

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.

IPR2024-00148
Patent 10,594,376 B2

Before BARBARA A. PARVIS, JAMES J. MAYBERRY, and
KARA L. SZPONDOWSKI, *Administrative Patent Judges*.

MAYBERRY, *Administrative Patent Judge*.

ORDER

Denying Petitioner's Motion to Reopen IPR2022-00613
37 C.F.R. § 42.20

Dismissing Petitioner's Motion to Waive the
Time Limit for Filing a Motion for Joinder
37 C.F.R. §§ 42.5, 42.122

I. INTRODUCTION

Ubiquiti Inc. (“Petitioner” or “Ubiquiti”) filed in the instant proceeding a paper titled “Petitioner’s Motion for Leave to File Motion to Reopen IPR2022-00613.” Paper 2 (“Motion to Reopen” or “Mot.”). Relatedly, Petitioner filed a Motion to waive the time limit for filing a motion for joinder. Paper 4 (“Motion to Waive Time Limit”). We address both of these motions here.

As we explain in greater detail below, we treat Petitioner’s Motion for Leave to File Motion to Reopen IPR2022-00613 as a motion to reopen IPR2022-00613. We deny that motion. We dismiss the Motion to Waive Time Limit as moot.

A. *Background*

On November 10, 2023, Petitioner filed a Petition requesting *inter partes* review of claims 1–34 of U.S. Patent No. 10,594,376 B2 (Ex. 1001, the “’376 patent”). Paper 1 (“Pet.”), 1. Concurrently, Petitioner filed a Motion for Joinder pursuant to 35 U.S.C. § 315(c) and 37 C.F.R. § 42.122(b) (2023), seeking to be joined as a party to IPR2022-00613 (the “’613 IPR”), which also involved a petition challenging claims 1–34 of the ’376 patent. Paper 3, 1; *see also* ’613 IPR, Paper 12 (providing the Decision on Institution).

XR Communications LLC (“Patent Owner” or “XR”) filed a Preliminary Response and Opposition to Motion for Joinder that opposes the Motion to Reopen and Motion to Waive Time Limit. Paper 9 (“Prelim. Resp.”). Petitioner filed a Reply to the Preliminary Response. Paper 10 (“Reply”).

1. *The District Court litigation involving the '376 patent*

Petitioner identifies the following litigations as matters related to the '376 patent, all of which were filed in the U.S. District Court for the Central District of California on June 16, 2021: *XR Communications, LLC v. Aruba Networks, LLC*, No. 2:21-cv-04912; *XR Communications, LLC v. Belkin International, Inc.*, No. 2:21-cv-04914; *XR Communications, LLC v. Netgear, Inc.*, No. 2:21-cv-04942; *XR Communications, LLC v. D-Link Systems, Inc.*, No. 8:21-cv-01063; *XR Communications, LLC v. Netgear, Inc.*, No. 8:21-cv-01064; and *XR Communications, LLC v. Ubiquiti Networks, Inc.*, No. 8:21-cv-01065. Pet. 90–91. Petitioner indicates that all of these cases were consolidated into *XR Communications, LLC v. D-Link Systems, Inc.*, No. 8:17-cv-00596, on June 28, 2021. Mot. 3 n.1.

Petitioner also identifies the following litigations as matters related to the '376 patent, all of which were filed in the U.S. District Court for the Western District of Texas on June 16, 2021: *XR Communications, LLC v. Amazon.com, Inc., Amazon.com Services LLC et al.*, No. 6:21-cv-0619-ADA; *XR Communications, LLC v. ASUSTek Computer Inc.*, No. 6:21-cv-0622-ADA; *XR Communications, LLC v. Cisco Systems, Inc. et al.*, No. 6:21-cv-0622-ADA; *XR Communications, LLC v. Google LLC*, No. 6:21-cv-0625-ADA; and *XR Communications, LLC v. Samsung Electronics Co. Ltd.*, No. 6:21-cv-0626-ADA (W.D. Tex.). Pet. 91.

