

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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RESMED CORP.,  
Petitioner,

v.

FRACTUS, S.A.,  
Patent Owner.

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Case No. IPR2026-00191  
Patent No. 11,031,677

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**PATENT OWNER'S OPPOSITION  
TO PETITIONER'S MOTION FOR JOINDER**

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## **I. STATEMENT OF THE PRECISE RELIEF REQUESTED**

ResMed Corp. (“Petitioner”) submitted a Petition (“the Petition”) for inter partes review (“IPR”) of U.S. Patent No. 11,031,677 (“the ’677 patent”) on January 2, 2026, filed concurrently with a Motion for Joinder to join the proceeding with *Inter Partes* Review IPR2025-01026 (the “’1026 proceeding”). Patent Owner Fractus, S.A. (“Patent Owner”) submits that joinder is inappropriate and requests that the Motion for Joinder be denied.

## **II. STATEMENT OF MATERIAL FACTS**

For purposes of this paper, Patent Owner adopts Petitioner’s statement of materials facts.

## **III. JOINDER IS NOT APPROPRIATE**

A motion for joinder should include a discussion of why joinder is appropriate, whether the new petition presents any new grounds of unpatentability, any impact joinder would have on the trial schedule for the existing review, and how briefing and discovery may be simplified. *Kyocera Corp. v. Softview LLC*, IPR2013-00004, Paper 15, at 4 (PTAB April 24, 2013). The most important of these considerations is why joinder is appropriate. In this case, joinder is decidedly not appropriate.

First, a petitioner has the burden of proof to establish that joinder is appropriate. 37 C.F.R. §§ 42.20(c), 42.122(b). Petitioner’s conclusory statements in the Motion that joinder is appropriate are insufficient to meet its burden. *HTC Corp.*

*v. Uniloc 2017 LLC*, IPR2018-01589, Paper 9, at 9 (PTAB Feb. 27, 2019) (conclusory statements do not support joinder). Further, as Patent Owner will show below, joinder would be inappropriate because: 1) joinder of the present proceeding to the '1026 proceeding would be contrary to the intent of IPR, 2) joinder would be contrary to public policy, 3) joinder would fail to ensure efficient use of Board resources, and 4) joinder would be a waste of Board resources as the merits of the Petition are poor.

***A. Joinder Would be Contrary to the Intent of Inter Partes Review***

IPRs “should generally serve as a complete substitute for at least some phase of the litigation.” S. Rep. No. 110-259 at 72; *see also* 90 Fed. Reg. 48336 (October 17, 2025). This substitution is implemented, in part, through the estoppel provisions of 35 U.S.C. § 315(e)(2). Joining Petitioner to the '1026 proceeding would thwart this intent.

Specifically, Petitioner seeks the benefit of this proceeding while potentially avoiding the risk presented by the estoppel provisions of 35 U.S.C. § 315(e)(2). The Federal Circuit has held that a joining party to an IPR may, in some circumstances, avoid the estoppel provisions of 35 U.S.C. § 315(e)(2) as a joining party cannot reasonably raise additional grounds in the IPR proceeding. *Network-1 Techs., Inc. v. Hewlett-Packard Co.*, 981 F.3d 1015, 1027 (Fed. Cir. 2020) (“HP, however, was not estopped from raising other invalidity challenges against those claims because, as a

joining party, HP could not have raised with its joinder any additional invalidity challenges.”). Therefore, in the likely event Patent Owner successfully defends the ‘677 patent (*see* section III.D, *infra*), the proceeding will have failed to substitute for any portion of the litigation as Petitioner may be free to assert additional new invalidity theories based on prior art printed publications.

Petitioner has provided no indication that it intends to use the joined proceeding as a substitute for its invalidity case in litigation. Petitioner has not stipulated that it will not pursue the same invalidity grounds in the co-pending litigation. *See, e.g., Elong Int’l USA Inc. v. Feit Electric Co., Inc.*, IPR2025-00258, Paper 16, at 3 (PTAB June 25, 2025) (Precedential) (“Petitioners ... will not assert invalidity positions based on the same prior art in the district court” should they be joined.”)(internal quotations omitted). Nor has Petitioner stipulated that it will not pursue alternative grounds based on prior art printed publications in litigation. Absent such stipulations, it is Petitioner’s intent to use the joined proceeding as a first bite at the invalidity apple, and the litigation as a second.

