UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

T-Mobile US, Inc., T-Mobile USA, Inc., TeleCommunication Systems, Inc., Ericsson Inc., and Telefonaktiebolaget LM Ericsson,
Petitioners,

v.

TracBeam, LLC,
Patent Owner.

Case No. IPR2016-00728
Patent 7,525,484 B2

PETITIONERS' REPLY IN SUPPORT OF MOTION FOR JOINDER TO RELATED *INTER PARTES* REVIEW OF U.S. PATENT NO. 7,525,484 (CASE NO. IPR2015-01708) UNDER 35 U.S.C. § 315(c) AND 37 C.F.R. § 42.122(b)

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Exhibit List

Exhibit No.	Description
1028	Joint Motion to Resolve Disputes and Enter Docket Control Order, D.I. 56 (April 19, 2015)
1029	Noonen Email re Meet and Confer (June 18, 2015)

I. INTRODUCTION

In its Preliminary Response, Patent Owner provides no substantive attack on the merits of this supplemental petition. Paper No. 9 (PO Preliminary Response). Rather, Patent Owner relies solely on procedural reasons for its denial, similar to those asserted in its Patent Owner Opposition, Paper 8 ("Opp."). Petitioners submit that for the reasons set forth in the supplemental petition, there is a reasonable likelihood that Petitioners will prevail as to the invalidity of Claim 25 of the '484 Patent. Patent Owner's arguments that the law forbids joinder by the same petitioner, that its assertion of over 140 claims did not prejudice Petitioners' ability to file IPRs, and that this supplemental petition is merely a "second bite at the apple" are not persuasive for the reasons discussed below. *See id.*

II. JOINDER BY THE SAME PETITIONER IS PROPER

Patent Owner's argument that joinder by the same petitioner is impermissible flies in the face of two recent expanded-panel decisions finding joinder by the same petitioner entirely proper. *See* Opp. at 2-3.[1] These two

[1] Indeed, to support its proposition, Patent Owner relies on one case that was overturned by one of these expanded panel decisions. *See* Opp. at 2-3 (citing *Target Corp. v. Destination Maternity Corp.*, IPR2014-00508, Paper No. 18 (PTAB Sept. 25, 2014) (decision denying motion for joinder); *see id.* Paper No. 28 at 17 (PTAB Feb. 12, 2015) (granting Petitioner's Request for Rehearing and

expanded panels reversed decisions that denied joinder of the same petitioner, finding that those decisions used an improperly narrow interpretation of § 315(c)). The first expanded panel found that "the Board consistently has allowed joinder of additional grounds by the same party" and held that § 315(c) permits a party to join in a proceeding in which it is already a party. *Target Corp. v. Destination Maternity Corp*., IPR2014-00508, Paper No. 28 at 6, Paper No. 31 at 5 (PTAB Feb. 12, 2015). A second expanded panel came to the same conclusion, explicitly stating "that § 315(c) permits the joinder of any person who properly files a petition under § 311, ***including a petitioner who is already a party to the earlier instituted inter partes review***." *Zhongshan Broad Ocean Motor Co., Ltd. v. Nidec Motor Corp.*, IPR2015-00762, Paper No. 16 at 5 (PTAB Oct. 5, 2015) (emphasis added). Thus, Patent Owner has the law wrong.

III. THE CIRCUMSTANCES OF THIS CASE WARRANT JOINDER

Joinder is further justified to alleviate prejudice suffered by Petitioners from Patent Owner's gamesmanship in asserting an excessive number of claims in the district court litigation. Patent Owner's assertion of over 140 claims at the outset of the litigation and nearly 80 claims at the IPR deadline prejudiced Petitioners' ability to fully address each and every one of these lengthy claims in the original

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concluding that "the Decision Denying Joinder was based on an improper construction of 35 U.S.C. 315(c)").

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