

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SIERRA WIRELESS AMERICA, INC., SIERRA WIRELESS, INC.,
and RPX CORP.,
Petitioner,

v.

M2M SOLUTIONS LLC,
Patent Owner.

Case IPR2015-01823
Patent 8,648,717 B2

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

GALLIGAN, *Administrative Patent Judge*.

FINAL WRITTEN DECISION
35 U.S.C. § 318

I. INTRODUCTION

In this *inter partes* review, instituted pursuant to 35 U.S.C. § 314 and 37 C.F.R. § 42.108, Sierra Wireless America, Inc., Sierra Wireless, Inc., and RPX Corp. (collectively, “Petitioner”) challenge the patentability of claims 1, 3, 5, 6, 10–13, 15–24, and 29 of U.S. Patent No. 8,648,717 B2 (“the ’717 patent,” Ex. 1001), owned by M2M Solutions LLC (“Patent Owner”).

We have jurisdiction under 35 U.S.C. § 6. This Final Written Decision, issued pursuant to 35 U.S.C. § 318(a), addresses issues and arguments raised during trial. For the reasons discussed below, we determine that Petitioner has proven by a preponderance of the evidence that claims 24 and 29 of the ’717 patent are unpatentable. *See* 35 U.S.C. § 316(e) (“In an *inter partes* review instituted under this chapter, the petitioner shall have the burden of proving a proposition of unpatentability by a preponderance of the evidence.”). However, Petitioner has not proven by a preponderance of the evidence that claims 1, 3, 5, 6, 10–13, and 15–23 of the ’717 patent are unpatentable.

A. Procedural History

On August 26, 2015, Petitioner requested *inter partes* review of claims 1–3, 5–7, 10–24, 29, and 30 of the ’717 patent. Paper 1, “Pet.” Patent Owner filed a Preliminary Response. Paper 11. In a Decision on Institution of *Inter Partes* Review, we instituted trial of claims 1, 3, 5, 6, 10–13, 15–24, and 29, but we denied institution as to claims 2, 7, 14, and 30. Paper 16, “Dec. on Inst.” Trial was instituted on the following grounds of unpatentability:

1. Whether claims 1, 3, 5, 6, 10–13, 15, 18, 22–24, and 29 are unpatentable under 35 U.S.C. § 103(a) as having been obvious over Whitley¹ and the SIM Specification;²
2. Whether claims 16, 17, 19, and 20 are unpatentable under 35 U.S.C. § 103(a) as having been obvious over Whitley, the SIM Specification, and Kail;³ and
3. Whether claim 21 is unpatentable under 35 U.S.C. § 103(a) as having been obvious over Whitley, the SIM Specification, and Eldredge.⁴

Dec. on Inst. 32–33.

During the trial, Patent Owner filed a Response (Paper 27, “PO Resp.”), and Petitioner filed a Reply (Paper 33, “Reply”).

An oral hearing was held on December 5, 2016, a transcript of which appears in the record. Paper 37 (“Tr.”).

B. 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. 3; Paper 8. The ’717 patent is also the subject of *Telit Wireless Solutions Inc. et al. v. M2M Solutions LLC*, Case IPR2016-00055, in which the Board is issuing a Final Written Decision concurrently.

¹ WO 99/49680 A1, published Sept. 30, 1999 (Ex. 1003).

² Digital cellular telecommunications system (Phase 2+); Specification of the Subscriber Identity Module - Mobile Equipment (SIM - ME) interface (GSM 11.11 version 7.4.0 Release 1998) (1999) (Ex. 1004).

³ US 5,959,529, issued Sept. 28, 1999 (Ex. 1005).

⁴ WO 95/05609, published Feb. 23, 1995 (Ex. 1006).

C. Illustrative Claim

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 29 is reproduced below:

29. 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 containing instructions to program the stored number comprise one or more short message service (SMS) data messages; 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 at least one

incoming short message service (SMS) data message or packet switched data message.

Ex. 1001, 16:1–38.

II. ANALYSIS

A. Claim Construction

In an *inter partes* review, “[a] claim in an unexpired patent shall be given its broadest reasonable construction in light of the specification of the patent in which it appears.” 37 C.F.R. § 42.100(b); *see Cuozzo Speed Techs., LLC v. Lee*, 136 S. Ct. 2131, 2144–46 (2016) (upholding the use of the broadest reasonable interpretation standard). In applying a broadest reasonable construction, claim terms generally are given their ordinary and customary meaning, as would be understood by one of ordinary skill in the art in the context of the entire disclosure. *See In re Translogic Tech., Inc.*, 504 F.3d 1249, 1257 (Fed. Cir. 2007). This presumption may be rebutted when a patentee, acting as a lexicographer, sets forth an alternate definition of a term in the specification with reasonable clarity, deliberateness, and precision. *In re Paulsen*, 30 F.3d 1475, 1480 (Fed. Cir. 1994).

Petitioner proposed constructions for the terms “coded number,” “identity module,” and “programming transmitter,” and Petitioner proposed “programmable interface” be given its plain and ordinary meaning. Pet. 13–16. In its Preliminary Response, Patent Owner contended that Petitioner’s proposed constructions for the terms “identity module” and “programming transmitter” were incorrect, but Patent Owner did not propose its own constructions for these terms in its Preliminary Response. Prelim. Resp. 2–3. We determined in the Decision on Institution that, at that time, these terms did not require express constructions. Dec. on Inst. 6.

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