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

TABLE OF CONTENTS

I. STATEMENT OF PRECISE RELIEF REQUESTED 1

II. BACKGROUND AND RELATED PROCEEDINGS 3

III. STATEMENT OF REASONS FOR THE REQUESTED RELIEF 5

A. Legal Standards and Applicable Rules 5

B. Joinder with the Instituted Meta Proceedings Is Appropriate.....6

C. No New Grounds of Unpatentability Are Asserted in the Petitions 7

D. Joinder Will Have No Impact on the Meta Proceedings Trial Schedules.....7

E. Agreed Procedures to Simplify Briefing and Discovery 8

IV. *GENERAL PLASTIC* DOES NOT APPLY 9

V. DISCRETIONARY DENIAL IS NOT APPROPRIATE UNDER *FINTIV* EITHER.....13

VI. CONCLUSION.....15

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:

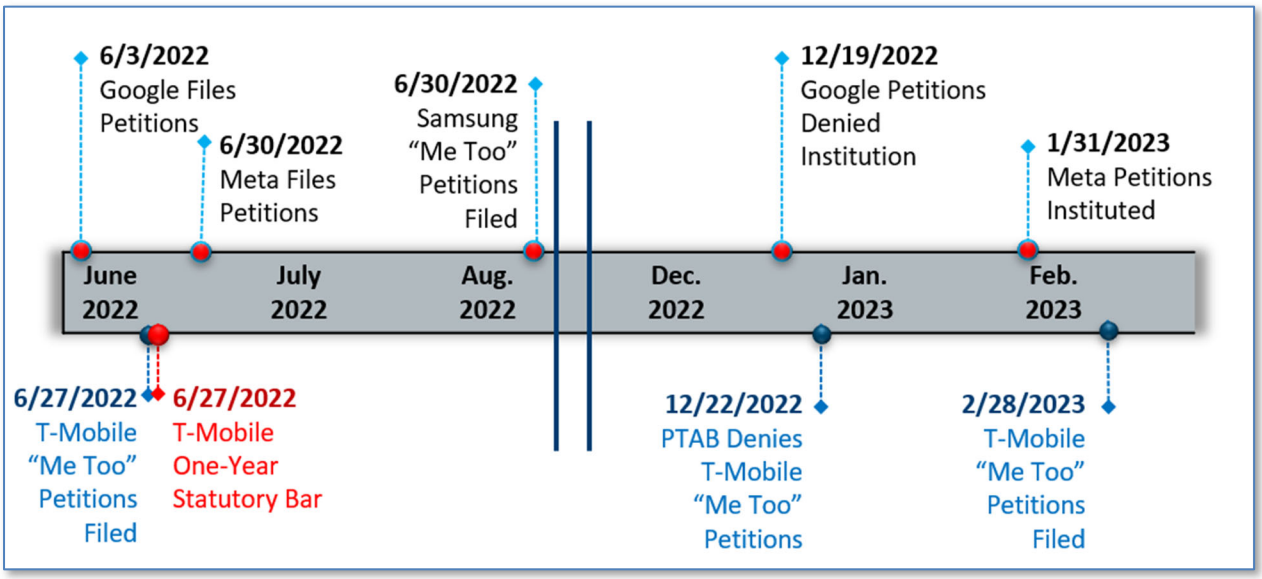
Case No.	Jurisdiction	Status
VoIP-Pal.com, Inc. v. T-Mobile USA, Inc., Case No. 6:21-cv-00674	Western District of Texas	Litigation is pending.
VoIP-Pal.com, Inc. v. Meta Platforms, Inc., et al., Case No. 3:22-cv-03202	Northern District of California	Litigation is pending. Transferred from Case No. 6:21-cv-00665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

