

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Comcast Cable Communications, LLC; Cox Communications, Inc.; Time Warner
Cable Enterprises LLC; Verizon Services Corp. and ARRIS Group, Inc.

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

Comcast Cable Communications, LLC (“Comcast”); Cox Communications, Inc. (“Cox”); Time Warner Cable Enterprises LLC (“TWC”); Verizon Services Corp. (“Verizon”) and ARRIS Group, Inc. (“ARRIS”) (collectively “Petitioner”) submit 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”).

Petitioner 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). Petitioner 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”). Petitioner 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. Petitioner has conferred with counsel for Cisco and DISH, and neither oppose this motion. This motion is timely as it was filed within one month of the institution of IPR2016-01008. 35 U.S.C. § 21(b); 37 C.F.R. § 42.122(b).

II. BACKGROUND AND RELATED PROCEEDINGS

TQ Delta, the owner of the ‘412 patent, sued six companies, including the Comcast, Cox, TWC, and Verizon Petitioners, 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.”). In addition, Products made by ARRIS are accused of infringement in these litigations. The 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 from these litigations.

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.

On November 11, 2016, DISH Network L.L.C. (“DISH”) filed petitions for IPRs and motions to join the same set of four Cisco IPRs. *See* DISH IPR Case Nos. IPR2017-00251 (‘430 patent), -00253 (‘412 patent), -00254 (‘243 patent), -00255 (‘158 patent). For simplicity, this motion for joinder is substantially identical to DISH’s pending motions for joinder, in which DISH likewise agrees to take on an “understudy” role. *See, e.g.*, IPR2017-00251, Paper 2, at 5 (citing IPR2013-00495, Paper 13 (Sept. 16, 2013)).

Separately, ARRIS is filing a motion to join a fifth instituted IPR filed by Cisco, IPR Case No. IPR2016-01007 (‘956 patent). An affiliate of ARRIS, 2Wire, Inc., is accused of infringing the ‘956 patent in an earlier litigation, *TQ Delta LLC v. 2Wire, Inc.*, No. 1:13-cv-01835 (D. Del. 2013).

Several other IPRs have been filed against Asserted Patents and are awaiting institution. These include IPR2016-01160 (‘404 patent), filed by the 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 Network L.L.C. 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.

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