

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

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

v.

M2M SOLUTIONS LLC,
Patent Owner.

Case IPR2016-00054
Patent 8,648,717 B2

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

GALLIGAN, *Administrative Patent Judge*.

DECISION
Request for Rehearing
37 C.F.R. § 42.71

INTRODUCTION

On May 23, 2016, Telit Wireless Solutions Inc. and Telit Communications PLC (collectively, “Petitioner”) filed a Request for Rehearing (Paper 10, “Req. Reh’g”) of our Decision (Paper 9, “Dec.”) denying *inter partes* review of all grounds raised in the Petition (Paper 1, “Pet.”), which challenged claims 1–30 of U.S. Patent No. 8,648,717 B2 (“the ’717 patent”). Petitioner submits new evidence (Exs. 1037–41) with its Request for Rehearing.

For the reasons that follow, Petitioner’s Request for Rehearing is denied.

STANDARD OF REVIEW

Under 37 C.F.R. § 42.71(c), “[w]hen rehearing a decision on petition, a panel will review the decision for an abuse of discretion.” The party requesting rehearing has the burden of showing that the decision from which rehearing is sought should be modified, and “[t]he request must specifically identify all matters the party believes the Board misapprehended or overlooked.” 37 C.F.R. § 42.71(d).

ANALYSIS

On rehearing, Petitioner argues that a Memorandum Opinion from the U.S. District Court for the District of Delaware addressing, *inter alia*, U.S. Patent No. 8,094,010 B2 (“the ’010 patent”), which is related to the ’717 patent, presents “[n]ew facts . . . that Petitioner could not have previously raised in its earlier Petition.” Req. Reh’g 1, 3 (citing Ex. 1037, Memorandum Opinion, Jan. 6, 2016, *M2M Solutions Inc. v. Motorola Solutions, Inc., et al.*, Case No. 1:2012-cv-00033-RGA (D. Del)). According to Petitioner, the District Court determined that claims of the

'010 patent required only the capability to perform certain functions. *Id.* at 1. Petitioner argues that, based on the District Court's decision regarding the '010 patent, we misapprehended the scope of the claims of the '717 patent, which should be construed more broadly to require only the capability to perform certain functions, particularly storing an IP address. *Id.* at 4, 11. Petitioner contends that under this construction, which is the broadest reasonable interpretation, U.S. Patent No. 6,034,623 (Ex. 1013, "Wandel") anticipates or, in combination with other references, renders obvious the challenged claims because our Decision "confirmed that Wandel disclosed a device that was *capable* of using IP addresses." *Id.* at 4 (citing Dec. 11).

We are not persuaded. As an initial matter, we could not have misapprehended or overlooked evidence that was not part of the record at the time of the Decision. To the extent Petitioner contends that we should consider the evidence for the first time now, Petitioner has not shown good cause for doing so. *See* Office Patent Trial Practice Guide, 77 Fed. Reg. 48,756, 48,768 (Aug. 14, 2012) (in deciding a request for rehearing, "[e]vidence not already of record at the time of the decision will not be admitted absent a showing of good cause"). The District Court Opinion cited by Petitioner issued January 6, 2016, more than three weeks before Patent Owner filed its Preliminary Response and more than three months before we issued our Decision. On rehearing, Petitioner states "Patent Owner argued a claim interpretation inconsistent with the Court's decision and its own position in the Court" in the Patent Owner Preliminary Response. Req. Reh'g 3. However, in the nearly three months between when Patent Owner filed its Preliminary Response and when we issued our

Decision, Petitioner did not attempt to bring this to our attention or, for example, seek authorization to file a reply to the Preliminary Response. Rather, Petitioner waited a full month after we issued our Decision to raise this issue. In view of Petitioner's delay, we are not persuaded Petitioner has demonstrated good cause to introduce this evidence.

Furthermore, Petitioner mischaracterizes our Decision in asserting that we found Wandel's device to be "capable" of using IP addresses. *See id.* at 2, 4. In our Decision, we found "Wandel explicitly states that the disclosed radio modem operates on the Mobitex network" (Dec. 9 (citing Ex. 1013, 4:29–37)), and Petitioner did not assert that addresses in a Mobitex network are IP addresses (*id.* at 7). As we stated in our Decision,

Petitioner has not proffered sufficient evidence to persuade us that Wandel, as viewed by a person of ordinary skill in the art, discloses an "IP-based CDPD network" or that "Wandel's radio modem communicated over the CDPD network," such that the "destination address[es] for log packets" disclosed in Wandel would have been IP addresses.

Id. at 10 (emphasis added) (citing Pet. 22–23). We further found:

Although the evidence supports the proposition that, in an IP-based network, IP addresses would have been used, this evidence is insufficient to demonstrate that a person of ordinary skill in the art would view Wandel as disclosing a radio modem operating in an IP-based CDPD network, especially in view of Wandel's express disclosure that the described radio modem is operable in a Mobitex network.

Id. (citing Ex. 1013, 4:29–37). Therefore, Petitioner's assertions on rehearing that we found Wandel's device to be "capable" of using IP addresses are incorrect. *See* Req. Reh'g 2, 4.

In view of the foregoing, we are not persuaded that we “misapprehended the breadth of the claims and thus the relevance of the prior art,” as asserted by Petitioner. *See id.* at 2.

On rehearing, Petitioner also argues:

The combination of Wandel and Boden was described in Grounds 6–10 of the Petition. Although this combination was proposed to address another claim interpretation issue, (*see* Petition at 55), this combination disclosed all of the claimed elements, and it is in the interest of justice that the Board consider the combination for all that it disclosed. In particular, Wandel’s device operated over CDPD and was compatible with and would have used the IP addresses of Boden for its “destination addressing.”

Id. at 12 (citing Ex. 1013, 4:40, 10:20–26, Ex. 1027, 4:31–35, Ex. 1015, 444) (emphasis omitted).

However, this argument regarding Petitioner’s alternative unpatentability challenges based on Boden does not identify any argument in the Petition that we overlooked or misapprehended. Rather, Petitioner makes a new argument relying on Boden to address deficiencies we found in Petitioner’s contentions with respect to Wandel. A request for rehearing is not an opportunity to add new arguments. We could not have misapprehended or overlooked this argument because Petitioner is presenting this argument for the first time on rehearing. Furthermore, for the reasons explained above and in our Decision, we do not agree with Petitioner’s contention that “Wandel’s device operated over CDPD.” *See id.*

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