

UNITED STATES PATENT AND TRADEMARK OFFICE

---

BEFORE THE PATENT TRIAL AND APPEAL BOARD

---

CORNING OPTICAL COMMUNICATIONS RF, LLC,  
Petitioner,

v.

PPC BROADBAND, INC.,  
Patent Owner.

---

Case IPR2014-00440 (Patent 8,597,041 B2)  
Case IPR2014-00441 (Patent 8,562,366 B2)  
Case IPR2014-00736 (Patent 6,676,446 B2)<sup>1</sup>

---

Before JAMESON LEE, JOSIAH C. COCKS, and  
JACQUELINE WRIGHT BONILLA, *Administrative Patent Judges.*

BONILLA, *Administrative Patent Judge.*

DECISION

Granting Patent Owner's Motions to Dismiss Petitions for  
Failure to Name All Real Parties-In-Interest  
*35 U.S.C. § 312(a) and 37 C.F.R. §§ 42.8(b)(1), 42.72*

---

<sup>1</sup> This Decision addresses common issues raised in all three cases. Papers, arguments, and evidence submitted by Patent Owner and Petitioner as it relates to the issue at hand are largely the same in each case. Thus, we issue one Decision to be entered in each case. The parties are not authorized to use this caption without prior authorization of the Board.

IPR2014-00440 (Patent 8,597,041 B2)

IPR2014-00441 (Patent 8,562,366 B2)

IPR2014-00736 (Patent 6,676,446 B2)

## I. INTRODUCTION

On August 19, 2014, we instituted an *inter partes* review of claims 1, 8, 9, 11, 18–26, and 29 of U.S. Patent No. 8,597,041 (“the ’041 patent”) in Case IPR2014-00440, as well as an *inter partes* review of claims 31, 37, 39, 41, 42, 55, and 56 of U.S. Patent No. 8,562,366 (“the ’366 patent”) in Case IPR2014-00441, based on two Petitions filed by Petitioner, Corning Optical Communications RF, LLC (“Petitioner”). On September 12, 2014, we instituted an *inter partes* review of claims 1–7 of U.S. Patent No. 6,676,446 (“the ’446 patent”) in Case IPR2014-00736, based on a Petition also filed by Petitioner.

After institution, in all three proceedings, we authorized Patent Owner, PPC Broadband, Inc. (“Patent Owner”) to file a motion for additional discovery directed to information as to whether the Petitions should have identified Petitioner’s parent, Corning Incorporated (“Corning Inc.”), and Petitioner’s sister company, Corning Optical Communications LLC (“Corning NC”), as real parties-in-interest. *See, e.g.*, IPR2014-00440, Paper 31 (order authorizing motion).<sup>2</sup> Specifically, we authorized a motion for discovery as to whether those two entities funded or controlled the filing and conduct of these *inter partes* reviews. *Id.* We also urged the parties to come to agreement on discovery, to obviate the need for a motion. *Id.* Thereafter, Patent Owner provided a Request for Discovery to Petitioner, and Petitioner responded. *See, e.g.*, IPR2014-00440, Ex. 2100 (“Petitioner’s Objections and Responses to Patent Owner’s First Request for Discovery,” “Response to the Discovery Request” or “Discovery Response”).

---

<sup>2</sup> As discussed below, for clarity and expediency, we treat IPR2014-00440 as representative of all three cases. All citations are to IPR2014-00440 unless otherwise noted.

IPR2014-00440 (Patent 8,597,041 B2)

IPR2014-00441 (Patent 8,562,366 B2)

IPR2014-00736 (Patent 6,676,446 B2)

A few weeks later, after a subsequent telephone conference with the parties, we authorized Patent Owner to file a Motion to Dismiss the Petition for failure to name all real parties-in-interest in each of the three proceedings. *E.g.*, IPR2014-00440, Paper 41, 2. We indicated to the parties that each Motion to Dismiss should include two sections, the first discussing why Patent Owner waited until March 2015 to raise the issue of real party-in-interest and whether Patent Owner raised the issue too late, and the second discussing the merits of the issue. *Id.*

Because the real parties-in-interest issue is common to all three cases, and both parties filed similar papers in all cases as it relates to this issue, we consider the three cases together in this Decision. For clarity and expediency, we treat IPR2014-00440 as representative of all three cases.

Patent Owner filed a Motion to Dismiss the Petition for Failure to Name All Real Parties-In-Interest in each of the three cases. Papers 43, 44 (“Motion to Dismiss” or “Motion”).<sup>3</sup> As also authorized (Paper 50, 2), Patent Owner filed Supplemental Briefing on the Legislative History of 35 U.S.C. § 312(a)(2) (Paper 52, “Supp. Briefing”). Petitioner filed an Opposition to the Motion to Dismiss (Paper 54, “Opp.”) and Patent Owner filed a Reply to the Opposition (Paper 59, “Reply”). Petitioner also filed Objections to Evidence Entered with Patent Owner’s Reply. Paper 64 (“Objections”).<sup>4</sup> An oral hearing was held on June 4,

---

<sup>3</sup> Patent Owner originally filed “Confidential” (Paper 43) and “Redacted—Public” (Paper 44) versions of its Motion to Dismiss. As jointly requested by the parties, the confidential version of the Motion to Dismiss (Paper 43) will be designated as available to the public, and the original public version of the Motion (Paper 44) will be expunged. Paper 53, 1.

