

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

UNIFIED PATENTS INC.,
Petitioner,

v.

C-CATION TECHNOLOGIES, LLC,
Patent Owner.

Case IPR2015-01045
Patent 5,563,883

Before BARBARA A. BENOIT, LYNNE E. PETTIGREW, and
MIRIAM L. QUINN, *Administrative Patent Judges*.

PETTIGREW, *Administrative Patent Judge*.

DECISION

Denying Institution of *Inter Partes* Review
37 C.F.R. § 42.108

Denying Petitioner's Motion for Joinder
37 C.F.R. § 42.122(b)

I. INTRODUCTION

Unified Patents Inc. (“Petitioner” or “Unified”) filed a Petition for *inter partes* review of claims 1, 3, and 4 of U.S. Patent No. 5,563,883 (Ex. 1001, “the ’883 patent”). Paper 2 (“Pet.”). C-Cation Technologies, LLC (“Patent Owner”) filed a Preliminary Response. Paper 7 (“Prelim. Resp.”). After we instituted an *inter partes* review of the ’883 patent in *ARRIS Group, Inc. v. C-Cation Technologies, LLC*, Case IPR2015-00635 (“the ARRIS IPR”), Petitioner filed a Motion for Joinder with the ARRIS IPR. Paper 11 (“Mot.”). Petitioner represents that neither ARRIS nor Patent Owner opposes the Motion for Joinder. *Id.* at 2.

For the reasons explained below, we do not institute an *inter partes* review of claims 1, 3, and 4 of the ’883 patent based on the Petition, and we deny Petitioner’s Motion for Joinder.

II. RELATED PROCEEDINGS

The parties state that the ’883 patent has been asserted in *C-Cation Technologies, LLC v. Atlantic Broadband Group LLC*, No. 1:15-cv-00295 (D. Del.), and *C-Cation Technologies, LLC v. Time Warner Cable Inc.*, No. 2:14-cv-00059 (E.D. Tex.). Pet. 2; Paper 6, 2.

In the ARRIS IPR, we instituted an *inter partes* review of claims 1, 3, and 4 of the ’883 patent. *ARRIS Group, Inc. v. C-Cation Techs., LLC*, Case IPR2015-00635 (PTAB July 31, 2015) (Paper 19). Cox Communications, Inc. was joined as a petitioner in the ARRIS IPR after we instituted review of claims 1, 3, and 4 of the ’883 patent based on Cox’s petition and granted Cox’s motion for joinder with IPR2015-00635. *Cox Commc’ns, Inc. v. C-Cation Techs., LLC*, Case IPR2015-01796 (PTAB Oct. 2, 2015) (Paper 9);

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ARRIS Group, Inc. v. C-Cation Techs., LLC, Case IPR2015-00635 (PTAB Oct. 2, 2015) (Paper 26).

The '883 patent has been the subject of two additional petitions for *inter partes* review. In *Cisco Systems, Inc. v. C-Cation Technologies, LLC*, Case IPR2014-00454 (PTAB Aug. 29, 2014) (Paper 12), the Board denied institution of *inter partes* review. In *ARRIS Group, Inc. v. C-Cation Technologies, LLC*, Case IPR2014-00746 (PTAB Nov. 24, 2014) (Paper 22), the Board instituted *inter partes* review, and subsequently granted Patent Owner's request for adverse judgment (Paper 28).

III. DISCUSSION

Institution of an *inter partes* review is authorized, but not required, when “the information presented in the petition . . . shows that there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.” 35 U.S.C. § 314(a); *see also* 37 C.F.R. § 42.108(a) (“[T]he Board *may* authorize the review to proceed on all or some of the challenged claims and on all or some of the grounds of unpatentability asserted for each claim.” (emphasis added)). Thus, the decision whether to institute an *inter partes* review is discretionary.

The decision whether to grant joinder also is discretionary, as set forth in 35 U.S.C. § 315(c):

If the Director institutes an *inter partes* review, the Director, in his or her discretion, may join as a party to that *inter partes* review any person who properly files a petition under section 311 that the Director, after receiving a preliminary response under section 313 or the expiration of the time for filing such a response, determines warrants the institution of an *inter partes* review under section 314.

