

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.

IPR2023-00638 (Patent 8,630,234 B2)
IPR2023-00639 (Patent 8,630,234 B2)
IPR2023-00640 (Patent 10,880,721 B2)
IPR2023-00641 (Patent 10,880,721 B2)¹

Before MITCHELL C. WEATHERLY, TERRENCE W. McMILLIN, and
CHRISTOPHER L. OGDEN, *Administrative Patent Judges*.

WEATHERLY, *Administrative Patent Judge*.

DECISION
Denying Institution of *Inter Partes* Reviews
35 U.S.C. § 314
Denying Motions for Joinder
35 U.S.C. § 315(c); 37 C.F.R. § 42.122

¹ The parties may not use a combined-case caption, unless given permission to do so.

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I. INTRODUCTION

T-Mobile USA, Inc.² (“Petitioner”) filed petitions to institute an *inter partes* review in each of the captioned proceedings. Paper 3³ (“Pet.”). Concurrently with each Petition, Petitioner filed a Motion for Joinder in which it sought to join IPR2022-01231, IPR2022-01232, IPR2022-01234, and IPR2022-01235 (the “Target IPRs”) as a party. Paper 4 (“Mot.” or “Motion”). VoIP-Pal.com, Inc. (“Patent Owner”) filed a Preliminary Response opposing institution in each of the captioned proceedings (Paper 10) and an Opposition to each Motion (Paper 8, “Opp.”). Petitioner filed a Reply in support of each Motion. Paper 9 (“Reply”).

For the reasons set forth below, we do not institute *inter partes* review and we deny the Motions.

II. DISCRETIONARY DENIAL OF INSTITUTION

Institution of an *inter partes* review is authorized by statute when “the information presented in the petition filed under section 311 and any response filed under section 313 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.” 35 U.S.C. § 314(a). Petitioner challenges the same claims on the same grounds based on the same arguments and evidence presented in the petitions in the Target IPRs. *Compare* IPR2022-

² Petitioner identifies T-Mobile USA, Inc. and T-Mobile US, Inc. as the real parties-in-interest. Pet. 1.

³ We refer to papers and exhibits in IPR2023-00638. Substantially similar documents were filed in IPR2023-00639, IPR2023-00640, and IPR2023-00641. This Order applies equally to all captioned proceedings.

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01231, Paper 3 (Petition), 5–6, 8–73, *with* Pet. 5, 8–73. In each of the Target IPRs, we determined that “Petitioner . . . demonstrated a reasonable likelihood of establishing that at least [one] claim is unpatentable” and “institute[d] an *inter partes* review of all challenged claims of the [challenged patents] on all grounds alleged by Petitioner.” IPR2022-01231, Paper 10 (Decision Granting Institution of *Inter Partes* Review), 3; *see also SAS Inst., Inc. v. Iancu*, 138 S. Ct. 1348, 1359–60 (2018); 37 C.F.R. § 42.108(a) (“When instituting *inter partes* review, the Board will authorize the review to proceed on all of the challenged claims and on all grounds of unpatentability asserted for each claim.”). Having already considered the merits of the challenges and evidence presented in these “me too” petitions vis-à-vis the threshold of institution for *inter partes* review in the Target IPRs, we determine that the Petitions in these proceedings also present a reasonable likelihood of prevailing on the challenge of at least one claim of the challenged patents.

Notwithstanding the merits, however, Patent Owner argues that we should exercise our discretion to deny institution of these Petitions under 35 U.S.C. § 314(a) and, accordingly, deny the Motions, citing and discussing the *General Plastic* factors. Opp. 1 (citing *General Plastic Industrial Co., Ltd. v. Canon Kabushiki Kaisha*, IPR2016-01357, Paper 19 at 16 (PTAB Sept. 6, 2017) (precedential as to § II.B.4.i)). Petitioner argues that the *General Plastic* factors do not apply here, where Petitioner seeks to join as a party to the Target IPRs and take an inactive or understudy role. Mot. 2, 9; Reply 1–2. As explained in further detail below, Petitioner’s understudy argument is not persuasive here, where the copied petitions are Petitioner’s

