

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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PROTECTION ONE, INC.,  
Petitioner,

v.

MD SECURITY SOLUTIONS, LLC,  
Patent Owner.

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Case IPR2016-01235  
Patent 7,864,983 B2

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Before SALLY C. MEDLEY, TRENTON A. WARD, and  
WILLIAM M. FINK, *Administrative Patent Judges*.

FINK, *Administrative Patent Judge*.

DECISION

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

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

## I. INTRODUCTION

Protection One, Inc. (“Petitioner” or “Protection One”) filed a Petition for *inter partes* review of claims 1–20 of U.S. Patent No. 7,864,983 B2 (Ex. 1001, “the ’983 patent”). Paper 2 (“Pet.”). Concurrently with its Petition, Protection One filed a Motion for Joinder with *RPX Corporation v. MD Security Systems, LLC*, Case IPR2016-00285 (“the RPX IPR”), a case challenging the same claims of the ’983 patent on the same grounds as this matter. Paper 3 (“Mot.”). Protection One represents that Petitioner in the RPX IPR—RPX Corporation (“RPX”)—does not oppose the Motion for Joinder. Mot. 7. MD Security Systems, LLC (“Patent Owner”) did not file an opposition to Protection One’s Motion for Joinder after being given an opportunity to do so. *See* Paper 6. Patent Owner also did not file a Preliminary Response by the deadline set forth in Paper 6.

For the reasons explained below, we institute *inter partes* review of claims 1–20 of the ’983 patent and grant Protection One’s Motion for Joinder.

## II. RELATED PROCEEDINGS

In addition to the RPX IPR identified above, Petitioner and Patent Owner identify the following pending judicial matters as relating to the ’983 patent: *MD Security Solutions, LLC v. Bright House Networks, LLC*, No. 6:15-cv-00777 (M.D. Fl.), *MD Security Solutions LLC v. CenturyTel Security Systems, Inc.*, No. 6:15-cv-01967 (M.D. Fl.), and *MD Security Solutions LLC v. Protection 1, Inc.*, No. 6:15-cv-01968 (M.D. Fl.). Pet. 2–3; Paper 7, 1.

In the RPX IPR, we instituted *inter partes* review of claims 1–20 of the ’983 patent on the following grounds:

References	Basis	Challenged Claims
Milinusic <sup>1</sup> and Osann <sup>2</sup>	§ 103(a)	1–8, 11, and 18–20
Milinusic, Osann, and Ozer <sup>3</sup>	§ 103(a)	9, 10, and 12–17

*RPX Corporation v. MD Security Systems, LLC*, Case IPR2016-00285, slip op. at 20 (PTAB June 6, 2016) (Paper 9) (“the RPX Dec.”).

### III. INSTITUTION OF *INTER PARTES* REVIEW

The Petition in this proceeding asserts the same grounds of unpatentability as those shown above on which we instituted review in the RPX IPR. *Compare* Pet. 13–38, *with* RPX Dec. 20. Indeed, the “Petition is substantively identical as to those grounds, and presents no new issues.”

Mot. 3.

For the same reasons set forth in our institution decision in the RPX IPR, we determine that the information presented in Protection One’s Petition shows a reasonable likelihood that Petitioner would prevail in showing (a) claims 1–8, 11, and 18–20 would have been obvious over Milinusic and Osann; and (b) claims 9, 10, and 12–17 would have been obvious over Milinusic, Osann, and Ozer. *See* RPX Dec. 10–19.

Accordingly, we institute *inter partes* review on the same grounds as those on which we instituted review in the RPX IPR. We do not institute *inter partes* review on any other grounds.

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<sup>1</sup> U.S. Patent No. 7,106,333 B1, issued September 12, 2006 (Ex. 1003) (“Milinusic”)

<sup>2</sup> U.S. Patent No. 7,253,732 B2, issued August 7, 2007 (Ex. 1004) (“Osann”)

<sup>3</sup> U.S. Patent Application Publication No. 2004/0120581 A1, published June 24, 2004 (Ex. 1005) (“Ozer”).

### III. GRANT OF MOTION FOR JOINDER

The Petition and Motion for Joinder in this proceeding were accorded a filing date of July 5, 2016. *See* Paper 4. Thus, Petitioner's Motion for Joinder is timely because joinder was requested no later than one month after the institution date of the RPX IPR, i.e., June 6, 2016. *See* 37 C.F.R. § 42.122(b).

The statutory provision governing joinder in *inter partes* review proceedings is 35 U.S.C. § 315(c), which reads:

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.

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).

As noted, the Petition in this case asserts the same invalidity grounds on which we instituted review in the RPX IPR. *See* Mot. 3. Protection One also relies on the same prior art analysis and expert testimony submitted by RPX. *See id.* at 4. Indeed, the Petition is nearly identical to the petition filed by RPX with respect to the grounds on which review was instituted in the RPX IPR. *See id.* at 3–4. Thus, this *inter partes* review does not present any ground or matter not already at issue in the RPX IPR.

If joinder is granted, Protection One agrees to participate in an “understudy” role” unless RPX ceases to participate. Mot. 4, 7. Protection One agrees to consolidate its filings with those of RPX, unless a filing solely concerns issues that do not involve RPX, not introduce argument or discovery not already introduced by RPX, to be bound by any agreement between Patent Owner and RPX concerning discovery or depositions, and not to receive any direct, cross or redirect time beyond that permitted for RPX. *Id.* at 7. Protection One concludes that, if joined, there will be only one set of briefing on the issues as opposed to briefing from both sets of Petitioners if that would result if the cases are not joined. *Id.*

We agree with Petitioner that joinder with the RPX IPR is appropriate under the circumstances. Accordingly, we *grant* Petitioner’s Motion for Joinder.

## V. ORDER

Accordingly, it is:

ORDERED that an *inter partes* review is instituted in IPR2016-01235;

FURTHER ORDERED that the Motion for Joinder with IPR2016-00285 is *granted*, and Protection One, Inc. is joined as a petitioner in IPR2016-00285;

FURTHER ORDERED that IPR2016-01235 is terminated under 37 C.F.R. § 42.72, and all further filings shall be made only in IPR2016-00285;

FURTHER ORDERED that, subsequent to joinder, the grounds for trial in IPR2016-00285 remain unchanged;

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