

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE PATENT TRIAL AND APPEAL BOARD

---

**AT&T CORP., AT&T COMMUNICATIONS LLC, AT&T MOBILITY LLC,  
AT&T MOBILITY II LLC, AND AT&T SERVICES INC.**

Petitioners,

v.

**DALI WIRELESS, INC.**

Patent Owner.

---

Case IPR2023-00646  
Patent No. 8,682,338

---

**PETITIONERS' MOTION FOR JOINDER  
UNDER 35 U.S.C. § 315(c), 37 C.F.R. §§ 42.22, and 42.122(b)**

## Table of Contents

<b>I.</b>	<b>STATEMENT OF PRECISE RELIEF REQUESTED .....</b>	<b>1</b>
<b>II.</b>	<b>BACKGROUND AND RELATED PROCEEDINGS .....</b>	<b>3</b>
<b>III.</b>	<b>STATEMENT OF REASONS FOR RELIEF REQUESTED .....</b>	<b>3</b>
<b>A.</b>	<b>Legal Standard .....</b>	<b>3</b>
<b>B.</b>	<b>AT&amp;T's Motion for Joinder is Timely .....</b>	<b>4</b>
<b>C.</b>	<b>The <i>Kyocera</i> Factors Favor Joinder .....</b>	<b>4</b>
<b>1.</b>	<b>Factor 1: Joinder is appropriate.....</b>	<b>4</b>
<b>2.</b>	<b>Factor 2: The AT&amp;T Petition proposes no new grounds of unpatentability .....</b>	<b>7</b>
<b>3.</b>	<b>Factor 3: Joinder will not unduly burden or negatively impact the Ericsson IPR.....</b>	<b>8</b>
<b>IV.</b>	<b>CONCLUSION .....</b>	<b>11</b>

## **I. STATEMENT OF PRECISE RELIEF REQUESTED**

Petitioners AT&T Corp., AT&T Communications LLC, AT&T Mobility LLC, and AT&T Mobility II LLC, and AT&T Services Inc. (“AT&T”) respectfully submit this Motion for Joinder together with a Petition for *Inter Partes* Review of U.S. Patent No. 8,682,338 (the “AT&T Petition”). On July 22, 2022, Ericsson Inc. (“Ericsson”) filed a Petition for *Inter Partes* Review of U.S. Patent No. 8,682,338 (the “’338 Patent”) in *Ericsson Inc. v. Dali Wireless, Inc.*, IPR2022-01212 (the “Ericsson IPR”). The Board instituted trial for the Ericsson IPR in a Decision dated February 1, 2023. AT&T requests *inter partes* review and joinder with the Ericsson IPR pursuant to 35 U.S.C. § 315(c) and 37 C.F.R. § 42.122(b). Joinder is appropriate because the AT&T Petition is substantively identical to the petition in the Ericsson IPR; the AT&T Petition challenges the same claims of the ’338 Patent on the same grounds and relies on the same prior art, arguments, and evidence, including a declaration from the same expert (i.e., the AT&T Petition is a “copycat” petition). Joinder is also appropriate because AT&T’s request is only for the opportunity to join with the Ericsson IPR as an “understudy” to Ericsson, and as such AT&T would only assume an active role in the event that Ericsson settles with Patent Owner.

In making this request, AT&T seeks to maximize efficiency in two ways. First, by requesting joinder rather than pursuing another independent patentability

review by the Office (*e.g.*, *ex parte* reexamination), AT&T seeks to reduce the number of parallel challenges to the '338 Patent pending before the Office.

Second, AT&T seeks to represent the public interest in having the Office review claims of the '338 Patent that Patent Owner has suggested are widely used within the industry. *See* IPR2022-00182, Paper 9 at 1-2 & Paper 11 at 18; EX1103, 1625:2-1626:16; *see also General Plastic Indus. Co. v. Cannon Kabushiki Kaisha*, IPR2016-01357, Paper 19 at 16 (PTAB Sept. 6, 2017) (precedential) (“In exercising discretion...we are mindful of the goals of the AIA— namely, to improve patent quality and make the patent system more efficient by the use of post-grant review procedures.”); *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 at 6 (PTAB Mar. 20, 2020) (precedential) (“the Board takes a holistic view of whether efficiency and integrity of the system are best served by denying or instituting review”).

