

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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CENTRAL SECURITY GROUP – NATIONWIDE, INC.,  
Petitioner,

v.

UBIQUITOUS CONNECTIVITY, LP,  
Patent Owner.

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IPR2019-01609  
Patent 8,064,935 B2

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Before JEAN R. HOMERE, JOHN F. HORVATH, and  
MELISSA A. HAAPALA, *Administrative Patent Judges*.

HORVATH, *Administrative Patent Judge*.

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

Granting Motion for Joinder  
35 U.S.C. § 315(c); 37 C.F.R. § 42.122

## I. INTRODUCTION

### A. Background

Central Security Group – Nationwide, Inc. (“Petitioner”) filed a Petition requesting *inter partes* review of claims 1–22 (“the challenged claims”) of U.S. Patent No. 8,064,935 B2 (Ex. 1001, “the ’935 patent”). Paper 2 (“Pet.”). Concurrently, Petitioner filed a Motion for Joinder seeking to join Petitioner as a party to *Resideo Technologies, Inc. v. Ubiquitous Connectivity, LP*, IPR2019-01335 (PTAB) (“the *Resideo* IPR”). Paper 3 (“Mot.”). Ubiquitous Connectivity, LP (“Patent Owner”) filed a Preliminary Response to the Petition (Paper 9, “Prelim. Resp.”) and an Opposition to the Motion for Joinder (Paper 10, “Opp.”). We have jurisdiction under 35 U.S.C. § 6.

For the reasons discussed below, we institute *inter partes* review of all challenged claims, and grant Petitioner’s Motion for Joinder.

### B. Real Parties in Interest

Petitioner identifies itself and Guardian Security Systems, Inc., CSG Holdco, Inc., Central Security Group Holdings, Inc., Central Security Group Holdco, Inc., and Central Security Group, Inc. as the real parties-in-interest. Pet. 1. Patent Owner identifies itself as the real party-in-interest. Paper 7, 1.

### C. Related Matters

Petitioner and Patent Owner identify *Ubiquitous Connectivity, LP v. Central Security Group – Nationwide, Inc.*, 4:18-cv-00368 (N.D. OK), *Ubiquitous Connectivity, LP v. City of San Antonio d/b/a CPS Energy*, 5:18-cv-00718 (W.D. TX), and *Ubiquitous Connectivity, LP v. TXU Energy Retail Company LLC*, 6:17-cv-00433 (E.D. TX) as district court proceedings that can affect or be affected by this proceeding, and Patent Owner further

identifies *Ubiquitous Connectivity, LP v. TXU Energy Retail Co.*, 3:18-cv-02084 (N.D. Tex.). Pet. 1; Paper 7, 1.

Petitioner and Patent Owner identify *Resideo Technologies, Inc. v. Ubiquitous Connectivity, LP*, IPR2019-01335 (PTAB 2019), and *Resideo Technologies, Inc. v. Ubiquitous Connectivity, LP*, IPR2019-01336 (PTAB 2019) and *Central Security Group – Nationwide, Inc. v. Ubiquitous Connectivity, LP*, IPR2019-01610 (PTAB 2019) (both challenging related U.S. Patent No. 9,602,655 B2) as *inter partes* reviews that can affect or be affected by this proceeding. Pet. 1; Paper 7, 1–2.

Patent Owner identifies Application No. 16/503,883 as a pending application that can affect or be affected by this proceeding. Paper 7, 2.

*D. Evidence<sup>1</sup>*

Reference		Effective Date	Exhibit
Oinonen	US 6,275,710 B1	Aug. 14, 2001	1016
Bielski <sup>2</sup>	EP 1391861 A2	Feb. 25, 2004	1017
Chi-Hsiang Wu and Rong-Hong Jan, <i>System integration of WAP and SMS for home network system</i> , 42 Computer Networks 493–502 (2003) (“Wu”)		July 15, 2003 <sup>3</sup>	1018
Sears	US 2002/0069263 A1	June 6, 2002	1019
Menard	US 2002/0177428 A1	Nov. 28, 2002	1020
Antila	US 6,583,770 B1	June 24, 2003	1021

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<sup>1</sup> Petitioner also relies upon the Declarations of Kevin Jeffay (Ex. 1003) and Rupert Lee (Ex. 1028).

