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Paper 14
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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ENFORA, INC., NOVATEL WIRELESS SOLUTIONS, INC., and NOVATEL WIRELESS, INC.,
Petitioner,

v.

M2M SOLUTIONS LLC,
Patent Owner.

Case IPR2015-01670
Patent 8,648,717 B2

Before KALYAN K. DESHPANDE, JUSTIN T. ARBES, and DANIEL J. GALLIGAN, *Administrative Patent Judges*.

GALLIGAN, *Administrative Patent Judge.*

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

I. INTRODUCTION

Enfora, Inc., Novatel Wireless Solutions, Inc., and Novatel Wireless, Inc. (collectively, "Petitioner") filed a Petition ("Pet.") requesting *inter partes* review of claims 1–7, 10–20, and 23–30 of U.S. Patent No. 8,648,717 B2 ("the '717 patent," Ex. 1001). Paper 2. M2M Solutions LLC ("Patent Owner") timely filed a Preliminary Response. Paper 8 ("Prelim. Resp."). We have jurisdiction under 35 U.S.C. § 314 and 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:

> THRESHOLD—The Director may not authorize an inter partes review to be instituted unless the Director determines that 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.

Upon consideration of the information presented in the Petition and the Preliminary Response, we are not persuaded that Petitioner has established a reasonable likelihood that it would prevail in its challenges to claims 1–7, 10–20, and 23–30 of the '717 patent. Accordingly, we decline to institute an *inter partes* review of these claims.

A. Related Matters

Petitioner and Patent Owner cite a number of judicial matters in the United States District Court for the District of Delaware involving the '717 patent, as well as matters involving ancestor patents of the '717 patent. *See* Pet. 1–2; Paper 5. Petitioner concurrently filed another Petition for *inter partes* review challenging claims 1–7, 10–14, 18, and 21–30. Pet. 2; IPR2015-01672. Three additional Petitions for *inter partes* review have

been filed by other petitioners challenging various claims of the '717 patent. *See* IPR2015-01823; IPR2016-00054; IPR2016-00055.

B. The '717 Patent (Ex. 1001)

The '717 patent is generally directed to a programmable communicator device. Ex. 1001, Abstract. The '717 patent has three independent claims—claims 1, 24, and 29. Claim 1 is reproduced below:

> 1. A programmable communicator device comprising:
>
> a programmable interface for establishing a communication link with at least one monitored technical device, wherein the programmable interface is programmable by wireless packet switched data messages; and
>
> a processing module for authenticating one or more wireless transmissions sent from a programming transmitter and received by the programmable communicator device by determining if at least one transmission contains a coded number;
>
> wherein the programmable communicator device is configured to use a memory to store at least one telephone number or IP address included within at least one of the transmissions as one or more stored telephone numbers or IP addresses if the processing module authenticates the at least one of the transmissions including the at least one telephone number or IP address and the coded number by determining that the at least one of the transmissions includes the coded number, the one or more stored telephone numbers or IP addresses being numbers to which the programmable communicator device is configured to and permitted to send outgoing wireless transmissions;
>
> wherein the programmable communicator device is configured to use an identity module for storing a unique identifier that is unique to the programmable communicator device;
>
> and wherein the one or more wireless transmissions from the programming transmitter comprises a General Packet Radio Service (GPRS) or other wireless packet switched data message;
>
> and wherein the programmable communicator device is configured to process data received through the programmable

interface from the at least one monitored technical device in response to programming instructions received in an incoming wireless packet switched data message.

C. Prior Art Relied Upon

Petitioner relies upon the following prior art references:

Kennedy, III et al. (hereinafter "Kennedy")	US 5,771,455	June 23, 1998	Ex. 1026
Gaukel	US 6,072,396	June 6, 2000	Ex. 1027
Van Bergen	WO 00/17021	Mar. 30, 2000	Ex. 1028
Specification of the Bluetooth System, v1.0B (1999) (hereinafter "Bluetooth Specification")			Ex. 1034
Applicant's Admitted Prior Art (AAPA)—excerpts from Ex. 1001, 1:30–4:9 ("Background of the Invention" section of the '717 patent).			

D. Asserted Grounds of Unpatentability

Petitioner challenges claims 1–7, 10–20, and 23–30 of the '717 patent based on the asserted grounds of unpatentability set forth in the table below.

References	**Basis**	**Claim(s) Challenged**
Kennedy and AAPA	§ 103(a)	1–7, 10–18, and 24–30
Kennedy, AAPA, and Gaukel	§ 103(a)	19 and 20
Kennedy, AAPA, and Van Bergen	§ 103(a)	23
Kennedy, AAPA, and Bluetooth Specification[1]	§ 103(a)	4

[1] Petitioner proposes this as an alternative ground. Pet. 44.

II. CLAIM CONSTRUCTION

Petitioner and Patent Owner propose constructions for various terms of the '717 patent. Pet. 10–16; Prelim. Resp. 2–6; Papers 10, 12. Based on Petitioner's unpatentability challenges, we determine that these terms, as well as all remaining terms, need not be construed explicitly at this time.

III. ANALYSIS

A. "Processing Module for Authenticating"

All of the asserted grounds of unpatentability in this Petition rely on Kennedy as allegedly teaching or suggesting the following limitation of independent claims 1, 24, and 29: "a processing module for authenticating one or more wireless transmissions sent from a programming transmitter and received by the programmable communicator device by determining if at least one transmission contains a coded number." *See* Pet. 32–35, 50, 54. Petitioner contends that Kennedy teaches this limitation in two ways. *Id.*

First, Petitioner argues that Kennedy discloses a "handshake protocol" in which a challenge is issued and a response is transmitted in return. Pet. 33–34 (citing Ex. 1026, 16:44–48, 18:61–19:58; Ex. 1004 ¶ 140). Kennedy discloses: "If the platform receives a challenge, then at block 332 the platform returns a response based on the challenge received, a key particular to the mobile unit, and an encryption algorithm." Ex. 1026, 19:35–38. Petitioner argues that "[a] 'key' in this instance is a 'coded number.'" Pet. 33. Petitioner further argues: "In this manner, the units 16, 216 only permit receipt of the programming transmission if it contains, in part, a key that i[s] 'particular to the mobile unit,' *i.e.*, that is unique to the mobile unit in the system in which it is used." *Id.* at 34.

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