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second set of challenges to the patents, and upon the Target IPRs settling, Petitioner would stand in to continue proceedings that would otherwise be terminated. In effect, it would be as if Petitioner had brought the second set of challenges in the first instance. This effect is especially apparent in these particular circumstances because the original petitioner in the Target IPRs, Meta, has already been dismissed from those proceedings, and the remaining parties have jointly moved to terminate them because they have settled their dispute. The current circumstances, in which a second petition has been filed after the first was denied on the merits, are the particular circumstances that *General Plastic* was intended to address. *General Plastic*, Paper 19 at 17 (“Multiple, staggered petitions challenging the same patent and same claims raise the potential for abuse.”).

That Petitioner seeks to join the Target IPRs does not obligate us to institute these Proceedings without first considering whether to exercise discretion under § 314(a). The statutory provision governing joinder in *inter partes* review proceedings is 35 U.S.C. § 315(c), which reads:

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.

Section 315(c) requires “two different decisions,” both of which are discretionary, first “whether the joinder applicant’s petition for IPR ‘warrants’ institution under § 314,” and second whether to “whether to ‘join as a party’ the joinder applicant”). *Facebook, Inc. v. Windy City Innov.*,

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LLC, 973 F.3d 1321, 1332 (Fed. Cir. 2020). Under 35 U.S.C. § 315(c), the discretion of the Director to join a party to an ongoing IPR is premised on the Director’s determination that the petition warrants institution. That determination is not limited to determining whether the merits of the petition meet the reasonable likelihood threshold for at least one challenged claim. Under *General Plastic*, the Board may deny a petition based on the Director’s discretionary authority under § 314(a). *General Plastic*, Paper 19 at 15. Thus, before determining whether to join Petitioner as a party to the Target IPRs, even though the petitions are each a “me-too” petition, we first determine whether *General Plastic* should be applied and, if applied, whether application of the *General Plastic* factors warrants the exercise of discretion to deny the Petition under § 314(a).

In its Motion and Reply, Petitioner argues that the “*General Plastic* factors for discretionary denial do not apply to a ‘me-too’ petition coupled with a timely^[4] motion to join.” Mot. 2 (citing *Celltrion, Inc. v. Genentech, Inc.*, IPR2018-01019, Paper 11, at 9–11 (PTAB Oct. 30, 2018)); *see also id.* at 9; Reply 1–2. Patent Owner argues to the contrary that the *General Plastic* factors “are to be considered in relation to motions for joinder when considering discretionary denial.” Opp. 5 (citing *Apple Inc. v. Uniloc 2017 LLC*, IPR2020-00854, Paper 9 (PTAB October 28, 2020) (precedential)). Patent Owner clearly has the better position. *Apple* is a precedential Board

⁴ The Motions are timely because they were filed less than one month after institution of the Target IPRs. *See* 37 C.F.R. § 42.122(b). The Target IPRs were instituted on January 31, 2023. *See, e.g.*, IPR2022-01231, Paper 10. The Petitions (Paper 3) and Motions for Joinder (Paper 4) were filed on February 28, 2023.

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decision entered and designated precedential later than *Celltrion*. Despite Patent Owner's citation to and reliance on *Apple* in its Opposition, Petitioner does not cite or discuss *Apple* in its Reply or attempt to distinguish *Apple* or provide any reason why *Apple* should not be followed under the circumstances of these proceedings. *See generally* Reply. Accordingly, we follow and adopt the reasoning of the precedential Board decision in *Apple* and proceed to analyze the *General Plastic* factors.

The Board's decision in *General Plastic* articulates a non-exhaustive list of factors to be considered in evaluating whether to exercise discretion under 35 U.S.C. § 314(a) to deny a petition that challenges a patent that was previously challenged before the Board. These factors are:

1. whether the same petitioner previously filed a petition directed to the same claims of the same patent;
2. whether at the time of filing of the first petition the petitioner knew of the prior art asserted in the second petition or should have known of it;
3. whether at the time of filing of the second petition the petitioner already received the patent owner's preliminary response to the first petition or received the Board's decision on whether to institute review in the first petition;
4. the length of time that elapsed between the time the petitioner learned of the prior art asserted in the second petition and the filing of the second petition;
5. whether the petitioner provides adequate explanation for the time elapsed between the filings of multiple petitions directed to the same claims of the same patent;
6. the finite resources of the Board; and

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7. the requirement under 35 U.S.C. § 316(a)(11) to issue a final determination not later than 1 year after the date on which the Director notices institution of review.

