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. IPR2016-00745
Patent 7,764,231

OPPOSITION TO MOTION FOR JOINDER

Exhibit List

Exhibit No.	Description
2001	*Order, dkt. #75, TracBeam, LLC., v. T-Mobile US, Inc. et. al.,* Case No. 6:14-CV-678 (E. D. Tx. June 2, 2015)
2002	*Notice of Compliance regarding Reasonable Number of Asserted Claims, dkt. #88, TracBeam, LLC., v. T-Mobile US, Inc. et. al.,* Case No. 6:14-CV-678 (E. D. Tx. June 24, 2015)

Petitioners seek to join a Petition that presents a single ground challenging claim 17 of the '231 Patent as obvious based on combining Loomis and Wortham. In IPR2015-01687, Petitioners previously challenged claim 17 of the '231 Patent and likewise asserted obviousness based on combining Loomis and Wortham. They lost on this issue. Paper 10 at 19 ("[W]e are not persuaded that Petitioner has established a reasonable likelihood that it would prevail with respect to claim 17 as obvious over Loomis and Wortham."). Petitioners now seek a second bite at the apple using the Board's guidance from its prior Decision to try to correct deficiencies in their original Petition. Petitioners' Motion and second-try Petition should be rejected.

The controlling statute, 35 U.S.C. Section 315(c), provides:

> 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.[1]

Based on this statute, the Board should reject Petitioners' Motion and corresponding Petition for two independent reasons:

Reason 1: Petitioners cannot join their own Petition.

[1] Emphasis added unless otherwise noted.

Reason 2: Relevant factors that the Board considers before exercising its discretion to grant Petitioners' Motion and institute Petitioners' second-try Petition demonstrate that the Board should not exercise its discretion here.

Each reason is addressed in turn.[2]

I. Petitioners cannot circumvent Section 315(b)'s one-year statutory bar by filing a new Petition and then joining it to their own Petition.

PTAB panels have correctly determined, based on persuasive reasoning, that "35 U.S.C. § 315(c) does not permit the joinder of a party to a proceeding in which it already is a party." *Eizo Corporation v. Barco N.V.*, IPR2014-00778, Paper 18 at 8 (Oct. 10, 2014) (McKone concurring); *SkyHawke Technologies, LLC. v. L&H Concepts, LLC*, IPR2014-01485, Paper 13 at 3 (March 20, 2015) ("A person cannot be joined as a party to a proceeding in which it is already a party").

As explained in detail in these (and other) decisions, precluding a party from joining its own petition:

- is consistent with "the plain language of § 315(c)" and "harmonious with the plain language of § 315(b)" (*Target Corp. v. Destination Maternity Corp.*, IPR2014-00508, Paper 18 at 11 (Sept. 25, 2014));
- is supported by the legislative history (*SkyHawke*, IPR2014-01485, Paper 13

[2] For purposes of this Opposition, Patent Owner does not dispute Petitioners' Facts 1-9 but disputes Facts 10 and 11.

at 4 ("the legislative history supports our view that § 315(c) provides for joinder of only a person who is not already a party to the proceeding"));

- "reduces Patent Owner harassment" (*Target*, IPR2014-00508, Paper 18 at 10); and
- "reduces the burden on Office resources" (*Target*, IPR2014-00508, Paper 14 at 10-11).

Because Petitioners are seeking to join "a proceeding in which [they] already [are] a party" (*Eizo*, IPR2014-00778, Paper 18 at 8), this Motion should be denied.

III. The Board should not exercise its discretion and permit Petitioners' Motion and second-try Petition.

The Director "in his or her discretion, may join" someone to an IPR. 35 U.S.C. 315§(c); *Microsoft Corp. v. Biscotti Inc.*, IPR2015-01054, Paper 10 at 7 (Oct. 22, 2015) ("the decision to grant joinder is discretionary"). As the moving parties, Petitioners have the burden of demonstrating that joinder is justified and that the Board should exercise its discretion. 37 C.F.R. § 42.20(c) ("The moving party has the burden of proof.").

In determining whether to exercise its discretion to permit joinder, the Board considers whether the petition that is proposed to be joined to an instituted IPR is one "that warrants the institution of an *inter partes* review." 35 U.S.C. §315(c)). When evaluating whether institution is warranted for second-try petitions—

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