

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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ARRIS GROUP, INC., TELLABS, INC.  
ALCATEL-LUCENT USA, INC., and SOURCE PHOTONICS, INC.,  
Petitioner,

v.

CIRREX SYSTEMS LLC,  
Patent Owner.

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Case IPR2015-00530  
Patent 6,404,953 B1

Before MEREDITH C. PETRAVICK, TRENTON A. WARD, and  
BRIAN P. MURPHY, *Administrative Patent Judges*.

WARD, *Administrative Patent Judge*.

DECISION

Denying Petitioner's Motion for Joinder  
And Denying Institution of *Inter Partes* Review  
*37 C.F.R. §§ 42.108, 42.122*

## I. INTRODUCTION

Arris Group, Inc., Tellabs, Inc., Alcatel-Lucent USA, Inc., and Source Photonics, Inc. (collectively, “Petitioner”) filed a Petition (Paper 1, “Pet.”) to institute an *inter partes* review of claims 1, 23, 24, 26, 31, 47, and 51 of U.S. Patent No. 6,404,953 B1 (Ex. 1001, “the ’953 patent”). On the same day, Petitioner also filed a Motion for Joinder, requesting joinder of this proceeding with a related and instituted proceeding, *Arris Group, Inc. v. Cirrex Sys. LLC*, Case IPR2014-00815 (“’815 IPR”). Paper 3 (“Joinder Motion”). Petitioner filed its Joinder Motion within one month after institution of a trial in the ’815 IPR, as required by 37 C.F.R 122(b). Patent Owner Cirrex Sys., Inc. filed a Preliminary Response to the Petition. Paper 11 (“Prelim. Resp.”). Patent Owner also filed an Opposition to Petitioner’s Motion for Joinder (Paper 8, “Opp. To Joinder”), and Petitioner filed a Reply to Patent Owner’s Opposition to Motion for Joinder (Paper 10, “Reply”).

We have jurisdiction under 35 U.S.C. § 314, which provides that an *inter partes* review may be authorized only if “the information presented in the petition . . . and any [preliminary] response . . . shows that there is a reasonable likelihood that the petitioner would prevail with respect to at least one of the claims challenged in the petition.” 35 U.S.C. § 314(a).

For the reasons below, we determine that Petitioner has not shown that joinder is warranted in this instance. We also deny the Petition and do not institute *inter partes* review as to the claims 1, 23, 24, 26, 31, 47, and 51 of the ’953 patent.

