

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

T-MOBILE US, INC., T-MOBILE USA, INC.,
TELECOMMUNICATION SYSTEMS, INC., ERICSSON INC., and
TELEFONAKTIEBOLAGET LM ERICSSON
Petitioners,

v.

TRACBEAM, LLC,
Patent Owner

Case No. IPR2015-01713
Patent 8,032,153

JOINT MOTION TO LIMIT PETITION UNDER 37 C.F.R. § 42.71

I. Statement of the Precise Relief Requested.

Pursuant to 37 C.F.R. § 42.71 and an email authorizing this motion,¹ Petitioners T-Mobile US, Inc., T-Mobile USA, Inc., TeleCommunication Systems, Inc., Ericsson Inc., and Telefonaktiebolaget LM Ericsson (collectively “Petitioners”) and Patent Owner TracBeam, LLC (“Patent Owner”) jointly request that the Board limit this Petition for *Inter Partes* Review of U.S. Patent No. 8,032,153 (“the ‘153 patent”) to claims 1, 3, and 15. Accordingly, the parties respectfully request that the Board remove claims 16, 20, 21, 23, 27, and 29 of the ‘153 patent from this proceeding.

II. Statement of Facts.

Petitioners filed this Petition for *Inter Partes* Review on August 11, 2015, requesting review of claims 1, 3, 15, 16, 20, 21, 23, 27, and 29 of the ‘153 patent. Patent Owner recently filed its Preliminary Response on November 16, 2015.

This proceeding is still in its preliminary stages. The Board has yet to decide whether to institute a trial.

¹ Email from Maria Vignone, Paralegal Operations Manager, Patent Trial and Appeal Board, to Sean Luner and others, respective counsel for Patent Owner and Petitioners (November 17, 2015).

The T-Mobile Petitioners and Patent Owner are parties in a litigation involving the ‘153 patent in the United States District Court for the Eastern District of Texas, *TracBeam, LLC v. T-Mobile US, Inc. et al.*, Case No. 6:14-cv-00678.²

On November 16, 2015, all Petitioners and Patent Owner executed a *Narrowing Agreement*, in which they agreed to limit the issues in dispute in both the District Court litigation and in multiple *Inter Partes* Reviews, by, among other things, agreeing to file this Motion to remove claims 16, 20, 21, 23, 27, and 29 from this proceeding.

Concurrent with this *Joint Motion to Limit the Petition* in this proceeding, pursuant to the *Narrowing Agreement*, the Petitioners and Patent Owner are also filing:

(a) *Joint Motions to Terminate* in the following proceedings:

- IPR2015-01682;
- IPR2015-01684;

² The District Court litigation also involves U.S. Patent Nos. 7,764,231, 7,298,327, and 7,525,484. Petitioners filed Petitions for *Inter Partes* Review concerning each of these patents. *See* IPR2015-01681, IPR2015-01682, IPR2015-01684, IPR2015-01686, IPR2015-01687, IPR2015-01709, IPR2015-01711, IPR2015-01712, and IPR2015-01713.

- IPR2015-01686; and
- IPR2015-01709;

(b) *Joint Motions to Limit Petition* in the following proceedings:

- IPR2015-01681 limited to claims 25 and 82;
- IPR2015-01687 limited to claims 17, 20, and 25;
- IPR2015-01708 limited to claims 1, 25, and 51;
- IPR2015-01711 limited to claim 27; and
- IPR2015-01712 limited to claims 1, 2, 44, and 60

III. Argument.

A. Limiting the Petition is Appropriate.

The parties respectfully submit that the Board should limit the Petition in this proceeding to claims 1, 3, and 15 of the ‘153 patent for the following reasons.

First, the parties are filing this joint motion early in this proceeding, just days after Patent Owner filed its Preliminary Response and well before the Board will decide whether to institute trial. *See Netflix, Inc. v. Copy Protection LLC*, IPR2015-00921, Paper 14 at 2 (June 5, 2015) (“this proceeding is still in its preliminary stages, and a decision has not been made yet whether to institute trial”); *Fresenius-Kabi USA LLC v. Cubist Pharmaceuticals, Inc.*, IPR2015-

00223, Paper 28 at 2-3 (September 18, 2015) (the proceedings “are still in their preliminary stages.”).

Second, because the merits of the petition have not been determined, reducing the number of claims at this early juncture allows both the District Court litigation and these proceedings to be conducted more efficiently and less expensively, consistent with 37 C.F.R. § 42.1(b) (the PTAB rules should be “construed to secure the just, speedy, and inexpensive resolution of every proceedings”); *see Fresenius-Kabi USA LLC v. Cubist Pharmaceuticals, Inc.*, IPR2015-00223, Paper 28 at 2 (“The narrowing of issues at this preliminary stage of the proceedings would serve to both conserve judicial resources and facilitate the Board’s goal of resolving *inter partes* reviews in a just, speedy, and inexpensive manner.”); *Netflix, Inc. v. Copy Protection LLC*, IPR2015-00921, Paper 14 at 2 (June 5, 2015) (“limiting the proceedings facilitates the board’s goal of resolving *inter partes* reviews in a just, speedy, and inexpensive manner.” (citing 37 C.F.R. § 42.1(b))).

Third, the parties agreed to limit this petition in connection with a broader agreement to narrow the disputed issues in several co-pending proceedings, including multiple *Inter Partes* Reviews and the District Court litigation.

Fourth, under the *Narrowing Agreement*, Petitioners agreed that they will not participate in challenging the claims that the parties seek to remove from this

proceeding if this *Motion to Limit Petition* is not granted and the proceeding is instituted.

The Board has consistently granted Motions to Limit Petitions under these circumstances, *see, e.g.*:

- *Fresenius-Kabi USA LLC v. Cubist Pharmaceuticals, Inc.*, IPR2015-00223, Paper 28 (September 18, 2015);
- *Netflix, Inc. v. Copy Protection LLC*, IPR2015-00921, Paper 14 (June 5, 2015);
- *Fresenius Kabi USA LLC v. Cubist Pharmaceuticals, Inc.*, IPR2015-01566, Paper 15 (September 15, 2015);
- *AAB, Inc. v. ROY-G-BIV Corporation*, IPR2013-00282, Paper 11 (June 10, 2013);
- *Aker Marine AS v. Neptune Technologies and Bioresources, Inc.*, IPR2014-00003, Paper 21 (February 3, 2014).

B. A Copy of the Narrowing Agreement is Provided.

The *Narrowing Agreement* has been executed in writing. A true copy is filed along with this Motion, as business confidential information pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74, as Exhibit 2001.

A Joint Request to File an Agreement as Business Confidential Information
under 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74 is also being filed along with this
Motion.

C. Summary.

For the foregoing reasons, Petitioners and Patent Owner respectfully request
that the Board limit the Petition in this proceeding to claims 1, 3, and 15, and
remove claims 16, 20, 21, 23, 27, and 29 from consideration.

Respectfully submitted,

Date: November 24, 2015

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CERTIFICATE OF FILING AND SERVICE

I hereby certify that a true and correct copy of the foregoing **JOINT MOTION TO LIMIT PETITION UNDER 37 C.F.R. § 42.71** is being filed via PRPS and served by electronic mail this 24th day of November, 2015 on counsel for Petitioners as follows:

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