

Filed: February 12, 2024

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ERICSSON INC.,

PETITIONER,

V.

GENERAL ACCESS SOLUTIONS, LTD.,

PATENT OWNER.

Case No. IPR2024-00392

U.S. Patent No. 7,230,931

**PATENT OWNER'S OPPOSITION TO
PETITIONER'S MOTION FOR JOINDER**

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I. INTRODUCTION

On January 12, 2024, Ericsson filed an IPR Petition against U.S. Patent No. 7,230,931 (“the ’931 patent”). At the same time, Petitioner filed a Motion for Joinder to *Inter Partes* Review IPR2023-00978. The Board should deny Ericsson’s Motion because Ericsson is estopped from requesting any challenge to the ’931 patent that its privy, Sprint, brought or could have brought in its prior IPR that resulted in a Final Written Decision (“FWD”). Additionally, because Patent Owner sued Ericsson’s privy, Sprint, for infringing the ’931 patent over seven years ago, Ericsson is time-barred from challenging the ’931 patent in an IPR, and fairness does not require that it be allowed to join a challenge to the patent at this late stage. Finally, the *General Plastic* factors also weight in favor of discretionary denial of Ericsson’s joinder motion in this case.

II. ARGUMENT

A. Legal Standard

As the moving party, Petitioner has the burden of proof to establish that joinder is appropriate. 37 C.F.R. §§ 42.20(c), 42.122(b). However, under U.S.C. 35 § 315(e)(1), “[t]he petitioner in an inter partes review ... that results in a final written decision under section 318(a), or the real party in interest or privy of the petitioner, may not request or maintain a proceeding before the Office with respect to that claim on any ground that the petitioner raised or reasonably could have raised during that inter partes review.”

Additionally, “[t]he fact that the [Director or her delegate the] Board has the discretion to join a party does not mean that joinder is automatic, particularly given the need to complete proceedings in a just, speedy, and inexpensive manner.” *Dell Inc. v. Network-1 Sec. Sols., Inc.*, IPR2013-00385, Paper 17 at 6 (PTAB July 29, 2013). “[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 § 315(c). In order to balance various considerations, including those raised by other statutes such as the time bar of § 315(b), the Board will exercise this discretion only in limited circumstances—namely, where fairness requires it and to avoid undue prejudice to a party. Circumstances leading to this narrow exercise of our discretion may include, for example, actions taken by a patent owner in a co-pending litigation such as the late addition of newly asserted claims.” *Proppant Express Invs., LLC v. Oren Techs., LLC*, IPR2018-00914, Paper 38 at 4 (PTAB Mar. 13, 2019) (precedential)).

B. Ericsson is Estopped from Joining IPR2023-00978.

On April 30, 2016, Patent Owner accused Sprint’s LTE base stations of infringing the ’931 patent. (Ex. 2001 at 1.) (“Sprint Litigation”) Sprint was served with Patent Owner’s complaint on July 29, 2016. *See Sprint Spectrum L.P. v. General Access Solutions, Ltd.*, IPR2017-01889, Paper 1 at 3, n.1 (“Sprint IPR”). As a result, on July 28, 2017, Sprint challenged the claims at issue here—claims 28

and 29 of the '931 Patent (the “Challenged Claims”) in the Sprint IPR. In that IPR, Sprint identified Patent Owner’s April 30, 2016 suit against it as a Related Matter under 37 C.F.R. § 42.8(b)(2). *Id.* at Paper 1 at 3. The Board issued its FWD in that IPR on March 7, 2019. *Id.* at Paper 43. Then, following an appeal and remand from the Federal Circuit, the Board issued a subsequent FWD in that IPR, confirming the patentability of the Challenged Claims, on January 29, 2021. *Id.* at Paper 61.

Under U.S.C. 35 § 315(e)(1), “[t]he petitioner in an inter partes review ... that results in a final written decision under section 318(a), ***or the real party in interest or privy of the petitioner***, may not request or maintain a proceeding before the Office with respect to that claim on any ground that the petitioner raised or reasonably could have raised during that inter partes review.” (emphasis added). Petitioner Ericsson was the privy of Petitioner Sprint in the Sprint IPR that resulted in a FWD. Thus, Ericsson is estopped from filing its current Petition and Motion for Joinder to IPR2023-00978, which raises grounds that the Sprint IPR raised or reasonably could have raised, as discussed in Section II.D., below.

