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571-272-7822

Paper 11
Entered: September 29, 2016

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 B2

Before KALYAN K. DESHPANDE, JUSTIN T. ARBES, and DANIEL J. GALLIGAN, *Administrative Patent Judges*.

Opinion for the Board filed by *Administrative Patent Judge* ARBES.

Opinion Concurring filed by *Administrative Patent Judge* GALLIGAN.

ARBES, *Administrative Patent Judge*.

DECISION
Denying Institution of *Inter Partes* Review
37 C.F.R. § 42.108

Denying Petitioner's Motion for Joinder
37 C.F.R. § 42.122

Petitioners Telit Wireless Solutions Inc. and Telit Communications PLC (collectively, "Petitioner") filed a Petition (Paper 1, "Pet.") requesting *inter partes* review of claims 25–28 and 30 of U.S. Patent No. 8,648,717 B2 (Ex. 1201, "the '717 patent") pursuant to 35 U.S.C. § 311(a) and a Motion for Joinder (Paper 3, "Mot.") with Case IPR2016-00055 ("the -55 Case"). Patent Owner M2M Solutions LLC filed an Opposition (Paper 8, "Opp.") to the Motion for Joinder, to which Petitioner filed a Reply (Paper 9, "Reply"). Patent Owner did not file a preliminary response pursuant to 35 U.S.C. § 313. Pursuant to 35 U.S.C. § 314(a), the Director may not authorize an *inter partes* review unless the information in the petition and preliminary response "shows that there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition." For the reasons that follow, we deny the Petition and deny Petitioner's Motion for Joinder.

I. BACKGROUND

A. Related Proceedings

Petitions requesting *inter partes* review of the '717 patent were filed previously in Cases IPR2015-01670, IPR2015-01672, IPR2016-00054, and IPR2016-00853, all of which were denied.

On August 26, 2015, Sierra Wireless America, Inc., Sierra Wireless, Inc., and RPX Corp. (collectively, "the Sierra parties") filed a petition requesting *inter partes* review of claims 1–3, 5–7, 10–24, 29, and 30 of the '717 patent, asserting four grounds of unpatentability based on five prior art references. IPR2015-01823, Paper 1. On March 8, 2016, we instituted an *inter partes* review as to claims 1, 3, 5, 6, 10–13, 15–24, and 29 on three of

the asserted grounds, but denied institution as to claims 2, 7, 14, and 30. IPR2015-01823, Paper 16.

On October 21, 2015, Petitioner filed a petition requesting *inter partes* review of claims 1–30 of the '717 patent in the -55 Case, asserting 14 grounds of unpatentability based on seven prior art references. IPR2016-00055, Paper 1. On April 22, 2016, we instituted an *inter partes* review as to claims 1–24 and 29 on five of the asserted grounds, but denied institution as to claims 25–28 and 30. Ex. 1207 ("-55 Dec. on Inst."). Petitioner filed a request for rehearing, which was denied. *See* IPR2016-00055, Papers 11, 13. Petitioner filed its Petition and Motion for Joinder with the -55 Case in the instant proceeding on May 23, 2016.

Also, on May 19, 2016, the Sierra parties filed a petition requesting *inter partes* review of claims 1–24 and 29 of the '717 patent and a motion for joinder with the -55 Case. IPR2016-01073, Papers 1, 2. In a concurrently issued decision, we institute and grant the Sierra parties' motion for joinder.

B. The Prior Art

Petitioner relies on the following prior art:

> International Patent Application Publication No. WO 00/17021, published March 30, 2000 (Ex. 1208, "Van Bergen"); and
>
> C. Bettstetter *et al*., "GSM Phase 2+ General Packet Radio Service GPRS: Architecture, Protocols, and Air Interface," IEEE COMMUNICATIONS SURVEYS, vol. 2, no. 3 (1999) (Ex. 1209, "Bettstetter").

C. The Asserted Ground

Petitioner challenges claims 25–28 and 30 of the '717 patent as unpatentable over Van Bergen and Bettstetter under 35 U.S.C. § 103(a).[1]

II. DISCUSSION

A. Motion for Joinder

The AIA created administrative trial proceedings, including *inter partes* review, as an efficient, streamlined, and cost-effective alternative to district court litigation. The AIA permits the joinder of like proceedings. The Board, acting on behalf of the Director, has the discretion to join an *inter partes* review with another *inter partes* review. 35 U.S.C. § 315(c). Section 315(c) provides (emphasis added):

> JOINDER.—If the Director institutes an inter partes review, *the Director, in his or her discretion, may join as a party to that inter partes review any person who properly files a petition under section 311* that the Director, after receiving a preliminary response under section 313 or the expiration of the time for filing such a response, determines warrants the institution of an inter partes review under section 314.

35 U.S.C. § 315(b) bars institution of an *inter partes* review when the petition is filed more than one year after the petitioner (or the petitioner's real party-in-interest or privy) is served with a complaint alleging infringement of the patent. 35 U.S.C. § 315(b); 37 C.F.R. § 42.101(b). However, the one-year time bar does not apply to a request for joinder.

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[1] Petitioner provides, for parent independent claim 29 and dependent claims 25, 26, 27, and 30, an explanation as to how certain limitations of the claims allegedly are taught by Van Bergen and certain limitations allegedly are taught by Bettstetter. Pet. 24–34. For parent independent claim 24 and dependent claim 28, Petitioner argues that the limitations of the claims are taught by Van Bergen. *Id*. at 18–24, 29.

35 U.S.C. § 315(b) ("The time limitation set forth in the preceding sentence shall not apply to a request for joinder under subsection (c)."); 37 C.F.R. § 42.122(b). Petitioner was served with a complaint alleging infringement of the '717 patent on October 24, 2014—more than one year before filing the instant Petition. *See* Mot. 3; Opp. 2. Thus, absent joinder with the -55 Case, the Petition in this proceeding is barred.

Joinder may be authorized when warranted, but the decision to grant joinder is discretionary. *See* 35 U.S.C. § 315(c); 37 C.F.R. § 42.122. The Board determines whether to grant joinder on a case-by-case basis, taking into account the particular facts of each case, substantive and procedural issues, and other considerations. *See* 157 CONG. REC. S1376 (daily ed. Mar. 8, 2011) (statement of Sen. Kyl) (when determining whether and when to allow joinder, the Office may consider factors including "the breadth or unusualness of the claim scope" and claim construction issues). When exercising its discretion, the Board is mindful that patent trial regulations, including the rules for joinder, must be construed to secure the just, speedy, and inexpensive resolution of every proceeding. *See* 35 U.S.C. § 316(b); 37 C.F.R. § 42.1(b).

As the moving party, Petitioner has the burden of proof in establishing entitlement to the requested relief. 37 C.F.R. §§ 42.20(c), 42.122(b). A motion for joinder should: (1) set forth the reasons why joinder is appropriate; (2) identify any new ground(s) of unpatentability asserted in the petition; and (3) explain what impact (if any) joinder would have on the trial schedule for the existing review. *See* Mot. 5; Frequently Asked Question H5 on the Board's website at http://www.uspto.gov/ip/boards/bpai/prps.jsp. Petitioner should address specifically how briefing and/or discovery may be

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