Case No.	Jurisdiction	Status
VoIP-Pal.com, Inc. v. Amazon.com, Inc., et al., Case No. 6:21-cv-00668	Western District of Texas	Litigation is pending.
VoIP-Pal.com, Inc. v. Apple Inc., Case No. 6:21-cv-00670	Western District of Texas	Litigation was terminated.
VoIP-Pal.com, Inc. v. AT&T Corp., et al., Case No. 6:21-cv-00671	Western District of Texas	Litigation was terminated.
VoIP-Pal.com, Inc. v. Verizon Communications Inc., et al., Case No. 6:21-cv-00672	Western District of Texas	Litigation is pending.
VoIP-Pal.com, Inc. v. Samsung Electronics Co., Ltd., et al., Case No. 6:21-cv-01246	Western District of Texas	Litigation is pending. Transferred from Austin division, formerly Case No. 1:21-cv-01084.
VoIP-Pal.com, Inc. v. Huawei Technologies Co. Ltd. et al., Case No. 3:23-cv-00151	Northern District of Texas	Litigation is pending. Transferred from Case No. 6:21-cv-01085 (W.D. Tex.).
AT&T Corp., et al. v. VoIP-Pal.com, Inc., Case No. 3:21-cv-05078	Northern District of California	Litigation was terminated.
Apple Inc. v. VoIP-Pal.com, Inc., Case No. 3:21-cv-05110	Northern District of California	Litigation was terminated.
Cellco Partnership d/b/a Verizon Wireless Inc., et al. v. VoIP-Pal.com, Inc., Case No. 3:21-cv-05275	Northern District of California	Litigation was terminated.
Twitter, Inc. v. VoIP-Pal.com, Inc., Case No. 3:21-cv-09773	Northern District of California	Litigation is pending.

The following petitions for *inter partes* review have been filed to date:

Petitioner	Case Nos.	Status
Meta Platforms, Inc. f/k/a Facebook, Inc.	IPR2022-01178 IPR2022-01179	Petitions filed on June 30, 2022. Institution granted on January 31, 2023. Review is pending.
Samsung Electronics Co., Ltd.	IPR2022-01390 IPR2022-01391	Petitions and motions for joinder filed on August 23, 2022, and are pending.
Google LLC f/k/a Google Inc.	IPR2022-01072 IPR2022-01073	Petitions filed on June 3, 2022. Institution denied on December 19, 2022.
Amazon.com Inc. et al. (including Petitioner)	IPR2022-01178 IPR2022-01179	Petitions and joints for joinder filed on June 27, 2022. Institution denied on December 22, 2022.

The below timeline shows the above sequence of petitions and decisions:



III. STATEMENT OF REASONS FOR THE REQUESTED RELIEF

A. Legal Standards and Applicable Rules

The Board has discretion to join a properly filed IPR petition to an IPR proceeding. 35 U.S.C. § 315(c); 37 C.F.R. § 42.122(b); *see also Dell Inc. v. Network-*

1 Sec. Solutions, Inc., IPR2013-00385, Paper 17, at 4-6 (PTAB July 29, 2013). "The Board will determine 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." *Dell*, IPR2013-00385, Paper 17, at 3. The movant has the burden of proof to establish that it is entitled 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 grounds of unpatentability asserted in the petition; (3) explain what impact (if any) joinder would have on the trial schedule for the existing review; and (4) address specifically how briefing and discovery may be simplified.

Dell, IPR2013-00385, Paper 17, at 4.

B. Joinder with the Instituted Meta Proceedings Is Appropriate

The Board "routinely grants motions for joinder where the party seeking joinder introduces identical arguments and the same grounds raised in the existing proceeding." *Samsung Elecs. Co., Ltd. v. Raytheon Co.*, IPR2016-00962, Paper 12, at 9 (PTAB Aug. 24, 2016) (internal quotations and citations omitted). Here, joinder with the Meta proceedings is appropriate because the present Petitions introduce identical arguments and the same grounds raised in the Meta proceedings (i.e., they contain the same grounds, based on the same prior art combinations and supporting evidence, against the same claims) and the motion is timely filed. Be-

cause the Petitions present identical arguments and the same grounds, good cause exists for joining these proceedings with the Meta proceedings so that the Board, consistent with 37 C.F.R. § 42.1(b), can efficiently "secure the just, speedy, and inexpensive resolution" of the issues raised.

C. No New Grounds of Unpatentability Are Asserted in the Petitions

Petitioner copied the substance of Meta's petitions and relies on the same accompanying declaration. There are therefore no new grounds of unpatentability. Petitioner seeks only to join the proceeding as instituted and does not seek to broaden or otherwise alter the scope of the Meta proceedings.

