

Paper No. _____

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

TELIT WIRELESS SOLUTIONS INC. AND
TELIT COMMUNICATIONS PLC.,
Petitioner,
v.

M2M SOLUTIONS LLC
Patent Owner

Case IPR2016-01081
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 Telit Wireless Solutions Inc.’s and Telit Communications PLC’s (collectively, “Petitioner”) Motion for Joinder to Related Instituted IPR2016-00055 Under 37 C.F.R. § 42.122(B) (“Motion”) filed on May 23, 2016. (Paper 4.) Petitioner’s Motion seeks to join IPR2016-01081 (“Second Petition”) filed May 23, 2016, to IPR2016-00055 (“First Petition”), instituted by the Board on April 22, 2016. Petitioner seeks joinder because its Second 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. Further, the Second Petition challenges the same five claims from the ’717 patent that the Board denied instituting trial on in the First Petition. However, the Board has repeatedly used its discretion under 35 U.S.C. § 315(c) to deny joinder when a petitioner uses a prior institution as a guide to attempt to remedy deficiencies in the first petition. *See, e.g., LG Electronics, Inc. v. ATI Technologies ULC*, IPR2015-01620, slip op. at 10-11 (PTAB Feb. 2, 2016) (Paper 10). Further, the Board has consistently used its discretion under 35 U.S.C. § 325(d) to deny a “[p]etition because ‘the same or substantially the same prior art or arguments previously were presented to the Office.’” *See, e.g., T-Mobile US, Inc., et al. v. TracBeam, LLC*, IPR2016-00728, slip op. at 14 (PTAB May 25, 2016) (Paper 11).

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