

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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CRADLEPOINT, INC., DELL INC., HONEYWELL INTERNATIONAL, INC.,  
SIERRA WIRELESS, INC., TCL COMMUNICATION TECHNOLOGY  
HOLDINGS LIMITED, TCT MOBILE INTERNATIONAL LIMITED, TCT  
MOBILE, INC., TCT MOBILE (US) INC., TCT MOBILE (US)  
HOLDINGS INC., THALES DIS AIS DEUTSCHLAND GMBH,  
ZTE CORPORATION, AND ZTE (USA) INC.

Petitioner,

v.

3G LICENSING S.A.

Patent Owner.

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IPR2021-00639  
Patent 8,189,611 B2

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Before JAMESON LEE and MONICA S. ULLAGADDI,  
*Administrative Patent Judges.*

LEE, *Administrative Patent Judge.*

ORDER  
Conduct of Proceedings  
*37 C.F.R. § 42.05*

### Introduction

On March 18, 2021, Petitioner filed a petition for *inter partes* review of Patent 8,189,611 B2. Paper 8. Petitioner includes twelve different sub-entities, as noted in the caption of this case above. The Petition divides these twelve sub-entities into seven groups and, for each group, designates lead and backup counsel. Paper 8, 2–5. Each group has a designated lead counsel who is different from the designated lead counsel of all the other groups. *Id.*

### Discussion

According to 37 C.F.R. § 42.2, “Petitioner” means “the party filing a petition requesting that a trial be instituted.” By referring to “the party filing a petition,” 37 C.F.R. § 42.2 identifies “Petitioner” as a single party. Thus, in circumstances not involving a motion for joinder or consolidation of separate proceedings, for each “petition” there is but a single party filing the petition, no matter how many companies are listed as petitioner or petitioners and how many companies are identified as real parties-in-interest. *Agilysis, Inc. v. Ameranth, Inc.*, CBM2014-00014, Paper 11 at 3 (PTAB Feb. 11, 2014); *see also 505 Games, Inc. v. Babbage Holdings, Inc.*, IPR2014-00954, Paper 17 at 2 (PTAB Aug. 22, 2014). Even though the separate sub-entities regard and identify themselves as “Petitioners,” before the Board they constitute and stand in the shoes of a single “Petitioner.” *Agilysis Inc.*, CBM2014-00014, Paper 11 at 3.

Because the twelve sub-entities constitute, collectively, a single party, they must speak with a single voice, in both written and oral representation. They may not take different actions in the proceeding, even if they may individually negotiate

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with Patent Owner regarding settlement. This initial separate designations of lead counsel for sub-entities of Petitioner treat the sub-entities as multiple parties. That is not only contrary to 37 C.F.R. § 42.2, but also prejudicial to Patent Owner, who potentially would have to respond to seven different, possibly inconsistent, positions on every issue. *See Agilysis Inc.*, CBM2014-00014, Paper 11 at 3–4. Nor would the Board’s interests in the speedy and efficient resolution of post-grant proceedings be served by permitting the presentation of inconsistent positions based on the filing of a single petition. *Id.*

Order

It is

ORDERED that within one week of the day of this communication, Petitioner shall file a paper to re-designate lead counsel in accordance with 37 C.F.R. § 42.10(a) by regarding itself as a single party, and provide updated service information in light of the re-designation of lead counsel; and

FURTHER ORDERED that all papers filed on behalf of “Petitioner” binds each sub-entity within the “Petitioner” designation, except for papers regarding settlement of a sub-entity with Patent Owner.

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