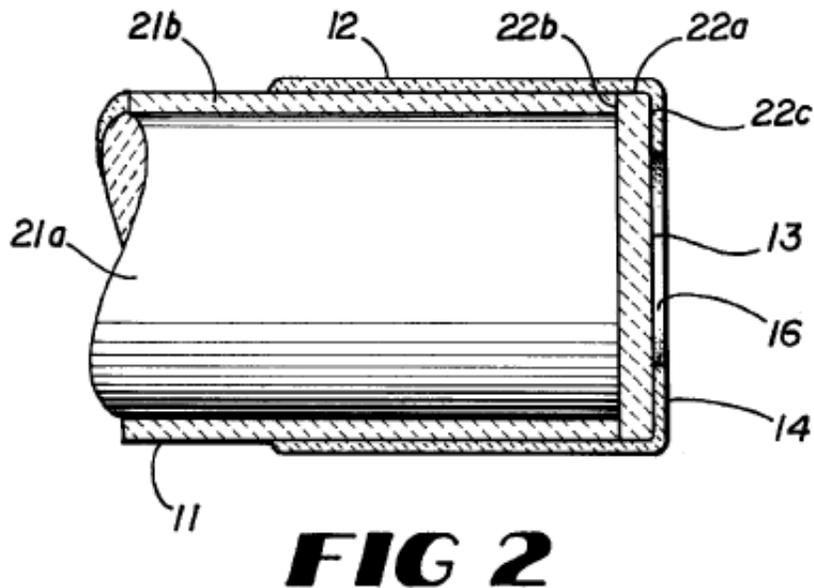
A. *Related Proceedings*

The '953 patent is involved in a district court proceeding in the U.S. District Court of Delaware captioned *Cirrex System LLC v. Verizon Communications Inc.*, Case No. 13-cv-921-GMS (D. Del.). Pet. 6; Paper 4, 3. Additionally, on May 23, 2014, Petitioner filed a Petition (“First Petition”) to institute an *inter partes* review of claim 30 of the '953 patent in the '815 IPR. *Arris Group, Inc. v. Cirrex Sys. LLC*, Case IPR2014-00815 (PTAB May 23, 2014) (Paper 1). On December 3, 2014, we instituted an *inter partes* review in the '815 IPR of claim 30 of the '953 patent. *Arris Group, Inc. v. Cirrex Sys. LLC*, Case IPR2014-00815, slip op. 17 (PTAB December 3, 2014) (Paper 8). Subsequently, Petitioner filed its Petition in the instant proceeding on January 5, 2015, challenging additional claims in the same patent, namely, claims 1, 23, 24, 26, 31, 47, and 51 of the '953 patent. Pet. 17–19.

B. *The '953 Patent*

The '953 patent is titled “Optical Assembly With High Performance Filter” and generally relates to an apparatus for optical noise reduction in optical assemblies by controlling or limiting undesirable photon entrance, reflection, departure, or appearance in or from the assembly. Ex. 1001, 2:36–39. The '953 patent describes how in a preferred embodiment high performance filters can be combined with masking to eliminate significant sources of unwanted light penetration in an optical assembly. *Id.* at 3:65–67.

Figure 2 of the '953 patent is reproduced below.



As shown above in Figure 2 of the '953 patent, the end of an elongated waveguide is shown in optical fiber 11 having mask 12 and filter 13. *Id.* at 3:44–47. The '953 patent describes that mask 12 covers filter edge surface 22a, the area of junction between filter 13 and end face 22b of fiber 11, the area of junction between the filter edge surface and filter face 22c, and the peripheral portion of filter face surface 13 distal to fiber 22d. *Id.* at 6:63–7:3. The '953 patent describes that filter 13 can be a thin-film filter with high performance characteristics “having a large number of alternating high/low refractive indices, stacked layers deposited on a substrate.” *Id.* at 4:14–17.

Claim 1, reproduced below, is illustrative of the claimed subject matter:

1. An optical assembly comprising  
a waveguide member having at least two ends,  
a filter in optical communication with said waveguide member, said filter having a face surface facing toward one end

of said waveguide member, a second face surface facing away from one end of said waveguide member, and at least one peripheral edge surface, and

a mask adhering to at least one of said filter surfaces, said mask substantially opaque in at least one selected spectral region and impacting the extent to which photons in said selected spectral region can pass through said filter.

## II. DECISION ON THE MOTION FOR JOINDER

### A. *Background*

The statutory provision governing joinder of *inter partes* review proceedings is 35 U.S.C. § 315(c), which reads as follows:

(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.

Section 315(b) of the statute generally bars institution of *inter partes* review when the petition is filed more than one year after the petitioner (or petitioner's real party in interest or privy) is served with a complaint alleging infringement of the patent. 35 U.S.C. § 315(b); 37 C.F.R. § 42.101(b). That one-year time bar, however, does not apply to a request for joinder.

35 U.S.C. § 315(b) (final sentence); 37 C.F.R. § 42.122(b). This is an important consideration here because Petitioner was served with a complaint asserting infringement of the '953 patent more than one year before filing the Petition in this proceeding. *See* Joinder Motion 2, 10. The '953 patent is involved in a district court proceeding in the U.S. District Court of the District of Delaware captioned *Cirrex System LLC v. Verizon*

*Communications Inc.*, Case No. 13-cv-921-GMS (D. Del.) (“Delaware Action”). Pet. 6. Petitioner represents that the complaint in the Delaware Action was filed on May 22, 2013, and subsequently served on Petitioner on May 26, 2013. Joinder Motion 1. Thus, absent joinder of this proceeding to the ’815 IPR, institution based on the current Petition is barred under 35 U.S.C. § 315(b).

Joinder may be authorized when warranted, but the decision to grant joinder is discretionary. 35 U.S.C. § 315(c); 37 C.F.R. § 42.122(b). As indicated in the legislative history, the Board will determine whether to grant joinder on a case-by-case basis, taking into account the particular facts of each case. *See* 157 Cong. Rec. S1376 (daily ed. Mar. 8, 2011) (statement of Sen. Kyl) (when determining whether and when to allow joinder, the Office may consider factors including the breadth or unusualness of the claim scope, claim construction issues, and consent of the patent owner). When exercising that discretion, the Board is mindful that patent trial regulations, including the rules for joinder, must be construed to secure the just, speedy, and inexpensive resolution of every proceeding. 37 C.F.R. § 42.1(b).

