

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

AT&T SERVICES, INC.,

Petitioner,

v.

CONVERGENT MEDIA SOLUTIONS, LLC,

Patent Owner.

INTER PARTES REVIEW OF U.S. PATENT NO. 8,850,507 B2
Case IPR No.: IPR2017-01235

PATENT OWNER'S OPPOSITION TO PETITIONER'S MOTION FOR JOINDER

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35 U.S.C. §315(c)1, 5, 6

37 C.F.R. §42.101(b)7

37 C.F.R. §42.122(b)7, 8

Case IPR2017-01235
U.S. Patent No. 8,850,507 B2

PATENT OWNER'S EXHIBIT LIST

Exhibit No.	Description
2001	Patent Owner CMS's First Amended Complaint against Petitioner AT&T Services, Inc., Case No. 3:15-cv-02156-M, ECF No. 21 (Nov. 10, 2015).
2002	Petitioner AT&T Services, Inc.'s Answer to Patent Owner CMS's First Amended Complaint. Case No. 3:15-cv-02156-M, ECF No. 26 (Nov. 30, 2015).

I. Introduction

Patent Owner Convergent Media Solutions, LLC (“CMS” or “Patent Owner”) files this opposition to Petitioner AT&T Services, Inc.’s (“AT&T” or “Petitioner”) Motion for Joinder, Paper 3 (“Motion”).

Petitioner’s Motion for Joinder should be denied. Petitioner cannot dispute that it filed its petition more than one year after it was served with a complaint for infringement of U.S. Patent 8,850,507 (the “507 patent”). For this reason alone, Petitioner’s IPR petition, Paper 1, is defective and the Board should not institute a trial in this case. *See* 35 U.S.C. §315(b) (“An inter partes review may not be instituted if the petition requesting the proceeding is filed more than 1 year after the date on which the petitioner ... is served with a complaint alleging infringement of the patent.”). Because Petitioner filed a defective petition, joinder would be improper. *See* 35 U.S.C. §315(c) (authoring joinder only for “any person who properly files a petitioner under section 311 ...”) and 35 U.S.C. §311(a) (stating that all petitions are “[s]ubject to the provisions of this chapter,” thus including the timeliness requirement of §315(b)). Any prejudice to Petitioner in denying the Motion for Joinder is a product of Petitioner’s decision to file its Petition after it was time-barred.

Patent Owner understands that Petitioner’s IPR petition is duplicative of the

grounds, evidence, and arguments presented by petitioners Netflix, Inc. and Roku, Inc. in IPR2016-01761 (the “-01761 IPR”), which has been instituted for trial. Patent Owner is aware of previous Board decisions permitting institution of copy-cat petitions that would otherwise be time-barred when a request for joinder to an instituted trial is filed with the copy-cat petition. Patent Owner respectfully contends that such an outcome is contrary to the statutory mandate of §315(b), and that in doing so the Board exceeds a limitation that Congress placed on the Board’s statutory authority and that is plainly expressed in the statute. Despite the prior panel decisions to the contrary, Patent Owner urges this panel to follow the plain language of the statute; and Patent Owner presents its arguments here to preserve the issue for appeal, if necessary.

Additionally, the parties to the proceeding that Petitioner seeks to join have settled their dispute and filed a motion to terminate that proceeding. Patent Owner and Netflix and Roku respectfully believe that the proceeding that AT&T seeks to join should be terminated. On this additional basis, the Motion for Joinder should be denied.

II. Status of Related Litigations and Proceedings

As of this filing, the ’507 patent is currently subject to one additional IPR proceeding between Patent Owner and Petitioners Netflix, Inc. and Roku, Inc.,

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