

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. IPR2016-01073

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PETITIONERS' REPLY IN SUPPORT OF ITS MOTION FOR JOINDER

## I. Introduction

The Board has routinely granted joinder under 35 U.S.C. §315(c) of “copycat” petitions 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.

## II. Argument

Petitioners’ Petition in this case is identical to the Petition filed by Telit as to the grounds on which the Board granted institution. IPR2016-01073, Paper 2, p. 3, Statement of Fact (SOF) 7. It relies on the same prior art references, arguments and evidence as the Telit Petition. *Id.* Accordingly, the prior art references, evidence and arguments are identical. No additional work is required to review this petition, and joinder is routinely granted when such “copycat” petitions are filed. See, e.g., *Cisco*, IPR2015-01397, Paper 9, pp. 2-3; *Hyundai*, IPR2014-01543, Paper No. 11, pp. 5; *Dell*, IPR2013-00385, Paper No. 17, pp. 8-10; *Motorola*, IPR2013-00256, Paper 10, pp. 8-10.

M2M cites *Samsung* (IPR2014-01142) as a basis for denying the motion for joinder. However, the joinder issues in this case differ substantially from the joinder issues in IPR2014-00208. Cf. IPR2016-01073, Paper 2 and IPR2014-001142, Paper 11. In *Samsung*, Samsung’s joinder motion was denied because

Samsung's Petition was different than the Petition in the proceeding it sought to be joined with, but failed to identify any differences in the two Petitions. *Id.* at 4-5. In *Samsung*, the joinder motion was also denied because Samsung's Petition also relied on a different expert who presented different arguments than those presented in the Petition in the proceeding it sought to be joined with (i.e., new evidence and new arguments would have been introduced into the joint proceeding). *Id.* at 5-6. Neither of these circumstances exist here. Here, the Petitions and the evidence are identical on the grounds on which the Board instituted review, and include the same analysis, prior art exhibits, and expert testimony. IPR2016-01073, Paper 2, p3., SOF 7. Petitioners also presented the grounds on which Telit had requested rehearing, and agreed to be bound by the Board's decision on the request for rehearing. *Id.*

In its joinder motion, Samsung also did not set forth how briefing or discovery would be simplified nor did it submit that it would agree to or will work with the petitioner in that case to manage simplification of briefing and discovery. IPR2014-01142, Paper 11, p. 5. By contrast, Petitioners agreed not to conduct additional depositions or other discovery so that all discovery in the joined proceeding will be completed within the ordinary time limits of the original Telit IPR proceeding. IPR2016-01073, Paper 2, p. 11. Petitioners likewise agreed to coordinate with Telit to simplify briefing and discovery, and will be bound by any

orders the Board issues to simplify briefing and discovery (including whether separate filings will be permitted or not). *Id.*, pp. 10-11.

The only harm M2M identifies that it would suffer as a result of institution of the proceedings based on the second petition and granting of the joinder motion are the very minimal additional costs M2M might incur to prepare responses to the theoretical separate filings by Petitioners. Petitioners do not anticipate any disagreements with Telit that would result in any such separate filings. The need to respond to such theoretical additional filings is a minimal cost that should not justify denial of joinder. See, e.g., *Hyundai*, IPR2014-01543, Paper No. 11 at 5. Petitioners further note that the Board may decline to permit such separate filings. Accordingly, any prejudice to Petitioners far outweighs the minimal if any prejudice to M2M.

### **III. Conclusion**

For the foregoing reasons, Petitioners respectfully request that the Board grant its Motion and join Petitioners' third '717 Petition with IPR2016-00055.

Respectfully submitted,

Dated: July 20, 2016

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U.S. Patent No. 8,648,717  
Reply ISO Motion for Joinder

**CERTIFICATE OF SERVICE**

The undersigned hereby certifies that a copy of the foregoing Reply in Support of Motion for Joinder to Related Instituted *Inter Partes* Review was served in its entirety on July 20, 2016 by e-mail on the following individuals:

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