<sup>4</sup> Specifically, Petitioner objected to Exhibit 2142, which is cited in Patent Owner’s Reply. Objections 1; Reply 10. Because we do not rely on Exhibit 2142 in this Decision, Petitioner’s objection is moot.

IPR2014-00440 (Patent 8,597,041 B2)

IPR2014-00441 (Patent 8,562,366 B2)

IPR2014-00736 (Patent 6,676,446 B2)

2015. A transcript of the hearing in relation to the Motion to Dismiss has been entered into the record. Paper 67 (“Tr.”).

Because the Petitions fail to identify all real parties in interest as required by 35 U.S.C. § 312(a)(2), we grant Patent Owner’s Motions to Dismiss, vacate our Decisions to Institute (Paper 10), and terminate the reviews.

## II. ANALYSIS

### A. Patent Owner’s Contentions

Patent Owner contends that Petitioner’s parent, Corning Inc. (Ex. 2104),<sup>5</sup> and its sister company, Corning NC (Ex. 2105),<sup>6</sup> were and are real parties-in-interest (“RPI”) because they had the opportunity to control, and actually controlled, Petitioner’s participation in these *inter partes* review (“IPR”) proceedings. Motion, 1, 6. Among other evidence, Patent Owner refers to Petitioner’s Response to the Discovery Request (Ex. 2100), as well as a relevant engagement letter in relation to these IPR proceedings between an executive at Corning Inc. and outside counsel for Petitioner (Ex. 2101). Motion 4–11.

Specifically, Patent Owner contends that Petitioner admitted that officers and in-house counsel employed by Corning Inc. and Corning NC provided direction to counsel for Petitioner in this proceeding. *Id.* at 1, 4–9. To the extent that Petitioner asserts that certain individuals at Corning Inc. and Corning NC directed outside counsel only in their “capacity” as an officer or counsel to

---

<sup>5</sup> Exhibit 2104, which presents a copy of a Certificate of Interest filed by counsel for Petitioner with the U.S. Court of Appeals for the Federal Circuit, states “Corning Optical Communications RF LLC is a wholly owned subsidiary of Corning Oak Holding, LLC, which is a wholly owned subsidiary of Corning Inc.”

<sup>6</sup> Exhibit 2105, which is copy of a D&B Business Report, indicates that Corning NC is a subsidiary of Corning Inc.

IPR2014-00440 (Patent 8,597,041 B2)

IPR2014-00441 (Patent 8,562,366 B2)

IPR2014-00736 (Patent 6,676,446 B2)

Petitioner, Patent Owner contends “that ‘capacity’ clearly is in name only,” because they “did not work for Petitioner and are not paid by Petitioner.” *Id.* at 6.

Patent Owner further contends that “[a]t the very least, the boundary lines are sufficiently blurred between the Corning entities such that—it is difficult for both insiders and outsiders to determine precisely where one ends and another begins.” *Id.* at 6–9 (quoting *Atlanta Gas Light Co. v. Bennett Regulator Guards, Inc.*, Case IPR2013-00453, slip op. at 11 (PTAB Jan. 6, 2015) (Paper 88)). In addition, Patent Owner contends that Corning Inc. retained counsel for this matter, and that invoices for the matter were sent to, and paid, by Corning Inc. Motion 1, 9–11.

Thus, according to Patent Owner, both Corning Inc. and Corning NC exercised, or could have exercised, control over Petitioner’s participation in this proceeding, and should have been named as real parties-in-interest. *Id.* at 1–2, 6. Patent Owner contends that because the Petition fails to name all real parties-in-interest, its filing date must be vacated, with a new filing date to be set only if and when Petitioner submits an updated mandatory notice. *Id.* at 2, 12. In addition, because Patent Owner served Petitioner with a complaint alleging infringement of the challenged patent more than one year after any possible new filing date, the Petition is barred under 35 U.S.C. § 315(b), and we must terminate the proceeding. *Id.*

Patent Owner also argues that it timely raised the RPI issue in this case. *Id.* at 12–15. Patent Owner explains that it served Petitioner with a complaint alleging infringement of the challenged patents on November 6, 2013. *Id.* at 12.<sup>7</sup> On

---

<sup>7</sup> In IPR2014-00736, Patent Owner asserts that it served Petitioner with a complaint alleging infringement of the ’446 patent on June 11, 2013. Motion 12.

# 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.