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Paper 10
Entered: April 3, 2017

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.

Case IPR2017-00417
Patent 8,718,158 B2

Before SALLY C. MEDLEY, KALYAN K. DESHPANDE, and TREVOR M. JEFFERSON, *Administrative Patent Judges*.

MEDLEY, *Administrative Patent Judge*.

DECISION
Institution of *Inter Partes* Review
37 C.F.R. § 42.108

Petitioner's Motion for Joinder
37 C.F.R. § 42.122(b)

I. INTRODUCTION

Comcast Cable Communications, L.L.C., Cox Communications, Inc., Time Warner Cable Enterprises L.L.C., Verizon Services Corp., and ARRIS Group, Inc. (collectively "Petitioner") filed a Petition for *inter partes* review of claims 1–30 of U.S. Patent No. 8,718,158 B2 (Ex. 1001, "the '158 patent"). Paper 1 ("Pet."). Concurrently with its Petition, Petitioner filed a Motion for Joinder with *Cisco Systems, Inc. v. TQ Delta, LLC*, Case IPR2016-01021 ("the Cisco IPR"). Paper 3 ("Mot."). Petitioner represents that the petitioners in the Cisco IPR—Cisco Systems, Inc. and DISH Network, L.L.C.[1]—do not oppose the Motion for Joinder. Mot. 1. TQ Delta, LLC ("Patent Owner") submits that it does not oppose joinder. *See* Paper 9. Patent Owner also elected to waive its Preliminary Response. *Id.*

For the reasons explained below, we institute an *inter partes* review of claims 1–30 of the '158 patent and grant Petitioner's Motion for Joinder.

II. RELATED PROCEEDINGS

Petitioner and Patent Owner identify several pending judicial matters as relating to the '158 patent. Pet. 2–3; Mot. 2–3; Paper 6, 2–4.

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[1] DISH Network, L.L.C., who filed a Petition in IPR2017-00255, has been joined as a petitioner in the Cisco IPR.

In the Cisco IPR, we instituted an *inter partes* review of claims 1–30 of the '158 patent on the following grounds:

References	Basis	Claims
Shively[2] and Stopler[3]	§ 103(a)	1, 2, 4, 15, 16, and 18
Shively, Stopler, and Gerszberg[4]	§ 103(a)	3, 5, 14, 17, 19, and 28–30
Shively, Stopler, and Bremer[5]	§ 103(a)	6, 9, 10, 12, 20, 23, 24, and 26
Shively, Stopler, Bremer, and Gerszberg	§ 103(a)	8, 11, 13, 22, 25, and 27
Shively, Stopler, Bremer, and Flammer[6]	§ 103(a)	7 and 21

Cisco Systems, Inc. v. TQ Delta, LLC, Case IPR2016-01021, slip op. at 20–21 (PTAB Nov. 4, 2016) (Paper 7) ("Cisco Dec.").

III. INSTITUTION OF *INTER PARTES* REVIEW

The Petition in this proceeding asserts the same grounds of unpatentability as the ones on which we instituted review in the Cisco IPR. *Compare* Pet. 13–62, *with* Cisco Dec. 20–21. Indeed, Petitioner contends that the Petition asserts only the grounds that the Board instituted in the Cisco IPR, there are no new arguments for the Board to consider, and Petitioner relies on the same exhibits and expert declaration as the Cisco IPR. Mot. 6.

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[2] U.S. Patent No. 6,144,696; issued Nov. 7, 2000 (Ex. 1011) ("Shively").
[3] U.S. Patent No. 6,625,219 B1; issued Sept. 23, 2003 (Ex. 1012) ("Stopler").
[4] U.S. Patent No. 6,424,646 B1; issued July 23, 2002 (Ex. 1013) ("Gerszberg").
[5] U.S. Patent No. 4,924,516; issued May 8, 1990 (Ex. 1017) ("Bremer").
[6] U.S. Patent No. 5,515,369; issued May 7, 1996 (Ex. 1019) ("Flammer").

For the same reasons set forth in our institution decision in the Cisco IPR, we determine that the information presented in the Petition shows a reasonable likelihood that Petitioner would prevail in showing that (a) claims 1, 2, 4, 15, 16, and 18 would have been obvious over Shively and Stopler, (b) claims 3, 5, 14, 17, 19, and 28–30 would have been obvious over Shively, Stopler, and Gerszberg, (c) claims 6, 9, 10, 12, 20, 23, 24, and 26 would have been obvious over Shively, Stopler, and Bremer, (d) claims 8, 11, 13, 22, 25, and 27 would have been obvious over Shively, Stopler, Bremer, and Gerszberg, and (e) claims 7 and 21 would have been obvious over Shively, Stopler, Bremer, and Flammer. *See* Cisco Dec. 7–20. Accordingly, we institute an *inter partes* review on the same grounds as the ones on which we instituted review in the Cisco IPR. We do not institute *inter partes* review on any other grounds.

IV. GRANT OF MOTION FOR JOINDER

The Petition and Motion for Joinder in this proceeding were accorded a filing date of December 5, 2016. *See* Paper 5. Thus, Petitioner's Motion for Joinder is timely because joinder was requested no later than one month after the institution date of the Cisco IPR, i.e., November 4, 2016.[7] *See* 37 C.F.R. § 42.122(b).

The statutory provision governing joinder in *inter partes* review proceedings is 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

[7] Because December 4, 2016 fell on a Sunday, the one-month date extended to the next business day, December 5, 2016. *See* 37 C.F.R. § 1.7.

> 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).

As noted, the Petition in this case asserts the same unpatentability grounds on which we instituted review in the Cisco IPR. *See* Mot. 6. Petitioner also relies on the same prior art analysis and expert testimony submitted by the Cisco Petitioner. *See id.* Indeed, the Petition is nearly identical to the petition filed by the Cisco Petitioner with respect to the grounds on which review was instituted in the Cisco IPR. *See id.* Thus, this *inter partes* review does not present any ground or matter not already at issue in the Cisco IPR.

If joinder is granted, Petitioner anticipates participating in the proceeding in a limited capacity absent termination of the Cisco Petitioner as a party. *Id.* at 7. Petitioner agrees to "assume a limited 'understudy' role" and "would only take on an active role if Cisco were no longer a party to the IPR." *Id.* Petitioner further represents that it "presents no new grounds for invalidity and its presence in the proceedings will not introduce any additional arguments, briefing or need for discovery." *Id.* Because Petitioner expects to participate only in a limited capacity, Petitioner submits that joinder will not impact the trial schedule for the Cisco IPR. *Id.* at 6–7.

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