UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE PATENT TRIAL AND APPEAL BOARD

COMMSCOPE, INC.
Petitioner

v.

TQ DELTA, LLC,
Patent Owner

Case: IPR2023-00064
Patent No. 8,276,048

RESPONSE TO PETITIONER'S MOTION FOR JOINDER

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I. Introduction

Patent Owner TQ Delta, LLC ("TQ Delta" or "Patent Owner") submits this Response in opposition to the Motion filed by CommScope, Inc. ("CommScope" or "Petitioner") to join its "copycat" petition with the *Nokia of American Corp. v. TQ Delta, LLC* proceedings in IPR2022-00666.

The Board should deny the Petitioner's Motion. CommScope undisputedly cannot seek review on its own under Section 315(b)'s one-year bar: CommScope already had its day in court with the '048 Patent in Delaware—the suit began in 2014 (and CommScope lost at trial on the '048 Patent in 2019). CommScope does not provide any compelling reason that the Board should grant joinder in view of that one-year bar. The facts show that joinder is not appropriate. In the Texas Proceedings, CommScope is asserting invalidity using on the same base references—Mazzoni and Fadavi-Ardekani—that are at issue in the -666 proceeding. The Texas jury trial is set for March 2023, and joinder would give CommScope yet another bite at the validity apple after choosing not to file a timely Petition for *Inter Partes* Review.

The only result of joinder would be a full end-run around the one-year bar, especially in light of CommScope's 2019 trial-loss on the '048 Patent. TQ Delta and

petitioner Nokia[1] have settled their disputes and will shortly request authorization to file a joint request to terminate the -666 proceeding, which remains in its early stages. Thus, while CommScope based its request on a "copycat" petition and a "silent understudy" role, the practical impact will be that CommScope will be the lead and only party prosecuting the proceeding—after losing validity in District Court on the same base references and choosing to not challenge the '048 Patent before the Board for almost nine years. That is not an efficient or proper use of the *Inter Partes* Review procedure; it is abuse. TQ Delta thus respectfully requests that the Board deny CommScope's Motion.

II. Factual Background

A. The Delaware Litigation Against CommScope's Subsidiary 2Wire Began Nearly Nine Years Ago

In Delaware, in February 2014, TQ Delta served 2Wire and Pace Americas, LLC (formerly known as Pace Americas, Inc.), and Pace plc with a complaint alleging infringement of the '048 Patent. *See* IPR2022-00666, Ex. 2001 and 2002. At the time, 2Wire was a wholly-owned subsidiary of Pace plc. IPR2022-00666, Ex. 2001 at ¶ 4. Since April 2019, 2Wire (which was merged into ARRIS Solutions, Inc.) and Pace Plc (which became ARRIS Global, Ltd.) have been owned by CommScope Holding Company, Inc. The Board concluded (in a related proceeding

[1] TQD notes that the '048 Patent was never asserted against Nokia in the Texas Proceeding.

involving another TQ Delta DSL Patent) that CommScope is a real-party-in-interest of 2Wire based on its acquisition of 2Wire. *CommScope, Inc. v. TQ Delta, LLC*, IPR2022-00352 (Paper 13) (P.T.A.B. Aug. 19, 2022). The Board found that Section 315(b) barred CommScope's petition in that proceeding.

The 2Wire Lawsuit is ongoing. The case was divided into different patent families for trial. IPR2022-00666, Ex. 1022, at 2–3. A trial on liability and validity for Family 3 (which included the '048 Patent) took place in May 2019, and the jury found that 2Wire (now part of CommScope) infringed claim 1 of the '048 Patent and that 2Wire failed to prove that that the claim was invalid. *See* IPR2022-00666, Ex. 2003 at 2. 2Wire raised the Mazzoni prior art reference at trial, and at summary judgment, the Court found no invalidity based on the Fadavi-Ardekani references (both references are at issue in the -666 proceeding CommScope seeks to join). A damages trial will be scheduled after all liability trials are completed. *See* IPR2022-00666, Ex. 2011.

B. The Texas Litigation Against CommScope and Nokia

On August 13, 2021, TQ Delta sued the "CommScope Defendants" (CommScope Holding Company, Inc., CommScope Inc., ARRIS International Limited, ARRIS Global Ltd., ARRIS US Holdings, Inc., ARRIS Solutions, Inc., ARRIS Technology, Inc., and ARRIS Enterprises) for infringement of several of its patents in Civil Action No. 2:21-cv-00310 (E.D. Tex.), including the '048 Patent.