General Plastic, Paper 19 at 9–10. We address each of these factors below.

1. “*whether the same petitioner previously filed a petition directed to the same claims of the same patent*”

There is no dispute that these Petitions are the second set of petitions Petitioner has filed against the challenged patents and that all the claims challenged in the first set of petitions are challenged in this second set of petitions.⁵ Mot. 2, 5, 10; Opp. 1–3, 7. We determine that this first *General Plastic* factor weighs in favor of denying institution.

2. “*whether at the time of filing of the first petition the petitioner knew of the prior art asserted in the second petition or should have known of it*”

In the Petitions in these proceedings, Petitioner relies on U.S. Patent No. 7,668,159 (Ex. 1005, “Buckley”) and U.S. Patent No. 8,731,163 (Ex. 1009, “Bates”) to establish the unpatentability of the challenged claims. Pet. 5.⁶ Patent Owner shows that Petitioner knew of these references and

⁵ The claims challenged in the first set of petitions are not identical to the claims challenged in the second set of petitions. In each of these proceedings, additional claims from each of the challenged patents are challenged. Mot. 10 (“Petitioner previously filed two ‘me too’ petitions directed to an overlapping but not identical set of claims.”); Opp. 7 (“Petitioner is the same and its petition is directed to the same claims of the same patent plus claims 2, 3, 6, and 29.”).

⁶ In the Petitions in IPR2023-00639, IPR2023-00640, and IPR2023-000641, Petitioner also relies on U.S. Patent No. 6,954,654. *See, e.g.*, IPR2023-00639, Paper 3 (Petition), 6. In each of those proceedings, Patent Owner relies on the same evidence cited in IPR2023-00638 (and cited and discussed in the body of this paper) to establish that Petitioner was aware of this

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identified them as rendering at least some of the claims of the challenged patents invalid in preliminary invalidity contentions filed on January 25, 2022. Opp. 4, 8 (citing Ex. 2001, 16–17). The Petitioner filed its first set of petitions on June 27, 2022. *Id.* at 2. Petitioner does not dispute that it knew of Buckley and Bates at the time of filing its first set of petitions. *See* Mot. 10–11, Reply 2–3. We determine that the second *General Plastic* factor weighs in favor of denying institution.

3. “*whether at the time of filing of the second petition the petitioner already received the patent owner’s preliminary response to the first petition or received the Board’s decision on whether to institute review in the first petition*”

Petitioner’s second set of petitions were filed on February 28, 2023. *See* Pet. 78; *see also* Opp. 1. As argued by Patent Owner, “Petitioner already received the patent owner’s preliminary response to the first petition on October 6, 2022, and on December 22, 2022, had received the Board’s decision denying to institute review for failing to demonstrate a reasonable likelihood of prevailing with respect to any of the challenged claims.” Opp. 9. Petitioner does not dispute this sequence. *See generally* Mot. and Reply.

However, the guidance received on October 6, 2022, and December 22, 2022, arrived after Meta filed the petitions in the Target IPRs. The merits of the Target IPRs thus were fixed before Petitioner received any of this guidance. Petitioner filed its Motions and Petitions during the one-month window that opened on January 31, 2023. However, because the

reference prior to filing its first set of petitions. *See, e.g.*, IPR2023-00639, Paper 3 (Patent Owner’s Opposition to the Motion for Joinder), 3, 8.

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Petitions are “me too” petitions and the merits of the challenges in the Target IPRs were formulated and fixed in the record on June 30, 2022, Petitioner did not receive any guidance from Patent Owner or the Board on its first set of petitions in October and December of 2022. Accordingly, any guidance provided by Patent Owner or the Board could not have influenced the content of the Petitions at issue in this proceeding. For this reason, we determine that the third *General Plastic* factor weighs against discretionarily denying institution.

