**UNITED STATES PATENT AND TRADEMARK OFFICE**

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**BEFORE THE PATENT TRIAL AND APPEAL BOARD**

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COMMSCOPE, INC.
Petitioner

v.

TQ DELTA, LLC
Patent Owner

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U.S. Patent No. 7,836,381
Issue Date: November 16, 2010
Title: Computer Readable Medium With Instructions For Resource Sharing In A Telecommunications Environment

Case No. IPR2023-00066

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# PETITIONER'S MOTION FOR JOINDER UNDER 37 C.F.R. §§ 42.22 AND 42.122(b)

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# TABLE OF CONTENTS

**Page**

# TABLE OF AUTHORITIES

**Page(s)**

**Cases**

**Statutes**

## I. STATEMENT OF RELIEF REQUESTED

Petitioner CommScope, Inc. (hereinafter "CommScope" or "Petitioner") respectfully requests joinder of the concurrently filed petition for inter partes review of U.S. Patent No. 7,836,381 ("the '381 patent") (IPR2023-00066) with *Nokia of America Corp. v. TQ Delta, LLC*, IPR2022-00665, filed March 7, 2022 and instituted October 3, 2022 (hereinafter, the" Nokia IPR"). *See* IPR2022-00665, Paper 10. The grounds in the instant Petition—and evidence upon which they rely—are identical to the grounds in the Nokia IPR petition, which the Board found to present "a compelling unpatentability challenge." *Id.* at 7.

Further, if joined, CommScope will assume a "silent understudy" role. Thus, the proposed joinder will not complicate or delay the Nokia IPR in any manner, or prejudice the Patent Owner. Accordingly, CommScope respectfully requests that the Board institute Petitioner's IPR and grant this Motion for Joinder.

## II. BACKGROUND

On March 7, 2022, Nokia petitioned for IPR of the '381 patent. *Nokia of Am. Corp. v. TQ Delta, LLC*, IPR2022-00665, Paper 2 (PTAB Mar. 7, 2022). On October 3, 2022, the Board instituted the Nokia IPR.

The instant Petition is the same as the Nokia IPR: it involves the same patent, claims, grounds of unpatentability, and evidence. The instant Petition includes the expert declarations of Dr. Richard Wesel (Ex. 1003, "Wesel Decl.")

and Sylvia Hall-Ellis (Ex. 1033, "Hall-Ellis Decl."), which are identical to their declarations put forth in the Nokia IPR.

Patent Owner asserted the '381 patent against 2Wire, a predecessor entity to CommScope in *TQ Delta, LLC v. 2Wire, Inc.*, Case No. 1-13-cv-01835 (D. Del. Nov. 4, 2013) (the "Delaware Litigation"). In *CommScope, Inc. v. TQ Delta, LLC*, IPR2022-00352, Paper 13 (PTAB Aug. 19, 2022) the Board determined that 2Wire is a real party in interest to CommScope's '835 Patent IPR,

## III. LEGAL STANDARDS

The Leahy-Smith America Invents Act (AIA) permits joinder of inter partes review (IPR) proceedings under 35 U.S.C. § 315(c), which states:

> (c) JOINDER. – 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.

"In deciding whether to join a party to an inter partes review, § 315(c) requires 'two different decisions,' first 'whether the joinder applicant's petition for IPR warrants institution under § 314,' and then whether to 'exercise… discretion to decide whether to join as a party the joinder applicant.' *See Facebook, Inc. v.*

*Windy City Innov., LLC*, 973 F.3d 1321, 1332 (Fed. Cir. 2020). 'The statute makes clear that the joinder decision is made after a determination that a petition warrants institution, thereby affecting the manner in which an IPR will proceed.' *Id.* (citing *Thryv v. Click-to-Call Techs., LP*, 140 S. Ct. 1367, 1377 (2020))." *Intel Corp. v. VLSI Technology LLC*, IPR2022-00479, Paper 13 at 4 (P.T.A.B. June 6, 2022).

"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) address[] specifically how briefing and discovery may be simplified." *Kingston Tech.*, IPR2020-00139, Paper 12 at 6-7; *see also Hyundai Motor Co. v. Am. Vehicular Sciences LLC*, IPR2014-01543, Paper No. 11 at 3 (Oct. 24, 2014); *Macronix Int'l Co. v. Spansion*, IPR2014-00898, Paper 15 at 4 (Aug. 13, 2014); *Dell Inc. v. Network-1 Sec. Solutions, Inc*., IPR2013-00385, Paper 17 (PTAB July 29, 2013); *Kyocera Corporation v. Softview LLC*, IPR2013-00004, Paper 15 at 4 (April 24, 2013)).

