

Paper No. _____

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

VERIZON SERVICES CORP. AND
VERIZON BUSINESS NETWORK SERVICES INC.
Petitioners

v.

STRAIGHT PATH IP GROUP, LLC
Patent Owner

Case IPR2015-01407
U.S. PATENT NO. 6,131,121
CLAIMS 3-4, and 6-14

Title: Point-to-Point Computer Network Communication Utility
Utilizing Dynamically Assigned Network Protocol Addresses

PETITIONERS' MOTION FOR JOINDER UNDER
35 U.S.C. § 315(c) AND 37 C.F.R. § 42.22 AND § 42.122(b)

I. INTRODUCTION

Petitioners Verizon Services Corp. and Verizon Business Network Services Inc. submit the present Motion for Joinder pursuant to 37 C.F.R. § 42.122(b), which authorizes the filing of a “motion under § 42.22, no later than one month after the institution date of any *inter partes* review for which joinder is requested.” 37 C.F.R. § 42.122(b). Petitioners submit that the present Motion for Joinder is timely filed because it is being filed no later than one month after institution of the *inter partes* review proceeding with which joinder is sought.

Petitioners hereby move for joinder of the present petition for *inter partes* review **IPR2015-01407** (the “PETITIONERS’ IPR”) with **IPR2015-00196** (the “LG IPR”), LG Electronics, Inc. (“LGE”), Toshiba Corp. (“Toshiba”), VIZIO, Inc. (“VIZIO”), and Hulu, LLC (“Hulu”) (collectively, “LG/Hulu”). The PETITIONERS’ IPR is identical to the LG IPR in all substantive respects, includes identical exhibits to the LG IPR, and relies upon the same expert declarant as the LG IPR. LG/Hulu does not oppose this motion, based on Petitioners’ and LG/Hulu’s agreement that LG/Hulu will continue to maintain the lead role in the proceedings so long as LG/Hulu are parties.

II. BACKGROUND AND RELATED PROCEEDINGS

The PETITIONERS’ IPR and the LG IPR are among a family of *inter partes* review proceedings relating to U.S. Patent Nos. 6,108,704 and 6,131,121 that have

been asserted by Straight Path IP Group, LLC (“Straight Path”) against numerous defendants.

The complaint in *Straight Path IP Group, Inc. v. Verizon Communications, Inc.*, Civ. No. 1:14-cv-07798 (S.D.N.Y.), was first served on October 2, 2014. Accordingly, all petitions for *inter partes* review that have been filed by Petitioners are timely as prescribed by 35 U.S.C. § 315(b). Further, neither Petitioner has filed a civil action challenging the validity of a claim of the ’121 patent.

Currently, the family of *inter partes* review proceedings relating to the above identified Straight Path patents consists of the following proceedings that involve Petitioners and LG/Hulu:

PETITIONERS’ IPRs			LG IPRs		
Patent	Reference	Filed	Reference	Filed	Claims in IPR
6,108,704	IPR2015-01406	6/15/2015	2015-00209	10/31/2014	1, 11-12, 14, 16, 19, 22-23, 27, 30-31
6,131,121	IPR2015-01407	6/15/2015	2015-00196	10/31/2014	3-4, 6-14

In addition to the present Motion for Joinder, Petitioners are presently filing Motions for Joinder for the other above-mentioned Petitioners’ petitions with the corresponding petitions filed by LG/Hulu, subject to the same conditions sought by this motion. LG/Hulu does not oppose the motions.

III. DISCUSSION

If the Director institutes an *inter partes* review, Petitioners respectfully requests that the Board exercise its discretion to grant joinder of the PETITIONERS' IPR and LG IPR proceedings pursuant to 35 U.S.C. § 315(c), 37 C.F.R. § 42.22, and 37 C.F.R. § 42.122(b). In support of this motion, Petitioners propose consolidated filings and other procedural accommodations designed to streamline the proceedings.

