3. Accordingly, the parties argued: “in view of the Parties’ settlement and joint request to terminate, good cause exists to terminate this IPR.” *Id.* at 4.

On October 3, 2023, the Board granted XR and NEGEAR’s joint motion to terminate. -613 IPR, Paper 52. The Board summarized the joint motion and reviewed the settlement agreement attached thereto. *Id.* at 3. As the Board found, “A final written decision has not been entered in this proceeding. Under this circumstance and in view of the Parties’ settlement, we determine that good cause exists to terminate the proceeding.” *Id.* Accordingly, the Board terminated IPR2022-00613 in its entirety. *Id.* at 4.

C. Summary of Key Dates

Ubiquiti was served with a complaint alleging infringement of the '376 patent on June 21, 2021. Under 35 U.S.C. § 315(b), its deadline to file an IPR petition challenging the '376 patent was *June 21, 2022*. Ubiquiti’s instant IPR petition was filed on November 10, 2023—one year and five months after being time-barred.

IPR2022-00613 was instituted (based on a petition filed by Samsung, Google, and Cisco) on October 20, 2022. -613 IPR, Paper 12. Under 37 C.F.R. § 42.122(b), Ubiquiti's deadline to file a motion for joinder to IPR2022-00613 was *November 20, 2022*. Ubiquiti's instant motion for joinder was filed on November 10, 2023—one year after the joinder deadline (and only after the IPR had terminated).

III. INSTITUTION SHOULD BE DENIED

Ubiquiti was served with a complaint on the '376 patent in June 2021 but failed to take any action in seeking IPR for two years and five months (until November 2023). Further, by November 2023, the deadline to join Samsung's IPR had expired one year earlier. The Samsung IPR terminated because of settlement, and there were no other pending IPRs on the '376 patent. Thus, Ubiquiti's instant IPR petition and motion for joinder are untimely and improper. The Board should summarily deny institution and the requested relief in Ubiquiti's motions.

As Ubiquiti acknowledges,¹ its petition depends on a series of motions that must each be granted for the petition to be viable:

¹ See Paper 3 (Ubiquiti Motion for Joinder) at 1 (“Ubiquiti is filing this motion for joinder concurrently with a motion for leave to file a motion to reopen IPR2022-00613, a petition for inter partes review of the '376 patent (the ‘instant Petition’) in IPR2024-00148, and a motion to waive the time limit for filing a motion for joinder set forth in 37 C.F.R. § 42.122(b).”).

1. Petitioner's Motion for Leave to File Motion to Reopen IPR2022-00613 (Paper 2)
2. Petitioner's Motion to Waive the Time Limit for Filing a Motion for Joinder Pursuant to 37 C.F.R. § 42.5(c)(3) (Paper 4)
3. Petitioner's Motion for Joinder of Proceedings (Paper 3)

But none of these motions have merit. They request relief that is both unprecedented and entirely unjustified based on the facts and circumstances of this case. XR addresses each of Ubiquiti's motions in turn.

A. Ubiquiti's Request to "Reopen" a Terminated IPR (IPR2022-00613) Is Unprecedented and Unjustified

Ubiquiti first moves for leave "to file a motion to reopen IPR2022-00613" (Paper 2). But the Board properly terminated IPR2022-00613 on October 3, 2023 because of settlement. -613, Paper 52. There is no authority for the Board "reopen" a terminated IPR in these circumstances. Ubiquiti does not cite a single case that supports its requested relief, and XR is aware of none.

Much of Ubiquiti's motion is devoted to irrelevant characterizations and personal attacks upon XR. *See* Paper 2 at 1, 6. But the only facts that matter are the following recited in Ubiquiti's motion (*id.* at 3–4):

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 just 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.

As Ubiquiti states, the parties in IPR200-00613 filed a joint motion to terminate, and the Board granted terminated the IPR. That should put an end to the matter. Ubiquiti does not—because it cannot—allege that XR and NETGEAR made any misrepresentations in the joint motion to terminate (nor would Ubiquiti, as a non-party, have standing to object). Nor does Ubiquiti allege that the Board lacked authority or discretion to grant the joint motion and terminate the IPR. Nor does Ubiquiti allege that the Board misapprehended or overlooked any material matters in granting termination. Ubiquiti's request, therefore, amounts to an improper motion for reconsideration without the legal and factual basis for such a motion.

