

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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AT&T CORP., AT&T SERVICES, INC., and AT&T MOBILITY LLC,

Petitioners,

v.

ALEXANDER I. SOTO and WALTER G. SOTO,

Patent Owners.

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Case: IPR2024-00712  
U.S. Patent No. 8,238,754

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**MOTION FOR JOINDER TO IPR2023-00960**

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**I. STATEMENT OF PRECISE RELIEF REQUESTED**

Petitioners AT&T Corp., AT&T Services, Inc., and AT&T Mobility LLC (“Petitioners” or “AT&T”) move for joinder of its contemporaneously-filed Petition for *Inter Partes* Review (“IPR”) of claims 1-16 and 18-30 of U.S. Patent No. 8,238,754 (“the ’754 Patent”) with a pending IPR, *Nokia of America Corporation v. Alexander I. Soto and Walter G. Soto*, IPR2023-00960 (“the Nokia IPR”), which the Board instituted on February 23, 2024.

The Nokia IPR concerns the same patent and the same claims as AT&T’s Petition. AT&T’s Petition and supporting expert declaration are substantively identical to the petition and expert declaration submitted in the Nokia IPR. Petitioner here asserts that the same claims are obvious over the same prior art based on the same arguments supported by the same expert as in the Nokia IPR.

Petitioner agrees to take an “understudy” role if joined. Joinder will not cause any delay in the resolution of the Nokia IPR. Joinder, therefore, is appropriate because it will resolve the same patentability issues of the same patent, it will not delay the schedule that the Board has issued in the Nokia IPR, and the parties in the Nokia IPR will not be prejudiced.

## II. STATEMENT OF MATERIAL FACTS

1. Alexander I. Soto and Walter G. Soto (“Patent Owners”) purport to own the ’754 Patent.

2. Patent Owners’s exclusive licensee, NextGen Innovations, LLC, has asserted the ’754 Patent against Petitioners, the Nokia IPR petitioner, and others in lawsuits in the Eastern District of Texas and the Northern District of California: *NextGen Innovations, LLC v. AT&T Services, Inc. et al.*, No. 2:23-cv-00263 (E.D. Tex., filed June 1, 2023); *NextGen Innovations, LLC v. Fujitsu Network Comm’ns., Inc. et al.*, No. 2:22-cv-00307 (E.D. Tex., filed Aug. 9, 2022); *NextGen Innovations, LLC v. Nokia of Am. Corp. et al.*, No. 2:22-cv-00309 (E.D. Tex., filed Aug. 9, 2022); *NextGen Innovations, LLC v. II-VI, Inc. et al.*, No. 4:21-cv-07477 (N.D. Cal., filed Sep. 24, 2021); *NextGen Innovations, LLC v. II-VI, Inc. et al.*, No. 4:20-cv-00854 (E.D. Tex., filed Oct. 30, 2020).

3. On June 30, 2023, Nokia of America Corporation (“Nokia”) filed the Nokia IPR, requesting cancellation of claims 1-16 and 18-30 of the ’754 Patent. IPR2023-00960, Paper 2. On November 27, 2023, Patent Owners filed a Preliminary Response. IPR2023-00960, Paper 14. On January 10, 2024, Nokia filed a Reply to Patent Owner’s Preliminary Response. IPR2023-00960, Paper 15.

4. On February 23, 2024, the Board instituted the Nokia IPR and entered a Scheduling Order. IPR2023-00960, Papers 19 and 21.

5. Along with this Motion for Joinder, Petitioner simultaneously files the Petition, which argues, among other things, that the same claims of the '754 Patent are obvious based on the same grounds and for the same reasons as set forth in the Nokia IPR petition. The Petition is supported by the same expert declaration of Paul R. Prucnal, Ph.D. that was submitted in support of the Nokia IPR petition.

7. The grounds proposed in the Petition are identical to those described in the Nokia IPR petition. *See* Ex. 2038 (redline comparison of AT&T Petition and Nokia Petition). Outside of replacing Nokia with the AT&T Petitioners, and the corresponding updates to the Mandatory Notices (Section X) and Discretionary Issues (Section VIII), the only changes in the present Petition relative to the petition in IPR2023-00960 are to update the description of pending cases in the paragraph spanning pages 9-10. Ex. 2038, 21-22/116. The Petition does not contain any different or additional arguments or evidence in support of the unpatentability of claims 1-16 and 18-30 of the '754 Patent.

### III. STATEMENT OF REASONS FOR RELIEF REQUESTED

#### A. Joinder is timely

This request is being submitted within the time period set forth in 37 C.F.R. § 42.122(b). The one-month period ends on Saturday, March 23, and the Petition and this Motion are therefore timely filed on Friday, March 22.