<sup>2</sup> Bielski is a certified translation of a European Patent Application originally published in German. *See* Ex. 1017, 20–39.

<sup>3</sup> Petitioner relies upon the Lee Declaration to establish the public availability of Wu on the effective date. *See* Pet. 12.

Reference		Effective Date	Exhibit
Ehlers	US 2004/0117330 A1	July 28, 2003 <sup>4</sup>	1022
Whitley	WO 99/49680	Sept. 30, 1999	1023

### *E. Asserted Grounds*

Petitioner asserts the challenged claims are unpatentable on the following grounds:

Claim(s) Challenged	35 U.S.C. §	Reference(s)/Basis
1–3, 7, 11–15, 17–19, 21	103(a)	Oinonen, Whitley
4–6, 16	103(a)	Oinonen, Whitley, Sears
8	103(a)	Oinonen, Whitley, Antila
9, 10	103(a)	Oinonen, Whitley, Antila, Ehlers
20, 22	103(a)	Oinonen, Whitley, Menard
1–4, 7–9, 11–15, 17–19, 21	103(a)	Bielski, Wu
5, 6, 16	103(a)	Bielski, Wu, Sears
10	103(a)	Bielski, Wu, Ehlers
20, 22	103(a)	Bielski, Wu, Menard

## II. ANALYSIS

### *A. Institution of Inter Partes Review*

Petitioner avers that the “Petition is materially the same as the petition filed in the [*Resideo* IPR].” Mot. 1. That is, Petitioner avers that the Petition “challenge[s] the same claims, on the same grounds and rel[ies] on the same prior art and evidence, including an identical declaration from the same expert.” *Id.* Our independent review of the Petition, the petition filed in the *Resideo* IPR, and the evidence relied on in both petitions, confirm

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<sup>4</sup> Petitioner relies on the filing date of Ehlers to establish its availability as prior art under 35 U.S.C. § 102(e). *See* Pet. 14.

Petitioner's representations. *Compare* Pet. 3–83, with *Resideo* IPR, Paper 2 at 3–85.

Patent Owner filed a preliminary response to the petition filed in the *Resideo* IPR on October 28, 2019. *Resideo* IPR, Paper 6, 62. Patent Owner filed a Preliminary Response to the instant Petition on January 3, 2020. Paper 9, 62. Based on our independent review, Patent Owner's Preliminary Response raises the same arguments for patentability that were raised in the preliminary response to the petition filed in the *Resideo* IPR. *Compare* Prelim. Resp. 1–62, with *Resideo* IPR, Paper 6, 1–62.

We instituted *inter partes* review of claims 1–22 of the '935 patent based on the petition filed in the *Resideo* IPR on January 27, 2020. *Resideo* IPR, Paper 7. For the same reasons discussed in our Decision on Institution in the *Resideo* IPR, we find Petitioner has demonstrated a reasonable likelihood of showing at least one claim of the '935 patent is unpatentable. *See id.* We, therefore, grant the Petition and institute *inter partes* review of all challenged claims on all grounds raised.

#### *B. Motion for Joinder*

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

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.

Procedurally, a motion for joinder must be filed “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) (2019). Moreover, as suggested in

*Kyocera Corp. v. SoftView LLC*, IPR2013-00004, Paper 15 at 4 (PTAB Apr. 24, 2013), to ensure the just, speedy, and inexpensive resolution of every proceeding, 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.

Petitioner filed its Motion for Joinder on September 13, 2019, prior to our January 27, 2020 decision granting review of the '935 patent in the *Resideo* IPR that Petitioner seeks to join. Mot. 10; *Resideo* IPR, Paper 7. Nonetheless, Petitioner's Motion for Joinder asks that any "action on this motion be held in abeyance until, and the motion be granted only if, an IPR is instituted in the [*Resideo* IPR]." *Id.* at 1.