The Board has already determined that Ericsson is a privy of Sprint with respect to allegations of infringement arising out of Sprint’s use of Ericsson’s LTE base stations, such as those in the Sprint Litigation. Specifically, Ericsson represented to both the Board and a District Court that “Ericsson’s supply contract with Sprint contains detailed indemnification provisions, which specifically require

Ericsson to indemnify Sprint from patent infringement claims arising out of Sprint's use of Ericsson's LTE base stations." (Ex. 2002 at 1.) As a result, the Board found that Ericsson "has a preexisting substantive legal relationship" with Sprint "regarding the base stations at issue in the District Court Litigation"—which are the LTE base stations that Ericsson provides to Sprint. *See Ericsson Inc. v. Regents of the University of Minnesota*, IPR2017-01186, Paper 58 at 7-10, 14 (PTAB June 19, 2020) ("*Regents*") The Board further relied on "Ericsson's supply contract with Sprint" for "Sprint's use of Ericsson's LTE stations" in finding that Ericsson "had the opportunity to control the defense of the District Court Defendants with respect to the base stations." *Id.* at 10-11, 14; *see* Ex. 2002 at 1. Consequently, the Board found that based on "the second and fourth *Taylor* categories," Ericsson "is in privity with the District Court Defendants"—including Sprint. *Id.* at 14

Because the Sprint IPR—as in *Regents*—arises "from patent infringement claims arising out of Sprint's use of Ericsson's LTE base stations," the "detailed indemnification provisions" in "Ericsson's supply contract with Sprint" must make Ericsson a privy of Sprint's in the Sprint IPR just as it was a privy with Sprint in the *Regents* litigation. (*See* Ex. 2002 at 1.) As such, Ericsson is now estopped from challenging claims 28 and 29 of the '931 patent, which its privy, Sprint, already challenged to a FWD in the Sprint IPR. *See* Sprint IPR at Paper 61.

C. Ericsson is Time-Barred from Challenging the '931 Patent.

In addition to being estopped from bringing an IPR, Ericsson is also time-barred under § 315(b). As described above, Patent Owner sued Ericsson's privy, Sprint, for infringing the '931 patent in 2016. Thus, because Sprint is time-barred from bringing an additional IPR challenging the '931 patent (in addition to being estopped from doing so based on the Sprint IPR), so is its privy, Ericsson.

Indeed, the Board previously denied an IPR Petition from Ericsson in *Regents* on the basis that it was “barred under § 315(b)” because Ericsson “filed the Petition more than one year after the date on which its privy [Sprint] was served with a complaint alleging infringement of the [LTE base station-related] patent.” *See Ericsson Inc.*, IPR2017-01186, Paper 58 at 7, 11, 15 (finding that Ericsson has agreements with Sprint “to supply them with the base stations that implement some of the functionality identified in Patent Owner’s infringement allegations,” and “that preexisting relationship includes substantive legal obligations. Namely, the supply agreements include indemnification provisions” and “the indemnification provisions in [Ericsson’s] supply agreements with the District Court Defendants specifically address the issue of control” (citing Ericsson’s “supply agreement with Sprint”).)

Just as in *Regents*, Patent Owner has accused Sprint’s LTE base stations—again supplied by Ericsson—of infringing its patent. Because Ericsson has

admitted that “Ericsson’s supply contract with Sprint contains detailed indemnification provisions, which specifically require Ericsson to indemnify Sprint from patent infringement claims arising out of Sprint’s use of Ericsson’s LTE base stations,” Ericsson must similarly be time-barred from filing an IPR in this matter. *See Ericsson Inc. v. Regents of the University of Minnesota*, IPR2017-01186, Ex. 2032 at 1 (PTAB June 19, 2020).

Although the Board has the discretion to permit a time-barred petitioner to join an IPR, “the 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),” and the Board “will do so only where fairness requires it and to avoid undue prejudice to a party.” (Consolidated Trial Practice Guide at 76-77.) Ericsson has provided no reason that fairness requires it to join a petition (1) more than seven years after its privy was sued for infringing the ’931 patent, (2) after that same privy has already brought an IPR challenging the ’931 patent that resulted in a FWD affirming the patentability of the Challenged Claims, and (3) after Ericsson’s District Court case was dismissed with prejudice. (*See* Ex. 2003 at 1.) *See Code200 et al. v. Bright Data Ltd.*, IPR2021-01503, Paper 13 at 8 (PTAB Mar. 14, 2022) (denying joinder motion where “allowing joinder would offer Petitioner a second bite at asserting invalidity after the previous dismissal with prejudice of Petitioner’s invalidity counterclaims in the District Court action.”).

D. The *General Plastic* Factors Weigh Against Joinder.

The Board has clarified that discretionary factors must be considered before determining a joinder motion. *Apple Inc. v. Uniloc 2017 LLC*, IPR2020-00854, Paper 9 at 5 (PTAB Oct. 28, 2020) (precedential) (“before determining whether to join . . . even though the Petition is a ‘me-too petition,’ we first determine whether application of the General Plastic factors warrants the exercise of discretion to deny the Petition under §314(a).”); *see also Gen. Plastic Indus. Co., Ltd. v. Canon Kabushiki Kaisha*, IPR2016-01357, Paper 19 at 15-19 (PTAB Sept. 6, 2017) (precedential) (precedential). The *General Plastic* factors weigh in favor of exercising discretion to deny the petition and joinder. Discretionary denial is appropriate here given the substantial relationship between Ericsson and Sprint.

In *General Plastic Co. Ltd. v. Canon Kabushiki Kaisha* the Board enumerated seven non-exhaustive factors the Board may consider when exercising its discretion to institute an IPR. *Id.* at 16-17 (citation omitted). Those factors relevant here, discussed below, weigh against institution.