4. “*the length of time that elapsed between the time the petitioner learned of the prior art asserted in the second petition and the filing of the second petition*”

As shown above in discussing the second *General Plastic* factor, Petitioner knew of the prior art asserted in the second set of petitions at least as early as January 25, 2022. *See* Ex. 2001, 16–17. Petitioner’s second set of petitions were filed on February 28, 2023. Petitioner argues that it “was unable to file the Petitions and move to join [the Target IPRs] until institution because it was time-barred under 35 U.S.C. § 315(b).” Mot. 12. This argument is not supported by the timing of Petitioner’s undisputed knowledge of the asserted art and the filing of the first set of petitions by Petitioner. As also discussed above in relation to the second *General Plastic* factor, on June 27, 2022, when Petitioner was not barred, Petitioner filed its first set of petitions with prior knowledge of the art asserted in the second set of petitions. At the same time, Petitioner was aware of Buckley and Bates and thus could have filed petitions asserting challenges on that prior art. As argued by Patent Owner, “Petitioner knew of the prior art when it prepared and filed [its first set of petitions]. Petitioner chose to withhold the prior art

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at that time.” Opp. 10–11. We determine that the fourth *General Plastic* factor weighs in favor of denying institution.

5. “*whether the petitioner provides adequate explanation for the time elapsed between the filings of multiple petitions directed to the same claims of the same patent*”

Petitioner filed its first petitions on June 27, 2022, the last date allowed before it was statutorily barred from filing any petition. *See* Mot. 5 (summarizing timeline of certain relevant events). After June 27, 2022, Petitioner was statutorily barred from filing any petition. 35 U.S.C. § 315(b). If Petitioner had wished to challenge claims of the patents at issue in these proceedings based on Buckley and Bates, it would have had to do so no later than June 27, 2022, the date on which it filed its first petitions. It chose not to do so despite knowing about and asserting invalidity based upon Buckley and Bates no later than January 25, 2022.

Petitioner contends that it 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).” Mot. 12. But Petitioner’s argument presumes that the only way it could have challenged the patents based on Buckley and Bates would have been to join Meta’s petitions in the Target IPRs. Petitioner fails to explain why it did not file its own petition based on Buckley and Bates between January 25, 2022, and June 27, 2022, the last day before Petitioner was statutorily barred.

The issue to be addressed in factor 5 is why Petitioner delayed “between the filings of multiple petitions directed to the same claims of the same patent.” This time period of relevant delay starts on the date that a first petition is filed by Petitioner, June 27, 2022, in this case and runs until the

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filing of the second petition filed by the Petitioner, February 28, 2023. Thus, any “delay” in filing a petition based upon Buckley and Bates between January 25, 2022, and June 26, 2022, is not relevant to our consideration of factor 5.

When the Board instituted review in the Target IPRs on January 31, 2023, a one-month window opened during which Petitioner could file the Petitions so long as they were accompanied by a motion for joinder. 37 C.F.R. § 42.122(b). Petitioner filed the Petitions and Motions in these proceedings on the last day of the one-month period set in our Rules. Once the Petitioner was barred beginning June 28, 2022, and decided to file the “me too” Petitions at issue here, we discern no meaningful delay because a one-month window for filing a non-barred petition opened for Petitioner on January 31, 2023. Under factor 5, Petitioner need not explain why it used the entire one-month time period set by our Rules to file the Petitions and Motions.

For these reasons, we determine that this fifth *General Plastic* factor weighs against denying institution.

6. “*the finite resources of the Board*”

Petitioner argues that “[a]llowing 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.” Mot. 13. Patent Owner argues:

Petitioner had its chance to file IPRs citing to the prior art it knew about in January, 2022. It chose not to. The finite resources of the Board should not be used for a Petitioner who filed an IPR withholding prior art of which it was aware, failed to demonstrate a reasonable likelihood of prevailing with respect to any of the challenged claims, and now wishes to file a second

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petition. Petitioner tries to justify its expenditure of Board resources in connection with its [first set of] petitions by [arguing that its second set of petitions] “... will not impact the Board’s resources beyond those resources the Board dedicates to the instant joinder motion” ([Mot.] 13). But this argument assumes that [the parties to the Target IPRs] will handle [the Target IPRs] until . . . complete. If [the Target IPRs] were to settle before then, however, then the Board’s resources will be impacted because [Petitioner] will have the opportunity to continue [the Target IPRs] even though th[ose] IPR[s] should be terminated at that point. Enough is enough! Petitioner has already made its decision for using Board resources in connection with its first [set of] petition[s]. This factor weighs in favor of denying institution and joinder.

