UNITED STATES PATENT AND TRADEMARK OFFICE

_____

BEFORE THE PATENT TRIAL AND APPEAL BOARD

_____

DISH Network, L.L.C.,
Petitioner

v.

TQ Delta LLC,
Patent Owner

U.S. Patent No. 8,238,412
Filing Date: May 13, 2010
Issue Date: August 7, 2012
Inter Partes Review No. 2016-_____

Title: Multicarrier modulation messaging for power level per subchannel
information

MOTION FOR JOINDER

I.   INTRODUCTION

DISH Network L.L.C. ("DISH" OR "Petitioner") submits concurrently with this motion a Petition for *Inter Partes* Review of U.S. Patent No. 8,238,412 (the "'412 patent") ("Petition") based on the identical grounds that form the basis for the pending *inter partes* review initiated by Cisco Systems, Inc. concerning the same patent, Case No. IPR2016-01008 (the "Cisco IPR").

DISH respectfully requests that the Petition be instituted and moves that the Petition be joined with the Cisco IPR pursuant to 35 U.S.C. § 315(c) and 37 C.F.R. §§ 42.22 and 42.122(b). DISH merely requests an opportunity to join with the Cisco IPR as an "understudy" to Cisco, only assuming an active role in the event Cisco settles with Patent Owner TQ Delta, LLC ("TQ Delta"). DISH does not seek to alter the grounds upon which the Board has already instituted the Cisco IPR, and joinder will have no impact on the IPR's existing schedule. DISH has conferred with Cisco and Cisco does not oppose this motion. Under Rule 42.122(b), this motion is timely as it was filed within one month of the institution of IPR2016-01008.

II.   BACKGROUND AND RELATED PROCEEDINGS

TQ Delta, the owner of the '412 patent, sued six companies, including DISH, in the District of Delaware in July 2015 for infringement of U.S. Pat. Nos. 6,961,369, 7,835,430, 8,238,412, 8,432,956, 8,611,404, 8,718,158, 9,014,243, and 9,094,268 (collectively, the "Asserted Patents."). These litigations are *TQ Delta LLC v. Comcast Cable Communications, LLC*, No. 1-15-cv-00611 (D. Del. 2015); *TQ Delta LLC v. CoxCom, LLC et al.*, No. 1-15-cv-00612 (D. Del. 2015); *TQ Delta LLC v. DIRECTV et al.*, No. 1-15-cv-00613 (D. Del. 2015); *TQ Delta LLC v.DISH Network Corporation et al.*, No. 1-15-cv-00614 (D. Del. 2015); *TQ Delta LLC v. Time Warner Cable Inc., et al.*, No. 1-15-cv-00615 (D. Del. 2015); and *TQ Delta LLC v. Verizon Communications, Inc. et al., Inc.*, No. 1-15-cv-00616 (D. Del. 2015). TQ Delta subsequently voluntarily dismissed the '369 and '956 patents.

In May 2016, Cisco Systems, Inc. ("Cisco") filed six petitions for *inter partes* review against five of the Asserted Patents. *See* IPR Case Nos. IPR2016-01006 ('430 patent), -01007 ('956 patent), -01008 ('412 patent), -01009 ('412 patent), -01020 ('243 patent) and -01021 ('158 patent). The Board instituted each of these IPRs on November 4, 2016. *Id.* In addition to this motion to join IRP2016-01008, Petitioner is filing related motions to join IPR Case Nos. IPR2016-01006, -01020 and -01021.

Several other IPRs have been filed against Asserted Patents and are awaiting institution. These include IPR2016-01160 ('404 patent), filed by the ARRIS Group, Inc. ("ARRIS") on June 6, 2016, IPR2016-01466 ('404 patent), filed by Cisco on July 20, 2016, IPR2016-01469 ('268 patent) and -01470 ('404 patent), filed by DISH on July 21, 2016, and IPR2016-01760 ('268 patent) filed by Cisco on September 8, 2016.