IPR2022-00666, Ex. 1027. On that same day, TQ Delta also sued Nokia Corp., Nokia Solutions and Networks Oy, and Nokia of America Corp. for infringement of several of its patents in Civil Action No. 2:21- cv-00309 (E.D. Tex.), but did not assert the '048 Patent against Nokia. IPR2022-00666, Ex. 1026.

On October 22, 2021, the Texas Court consolidated both cases into Case No. 2:21-cv-00310 (the "Texas Lawsuit"). IPR2022-00666, Ex. 2008. Trial in the Texas Lawsuit is scheduled for March 2023. Early on, the Texas Court entered a case-management Order requiring a phased narrowing of claims, and TQ Delta's asserted claims against CommScope have only narrowed during the litigation. TQ Delta has elected to try claim 5 of the '048 Patent.

In Texas, CommScope has elected to pursue three invalidity combinations at trial: Mazzoni + VDSL1; Mazzoni + LB-031; and Fadavi-Ardekani + VDSL1. These are the same base references (Mazzoni and Fadavi-Ardekani) on which the -666 proceedings and CommScope's Petition rests.

On November 23, 2022, TQ Delta and Nokia informed the Texas Court that "all matters in controversy between the parties have been settled, in principle." *TQ Delta, LLC v. CommScope Holding Co.*, No. 2:21-CV-310-JRG (E.D. Tex. Nov. 23, 2022) (Dkt. 316). The parties, in view of the settlement, will promptly request authorization to file a joint motion to terminate the -666 proceeding.

C. The Nokia IPR Proceedings and CommScope's Petition

On March 4, 2022, Nokia filed the Petition in the -666 proceeding, seeking review based on Mazzoni and Fadavi-Ardekani (each in combination with a European version of the VDSL1). TQ Delta has never asserted the '048 Patent against Nokia. The Board instituted review, and credited Nokia's claim that it was not an RPI of CommScope for to the Petition. After institution, CommScope (the only party sued for infringing the '048 Patent) filed a "copycat" Petition seeking institution based on the same references as the Nokia Petition on October 26, 2022 with an accompanying motion to join the -666 proceeding as a "silent understudy."

As described above, Nokia and TQ Delta will request authorization to file a joint motion to terminate the -666 proceeding due to the settlement. The current deadline for the Patent Owner Response in the -666 proceeding is December 20, 2022. IPR2022-00666, Paper 11. Oral argument is set for June 27, 2023. *Id.*

III. Applicable Law

Section 315(c) provides that, if review is instituted, "the Director, in his or her discretion, may join as a party to that inter partes review[.]" Thus, while "[j]oinder may be authorized when warranted," the "decision to grant joinder is discretionary" by statute. *Code200, UAB v. Bright Data Ltd.*, IPR2021-01502 (Paper No. 13), at 8 (P.T.A.B. Mar. 14, 2022) (citing 35 U.S.C. § 315(c); 37 C.F.R. § 42.122); *id.* at 9 ("Section § 315(c) explicitly provides that joinder is discretionary.").

One of the factors to consider is the existence of a time-bar and, in general, joinder is only appropriate in "limited circumstances where fairness requires it and to avoid undue prejudice to a party."

> We conclude that the existence of a time bar is one of several factors that may be considered when exercising our discretion under § 315(c). In general, the Board will exercise this discretion only in limited circumstances where fairness requires it and to avoid undue prejudice to a party. Circumstances which may justify this narrow exercise of discretion may include, for example, actions taken by a patent owner in a co-pending litigation such as the late addition of new asserted claims. On the other hand, the Board does not generally expect fairness and prejudice concerns to be implicated, for example, where a petitioner merely corrects its mistakes or omissions.

Proppant Express Investments, LLC v. Oren Techs., LLC, IPR2018-00914 (Paper No. 38), at 16 (P.T.A.B. Mar. 13, 2019) (precedential), *overruled on other grounds*, *Facebook, Inc. v. Windy City Innovations, LLC*, 973 F.3d 1321, 1333 (Fed. Cir. 2020). In general, "[a] motion for joinder should: (1) set forth the reasons 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) addresses specifically how briefing and/or discovery may be simplified." *Kingston Tech. Co. v. SecureWave Storage Solutions, Inc.*, IPR2020-00139 (P.T.A.B. Mar. 23, 2020).