Patent Owner identifies the following litigations as matters related to the '376 patent: *XR Communications, LLC v. Ubiquiti Networks, Inc.*, Case No. 8-21-cv- 01065 (C.D. Cal.); *XR Communications, LLC v. Belkin International, Inc.*, Case No. 2-21-cv- 04914 (C.D. Cal.); *XR Communications, LLC v. ASUSTek Computer Inc.*, Case No. 6:21-cv-00622-ADA (W.D. Tex.); *XR Communications LLC v. AT&T Inc. et al.*, Case

No. 2-23-cv-00202 (E.D. Tex.); *XR Communications v. Verizon Communications, Inc. and Cellco Partnership d/b/a Verizon Wireless*, Case No. 2-23-cv-00203 (E.D. Tex.); and *XR Communications LLC v. T-Mobile USA, Inc.*, Case No. 2-23-cv-00204 (E.D. Tex.). Paper 7 (Patent Owner’s Mandatory Notices), 1.

2. *The ’613 IPR*

We instituted trial in IPR2022-00613 on October 20, 2022, based on a Petition filed by Cisco Systems, Inc., Google LLC, Samsung Electronics Co., Ltd., and Samsung Electronics America, Inc., on March 3, 2022. *See* ’613 IPR, Paper 12. NETGEAR, Inc. and Aruba Networks LLC, which filed a petition and motion for joinder in IPR2023-00136 on November 18, 2022, and eero LLC, which filed a petition and motion for joinder in IPR2023-00174 on November 17, 2022, were joined as petitioners in the ’613 IPR. ’613 IPR, Papers 25, 26.

All of the petitioners were subsequently terminated from the ’613 IPR proceeding based on settlements. *See* ’613 IPR, Papers 34, 40, 52; Mot. 3 (“Between June and September 2023, various petitioners reached settlement agreements with XR.”). With the termination of the last petitioner, NETGEAR, Inc., on October 3, 2023, due to settlement, the ’613 IPR was terminated. *See* ’613 IPR, Paper 52, 3 (“35 U.S.C. § 317(a) also provides that if no petitioner remains in the *inter partes* review, the Office may terminate the review.”); Mot. 4.

II. ANALYSIS

As an initial matter, Petitioner’s Motion to Reopen IPR2022-00613 is an unauthorized motion filed in the instant proceeding. As our rules require, the Board must authorize most motions related to an *inter partes* review

proceeding. *See* 37 C.F.R. § 42.20(b) (2023).¹ We “may expunge any paper . . . that is not authorized under [Part 42] or in Board order or that is filed contrary to a Board order.” 37 C.F.R. § 42.7(a) (2023). As we discuss in greater detail below, we have reviewed the Motion to Reopen and the Motion to Waive Time Limit, along with Patent Owner’s arguments in opposition in Patent Owner’s Preliminary Response and Opposition to Motion for Joinder, and we are not persuaded by Petitioner’s arguments relating to reopening the ’613 IPR. Still, we consider Petitioner’s Motion to Reopen, as the motion presents an issue not previously presented to the Board on which Petitioner’s Petition and Motion for Joinder rests. Accordingly, we do not expunge the Motion to Reopen and we address the merits below.

Also, because certain arguments made in the Motion to Waive Time Limit relate to the issues presented in the Motion to Reopen, we consider the arguments in the Motion to Reopen and the Motion to Waive Time Limit together in addressing the merits of the Motion to Reopen.

1. Petitioner’s arguments

Petitioner argues that when the ’613 IPR was terminated, the ’376 patent was involved in at least two district court cases. Mot. 4 (identifying litigation in the Central District of California involving Petitioner and Belkin International, Inc., and litigation in the Western District of Texas involving ASUSTeK Computer Inc.); Motion to Waive

¹ Petitioner moves for leave to file its Motion to Reopen “[p]ursuant to 37 C.F.R. § 41.121(a)(3).” Mot. 1. “Part 41 governs appeals and interferences before the Patent Trial and Appeal Board.” 37 C.F.R. § 41.1(a). We treat Petitioner’s Motion to Reopen as filed under Part 42, which governs trial practice. *See id.* § 42.