Under 35 U.S.C. § 315(b), entities who would otherwise be time-barred may file IPR petitions with accompanying motions for joinder pursuant to § 315(c). Indeed, the Federal Circuit has recognized that "§ 315(b) includes a specific exception to the time bar." *Facebook, Inc. v. Windy City Innovations, LLC*, , 973 F.3d 1321, 1333 (Fed. Cir. March 18, 2020) (quoting 35 U.S.C. § 315(b))

(emphasis added). "Congress… demonstrated that it knew how to provide an exception to the time bar by including a second sentence in the provision: 'The time limitation set forth in the preceding sentence shall not apply to a request for joinder under subsection (c).'" *Click-To-Call Techs., LP v. Ingenio, Inc., YellowPages.com, LLC*, 899 F.3d 1321, 1331 (Fed. Cir. 2018) (quoting 35 U.S.C. § 315(b)).

## IV. STATEMENT OF REASONS FOR RELIEF REQUESTED

In view of the applicable law, the Board should exercise its discretion to grant joinder and institute CommScope's copycat IPR on the '381 Patent joining it to the Nokia IPR for the reasons set forth below under the *Kingston Tech.* framework.

### A. Joinder is Appropriate Because the Petition and Motion Are Timely.

The Motion for Joinder and accompanying Petition are timely because they are filed less than one month after the October 3, 2022 decision instituting trial in the Nokia IPR. 37 C.F.R. § 42.122(b) ("Any request for joinder must be filed... no later than one month after the institution date of any inter partes review for which joinder is requested."); *see also Kingston Tech. Co. v. Securewave Storage Solutions, Inc.*, IPR2020-00139, Paper 12 at 6-7 (PTAB Mar. 23, 2020) (holding that "me-too" petition was timely where it was filed more than one year after petitioner was sued for infringement but within one month of the institution of the

IPR which petitioner sought to join); *Intel*, IPR2022-00479, Paper 13 at 17 ("Petitioner's timeliness in filing the Petition and requesting joinder minimized the potential disruption to an existing proceeding if joinder is granted… those aspects of Petitioner's approach support granting joinder.").

**B. The Petition Does Not Present New Grounds.**

CommScope's Petition does not raise any new grounds of unpatentability and does "not present issues that might complicate or delay" the Nokia IPR. *See Enzymotec Ltd. v. Neptune Techs. & Bioresources, Inc.*, IPR2014-00556, Paper 19 (PTAB July 9, 2014). CommScope's Petition challenges the same claims (1-8) of the '381 patent using the same arguments, analysis, evidence, and two grounds of unpatentability as the Nokia IPR. *See, e.g., Kingston Tech.*, IPR2020-00139, Paper 12 at 6-9; *Hyundai*, IPR2014-01543, Paper 11 at 2-4; *Dell*, IPR2013-00385, Paper 17, at 6-10.

**C. The Petition Will Not Impact the Schedule in the Nokia IPR.**

Because CommScope's Petition raises no new grounds of unpatentability, and because a Scheduling Order has been established for the Nokia IPR, joinder will have no impact on the schedule of the Nokia IPR. *See Sony Corp. v. Memory Integrity, LLC.*, IPR2015-01353, Paper No. 11 at 6 (Oct. 15, 2015) (granting IPR and motion for joinder where "joinder should not necessitate any additional briefing or discovery from Patent Owner beyond that already required in [the

original IPR]"). CommScope will adhere to all applicable deadlines set in the Scheduling Order for the Nokia IPR and, as detailed below, will assume an understudy role in the proceeding. Nokia does not support the motion. But assuming that CommScope represents that it will take an understudy role, Nokia does not object to the motion.

Accordingly, joinder of CommScope to the Nokia IPR will not affect the Board's ability to complete its review and final decision within the statutory time limits under 35 U.S.C. § 316(a)(11) and 37 C.F.R. § 42.100(c).

**D. Briefing and Discovery Will be Simplified.**

As a "silent understudy," CommScope agrees that, if joined, the following conditions will apply:

a) all filings by CommScope in the joined proceeding will be consolidated with the filings of Nokia, unless a filing solely concerns issues that do not involve Nokia;[1]

b) CommScope shall not be permitted to raise any new grounds not instituted by the Board in the Nokia IPR, or introduce any argument or discovery not already introduced by Nokia;

[1] If a filing is necessary concerning an issue that does not involve Nokia, CommScope will seek prior authorization from the PTAB before filing any paper.

c) CommScope shall be bound by any agreement between the Patent Owner and Nokia concerning discovery and/or depositions; and

d) CommScope at deposition shall not receive any direct, cross examination or redirect time beyond that permitted for Nokia in this proceeding alone under either 37 C.F.R. § 42.53 or any agreement between the Patent Owner and Nokia.

*See Mylan Pharms.*, IPR2019-01905, Paper 12 at 8-9 (granting motion for joinder subject to identical conditions); *Mylan Pharms. Inc. v. Novartis AG*, IPR2015-00268, Paper 17 at 5-6 (PTAB Apr. 10, 2015) (finding the same proposed limitations "are consistent with the 'understudy' role that Petitioner agrees to assume, as well as Petitioner's assertion that its presence would not require introducing any additional arguments, briefing or discovery."). CommScope will also abide by any additional conditions the Board deems appropriate.