#### B. The applicable factors support joinder

The Board has discretion to join this IPR with the Nokia IPR. *See* 35 U.S.C. § 315(c); 37 C.F.R. § 42.122(b); *HTC v. Parthenon Unified Memory Architecture LLC*, IPR2017-00512, Paper 12 at 6 (PTAB June 1, 2017). In considering a motion for joinder, the Board considers the following factors: (1) the reasons why joinder is appropriate; (2) whether the petition raises any new grounds of unpatentability; (3) any impact joinder would have on the cost and trial schedule for the existing review; and (4) whether joinder will add to the complexity of briefing or discovery. *Kyocera Corp. v. Softview LLC*, IPR2013-00004, Paper 15 at 4 (PTAB Apr. 24, 2013); Consolidated Trial Practice Guide 76 (Nov. 2019), <https://go.usa.gov/xpvPF>. These factors weigh in favor of joinder. As a result, the Board should exercise its discretion to allow joinder here.

##### ***1. Joinder is appropriate because Petitioner proposes no new grounds of unpatentability (factors 1 and 2)***

The Board “routinely grants motions for joinder where the party seeking joinder introduces identical arguments and the same grounds raised in the existing

proceeding.” *Samsung Elecs. Co. v. Raytheon Co.*, IPR2016-00962, Paper 12 at 9 (PTAB Aug. 24, 2016) (internal quotations and citations omitted) (emphasis original). Joinder is appropriate here because the Petition asserts the same grounds and relies on the same evidence for unpatentability presented in the Nokia IPR. Specifically, the Petition and the Nokia IPR petition rely on the same grounds. Moreover, the Petition and the Nokia IPR petition rely on the same declaration of Paul R. Prucnal, Ph.D. The arguments in both petitions are identical; there are no new arguments or grounds of unpatentability asserted in the Petition.

As the same issues will be addressed in both proceedings, joinder makes sense. *See, e.g., HTC*, IPR2017-00512, Paper 12 at 7 (granting motion for joinder where the second petition involved “the same claims, the same patent, the same prior art references, the same expert declaration, and the same arguments and rationales”); *STMicroelectronics, Inc. v. Lone Star Silicon Innovations, LLC*, IPR2018-00436, Paper 7 at 5 (PTAB May 4, 2018) (similar).

**2. *Joinder will not impact the trial schedule or cost of the joined proceeding (factor 3)***

Joinder will not prejudice the parties to the Nokia IPR. Unless the Nokia IPR is settled at a time that would necessitate adjustments, Petitioner will not request any alterations to the trial schedule that the Board issued in the Nokia IPR (IPR2023-00960, Paper 21), leaving that schedule unchanged.

Petitioner also agrees to adopt a secondary, “understudy” role in the Nokia IPR, if joined. *See, e.g., Garmin Int’l, Inc. v. Philips North Am. LLC*, IPR2020-00910, Paper 8 at 45, 47-50 (PTAB Nov. 19, 2020) (granting joinder where petitioners agreed to accept an “understudy” role); *STMicroelectronics*, IPR2018-00436, Paper 7 at 5 (similar). Petitioner will assume a primary role only if the Nokia IPR petitioner ceases its participation in that proceeding. Petitioner’s agreement to take an “understudy” role removes any potential complication or delay caused by joinder, while providing the parties an opportunity to address all issues that may arise. *See, e.g., Mylan Pharms. Inc. v. Novartis AG*, IPR2014-00550, Paper 38 at 5-6 (PTAB Apr. 10, 2015). Counsel for the Nokia IPR petitioner indicated that the Nokia IPR petitioner will not oppose this motion. Counsel for Patent Owners indicated that Patent Owners will review any difference between the AT&T Petition and the Nokia IPR petition and consider that and other factors before taking a position on the motion itself. However, because the AT&T Petitioners will be in the understudy role, joinder will not affect the cost of the Nokia IPR for Patent Owners, the Nokia IPR petitioner, or the Board.

**3. *Joinder will not complicate briefing and discovery (factor 4)***

This factor favors joinder. If joinder is granted, Petitioner agrees to take on an understudy role. Accordingly, joinder will not affect briefing and discovery. Those activities will proceed in the same way with or without joinder. In either

case, the Nokia IPR petitioner will file briefing and conduct discovery, and Petitioner will not be involved. Petitioner will take an active role only if the Nokia IPR petitioner exits the proceeding.

#### IV. CONCLUSION

For the foregoing reasons, Petitioners AT&T Corp., AT&T Services, Inc., and AT&T Mobility LLC respectfully ask the Board to institute their Petition for *Inter Partes* Review of U.S. Patent No. 8,238,754 and join this proceeding with *Nokia of America Corporation v. Alexander I. Soto and Walter G. Soto*, IPR2023-00960.

Date: March 22, 2024

Respectfully submitted,

/Eagle H. Robinson/  
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*Lead Counsel for Petitioner*

**CERTIFICATE OF SERVICE**

The undersigned hereby certifies that a true and correct copy of this MOTION FOR JOINDER TO IPR2023-00960 has been served via email to counsel for the parties in IPR2023-00960, and to litigation counsel for Patent Owner's exclusive licensee NextGen Innovations, LLC:

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Date: March 22, 2024

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