For example, 37 C.F.R. § 42.71 provides that “[a] party dissatisfied with a decision” may seek rehearing and “[t]he request must specifically identify all matters the party believes the Board misapprehended or overlooked.” Here, Ubiquiti is not a party. It also fails to identify any matter the Board misapprehended or overlooked. And Ubiquiti's request comes past the deadline to seek rehearing (within 30 days of a final decision). Thus, Ubiquiti's request to “reopen” IPR2022-00613 (i.e., reverse the Board's termination decision) is procedurally and substantively defective.

Ubiquiti's arguments in support of its request to reopen are meritless. It points to different IPRs, under different factual circumstances, where the Board denied a joint motion to terminate. Paper 2 at 5–6. That is immaterial and doesn't support the relief Ubiquiti seeks. It cannot be seriously disputed that the Board in IPR2022-00613 had authority and discretion to terminate the IPR. That the Board might possibly have reached a different conclusion (or that other panels in other cases and other circumstances have reached a different conclusion) does not show that termination was erroneous. Nor does it remotely justify *reversing* the termination decision after-the-fact. To make such a request, one would expect Ubiquiti to come forward with extraordinary facts and circumstances. But it has none—only the self-interested desire of an accused infringer seeking to avoid liability.

Ubiquiti also asserts that “[t]he interests of justice warrant the Board to consider Ubiquiti's request to reopen IPR2022-00613.” Paper 2 at 5. This fails for many reasons. The interests of justice favor promoting settlements, as well as terminating proceedings that are resolved pursuant to settlement. The interests of justice also favor finality in IPR decisions. If terminated IPR proceedings could be reopened at-will, that would undermine predictability and reliance in the IPR system. Further, any notion that justice favors considering a request from *Ubiquiti* is particularly unfounded. Ubiquiti had zero involvement in IPR2022-00613 (or any other IPR on the '376 patent) while it was pending. Ubiquiti does not and cannot

explain why it chose not to participate. There is no justification or good cause for allowing Ubiquiti to reopen the IPR after it was properly terminated.

B. Ubiquiti's Request to Retroactively Extend the Deadline for Seeking Joinder by One Year Is Frivolous

Ubiquiti next moves for the Board to “waive the time limit for a joinder specified in 37 C.F.R. § 42.122(b), and permit Ubiquiti's filing of motion for joinder.” Paper 4 at 1. Ubiquiti casually mentions that its “petition and motion for joinder were filed more than ‘one month after’” the institution date of IPR2022-00613. This is a vast understatement. IPR2022-00613 is no longer pending and it was instituted on October 20, 2022. -613 IPR, Paper 12. Thus, the deadline for a petitioner to seek joinder was November 20, 2022. Ubiquiti's instant motion for joinder comes on November 10, 2023—one year after the joinder deadline (and only after the IPR was terminated).

There is no basis to resuscitate IPR2022-00613, treat it as a pending IPR, and then allow Ubiquiti to retroactively seek joinder a year after the applicable deadline. *See* 37 C.F.R. § 42.122(b) (“Any request for joinder ***must be filed***, as a motion under § 42.22, *no later than one month after the institution date* of any *inter partes* review for which joinder is requested”) (emphasis added). Ubiquiti's request is frivolous and fails for several dispositive reasons.

First, Ubiquiti does not cite any proper authority that would allow such a request, and XR is aware of none. Ubiquiti relies on § 42.5(c)(3), which provides that “A late action 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.” But that section plainly applies to modest extensions that occur during IPR proceedings, such as a party filing a brief a day or two late. It does ***not*** apply to retroactively extending a deadline by almost *one year* (particularly since the IPR has already been terminated). Ubiquiti does not—and cannot—cite any case that has applied § 42.5(c)(3) in the extraordinary way it seeks.

Second, granting a retroactive extension of the joinder deadline by one year (and relying on § 42.5(c)(3) to do so) would eviscerate the one-year time bar under § 315(b). That statute provides that “An *inter partes* review ***may not be instituted*** if the petition requesting the proceeding is filed more than 1 year after the date on which the petitioner . . . is served with a complaint alleging infringement of the patent.” 35 U.S.C. § 315(b). Here, Ubiquiti was served with a complaint on the '376 patent in June 2021, but the first time it decided to file an IPR on the '376 patent was *two years and five months later* (in November 2023).

Although the time limit set forth in § 315(b) doesn't apply to a request for joinder, that exception is circumscribed by 37 C.F.R. § 42.122(b), which provides that a request for joinder “*must be filed*” within one month of the institution date of

the IPR. To allow a third-party to join a terminated IPR up to a year past the joinder deadline would violate both 37 C.F.R. § 42.122(b) and 35 U.S.C. § 315(b). And it would contravene the important timing and procedural requirements that were enacted as part of the AIA and intended to protect patent owners.

