

UNITED STATES PATENT AND TRADEMARK OFFICE

---

BEFORE THE PATENT TRIAL AND APPEAL BOARD

---

WAVEMARKET, INC. D/B/A LOCATION LABS  
Petitioner

v.

CALLWAVE COMMUNICATIONS, LLC  
Patent Owner

---

Case IPR2014-00920  
Patent 6,771,970

---

**Petitioner's Motion to Join Pursuant to  
35 U.S.C. § 315(c) and 37 C.F.R. § 42.122(b)**

Location Labs respectfully requests the Board to join the trial resulting from the second petition for *inter partes* review of the '970 patent (filed with this motion) with IPR2014-00199 (“the '199 trial”) because the second petition has overlapping prior art, relies on testimony from the same expert witness, involves the same patent with the same parties, and the petitioner expeditiously petitioned for review of the '970 patent. Accordingly, there is good cause for granting this motion for joinder. In addition, joinder would enable a just, speedy, and efficient determination of the patentability of the claims of the '970 patent.

## **I. APPLICABLE STATUTE AND RULE**

### ***35 U.S.C. § 315(c)***

(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.

### ***37 C.F.R. § 42.122(b)***

Request for joinder. Joinder may be requested by a patent owner or petitioner. 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. The time period set forth in § 42.101(b) shall not apply when the petition is accompanied by a request for joinder.

## II. RELIEF REQUESTED

In this motion, the petitioner requests that the second petition be joined with the '199 trial.

## III. STATEMENT OF FACTS

1. On November 27, 2013, the petitioner filed a petition for *inter partes* review of the '970 patent ("first petition").

2. The first petition asserted that Elliot<sup>1</sup> and Fitch<sup>2</sup>, alone or in combination, anticipated or rendered obvious claims 1–19 of the '970 patent.

3. The patent owner filed a preliminary response on March 17, 2014.

4. On May 9, 2014, the Board decided to institute review of claim 18 of the '970 patent as anticipated by Elliot, but denied review of claims 1–17 and 19 on any of the proposed grounds.

5. The petitioner requested rehearing on May 23, 2014.

6. The patent owner opposed the petitioner's request for rehearing on June 6, 2014.

---

<sup>1</sup> U.S. Patent No. 6,243,039 to Elliott (Ex. 1110).

<sup>2</sup> U.S. Patent No. 6,321,092 to Fitch (Ex. 1105).

7. The petitioner filed a second petition for *inter partes* review of claims 1–17 and 19 of the '970 patent on June 9, 2014 ("second petition"), one month from the May 9, 2014 decision to institute.

#### **IV. ARGUMENT**

The '199 trial includes review of claim 18 of the '970 patent as anticipated by Elliott. The second petition, which the petitioner seeks to join with the '199 trial, relies on a limited number of grounds closely related to the grounds the Board is considering in the '199 trial. The table below summarizes the relationship between the grounds already considered in the '199 trial and those proposed in the second petition.

<b>Grounds Proposed in First Petition<sup>3</sup></b>	<b>Grounds Proposed in Second Petition</b>
Fitch (§ 102): 1-3, 11-14, 16 and 19	Fitch in view of Roel-Ng <i>et al.</i> <sup>4</sup> (§ 103): 1-3, 11-14, 16 and 19
Fitch in view of Jones (§ 103): 4	Fitch in view of Roel-Ng <i>et al.</i> and Jones (§ 103): 4
Fitch in view of Shah <sup>5</sup> (§ 103): 5	Fitch in view of Roel-Ng <i>et al.</i> and Shah (§ 103): 5
Fitch in view of Elliot (§ 103): 6-10, 15, 17 and 18	Fitch in view of Roel-Ng <i>et al.</i> and Elliot (§ 103): 6-10, 15 and 17

The grounds proposed in the second petition rely on Roel-Ng *et al.*, which was absent from the first petition. Roel-Ng *et al.* teaches the elements of the claims that the Board stated were absent in Fitch and Elliot. However, considering Roel-Ng *et al.* will not unduly burden the Board as petitioner relies on it for a single limitation in claims 1, 14, and 19, and Fitch and Elliot are overlapping prior art.

In addition to relying on overlapping prior art, the '199 trial and second petition involve the same parties, the same patent, and the same expert. Indeed, the claims not currently under review recite many of the same limitations as claim 18

---

<sup>3</sup> The first petition also proposed grounds based on Elliot. To minimize the number of issues and facilitate joinder, the second petition does not rely on Elliot as a primary reference.

<sup>4</sup> U.S. Patent No. 6,002,936 (Ex. 1107).

<sup>5</sup> U.S. Patent No. 5,758,313 (Ex. 1109).

# Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

## Real-Time Litigation Alerts



Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

## Advanced Docket Research



With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

## Analytics At Your Fingertips



Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

## API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

## LAW FIRMS

Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

## FINANCIAL INSTITUTIONS

Litigation and bankruptcy checks for companies and debtors.

## E-DISCOVERY AND LEGAL VENDORS

Sync your system to PACER to automate legal marketing.