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 No. IPR2023-00639
U.S. Patent No. 8,630,234

PETITIONER'S REPLY IN SUPPORT OF MOTION FOR JOINDER

TABLE OF CONTENTS

I. VOIP-PAL DOES NOT DISPUTE KEY FACTS FAVORING JOINDER....1

II. THE *GENERAL PLASTIC* FACTORS WEIGH IN FAVOR OF INSTITUTION....2

III. T-MOBILE'S *SOTERA* STIPULATION FURTHER RENDERS DISCRETIONARY DENIAL INAPPROPRIATE....5

IV. CONCLUSION....5

TABLE OF AUTHORITIES

Advanced Micro Devices, Inc. v. Monterey Research, LLC,
IPR2021-00776, Paper 13 (Oct. 13, 2021) 2, 4

Atlassian Corp. v. Express Mobile, Inc.,
IPR2022-00783, Paper 16 (Oct. 7, 2022) 3

Celltrion, Inc. v. Genentech, Inc.,
IPR2018-01019, Paper 11 (Oct. 30, 2018) 1

Code200, UAB v. Bright Data, Ltd.,
IPR2022-00861, Paper 18 (Aug. 23, 2022) 2, 3, 4

Expedia, Inc. v. Express Mobile, Inc.,
IPR2022-00785, Paper 16 (Sept. 27, 2022) 3, 4, 5

Samsung Elecs. Co. v. VoIP-Pal.com, Inc,
IPR2022-01390, Paper 12 (Mar. 16, 2023) 4

Sotera Wireless, Inc. v. Masimo Corp.,
IPR2020-01019, Paper 12 (Dec. 1, 2020) 5

T-Mobile USA, Inc. ("T-Mobile") respectfully submits this Reply to VoIP-Pal.com, Inc.'s ("VoIP-Pal") Opposition to Petitioner's Motion for Joinder (Paper 8, "Opp."). As discussed below, the circumstances here compel granting joinder.

I. VoIP-Pal Does Not Dispute Key Facts Favoring Joinder

VoIP-Pal does not dispute any of the key facts in T-Mobile's motion, and it entirely ignores the fact that the Board recently granted Samsung's joinder motion, which is materially identical to the present T-Mobile joinder motion. Likewise, VoIP-Pal does not respond to T-Mobile's analysis of the joinder factors. *See* Paper 4 ("Mot."), at 5-9. For example, VoIP-Pal does not dispute that T-Mobile's petition is substantively identical to that in *Meta Platforms, Inc. v. VoIP-PAL.com, Inc.*, IPR2022-01232 ("the Meta IPR proceeding") or that T-Mobile's petition does not propose any new grounds of unpatentability. Nor does VoIP-Pal dispute that joinder will not negatively impact the Meta IPR proceeding (which now already includes Samsung) or that T-Mobile agreed to procedures that will simplify briefing and discovery. These factors all favor joinder.

VoIP-Pal instead addresses ***discretionary*** issues under *General Plastic* (Opp. at 4-12), even though an analysis of those factors is not "particularly persuasive for establishing abuse of the review process for the situation where a different petitioner files a 'me-too' or 'copycat' petition in conjunction with a timely motion to join." *Celltrion, Inc. v. Genentech, Inc.*, IPR2018-01019, Paper 11, at 9-11 (Oct.

30, 2018). Even if they were relevant, however, which they are not, none of VoIP-Pal's discretionary-based arguments pass muster.

II. THE *GENERAL PLASTIC* FACTORS WEIGH IN FAVOR OF INSTITUTION

***General Plastic* Factor 1:** VoIP-Pal admits that additional claims are at issue in this proceeding as compared to T-Mobile's previous "me too" petition—namely claim 69. Opp. at 7. Factor 1 thus favors institution. *AMD v. Monterey Research, LLC*, IPR2021-00776, Paper 13, at 12 (Oct. 13, 2021) (factor 1 did not weigh against institution when the "me-too" petition challenged different claims from two previous petitions). VoIP-Pal claims T-Mobile's citation to *Code200, UAB v. Bright Data*, IPR2022-00861, Paper 18, at 4-5 (Aug. 23, 2022), is "[s]urprising[]." Opp. at 7. But *Code200* highlights the importance of "allowing [a petitioner] the opportunity to pursue a decision on the merits." IPR2022-00861, Paper 18, at 4-5; *see also* Mot. at 10 (quoting same). T-Mobile, like the *Code200* petitioner, did not receive individual consideration of or a substantive analysis on the merits. The *Code200* petition was discretionarily denied, whereas T-Mobile's previous petition was denied only because the petition it sought to join was not instituted. The Board's emphasis on allowing a petitioner to pursue a decision is the same, however.

***General Plastic* Factors 2, 4, and 5:** VoIP-Pal argues that T-Mobile knew about the existence of prior art references cited in the Meta IPR proceeding before

T-Mobile's first "copycat" petition. Opp. at 7-10. As an initial matter, that knowledge is irrelevant because T-Mobile did not select any art and is "merely present[ing] the same challenges that previously resulted in institution." *See Atlassian Corp. v. Express Mobile*, IPR2022-00783, Paper 16, at 10 (Oct. 7, 2022). Moreover, awareness of specific prior art references does not mean awareness of the specific combination and analysis of Meta's Petition, which T-Mobile only learned on June 30, 2022, when Meta filed its IPR Petition. T-Mobile has never therefore "filed an IPR withholding prior art" (Opp. at 11); it has only sought to join another party's existing proceedings. Thus, these factors do not weigh in favor of discretionary denial.

