

Filed: February 16, 2024

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

NOKIA OF AMERICA CORPORATION,

PETITIONER,

V.

GENERAL ACCESS SOLUTIONS, LTD.,

PATENT OWNER.

Case No. IPR2024-00461

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

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

TABLE OF CONTENTS

I.	INTRODUCTION	1
II.	LEGAL STANDARD	1
III.	ARGUMENT	3
A.	The <i>General Plastic</i> Factors Weigh Against Joinder.....	3
1.	First Factor: Relationship Between Petitioners.	4
2.	Second Factor: The First Petitioner Should Have Known of the Prior Art.	7
3.	Third, Fourth, and Fifth Factors: Timing.....	8
4.	Sixth and Seventh Factors: The Board’s Resources and Timing	9
B.	Patent Owner Will Address Whether Petitioner’s Petition Warrants Institution in its Preliminary Response.	9
IV.	CONCLUSION	9

TABLE OF AUTHORITIES

Cases

<i>Apple Inc. v. Uniloc 2017 LLC</i> , IPR2020-00854 (PTAB Oct. 28, 2020) (Paper 9)	2
<i>Dell Inc. v. Network-1 Sec. Sols., Inc.</i> , IPR2013-00385 (PTAB July 29, 2013) (Paper 17).....	2
<i>Facebook, Inc. v. Windy City Innovations, LLC</i> , 973 F.3d 1321 (Fed. Cir. 2020).....	1, 9
<i>Gen. Plastic Indus. Co., Ltd. v. Canon Kabushiki Kaisha</i> , IPR2016-01357 (PTAB Sept. 6, 2017) (Paper 19)	2, 4
<i>RPX Corp. v. Applications in Internet Time, LLC</i> , IPR2015-01750 (PTAB Oct. 2, 2020) (Paper 128)	8
<i>Sprint Spectrum L.P. v. General Access Solutions, Ltd.</i> , IPR2017-01889 (PTAB Jan. 29, 2021) (Paper 61).....	5
<i>Sprint Spectrum L.P. v. General Access Solutions, Ltd.</i> , IPR2017-01889 (PTAB July 28, 2017) (Paper 1).....	4, 5
<i>Sprint Spectrum L.P. v. General Access Solutions, Ltd.</i> , IPR2017-01889 (PTAB Mar. 7, 2019) (Paper 43).....	5
<i>Valve Corp. v. Elec. Scripting Prods., Inc.</i> , IPR2019-00062 (PTAB Apr. 2, 2019) (Paper 11)	4

Statutes

37 C.F.R. § 42.122(b)	2
37 C.F.R. § 42.20(c).....	2

Other Authorities

88 Fed. Reg. 24503	7
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I. INTRODUCTION

On January 16, 2024, Nokia of America Corporation (“Nokia”) 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. Given the substantial relationship between Sprint (the petitioner in a prior IPR challenging claims 28 and 29 of the ’931 patent) and its supplier, Nokia (the Petitioner here), the Board should deny Nokia’s Motion because the *General Plastic* factors weigh in favor of discretionary denial of Nokia’s joinder motion in this case.

II. LEGAL STANDARD

“To join a party to an instituted IPR, the plain language of § 315(c) requires two different decisions.” *Facebook, Inc. v. Windy City Innovations, LLC*, 973 F.3d 1321, 1332 (Fed. Cir. 2020). The first decision is “whether the joinder [to] applicant’s petition for IPR ‘warrants’ institution under § 314.” The second is “whether to ‘join as a party’ the joinder applicant.” *Id.* “Joinder may be authorized when warranted, but the decision to grant joinder is discretionary.” *Sony Corp. of Am. v. Network-1 Sec. Sols., Inc.*, IPR2013-00386, Paper 16 at 3 (PTAB Jul. 29, 2013). “The fact that the [Director or her delegate] 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).

As the moving party, Nokia has the burden of proof to establish that joinder is appropriate. 37 C.F.R. §§ 42.20(c), 42.122(b). When considering a motion for joinder, the Board examines factors including: (1) reasons why joinder is appropriate; (2) any new grounds of unpatentability asserted in the petition; (3) what impact (if any) joinder would have on the trial schedule for the existing review; and (4) specifically how briefing and discovery may be simplified. *See Dell Inc.*, IPR2013-00385, Paper 17 at 3.

The Board has also 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).