AT&T’s request for joinder is timely because it is filed no later than one month after the institution date of the Ericsson IPR. If joinder is granted, AT&T will take an “understudy role” so long as Ericsson participates in the Ericsson IPR. Accordingly, joinder will not unduly burden or prejudice the parties to the Ericsson IPR and will provide for a just, speedy, and inexpensive determination of related proceedings.

Counsel for AT&T has conferred with counsel for Ericsson and confirmed that Ericsson does not oppose joinder.

## **II. BACKGROUND AND RELATED PROCEEDINGS**

1. On January 7, 2022 Patent Owner filed a complaint asserting infringement of the '338 Patent against multiple parties including AT&T and Ericsson. *See* Petition VIII.B.1

2. On July 22, 2022, Ericsson filed a Petition for *Inter Partes* Review challenging Claims 1-12 of the '338 Patent. *See Ericsson Inc. v. Dali Wireless, Inc.* IPR2022-01212, Paper 2, (PTAB Jul. 22, 2022) On August 8, 2022, Ericsson filed a corrected Petition (the “Ericsson Petition”). *See Ericsson Inc. v. Dali Wireless, Inc.* IPR2022-01212, Paper 6, (PTAB Aug. 8, 2022)

3. On February 1, 2023, the Board instituted trial for the Ericsson IPR. *See Ericsson Inc. v. Dali Wireless, Inc.* IPR2022-01212, Paper 17, (PTAB Feb. 1, 2023)

## **III. STATEMENT OF REASONS FOR RELIEF REQUESTED**

AT&T's motion for joinder should be granted because the motion is timely, and the *Kyocera* factors favor joinder.

### **A. Legal Standard**

The Board may join as a party to an instituted *inter partes* review a person who has properly filed a petition for *inter partes* review that warrants institution.

35 U.S.C. § 315(c). Any request for joinder must be filed “no later than one month after the institution date of any *inter partes* review for which joinder is requested.”

37 C.F.R. § 42.122(b). A petition for *inter partes* review is not subject to the one-year statutory time bar if the petition is accompanied by a request for joinder. 35 U.S.C. § 315(b); 37 C.F.R. § 42.122(b).

“A motion for joinder should: set forth the reasons joinder is appropriate; identify any new grounds of unpatentability asserted in the petition; and explain what impact (if any) joinder would have on the trial schedule for the existing review.” *Hyundai Motor Am. V. Stratosaudio, Inc.*, IPR2022-00224, Paper 11 at 7 (PTAB Jun. 2, 2022) (citing *Kyocera Corp. v. Softview LLC*, IPR2013-00004, Paper 15 at 4 (PTAB Apr. 24, 2013)).

**B. AT&T’s Motion for Joinder is Timely**

AT&T’s Motion for Joinder is timely because it is being filed no later than one month from the date of the decision instituting trial in the Ericsson IPR issued by the Board on February 1, 2023. See 37 C.F.R § 42.122(b).

**C. The *Kyocera* Factors Favor Joinder**

**1. Factor 1: Joinder is appropriate**

Joinder with the Ericsson IPR is appropriate because the AT&T Petition involves the same patent, challenges the same claims, and is based on the same grounds and evidence, including a declaration from the same expert, relied upon in

the Ericsson Petition. In short, the AT&T Petition is substantively identical to the Ericsson Petition with respect to the prior art challenges. Only minor changes were necessary to properly identify the filing party and to update the analysis of discretionary denial. As such, the AT&T Petition does “not present new issues that might complicate or delay” the existing Ericsson IPR. *See Enzymotec Ltd. v. Neptune Techs & Bioresources, Inc.*, IPR2014-00556, Paper 19 at 6 (July 9, 2014) (“we are mindful of a policy preference for joining a party that does not present new issues that might complicate or delay an existing proceeding”).

Nor does joinder present a risk of duplicative efforts between the PTAB and the district court litigation between Patent Owner and AT&T. Nor will there be any duplication, even if the district court case is subsequently tried as AT&T makes a *Sotera*-style stipulation not to pursue, in any further proceedings at the district court, any ground that was raised or could have been reasonably raised in an IPR. *See* Petition at VII.B.