Petitioner argues its Motion for Joinder should be granted for several reasons. First, Petitioner argues the "Petition introduces identical arguments and the same grounds raised in the [*Resideo* IPR]," and the Board "routinely grants motions for joinder where the party seeking joinder introduces identical arguments and the same grounds raised in an existing proceeding." *Id.* at 4–5 (quoting *Samsung Elecs. Co., Ltd. v. Raytheon Co.*, IPR2016-00962, Paper 12 at 9 (PTAB Aug. 24, 2016)). Second, Petitioner argues joinder will not impact the trial schedule of the *Resideo* IPR because the Petition "does not seek to broaden the scope of the [*Resideo* IPR]," and Petitioner "explicitly consents to the trial schedule as adopted in the [*Resideo* IPR]." *Id.* at 6–7. Third, Petitioner argues Patent Owner will not be prejudiced by joinder because "the issues presented in the present Petition are identical to the issues presented in the [*Resideo* IPR]." *Id.* at 7. Lastly, Petitioner argues briefing and discovery in the *Resideo* IPR will not become

unduly burdensome because Petitioner “explicitly agrees to take an ‘understudy’ role.” *Id.* Specifically, Petitioner agrees that as long as Resideo remains a party to the *Resideo* IPR, Petitioner will (a) consolidate its filings with Resideo, (b) not introduce any argument or evidence not introduced by Resideo, (c) be bound by any discovery agreement between Resideo and Patent Owner, and (d) not receive any direct, cross, or redirect time beyond that permitted by 37 C.F.R. § 42.53 or agreed to by Resideo and Patent Owner. *Id.* at 7–8.

Patent Owner argues Petitioner’s Motion for Joinder should be denied for several reasons. First, Patent Owner argues the Motion is untimely because it was filed prior to a decision on institution in the *Resideo* IPR. Opp. 1–4. Specifically, Patent Owner argues that, based on 35 U.S.C. § 315(c) and 37 C.F.R. § 42.122(b), “a request for joinder is appropriate only if a decision granting institution has been entered in the *inter partes* review for which joinder is requested.” *Id.* at 1–2 (*quoting Linear Tech. Corp. v. In-Depth Test LLC*, IPR2015-01994, Paper 7 at 4 (PTAB Oct. 20, 2015)). Second, Patent Owner argues “the Petition does not warrant institution for at least the reasons discussed in Patent Owner’s Preliminary Response.” *Id.* at 4. Third, Patent Owner argues the Motion should be denied because “[t]he *General Plastic*<sup>[5]</sup> factors . . . weigh against granting Petitioner’s motion” and Petitioner fails to “address the *General Plastic* factors or otherwise explain its two-month delay in filing its Petition after the virtually identical Petition in the [*Resideo* IPR] was filed on July 15, 2019.” *Id.* at 5.

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<sup>5</sup> *General Plastic Indus. Co. v. Canon Kabushiki Kaisha*, IPR2016-01347, Paper 19 (PTAB Sept. 6, 2017).

Upon considering the arguments and evidence presented by Petitioner and Patent Owner, we are persuaded that it is appropriate under the circumstances to join Petitioner to the *Resideo* IPR. The parties agree that the Petition challenges the same claims challenged in the *Resideo* IPR on the same grounds using the same prior art. *See* Mot. 1 (“The Petition and the petition in the [*Resideo* IPR] challenge the same claims, on the same grounds[,] and rely on the same prior art and evidence.”); Opp. 3 (“Indeed, the two Petitions raise the same challenges to the same ’935 patent claims.”). Moreover, Petitioner avers it will take an “understudy” role in the *Resideo* IPR by consolidating all filings, refraining from advancing new arguments, binding itself to any discovery agreements, and limiting its deposition time to the time already allotted. *See* Mot. 6–8. Thus, joinder would result in the just, speedy, and inexpensive resolution of the instant Petition as well as the petition filed in the *Resideo* IPR. *See* 37 C.F.R. § 42.1(b).