1. Reasons Joinder Is Appropriate

Joinder is appropriate in this case because it is the most expedient way to secure the just, speedy, and inexpensive resolution of the related proceedings. *See* 35 U.S.C. § 316(b); 37 C.F.R. § 42.1(b). Intentionally, the PETITIONERS' IPR is substantively identical to the corresponding LG IPR in an effort to avoid multiplication of issues before the Board. Given the duplicative nature of these petitions, joinder of the related proceedings is appropriate. As discussed below, Petitioners will agree to consolidated filings and discovery, and procedural concessions, which LG/Hulu does not oppose and which do not prejudice Straight Path.

a. Substantively Identical Petitions

Petitioners represent that the PETITIONERS' IPR is identical to the LG IPR in all substantive respects. It includes identical grounds, analysis, and exhibits, and relies upon the same expert declarant and declaration as the LG IPR. The only

differences are in the introduction section, to identify the correct set of Petitioners, and in the mandatory notices section. Accordingly, if instituted, maintaining the PETITIONERS' IPR proceeding separate from that of the LG IPR would entail needless duplication of effort.

b. Consolidated Filings and Discovery

Because the grounds of unpatentability in the PETITIONERS' IPR and LG IPR are the same, the case is amenable to consolidated filings. Petitioners will agree to consolidated filings for all substantive papers in the proceeding (*e.g.*, Reply to the Patent Owner's Response, Opposition to Motion to Amend, Motion for Observation on Cross Examination Testimony of a Reply Witness, Motion to Exclude Evidence, Opposition to Motion to Exclude Evidence and Reply). Specifically, Petitioners will agree to incorporate its filings with those of LG/Hulu in a consolidated filing, subject to the ordinary rules for one party on page limits. LG/Hulu and Petitioners will be jointly responsible for the consolidated filings.

Petitioners agree not to advance any arguments separate from those advanced by Petitioner and LG/Hulu in the consolidated filings. These limitations avoid lengthy and duplicative briefing. Petitioners also agree that, so long as LG/Hulu are parties, LG/Hulu will maintain the lead role in the proceedings.

Consolidated discovery is also appropriate given that Petitioners and LG/Hulu are using the same expert declarant who has submitted the same, identical

declaration in the two proceedings. Petitioners and LG/Hulu will designate an attorney to conduct the cross-examination of any given witness produced by Straight Path and the redirect of any given witness produced by Petitioners or LG/Hulu within the time frame normally allotted by the rules for one party. Petitioners and LG/Hulu will not receive any separate cross-examination or redirect time.

Petitioners will agree to the foregoing conditions regarding consolidated filings and discovery even in the event other IPRs filed by other, third-party petitioners are joined with the LG IPR.

2. No New Grounds of Unpatentability

The PETITIONERS' IPR raises no new grounds of unpatentability from those of the LG IPR because, in fact, the petitions are identical.

3. No Impact on IPR Trial Schedule

The small difference between the filing date of the PETITIONERS' IPR and the LG IPR is without consequence should the proceedings be joined. The trial schedule for the LG IPR would not need to be delayed to effect joinder based on Straight Path's preliminary response and the later-filed PETITIONERS' IPR. The joint proceeding would allow the Board and parties to focus on the merits in one consolidated proceeding without unnecessary duplication of effort, and in a timely manner.

4. Briefing and Discovery Will Be Simplified

Joinder will simplify briefing and discovery because Petitioners seek an order similar to that issued in *Motorola Mobility LLC v. Softview LLC*, IPR2013-00256 (PTAB June 20, 2013) (Paper 10). As discussed above, Petitioners and LG/Hulu will engage in consolidated filings and discovery, subject to the understanding that LG/Hulu will maintain the lead role in the proceedings so long as LG/Hulu are parties, which will simplify the briefing and discovery process.

5. No Prejudice to Straight Path if Proceedings Are Joined

Petitioners propose joinder to streamline the proceedings and reduce the costs and burdens on the parties. Petitioners believe joinder will achieve these goals for several reasons. First, joinder will most certainly decrease the number of papers the parties must file, by eliminating a duplicative proceeding. Second, joinder will also reduce by half the time and expense for depositions and other discovery that would otherwise be required in separate proceedings. Third, joinder creates case management efficiencies for the Board and parties without any prejudice to Straight Path.

