

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
Patent No. 7,230,931

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

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I. ERICSSON IS NOT ESTOPPED FROM JOINING IPR2023-00978.

In its Opposition (Paper 7, “Opp.”) Patent Owner argues that Ericsson is estopped from joining IPR2023-00978 based on its alleged privity with Sprint, who previously challenged claims 28 and 29 of the ’931 Patent in IPR2017-01889 (“Sprint ’931 Patent IPR”). Opp., 2-3. PO argues that privity exists, because Ericsson and Sprint were found to be privies in a different IPR, IPR2017-01186 involving U.S. Pat. No. 8,774,309, which Regents of the University of Minnesota asserted against Sprint in federal district court. Opp., 3-4 (citing *Ericsson Inc. v. Regents of the University of Minnesota*, IPR2017-01186, Paper 58 at 7-10, 14 (PTAB June 19, 2020) (“Regents IPR”)). That is, PO asserts that Ericsson and Sprint were privies with respect to the Sprint ’931 Patent IPR because they were found to be privies in a ***different, unrelated*** IPR involving a ***different, unrelated*** patent. This argument is without merit.

PO fails to set forth any evidence to support a privity finding between Ericsson and Sprint regarding the ’931 Patent at issue here. In fact, comparing PO’s opposition to Ericsson’s joinder motion to PO’s opposition to Nokia’s motion to also join IPR2023-00978 exposes that PO lacks any such evidence. When opposing Nokia’s Motion for Joinder to IPR2023-00978, PO relied on Sprint’s district court Initial Disclosures identifying Nokia as a supplier and a potential

indemnifier. PO argued that this was evidence of Nokia being a privy to Sprint with respect to the Sprint '931 Patent IPR. *See Nokia of America Corp. v. General Access Solutions, Ltd.*, IPR2024-00461, Paper 8 at 5-6 (PTAB Feb. 16, 2024). Notably, however, those same Initial Disclosures say *nothing* about Ericsson as a supplier or potential indemnitor to Sprint with respect to the Sprint '931 Patent IPR. Ex. 1100 at 3, 9-10. PO identifies no evidence that there is privity between Sprint and Ericsson with respect to the Sprint '931 Patent IPR.

In the Regents IPR, the Board found Ericsson to be in privity with Sprint based on a preexisting indemnity relationship there and the opportunity to control that corresponding district court litigation where Ericsson had intervened. *See* IPR2017-01186, Paper 60 at 4. But PO here has provided no evidence to support such a finding with respect to the Sprint '931 Patent IPR and the earlier district court litigation against Sprint involving the '931 Patent in which Ericsson did not intervene. Moreover, Ericsson's indemnity of Sprint, on which the Regents IPR privity finding was based, was limited to "infringement claims made by Plaintiff [Regents] against Ericsson base stations in [the Regents] lawsuit." Ex. 2002 at 3, fn. 1. Accordingly, Ericsson and Sprint are not privies with respect the '931 Patent, and Ericsson is not estopped from joining IPR2023-00978.

II. ERICSSON IS NOT TIME-BARRED FROM CHALLENGING THE '931 PATENT.

Despite the fact that the § 315(b) time bar does not apply to a request for joinder, PO argues Ericsson should be time-barred from challenging the '931 Patent based on Ericsson's alleged privity with Sprint. Opp., 5. As discussed above, however, Ericsson is not in privity with Sprint with respect to the '931 Patent. Thus, for the same reasons, Ericsson is not time-barred under § 315(b).

III. PO'S GENERAL PLASTIC ARGUMENT FAILS.

Concerning the first *General Plastic* factor, PO again relies on the alleged privity relationship between Ericsson and Sprint. Opp., 7-8. But as discussed above, PO provides no evidence to support a privity or other relationship between Sprint and Ericsson with respect to the '931 Patent. Accordingly, GAS's "allegations appear to be mere speculation," so factor 1 weighs against denying institution and joinder. *See Celco Partnership d/b/a Verizon Wireless v. General Access Solutions, Ltd.*, IPR2023-00978, Paper 20 at 19 (PTAB Dec. 14, 2023).

"[F]actors 2-5 bear little relevance" in the Board's *General Plastic* analysis "[o]nce resolution of factor 1 indicates that Petitioner had not previously filed a petition against the same patent" unless "there is evidence in the record of extenuating circumstances such as a showing that there was a previous petitioner who challenged the same patent and that the previous petitioner and the current petitioner planned the staggered petitions." *Alcatel-Lucent USA Inc. v. Oyster Optics, LLC*, IPR2017-02146, Paper 12 at 12 (PTAB Feb. 28, 2018) (non-

precedential); *see also Verizon v. General Access Solutions*, IPR2023-00978, Paper 20 at 19. There is no such evidence. Moreover, with respect to factor 2, PO provides no evidence to support its assertion that Ericsson knew or should have known of the new art at the time of the filing of the Sprint IPR on the '931 Patent. In addition, “the concerns underlying factor 3 are not implicated significantly,” because “it is not the same petitioner refining arguments by filing multiple, staggered petitions.” *Id.* And PO “does not present specific arguments regarding factors 4 and 5” related to the timing of when Petitioner learned of the new prior art and the timing of the Petition. *See, e.g., id.* at 21. *General Plastic* factors 2-5 weigh against denying institution and joinder.

Regarding factors 6 and 7, PO’s concern about the Board’s finite resources ignores that Ericsson’s Petition merely seeks joinder to an already instituted IPR with a final written decision deadline less than 1 year from the filing of Ericsson’s *Petition* (and less than five months from anticipated institution of this IPR). These factors weigh against denying institution and joinder.

IV. CONCLUSION

PO’s arguments fail, and Ericsson’s *inter partes* review should be joined.

Dated: March 12, 2024

Respectfully submitted,

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A handwritten signature in black ink, appearing to read "Chad C. Walters", written over a horizontal line.

Chad C. Walters
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CERTIFICATE OF SERVICE

In accordance with 37 C.F.R. § 42.6(e), the undersigned certifies that on the 12th day of March, 2024, a complete and entire copy of PETITIONER'S REPLY TO PATENT OWNER'S OPPOSITION TO MOTION FOR JOINDER, Exhibit 1100, and PETITIONER'S UPDATED EXHIBIT LIST were served on Patent Owner via email to the following addresses:

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Dated: March 12, 2024

Respectfully submitted,

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