The burden is on CommScope to show that joinder is appropriate. 37 C.F.R. §§ 42.20(c), 42.112(b).

IV. The Board Should Deny CommScope's Joinder Motion

TQ Delta respectfully requests that the Board deny CommScope's Joinder Motion for the following reasons.

A. CommScope Does Not Show That Joinder Is Appropriate

CommScope sole argument for why joinder is appropriate is that it timely filed its motion and petition. Mot. at 4–5. But this is insufficient to show that joinder is appropriate here. CommScope does not dispute that its Petition is time-barred under Section 315(b)—both as a result of the complaint in *2Wire* case served almost a decade ago and the Texas case in which CommScope was served with a complaint in August, 2021 (approximately 14 months before CommScope's petition).[2] Mot. at 8–10. In this circumstance, the Board's precedential *Proppant* decision—which CommScope fails to address at all—explains that, "[i]n general, the Board will exercise this discretion only in limited circumstances where fairness requires it and to avoid undue prejudice to a party." *Proppant*, IPR2018-00914 (Paper No. 38) at 16. This is because, among other reasons, "[t]he one-year time limitation of § 315(b) is important to ensure 'quiet title to patent owners' and to prevent inter partes review from being 'used as [a] tool[] for harassment.' . . . Broadly exercising the discretion granted to the Director in § 315(c) could effectively circumvent the time limitation

[2] The Board held, for another TQ Delta patent asserted in the *2Wire* case, that the one-year bar applied to CommScope, resulting in denial of institution. *CommScope, Inc. v. TQ Delta, LLC*, IPR2022-00352 (Paper 13) (P.T.A.B. Aug. 19, 2022).

in § 315(b) in many cases. This would obviate the careful statutory balance." *Id.* at 18 (citation omitted); *see also* Trial Practice Guide at 77 (Nov. 2019) ("The conduct of the parties and attempts to game the system may also be considered. In this way, the Board can carefully balance the interest in preventing harassment against fairness and prejudice concerns. . . .") (emphasis added).

CommScope does not engage in that analysis in its Motion, but a proper analysis shows that joinder is inappropriate here.

1. Fairness Does Not Require Joinder, and CommScope Does Argue Otherwise

Fairness does not require joinder, and CommScope does not claim otherwise. CommScope does not point to a circumstance that could justify joinder. It does not claim that TQ Delta has taken an action in the Texas Court that could justify joinder, such as recently asserting new claims or taking some action that would prejudice CommScope if joinder were denied. CommScope instead asserts, under *Kingston* and the legislative history, that "the PTO anticipated that joinder would be granted as a matter of right in circumstances like those there." Mot. at 7–8. But the Board has expressly rejected that argument because it conflicts with the statute: "[A]lthough Petitioner cites *Kingston* and the AIA's legislative history to suggest that joinder should be permitted as a matter of right, we do not agree. Section § 315(c) explicitly provides that joinder is discretionary." *Code200*, IPR2021-01502 (Paper No. 13), at 8.

Indeed, this is a case in which joinder would be unfair and the Board should exercise its discretion to deny joinder. CommScope's only basis to challenge the '048 Patent in an *Inter Partes* Review proceeding is—despite losing a validity trial in Delaware and choosing not to file a timely Petition after getting sued twice—is Nokia's Petition. But TQ Delta and Nokia have resolved all of their disputes regarding the '048 Patent and will jointly contact the Board shortly for authorization to file a joint motion to terminate the IPR2022-00666 proceeding (in addition to all of the Nokia-initiated proceedings for TQ Delta's DSL-related patents). Because the proceeding remains in its early stages (the Patent Owner's Response deadline has not passed), TQ Delta expects that the Board will terminate the proceeding. PTAB Consolidated Trial Practice Guide, II(N) (Nov. 2019) (explaining that the Board "expects that a proceeding will terminate after the filing of a settlement agreement, unless the Board has already decided the merits of the proceeding"); *see also* 35 U.S.C. §§ 317(a), 327; *Commc'ns Test Design, Inc. v. Contec, LLC*, IPR2019-01669, Paper 14, at 3-4 (P.T.A.B. May 13, 2020) (granting joint motion to terminate after Board granted institution of review but before the proceeding had reached the first due date of the scheduling order because it was in the "early stage of the proceedings").