D. Joinder Will Have No Impact on the Meta Proceedings Trial Schedules

Because the Petitions are substantively identical to Meta's petitions and rely on the same declaration, Patent Owner should not require any discovery from Petitioner. There are no new issues for the Board to address, and Patent Owner will not be required to present any additional responses or arguments. Petitioner further agrees to the trial schedule already entered in the Meta proceedings. *See* Paper 11, IPR2022-01234, IPR2022-01235. The next scheduled due date (DUE DATE 1) is Patent Owner's Response to the Petition, and that deadline will not be delayed or otherwise negatively impacted because the issues presented, even if the Petitions are instituted and joined after one or more due dates.

Joinder will not therefore unduly burden other otherwise have any impact on

the trial schedule for the Meta proceedings. *See LG*, IPR2015-01353, Paper 11, at 6 (granting joinder where "joinder should not necessitate any additional briefing or discovery from Patent Owner beyond that already required in [the original IPR]").

E. Agreed Procedures to Simplify Briefing and Discovery

Petitioner agrees to assume an "understudy" role, which will simplify briefing and discovery. Specifically, Petitioner agrees, upon joining the Meta proceedings, that the following conditions, as previously approved by the Board in similar circumstances, shall apply so long as Meta remains an active party:

1) all filings by Petitioner in the joined proceedings will be consolidated with Meta's filings, unless a filing concerns issues solely involving Petitioner (none of which are currently anticipated after joinder);
2) Petitioner shall not be permitted to raise any new grounds not already instituted by the Board in the Meta proceedings, or introduce any argument or discovery not already introduced by Meta;
3) Petitioner shall be bound by any agreement between Patent Owner and Meta concerning discovery and depositions; and
4) Petitioner shall not receive any direct, cross examination, or redirect time at deposition beyond that permitted under either 37 C.F.R. § 42.53 or any agreement between Patent Owner and Meta.

See Noven Pharmaceuticals, Inc. v. Novartis AG, IPR2014-00550, Paper 38, at 5 (PTAB Apr. 10, 2015). In short, Petitioner will not assume an active role.

Because Petitioner would adopt an "understudy" role, the parties can comply with the ordered trial schedules without requiring any duplicative efforts by the

Board or the Patent Owner. These steps minimize the possibility of any complication or delay from joinder. *See LG*, IPR2015-01353, Paper 11, at 6-7. Petitioner is further willing to agree to any other reasonable conditions the Board deems necessary.

IV. *GENERAL PLASTIC* DOES NOT APPLY

The discretionary denial factors outlined by *General Plastic* are not relevant "where a different petitioner files a 'me-too' or 'copycat' petition in conjunction with a timely motion to join." *See, e.g., Celltrion*, IPR2018-01019, Paper 11, at 9-11. Petitioner has not made any changes to the substantive positions advanced in the Meta proceedings. Rather, Petitioner merely seeks to ensure that the Meta proceedings are not prematurely terminated based on opportunistic settlement by Patent Owner with fewer than all parties against which it has asserted the '721 patent. As such, Petitioner respectfully submits that *General Plastic* does not apply here. *See also id.* at 10-11 (finding petitioner's "copycat" petition and motion to join an instituted IPR "effectively obviate[] any concerns of serial harassment and unnecessary expenditure of resources" even though petitioner "previously filed two petitions directed to the same claims of the same patent").

But if the Board does analyze the *General Plastic* factors, those factors weigh in favor of instituting the present petitions and granting this motion. *See General Plastic Indus. Co., Ltd. v. Canon Kabushiki Kaisha*, IPR2016-01357,

Paper 19, at 16 (PTAB Sept. 6, 2017) (precedential as to § II.B.4.i).