Finally, several other IPRs have been filed on the asserted patents but were denied institution. On July 17, 2015, ARRIS filed IPR2016-00428 ('430 patent), -00429 ('956 patent), and -00430 ('412 patent.) On June 22, 2016, the Board denied institution of these IPRs.

III. LEGAL STANDARD AND APPLICABLE RULES

Joinder is governed by 35 U.S.C. § 315(c), which reads as follows:

Joinder.— 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 the 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* Decision on Joinder, IPR2013-00385 (Paper

No. 17, July 29, 2013); *see also* Order Authorizing Joinder, IPR2013-00004 (Paper No. 15, April 24, 2013.) Petitioner that submits the factors outlined below support granting of the present Motion for Joinder.

IV.   DISH MEETS THE REQUIREMENTS FOR MOTION FOR JOINDER

DISH submits that (1) joinder is appropriate because it will promote efficient determination of the validity of the '412 patent without prejudice to Cisco; (2) DISH's petition raises the same grounds for unpatentability as does Cisco's petition; (3) joinder would not affect the pending schedule in the Cisco IPR nor would it increase the complexity of that proceeding; and (4) DISH is willing to accept an understudy role in the Cisco IPR to minimize burden and schedule impact. Absent joinder, DISH could be prejudiced if the Cisco IPR is terminated before the Board issues a final written decision. DISH could have to litigate the same positions in the Petition before the District Court under a higher burden of proof, wasting resources and losing efficiency. Accordingly, joinder should be granted.

A.   Joinder Will Promote the Efficient Determination of the '412 Patent's Validity and Will Not Prejudice Cisco or TQ Delta

Granting joinder and allowing DISH to assume an understudy role will not prejudice Cisco. The Petition does not raise any issues that are not already before the Board in the Cisco IPR. Joinder thus would not affect the timing of the Cisco IPR or content of TQ Delta's responses. The Board has granted motions for joinder in similar circumstances. *See*, e.g., Decision on Joinder, IPR2014-00743 (Paper 10, June 18, 2014). DISH has notified counsel for Cisco of its intent to assume only an understudy role and Cisco does not oppose this motion.

Moreover, the Board's final written decision on the '412 patent will minimize issues in the underlying litigation and could potentially resolve the underlying litigation altogether. This would promote the efficient determination of the '412 patent's validity. If the Board allows

DISH to join the Cisco IPR and upholds the '412 patent's validity, DISH will be estopped from further challenging the validity of the '412 patent on the grounds in the Petition. See 35 U.S.C. § 315(e)(1). Joinder is appropriate here to promote judicial efficiency and avoid unnecessary expense.

B.   DISH's Petition Raises the Same Grounds As the Cisco IPR

The Petition asserts only grounds that the Board has already instituted in the Cisco IPR. There are no new arguments for the Board to consider. Likewise, the Petition relies on the same exhibits and expert declaration as the Cisco IPR.

C.   Joinder Will Not Affect the Schedule of the Cisco IPR

Allowing DISH to join the Cisco IPR will not impact the Board's ability to complete its review within the statutory period and according to the schedule already set in the Cisco IPR. Section 316(a)(11) requires that IPR proceedings be completed and the Board's final decision issued within one year of the institution of the IPR. *See also* 37 C.F.R. § 42.100(c). DISH agrees to an understudy role and does not raise any issues that are not already before the Board. The invalidity grounds in the Petihtion are the same as those the Board already instituted in the Cisco IPR. Given that DISH will assume an understudy role, its addition to this IPR proceeding will not introduce any additional arguments, briefing, or need for discovery. *See* Decision on Joinder, IPR2013-00495 (Paper 13, Sept. 16, 2013).

DISH submits that TQ Delta does not need to file a Patent Owner's Preliminary Response, and requests that the Board proceed without one. This is consistent with the Board's Order in IPR2013-00256 (Paper 8, June 13, 2013), which allowed the Patent Owner to file a preliminary response addressing only those points raised in the new petition that were different from those in the granted petition. Here, because the invalidity grounds in the Petition are identical to those instituted in the Cisco IPR, there are no new arguments for TQ Delta to

DOCKET ALARM

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.

fastcase
Smarter legal research.