Time Limit 5 (identifying the Central District of California litigation involving Petitioner and Belkin International, Inc.). Petitioner argues that “[t]he Board can enable ‘the just, speedy, and inexpensive resolution of’ multiple disputes related to the ’376 patent by reopening” the ’613 IPR and allowing Petitioner to join that proceeding. Mot. 4–5 (citing *LaRose Indus. v. Capriola Corp.*, IPR2013-00121, Paper 11, 24 (PTAB June 28, 2013)).

Petitioner argues that “[t]he interests of justice warrant the Board to consider Ubiquiti’s request to reopen” the ’613 IPR. Mot. 5. Petitioner argues that there is “a strong public interest in resolving doubts about the validity of the ’376 patent at an administrative level.” *Id.* (citing *Perkins v. Kwon*, 886 F.2d 325, 329 (Fed. Cir. 1989)); *see also* Motion to Waive Time Limit 4–5 (quoting *Perkins*). Petitioner argues that “the record in [the ’613 IPR] was fully developed and ‘the public’s interest in the status of the challenged . . . patent is at its peak.” Mot. 5 (quoting *Rubicon Comm’s v. Lego*, IPR2016-01187, Paper 100 (PTAB Dec. 14, 2017)). Petitioner argues that the ’613 IPR was terminated three weeks prior to the statutory due date and that the Board has declined to terminate other similarly situated proceedings. *Id.* at 5–6 (citing *Rubicon Comm’s*, IPR2016-01187, Paper 100; *Apple Inc. v. OpenTV, Inc.*, IPR2015-00969, Paper 29, 4–5 (PTAB Sept. 10, 2016); *Apple, Inc. v. Smartflash LLC*, CBM2015-00015, Paper 49, 6 (PTAB Nov. 4, 2015)).

Petitioner argues that, in instituting the ’613 IPR, we “found there exists ‘a reasonable likelihood’ that a challenge to the patentability of claims 1–34 of the ’376 patent would prevail.” Motion to Waive Time Limit 5 (citing ’613 IPR, Paper 12, 39). Petitioner argues that “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.” *Id.* Petitioner adds that granting its motions “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.” *Id.*

Petitioner argues that “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.” Motion to Waive Time Limit 6 (citing *Macauto v. BOS GmbH & KG*, IPR2012-00004, Paper 23, 2 (Feb. 20, 2013); *Vestcom Int’l v. Grandville Printing Co.*, IPR2013-00031, Paper 27, 2 (May 6, 2013)).

Petitioner argues that terminating an *inter partes* review proceeding “may be inappropriate in light of ‘related district court action in which infringement of the involved patent has been alleged.’” *Id.* (quoting *Applied Voice & Speech Techs. v. IPVX Patent Holdings, Inc.*, IPR2013-00216, Paper 10, 2 (July 15, 2013)).

Petitioner adds that the district court litigation involving the ’376 patent “was a powerful factor supporting a decision to institute” the ’613 IPR. Motion to Waive Time Limit 6. Petitioner also notes that the litigation in the Central District of California was stayed because of the ’613 IPR. *Id.*

Petitioner concludes that “XR . . . should not be able to obviate the Board’s review of the ’376 patent—which was very nearly complete after lengthy, extensive substantive proceedings—by settling with the original petitioners, further prolonging multiple district court proceedings in multiple states.” Mot. 6–7. Petitioner argues that “[t]he 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.” Paper 4, 6–7.

2. *Patent Owner’s opposing arguments*

Patent Owner responds that the relief Petitioner seeks “is both unprecedented and entirely unjustified based on the facts and circumstances of this case.” Prelim. Resp. 1. Patent Owner argues that “[t]here is no authority for the Board [to] ‘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.” *Id.* 7.