The ***first factor*** is whether the same petitioner previously filed a petition directed to the same claims of the same patent. Petitioner previously filed two "me too" petitions directed to an overlapping but not identical set of claims (the challenged claims spanned two petitions, which was necessary in view of the number of claims asserted in the district court action then and now). *See* Paper 1, IPR2022-01180; Paper 1, IPR2022-01181. The present "me too" Petitions challenge a similar but non-identical set of claims, however, Petitioner stipulated before and stipulates again that if the Petitions are instituted, Petitioner 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 (PTAB Dec. 1, 2020) (precedential). Moreover, Petitioner did not request nor receive any individual consideration of or decision on the merits of its prior petitions, which were conditioned on institution of the Google petitions. *See Code200, UAB et al. v. Bright Data Ltd.*, IPR2022-00861, -00862, Paper 18, at 4-5 (PTAB Aug. 23, 2022) (highlighting the importance of "allowing [a petitioner] the opportunity to pursue a decision on the merits") (initiating *sua sponte* Director review to clarify the application of *General Plastic*). This factor favors institution.

The ***second factor*** is whether at the time of filing the first petition the petitioner knew or should have known of the prior art asserted in the second

petition. This factor does not apply here. Petitioner's petitions were all "copycat" petitions; Petitioner had no involvement in selecting the prior art presented in either the Google petitions or the Meta petitions or opportunity to join those petitions. Moreover, the Meta petitions were filed shortly after Petitioner's one-year statutory bar for filing a petition under 35 U.S.C. § 315(b), so Petitioner could not have sought to join those petitions at any time prior to institution. In addition, the Meta petitions were filed long before the Board's institution decision on the Google petitions, and Petitioner has not sought to substantively add to or change any of the grounds for review in the Meta proceedings, so none of the potential "road-mapping" concerns this factor is intended to address apply here either. *See Code200*, IPR2022-00861, -00862, Paper 18, at 5 ("[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."). The Petitions could not be and were not "refined based on lessons learned from later developments" in the Google proceedings. This factor is therefore neutral, if not inapplicable.

The ***third factor*** is whether at the time of filing the subsequent petition, the petitioner already received the patent owner's preliminary response to the first petition or the Board's decision on whether to institute review in the first petition.

The sequence of events (timeline above) demonstrates that Petitioner now moves to join identical Meta petitions that were filed long before Patent Owner filed its preliminary response to the Google petitions and even longer before the Board's institution decision. In addition, because the present Petitions are essentially copies of the Meta petitions and submitted with a motion for joinder stating that Petitioner will serve an understudy role, the Petitions cannot be an attempt to harass the Patent Owner or otherwise engage in the type of serial, tactical filings this factor is intended to address. Thus, this factor weighs in favor of joinder.

The ***fourth*** and ***fifth factors*** are the length of time elapsed between the time the petitioner learned of the prior art and filed the second petition and whether the petitioner provides adequate explanation for the time elapsed between the petitions. Petitioner filed the Petitions and joinder motion within one month of institution of the Meta proceedings—within the time period specifically allowed under 35 U.S.C. § 315(c) and 37 C.F.R. § 42.122(b). Petitioner was unable to file the Petitions and move to join the Meta proceedings until institution because it was time-barred under 35 U.S.C. § 315(b). Petitioner has also agreed that it will adhere to the trial schedules in the Meta proceedings, so joinder will not delay the proceedings. Where, as here, Petitioner will be taking an understudy role, the fourth and fifth factors are of limited relevance, but to the extent they are relevant, they favor joinder. *See Code200*, IPR2022-00861, -00862, Paper 18, at 6.

The ***sixth factor*** is the finite resources of the Board. Allowing Petitioner's joinder in an understudy role will not impact the Board's resources beyond those resources the Board dedicates to the instant joinder motion. *Id*. at 6 ("[T]he Board's mission to improve patent quality and restore confidence in the presumption of validity that comes with issued patents outweighs the impact on Board resources needed to evaluate the merits of a petition.") (internal quotation omitted). This factor favors institution.

The ***seventh factor*** is the Board's requirement under 35 U.S.C. § 316(a)(11) to issue a final determination not later than one year after the date on which the Director notices institution of review. As explained above, joinder will not impact the trial schedules so the Petitions will not delay the proceedings. Accordingly, this factor also weighs in favor of institution.

Thus, none of the *General Plastic* factors weighs against joinder.

