

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  
Patent 5,563,883

---

**PATENT OWNER'S REPLY IN SUPPORT OF ITS  
MOTION FOR DISCOVERY FROM PETITIONER**

**TABLE OF CONTENTS**

I. INTRODUCTION ..... 1

II. PETITIONER’S OPPOSITION MISAPPLIES 37 C.F.R. § 42.73..... 2

III. COMMON LAW CLAIM PRECLUSION IS NOT PROPERLY APPLIED  
HERE ..... 3

IV. CONCLUSION ..... 5

**TABLE OF AUTHORITIES**

**Cases**

*Astoria Fed. Savings and Loan Assoc. v. Solimino*,  
501 U.S. 104 (1991).....3, 4

*Epic Metals Corp. v. H. H. Robertson Co.*,  
870 F.2d 1574 (Fed. Cir. 1989) ..... 4

*Garmin Int’l, Inc. et al. v. Cuozzo Speed Techs. LLC*,  
IPR2012-00001, Paper 26 (PTAB Mar. 5, 2013) ..... 1

*Pactiv Corp. v. Dow Chem. Co.*,  
1:04-CV-81, 2005 U.S. Dist. LEXIS 42538 (Fed. Cir. 2005)..... 4

*Parklane Hosiery Co. v. Shore*,  
439 U.S. 322 (1979).....5

**Statutes**

35 U.S.C. § 315..... 1, 3, 4

**Regulations**

37 C.F.R. § 42.73 .....2, 3

## I. Introduction

Petitioner does not contest that four of the five factors outlined in *Garmin Int'l, Inc. et al. v. Cuozzo Speed Techs. LLC*, IPR2012-00001, Paper 26 (PTAB Mar. 5, 2013) for determining whether additional discovery is “necessary in the interest of justice” weigh in favor of granting Patent Owner’s motion for targeted discovery. (Paper 8 (“Opposition”)). As to the remaining factor (more than a possibility and mere allegation that something useful will be found), Petitioner does not contest that the requested discovery exists, but rather, asserts that it will not be “useful” because Patent Owner is barred from using it.

According to the Petitioner, parties to a concluded *inter partes* review proceeding are precluded from raising in a later *inter partes* review proceeding any arguments that they could have raised in the earlier proceeding. Opposition at 4-8. Specifically, Petitioner argues that because Patent Owner did not argue in IPR2014-00746 that Petitioner was barred pursuant to 35 U.S.C. § 315(b) due to Petitioner’s privity with a previous litigant, and instead elected to file a disclaimer to end that proceeding, Patent Owner cannot raise the privity issue in this proceeding. *Id.*

This argument lacks merit. In addition to relying on a misapplication of the relevant statutes, regulations, case law, and facts, the impropriety of Petitioner’s position is clear: under Petitioner’s theory, its instant petition could not have been brought because it is based on prior art that Petitioner could have presented in the

earlier proceeding, but chose not to. Indeed, if Petitioner's preclusion assertions are accepted, dismissal of Petitioner's petition in this proceeding would necessarily result.

## **II. Petitioner's Opposition Misapplies 37 C.F.R. § 42.73**

Petitioner argues that 37 C.F.R. § 42.73(a) precludes Patent Owner from raising privity as a ground of non-institution. Opposition at 4. In doing so, Petitioner misrepresents the regulation. 37 C.F.R. § 42.73(a) relates to the scope of a judgment and not its preclusive effect. The preclusive effect that results from a judgment is specifically addressed in 37 C.F.R. § 42.73(d), which makes clear that any resulting estoppel only applies on a patent claim by patent claim basis, or to such claims "not patentably distinct" therefrom.

That is not the case here. In IPR2014-00746, review was instituted only for claim 14. While an adverse judgment issued as to claim 14, that judgment did not reach claims 1, 3, and 4, and Patent Owner has never taken any action inconsistent with the judgment against claim 14. Moreover, Petitioner does not, nor can it, argue that claims 1, 3, and 4 are not patentably distinct from claim 14.

Thus, Petitioner's argument with respect to 37 C.F.R. § 42.73 relies entirely on conflating the preclusive language of C.F.R. § 42.73(d) with part (a). Petitioner cites no authority for doing so. Moreover, applying the preclusive effect of a judgment as broadly as Petitioner proposes would improperly subsume the more limited scope of part (d), leaving part (d) without any meaning.

# Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

## Real-Time Litigation Alerts



Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

## Advanced Docket Research



With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

## Analytics At Your Fingertips



Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

## API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

## LAW FIRMS

Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

## FINANCIAL INSTITUTIONS

Litigation and bankruptcy checks for companies and debtors.

## E-DISCOVERY AND LEGAL VENDORS

Sync your system to PACER to automate legal marketing.