As the moving party, Petitioner has the burden of proof in establishing entitlement to the requested relief. 37 C.F.R. 42.20(c).

### *B. Analysis*

Petitioner argues that its Joinder Motion should be granted because Petitioner’s Motion and Petition are timely and submitted within one month of the December 3, 2014, institution of *inter partes* review in the ’815 IPR. Pet. 3. Petitioner further argues that joinder is appropriate because: (1) other panels have permitted joinder of additional grounds by the same party under 35 U.S.C. § 315(c) (Joinder Motion 8); (2) joining the cases will not

bring any prejudice to the Patent Owner (Joinder Motion 11); (3) the new prior art relied upon is used to address claim limitations not present in the First Petition (Joinder Motion 12); and (4) the trial schedule of the First Petition will be minimally impacted by joinder (Joinder Motion 13).

In response, Patent Owner opposes Petitioner's Joinder Motion and argues that the Petition introduces a number of new issues with respect to seven additional claims, new prior art references, and newly proposed combinations, which were not previously considered by the Board. Opp. To Joinder 3. Furthermore, Patent Owner argues that an improper circumstance for joinder resulted from Petitioner's delay in filing the instant petition (the "Second Petition") and that the Board should not award that delay by granting Petitioner's motion to join. *Id.* Specifically, Patent Owner argues that the claims 1, 23, 24, 26, 31, 47, and 51 ("additional claims") of the '953 patent challenged in the Second Petition were expressly made part of the Delaware Action on June 26, 2014, but the Petitioner waited until January 5, 2015 to file the Second Petition. *Id.* at 7. Patent Owner points out that had the Petitioner promptly sought joinder with the '815 IPR, "combining the two proceedings may have made sense." *Id.* at 7-8.

In its Reply, Petitioner responds that Petitioner was reasonable in waiting from June 26, 2014 until January 5, 2015 to file the Second Petition, because Petitioner was not required to file the Second Petition prior to knowing whether the '815 IPR would be instituted. Reply 1. Furthermore, Petitioner argues that the Board rejected a similar argument by the Patent Owner in *Amneal Pharms. LLC v. Endo Pharms., Inc.*, Case IPR2014-01365 (PTAB Feb. 4, 2015) (Paper 13).

In *Amneal*, the Board denied a motion to join certain challenged claims because, among other things, the petitioner failed to articulate why it did not challenge the claims in the first petition. *Id.* at 8. Additionally, in *Amneal*, the Board granted joinder for two claims which the petitioner was alleged to infringe for the first time in a separate district court case filed after the 35 U.S.C. § 315(b) bar date. *Id.* at 8–9. Specifically, the Board found that because patent owner alleged infringement of the claims by the petitioner for the first time after the § 315(b) bar date, joinder of those claims was justified. *Id.* at 9.

Notably, here, the additional claims asserted in the Second Petition were not the subject of a new district court case filed after the § 315(b) bar date. Petitioner states that as of the § 315(b) bar date, May 26, 2014, “Claim 30 remained the only claim in the ’953 [p]atent that was asserted by the Patent Owner.” Joinder Motion, 2. Contrary to Petitioner’s characterization, however, the original complaint of the Delaware Action filed on May 22, 2013 alleged that “Tellabs has infringed *one or more claims of the ’953 patent*,” and not just claim 30. Ex. 3000, 8 (emphasis added). Significantly, Petitioner does not argue that an *amended complaint* was filed by Patent Owner in the Delaware Action to allege infringement of the additional claims, but merely that the “Patent Owner served *amended infringement contentions* in the Delaware Action.” Joinder Motion 2–3 (emphasis added).

