

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ARRIS Group, Inc.

Petitioner

v.

TQ Delta LLC,
Patent Owner

U.S. Patent No. 8,432,956

Filing Date: May 21, 2012

Issue Date: April 30, 2013

Inter Partes Review No. 2016-_____

Title: Multicarrier Modulation Messaging for Power Level per Subchannel
Information

MOTION FOR JOINDER

I. INTRODUCTION

ARRIS Group, Inc. (“Petitioner”) submits concurrently with this motion a petition for *inter partes* review of U.S. Patent No. 8,432,956 (“the ‘956 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. IPR2016-01007 (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 IPR2016-01007. 35 U.S.C. § 21(b); 37 C.F.R. § 42.122(b).

II. BACKGROUND AND RELATED PROCEEDINGS

TQ Delta, the owner of the ‘956 patent, sued an affiliate of ARRIS, 2Wire, Inc., of infringing the ‘956 patent in the District of Delaware, *TQ Delta LLC v. 2Wire, Inc.* No. 1:13-cv-01835 (D. Del. 2013). Thereafter, TQ Delta 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.”). Products made by Petitioner are accused of infringement in these litigations, which 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 six litigations, but did not dismiss the ‘956 patent from the litigation against 2Wire, Inc..

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 IRP2016-01007, Petitioner is filing related motions to join IPR Case Nos. IPR2016-01006, -01008, -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). While DISH did not file a motion for joinder of Cisco’s IPR of the ‘956 patent, for simplicity, Petitioner’s motion here is substantially identical to DISH’s pending motions for joinder of the other related patents, 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)).

Several other IPRs have been filed against Asserted Patents and are awaiting institution. These include IPR2016-01160 (‘404 patent), filed by the Petitioner 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, Petitioner filed IPR2016-00428 (‘430 patent), -00429 (‘956 patent), and -00430 (‘412 patent).

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 submits the factors outlined below support granting of the present Motion for Joinder.

IV. PETITIONER MEETS THE REQUIREMENTS FOR MOTION FOR JOINDER

Petitioner submits that (1) joinder is appropriate because it will promote efficient determination of the validity of the ‘956 patent without prejudice to Cisco; (2) Petitioner’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) Petitioner is willing to accept an understudy role in the Cisco IPR to minimize burden and schedule impact. Absent joinder, Petitioner could be prejudiced if the Cisco IPR is terminated before the Board issues a final written decision. Petitioner’s affiliate, 2Wire, Inc., could

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.