Patent Owner argues that “the parties in IPR20[22]-00613 filed a joint motion to terminate, and the Board granted [the joint motion and] terminated the IPR. That should put an end to the matter.” Prelim. Resp. 8. Patent Owner argues that Petitioner does not argue that XR and NETGEAR made any misrepresentations in the joint motion to terminate, nor that the Board lacked the authority to terminate the ’613 proceeding. *Id.*

Patent Owner argues that the *inter partes* review proceedings on which Petitioner relies related to terminating a proceeding close to the statutory deadline are “immaterial” and do not support Petitioner’s Motion to Reopen. Prelim. Resp. 9. Patent Owner argues that because other panels arrived at a different conclusion after considering the specific circumstances of those cases does not indicate that the ’613 IPR was terminated erroneously. *Id.* Patent Owner continues that these decisions do not “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” *Id.*

Patent Owner argues that “any notion that justice favors considering a request from [Petitioner] is particularly unfounded.” Prelim. Resp. 9. Patent Owner argues that Petitioner had no involvement in the ’613 IPR. *Id.*

Patent Owner explains that Petitioner “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.” *Id.* at 9–10.

Patent Owner argues that “[t]he interests of justice favors promoting settlements . . . [and] finality in IPR decisions.” Prelim. Resp. 9. Patent Owner adds that “[i]f terminated IPR proceedings could be reopened at-will, that would undermine predictability and reliance in the IPR system.” *Id.*

Patent Owner also argues that we do not have the authority to waive Petitioner’s delay in filing a motion for joinder. Prelim. Resp. 11. Patent Owner argues that Rule 42.5(c)(3) “plainly applies to modest extensions.” *Id.* Patent Owner adds that the rule “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.” *Id.*

Patent Owner argues that “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 [35 U.S.C.] § 315(b).” Prelim. Resp. 11. Patent Owner explains that the present Petition was filed two years and five months after Petitioner was served with a complaint. Patent Owner recognizes that the § 315(b) time bar does not apply in joinder cases, but argues that joining a third party a year after the joinder deadline “would contravene the important timing and procedural requirements that were enacted as part of the AIA and intended to protect patent owners.” *Id.* at 11–12; *see also id.* at 13 (explaining the Petitioner’s motions seek to

circumvent “the policies underlying the timing requirements of 35 U.S.C. § 315(b) and 37 C.F.R. § 42.122(b)” and undermine “the Board’s policies of promoting settlement and terminating proceedings resolved pursuant to settlement, as well as in finality in IPR decisions”).

Finally, Patent Owner invites us to order Petitioner to show cause why it should not be sanctioned in this case, arguing the Petitioner’s request for relief and supporting arguments are “frivolous.” Prelim. Resp. 17–21.

3. *Petitioner’s reply arguments*

Petitioner replies that this case “presents unique circumstances.” Reply 1. Petitioner argues that Patent Owner settled with the last remaining petitioner in the ’613 IPR “to ensure termination before the Board could address the merits of the IPR—following the invalidation of, or unpatentability findings on, other asserted claims of every other patent XR has brought against Ubiquiti for the past seven years.” *Id.*

Petitioner argues that “the Board has broad discretion to allow a late joinder.” Reply 1. Petitioner argues that granting the Motion to Reopen does not undermine the policy towards settlement. *Id.* Petitioner explains that the settlements in the ’613 IPR resolved the cases with the six petitioners in that proceeding—the only consequence in granting the Motion to Reopen is that the Board would determine the patentability of the claims challenged in the proceeding. *Id.* In addressing Patent Owner’s argument that granting the Motion to Reopen would discourage future settlement, Petitioner argues that Patent Owner “effectively advocates for the position that patent holders should be permitted to enter into settlements—even on unreasonable terms—for the purpose of avoiding the review of defective patents.” *Id.* at 1–2.

Petitioner argues that Patent Owner “knows that any of the many defendants facing new lawsuits . . . or any other third-party could still bring an identical IPR, in which Ubiquiti could seek to join. Rather than begin anew based on the exact same submissions and evidence, the Board should hear Ubiquiti’s petition now.” Reply 3.