V. DISCRETIONARY DENIAL IS NOT APPROPRIATE UNDER *FINTIV* EITHER

Institution is also appropriate under the six-factor test set forth in *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11, at 3 (PTAB Mar. 20, 2020), as further clarified by Director Vidal's June 21, 2022 interim procedure for discretionary denials (the "Memorandum") (available at https://www.uspto.gov/sites/default/files/documents/interim_proc_discretionary_denials_aia_parallel_district_court_litigation_memo_20220621_.pdf).

Turning to the ***fourth*** and dispositive factor here (overlap between issues), Petitioner stipulates that, if the IPRs are instituted, Petitioner will not pursue the grounds raised, or that reasonably could have been raised, in these proceedings. *Sotera*, IPR2020-01019, Paper 12, at 18-19. There is therefore no overlap with arguments made in the district court proceedings. This stipulation "mitigates concerns of potentially conflicting decisions and duplicative efforts between the district court and the PTAB," and the Director has clarified that the PTAB will not discretionarily deny institution where, as here, Petitioner has made a *Sotera* stipulation. Memorandum, 7-8.

Discretionary denial under the *Fintiv* factors is therefore not appropriate. However, turning briefly to the additional factors for the sake of completeness, for the ***first factor*** (stay), Petitioner is requesting institution on all asserted claims in the related action and timely sought leave to join the Meta proceedings within one month of institution. The relevant facts therefore favor a stay. *See Fintiv*, IPR2020-00019, Paper 15 at 12 (PTAB May 13, 2020) (informative); *HP v. Neodron*, IPR2020-00459, Paper 17 at 35-36 (PTAB Sept. 14, 2020).

The ***second*** (proximity of trial dates) and ***third*** (investment in parallel proceedings) factors are at least neutral. While the Texas court set a tentative trial date of July 17, 2023 for the *Amazon* trial, no date has been set for Petitioner's trial. Indeed, the court has indicated that it will hold trials in order of case number,

meaning that both the *Amazon* and *Verizon* trials will need to occur before it will be Petitioner's turn. Petitioner has also committed that it will not raise any invalidity arguments that could have been raised in these proceedings, such that the district court action will have no impact on the grounds under review here.

While the ***fifth factor*** (parties) may weigh slightly in favor of denial because the parties are the same as one of the pending district court actions, under the "holistic view" of whether integrity of the system and efficiency are best served, the factors here indicate that institution is proper. *Samsung Elecs. Co. v. Dynamics*, IPR2020-00505, Paper 11 at 15 (PTAB Aug. 12, 2020).

The ***sixth*** factor (other circumstances) also weighs in favor of institution because of the strength of the petition, which has already been confirmed through institution of the Meta proceedings: "[T]he PTAB will not rely on the *Fintiv* factors to discretionarily deny institution … where a petition presents compelling evidence of unpatentability." Memorandum, 2; *see also Thryv, Inc. v. Click-To-Call Techs.*, 140 S. Ct. 1367, 1374 (2020).

VI. CONCLUSION

Joinder will not affect the substance, procedure, or scheduling of the Meta proceedings but will simplify the issues and promote efficiency, justice, and speed. For the foregoing reasons, Petitioner respectfully requests *inter partes* review of U.S. Patent No. 10,880,721 and joinder with IPR2022-01234 and IPR2022-01235.

Respectfully submitted,

Dated: February 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

CERTIFICATE OF SERVICE

I hereby certify that on February 28, 2023, I caused a true and correct copy of the foregoing **PETITIONER'S MOTION FOR JOINDER** to be served via USPS Priority Mail Express on the Patent Owner at the following correspondence address of record as listed on PAIR:

THORPE NORTH & WESTERN, LLP.
P.O. Box 1219
SANDY UT 84091-1219

A courtesy copy was also sent via electronic mail to the Patent Owner's litigation counsel at the following email addresses:

Lewis E. Hudnell, III, lewis@hudnellaw.com
Nicolas S. Gikkas, nick@hudnelllaw.com
Hudnell Law Group P.C.
800 W. El Camino Real Suite 180
Mountain View, California 94040

Respectfully submitted,

Dated: February 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