IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ERICSSON INC.
("Ericsson"),

Petitioner,

v.

UNILOC 2017 LLC
("Uniloc"),

Patent Owner.

Case No. IPR2020-00315
U.S. Patent No. 7,075,917

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

Ericsson hereby affirms and clarifies its role as an "understudy" and continues to respectfully request that the Board grant its Motion for Joinder.

A few days before Uniloc's deadline to oppose Ericsson's Motion for Joinder, a panel in another proceeding involving Ericsson and Uniloc *sua sponte* requested "clarification" as to Ericsson's role as an "understudy" in Ericsson's Motion for Joinder in that proceeding. *See* IPR2020-00376, Paper 8 (PTAB Jan. 21, 2020). Uniloc shortly thereafter filed its opposition to Ericsson's Motion for Joinder here, paralleling the Board's requested clarification to Ericsson's "understudy" role.

The ambiguities alleged regarding Ericsson's "understudy" role are the *only* basis on which Uniloc has opposed Ericsson's joinder motion in this case. Uniloc has not argued that joinder would negatively impact the timing of the existing trial schedule in the Microsoft IPR, nor has Uniloc argued that joinder would risk the possibility of Patent Owner having to address new issues. Those concerns are the primary focus of the joinder analysis yet are not at issue here.

Finally, Uniloc incorrectly states that "[t]he '917 has not and is presently not the subject of any district court litigation." Opp'n at 1. As Ericsson's Motion explained, Uniloc has accused various parties in separate lawsuits of infringing the '917 Patent, including an Ericsson customer (Ericsson has intervened in that lawsuit) and Microsoft in pending lawsuits.

I. The Board has granted joinder based on conditions similar to Ericsson's originally proposed conditions on its "understudy" role.

Ericsson's originally proposed conditions on its role as an "understudy" mimicked prior Board cases in which the Board has granted joinder with a party acting in an "understudy" capacity. For example, in *Blackberry Corp. v. Uniloc 2017 LLC*, the Board granted joinder over Uniloc's opposition where the petitioner proposed the same conditions on its understudy role. IPR2019-01283, Paper 10 at 6-9 (PTAB Nov. 5, 2019); *see also id.*, Paper 3 at 8-9 (Joinder Mot.) (proposing the same conditions); *see also Apple Inc. v. INVT SPE LLC*, IPR2019-00958, Paper 9 at 6–8 (PTAB May 30, 2019). Thus, Ericsson was not attempting to engage in gamesmanship. Nevertheless, Ericsson clarifies its role as an understudy consistent with the conditions presented in IPR2020-00376, Paper 9.

II. Ericsson further clarified its role as an "understudy" in IPR2020-00376, and Ericsson agrees to those conditions in this case.

Uniloc's opposition focuses on alleged ambiguities in the understudy limitations proposed by Ericsson, namely, Ericsson's role in substantive filings and depositions; and in any appeal to the Federal Circuit. Ericsson's potential role in filings and depositions, as well as discovery and oral hearing, are clarified below. Any potential appeal to the Federal Circuit is also addressed.

To clarify the "understudy" role, Ericsson agrees to the following conditions regarding the joined proceeding, which are the same as those set forth by Ericsson in IPR2020-00376, Paper 9.

So long as Microsoft remains an active party in the joined proceeding:

1. Ericsson will not be making any substantive filings, and Ericsson agrees that Microsoft alone will be responsible for all substantive petitioner filings in the joined proceeding;
2. Ericsson agrees to be bound by all filings by Microsoft in the joined proceeding, except for filings regarding termination and settlement;
3. Ericsson must obtain prior Board authorization to file any paper or to take any action on its own in the joined proceeding;
4. Ericsson shall not be permitted to raise any new grounds not already instituted by the Board in the Microsoft IPR, or introduce any argument or discovery not already introduced by Microsoft;
5. Ericsson shall be bound by any agreement between Patent Owner and Microsoft concerning discovery and/or depositions;
6. Ericsson will not cross examine or defend any witness at deposition;
7. Microsoft will be responsible for any oral hearing presentation, including the preparation of demonstrative exhibits.

Only if Microsoft ceases participation in the proceeding:

8. Ericsson would assume a primary role, meaning it would take over the role previously filled by Microsoft.

Uniloc has expressed concern regarding whether Ericsson could nevertheless "participate" in a substantive filing by Microsoft. Opp'n at 3. It is unclear whether Uniloc seeks to prohibit communication with Microsoft, which would be unreasonable. Regardless, the provisions above make it clear that Microsoft is in total control of any substantive filing, deposition and oral hearing, and Microsoft has not expressed any desire for input from Ericsson.

Uniloc's final concern is that Ericsson may "seek to file its own appeal briefing, separate and apart from Microsoft" in any appeal to the Federal Circuit. Opp'n at 5. Uniloc's focus on the procedure of a different tribunal is not only irrelevant to the joinder analysis, but, more importantly, its implication that Ericsson should stipulate to no appeal briefing is also unreasonable. It is unreasonable because Ericsson is not aware of any mechanism in the Federal Circuit that would allow a party to take a similar "understudy" role in any appeal as a matter of right, and Uniloc has not cited to any.

For Ericsson to participate in a Federal Circuit appeal, Ericsson needs to file or join briefing. For example, if Microsoft and Ericsson were to file notices of

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