

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*.

Opinion for the Board filed by *Administrative Patent Judge* DESHPANDE.

Opinion Concurring filed by *Administrative Patent Judge* GALLIGAN.

DESHPANDE, *Administrative Patent Judge*.

DECISION

Denying Joinder and Denying Institution of *Inter Partes* Review
37 C.F.R. §§ 42.108, 42.122(b)

I. INTRODUCTION

Sierra Wireless America, Inc., Sierra Wireless, Inc., and RPX Corp. (collectively, “Petitioner”) filed a Petition (Paper 1, “Pet.”) requesting *inter partes* review of claims 2, 7, 14, and 30 of U.S. Patent No. 8,648,717 B2 (Ex. 1001, “the ’717 patent”) and a Motion for Joinder (Paper 4, “Mot.”) seeking to have this Petition joined to IPR2015-01823. M2M Solutions LLC (“Patent Owner”) filed an Opposition (Paper 9, “Opp.”) to Petitioner’s Motion for Joinder as well as a Preliminary Response to the Petition (Paper 14, “Prelim. Resp.”). Petitioner filed a Reply (Paper 12, “Reply”) to Patent Owner’s Opposition.

We have jurisdiction under 35 U.S.C. § 314(a). For the reasons that follow, Petitioner’s Motion for Joinder and Petition are *denied*.

Related Case IPR2015-01823

On August 26, 2015, Petitioner filed a Petition to institute an *inter partes* review of claims 1–3, 5–7, 10–24, 29, and 30 of the ’717 patent. IPR2015-01823, Paper 1. On March 8, 2016, the Board instituted an *inter partes* review of claims 1, 3, 5, 6, 10–13, 15–24, and 29. IPR2015-01823, Paper 16, 32–33 (“-1823 Dec. on Inst.”). The Board did not institute an *inter partes* review of claims 2, 7, 14, and 30. *Id.* at 25–26, 33. Petitioner subsequently filed, on April 8, 2016, its Petition in the instant proceeding challenging claims 2, 7, 14, and 30, and a Motion for Joinder requesting that this proceeding be joined with IPR2015-01823.

II. MOTION FOR JOINDER

The Leahy-Smith America Invents Act, Pub. L. No. 112-29 (2011), permits joinder of like review proceedings. Thus, an *inter partes* review may be joined with another *inter partes* review. The statutory provision governing joinder of *inter partes* review proceedings is 35 U.S.C. § 315(c), which provides:

JOINDER.—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.

Thus, joinder may be authorized when warranted, but the decision to grant joinder is discretionary. 35 U.S.C. § 315(c); 37 C.F.R. § 42.122. The Board determines whether to grant joinder on a case-by-case basis, taking into account the particular facts of each case, substantive and procedural issues, and other considerations.

As the movant, Petitioner bears the burden to show that joinder is appropriate. 37 C.F.R. § 42.20(c). A motion for joinder should: (1) set forth the reasons why joinder is appropriate; (2) identify any new ground(s) of unpatentability asserted in the petition; and (3) explain what impact (if any) joinder would have on the trial schedule for the existing review. *See* Frequently Asked Question H5 on the Board's website at <http://www.uspto.gov/ip/boards/bpai/prps.jsp>. Petitioner should specifically address how briefing and/or discovery may be simplified to minimize schedule impact. *See Kyocera Corp. v. SoftView LLC*, Case IPR2013-

00004, slip op. at 4 (PTAB Apr. 24, 2013) (Paper 15) (representative); Mot. 5.

Petitioner argues that its Motion for Joinder is timely and joinder is appropriate because of efficiency, public policy considerations, and a lack of prejudice to Patent Owner. Mot. 5–8. Petitioner further sets forth that the instant Petition generally relies upon substantially the same prior art and the same declarant as Petitioner relied upon in IPR2015-01823. *Id.* at 6–7.

Petitioner also argues generally that joinder will not result in unnecessary delay. *Id.* at 9. Specifically, Petitioner asserts it is “willing to forfeit a reasonable portion[] of its response period to the extent that it is deemed necessary” and Petitioner “will also accommodate any reasonable logistical or scheduling request” of Patent Owner. *Id.*; Reply 4 (stating that Petitioner will agree to unspecified “changes in the schedule”).

Patent Owner argues Petitioner has not met “its burden of proof for explaining the impact joinder would have on the trial schedule for the existing review or to address specifically how briefing and discovery may be simplified.” Opp. 12. Specifically, Patent Owner argues that although Petitioner generally states that Petitioner is willing to forfeit reasonable portions of its response period and will accommodate reasonable logistical and scheduling requests, Petitioner does not set forth any specific impact joinder would have on the trial schedule. *Id.* at 12–13. Patent Owner further argues that Petitioner’s “Motion is silent” as to how briefing and discovery may be simplified. *Id.*

We agree with Patent Owner. Petitioner does not explain specific modifications to the schedule that would be necessary to account for the additional issues, grounds, and prior art raised in the Petition. *See* Mot. 9;

Reply 4. Indeed, the *inter partes* review in IPR2015-01823 involves four prior art references (Whitley, SIM Specification, Kail, and Eldridge) and three grounds of unpatentability. -1823 Dec. on Inst. 32–33. The Petition in the instant proceeding raises two additional prior art references (SIM Application Toolkit and SIM API Spec.) and asserts two additional prior art grounds challenging four claims, with new declarant testimony for the newly asserted grounds. Pet. 6–9.

Nor does Petitioner explain how briefing and discovery may be simplified. As noted by Patent Owner, Petitioner filed the instant Petition a full month after the Institution Decision in IPR2015-01823 and only six weeks before the deadline for Patent Owner’s Response in IPR2015-01823. Opp. 9; *see* IPR2015-01823, Paper 19, 6. Petitioner’s general statements of forfeiting “reasonable” periods of its response period and accommodating “reasonable” logistical and scheduling requests does not address sufficiently the impact joinder would have on the trial schedule of IPR2015-01823, particularly given that Patent Owner already filed its Response on May 25, 2016. As such, Petitioner has not provided sufficient explanation as to how such timing would impact the trial schedule for IPR2015-01823 or any modifications to the trial schedule that would be necessary to accommodate joinder.

We also note that, under the circumstances, joinder would have a significant adverse impact on the Board’s ability to complete the existing proceeding in a timely manner, which weighs against granting the Motion for Joinder. The Board is charged with securing the just, speedy, and inexpensive resolution of every proceeding, and has the discretion to join or not join proceedings to ensure that objective is met. 37 C.F.R. §§ 42.1(b),

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