

Paper No. _____

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SIERRA WIRELESS AMERICA, INC.,
SIERRA WIRELESS, INC. and RPX CORP.,

Petitioner,

v.

M2M SOLUTIONS LLC
Patent Owner

Case IPR2016-00853
Patent 8,648,717

PATENT OWNER'S OPPOSITION TO MOTION FOR JOINDER

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TABLE OF CONTENTS

I. OBJECTIONS TO STATEMENT OF MATERIAL FACTS.....2

II. BACKGROUND2

III. ARGUMENT.....4

 A. Petitioner is not entitled to a “second bite at the apple” and fails to meet its burden that joinder is appropriate.....4

 i. Joinder should be denied where the second-filed petition is an attempt to cure the deficiencies of the first-filed petition.....4

 ii. Petitioner used the Board’s decision as a roadmap to attempt to address the deficiencies in its First Petition.....6

 iii. Joinder is not appropriate for any of Petitioner’s reasons9

 B. Petitioner cites to decisions granting joinder that are not applicable to the circumstances of this case.....10

 C. Petitioner also fails to meet its burden of proof regarding impact on trial schedule and simplifications for briefing and discovery12

 D. The Board should deny Petitioner’s Motion because the statute does not authorize joinder of the same party to an instituted IPR.....14

IV. CONCLUSION.....15

TABLE OF AUTHORITIES

Page(s)

Cases

ABB Inc. v. Roy-G-Biv Corp., IPR2013-00286 (PTAB Aug. 9, 2013)12

Apotech, Inc. v. Synopsys, Inc.,
IPR2015-00760, (PTAB July 21, 2015)8

Ariosa Diagnostics v. ISIS Innovation Limited, IPR2013-0025011

Butamax Adv. Biofuels LLC v. Gevo, Inc.,
IPR2014-00581, (PTAB Oct. 14, 2014)6

Dell Inc. v. Network-1 Sec. Solutions, Inc., IPR2013-00385 (PTAB
July 29, 2013).....10, 12

LG Electronics, Inc. v. ATI Technologies ULC,
IPR2015-01620, (PTAB Feb. 2, 2016).....1, 5, 9

Medtronic, Inc. et al. v. Endotach LLC,
IPR2014-00695, (PTAB Sept. 25, 2014).....6

Micro Motion, Inc. v. Invensys Systems, Inc.,
IPR2014-01409, (PTAB Feb. 15, 2015).....5

Microsoft Corp. v. Proxycorr, Inc., IPR2013-00109 (PTAB Feb. 25,
2013)11

Samsung Electronics Co., Ltd., et al. v. Affinity Labs of Texas, LLC,
IPR2015-00820, (PTAB May 15, 2015)5

Samsung Electronics Co., Ltd., et al. v. Affinity Labs of Texas, LLC,
IPR2015-00821, (PTAB May 15, 2015)5

Samsung Electronics Co., Ltd. v. Virginia Innovation Sciences, Inc.,
IPR2014-00557 (PTAB June 13, 2014)11

Skyhawk Tech., LLC v. L&H Concepts, LLC,
IPR2014-01485, (PTAB Mar. 20, 2015)14

<i>Sony Corp. v. Yissum Res. & Dev. Co. of the Hebrew Univ. of Jerusalem</i> , IPR2013-00326 (PTAB Sept. 24, 2013)	10, 11
<i>Standard Innovation Corp. v. Lelo, Inc.</i> , IPR2014-00907, slip op. (PTAB Dec. 1, 2014).....	5
<i>Target Corp. v. Destination Maternity Corp.</i> , IPR2014-00508 (PTAB Feb. 12, 2015)	11, 14
Statutes	
35 U.S.C. § 102(b)	2
35 U.S.C. § 315(b)	1, 4, 5
35 U.S.C. § 315(c)	1, 4, 14
35 U.S.C. § 325(d)	6
Other Authorities	
37 C.F.R. § 42.20(c).....	4

Patent Owner's Opposition to Motion for Joinder
IPR2016-00853

Patent Owner, M2M Solutions LLC ("M2M"), respectfully requests that the Board deny Sierra Wireless America Inc.'s, Sierra Wireless Inc.'s and RPX Corp.'s (collectively, "Petitioner") Motion for Joinder to Related Instituted *Inter Partes* Review ("Motion") filed on April 8, 2016. (Paper 4.) Petitioner's Motion seeks to join IPR2016-00853 ("Second Petition") filed April 8, 2016, to IPR2015-01823 ("First Petition"), instituted by the Board on March 8, 2016. Petitioner seeks joinder because its Second Petition is time barred under 35 U.S.C. § 315(b) as it was filed more than one year after Petitioner was served with a complaint alleging infringement of U.S. Patent No. 8,648,717. Further, the Second Petition challenges the same four claims from the '717 patent that the Board denied instituting trial on that Petitioner challenged in the First Petition. However, the Board has used its discretion under 35 U.S.C. § 315(c) repeatedly to deny joinder when a petitioner uses a prior institution as a guide to remedy deficiencies in the first petition. *See, e.g., LG Electronics, Inc. v. ATI Technologies ULC*, IPR2015-01620, slip op. at 10-11 (PTAB Feb. 2, 2016) (Paper 10).

Consistent with Board precedent, the Board should deny Petitioner's Motion. Petitioner's Second Petition is nothing more than an attempt at a "second bite at the apple" and Petitioner is not entitled to cure the deficiencies of its First Petition to again challenge claims 2, 7, 14, and 30 of the '717 patent. The facts of this case and Petitioner's arguments do not support its Motion, but instead weigh

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