UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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TELIT WIRELESS SOLUTIONS INC. and
TELIT COMMUNICATIONS PLC,
Petitioner,

v.

M2M SOLUTIONS LLC,
Patent Owner.

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Case IPR2016-00054
Patent 8,648,717 B2

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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

Telit Wireless Solutions Inc. and Telit Communications PLC (collectively, "Petitioner") filed a Petition ("Pet.") requesting *inter partes* review of claims 1–30 of U.S. Patent No. 8,648,717 B2 ("the '717 patent," Ex. 1001), which are all of the claims of the '717 patent. Paper 1. 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 1–30 of the '717 patent. Accordingly, we decline to institute an *inter partes* review of those 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 1–30 of the '717 patent. Pet. 3; IPR2016-00055.

B. 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 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

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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:

Wandel	US 6,034,623	Mar. 7, 2000	Ex. 1013
McGarry et al. (hereinafter "McGarry")	US 6,038,491	Mar. 14, 2000	Ex. 1025
Boden et al. (hereinafter "Boden")	US 6,182,228 B1	Jan. 30, 2001 (filed Aug. 17, 1998)	Ex. 1027
Fernandez et al. (hereinafter "Fernandez")	US 6,697,103 B1	Feb. 24, 2004 (filed Mar. 19, 1998)	Ex. 1023
Whitley	WO 99/49680	Sept. 30, 1999	Ex. 1026
Sonera	WO 00/14984	Mar. 16, 2000	Ex. 1019

D. Asserted Grounds of Unpatentability

Petitioner challenges claims 1–30 of the '717 patent based on the asserted grounds of unpatentability set forth in the table below.

Reference(s)	Basis	Claim(s) Challenged
Wandel	§ 102(b)	1–3, 5–15, 18, and 23–28
Wandel and Sonera	§ 103(a)	4
Wandel and Fernandez	§ 103(a)	16, 17, 19, 20, and 22
Wandel and McGarry	§ 103(a)	21
Wandel and Whitley	§ 103(a)	29 and 30
Wandel and Boden[1]	§ 103(a)	1–3, 5–15, 18, and 23–28
Wandel, Boden, and Sonera	§ 103(a)	4
Wandel, Boden, and Fernandez	§ 103(a)	16, 17, 19, 20, and 22

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[1] Petitioner proposes the challenges based on Boden as alternative grounds to address the possibility of a narrower claim construction. Pet. 4–5, 55–58.

| Wandel, Boden, and McGarry | § 103(a) | 21 |
| Wandel, Boden, and Whitley | § 103(a) | 29 and 30 |

II. CLAIM CONSTRUCTION

Petitioner and Patent Owner propose constructions for two terms of the '717 patent. Pet. 8–11; Prelim. Resp. 2–5. 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

Petitioner contends that Wandel anticipates independent claims 1 and 24 and that the combination of Wandel and Whitley renders obvious claim 29. Pet. 12–25, 35–36, 51–54. Petitioner further contends that the combination of Wandel and Boden renders obvious claims 1 and 24, and the combination of Wandel, Boden, and Whitley renders obvious claim 29. Pet. 55–58. All of the asserted grounds of unpatentability in this Petition rely on Wandel as allegedly disclosing storing an IP address, as recited in independent claims 1, 24, and 29. *See id.* at 21–22, 36, 51–53, 55–58.

A. *Wandel*

Wandel discloses a radio modem for a Mobitex network having "a stored autonomous radio telemetry (ART) program that converts the otherwise general purpose radio modem into a special purpose radio telemetry device." Ex. 1013, 4:29–37, 5:44–47. Wandel discloses that "the ART program reconfigures the serial port of the radio modem from a standard Mobitex MASC [(Mobitex Asynchronous Protocol)] protocol to a general purpose input/output system that supports TTL logic, simple switches, and an I^{2}C bus." *Id.* at 5:52–56.

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