Petitioner also argues that Patent Owner provides no authority to support its position that Rule 42.5(c)(3) would not let the Board excuse an action that is late by more than a year. Reply 3. Petitioner argues that, when the last petitioner in the ’613 IPR settled with Patent Owner and that proceeding was terminated, Petitioner “promptly filed its request for joinder, paid substantial fees, and presented its own, identical IPR petition.” *Id.* Petitioner argues that it knows of no authority that would prevent us from now hearing its Petition. *Id.*

Petitioner replies that 35 U.S.C. § 315(b) is not implicated because the statute bars instituting an *inter partes* review proceeding and the ’613 IPR has already been instituted. Reply 3–4. Petitioner argues that, contrary to Patent Owner’s argument, the Consolidated Trial Practice Guide (“CTPG”²) supports joinder. *Id.* at 4. For example, Petitioner directs us to language in the CTPG that states that “conduct of the parties and attempts to game the system may . . . be considered,” along with “fairness and prejudice concerns” in deciding to join a party barred under § 315(b). *See id.*; CTPG 77.

Finally, Petitioner replies that sanctions are not warranted, as “[n]o authority precludes” the Motion to Reopen. Reply 5.

² Available at <https://www.uspto.gov/sites/default/files/documents/tpgnov.pdf?MURL=Tri alPracticeGuideConsolidated>.

4. *Analysis and conclusions on the motions*

For the reasons discussed below, we deny the Motion to Reopen. Also, because Petitioner’s Motion to Waive Time Limit is predicated on our granting the Motion to Reopen, we dismiss the Motion to Waive Time Limit as moot.³

First, Petitioner does not identify any authority that would give us the power to reopen a terminated proceeding. The Leahy-Smith America Invents Act (“AIA”), Pub. L. No. 112-29, 125 Stat. 284, 296–07 (2011), establishes the legal framework for AIA trial proceedings before the Board, including petitioning for an *inter partes* review (35 U.S.C. § 311), instituting a review (35 U.S.C. § 314), conducting a review (35 U.S.C. § 316), and terminating or completing a review (35 U.S.C. §§ 317, 318). Under this framework, the Board established procedures governing an *inter partes* review. *See* 35 U.S.C. § 316(a) (enumerating subject matter for regulations that “[t]he Director shall prescribe” for the conduct of an *inter partes* review); 37 C.F.R. §§ 42.1–42.80 (providing regulations for trial practice and procedure), §§ 42.100–42.123 (providing regulations for *inter partes* review). Petitioner does not identify any specific statute or regulation that authorizes us to reopen a properly terminated *inter partes* review proceeding. And we do not discern a specific statute or regulation that gives us such authority. Petitioner argues that there is no authority that precludes us from reopening a proceeding. But the lack of an express prohibition against an action does not necessarily mean we have the authority for that action, particularly the extraordinary action of reopening a terminated proceeding at the behest of a non-party to that proceeding.

³ Concurrent with entering this Order, we enter an Order denying joinder.

Second, even if we have the authority to reopen the '613 IPR, we are not persuaded that such an action is warranted here. As an initial matter, we agree with Patent Owner that the '613 IPR was properly terminated.

Title 35, Section 317 of the U.S. Code states, in relevant part,

An inter partes review instituted under this chapter shall be terminated with respect to any petitioner upon the joint request of the petitioner and the patent owner, unless the Office has decided the merits of the proceeding before the request for termination is filed. . . . If no petitioner remains in the inter partes review, the Office may terminate the review or proceed to a final written decision under section 318(a).

35 U.S.C. § 317(a). As we had not decided the merits of the proceeding before NETGEAR and XR jointly requested termination, and the parties satisfied other statutory requirements for termination, the statute required us to terminate Petitioner NETGEAR from the proceeding. *See* '613 IPR, Paper 52, 2. The statute then gives us discretion to terminate the proceeding or continue to a final written decision. We exercised our discretion to terminate the '613 IPR without rendering a final written decision.⁴ *See* 37 C.F.R. § 42.72 (“The Board may terminate a trial without rendering a final written decision, where appropriate, including . . . pursuant to a joint request under 35 U.S.C. 317(a). . . .”).