**E. Joinder Will Not Prejudice Patent Owner.**

Joinder of Petitioner to the Nokia IPR will not prejudice Patent Owner. The Patent Owner need not expend any additional resources above and beyond those required in the current Nokia IPR. Indeed, it is hard to imagine how the Patent Owner could be prejudiced by CommScope's joinder, as the PTO anticipated that joinder would be granted as a matter of right in circumstances like those here. *See Kingston Tech.*, IPR2020-00139, Paper 12 at 14 (quoting 157 CONG. REC. S1376

(daily ed. Mar. 8, 2011) (statement of Sen. Kyl) ("The Office anticipates that *joinder will be allowed as of right* – if an inter partes review is instituted on the basis of a petition, for example, a party that files *an identical petition will be joined to that proceeding*, and thus allowed to file its own briefs and make its own arguments.") (emphases in opinion)).

Further, any argument that joinder may somehow frustrate settlement between Nokia and Patent Owner would not be a basis to deny joinder, because that same possibility exists in every joinder situation. *Global Foundries U.S. Inc. v. Godo Kaisha IP Bridge 1*, IPR2017-00925 and IPR2017-00926, Paper 13 at 10 (June 9, 2017).

Patent Owner may argue that CommScope's petition should be denied because, based on the Board's determination that 2Wire was an real party in interest to CommScope's '835 patent IPR, 2Wire is a RPI here and is statutorily barred from seeking inter partes review. However, the one-year time limitation does not apply to a request for joinder. *See* 35 U.S.C. § 315(b); *Intel Corp. v. VLSI Technology LLC*, IPR2022-00479, Paper 13 at 7 n.7 (P.T.A.B. June 6, 2022). This argument should thus be rejected—as it has been in numerous similar IPRs—as it is inconsistent with the language of 35 U.S.C. § 315(b). *Facebook, Inc.*, 973 F.3d at 1333.

Indeed, the Board has instituted IPRs granting motions for joinder in similar proceedings where parties that were time-barred were permitted to pursue copycat IPR petitions. In *Kingston Tech Co., Inc. v. Securewave Storage Solutions, Inc.*, IPR2022-00139, Paper 12 (PTAB Mar. 23, 2020), the Board exercised is discretion to grant joinder where: 1) the copycat petition was filed within one month after institution of the original petition; and 2) the copycat petition did not add any new issues to the original IPR. *Id*., at 7. The Board held that the time bar did not apply to the *Kingston* petition and rejected Patent Owner's time-bar based arguments.

Specifically, the Board has instituted IPRs and granted motions for joinder in cases where parties who were otherwise time-barred filed copycat petitions to petitions filed by defendants in related litigation. *See Google LLC v. Express Mobile, Inc*., IPR2022-00597, Paper 17 (P.T.A.B. Aug. 19, 2022); *Sony Mobile Commc'ns Ab v. Ancora Techs., Inc*., IPR2021-00663, Paper 17 (P.T.A.B. June 10, 2021); *see also Intel,* IPR2022-00479, Paper 13 at 18 (rejecting Patent Owner's argument that joinder of otherwise time-barred parties would "effectively circumvent the time limitation in § 315(b)," because the statute provides for an exception to the time bar for joinder, and rejecting Patent Owner's argument that the Board should grant motions for joinder "only in limited circumstances," because neither same-party joinder nor new issues were involved in the copycat

petition);[2] *Nokia of Am. Corp. v. Oyster Optics, LLC*, IPR2018-00984, Paper 9 at 6 (Jul. 27, 2018) (instituting petition filed by a time-barred entity and determining that joinder would not unduly prejudice the patent owner). Critically, the Board "views substantive consideration of the merits of a petition as an important factor in maintaining the balance between improving patent quality and the potential for abuse. To determine otherwise would prioritize insulating patent owners from potential abuse without also addressing the public benefit to improving patent quality." *Intel*, IPR2022-00479, Paper 13 at 11. Here too, the Board should reject Patent Owner's arguments, consider CommScope's IPR on the merits, institute trial, and grant its motion for joinder.

## V. CONCLUSION

For the foregoing reasons, CommScope respectfully requests that its Petition for Inter Partes Review of the '381 patent be granted and that the proceedings be joined with IPR2022-00665.

[2] Unlike in *Intel*, in the instant case there are no questions regarding the relationship between the entities at issue and the grounds in this petition and the Nokia IPR are the same.

Date: November 1, 2022

Respectfully submitted,

By: /Sanjeet K. Dutta/

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**CERTIFICATE OF SERVICE ON PATENT OWNER**

Pursuant to 37 C.F.R. §§ 42.6(e), 42.8(b)(4), and 42.105, the undersigned certifies that on November 1, 2022, a complete copy of the foregoing Motion was served via Federal Express Next Business Day Delivery to the Patent Owner by serving the correspondence address of record for the '381 patent:

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Courtesy copies of the foregoing Motion were also served via Federal Express Next Business Day Delivery and email upon counsel of record for TQ Delta, LLC, the Patent Owner in IPR2022-00665:

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Dated: November 1, 2022

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