Moreover, joinder will reduce risk of prejudice to Petitioners. Although LG/Hulu is currently pursuing its challenge of the '121 patent through the LG IPR, 35 U.S.C. § 317 affords LG/Hulu the opportunity to withdraw from the proceeding through settlement with Straight Path and permits the Board to thereafter terminate

the proceeding if “no petitioner remains in the inter partes review.” *See* 35 U.S.C. § 317. Accordingly, joinder of Petitioners to the LG IPR would permit Petitioners to maintain their ongoing interests in the Board’s review of the ’121 patent in the case of such a settlement. Because allowing Petitioners to join the LG IPR would not substantively affect the complexity or timing of that proceeding, as described previously, the maintenance of Petitioners’ legitimate and ongoing interests in the Board’s review of the ’121 patent makes joinder appropriate.

IV. PROPOSED ORDER

Petitioners propose a joinder order for consideration by the Board as follows, which LG/Hulu does not oppose:

- The PETITIONERS’ IPR will be instituted and will be joined with the LG IPR on the same grounds as those for which the LG IPR has been instituted.
- The scheduling order for the LG IPR will apply to the joined proceeding, and LG/Hulu will maintain the lead role in the proceedings so long as they are parties.
- Throughout the proceeding, LG/Hulu and Petitioners will file papers as consolidated filings, except for motions that do not involve the other party, in accordance with the Board’s established rules regarding page limits. So long as they both continue to participate in the merged proceeding, LG/Hulu and Petitioners will identify each such filing as a Consolidated Filing and will be

responsible for completing all consolidated filings. Petitioners agree not to advance any arguments separate from those advanced by Petitioners and LG/Hulu in the consolidated filings so long as LG/Hulu remain parties.

- In consultation with Petitioners, LG/Hulu will designate an attorney to conduct the cross examination of any given witness produced by Straight Path and the redirect of any given witness produced by LG/Hulu or Petitioners within the time frame normally allotted by the rules for one party. LG/Hulu and Petitioners will not receive any separate cross-examination or redirect time.
- Straight Path will conduct any cross examination of any given witness jointly produced by LG/Hulu or Petitioners and the redirect of any given witness produced by Straight Path within the time frame normally allotted by the rules for one cross-examination or redirect examination.
- LG/Hulu and Petitioners will coordinate their presentation at the oral hearing.
- Petitioners will assume a second-chair role as long as LG/Hulu remain in the proceedings.

V. CONCLUSION

For the foregoing reasons, Petitioners respectfully requests that the Board grant joinder of the PETITIONERS' IPR and LG IPR proceedings.

Dated: June 15, 2015

Respectfully submitted,

/Rajeev Gupta/

Rajeev Gupta, Reg. No. 55,873

Darren M. Jiron, Reg. No. 45,777

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

901 New York Ave., NW

Washington, D.C. 20001-4413

Telephone: 202-408-4000

Facsimile: 202-408-4400

CERTIFICATE OF SERVICE

I certify that on June 15, 2015, I caused a copy of this PETITIONERS' MOTION FOR JOINDER UNDER 35 U.S.C. § 315(c) AND 37 C.F.R. § 42.22 AND § 42.122(b) to be served via FedEx Overnight upon the attorneys of record for the Patent Owner at the following address:

DAVIDSON BERQUIST JACKSON & GOWDEY LLP
8300 Greensboro Dr, Suite 500
McLean VA 22102

William Meunier
Matthew Durell
MINTZ, LEVIN, COHEN, FERRIS, GLOVSKY AND POPEO, P.C.
One Financial Center
Boston, Massachusetts 02111
wameunier@mintz.com
mdurell@mintz.com
StraightPathIPRs@mintz.com

Dated: June 15, 2015

Respectfully submitted,

/Rajeev Gupta/

Rajeev Gupta, Reg. No. 55,873
Darren M. Jiron, Reg. No. 45,777
FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.
901 New York Ave., NW
Washington, D.C. 20001-4413
Telephone: 202-408-4000
Facsimile: 202-408-4400