

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

T-MOBILE USA, INC.,
Petitioner,

v.

VOIP-PAL.COM, INC.,
Patent Owner.

Case Nos. IPR2023-00640 & IPR2023-00641
U.S. Patent No. 10,880,721

PETITIONER'S MOTION FOR JOINDER

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I. STATEMENT OF PRECISE RELIEF REQUESTED

Pursuant to 35 U.S.C. § 315(c) and 37 C.F.R. § 42.122(b), Petitioner T-Mobile USA, Inc. moves for joinder with the *Inter Partes* Reviews instituted in *Meta Platforms, Inc. v. VoIP-Pal, Inc.*, IPR2022-01234 and IPR2022-01235, instituted on January 31, 2023 (“the Meta proceedings”), for U.S. Patent No. 10,880,721 (“the ’721 patent”). This motion is timely because it is filed “no later than one month after the institution date of any *inter partes* review for which joinder is requested.” 37 C.F.R. § 42.122(b). Petitioner has consulted with counsel for Meta Platforms, Inc. (“Meta”), and Meta does not oppose Petitioner’s request.

Petitioner requests institution of the Petitions for *Inter Partes* Review filed concurrently herewith (the “Petitions”). The Petitions are substantively identical to the petitions filed in Meta proceedings (“Meta’s petitions”). The Petitions and Meta’s petitions challenge the same claims, on the same grounds, and rely on the same prior art and evidence, including the same declaration from the same expert. Petitioner agrees to proceed solely on the grounds, evidence, and arguments advanced, or that will be advanced, in the instituted Meta proceedings. The Petitions should therefore be instituted under 35 U.S.C. § 314 for the same reasons as the instituted Meta proceedings, and Petitioner’s joinder to the instituted Meta proceedings is appropriate under 35 U.S.C. § 315(c).

Petitioner further confirms that it will act as an “understudy” in the Meta

proceedings. Meta will maintain the lead role in the proceedings so long as it is a party, and Petitioner will not assume an active role unless Meta ends its participation. Petitioner's understudy role will avoid lengthy and duplicative briefing, and Petitioner will not seek additional depositions or deposition time either. Petitioner further agrees to the foregoing conditions even if additional petitioners are joined. Accordingly, the proposed joinder will neither unduly complicate the Meta proceedings nor delay their schedule. To the contrary, joinder will help efficiently resolve invalidity disputes among the impacted parties so that a single Board decision may dispose of the invalidity issues raised for all interested parties. *See* 35 U.S.C. § 315(e)(2).

Finally, the Board should use its discretion to institute the Petitions and grant joinder. The *General Plastic* factors for discretionary denial do not apply to a “me-too” petition coupled with a timely motion to join. *See, e.g., Celltrion, Inc. v. Genentech, Inc.*, IPR2018-01019, Paper 11, at 9-11 (PTAB Oct. 30, 2018). But even if the factors did apply, the factors favor joinder here. As an initial matter, Petitioner could not have joined the Meta proceedings previously because those petitions were filed after Petitioner's one-year statutory bar under 35 U.S.C. § 315(b). While Petitioner previously filed “me-too” petitions seeking to join petitions filed by Google LLC in IPR2022-01074 and IPR2022-01075 (the “Google petitions”), those petitions were conditioned upon institution of the Google proceedings, which

was denied. *See* Paper 5, at 1, IPR2022-01180, IPR2022-01181. The Board accordingly denied Petitioner’s conditional petitions and joinder requests based on denial of the Google petitions. Paper 11, at 2-3, IPR2022-01180, IPR2022-01181. Petitioner has therefore never received an individual merits consideration before the Board on the ’721 patent. There are also no “road-mapping” concerns here because the Meta petitions Petitioner seeks to join were filed only weeks after the Google petitions and could not have benefitted from the subsequent briefing and institution decision. Moreover, Petitioner has stipulated before and stipulates again under *Sotera* that Petitioner will not pursue any grounds raised, or that reasonably could have been raised, in these proceedings in the district court action if the Petitions are instituted. Institution and joinder of the Petitions is therefore appropriate.

II. BACKGROUND AND RELATED PROCEEDINGS

VoIP-Pal.com, Inc. (“Patent Owner”) purportedly owns and asserts the ’721 patent in the following district court actions:

Case No.	Jurisdiction	Status
<i>VoIP-Pal.com, Inc. v. T-Mobile USA, Inc.</i> , Case No. 6:21-cv-00674	Western District of Texas	Litigation is pending.
<i>VoIP-Pal.com, Inc. v. Meta Platforms, Inc., et al.</i> , Case No. 3:22-cv-03202	Northern District of California	Litigation is pending. Transferred from Case No. 6:21-cv-00665 (W.D. Texas).
<i>VoIP-Pal.com, Inc. v. Google, LLC f/k/a Google Inc.</i> , Case No. 3:22-cv-03199	Northern District of California	Litigation is pending. Transferred from Case No. 6:21-cv-00667 (W.D. Texas).

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