Third, Ubiquiti doesn't remotely show that its request is supported by good cause or would be just. As to good cause, the record confirms that Ubiquiti should not be excused. Ubiquiti was served with a complaint on the '376 patent in June 2021, and could have filed its own IPR within the one-year statutory deadline (until June 2022). Ubiquiti was also aware of IPR2022-00613 (filed by Samsung, Google, and Cisco) early on. It even sought a stay of its CDCal case district against XR based on Samsung's IPR. After IPR2022-00613 was instituted, Ubiquiti had every opportunity to file a motion for joinder within the one-month deadline. Indeed, its co-defendants in CDCal (NETGEAR and Aruba) did just that. Yet Ubiquiti decided to not participate in any IPRs on the '376 patent in any form until November 202—after IPR2022-00613 had been terminated and there were no other pending IPRs on the '376 patent. Ubiquiti doesn't even attempt to explain why it did not seek to join IPR2022-00613 by November 2022. Nor does it remotely show why missing that deadline and then delaying almost a full year (until November 2023) was justified. Accordingly, there is no basis and no good cause to grant Ubiquiti a lengthy, retroactive extension to the deadline to seek joinder.

As to the interests of justice, Ubiquiti's only argument is based on the self-interested desire of an accused infringer seeking to avoid liability. *See* Paper 4 at 5. To the contrary, justice weighs overwhelmingly against Ubiquiti's request. This includes the policies underlying the timing requirements of 35 U.S.C. § 315(b) and 37 C.F.R. § 42.122(b) and their goal of avoiding serial IPRs and unfairness to patent owners. Ubiquiti's request seeks to circumvent those requirements by *one year* without offering any adequate justification for doing so (much less a compelling one). Entertaining Ubiquiti's request would also undermine the Board's policies of promoting settlement and terminating proceedings resolved pursuant to settlement, as well as in finality in IPR decisions. If IPRs could be reopened and deadlines excused long after the fact, then reliance on the Board's orders and respect for its rules would be weakened.

C. Joinder Is Inappropriate and Unjust

Ubiquiti next moves to "join this proceeding (IPR2024-00148) to IPR proceeding IPR2022-00613, both of which concern [the '376 patent]." Paper 3 at 1. As Ubiquiti acknowledges, its motion for joinder depends on two concurrent requests: (1) its motion to reopen IPR2022-00613 (Paper 2) and (2) its motion to waive the time limit for filing a motion for joinder under 37 C.F.R. § 42.122(b) (Paper 4). But as discussed above, both requests are meritless, so Ubiquiti's motion for joinder fails at the outset. There is no basis to allow Ubiquiti to "join" a

terminated IPR that is no longer pending. And even if IPR2022-00613 could somehow be “reopened” (which Ubiquiti fails to support under the law or facts), there is no basis to retroactively extend the deadline to file a motion for joinder to that proceeding by nearly a full year.

In addition to these fatal defects, the Board should deny Ubiquiti’s joinder motion for at least two additional reasons. *First*, the circumstances of Ubiquiti’s time-bar weigh strongly against permitting joinder here. As the Trial Practice Guide explains regarding the Board’s discretion to allow joinder under § 315(c):

[T]he existence of a time bar under 35 U.S.C. § 315(b) is one of several factors that may be considered when exercising discretion under 35 U.S.C. § 315(c). Thus, when an otherwise time-barred petitioner requests same party and/or issue joinder, the Board may exercise its discretion to permit joinder, but will do so only where fairness requires it and to avoid undue prejudice to a party. *The Board expects to exercise its discretion to permit such joinder **only in extremely limited circumstances.*** Circumstances leading to this narrow exercise of discretion to permit such joinder may include, for example, certain actions taken by a patent owner in a co-pending litigation such as certain late additions of newly asserted claims.

PTAB Consolidated Trial Practice Guide (Nov. 2019) (“TPG”) at 76–77 (emphasis added) (citations omitted).

Here, Ubiquiti's motion for joinder comes *two years and five months* after it was first served with a complaint on the '376 patent. Thus, Ubiquiti would otherwise be time-barred from filing an IPR on the '376 patent by one year and five months. Ubiquiti doesn't cite any cases allowing joinder under such belated timing, and XR is aware of none. Instead, there is a strong presumption that joinder in these circumstances should be denied. *See* TPG at 77 ("The Board expects to exercise its discretion to permit such joinder [by an otherwise time-barred petitioner] *only in extremely limited circumstances.*"). Ubiquiti does not allege any "extremely limited circumstances" in this case that might permit an exception.