Joinder of this proceeding with the Ericsson IPR, and allowing AT&T to assume an understudy role to Ericsson, does not unduly burden or negatively impact the trial schedule in the Ericsson IPR in any meaningful way. Patent Owner will not be required to provide any additional analysis or arguments beyond what it has, and will already provide in responding to the Ericsson Petition.

Joinder, and allowing AT&T to assume an understudy role to Ericsson, will also have little, if any, impact on the Ericsson IPR because no new grounds will be added, the schedule will not be affected, no additional briefing or discovery will be required, and no additional burdens will be placed on Patent Owner.

Additionally, as noted above, AT&T is currently involved in litigation based on Patent Owner's allegation that AT&T's products infringe claims of the '338 Patent. AT&T therefore has a particular interest in the substantial questions of patentability surrounding the claims challenged in the '338 Patent. Joinder is appropriate for the additional reason that the grounds for unpatentability as to the challenged claims can be resolved through AT&T's limited "understudy" role in the IPR process as long as Ericsson remains in the joined IPR, and through AT&T's assumption of an active role in the event that Ericsson reaches a settlement with Patent Owner or otherwise ceases being an active party in the Ericsson IPR.

Patent Owner has alleged other industry participants infringe the '338 Patent (besides its accusations to date against AT&T) (*see* Petition VIII. B. 1. "Judicial Matters"), and thus there is substantial public interest in "permitting full and free competition in the use of ideas which are in reality a part of the public domain." *Lear, Inc. v. Adkins*, 395 U.S. 653, 670 (1969). That public interest in having the challenged claims of the '338 Patent reviewed for unpatentability favors allowing



joinder in this case, as joinder would allow AT&T to assume an active role in the IPR process, from its otherwise limited “understudy” role, if Ericsson ceases being an active party to the IPR. As AT&T has been accused of infringing the ’338 Patent, AT&T is well positioned to assume the representation of the public interest from Ericsson if such a circumstance should arise.

Accordingly, joinder is appropriate because it avoids the possibility of duplicate efforts, supports the just, speedy, and inexpensive review of the challenged claims in the ’338 Patent by the Office, and promotes the public interest in remedying the unjustified taking of public domain ideas for one party’s exclusive control.

**2. Factor 2: The AT&T Petition proposes no new grounds of unpatentability**

The AT&T Petition does not present any new grounds or arguments regarding unpatentability. It is substantively identical to the Ericsson Petition in that regard. The Board “routinely grants motions for joinder where the party seeking joinder introduces identical arguments and the same grounds raised in the existing proceeding.” *BlackBerry Corp. v. Uniloc 2017 LLC*, IPR2019-01283, Paper 10 at 8 (PTAB Nov. 5, 2019) (quoting *Samsung*, IPR2016-00962, Paper 12 at 9) (emphasis added). This factor therefore favors joinder.

**3. Factor 3: Joinder will not unduly burden or negatively impact the Ericsson IPR**

Joinder will not unduly burden Patent Owner. Because the AT&T Petition presents the same grounds and arguments as the Ericsson Petition, and because AT&T agrees to assume an “understudy” role unless Ericsson ceases to be a party to the IPR, there are no new issues for Patent Owner to address. *See Sony Corp. v. Memory Integrity, LLC*, IPR2015-01353, Paper 11 at 6 (PTAB Oct. 15, 2015) (granting motion for joinder and instituting IPR where “joinder should not necessitate any additional briefing or discovery from Patent Owner beyond that already required in [the original IPR]”).

Likewise, joinder will not negatively impact the trial schedule of the Ericsson IPR. AT&T expressly consents to the trial schedule issued in the Ericsson IPR. AT&T also agrees to take an “understudy” role in the joined proceeding, so long as Ericsson remains an active party in the joined proceeding. *See, e.g., Apple Inc. v. INVT SPE LLC*, IPR2019-00958, Paper 9 at 5-8 (PTAB May 30, 2019) (granting motion for joinder where the movant presented a substantively identical petition and agreed to take an “understudy” role in the joined proceeding); *Intel Corp. v. Alacritech, Inc.*, IPR2018-01352, Paper 11 at 3–5 (PTAB Jan. 8, 2019) (same). To be clear, AT&T only contemplates assuming the role of primary petitioner in the instituted Ericsson IPR if (i) Ericsson is terminated as a party to

the proceeding, or (ii) Ericsson ceases participating in the proceeding such that the proceeding is no longer “meaningfully adversarial,” contrary to the public interest. *See ZTE (USA), Inc. v. CyWee Group Ltd.*, IPR2019-00143, Paper 50 at 7-9 (PTAB Jul. 17, 2020) (allowing a joinder petitioner to assume the role of primary petitioner with respect to a motion to amend because the “trial no longer appears to be meaningfully adversarial” given the primary petitioner’s decision not to oppose revised amended claims).