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A motion for joinder should (1) set forth reasons why joinder is appropriate; (2) identify any new grounds of unpatentability asserted in the petition; (3) explain what impact, if any, joinder would have on the trial schedule for the existing review; and (4) address specifically how briefing and discovery may be simplified. *See Kyocera Corp. v. Softview LLC*, Case IPR2013-00004, slip op. at 4 (PTAB Apr. 24, 2013) (Paper 15).

Petitioner contends that claims 1, 3, and 4 of the '883 patent are unpatentable on the following grounds: (a) claims 1 and 4 under 35 U.S.C. § 103(a) as obvious over MPT 1343,¹ MPT 1347,² and MPT 1327,³ and (b) claim 3 under 35 U.S.C. § 103(a) as obvious over MPT 1343, MPT 1347, MPT 1327, Zdunek,⁴ and Dufresne.⁵ Pet. 17–55. The Petition asserts the same invalidity grounds and presents the same arguments as the petition in the ARRIS IPR. *See* Mot. 7; Prelim. Resp. 2. The Petition also relies on declaration testimony from the same expert retained by ARRIS. *See* Mot. 2; Ex. 1002 (Declaration of Stuart Lipoff). In addition, Patent Owner's arguments in the Preliminary Response regarding the asserted grounds of unpatentability are virtually identical to those presented by Patent Owner in the ARRIS IPR. *See* Mot. 7; Prelim. Resp. 25–37.

¹ MPT 1343 PERFORMANCE SPECIFICATION: SYSTEM INTERFACE SPECIFICATION FOR RADIO UNITS TO BE USED WITH COMMERCIAL TRUNKED NETWORKS OPERATING IN BAND III SUB-BANDS 1 AND 2 (1991) (Ex. 1006, "MPT 1343").

² MPT 1347 RADIO INTERFACE SPECIFICATION FOR COMMERCIAL TRUNKED NETWORKS OPERATION IN BAND III, SUB-BANDS 1 AND 2 (1991) (Ex. 1007, "MPT 1347").

³ MPT 1327 A SIGNALLING STANDARD FOR TRUNKED PRIVATE LAND MOBILE RADIO SYSTEMS (1991) (Ex. 1005, "MPT 1327").

⁴ U.S. Patent No. 4,870,408, issued Sept. 26, 1989 (Ex. 1008, "Zdunek").

⁵ U.S. Patent No. 4,920,533, issued Apr. 24, 1990 (Ex. 1009, "Dufresne").

One issue exists in the case before us that was not present in the ARRIS IPR—whether the Petition identifies all real parties-in-interest. *See* Mot. 7; Prelim. Resp. 5–8. Petitioner certifies in the Petition that “Unified is the real party-in-interest” and that “no other party exercised control or could exercise control over Unified’s participation in this proceeding, the filing of this petition, or the conduct of any ensuing trial.” Pet. 2. In support of its certification, Petitioner submits voluntary interrogatory responses regarding preparation and financing of the Petition. Ex. 1020.

In the Preliminary Response, Patent Owner contends the Petition should be denied because it fails to identify all the real parties-in-interest, as required by 35 U.S.C. § 312(a)(2). Prelim. Resp. 2. According to Patent Owner, Unified “is merely an entity whose sole purpose is to ‘protect’ the technology sectors of its secret members by challenging the validity of patents—here, an expired patent—asserted against them.” *Id.* at 6 (citing Ex. 2001 (excerpt from Frequently Asked Questions on the Unified Patents website)). Patent Owner further contends that “Petitioner’s only source of revenue is subscription fees that its members pay so that Unified can file these post-grant proceedings on behalf of their members.” *Id.* (citing Ex. 2002 (another excerpt from Frequently Asked Questions on the Unified Patents website)). In sum, Patent Owner argues, Petitioner “acts as a ‘shell’ for its anonymous members, filing petitions on their behalf and for their benefit using money collected from the subscription fees they pay.” *Id.* at 7.

In its Motion for Joinder, Petitioner acknowledges that whether the Petition identifies all real parties-in-interest is an issue not presented by the ARRIS IPR. Mot. 7. But in Petitioner’s view, this additional issue is not an impediment to joinder because the Board already thoroughly considered the

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