

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

TELIT WIRELESS SOLUTIONS INC. &

TELIT COMMUNICATIONS PLC,

Petitioner,

v.

M2M SOLUTIONS LLC,

Patent Owner.

Inter Partes Review No. 2016-01081

U.S. Patent No. 8,648,717

Issued: Feb. 11, 2014

Title: Programmable Communicator

**PETITIONER'S MOTION FOR JOINDER TO
INSTITUTED IPR 2016-00055 UNDER 37 C.F.R. § 42.122(B)**

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List of Materials Considered

Ex. No.	Description
1231	Brief for Intervenor – Director of the USPTO in <i>Yissum Research Dev. Corp. v. Sony Corp.</i> , Appeal No. 2015-1342, Request for Rehearing (United States Court of Appeals for the Federal Circuit), June 25, 2015

This Exhibit number refers to the exhibit listed in the Petition for *Inter Partes* Review this Motion accompanies.

I. PRECISE RELIEF REQUESTED

Pursuant to 35 U.S.C. § 315(c) and 37 C.F.R. § 42.122(b), Telit Wireless Solutions, Inc. and Telit Communications PLC (“Petitioner”) moves to join its Petition for *Inter Partes* Review (“Accompanying Petition”) of U.S. Patent No. 8,648,717 (“the ‘717 Patent”), filed contemporaneously herewith, with Petitioner’s *Inter Partes* Review Case No. IPR2016-00055, instituted on April 22, 2016 (“the Instituted IPR”).

The Accompanying Petition should be instituted, and the two IPRs should be joined, because there will be no prejudice to Patent Owner, and the benefit of joinder significantly outweighs any potential detriment. 37 C.F.R. § 42.1(b).

The Accompanying Petition proposes a single ground of rejection for five dependent claims based on the same prior art combination as ground **B** instituted for twenty claims 1-3, 5-18, 22, 23, and 29 in IPR2016-00055, Paper 9 p. 48:

Ground	Claim(s)	Reference(s)	Statute (Pre-AIA)
1	25-28 and 30	Van Bergen and Bettstetter	35 U.S.C. § 103(a)

The Accompanying Petition adds no new prior art. The same expert is being used for both Petitions so there will be no delays or added cost for additional depositions or discovery. The claims in the Accompanying Petition are nearly identical to instituted claims in the Instituted IPR. *See* Comparison of Claims in the Accompanying Petition at 34-39 (markings indicating differences between claims).

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