***General Plastic* Factor 3:** VoIP-Pal suggests factor 3 weighs in favor of discretionary denial because "Petitioner filed a prior petition in which it received patent owner's preliminary response and had received the Board's decision" before filing its copycat joinder petition. Opp. at 9. But factor 3 concerns road-mapping issues, *i.e.*, issues relating to whether a previous preliminary response or institution decision could be leveraged to gain an advantage in a later petition. *Code200*, IPR2022-00861, Paper 18, at 5; *see also Expedia, Inc. v. Express Mobile, Inc.*, IPR2022-00785, Paper 16, at 9 (Sept. 27, 2022). "'[R]oad-mapping' concerns are minimized when, as in this case, a petitioner files a later petition that raises unpatentability challenges substantially overlapping with those in the previously-

filed petition and the later petition is not refined based on lessons learned from later developments." *Code200*, IPR2022-00861, Paper 18, at 5. In fact, road-mapping "concerns simply don't apply in the case of a 'me too' Petition like this one, because Petitioner is not trying to leverage an earlier Petitioner for an unfair advantage." *Expedia*, IPR2022-00785, Paper 16, at 9; *see also* Mot. at 11-12. Thus, factor 3 weighs in favor of institution.

***General Plastic* Factor 6:** As set forth in the Motion, factor 6 weighs in favor of institution. Mot. at 13. The Board has already expended resources on the Meta IPR proceeding, which supports institution. *See AMD*, IPR2021-00776, Paper 13, at 17. Indeed, the Board recently confirmed its commitment to the Meta IPR proceeding by permitting another party, Samsung, to join the proceeding. *Samsung Elecs. Co. v. VoIP-Pal.com, Inc*, IPR2022-01390, Paper 12 (Mar. 16, 2023) (granting joinder). VoIP-Pal does not point to any substantive factors counseling otherwise, and instead simply asserts without basis that "the Board's resources will be impacted" if "Meta were to settle" before completion. Opp. at 11. But even if settlement did occur, Samsung will remain, and allowing the Meta IPR proceeding to continue would be a worthwhile and efficient use of Board resources in view of the large number of lawsuits that VoIP-Pal is pursuing on this patent.

***General Plastic* Factor 7:** VoIP-Pal asserts in conclusory fashion that "[t]his *General Plastic* factor appears neutral." *See* Opp. at 11-12. Instead, how-

ever, and as in *Expedia*, it actually weighs in favor of institution here because T-Mobile merely seeks to join an ongoing proceeding as an understudy. Mot. at 13. T-Mobile does not request any schedule changes, and the Board will be able to timely issue a final written decision. *See Expedia*, IPR2022-00785, Paper 16, at 10.

III. T-MOBILE'S *SOTERA* STIPULATION FURTHER RENDERS DISCRETIONARY DENIAL INAPPROPRIATE

VoIP-Pal does not address T-Mobile's review of each of the *Fintiv* factors (Mot. at 13-15), but turning back to the fourth and dispositive factor here (overlap between issues), T-Mobile has already stipulated that, if the IPRs are instituted, it will not pursue the grounds raised or that reasonably could have been raised in these proceedings. *Sotera Wireless, Inc. v. Masimo Corp.*, IPR2020-01019, Paper 12, at 18-19 (Dec. 1, 2020). There is therefore no overlap with arguments made in the district court proceedings, which will be streamlined through permitting T-Mobile's participation in in the Meta IPR Proceedings at no or *de minimus* additional effort to the Board and VoIP-Pal.

IV. CONCLUSION

T-Mobile has only ever sought to join existing proceedings at no added burden to the Board or VoIP-Pal. T-Mobile thus requests that the Board grant joinder.

Respectfully submitted,

Dated: April 28, 2023

PERKINS COIE LLP
1900 Sixteenth Street, Suite 1400
Denver, Colorado 80202
Phone: 303-291-2300
Fax: 303-291-2400

/Kourtney Mueller Merrill/
Lead Counsel
Kourtney Mueller Merrill, Reg. No. 58,195

Backup Counsel
Amanda Tessar, Reg. No. 53,683

Counsel for Petitioner

CERTIFICATE OF COMPLIANCE

Pursuant to 37 C.F.R. § 42.24(d), the undersigned certifies that **PETITIONER'S REPLY IN SUPPORT OF MOTION FOR JOINDER** complies with the page limit of 37 C.F.R. § 42.24(b)(3) because it meets the limit of 5 pages, excluding the parts of the brief exempted by 37 C.F.R. §42.24(a)(1).

/Kourtney Mueller Merrill/
Kourtney Mueller Merrill

CERTIFICATE OF SERVICE

I hereby certify that on April 28, 2023, I caused a true and correct copy of the foregoing **PETITIONER'S REPLY IN SUPPORT OF MOTION FOR JOINDER** to be electronically served in its entirety on counsel for Patent Owner as follows:

Lewis E. Hudnell, III
Nicolas S. Gikkas
HUDNELL LAW GROUP P.C.
lewis@hudnelllaw.com
nick@hudnelllaw.com

Respectfully submitted,

Dated: April 28, 2023

/Kourtney Mueller Merrill/
Lead Counsel
Kourtney Mueller Merrill, Reg. No. 58,195

Backup Counsel
Amanda Tessar, Reg. No. 53,683

Counsel for Petitioner

PERKINS COIE LLP
1900 Sixteenth Street, Suite 1400
Denver, Colorado 80202
Phone: 303-291-2300
Fax: 303-291-2400