

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*.

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

I. INTRODUCTION

Sierra Wireless America, Inc., Sierra Wireless, Inc., and RPX Corp. (collectively, “Petitioner”) filed a Petition requesting *inter partes* review of claims 1–3, 5–7, 10–24, 29, and 30 of U.S. Patent No. 8,648,717 B2 (“the ’717 patent,” Ex. 1001). Paper 1 (“Pet.”).¹ M2M Solutions LLC (“Patent Owner”) timely filed a Preliminary Response. Paper 11 (“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.

After considering the Petition, the Preliminary Response, and associated evidence, we conclude that Petitioner has demonstrated a reasonable likelihood of prevailing in showing unpatentability of claims 1, 3, 5, 6, 10–13, 15–24, and 29 of the ’717 patent. Thus, we institute an *inter partes* review as to 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

¹ We note that the Petition improperly uses single-spacing and a smaller font in the footnotes. *See* 37 C.F.R. § 42.6(a)(2). We will consider the full Petition, however, as it is only 57 pages (less than the 60-page limit). The parties shall follow the formatting rules for papers going forward.

patent, as well as matters involving ancestor patents of the '717 patent. *See* Pet. 3; Paper 8.

B. The '717 Patent

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. References

Petitioner relies upon the following references:

Kail	US 5,959,529	Sept. 28 1999	Ex. 1005
Eldredge	WO 95/05609	Feb. 23, 1995	Ex. 1006
Whitley	WO 99/49680 A1	Sept. 30, 1999	Ex. 1003
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) (hereinafter “SIM Specification”) ²		Dec. 1999	Ex. 1004
Excerpts from Expert Report by Dr. Ray W. Nettleton (hereinafter “Nettleton Report”)			Ex. 1008

² Based on the current record, Petitioner has made a threshold showing that the SIM Specification is a prior art printed publication under 35 U.S.C. § 102(b). *See* Pet. 5–6; Ex. 1013 ¶ 48; *Kyocera Wireless Corp. v. ITC*, 545 F.3d 1340, 1350–51 (Fed. Cir. 2008) (holding that a “reference is publicly accessible ‘upon a satisfactory showing that such document has been disseminated or otherwise made available to the extent that persons interested and ordinarily skilled in the subject matter or art exercising reasonable diligence, can locate it,’” and analyzing a similar set of ETSI standard documents) (citation omitted). Patent Owner does not argue in its Preliminary Response that the SIM Specification does not qualify as a prior art printed publication.

D. Asserted Grounds of Unpatentability

Petitioner challenges claims 1–3, 5–7, 10–24, 29, and 30 of the '717 patent based on the asserted grounds of unpatentability set forth in the table below.³

References	Basis	Claim(s) Challenged
Whitley and SIM Specification	§ 103(a)	1–3, 5–7, 10–15, 18, 22–24, 29, and 30
Whitley, SIM Specification, and Nettleton Report	§ 103(a)	1–3, 5–7, 10–15, 18, 22–24, 29, and 30
Whitley, SIM Specification, and Kail	§ 103(a)	16, 17, 19, and 20
Whitley, SIM Specification, and Eldredge	§ 103(a)	21

II. ANALYSIS

A. 35 U.S.C. § 325(d)

Patent Owner argues that the Petition should be denied under 35 U.S.C. § 325(d) because Whitley and the SIM Specification, which are relied upon for all unpatentability challenges in this Petition, were considered during prosecution. Prelim. Resp. 4–9. We are not persuaded that the Petition should be denied on this basis. Although Patent Owner provides evidence to indicate that the references were of record during the

³ Petitioner’s statement of relief requested identifies the challenged claims as claims 1–3, 5–7, 10–24, 29, and 30 (Pet. 4), and these are the claims for which Petitioner presents evidence and argument in the Petition. Petitioner’s statement that it “requests that claims 1–7 and 10–30 of the ‘717 patent be canceled based on the following grounds” (Pet. 6) appears to be a typographical error because Petitioner has not offered evidence or argument challenging claims 4 and 25–28. Accordingly, we do not consider these claims to be at issue.

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