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Paper 34
Entered: March 6, 2017

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

TELIT WIRELESS SOLUTIONS INC., TELIT COMMUNICATIONS PLC, SIERRA WIRELESS AMERICA, INC., SIERRA WIRELESS, INC., and RPX CORP.,
Petitioner,

v.

M2M SOLUTIONS LLC,
Patent Owner.

Case IPR2016-00055[1]
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

[1] Case IPR2016-01073 has been joined with this proceeding.

I. INTRODUCTION

In this *inter partes* review, instituted pursuant to 35 U.S.C. § 314 and 37 C.F.R. § 42.108, Telit Wireless Solutions Inc., Telit Communications PLC, Sierra Wireless America, Inc., Sierra Wireless, Inc., and RPX Corp. (collectively, "Petitioner") challenge the patentability of claims 1–24 and 29 of U.S. Patent No. 8,648,717 B2 ("the '717 patent," Ex. 1101), 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 1–23 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 claim 24 of the '717 patent is unpatentable.

A. Procedural History

On October 21, 2015, Telit Wireless Solutions Inc. and Telit Communications PLC requested *inter partes* review of claims 1–30 of the '717 patent. Paper 1, "Pet." Patent Owner filed a Preliminary Response. Paper 8. In our Decision on Institution of *Inter Partes* Review, we instituted trial of claims 1–24 and 29, but we denied institution as to claims 25–28 and 30. Paper 9, "Dec. on Inst." Trial was instituted on the following grounds of unpatentability:

1. Whether claim 24 is unpatentable under 35 U.S.C. § 102(b) as anticipated by Van Bergen;[2]

2. Whether claims 1–3, 5–18, 22, 23, and 29 are unpatentable under 35 U.S.C. § 103(a) as having been obvious over Van Bergen and Bettstetter;[3]

3. Whether claim 4 is unpatentable under 35 U.S.C. § 103(a) as having been obvious over Van Bergen, Bettstetter, and Sonera;[4]

4. Whether claims 19 and 20 are unpatentable under 35 U.S.C. § 103(a) as having been obvious over Van Bergen, Bettstetter, and Kuusela;[5] and

5. Whether claim 21 is unpatentable under 35 U.S.C. § 103(a) as having been obvious over Van Bergen, Bettstetter, and Eldredge.[6]

Dec. on Inst. 48.

Subsequent to institution, Sierra Wireless America, Inc., Sierra Wireless, Inc., and RPX Corp. filed a petition asserting the same grounds in Case IPR2016-01073, along with a motion for joinder with this proceeding. Trial was instituted and the motion for joinder was granted. Paper 25. Patent Owner filed a Response (Paper 24, "PO Resp."), and Petitioner filed a Reply (Paper 26, "Reply").

An oral hearing was held on December 5, 2016, a transcript of which appears in the record. Paper 33 ("Tr.").

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[2] WO 00/17021, published Mar. 30, 2000 (Ex. 1113).
[3] "GSM Phase 2+ General Packet Radio Service GPRS: Architecture, Protocols, and Air Interface," IEEE COMMUNICATIONS SURVEY, vol. 2, no. 3 (1999) (Ex. 1114).
[4] WO 00/14984, published Mar. 16, 2000 (Ex. 1125).
[5] WO 97/49077, published Dec. 24, 1997 (Ex. 1128).
[6] WO 95/05609, published Feb. 23, 1995 (Ex. 1129).

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. 2; Paper 5. The '717 patent is also the subject of *Sierra Wireless Am., Inc. et al. v. M2M Solutions LLC*, Case IPR2015-01823, in which the Board is issuing a Final Written Decision concurrently.

C. Illustrative Claim

The '717 patent is generally directed to a "programmable communicator device." Ex. 1101, 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.

Ex. 1101, 12:34–13:3.

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 following terms and phrases: "programmable," "coded number," "the transmissions including the at least

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