III. ARGUMENT

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

The *General Plastic* factors weigh in favor of exercising discretion to deny the petition and joinder in this case. 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:

- (1) whether the same petitioner previously filed a petition directed to the same claims of the same patent;
- (2) whether at the time of filing of the first petition the petitioner knew of the prior art asserted in the second petition or should have known of it;
- (3) whether at the time of filing of the second petition the petitioner already received the patent owner's preliminary response to the first petition or received the Board's decision on whether to institute review in the first petition;
- (4) the length of time that elapsed between the time the petitioner learned of the prior art asserted in the second petition and the filing of the second petition;
- (5) whether the petitioner provides adequate explanation for the time elapsed between the filings of multiple petitions directed to the same claims of the same patent;
- (6) the finite resources of the Board; and
- (7) the requirement under 35 U.S.C. § 316(a)(11) to issue a final determination not later than 1 year after the date on which the Director notices institution of review.

IPR2016-0135 at 16-17 (citation omitted). These factors weigh against institution.

1. 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 when 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). This factor weighs in favor of discretionary denial. In particular, discretionary denial is appropriate here given the substantial relationship between Sprint (the petitioner in a prior IPR challenging claims 28 and 29 of the ’931 patent) and its supplier, Nokia (the Petitioner here). *See, e.g.*, Ex. 2002 (T-Mobile press release announcing \$3.5 billion agreement between T-Mobile and Nokia); Ex. 2003 (T-Mobile press release announcing completed merger with Sprint); Ex. 2004 (article explaining T-Mobile \$3.5 agreement with Nokia to continue after T-Mobile merger with Sprint).

On April 30, 2016, Patent Owner accused Sprint’s LTE base stations of infringing the ’931 patent. (Ex. 2001 at 1) (“Sprint Litigation”). 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 an IPR. *See Sprint Spectrum L.P. v. General Access Solutions, Ltd.*, IPR2017-01889, Paper 1 at 3, n.1 (“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.

In the Sprint Litigation, Sprint (the petitioner in the prior Sprint IPR) represented that Nokia (the petitioner here) supplies the base station equipment that General Access accused of infringement. Specifically, with respect to Nokia, Sprint alleged the following:

Sprint states that the eNodeBs accused of infringement by Plaintiff were and are supplied to Sprint by Alcatel-Lucent USA Inc., Huawei Technologies USA, Nokia Solutions and Network, and Samsung Telecommunications America, LLC.

(Ex. 2005 at 3 (highlighting added).) Sprint additionally identified Nokia as “the designers, manufacturers, and/or suppliers” of Sprint’s “Wireless base stations that implement WiMax and LTE” that General Access accused Sprint of infringing:

Sprint further anticipates that a number of additional third parties, including at least the designers, manufacturers, and/or suppliers of technology, products, and/or services identified below, are likely to have discoverable information that Sprint may use to support its defenses in this litigation:

Entity	Subject(s)
Alcatel-Lucent USA Inc. 600-700 Mountain Avenue Murray Hill, NJ 07974	Wireless base stations that implement LTE
Huawei Technologies USA 5700 Tennyson Parkway, Suite 500 Plano, TX 75024	Wireless base stations that implement WiMAX and LTE
Nokia Solutions and Network 6000 Connection Drive Irving, TX 75039	Wireless base stations that implement WiMAX and LTE
Samsung Telecommunication America, LLC 1301 East Lookout Drive Richardson, TX 75082	Wireless base stations that implement WiMAX and LTE
Airspan Networks Inc. 777 Yamato Road Boca Raton, FL 33431	Wireless base stations that implement LTE

(*Id.* at 9 (highlighting added).)

In addition, Sprint has represented that it is indemnified for any infringement of the '931 patent by Nokia:

Based on Sprint's investigation to date and information reasonably available to Sprint at this time, Alcatel-Lucent USA, Inc., Huawei Technologies USA, Nokia Solutions and Network and/or Samsung Telecommunication America, LLC may be required to indemnify Sprint with regarding to the accused products.

(*Id.* at 10 (highlighting added).) Based on this significant relationship, Nokia should be found to be an unidentified real party in interest of privy of the petitioner

(Sprint) in the Sprint IPR, and conversely, Sprint should be found to be a real party in interest or privy of Petitioner here (Nokia).

To the extent that the Board determines that Nokia is not a privy of Sprint, the Board should then consider whether Nokia 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, Nokia clearly has a substantial interest in the outcome of these proceedings. That overlapping interest weighs heavily in favor of discretionary denial.

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

As shown below, both Sprint and Nokia’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 Nokia 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 Nokia knew or should have known of the “new” art at the time of the original petition in the Sprint IPR.

3. 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.

4. 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.

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

Patent Owner’s Preliminary Response will address whether Nokia’s Petition substantively warrants institution. A Petition that does not warrant institution cannot join another proceeding. *Facebook*, 973 F.3d at 1332 (“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).

IV. CONCLUSION

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

Dated: February 16, 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 16, 2024

Respectfully Submitted,

/Sarah E. Spires/

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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 16, 2024 at the following addresses of record:

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