Petitioner’s reliance on non-precedential Board decisions to suggest that terminating the '613 IPR was not proper is unpersuasive. *See* Mot. 5–6. As noted above, whether to terminate a proceeding after no petitioner remains is a matter of discretion. And, under the specific facts of the

⁴ Petitioner’s argument that “[t]he existence of multiple district court litigation involving '376 patent was a powerful factor supporting a decision to institute” the '613 IPR is unsupported in this record. *See* Motion to Waive Time Limit 6.

proceedings cited by Petitioner, those panels decided that rendering a final written decision was warranted despite the motion to terminate. *Cf. Rubicon Comm's*, IPR2016-01187, Paper 100 at 2–3 (stating that request to terminate came *less than one week* before the statutory deadline and after the panel decided the merits of the proceeding); *OpenTV, Inc.*, IPR2015-00969, Paper 29 at 5 (“Because *the parties* are not able to consider the contents of all of the agreements purporting to settle their disputes, they cannot know whether, and we cannot rely on their assurances that, these agreements in fact settle their disputes.”); *Smartflash LLC*, CBM2015-00015, Paper 49 at 6 (reasoning that the Board was “making determinations in related cases involving similar issues and argument”).

Also, Petitioner does not direct us to any persuasive authority that the Board should not terminate an *inter partes* review proceeding when there exists ongoing litigation involving the challenged patent and third parties, that is, parties not involved in the *inter partes* review. Petitioner’s reliance on the non-precedential Board decisions in *Macauto*, *Vestcom Int’l*, and *Applied Voice & Speech Techs.* is unpersuasive, as Petitioner reads too much into those decisions’ language. *See* Motion to Waive Time Limit 5–6. None of these cases expressly states that it considered whether third parties were involved in an ongoing related matter. Instead, the relied upon language can be read to indicate that no other disputes between the parties to the proceeding involving the challenged patent existed. *See, e.g., Macauto*, IPR2012-00004, Paper 23 at 2 (“The co-pending district court litigation is being dismissed and the parties have represented that no other actions are pending.”).

To the extent that Petitioner argues that the Federal Circuit’s decision in *Perkins* stands for the proposition that the Patent Office, rather than an

Article III court, should resolve issues of patent validity, Petitioner reads this decision too broadly. *See* Mot. 5; Motion to Waive Time Limit 4–5. In *Perkins*, the appellant questioned whether the Board properly determined the priority in an interference, after it determined that the claims in the interference count were unpatentable. *Perkins*, 886 F.2d at 326. *Perkins*, the appellant, had an issued patent with the claims at issue. *Id.* The Board determined that the claims were unpatentable, and that Kwon, not Perkins, had priority. *Id.* As a result, the Board cancelled Perkin’s issued claims. *Id.* at 325. The Federal Circuit, in interpreting the revised patent statute that combined two separate Board entities (Board of Patent Appeals and Board of Patent Interferences) into a single structure, determined that a “decision by the Board of all issues that are fully and fairly raised during the interference proceeding, whether related to patentability or priority, is in full accord with Congressional intent that PTO procedures be simplified as well as improved.” *Id.* at 328. That is, when determining patentability and priority of a claim are both issues in a proceeding (in the case of *Perkins*, an interference proceeding), the Federal Circuit concluded that the Office should reach a decision on both issues.

Regardless, the current Board has in place procedures for the very purpose under the circumstances here—post-grant reviews, such as *inter partes* reviews. Petitioner had two separate opportunities to avail itself of these procedures and took no action. Indeed, Petitioner’s lack of action within the timeframes provided by our rules and the governing statutes weighs heavily against any interests of justice in reopening the ’613 IPR, even if we had the authority to do so. Petitioner had the opportunity to petition the Board for an *inter partes* review of the ’376 patent within one year from the date it was served with the complaint alleging Petitioner

infringed the patent, something done by four other parties sued at the same time. Petitioner took no action. Once the '613 IPR was instituted, Petitioner had the opportunity to move to join the '613 IPR within one month of institution, something done by three other parties sued at the same time as Petitioner. Again, Petitioner took no action. Petitioner does not provide *any* explanation why it chose not to avail itself of these opportunities. *Cf.* CTPG 77 (“The Board does not generally expect fairness and prejudice concerns to be implicated by, for example, the mistakes or omissions of a petitioner.”).