First Factor: Relationship Between Petitioners: In *Valve Corp. v. Elec. Scripting Prods., Inc.*, the Board explained that “application of the *General Plastic* factors is not limited solely to instances where multiple petitions are filed by the same petitioner. Rather, when different petitioners challenge the same patent, we consider any relationship between those petitioners when weighing the *General*

Plastic factors.” IPR2019-00062, Paper 11 at 9 (PTAB Apr. 2, 2019)

(precedential). As explained in Section II.B., above, the Board has already held that Ericsson is a privy of Sprint with respect to its supplied LTE base stations at issue here. The Board should reach the same conclusion in this matter.

To the extent that the Board determines that Ericsson is not a privy of Sprint, the Board should then consider whether Ericsson nonetheless has a “substantial relationship” with Sprint. *See* Changes Under Consideration to Discretionary Institution Practices, Petition Word-Count Limits, and Settlement Practices for America Invents Act Trial Proceedings Before the Patent Trial and Appeal Board, 88 Fed. Reg. 24503, 24507 (proposed Apr. 21, 2023) (“[T]he USPTO is considering adopting a ‘substantial relationship’ test to evaluate whether certain entities are sufficiently related to a party in an AIA proceeding such that discretionary denial is warranted...”). As an indemnitor with financial responsibility for Sprint’s infringement, Ericsson clearly has a substantial interest in the outcome of these proceedings. That overlapping interest weighs heavily in favor of discretionary denial.

Second Factor: The First Petitioner Should Have Known of the Prior Art:

As shown below, both Sprint and Ericsson’s IPRs rely heavily on Vornefeld, which the Board and the Federal Circuit already considered.

	<u>Sprint IPR</u>	<u>Verizon IPR</u>
Ground 1	§ 102 Vornefeld	§ 103 Vornefeld + Atsuta
Ground 2	§ 103 Vornefeld + Ahy	§ 103 Vornefeld + Goldberg
Ground 3	§ 103 Vornefeld + Andersson	§ 103 Youssefmir + Atsuta
Ground 4	§ 103 Vornefeld + Andersson + Ahy	§ 103 Vornefeld + Atsuta + Tangemann
Ground 5	§ 103 Newman + Andersson + Ahy	§ 103 Vornefeld + Goldberg + Tangemann

And while Ericsson purports to add new art disclosing the use of a “single frame,” that art is (1) still dependent on Vornefeld and (2) cumulative of the art Sprint relied on in the previous IPR. Regardless, Sprint and Ericsson knew or should have known of the “new” art at the time of the original petition in the Sprint IPR.

Third, Fourth, and Fifth Factors: Timing: In *RPX Corp. v. Applications in Internet Time, LLC*, the Board found that the later-filed petitions challenged “the same claims of the same patents,” and were “filed by a party with a significant relationship to the original petitioner.” IPR2015-01750, at 38-39 (PTAB Oct. 2, 2020) (Paper 128) (precedential). The Board also determined that “the new petitioner “had the benefit of reviewing the original petitions and original Patent Owner preliminary responses.” *Id.* at 39.

The same is true here. Petitioner had the benefit of reviewing not only the original petition in the Sprint IPR and Patent Owner’s preliminary response, but

also the Board and the Federal Circuit’s decisions before filing its petition. This Petition is plainly crafted as an effort to overcome the specific deficiencies identified by the Board and the Federal Circuit. It is precisely this sort of redo that these factors are intended to prevent.

Sixth and Seventh Factors: The Board’s Resources and Timing: With deference and respect, the Board’s finite resources should not be expended re-reviewing strikingly similar challenges by related parties to claims previously upheld by both the Board and the Federal Circuit. These factors also weigh against institution.

E. Patent Owner Will Address Whether Petitioner’s Petition Warrants Institution in its Preliminary Response.

Patent Owner’s Preliminary Response will address whether Petitioner’s Petition substantively warrants institution. A Petition that does not warrant institution cannot join another proceeding. *Facebook, Inc. v. Windy City Innovations, LLC*, 973 F.3d 1321, 1332 (Fed. Cir. 2020) (“The statute makes clear that the joinder decision is made after a determination that a petition warrants institution, thereby affecting the manner in which an IPR will proceed.”) (citation omitted).

III. CONCLUSION

In view of the foregoing, Patent Owner respectfully requests that institution and joinder be denied.

Dated: February 12, 2024

Respectfully Submitted,

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CERTIFICATE OF COMPLIANCE

Under the provisions of 37 CFR § 42.24(d), the undersigned hereby certifies that Patent Owner's Opposition to Petitioner's Motion for Joinder complies with the 15-page limit under 37 C.F.R. § 42.24(b)(3). This paper contains fewer than the limit of 15 pages, excluding the table of contents, table of authorities, certificate of compliance, and certificate of service.

Dated: February 12, 2024

Respectfully Submitted,

/Sarah E. Spires /

Sarah E. Spires (Reg. No. 61,501)
Lead Counsel for Patent Owner

CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.6(e), I certify that I caused to be served on the counsel for Petitioner a true and correct copy of the foregoing Patent Owner's Opposition to Petitioner's Motion for Joinder, by electronic means on February 12, 2024 at the following addresses of record:

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