

Patent No. 8,648,717

Paper No. \_\_\_\_\_

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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

Petitioners

v.

M2M SOLUTIONS LLC  
Patent Owner

Patent No. 8,648,717  
Issue Date: February 11, 2015  
Title: PROGRAMMABLE COMMUNICATOR

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*Inter Partes* Review No. IPR2016-00853

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PETITIONERS' REPLY IN SUPPORT OF ITS MOTION FOR JOINDER

## **I. Introduction**

The Board has routinely granted self-joinder under 35 U.S.C. §315(c) under similar circumstances. Joinder is proper here because it would result in increased efficiencies, would prevent an invalid patent from being asserted in litigation, and because M2M has not demonstrated that it would suffer any harm or prejudice.

This petition should not be denied as a “second bite at the apple”.

## **II. Argument**

### **A. The Second Petition is Not a “Second Bite at the Apple”**

The need for a second petition is a direct result of M2M’s inconsistent positions relating to the scope of the claims in litigation and these proceedings. On May 15, 2005, M2M served Sierra Wireless with infringement contentions that identify features of the accused products as performing the authentication of claim 1, and the additional functions of dependent claims 2, 7, 14 and 30. Ex. 1017 at, e.g., p. 5-7 (the SIM card includes FDN, modules have SIM interface for connecting to and controlling the SIM card, the SIM card contains the PIN2 required for verification and non-specific software processes the AT commands to verify the PIN2 is accurate), p.13-16, 22-25, 38-41, 56-59 (Ready Agent or Smart Automation allegedly process data and cause the data to be transmitted). Specifically, M2M’s infringement contentions assert with respect to the “processing module” limitation of claim 1 that the SIM card of the accused

products includes a SIM card containing the FDN, which is “a memory module for storing telephone numbers, corresponding to remote devices, including remote monitoring devices.” Ex. 1017 at p. 6. M2M’s contentions continue by alleging that the accused products “support a combination of AT commands that collectively allow for the editing of a facility locked FDN phonebook... if used in conjunction with a required PIN2 password (i.e., a ‘coded number’) when the FDN phonebook has a facility lock applied.” *Id.* Both parties’ experts agree that it is the SIM card that performs this authentication.<sup>1</sup> M2M’s contentions then point to a different processor (a Monitoring Engine in the AirVantage Ready Agent and a Smart Automation Ready Agent software module allegedly residing in firmware) as performing the additional functions required by dependent claims 2, 7, 14 and 30. *Id.* at p.13-16, 22-25, 38-41, 56-59.

Petitioners reasonably relied on M2M’s infringement contentions when they filed the first petition on August 26, 2015. To save its claims, M2M argued that the processor has to be the same. *Sierra*, IPR2015-01823, Paper 11 at p. 40-43, 45-47. The Board’s decision denied institution of claims 2, 7, 14 and 30 based on M2M’s newly advanced position. However, as noted by M2M’s own expert, the SIM card application has the capability for processing the data for authentication; a different

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<sup>1</sup> See e.g., Exhibit 1013 (Declaration of Dr. Kevin Negus) at 79-83, 84, 87, 93-95 and IPR2015-01823, Exhibit 2011 at ¶87).

processor – the software on the device - performs the functions of dependent claims 2, 7, 14 and 30 in the infringement contentions. Accordingly, it is M2M's conflicting positions that have resulted in a need for a second petition. When the facts demonstrate that joinder is appropriate, as they do here, the Board has repeatedly allowed them. See *Ariosa*, Paper 104 at 6; see also *Target*, IPR2014-00508, Paper 28 at 16.

### **B. The Merits Warrant Joinder**

The second petition is limited to four dependent claims – Claims, 2, 7, 14 and 30. It relies on the same primary prior art references as the first petition, relying on one additional prior art reference that is part of the record of the first petition, and one additional prior art reference that is not part of the record of the first petition – added to address the limitations of these dependent claims. Accordingly, the prior art references in the first and second petitions are overlapping. Addition of the four dependent claims would not overcomplicate the proceedings – a minimal additional amount of work is required to review Claims 2, 7, 14 and 30. See, e.g., *Ariosa*, IPR2013-00250, Paper 24, p. 2-5; *Microsoft*, IPR2013-00109, Paper 15, p. 4-5; and *Samsung*, IPR2014-00557, Paper 10, p. 17-18.

M2M does not identify any harm that it would suffer as a result of institution of the proceedings based on the second petition and granting of the joinder motion;

instead, M2M merely argues that Petitioners have not met their burden regarding the impact on trial schedule and simplifications for briefing and discovery.

However, Petitioners, as noted in M2M's Opposition, will agree to changes in the schedule of the second petition that would result in little impact in the schedule of the first Petition. Additionally, the Board has discretion to accelerate the deadlines for M2M to file its response to the petition and motion to amend, which is reasonable given that the second petition only relates to four dependent claims. In any event, minor readjustments to the schedule are not sufficiently prejudicial to deny joinder. *Microsoft*, Paper 15 at 4; *Samsung*, Paper 10 at 18.

The cases cited by M2M in which joinder was denied involved significantly different circumstances. For example, in *Butamax*, the Board denied institution and joinder because the second Petition presented substantially the same prior art, and substantially the same arguments as the first petition. IPR2014-00581, Paper 8, p. 7-8. By contrast, in the present case, the second petition presents additional prior art references and different arguments than those presented in the first petition. These additional prior art references and different arguments were necessitated by M2M's changing positions regarding the meaning and scope of the four dependent claims, as set forth above.

In numerous cases, presenting similar circumstances, the Board has found joinder appropriate. See, e.g., *Ariosa*, IPR2013-00250, Paper 24, p. 2-5; *Microsoft*,

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