We also agree with Patent Owner that our policy favoring settlement and interests in finality weigh against reopening the '613 IPR. *See* Prelim. Resp. 9; *see, e.g.*, CTPG 86 (“There are strong public policy reasons to favor settlement between the parties to a proceeding. . . . The Board expects that a proceeding will terminate after the filing of a settlement agreement, unless the Board has already decided the merits of the proceeding.”). As Patent Owner argues, one of the reasons underpinning NETGEAR and Patent Owner’s decision to settle their disputes is their “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.” Prelim. Resp. 4–5 (quoting the joint motion to terminate, '613 IPR, Paper 49, 3). Reopening the '613 IPR would negate these factors, at least as to Patent Owner, which may weigh against other similarly situated patent owners reaching a settlement in the future.

Similarly, a patent owner may be reluctant to settle a proceeding if the patent owner thought that some third party could move the Board to reopen

the proceeding, or that patent owner may at least be forced to weigh the lack of finality against pursuing settlement.

We do not agree with Patent Owner that reopening the '613 IPR would eviscerate the time limit in § 315(b), as cases where a petitioner has sought to reopen a terminated proceeding to which it is not a party are rare. Still, our governing statutes and regulations lay out a timetable of petitioning or joining a post-grant proceeding. This timetable helps to ensure the just, speedy, and inexpensive resolution of patentability disputes, yet ensures that a patent owner's day in court is not unduly delayed. *Cf.* Prelim. Resp. 12 (“[I]t would contravene the important timing and procedural requirements that were enacted as part of the AIA and intended to protect patent owners.”). Petitioner's Motion to Reopen disrupts the normal timetable.

To the extent that Petitioner suggests that Patent Owner gamed the review process or otherwise acted improperly in settling the '613 IPR, we do not agree. *See* Reply 1 (“XR [settled with NETGEAR] in order to ensure termination before the Board could address the merits of the IPR—following the invalidation of, or unpatentability findings on, other asserted claims of every other patent XR has brought against Ubiquiti for the past seven years.”), 4 (quoting the CTPG, 76, that we will consider “attempts to game the system” when deciding a joinder motion). Both the record here and in the '613 IPR suggest the settlements were nothing more than arms-length negotiations between parties. *See, e.g.*, Prelim. Resp. 4–5 (discussing the XR and NETGEAR settlement).

Accordingly, for the reasons discussed above, we do not grant Petitioner's Motion to Reopen. And, because we do not reopen the '613 IPR, Petitioner has no proceeding to join. So, Petitioner's Motion for an Extension of Time to file its joinder motion is dismissed as moot.

5. *Sanctions*

Rule 42.12 authorizes the Board to “impose a sanction against a party for misconduct, including: . . . (2) [a]dvancing a misleading or frivolous argument or request for relief; . . . [or] (6) [a]buse of process.” 37 C.F.R. § 42.12. Patent Owner argues that we should order Petitioner to show cause why it should not be sanctioned for frivolous motions. Prelim. Resp. 17–20. Petitioner argues that sanctions are not warranted in this case, as “[n]o authority precludes” Petitioner’s motions. Reply 5.

We agree with Petitioner that, under these unique facts, sanctions are not warranted. Although we sympathize with Patent Owner, we find that Petitioner’s arguments, although weak, do not rise to the level of sanctionable conduct. As these motions present an issue not previously presented to the Board, there was no clear authority rejecting Petitioner’s arguments.

III. ORDER

In consideration of the foregoing, it is hereby

ORDERED that Petitioner’s Motion for Leave to File Motion to Reopen IPR2022-00613 (Paper 2) is granted to the extent that we convert the motion to a Motion to Reopen IPR2022-00613, a motion that we *deny* on the merits; and

FURTHER ORDERED that 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) is dismissed as moot.

IPR2024-00148
Patent 10,594,376

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