

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

RESMED CORP.
Petitioner,

v.

FRACTUS, S.A.
Patent Owner.

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

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

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I. INTRODUCTION

The Board should reject Patent Owner's ("PO") Opposition as it is a study in misdirection. It ignores that Petitioner seeks a standard, streamlined understudy joinder and instead advances meritless policy arguments that do not govern joinder under 35 U.S.C. § 315(c) (and conflict with the Director's efficiency directives). Because the Motion satisfies every joinder factor, the Board should grant the Motion.

II. ARGUMENT

A. Petitioner Has Established that Joinder is Appropriate

The Board routinely grants joinder where, as here, Petitioner seeks an "understudy" role on identical grounds and evidence and follows the existing schedule. *See, e.g., Samsung Electronics Co., Ltd. v. Molecular Rebar Design, LLC*, IPR2025-00355, Paper 11, at 6 (PTAB July 17, 2025) (granting joinder of copycat petition with an understudy joinder); *Cooler Master Co., Ltd. v. Asektek Danmark A/S*, IPR2023-00667, Paper 6, at 2-13 (PTAB August 28, 2023) (same).

PO alleges that Petitioner's Motion is "conclusory" and "insufficient to meet its burden," but it is PO's Opposition that is conclusory. *See Opp.*, 1. The Petition does not present any new grounds (Mot. 6-7), joinder will have minimal (if any) impact on the trial schedule, and Petitioner will accept an "understudy" role. (Mot. 5-9). Petitioner tied each *Kyocera* factor to record facts showing that the Petition is a true "copycat." *Kyocera Corp. v. Softview LLC*, IPR2013-00004, Paper 15 (PTAB

April 24, 2013). PO does not dispute any of the foregoing facts.

PO's reliance on *HTC Corp. v. Uniloc 2017 LLC* is misplaced. There, the Board rejected "conclusory statements" regarding joinder of a *new* claim. *HTC Corp.*, IPR2018-01589, Paper 9, at 9 (PTAB February 27, 2019). Petitioner adds no new claim (or grounds) here. In fact, the *HTC* Board granted joinder as to the originally challenged claims, confirming that joinder is also appropriate here. *Id.* at 6-7.

B. Joinder Directly Advances the Statutory Purpose of IPRs

PO's contention that Petitioner must waive all future litigation theories to justify joinder (Opp. 2-3) finds no support in the law. Whether an IPR serves as a "complete substitute" for parallel litigation is not a joinder factor. Rather, PO improperly conflates statutory estoppel under 35 U.S.C. § 315(e)(2) with a "complete" litigation waiver, a requirement Congress pointedly declined to mandate. 35 U.S.C. § 315(c). The joined IPR will resolve or materially narrow the primary validity issues in a single streamlined proceeding, thereby "substitut[ing] for at least some phase of the litigation." Opp., 2 (quoting S. Rep. No. 110-259 at 72). Indeed, if Petitioner prevails, the challenged claims are cancelled, and the litigation ends. If not, Petitioner is strictly estopped from re-litigating the same invalidity grounds in district court. 35 U.S.C. § 315(e)(2).

For joinder, Petitioner cannot add new grounds to the existing IPR. Thus, by

statutory design, Petitioner is entitled to “rais[e] other invalidity challenges against those claims” that it “***could not have raised with its joinder.***” See *Facebook, Inc. v. Windy City Innovations, LLC*, 973 F.3d 1321 (Fed. Cir. 2020); *Network-1 Techs., Inc. v. Hewlett-Packard Co.*, 981 F.3d 1015, 1027 (Fed. Cir. 2020) (emphasis added). PO’s attempt to impose broad litigation waivers subverts the very “intent” of joining an instituted proceeding, which, as PO itself states, was meant to “substitute” for only “***some*** phase[s] of the litigation.” Opp., 2 (emphasis added).

Finally, PO mischaracterizes *Elong Int’l USA Inc. v. Feit Electric Co., Inc.* (Opp. 3-5). *Elong* did not create a mandatory litigation stipulation for joinder; it addressed a situation for *discretionary denial* where a joined IPR would not conclude until *after* a district court trial in the parallel litigation. *Elong Int’l USA Inc.*, IPR2025-00258, Paper 16, at 2 (PTAB June 25, 2025). Those concerns are absent here, especially where the parallel litigation is in its infancy and the joined IPR will conclude well before trial.¹

¹ The parallel district court case (*Fractus, S.A. v. Resmed Corp.*, Case No. 25-cv-2680-LL-JLB (S.D. Cal. Oct. 9, 2025)) is still at an early stage, with no scheduling order and no trial date set. To the extent PO invokes *Elong* or other discretionary denial considerations, those issues are distinct from joinder and will be addressed, if raised, in discretionary denial briefing.

C. Settlement is Irrelevant to the Statutory Joinder Framework

PO's claim that joinder might "disincentivize settlement between Geotab and PO" is irrelevant and incorrect. Opp., 4. As the Board has held, the fact that an IPR may proceed after a partial settlement with one party is a natural consequence of all statutory joinder; it is not a basis for denial. *Intel Corp. v. VLSI Tech. LLC.*, IPR2022-00366, Paper 14, at 14 (PTAB June 8, 2022) (the Board has not been "persuaded to weigh" this factor against joinder). Moreover, PO's "settlement argument" is a red herring that ignores the enduring incentives to settle with individual parties, namely immediate elimination of costs, discovery burdens, and litigation risks associated with that specific adversary.

Finally, PO's 'efficiency' argument that joinder "prevent[s] termination" is a logical fallacy. Opp., 5. In reality, administrative efficiency is maximized by resolving a single, consolidated IPR proceeding rather than through serial, duplicative challenges. Joinder is the antidote to such inefficiency. By granting the Motion now, the Board ensures these grounds are resolved once, rather than risking a second, independent challenge in an IPR or parallel litigation.

D. PO's Subjective Assessment of the Merits Is Irrelevant and Improper

PO's (demonstrably incorrect) claim that the "patentability challenges in the Petition are weak" (Opp., 5) is an irrelevant and unwarranted collateral attack on the Board's Institution Decision in the '1026 IPR. *Geotab Inc. v. Fractus, S.A.*,

IPR2025-01026, Paper 20 (PTAB December 3, 2025) (“the ’1026 IPR”). The Board has already determined that “there is a reasonable likelihood Petitioner would prevail.” *Id.*, 73. Because Petitioner seeks joinder on a “copycat” petition, the merits are no longer germane. The Board has already committed its resources to adjudicating these grounds, regardless of whether Petitioner is joined as an understudy. *See Intel Corp.*, IPR2022-00366, at 14 (“We instituted the OpenSky IPR ... and we will continue expending resources to decide the merits ... regardless of joinder.”).

Furthermore, PO’s reliance on “an erroneous factual conclusion” it promises to “bring to light” in its Discretionary Denial Brief in this proceeding and the Patent Owner Response in the ’1026 proceeding (Opp., 5) constitutes a waiver and a failure of burden of production. PO cannot defeat joinder through strategic obfuscation (e.g., deferring substantive arguments to a future briefing) that deprives Petitioner of a meaningful reply. The Board should decide the Motion on the existing record, not PO’s speculative promises of future proof, and disregard PO’s attempt to litigate the ultimate merits of the case within a joinder opposition.

III. CONCLUSION

Petitioner respectfully request that the Board join Petitioner as a party to the ’1026 IPR.

Date: March 2, 2026

Respectfully submitted,

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CERTIFICATE OF SERVICE

The undersigned certifies that a true and correct copy of **PETITIONER'S
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