

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GENERAL ELECTRIC COMPANY,
Petitioner,

v.

TRANSDATA, INC.,
Patent Owner.

Case IPR2014-01380
Patent 6,903,699 C1¹

Before LYNNE E. PETTIGREW, FRANCES L. IPPOLITO, and
CHRISTOPHER M. KAISER, *Administrative Patent Judges*.

KAISER, *Administrative Patent Judge*.

DECISION
Denying Institution of *Inter Partes* Review
37 C.F.R. § 42.108

¹ Patent 6,903,699 B2 as modified by reexamination certificate 6,903,699 C1.

IPR2014-01380
Patent 6,903,699 C1

INTRODUCTION²

A. Background

General Electric Company (“Petitioner”) filed a Petition (Paper 1, “Pet.”) requesting an *inter partes* review of claims 1, 3, 5, 8, 10, 11, 16, and 21–53 of U.S. Patent No. 6,903,699 (Ex. 1001, “the ’699 patent”).

TransData, Inc. (“Patent Owner”) filed a Preliminary Response. Paper 22 (“Prelim. Resp.”). Petitioner filed a Reply to the Preliminary Response. Paper 27 (“Reply”); *see also* Paper 24 (order authorizing Reply).

We have authority to determine whether to institute an *inter partes* review. 35 U.S.C. § 314(b); 37 C.F.R. § 42.4(a). The standard for instituting an *inter partes* review is set forth in 35 U.S.C. § 314(a), which provides that an *inter partes* review may not be instituted “unless the Director determines . . . there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.” Under 35 U.S.C. § 315(b), “[a]n *inter partes* review may not be instituted if the petition requesting the proceeding is filed more than 1 year after the date on which the . . . privity of the petitioner is served with a complaint alleging infringement of the patent.”

After considering the Petition, the Preliminary Response, and the Reply, we determine that a privity of Petitioner was served with a complaint

² An earlier, non-public version of this decision was issued March 2, 2015. Paper 28. Because the present version is being issued solely to complete the public record of this proceeding, the portions of this decision relating to the treatment of confidential information are relevant only to the original non-public version. All due dates shall be computed based upon the date of issuance of the original, non-public version of this decision.

PUBLIC VERSION

IPR2014-01380
Patent 6,903,699 C1

alleging infringement of the '699 patent more than one year before the Petition was filed. Accordingly, we do not institute *inter partes* review.

B. Related Matters

The '699 patent has been asserted against multiple defendants, including Oklahoma Gas & Electric Company ("OG&E"), in an ongoing multidistrict litigation proceeding, *In re TransData Inc. Smart Meters Patent Litigation*, No. 5:12-ml-2309 (W.D. Okla.) ("the MDL proceeding"). Pet. 1–2;³ Ex. 2002, 6–7. One of the lawsuits alleging infringement of the '699 patent that was consolidated into the MDL proceeding was *TransData Inc. v. Oklahoma Gas & Electric Company*, No. 5-11-cv-01032 (W.D. Okla.) ("the Oklahoma lawsuit"). Paper 4, 1; *see* Ex. 2003, 9 (requiring future filings in case 5-11-cv-01032 to be made in case 5:12-ml-2309). The Oklahoma lawsuit was consolidated into the MDL proceeding on August 23, 2012. Ex. 2003, 9.

Patents 6,462,713 and 6,181,294, both of which are related to the '699 patent, also were asserted in the Oklahoma lawsuit and the MDL proceeding. Ex. 2002, 3–6. These patents are the subjects of pending petitions for *inter partes* review, IPR2014-01505 and IPR2014-01559, respectively.

Additionally, *ex parte* reexaminations are currently pending for claims 1, 3,

³ The page numbers in the Petition begin at 1, increase to 6, then start at 2 and increase thereafter to 61. The material cited here appears on the first page 6 and the second page 2, which are consecutive pages. To minimize confusion in this decision, we will not cite to the first set of pages 1 through 5, we will cite the first page 6 as page 1, and we will cite the remainder of the pages (the second page 2 through page 61) according to their indicated page numbers.

PUBLIC VERSION

IPR2014-01380
Patent 6,903,699 C1

5, and 16 of the '699 patent; claims 1, 2, 5, 6, 7, 15, 16, and 18–26 of the '713 Patent; and claims 17–20 and 22–29 of the '294 Patent. Pet. 2–3.

C. The Asserted Grounds of Unpatentability

Petitioner contends that claims 1, 3, 5, 8, 10, 11, 16, and 21–53 of the '699 patent are unpatentable under 35 U.S.C. §§ 102 and 103 based on the following grounds (Pet. 23, 31–60):⁴

⁴ Petitioner also provides a declaration from Gregory A. DesBrisay. Ex. 1012 (“the DesBrisay Declaration”).

IPR2014-01380
 Patent 6,903,699 C1

Statutory Ground	Basis ⁵	Challenged Claims
§ 102(e)	Bush	1, 3, 5, 8, 10, 11, 16, 21, 23, 25–47, and 49
§ 103	Bush and Johnson	1, 3, 5, 8, 10, 11, 16, 21, 23, 25–47, and 49
§ 103	Bush, Johnson, and Bearden	22 and 24
§ 103	Bush and AMR Report	45–48, 50, and 52
§ 103	Bush, AMR Report, and Siwiak	50 and 51
§ 103	Bush, AMR Report, and Krenz	53

D. The '699 Patent

The '699 patent relates to electric meters that can communicate over public wireless data networks. Specifically, the '699 patent describes a wireless communication device that permits information to be communicated to and from an electric meter contained in a meter chassis that has a protruding dielectric housing. Ex. 1001, 2:53–56. The '699 patent describes an embodiment of such a device that comprises “(1) a communication circuit within the chassis coupled to electric meter circuitry, and (2) an antenna element within the dielectric housing, the antenna coupled to the communication circuit.” *Id.* at 2:58–62.

⁵ U.S. Patent No. 6,078,785 (Ex. 1003) (“Bush”); U.S. Patent No. 5,553,094 (Ex. 1005) (“Johnson”); U.S. Patent No. 5,627,759 (Ex. 1006) (“Bearden”); RICHARD D. ALEXANDER, AUTOMATIC METER READING: THE REPORT FOR ELECTRIC UTILITIES (Greg Formanek, ed., 1993) (Ex. 1004) (“AMR Report”); U.S. Patent No. 4,737,797 (Ex. 1007) (“Siwiak”); U.S. Patent No. 5,508,709 (Ex. 1008) (“Krenz”).

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