Petitioner also intends to continue in the joined proceeding in the event of a settlement between Patent Owner and Geotab (the petitioner in the ’1026 proceeding), signaling its intent to use this proceeding as the first of two invalidity bites at the apple. Motion at 1, 8 (Petitioner indicating its intent to actively participate

in the proceeding if Geotab terminates its involvement or transfers control to Petitioner).

Accordingly, it is both unfair to Patent Owner and contrary to the intent of IPR to permit Petitioner to join this proceeding. Joining Petitioner would provide it with the benefits of an IPR proceeding without Petitioner having to accept any of the risks and without the proceeding serving as a substitute for any portion of litigation.

***B. Joinder Would Be Contrary to Public Policy***

Public and Board policies have long favored settlement between the parties in IPR and *termination* of proceedings upon such settlement. *E.g.*, Consolidated Trial Practice Guide at § N (“There are strong public policy reasons to favor settlement between the parties to a proceeding. ...The Board expects that a proceeding will terminate after the filing of a settlement agreement unless the Board has already decided the merits of the proceeding.”) (*citing* 35 U.S.C. §§ 317(a), 327). Allowing Petitioner to join the ’1026 proceeding would disincentivize settlement between Geotab and Patent Owner, eliminating the possibility that Patent Owner could end this proceeding through such a settlement. As joining Petitioner to the ’1026 proceeding would disincentivize settlement between the parties in that proceeding, joining Petitioner to the ’1026 proceeding is contrary to Public and Board policy that heavily favors settlement and termination of proceedings.

***C. Joinder Should be Denied to Ensure Efficient Use of Board Resources***

As discussed above, joining Petitioner to the '1026 proceeding would prevent termination of that proceeding in the event of a settlement between Patent Owner and Geotab. Joining Petitioner to the '1026 proceeding, therefore, limits the Board's ability to ensure efficient use of its resources. In the precedential *Elong* case, it was determined that a joined party that prevents the Board from terminating a proceeding places an additional burden on the Board. *Elong*, IPR2025-00258, Paper 16 at 3. Such a burden is contrary to the Board being able to make efficient use of its resources.

***D. The Merits of the Petition are Weak***

The patentability challenges in the Petition are weak and Petitioner is unlikely to prevail. Specifically, the primary prior art grounds in the '1026 proceeding were determined to have not met the threshold showing for institution. '1026 Institution Decision at 50, 52. The sole invalidity ground that purportedly met the institution standard was based on an incorrect legal analysis. *See* '1026 Proceeding, Paper 23. Worse yet, it is based on an erroneous factual conclusion, which Patent Owner will bring to light in its Discretionary Denial Brief in this proceeding and its Patent Owner Response in the '1026 proceeding. Given the weak invalidity case in the '1026 proceeding, pursuing those grounds is a waste of Board resources, even more so if the case is forced to continue after a settlement between Geotab and Patent

Owner. Accordingly, it would be inappropriate to join Petitioner to the '1026 proceeding, as doing so could unnecessarily extend the case, wasting Board resources.

#### **IV. CONCLUSION**

Based on the discussion above, Patent Owner respectfully submits that it would be inappropriate to join Petitioner to the '1026 proceeding. Therefore, Patent Owner requests that the Board deny the Motion for Joinder.

Dated: February 2, 2026

Respectfully submitted,

/Mark J. DeBoy/  
Mark J. DeBoy (Reg. 66,983)  
Attorney for Patent Owner  
Fractus S.A.

**CERTIFICATE OF SERVICE**

The undersigned certifies that pursuant to 37 C.F.R. § 42.6(e), a copy of the foregoing **PATENT OWNER'S OPPOSITION TO PETITIONER'S MOTION FOR JOINDER** was served via email (as previously consented to by counsel) on February 2, 2026 to lead and backup counsel of record for Petitioner as follows:

PH-Resmed-Fractus@paulhastings.com

Dated: February 2, 2026

/Mark J. DeBoy/

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