Thus, there will be no proceeding for CommScope to join and assume a "silent understudy role" to Nokia. Mot. at 6–7. If joined, CommScope instead will take the

lead (and only) role to prosecute in the *Inter Partes* Review in Nokia's absence—in a complete disregard of Section 315's one-year bar. Indeed, the Board has rejected a similar "silent understudy" argument because—in the event of a settlement—the joining party would be allowed to commit an end-run around the one-year bar and "stand in an continue a proceeding that would otherwise be terminated." *Apple Inc. v. Uniloc 2017 LLC*, IPR2020-00854, Paper 9 at 13 (P.T.A.B. Oct. 28, 2020) (precedential); *see also HTC Corp. v. Ancora Techs. Inc.*, IPR2021-00570, Paper 17 at 13 (P.T.A.B. June 10, 2021) ("[J]oinder in this circumstance would allow . . . HTC to continue a proceeding even after settlement with the primary petitioner, based on a second attempt by . . . HTC.").

While those cases involve a second petition (after the first petition was denied), the same reasoning applies here. Nokia has settled with TQ Delta. CommScope opted to not file a timely *Inter Partes* Review Petition (and waited over eight years since 2Wire was sued) and lost a validity trial on the same primary prior art raised here (upheld on post-trial review). But despite these choices, joinder would provide CommScope with yet another bite of the validity apple in this forum as the sole petitioner—as if the last decade never happened. And, at the same time, CommScope is challenging the '048 Patent in the Texas Court in a trial set for March

2023 on the same base Mazzoni and Fadavi-Ardekani references on which CommScope's Petition rests.[3]

CommScope does not allege that this repeat, untimely, and unending attack on TQ Delta's '048 Patent is fair. And it is not. It is an abuse of the patent system and weighs substantially for denial of CommScope's Motion. *See, e.g.*, *Micro Motion, Inc. v. Invensys Sys.*, IPR2014-01409, Paper 14, at 15 (P.T.A.B. Feb. 18, 2015) (when movant's petition "is admittedly time-barred under 35 U.S.C. 315(b)," it "weighs against joinder"); *Code200*, Paper 13 at 8 (refusing to join time-barred petition "because of prejudice to Patent Owner as well as Petitioner's unexplained delay in seeking inter partes review"); *Ubisoft, Inc. v. Uniloc USA, Inc.*, IPR2016-00414, Paper 16 at 5-7 (P.T.A.B. June 2, 2016) (holding that joinder of time-barred petition was not appropriate where petitioner had filed prior AIA petition raising "substantially identical" grounds).

2. Denying Joinder Will Not Unduly Prejudice CommScope, and CommScope Does Not Claim Otherwise

Denying joinder will not unduly prejudice CommScope, and it does not claim otherwise in its Motion. Again, in Texas, CommScope has raised invalidity

[3] CommScope claims in its Petition that it will file a stipulation regarding the district court action should the Board grant institution. Pet. at 71–72. But the deadline for the decision of whether to institute proceedings is months after the scheduled trial in the Texas Court. This timing makes CommScope's stipulation largely meaningless.

challenges to the ’048 Patent based on Mazzoni and Fadavi-Ardekani art underlying its petition. That case is set for trial in March 2023, months before an institution decision would be due on CommScope’s copycat petition. It is not undue prejudice to hold a patent defendant to its choice to not timely file an *Inter Partes* Review petition, which Section 315(b) bars, especially when that defendant intends to assert the same base references in an upcoming district court trial.

3. Granting Joinder Will Unduly Prejudice TQ Delta

Granting joinder will unduly prejudice TQ Delta. It will subject TQ Delta to another validity challenge by CommScope to the ’048 Patent, one that otherwise would be time-barred. *See, e.g.*, *Gen. Plastic Indus. Co. v. Canon Kabushiki Kaisha*, IPR2016-01357, Paper 19 at 17 (P.T.A.B. Sep. 6, 2017) (“[W]e . . . recognize the potential for abuse of the review process by repeated attacks on patents. . . . Multiple, staggered petitions challenging the same patent and same claims raise the potential for abuse.”).

Joinder will also unduly prejudice TQ Delta by frustrating TQ Delta’s settlement with Nokia. TQ Delta resolved its disputes with Nokia, and the parties will jointly move to terminate these *Inter Partes* Review proceedings. Joining CommScope would unduly prejudice TQ Delta by forcing it to undertake the expense that the Nokia settlement, in part, would avoid.

