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Paper No. 6
Filed: August 8, 2019

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ARRIS SOLUTIONS, INC.,
Petitioner,

v.

REALTIME ADAPTIVE STREAMING LLC,
Patent Owner.

Case IPR2019-00746
Patent 8,867,610 B2

Before KEVIN W. CHERRY, GARTH D. BAER, and NABEEL U. KHAN, *Administrative Patent Judges.*

BAER, *Administrative Patent Judge*.

DECISION
Institution of *Inter Partes* Review
35 U.S.C. § 314

Granting Motion for Joinder
37 C.F.R. § 42.122(b)

I. I. INTRODUCTION

A. Background

ARRIS Solutions, Inc. ("Petitioner") filed a Petition (Paper 2, "Pet.") to institute an *inter partes* review of claims 1, 2, 6, 8–14, 16, and 18 (the "challenged claims") of U.S. Patent No. 8,867,610 B2 (Exhibit 1001, "the '610 patent"). Concurrently, Petitioner filed a Motion for Joinder seeking to join Petitioner as party to *Sling TV, L.L.C., et al. v. Realtime Adaptive Streaming, LLC*, Case IPR2018-01331 (PTAB) ("the DISH IPR"). Paper 3 ("Mot."). Realtime Adaptive Streaming, LLC ("Patent Owner") has not filed a Preliminary Response. We have authority under 37 C.F.R. § 42.4(a) and 35 U.S.C. § 314, which provides that an *inter partes* review may not be instituted unless the information presented in the Petition "shows that there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition." For the reasons described below, we institute *inter partes* review of all the challenged claims, and grant Petitioner's Motion for Joinder.

B. Related Proceedings

Petitioner informs us that the '610 patent is involved in a number of related matters. *See* Paper 5, 1–2.

C. Asserted Grounds of Unpatentability

Petitioner challenges claims 1, 2, 6, 8–14, 16, and 18 of the '610 patent on the following grounds:

Reference(s)	Basis	Challenged Claim(s)
Vishwanath[1]	§ 102	1, 6, 9, and 16
Vishwanath	§ 103(a)	1, 6, 9, and 16
Vishwanath and Ishii[2]	§ 103(a)	14
Vishwanath and Kalra[3]	§ 103(a)	2, 8, 10–13, and 18

Pet. 6

II. DISCUSSION

A. Institution of Inter Partes Review

In its Motion for Joinder, Petitioner represents that this Petition "is substantively identical to the DISH Petition, containing only minor differences related to the formalities required by a different party filing the petition." Paper 3, 5. Petitioner, therefore, represents that this Petition and the DISH IPR petition "involve[] the same patent, challenges the same claims, relies on the same expert declaration, and is based on the same grounds and combinations of prior art." *Id*. at 4–5. Our independent review of the Petition and the DISH IPR petition confirms Petitioner's representations.

The DISH IPR petition was filed on July 3, 2018, challenging claims 1, 2, 6, 8–14, 16, and 18 of the '610 patent on the same grounds raised in this Petition. *See* DISH IPR, Paper 9, 4. Patent Owner filed a preliminary

[1] U.S. Pat. No. 6,216,157 (issued April 10, 2001) (Ex. 1004, "Vishwanath").
[2] U.S. Pat. No. 5,675,789 (issued Oct. 7, 1997) (Ex. 1005, "Ishii").
[3] U.S. Pat. No. 5,953,506 (issued Sept. 14, 1999) (Ex. 1006, "Kalra").

response to the DISH IPR petition on November 8, 2018. *Id.* at Paper 6 ("DISH IPR Prelim. Resp."). We instituted *inter partes* review based on the DISH IPR petition on January 31, 2019. *Id.* at Paper 9 ("DISH IPR Institution Decision"). Patent Owner filed a Response to the DISH IPR petition on March 21, 2019. *Id.*, Paper 15 ("DISH IPR Resp."). Patent Owner has not filed a Preliminary Response to this Petition.

Accordingly, upon our review of the Petition and for the reasons discussed above and in the DISH IPR Institution Decision, we are persuaded Petitioner has demonstrated a reasonable likelihood of success in showing the unpatentability of the challenged claims of the '610 patent on the same grounds raised and instituted in the DISH IPR. We, therefore, institute *inter partes* review based on the Petition.

B. Motion for Joinder

Joinder in *inter partes* reviews is governed by 35 U.S.C. § 315(c), which reads:

> 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 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 Kyocera Corp. v. SoftView LLC*, Case IPR2013-00004, slip op. at 4 (PTAB Apr. 24, 2013) (Paper 15).

We instituted the DISH IPR on January 31, 2019. *See* DISH IPR Institution Decision (Paper 9). Petitioner filed this Petition and Motion for Joinder on February 27, 2019, i.e., within one month of the institution date of the DISH IPR. *See* Papers 2 and 3. Thus, Petitioner timely filed its Motion for Joinder. *See* 37 C.F.R. § 42.122(b).

As discussed above, Petitioner represents that this Petition "is substantively identical to the DISH Petition, containing only minor differences related to the formalities required by a different party filing the petition." Paper 3, 5. Petitioner represents that this Petition "does not present any new grounds of unpatentability" that are not already present in the DISH IPR Petition. Paper 3, 6. Because this Petition is substantively identical to the DISH IPR Petition, Petitioner argues Patent Owner will not be required to present any additional responses or arguments. Petitioner argues "there is no reason to delay or alter the trial schedule already present in the DISH IPR" and represents that it "explicitly consents to the existing trial schedule." Paper 3, 6.

Moreover, Petitioner "agrees to take an 'understudy' role in the joined proceeding, absent termination of the original petitioner, DISH, as a party." Paper 3, 7. To that effect, Petitioner states that:

> (a) all filings by ARRIS in the joined proceeding be consolidated with the filings of the DISH, unless a filing solely concerns issues that do not involve DISH;
>
> (b) ARRIS shall not be permitted to raise any new grounds not already instituted by the Board, or introduce any argument or discovery not already introduced by DISH;
>
> (c) ARRIS shall be bound by any agreement between Patent Owner and DISH concerning discovery and/or depositions; and
>
> (d) ARRIS at deposition shall not receive any direct, cross examination or redirect time beyond that permitted for DISH in

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