

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 B2

Before KALYAN K. DESHPANDE, JUSTIN T. ARBES, and
DANIEL J. GALLIGAN, *Administrative Patent Judges*.

GALLIGAN, *Administrative Patent Judge*.

ORDER
Conduct of Proceeding
37 C.F.R. § 42.5

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On March 8, 2016, we issued a decision in IPR2015-01823 instituting an *inter partes* review of claims 1, 3, 5, 6, 10–13, 15–24, and 29 of U.S. Patent No. 8,648,717 B2 (“the ’717 patent”) but denying institution as to dependent claims 2, 7, 14, and 30 of the ’717 patent. *Sierra Wireless Am., Inc. v. M2M Solutions LLC*, Case IPR2015-01823, Paper 16, 2, 25–26. On April 8, 2016, Petitioner (Sierra Wireless America, Inc., Sierra Wireless, Inc., and RPX Corp.) filed a second Petition (IPR2016-00853) requesting *inter partes* review of claims 2, 7, 14, and 30 of the ’717 patent and a Motion for Joinder seeking to have the second Petition joined to IPR2015-01823. Papers 1, 4.

On May 4, 2016, counsel for Petitioner requested a conference call to discuss potential modifications to the schedule in this matter. In the email requesting the call, counsel for Petitioner indicated the parties had met and conferred regarding schedule modifications but could not reach agreement.

On May 9, 2016, a conference call was held with the Board. Petitioner explained that, because the present matter involves the four dependent claims on which institution was denied in IPR2015-01823, Petitioner is interested in adjusting the schedule, including expediting the deadline for Patent Owner’s Preliminary Response, so that, if joinder is granted and a trial is instituted in this matter, the deadlines in IPR2015-01823 would not be adversely impacted.

Patent Owner argued Petitioner’s proposed deadline of May 20, 2016, for Patent Owner’s Preliminary Response is unreasonable, noting that the Patent Owner Response in IPR2015-01823 is due on May 25, 2016, and, therefore, expediting the deadline for its Preliminary Response in this case to May 20, 2016, would significantly impact Patent Owner. Patent Owner

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represented it prefers to have the entire period typically permitted by the Rules for its Preliminary Response. Patent Owner opposes joinder, and Patent Owner timely filed its opposition to the Motion for Joinder. *See* Paper 9. We took the matter under advisement.

The Notice of Filing Date Accorded to the Petition was filed on April 12, 2016, and states that the deadline for Patent Owner's Preliminary Response is three months from the date of the notice, i.e., July 12, 2016. *See* Paper 5, 2; 37 C.F.R. § 42.107(b) ("The preliminary response must be filed no later than three months after the date of a notice indicating that the request to institute an *inter partes* review has been granted a filing date."). However, our Rules also provide the Board authority to modify default deadlines. 37 C.F.R. § 42.5(c)(1) ("The Board may set times by order. Times set by rule are default and may be modified by order. Any modification of times will take any applicable statutory pendency goal into account.").

We determine that advancing the deadline for Patent Owner's Preliminary Response in this proceeding by three weeks is appropriate under the circumstances and will not unduly burden Patent Owner.

Accordingly, it is:

ORDERED that the deadline for Patent Owner to file its Preliminary Response in IPR2016-00853 is June 21, 2016.

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