

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

T-MOBILE USA, INC. AND T-MOBILE US, INC.,
Petitioner

v.

MOBILE TELECOMMUNICATIONS TECHNOLOGIES, LLC,
Patent Owner

Case IPR2015-00015
Patent 5,915,210

**PETITIONER'S MOTION FOR JOINDER UNDER 35 U.S.C. § 315(c) AND
37 C.F.R. §§ 42.22 AND 42.122(b)**

Mail Stop "Patent Board"

Patent Trial and Appeal Board
U.S. Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

I. STATEMENT OF THE PRECISE RELIEF REQUESTED

Petitioner T-Mobile USA, Inc. and T-Mobile US, Inc. (collectively, "T-Mobile" or "Petitioner") respectfully requests joinder on the instituted grounds pursuant to 35 U.S.C. § 315(c) and 37 C.F.R. § 42.122(b) of the above-captioned *inter partes* review (hereinafter "T-Mobile IPR") with the pending *inter partes* review in IPR2014-01036, filed by Apple Inc. (the "Apple IPR").¹ In the Apple IPR, the Board instituted on two grounds and exercised its discretion to not institute on one other ground. Specifically, T-Mobile requests joinder to the Apple IPR on the two instituted grounds and continuation of the T-Mobile IPR as to the other ground.²

T-Mobile's joinder request is directed at the same claims, prior art, grounds of unpatentability, and arguments instituted in the Apple IPR. Accordingly, joinder

¹ It is T-Mobile's understanding that, if the request for joinder is granted, termination of the consolidated proceeding by settlement would require the consent of all parties, including T-Mobile. If T-Mobile's understanding is incorrect, T-Mobile respectfully withdraws this request for joinder.

² If the Board disagrees to allow the continuation of the T-Mobile IPR on the non-instituted grounds, T-Mobile respectfully requests joinder to the Apple IPR and consolidation of the two proceedings.

is appropriate because it will promote the efficient and consistent resolution of the validity of a single patent, will not prejudice the parties to the Apple IPR, and will eliminate duplicative filings and discovery as to the instituted grounds.

Continuation of T-Mobile's IPR as to the non-instituted grounds is also appropriate because the T-Mobile petition has been assigned a common judge from the panel of three judges for the Apple IPR and the Board has not made a substantive institution decision as to these grounds. T-Mobile's request will also narrow the grounds at issue in the T-Mobile IPR, resulting in reduced briefing and discovery for both parties.

II. STATEMENT OF MATERIAL FACTS

1. Apple filed its petition for *inter partes* review of claims 1, 10, and 19 of U.S. Patent No. 5,6915,210 ("the '210 patent") on or about June 27, 2014 ("the Apple Petition"). IPR2014-01036, Paper 2.

2. The Apple Petition challenged the patentability of the '210 patent on the following three grounds:

- a. Claims 1 and 10 are anticipated by Saalfrank;
- b. Claim 19 is rendered obvious by Saalfrank and Nakamura; and
- c. Claims 1, 10 and 19 are rendered obvious by Witsaman and Bingham.

IPR2014-01036, Paper 2. Apple supported its challenges with a declaration from Dr. Apostolos K. Kakaes. IPR2014-01036, Paper 2.

3. T-Mobile filed its petition for *inter partes* review of claims 1, 10, and 19 of the '210 patent on October 3, 2014 ("the T-Mobile Petition"). IPR2015-00015, Paper 1. T-Mobile supported its challenges with the declarations of Dr. Behnaam Aazhang and Dr. Apostolos K. Kakaes. IPR2015-00015, Paper 1.

4. The T-Mobile Petition challenged the patentability of the '210 patent on the same grounds offered in the Apple Petition. IPR2015-00015, Paper 1.

5. The Board instituted the Apple IPR on January 22, 2014 for grounds (a) and (b) of the above-listed grounds (the "Saalfrank grounds"). IPR2014-01035, Paper 10. As to ground (c) of the above-listed grounds (the "Witsaman ground"), the Board exercised its discretion to not institute review based on this ground. IPR2014-01036, Paper 9.

6. Apple does not oppose this Motion for Joinder.

III. STATEMENT OF REASONS FOR RELIEF REQUESTED

The Leahy-Smith America Invents Act ("AIA") permits joinder of *inter partes* review proceedings. 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.

In exercising its discretion to grant joinder, the Board considers the impact of substantive and procedural issues on the proceedings, as well as other considerations, while being “mindful that patent trial regulations, including the rules for joinder, must be construed to secure the just, speedy, and inexpensive resolution of every proceeding.” *Dell, Inc. v. Network-1 Security Solutions, Inc.*, Case IPR2013-00385, Paper No. 17 (July 29, 2013) at 3. The Board should consider “the policy preference for joining a party that does not present new issues that might complicate or delay an existing proceeding.” *Id.* at 10. Under this framework, joinder of the T-Mobile IPR with the Apple IPR is appropriate.

The Board has stated that “[a] motion for joinder should: (1) set forth the 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.” *Id.* at 4. Each of these issues is addressed fully below.

- A. Joinder will promote efficiency by consolidating issues, avoiding duplicate efforts, and preventing inconsistencies.**

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.