CommScope claims that TQ Delta will not face prejudice because CommScope's Petition is a "copycat" Petition that does not raise new issues. Mot. at 7; *see id.* at 5. But this argument proves too much. Joinder of issues is not allowed after the Federal Circuit's *Facebook* decision. 973 F.3d at 1332. And CommScope's claim that TQ Delta "need not expend any additional resources above and beyond those required in the current Nokia IPR" (Mot. at 7) is untrue in view of the Nokia settlement—joinder will require TQ Delta to expend resources to defend against a proceeding that Nokia and TQ Delta will have moved to terminate (and that CommScope was time-barred from seeking).

CommScope also claims that TQ Delta will not face prejudice in view of language from the decision in *Intel Corp. v. VLSI Tech. LLC*, IPR2022-00479, Paper 13 (P.T.A.B. June 6, 2022). Mot. at 10–11. But *Intel* was a different circumstance. Intel's first petition was denied under *Fintiv* and was not reviewed under the merits. Joinder here would result in unfairness and reward gamesmanship in a way that joinder in the *Intel* case did not.

TQ Delta will further be prejudiced by having to deal with the new discovery-related issues discussed above that would be created by joinder of CommScope, such as the real-party-interest issues raised below.

B. CommScope's Petition Will Impact The Schedule And Will Not Simplify Briefing And Discovery

Joinder will impact the schedule of the -666 proceeding and will not simplify briefing or discovery. For example, TQ Delta asserted that CommScope and Nokia were real-parties-in-interest and/or privies. Therefore, if CommScope is joined, TQ Delta will need to seek discovery from CommScope regarding its relationship with Nokia. *See, e.g.*, *ARM Ltd. v. AMD, Inc.*, IPR2018-01148, Paper 16 at 7 (P.T.A.B. Dec. 12, 2018) ("As a result of the request for joiner, [the original] and [joinder petitioners] are [RPIs] to the joined proceeding"); *Unified Patents Inc. v. CCation Techs., LLC*, IPR2015-01045, Paper 15 at 7 (P.T.A.B. Oct. 7, 2015) (denying joinder where it would add new RPI issues to the joined proceeding); *Unified Patents, Inc. v. Personalized Media Commc'ns, LLC*, IPR2015-00520, Paper 16 at 5 (P.T.A.B. June 8, 2015) ("[T]he potential for additional discovery [on RPI issues] . . . weighs in favor of denying [the] Motion for joinder.").

Moreover, the impact on the proceeding is not ameliorated by CommScope's assurances regarding its "understudy" role. With Nokia settled, CommScope will not be an understudy—it will take on the lead role as the only party prosecuting the proceedings, which will largely start afresh with Nokia terminated. And even if CommScope somehow could still be an "understudy," the cases CommScope cites address a different situation: the Patent Owner agreed to joinder under those terms. *See* Mot. at 6–7; *Mylan Pharm. Inc. v. Almirall*, LLC, IPR2019-01095, Paper 12 at

9 (P.T.A.B. Nov. 27, 2019); *Mylan Pharms. Inc. v. Novartis AG*, IPR2015-00268, Paper 17 at 5 (P.T.A.B. Apr. 10, 2015). TQ Delta does not agree to joinder, which further weighs against granting CommScope's motion. *See ZTE Corp. v. Adaptix, Inc.*, IPR2015-01184, Paper 10 at 6-7 (P.T.A.B. July 24, 2015) (referring to legislative history that identifies consent of the patent owner as a factor to consider on joinder).

V. Conclusion

TQ Delta respectfully requests that the Board deny Petitioner's Motion for Joinder.

Dated: November 25, 2022

Respectfully submitted,
THE DAVIS FIRM PC

By:/Christian J. Hurt/
Christian J. Hurt

CERTIFICATE OF SERVICE

I hereby certify that on November 25, 2022, a true copy of the following document(s):

PATENT OWNER TQ DELTA, LLC'S RESPONSE TO PETITIONER'S MOTION FOR JOINDER

was served via ***electronic mail*** to the address and parties as follows:

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A courtesy copy of Patent Owner TQ Delta, LLC's Response to Petitioner's Motion for Joinder was served on November 25, 2022, via electronic mail to the Petitioner Nokia as indicated below:

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I declare under penalty of perjury under the laws of the United States of America that the foregoing is true and correct. Executed on November 25, 2022 at Southlake, Texas.

/Christian J. Hurt/
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