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Paper 58
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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ERICSSON INC. and TELEFONAKTIEBOLAGET LM ERICSSON,
Petitioner,

v.

REGENTS OF THE UNIVERSITY OF MINNESOTA,
Patent Owner.

IPR2017-01200
Patent 8,718,185 B2

Before JENNIFER S. BISK, ROBERT J. WEINSCHENK, and
CHARLES J. BOUDREAU, *Administrative Patent Judges*.

BISK, *Administrative Patent Judge*.

DECISION
Denying Institution of *Inter Partes* Review
35 U.S.C. § 314

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I. INTRODUCTION

A. Background and Summary

Ericsson Inc. and Telefonaktiebolaget LM Ericsson (“Petitioner”) filed a Petition (Paper 1, “Pet.”) requesting an *inter partes* review of claims 1, 6, 9, 10, 15, 18, 24, and 25 (“the challenged claims”) of U.S. Patent No. 8,718,185 B2 (Ex. 1001, “the ’185 patent”). Regents of the University of Minnesota (“Patent Owner”) filed a Motion to Dismiss on the basis that it is entitled to sovereign immunity as an arm of the State of Minnesota. Paper 10. We denied Patent Owner’s Motion to Dismiss. Paper 16. Patent Owner appealed to the Court of Appeals for the Federal Circuit, and we stayed this proceeding pending the outcome of that appeal. Papers 23, 24. The Federal Circuit affirmed our Decision denying the Motion to Dismiss. Paper 25. Patent Owner then filed a Preliminary Response (Paper 31, “Prelim. Resp.”), and, with our authorization, Petitioner filed a Reply (Paper 48, “Reply”), and Patent Owner filed a Sur-reply (Paper 43, “Sur-reply”).¹

An *inter partes* review “may not be instituted if the petition requesting the proceeding is filed more than 1 year after the date on which the petitioner, real party in interest, or privy of the petitioner is served with a complaint alleging infringement of the patent.” 35 U.S.C. § 315(b). For the reasons discussed below, the evidence of record shows that the Petition was filed more than one year after the date on which a privy of Petitioner was served with a complaint alleging infringement of the ’185 patent. Therefore, the Petition is denied, and no trial is instituted.

¹ We cite to non-public versions of the Preliminary Response and Sur-reply, but Patent Owner also filed public versions. Papers 51, 53.

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B. Related Matters

The parties indicate that the '185 patent is involved in the following district court cases: 1) *Regents of the University of Minnesota v. AT&T Mobility LLC*, No. 0-14- cv-04666 (D. Minn.); 2) *Regents of the University of Minnesota v. Sprint Solutions, Inc.*, No. 0-14-cv-04669 (D. Minn.); 3) *Regents of the University of Minnesota v. T-Mobile USA, Inc.*, No. 0-14-cv-04671 (D. Minn.); and 4) *Regents of the University of Minnesota v. Cellco Partnership*, No. 0-14-cv-04672 (D. Minn.). Pet. 3; Paper 5, 1. We refer to these district court cases collectively as the District Court Litigation, and we refer to the defendants in those cases collectively as the District Court Defendants.

In addition to the Petition in the present proceeding, Petitioner also filed petitions for *inter partes* review of the other patents asserted in the District Court Litigation. IPR2017-01186, Paper 1; IPR2017-01197, Paper 1; IPR2017-01213, Paper 1; IPR2017-01214, Paper 2; IPR2017-01219, Paper 1.

II. ANALYSIS

Patent Owner served the District Court Defendants with complaints alleging infringement of the '185 patent on November 6, 2014. Ex. 2005, 1; Ex. 2007, 1; Ex. 2009, 1; Ex 2011, 1. Petitioner filed the Petition in this case more than one year later on March 30, 2017. Paper 3, 1. Patent Owner asserts that the Petition is barred under § 315(b) because the District Court

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Defendants are privies of Petitioner.² Prelim. Resp. 14–29. Petitioner contends that it is not in privity with the District Court Defendants, and, thus, that the Petition is timely. Pet. 5–8; Reply 4–12. For the reasons discussed below, we agree with Patent Owner that the Petition is barred under § 315(b).

A. *Legal Principles*

As stated above, § 315(b) provides that an *inter partes* review “may not be instituted if the petition requesting the proceeding is filed more than 1 year after the date on which the petitioner, real party in interest, or privy of the petitioner is served with a complaint alleging infringement of the patent.” Whether a petitioner is in privity with another party “is a highly fact-dependent question.” Office Patent Trial Practice Guide, 77 Fed. Reg. 48,756, 48,759 (Aug. 14, 2012) (“TPG”). Our “analysis seeks to determine whether the relationship between the purported ‘privy’ and the relevant other party is sufficiently close such that both should be bound by the trial outcome and related estoppels.” *Id.*

In *Taylor v. Sturgell*, 553 U.S. 880, 893 (2008), the Supreme Court explained that “the rule against nonparty preclusion is subject to exceptions” that “can be grouped into six categories.” Specifically, nonparty preclusion may be found 1) when “[a] person . . . agrees to be bound by the determination of issues in an action between others”; 2) “based on a variety

² Patent Owner asserts that the District Court Defendants also are real parties in interest. Prelim. Resp. 29–31. Because we determine that the District Court Defendants are privies of Petitioner, we need not decide whether they also are real parties in interest.

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of pre-existing ‘substantive legal relationship[s]’ between the person to be bound and a party to the judgment”; 3) when “a nonparty . . . was ‘adequately represented by someone with the same interests who [wa]s a party’”; 4) when “a nonparty . . . ‘assume[d] control’ over the litigation in which [the] judgment was rendered”; 5) when a nonparty acts as “a proxy” to relitigate for a party; and 6) when “a special statutory scheme may ‘expressly foreclos[e] successive litigation by nonlitigants.’” *Id.* at 893–95. The Supreme Court noted, though, that this list of six categories is just “a framework,” not “a definitive taxonomy.” *Id.* at 893 n.6.

B. Relevant Facts

Petitioner supplies wireless broadband base stations to the District Court Defendants. Ex. 2026, 1; Ex. 2027, 1; Ex. 2028, 1; Ex. 2029, 2. Petitioner acknowledges that it provides its base stations to the District Court Defendants pursuant to supply agreements that “contain[] detailed indemnification provisions.” Ex. 2031, 1; Ex. 2032, 1; Ex. 2033, 1; Ex. 2034, 1; *see* Ex. 2012, 9, 16; Ex. 2013, 14–15; Ex. 2014, 11; Ex. 2015, 14–15.³ Specifically, according to Petitioner, the supply agreements require it to indemnify the District Court Defendants for “patent infringement claims arising out of” the District Court Defendants’ “use of” Petitioner’s base stations. Ex. 2031, 1; Ex. 2032, 1; Ex. 2033, 1; Ex. 2034, 1; *see* Ex. 2012, 16; Ex. 2013, 14–15; Ex. 2014, 11; Ex. 2015, 14–15.

³ Patent Owner filed non-public and public versions of Exhibits 2012–2015 under the same exhibit numbers but incorrectly labeled the public version of Exhibit 2015 as “UMN 2014” in the document footer.

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