

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ARRIS GROUP, INC.
Petitioner

v.

C-CATION TECHNOLOGIES, LLC
Patent Owner

Case: IPR2015-00635

**PETITIONER'S OPPOSITION TO PATENT OWNER'S MOTION FOR
ADDITIONAL DISCOVERY**

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Patent Trial and Appeal Board
United States Patent and Trademark Office
PO Box 1450
Alexandria, Virginia 22313-1450
Submitted Electronically via the Patent Review Processing System

I. PRELIMINARY STATEMENT

Patent Owner seeks discovery for the sole purpose of relitigating an issue that was subsumed by a judgment and final written decision against Patent Owner in IPR2014-00746. This Board's rules as well as the principles of administrative *res judicata* preclude Patent Owner from raising the very same privity arguments it already had the opportunity to litigate. Despite knowing Petitioner's position on this issue in opposing the requested discovery, Patent Owner never squarely addresses it. Instead, Patent Owner elects to rely on a decision from an interference relating to issue preclusion—not *res judicata*—and never explains how its privity arguments are not foreclosed by Rule 42.73(a).

Taking additional discovery on a matter that cannot be raised in this proceeding in light of the unequivocal language of 37 C.F.R. § 42.73(a) and the common law doctrine of administrative *res judicata* cannot be in the "interests of justice." As such, Patent Owner's motion for additional discovery should be denied in its entirety.

II. FACTUAL BACKGROUND

After Petitioner requested *Inter Partes* Review of the '883 Patent in an earlier proceeding, Patent Owner raised the very same privity argument it wants to

raise here: that an earlier suit against non-party Comcast¹ bars Petitioner from requesting *Inter Partes* Review under § 315(b). See Patent Owner Prelim. Resp., IPR2014-00746, Paper 19 at 6-12 (Aug. 27, 2014). Notwithstanding Patent Owner’s privity argument, the Board instituted trial as to claim 14 based on Petitioner’s earlier Petition. See IPR2014-00746, Paper 22 at 28 (Nov. 24, 2014). Based on the very same documents Patent Owner requests in its Motion, the Board ruled that “Patent Owner does not provide evidence sufficient to demonstrate that, at the time of service of the 2011 complaint or the amended 2011 complaint, Petitioner exercised control or could have exercised control over Comcast’s participation in the 2011 district court proceeding.” IPR2014-00746, Paper 22 at 9 (Nov. 24, 2014). Thus, the Board continued, “based on the evidence presented at this stage of the proceeding, 35 U.S.C. § 315(b) does not bar institution of *inter partes* review.”² *Id.* at 10.

¹ *C-Cation Techs., LLC v. Comcast Corp.*, 2:11-cv-0030 (E.D. Tex. 2011).

² The documentation sought by Patent Owner will not establish that Petitioner had control or the ability to control the *Comcast* litigation to give rise to a bar under § 315(b). Specifically, the requested discovery will not show (1) that Petitioner was—or could have been—involved in the defense of the earlier litigation from the time of service of the Complaints in the *Comcast* case so as to make Petitioner

What happened after the Board's institution of trial in IPR2014-00746 is key to understanding Petitioner's position as to the present Motion. After Petitioner had filed and served the Petition for IPR in this proceeding, Patent Owner voluntarily disclaimed the only claim involved in the earlier IPR proceeding. *See* IPR2014-00746, Paper 27 (Feb. 9, 2015). As the Board recognized in its Judgment, Patent Owner's disclaimer constituted a request for adverse judgment under the Board's rules. *See* IPR2014-00746, Paper 28 at 2 (Feb. 18, 2015); *see also* 37 C.F.R. § 42.73(b)(2). As such the Board's Order indicated "that Patent Owner's request for adverse judgment under 37 C.F.R. § 42.73(b) is granted" IPR2014-00746, Paper 28 at 2 (Feb. 18, 2015). The Board also indicated that its order "constitutes a final written decision as to patentability of claim 14 under 35 U.S.C. § 318(a)." *Id.*

effectively a party to that case; (2) that Petitioner had the opportunity to be heard in the earlier litigation; (3) that Comcast provided prompt notice to Petitioner under the agreements; and (4) that Petitioner exercised sole control or full authority according to the agreements (particularly in light of the fact that several other companies' products were implicated by the allegations in that case).

III. ARGUMENT

A. Board's Rules Prohibit Patent Owner From Relitigating Any Issue That Was or Could Have Been Raised, Including the Privity Issue

Based on the Board's rules, Patent Owner knew or should have known that its request for adverse judgment would keep it from presenting issues that were raised or reasonably could have been raised in the earlier proceeding during proceedings on Petitioner's then-filed second petition for *Inter Partes* Review. Section 42.73(a) is unequivocal on this point: "***A judgment***, except in the case of a termination, ***disposes of all issues that were, or by motion reasonably could have been, raised and decided.***" Whether Petitioner was in privity at the time of service of the complaints in the *Comcast* action is plainly an issue that "reasonably could have been raised" in the earlier instituted trial. 37 C.F.R. § 42.73(a). Not only could it have been raised, it ***was raised*** during preliminary proceedings. Thus, in accordance with the clear mandate imposed by Board rule, the privity issue has been disposed of by the Board's Judgment.³ See 37 C.F.R. § 42.73(a).

³ Although not addressed by Patent Owner in its Motion, it is of no consequence that the privity question is tied to 35 U.S.C. § 315(b) or that section 315(b) might be jurisdictional in nature. The Supreme Court has long recognized that once a party has had an opportunity to litigate a jurisdictional question, that party is barred

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