Opp. 11. We find Patent Owner’s argument persuasive.

We agree with Patent Owner that because this is Petitioner’s second petition and Meta has been dismissed from the Target IPRs and Samsung has settled with Patent Owner, Petitioner would stand in to continue proceedings that would otherwise be terminated. Joinder in this circumstance would allow Petitioner to continue the proceedings, even after settlement with the primary petitioner, based on a second attempt by Petitioner. We are bound to follow the precedential Board decision in *Apple Inc. v. Uniloc 2017 LLC*, IPR2020-00854, Paper 9 (PTAB October 28, 2020) (precedential). The Apple panel, when evaluating factor six stated:

Although a joinder request is usually an efficient mechanism by which to become a petitioner in an IPR, in this case, Apple’s understudy role argument is not persuasive. Rather, we agree with Patent Owner that because this is Apple’s second petition, should Microsoft [the original petitioner] settle, Apple would stand in to continue a proceeding that would otherwise be terminated. Joinder in this circumstance would allow Apple to continue a proceeding, even after settlement with

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the primary petitioner, based on a second attempt by Apple. On balance, we conclude that this sixth General Plastic factor weighs in favor of denying institution of the proceeding.

Apple, 12. In the current circumstances, settlement of the Target IPRs with the existing petitioners is more than a hypothetical possibility; it has occurred. Patent Owner has settled the dispute presented in the Target IPRs with both Meta, which we have already dismissed, and Samsung, for which a motion to terminate due to settlement is pending. *See, e.g.*, IPR2022-01231, Paper 20 (terminating Target IPRs relating to Meta); IPR2022-01231, Paper 23 (joint motion to terminate due to settlement with Samsung).⁷ The rationale presented in *Apple* for finding that factor six weighs in favor of denying institution applies with even greater force in this proceeding.

For the reasons expressed above, we determine that this sixth *General Plastic* factor weighs in favor of denying institution of the proceeding.

7. “the requirement under 35 U.S.C. § 316(a)(11) to issue a final determination not later than 1 year after the date on which the Director notices institution of review”

Like the sixth *General Plastic* factor, the seventh factor, “the requirement under 35 U.S.C. § 316(a)(11) to issue a final determination not later than 1 year after the date on which the Director notices institution of review,” implicates an efficiency consideration. We note that the one-year deadline for entering a Final Written Decision in the Target IPRs was removed under 35 U.S.C. § 315(c) when we allowed Samsung to join the

⁷ The cited papers in IPR2022-01231 are representative of similar papers filed in all the Target IPRs.

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Target IPRs. Nevertheless, the Board maintains its goal to enter a Final Written Decision before the previously existing one-year time period, which expires January 31, 2024. We determine that factor seven neither favors nor disfavors denying institution.

Holistic Weighing of the Factors

After a holistic review of the *General Plastic* factors and the arguments presented for and against the exercise of discretionary denial, we conclude that the majority of the factors (four of seven with the seventh neutral) weigh in favor of denying institution of these proceedings. On balance and in view of the policy goals articulated in *General Plastic*, we conclude that it is appropriate here to exercise our discretion to deny institution under 35 U.S.C. § 314(a). Because we are exercising discretion to deny institution, we deny Petitioner's Motions for Joinder.

III. ORDER

For the reasons given, it is:

ORDERED that the Petitions in IPR2023-00638, IPR2023-00639, IPR2023-00640, and IPR2023-00641 are *denied*;

FURTHER ORDERED that the Motions for Joinder in IPR2023-00638, IPR2023-00639, IPR2023-00640, and IPR2023-00641 are *denied*; and

FURTHER ORDERED that a copy of this Decision shall be entered into the record of IPR2023-00638, IPR2023-00639, IPR2023-00640, and IPR2023-00641.

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