As an understudy in the Ericsson IPR, AT&T agrees to the following conditions regarding the joined proceeding, so long as Ericsson remains an active party in the joined proceeding:

- AT&T’s positions and interests in the joined proceeding will be represented by the filings of Ericsson unless a filing solely concerns issues that do not involve Ericsson;<sup>1</sup>
- AT&T shall not be permitted to raise any new grounds not already instituted by the Board in the Ericsson IPR, or introduce any argument or discovery not already introduced by Ericsson;

---

<sup>1</sup> Circumstances may require AT&T to request and file separate papers with respect to Ericsson’s individual status as petitioner in the proceeding—*e.g.*, a motion to terminate.

- AT&T shall be bound by any agreement between Patent Owner and Ericsson concerning discovery and/or depositions in the Ericsson IPR;
- At deposition, AT&T shall not receive any direct examination, cross-examination, or redirect time beyond that permitted in this proceeding for Ericsson under either 37 C.F.R. § 42.53 or any agreement between Patent Owner and Ericsson.

*See Apple*, IPR2019-00958, Paper 9 at 7–8 (granting a motion for joinder where the movant proposed the above limitations on its role as understudy); *see also Intel Corp.*, IPR2018-01352, Paper 11 at 4–5 (granting a motion for joinder with such limitations on the understudy).

Additionally, with respect to any oral hearing, Ericsson will be responsible for the presentation before the Board. AT&T, when in the understudy role, will not request any additional time to independently argue before the Board or attempt to submit its own demonstratives.<sup>2</sup>

Accordingly, if joinder is granted, briefing and discovery in the joined proceeding will be no more complex than if AT&T had never been joined.

---

<sup>2</sup> While AT&T will not materially participate in calls with the Board, depositions, and any oral hearing, AT&T anticipates that its counsel will attend such events.

Consolidated briefing and discovery will ensure a simplified and efficient joined proceeding.

#### **IV. CONCLUSION**

For the reasons above, AT&T respectfully requests that the Board (i) institute AT&T's concurrently filed Petition for *Inter Partes* Review of U.S. Patent No. 8,682,338; and (ii) grant joinder.

Respectfully submitted,

Dated: March 1, 2023

s/Patrick C. Muldoon/  
\_\_\_\_\_  
Patrick Craig Muldoon  
USPTO Reg. No. 47,343  
Duane Morris LLP  
901 New York Ave NW Suite 700  
East  
Washington, D.C. 20001  
pcmuldoon@duanemorris.com

**CERTIFICATION OF SERVICE**

I certify that on March 1, 2023, I caused a true and correct copy of the forgoing Motion for Joinder to be sent via overnight delivery on the PO at the following correspondence address of record as listed on PAIR.:

Artegis Law Group, LLP

John Carey  
7710 Cherry Park Drive Suite T #104  
Houston TX 77095

A courtesy copy was also sent via electronic mail to Patent Owner's counsel listed below.

[david.schumann@foliolaw.com](mailto:david.schumann@foliolaw.com)  
[palani@foliolaw.com](mailto:palani@foliolaw.com)  
[moses.xie@foliolaw.com](mailto:moses.xie@foliolaw.com)  
[timothy.dewberry@foliolaw.com](mailto:timothy.dewberry@foliolaw.com)  
[cliff.win@foliolaw.com](mailto:cliff.win@foliolaw.com)

s/Patrick Craig Muldoon/  
Patrick Craig Muldoon  
USPTO Reg. No. 47,343  
Duane Morris LLP  
901 New York Ave NW Suite 700 East  
Washington, D.C. 20001  
[pcmuldoon@duanemorris.com](mailto:pcmuldoon@duanemorris.com)

*ATTORNEY FOR PETITIONER*