Indeed, it is undisputed that Ubiquiti was served with a complaint on the '376 patent in June 2021 and could have filed its own IPR petition within the one-year statutory bar. Nor does Ubiquiti allege that XR's actions in the CDCal case somehow prevented Ubiquiti from filing a timely IPR. For example, there is no evidence that XR delayed in disclosing the asserted claims of the '376 patent or made "certain late additions of newly asserted claims." TPG at 77. Nor is there any evidence that Ubiquiti relied on XR's actions or would be unfairly prejudiced if its current motion for joinder is not permitted.

Second, Ubiquiti's assertion that allowing its request for joinder "would not present new issues" (Paper 3 at 7) is plainly incorrect. There are currently *no invalidity issues or grounds* concerning the '376 patent before the PTAB or in any

pending IPR. Thus, *all* the issues and grounds Ubiquiti seeks in IPR2024-00148 would be new. If joinder is allowed, XR and the Board would go from zero pending issues on the '376 patent to all the issues raised in IPR2024-00148. This is contrary to the policy underlying joinder, which permits a new petitioner to join issues that are already before the Board and will already be decided (and only if the new petitioner acts in an “understudy” role). Ubiquiti’s request would turn the policy behind joinder on its head. It seeks to use joinder to create a new IPR (as well as to wholly circumvent the one-year time bar) that would not otherwise be before the Board. This is unjustified and would unfairly prejudice XR.

Ubiquiti is also wrong that allowing joinder would not burden XR or the Board. As an initial matter, the joint motion to terminate in IPR2022-00613 was filed at least three weeks before the Board’s deadline to issue a FWD. And in granting termination, the Board noted that “A final written decision has not been entered in this proceeding.” -613 IPR, Paper 52 at 3. Ubiquiti would purport to require the Board to issue in FWD in IPR2022-00613. Moreover, any FWD would necessarily be issued long after the statutory deadline to issue a FWD within one-year of institution (October 20, 2023). This further shows that Ubiquiti is seeking a new IPR with a new schedule. Ubiquiti’s assertion that “joinder does not negatively impact the schedule in IPR2022-00613” (Paper 3 at 10) is nonsensical where that IPR has been terminated and no schedule currently exists.

Ubiquiti also overlooks the substantial work for the parties and the Board that could—and likely would—result from a FWD. Indeed, the parties to IPR2022-00613 (XR and NETGEAR) jointly requested termination to conserve time and expenses, including those incurred “from filing or opposing motions for reconsideration, requests for Director review, and/or Federal Circuit appeals that may arise depending on the outcome of the final written decision.” -613 IPR, Paper 49 at 3. If the claims of the '376 patent are upheld in a FWD, Ubiquiti would presumably reserve the right to file a motion for reconsideration, request for Director review, and a Federal Circuit appeal. And XR and the Board would be forced to incur substantial time in responding to and resolving those filings. That is why, as the parties represented in IPR2022-00613: “Terminating this IPR will obviate those disputes and also conserve the time and resources of the Board and the Patent Office.” *Id.*

D. The Board Should Order Ubiquiti to Show Cause and Reimburse XR’s Reasonable Attorney Fees

Under § 42.12, the Board may impose a sanction against a party for misconduct, including “[a]dvancing a misleading or frivolous argument or request for relief.” 37 C.F.R. § 42.12(a)(2). Such sanctions include ordering compensatory expenses, such as attorney fees. 37 C.F.R. § 42.12(b)(6). Here, Ubiquiti’s requests institution of IPR2024-00148 based on a petition it filed two years and five months

after being served with a complaint. This request for relief is frivolous and depends on several predicate requests for relief that are themselves frivolous:

1. Ubiquiti requests “reopening” IPR2022-00613, a proceeding that was properly terminated because of settlement (Paper 2); and
2. Ubiquiti requests a waiver, by nearly a year, from the deadline to file a motion for joinder to IPR2022-00613 (Paper 4); and
3. Ubiquiti requests joinder to a terminated, non-pending IPR that would circumvent both the one-year time bar and prohibition against adding new issues through joinder (Paper 3).

