

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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NOKIA OF AMERICA CORPORATION,  
Petitioner,

v.

OYSTER OPTICS, LLC,  
Patent Owner.

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Case IPR2018-00984  
Patent 6,476,952 B1

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Before PATRICK M. BOUCHER, JESSICA C. KAISER, and  
JOHN R. KENNY, *Administrative Patent Judges*.

KAISER, *Administrative Patent Judge*.

DECISION

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

## I. INTRODUCTION

### A. Background

On April 27, 2018, Nokia of America Corporation (“Petitioner”) filed a Petition (Paper 2, “Pet.”) requesting *inter partes* review of claims 1–5 (“the challenged claims”) of U.S. Patent No. 6,476,952 B1 (Ex. 1001, “the ’952 patent”). Concurrently with the Petition, Petitioner filed a Motion for Joinder (Paper 3, “Mot.”), requesting that this proceeding be joined with *Cisco Systems, Inc. and Oclaro, Inc. v. Oyster Optics, LLC*, Case IPR2017-02189 (“2189 IPR”). Mot. 1. Oyster Optics, LLC (“Patent Owner”) filed an Opposition to the Motion for Joinder (Paper 7, “Opp.”) and confirmed that it does not intend to file a Preliminary Response (Ex. 3001). Petitioner filed a Reply in Support of Motion for Joinder. Paper 8, “Reply.”

For the reasons discussed below, we grant Petitioner’s Motion for Joinder.

### B. Related Proceedings and Asserted Grounds of Unpatentability

In the 2189 IPR, we instituted *inter partes* review of the ’952 patent on the following two grounds:

1. Claims 1–3 and 5 under 35 U.S.C. § 103(a) as unpatentable over Kaneda<sup>1</sup> and Schneider<sup>2</sup>; and
2. Claim 4 under 35 U.S.C. § 103(a) as unpatentable over Kaneda, Schneider, and Heflinger.<sup>3</sup>

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<sup>1</sup> JP Pat. App. Pub. S61-127236 (Original Japanese Unexamined Patent, Ex. 1005; Declaration Regarding English Translation, Ex. 1006; English Translation, Ex. 1007).

<sup>2</sup> U.S. Pat. No. 6,700,907 B2 (Ex. 1026).

<sup>3</sup> U.S. Pat. No. 6,396,605 B1 (Ex. 1025).

2189 IPR, Paper 9, 34; 2189 IPR, Paper 11, 2.

The Petition in this proceeding challenges the same claims on identical grounds of unpatentability, and relies on the same evidence, including the same technical expert testimony, as presented in the 2189 IPR. Pet. 1; Mot. 5. Patent Owner confirmed that it did not intend to file a Preliminary Response and thus has not presented any arguments regarding the merits of the Petition in this case. Ex. 3001.

## II. ANALYSIS

An *inter partes* review may be joined with another *inter partes* review, subject to certain statutory provisions:

(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.

35 U.S.C. § 315(c); *see also* 37 C.F.R. § 42.122 (“Any request for joinder must be filed, as a motion under § 42.22, no later than one month after the institution date of any *inter partes* review for which joinder is requested.”).

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, e.g., Kyocera Corp. v. Softview LLC*, Case IPR2013-00004, Paper 15 (April 24, 2013). As the moving party,

Petitioner bears the burden of proving that it is entitled to the requested relief. 37 C.F.R. § 42.20(c).

As an initial matter, the present Motion for Joinder meets the requirements of 37 C.F.R. § 42.122(b) because the Motion was filed on April 27, 2018, which is not later than one month after the 2189 IPR was instituted on March 28, 2018.

In addition and as noted above, the present Petition challenges the same claims on the same grounds of unpatentability, and relies on the same evidence, including the same technical expert testimony, as presented in the 2189 IPR. Pet. 1; Mot. 5. Patent Owner has not presented any arguments regarding the merits of the Petition in this case. Ex. 3001.

For the above reasons, and in particular the fact that the present Petition is virtually identical to the petition in the 2189 IPR, we determine Petitioner has demonstrated sufficiently under 35 U.S.C. § 315(c) that its Petition in this case warrants the institution of an *inter partes* review under 35 U.S.C. § 314(a).

Petitioner further contends joinder will not affect the schedule in the 2189 IPR, agrees to assume an “understudy” role, and provides the following conditions that would apply as long as Cisco and Oclaro (“the 2189 Petitioners”) remain active parties:

(a) all filings by Petitioner in the joined proceeding be consolidated with the filings of Cisco and Oclaro, unless a filing solely concerns issues that do not involve Cisco or Oclaro;

(b) Petitioner shall not be permitted to raise any new grounds not already instituted by the Board, or introduce any argument or discovery not already introduced by Cisco or Oclaro;

(c) Petitioner shall be bound by any agreement between Patent Owner and Cisco or Oclaro concerning discovery and/or depositions; and

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

Mot. 5–7. Based on these conditions, Petitioner contends “joinder with this IPR proceeding will not introduce any additional arguments, briefing, or need for discovery.” *Id.* at 7.

Patent Owner opposes the Motion for Joinder. In particular, Patent Owner contends that the “concessions” proposed by Petitioner for its “understudy” role actually permit Petitioner “to take a much more active role in the proceedings without first seeking and receiving Board approval.”

Opp. 1. Specifically, Patent Owner points to the concession above in which “all filings by Petitioner [] in the joined proceeding be consolidated with the filings of [the 2189 Petitioners], *unless a filing solely concerns issues that do not involve* [the 2189 Petitioners].” *Id.* at 2. Patent Owner expresses the concern that this concession would allow Petitioner to have the consolidated filing plus Petitioner’s own substantive submission. *Id.*<sup>4</sup> Thus, Patent Owner contends that the Board should (1) deny joinder and dismiss the Petition without institution, or (2) if joinder is granted, relegate Petitioner to “a true ‘understudy’ role in IPR2017-02189 and [permit Petitioner] to submit any filing only after first seeking (and receiving) authorization from

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<sup>4</sup> Patent Owner also notes that joinder will not avoid redundant submissions as Petitioner argues because Petitioner is time barred under 35 U.S.C. § 315(b). *Id.* at 5–6.



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