

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 IPR2016-01073
Patent 8,648,717

PATENT OWNER'S OPPOSITION TO MOTION FOR JOINDER

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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 May 19, 2016. (Paper 2.) Petitioner’s Motion seeks to join IPR2016-01073 (“SW Petition”) filed May 19, 2016, to IPR2015-00055 (“Telit Petition”), filed by Petitioner Telit Wireless Solutions Inc. and Telit Communications PLC (collectively, “Telit”), instituted by the Board on April 22, 2016. Petitioner seeks joinder because its SW 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.

Where a petition is time barred and petitioner has failed to meet its burden why joinder is appropriate, the Board has denied motions for joinder. *Samsung Electronics Co., Ltd., et al. v. Arendi S.A.R.L.*, IPR2014-01142, slip op. at 7, (PTAB Oct. 2, 2014) (Paper 11). Consistent with Board precedent, the Board should deny Petitioner’s Motion. Contrary to Petitioner’s unsupported conclusory statement, joinder will substantially prejudice M2M. The Board should deny the Motion. At most, the Board should permit joinder only on the condition that Petitioner not file any briefs or other papers in this action or participate in depositions or the final hearing.

I. OBJECTIONS TO STATEMENT OF MATERIAL FACTS

1. M2M does not object to Petitioner's Material Fact Nos. 1-8.

II. BACKGROUND

M2M filed its complaint against Petitioner for infringement of the '717 patent in the District Court of Delaware on August 26, 2014. On April 22, 2016, the Board instituted trial on claims 1-24 and 29 and denied trial for claims 25-28 and 30 in IPR2016-00055, the Telit Petition. On May 19, 2016, nearly 21 months after being served with the complaint (nearly nine months after the one-year time bar), Petitioner filed its SW Petition challenging the same claims that the Board instituted trial on in the Telit Petition.

III. ARGUMENT

A. Petitioner fails to meet its burden of proof regarding impact on trial schedule and simplifications for briefing and discovery

The Board has denied motions for joinder where the petition has failed to discuss any specific impact on the schedule in the instituted petition, failed to set forth how briefing and discovery may be simplified, nor offered evidence that the petitioner in the instituted petition has agreed to coordinate with the second petitioner. *See Samsung*, IPR2014-01142, slip op. at 5 (Paper 11). Here, Petitioner likewise fails to meet its burden, and the Board should deny Petitioner's motion for joinder and deny institution of its petition as barred by statute. 35 U.S.C. § 315(b).

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