We are not persuaded that the Petition and Motion for Joinder should be denied based on the arguments raised in Patent Owner’s Preliminary Response for the reasons explained in our Decision on Institution in the *Resideo* IPR. *See Resideo* IPR, Paper 7. We are also not persuaded that the Petition and Motion for Joinder should be denied because Petitioner failed to address the *General Plastic* factors. Indeed, as noted in Petitioner’s Motion for Joinder, the *General Plastic* factors are not particularly relevant “where a different petitioner files a ‘me-too’ or ‘copycat’ petition in conjunction with a timely motion to join.” Mot. 5 (*quoting Celltrion, Inc. v. Genentech, Inc.*, IPR2018-01019, Paper 11 at 9–11 (PTAB Oct. 30, 2018)).

Lastly, we are not persuaded that the Motion for Joinder should be denied as untimely. The only timing requirement for a motion for joinder is that it be filed “*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) (2012) (emphasis added). The Motion for Joinder, which was filed *before* institution of the *Resideo* IPR, complies with this rule. Moreover, the Motion for Joinder was filed *conditionally*, with Petitioner expressly requesting “action on this motion be held in abeyance until, and . . . only if, an IPR is instituted in the [*Resideo* IPR].” Mot. 1. Patent Owner cites *Linear Tech* for the proposition that a motion for joinder should be denied when it seeks to join a proceeding that has yet to be instituted. Opp. 1-2. Although the Board in *Linear Tech* did deny as premature a motion for joinder filed prior to institution of the case to which joinder was sought, the Board authorized the petitioner to file a renewed motion for joinder should that case be subsequently instituted. *See Linear Tech.*, Paper 7 at 4–5. Here, because Petitioner asked us to consider its Motion for Joinder only if we instituted the *Resideo* IPR, we were able to decide the merits of the Petition and Motion for Joinder *after* instituting review in the *Resideo* IPR, thereby averting the need to deny the Motion for Joinder and have Petitioner refile it.

Accordingly, for the reasons discussed above, we find that joining Petitioner to the *Resideo* IPR is appropriate under the present circumstances and *grant* Petitioner’s Motion for Joinder.

### III. ORDER

In consideration of the foregoing, it is hereby:

ORDERED that *inter partes* review is instituted in IPR2019-01609;

FURTHER ORDERED that the Motion for Joinder with IPR2019-01335 is *granted*, and Petitioner is joined as a petitioner in IPR2019-01335;

FURTHER ORDERED that all further filings shall be made in IPR2019-01335 and a copy filed in IPR2019-01609;

FURTHER ORDERED that Petitioner shall file each paper due in IPR2019-01335, except for a paper that does not involve Resideo, as a consolidated filing with Resideo;

FURTHER ORDERED that, Petitioner may not file any paper in addition to the consolidated paper filed in IPR2019-01335 absent prior authorization from the Board;

FURTHER ORDERED that Petitioner and Resideo shall collectively designate attorneys to conduct the cross-examination of any witness produced by Patent Owner and the redirect of any witness produced by Resideo, within the timeframes set forth in 37 C.F.R. § 42.53(c) or agreed to by the parties;

FURTHER ORDERED that Petitioner and Resideo shall collectively designate attorneys to present at the oral hearing, if requested and scheduled, in a consolidated argument;

FURTHER ORDERED that the case caption in IPR2019-01335 shall be changed to reflect joinder of Central Security Group – Nationwide, Inc. as a petitioner in accordance with the attached example; and

FURTHER ORDERED that a copy of this Decision shall be entered into the record of IPR2019-01335.

IPR2019-01609  
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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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RESIDEO TECHNOLOGIES, INC. and  
CENTRAL SECURITY GROUP – NATIONWIDE, Inc.,<sup>6</sup>  
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IPR2019-01335  
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<sup>6</sup> Central Security Group – Nationwide, Inc., who filed a petition in IPR2019-01609, has been joined as a petitioner to this proceeding.