

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 IPR2015-00018
Patent 5,659,891

Before MIRIAM L. QUINN, MEREDITH C. PETRAVICK, and
SCOTT A. DANIELS, *Administrative Patent Judges*.

DANIELS, *Administrative Patent Judge*.

DECISION

Institution of *Inter Partes* Review and Grant of Motion for Joinder
37 C.F.R. § 42.108
37 C.F.R. § 42.122(b)

I. INTRODUCTION

T-Mobile USA, Inc. and T-Mobile US, Inc. (“T-Mobile”) filed a Petition to institute an *inter partes* review of claims 1–5 of U.S. Patent No. 5,659,891 (“the ’891 patent”). Paper 1 (“Pet.”). The Petition was accorded a filing date of October 3, 2014. Paper 3. On February 17, 2015, T-Mobile filed a Motion for Joinder (“Mot.,” Paper 10) seeking to join this proceeding with *Apple Inc., v. Mobile Telecommunications Technologies, LLC*, Case IPR2014-01035 (the “Apple IPR”). Mot. 1. The Apple IPR concerns the same patent as at issue here, namely the ’891 patent. We instituted trial in the Apple IPR on January 22, 2015. *See Apple Inc., v. Mobile Telecommunications Technologies, LLC*, Case IPR2014-01035, Paper 10 (Decision instituting *inter partes* review).

Patent Owner, Mobile Telecommunications Technologies, LLC (“MTel”), timely filed an Opposition (“Opp.,” Paper 11) to T-Mobile’s Motion for Joinder, and T-Mobile, in turn, filed a Reply (Paper 12).

We have jurisdiction under 35 U.S.C. § 314, which provides that an *inter partes* review may not be instituted “unless . . . there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.” For the reasons provided below, we (1) institute an *inter partes* review on all grounds, and (2) grant T-Mobile’s Motion for Joinder, subject to the conditions detailed herein.

II. INSTITUTION OF *INTER PARTES* REVIEW

The Petition in this proceeding asserts the same four grounds as those asserted in the Apple IPR. Pet. 4. We instituted a trial in the Apple IPR on 2 grounds:

1. Claims 1–5 as anticipated by Petrovic; and
2. Claim 5 as obvious over Petrovic, Raith and Alakija.

Apple v. Mobile Telecommunications Technologies, LLC, Case IPR2014-01035, slip op. at 17 (PTAB Jan. 22, 2015) (Paper 10). We exercised our discretion in the Apple IPR not to institute on third and fourth grounds, namely, claims 1–5 as anticipated by Cimini, and claim 5 as obvious over Cimini, Raith and Alkija. *Id.*

MTel waived its Preliminary Response in the Apple IPR (Apple IPR, Paper 8), but did file a Preliminary Response in this proceeding. Paper 9. MTel’s Preliminary Response in the present proceeding (Paper 12) did not provide persuasive arguments or evidence that alters our Decision instituting trial in the Apple IPR. In other words, institution of trial in this proceeding is based upon our consideration of essentially the same issues, directed to the same prior art references, already raised and considered in the Apple IPR. Accordingly, we institute an *inter partes* review in this proceeding on the same grounds as that on which we instituted trial in the Apple IPR.

III. GRANT OF MOTION FOR JOINDER

An *inter partes* review may be joined with another *inter partes* review, subject to the provisions of 35 U.S.C. § 315(c), which governs joinder of inter partes review proceedings:

(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 parties review under section 314.

As the moving party, T-Mobile bears the burden of proving that it is entitled to the requested relief. 37 C.F.R. § 42.20(c). A motion for joinder should: (1) set forth the reasons joinder is appropriate; (2) identify any new

grounds of unpatentability asserted in the petition; and (3) explain what impact (if any) joinder would have on the trial schedule for the existing review. *See* Frequently Asked Question H5, <http://www.uspto.gov/patents-application-process/appealing-patentdecisions/trials/patent-review-processing-system-prps-0> (last visited April 1, 2015).

The Petition in this proceeding has been accorded a filing date of October 3, 2014 (Paper 3), and the Motion for Joinder was filed on February 17, 2015. (Mot.). Thus, the Motion for Joinder in this proceeding satisfies the requirement of being filed within one month of the date, January 22, 2015, on which we instituted a trial in the Apple IPR. *See* 37 C.F.R. § 42.122(b) (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.).

In its Motion for Joinder, T-Mobile contends that its “joinder request is directed at the same claims, prior art, grounds of unpatentability, and arguments instituted in the Apple IPR.” Mot. 2. Specifically, T-Mobile requests that we join only the first two grounds with the Apple IPR, and permit the present proceeding to continue with respect to the third ground. *Id.* Keeping in mind that T-Mobile only requests the first two already instituted grounds be joined in the Apple IPR, T-Mobile represents that “joinder 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.” *Id.* at 2–3. Based on these representations, T-Mobile contends that, in the event of joinder, MTel would not be prejudiced, and the Apple IPR schedule would not be affected because the first two “grounds

contain[] the virtually identical arguments and claim construction sought in the Apple Petition.” *Id.* at 7.

MTel opposes the Motion for Joinder, arguing that T-Mobile has provided no evidence of Apple’s position with respect to joinder or corroboration that Apple and T-Mobile are prepared to work together. Opp. 1–2. Further, MTel argues that it filed a Preliminary Response in the present proceeding, but not in the Apple IPR. *Id.* at 2.

Based on the present record, we agree that joinder with the Apple IPR would promote the efficient resolution of these proceedings. In its Motion for Joinder, T-Mobile notes that both proceedings involve the same prior art, the same claims, and essentially the same arguments and evidence. T-Mobile has brought the same challenges in this proceeding, as in the Apple IPR, and joinder simplifies addressing the overlap of the first two grounds. We note that this proceeding was filed before we instituted a trial in the Apple IPR. Prejudice to MTel in this regard is minimal, because T-Mobile did not have the benefit of our analysis and decision for this proceeding. T-Mobile’s Petition is, therefore, an independent presentation of the same prior art and related evidence addressing the same claims. To the extent there are differences in Petitioner’s evidence and arguments regarding claim construction and the substantive application of the prior art to the claims, resolving these differences in a single proceeding is the most efficient course of action. Substantive issues in this IPR would not be unduly complicated by joining with the Apple IPR because joinder merely introduces the same grounds presented originally in the Apple IPR where all of the prior art is of record. In addition, scheduling of the joined proceeding, as set forth below, will occur so as to minimize impact to MTel, yet maintain

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