Moreover, Ubiquiti’s arguments in support of the requested relief are frivolous. For example, Ubiquiti fails to identify any relevant legal authority that supports either reopening a terminated IPR or retroactively excusing the deadline to seek joinder under 37 C.F.R. § 42.122(b) by nearly a year (and after the IPR had been terminated). Nor does Ubiquiti identify any factual circumstances that might support the unprecedented relief it seeks. For example, it fails to identify any misrepresentation by XR or error by the Board that could possibly justify unwinding the termination decision in IPR2022-00613. Nor does Ubiquiti even attempt to explain why it missed the deadlines to file an IPR under 35 U.S.C. § 315(b) and 37 C.F.R. § 42.122(b) or why excusing Ubiquiti from those deadlines by one year is supported by good cause. Overall, and by any objective measure, Ubiquiti’s request

for institution of IPR2024-00148 and joinder to IPR2022-00613 is frivolous.² For Ubiquiti's IPR petition to viable, the Board need to grant all three of Ubiquiti's concurrent motions. But each motion is itself frivolous. No reasonable litigant could expect *all three* to be granted under the law and factual circumstances of this case (including given Ubiquiti's utter lack of diligence).

Accordingly, XR respectfully requests that the Board order Ubiquiti to show cause as to why it should not be ordered to pay XR the reasonable attorney fees it incurred in responding to Ubiquiti's improper petition and motions. 37 C.F.R. § 42.11(d)(3) ("On its own, the Board may order an attorney, registered practitioner, or party to show cause why conduct specifically described in the order has not violated paragraph (c) of this section and why a specific sanction authorized by the Board should not be imposed.").

Ample authority supports an order to show cause here. For example, in *OpenSky Industries, LLC and Intel Corp. v. VLSI Tech. LLC*, Director Vidal ordered VLSI to show cause as to why it should not be ordered to reimburse Intel's reasonable fees incurred in responding to VLSI's rehearing request. IPR2021-01064, Paper 121 at 3–4 (PTAB Dec. 22, 2022). This was because the rehearing request

² Tellingly, none of the other time-barred defendants mentioned in Ubiquiti's joinder motion (Paper 3 at 4–5), Belkin and ASUSTeK, joined Ubiquiti's IPR petition or motions. This is because they lacked a good faith basis for the requested relief.

advanced arguments based on misleading statements of law and fact. that advanced arguments based on misleading statements of law and fact. *Id.* The same outcome is warranted here. If anything, Ubiquiti's requested relief and corresponding arguments are more unsupported than those advanced by VLSI found to be sanctionable. *See id.* at 3–4, 6–9.

And even if XR's fees in responding to Ubiquiti's petitions and motions are not significant, awarding them would prevent injustice in this case and promote the policies of the PTAB. *See id.* at 4 (“While I recognize the amount of these fees may not be significant, I want to make clear to the parties and the public that we will hold attorneys and parties accountable for the ethical obligations they owe to the Board.”). It would discourage petitioners from filing frivolous petitions and motions that result in harassment to patent owners and that increase the burden to patent owners and the Board. Without such a penalty, petitioners may be more willing to file improper petitions, knowing that the filing fee will be refunded when institution is denied.

If the Board agrees that an order to show cause is appropriate, XR respectfully requests that the Board adopt the procedure set forth in *VLSI*:

Within two weeks of the Board's decision, Ubiquiti and XR shall each file a 5-page paper addressing whether an award of attorney fees is appropriate as a sanction for Ubiquiti advancing frivolous arguments and requests for relief. XR shall also identify its attorney fees incurred in

responding to Ubiquiti's IPR petition and motions and may submit such evidence as necessary to support that identification. Within one week of the filing of such papers, Ubiquiti and XR may each file a 3-page paper in response.

See id. at 4.

IV. CONCLUSION

For the foregoing reasons, the Board should deny Ubiquiti's motion for joinder and deny institution of its IPR petition. The Board should also order Ubiquiti to show cause as to why it should not be ordered to pay XR the reasonable attorney fees it incurred in responding to Ubiquiti's untimely petition and frivolous motions.

Date: February 12, 2024

Respectfully submitted,

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CERTIFICATION REGARDING WORD COUNT

Pursuant to 37 C.F.R. §42.24(d), I certify that there are 4,938 words in the above paper excluding the portions exempted under 37 C.F.R. §42.24(a)(1).

Date: February 12, 2024

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CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.6(e)(1), I certify that the above document was served on February 6, 2024, by filing this document through the Patent Trial and Appeal Case Tracking System as well as delivering a copy via electronic mail upon the following attorneys of record for Petitioner:

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