In view of the circumstances of this case, we are not persuaded that Petitioner has sufficiently established that joinder to the ’815 IPR is warranted. First, although Petitioner alleges this is not a second bite at the apple, Petitioner fails to provide any basis for why it could not have

challenged the additional claims in the First Petition. *See* Joinder Motion 11–13. As of the filing of the First Petition, Patent Owner’s complaint in the Delaware Action alleged infringement by Petitioner of “one or more claims of the ’953 patent.” Ex. 3000, 8 (emphasis added). Therefore, at the time of filing the First Petition, Petitioner was on notice of infringement for any of the 51 claims in the ’953 patent. *See id.* Petitioner argues that claim 30 was the only claim in the ’953 patent asserted by the Patent Owner as of the May 26, 2014 bar date (Joinder Motion 2), but in addition to the general allegation of infringement of by Petitioner of “one or more claims of the ’953 patent,” the original complaint in the Delaware Action states that “Tellabs has been and is still infringing *at least claim 30* of the ’953 patent.” Ex. 3000, 7–8. Therefore, although Petitioner argues that “it was Patent Owner that waited until after the Section 315(b) bar date . . . to assert new claims” (Reply 3), Petitioner was on notice of an infringement allegation for any of the ’953 patent claims as of the service of the original complaint in the Delaware Action. *See id.*

Second, Petitioner delayed in filing the Second Petition. Petitioner argues that it received Patent Owner’s amended infringement contentions on June 26, 2014 in the Delaware Action. Joinder Motion 2. Petitioner waited, however, until the very last possible day, January 5, 2015, to file the Second Petition.<sup>1</sup> Petitioner argues that it makes “little sense to require that a petitioner file a time-barred petition and motion for joinder before a predicate trial has been instituted.” Reply 2. The rule for requesting joinder,

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<sup>1</sup> The ’815 IPR was instituted on December 3, 2014 (’815 IPR, Paper 8); thus, under 37 C.F.R. § 42.122, the motion to join must have been filed no later than one month after the institution date. As January 3, 2015 fell on a Saturday, Petitioner could file its motion as late as January 5, 2015.

however, does not prohibit the filing of a second petition until after institution of the first petition, but merely provides that the request for joinder must be filed “*no later than* one month after the institution date.” 37 C.F.R. § 42.122(b) (emphasis added). Petitioner could have informed the Board of its desire to challenge the additional claims along with the ’815 IPR well before January 5, 2015, yet it chose to file its Second Petition on the very last day permitted under the rules.

Third, the schedule for the ’815 IPR is significantly advanced, with the majority of briefing and evidentiary submissions complete. *See* ’815 IPR, Scheduling Order, Paper 9, 6. Furthermore, the oral argument for the ’815 IPR, if granted, would occur in less than one month, on August 19, 2015. *See id.* Therefore, joinder of the instant proceeding to the ’815 IPR would significantly impact the trial schedule of the ’815 IPR. More particularly, to synchronize this proceeding with the ’815 IPR would essentially require a stay of the ’815 IPR to permit the briefing, motions, and evidentiary submissions to be conducted in this proceeding. Such a stay of the ’815 IPR would be contrary to our policy of securing “the just, speedy, and inexpensive resolution of every proceeding.” 37 C.F.R. § 42.1(b).

Fourth, joinder of this proceeding would require the considerations of new grounds and new prior art asserted against the additional claims. Specifically, this proceeding challenges seven new claims and relies upon, among other things, three pieces of prior art not relied upon in the ’815 IPR. *See Opp. To Joinder* 5–6.

In view of the particular facts and issues before us in the instant case, we exercise our discretion to deny Petitioner’s Joinder Motion.

### III. DECISION ON THE PETITION

Institution of *inter partes* review is barred when the petition is filed more than one year after the petitioner is served with a complaint alleging infringement of the patent. 35 U.S.C. § 315(b); 37 C.F.R. § 42.101(b). Petitioner concedes that without joinder, its Second Petition is time barred. Joinder Motion 2, 10 (noting May 26, 2014 as the “statutory one-year bar date under 35 U.S.C. § 315(b)”); Reply 2. Accordingly, in view of our decision to deny Petitioner’s Joinder Motion, we deny the Second Petition because it was not filed within the time limits imposed under 35 U.S.C. § 315(b).

### IV. ORDER

In consideration of the foregoing, it is hereby:

ORDERED that Petitioner’s Motion for Joinder is *denied*;

FURTHER ORDERED that the Petition is *denied* and no trial is instituted.

#### PETITIONER:

D. Joseph English  
John M. Baird  
DUANE MORRIS LLP  
djenglish@duanemorris.com  
jmbaird@duanemorris.com

#### PATENT OWNER:

Tarek N. Fahmi  
ASCENDA LAW GROUP, PC  
tarek.fahmi@ascendalaw.com