

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 IPR2016-00055
Patent 8,648,717 B2

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

**PETITIONER'S REQUEST FOR REHEARING
UNDER 37 C.F.R. § 42.71(d)**

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I. PETITIONER'S REQUEST FOR REHEARING

Pursuant to 37 C.F.R. § 42.71(c)-(d), Telit Wireless Solutions Inc. and Telit Communications PLC (“Petitioner”) requests a partial rehearing of the Board’s Decision to institute *inter partes* review entered April 22, 2016 (“Decision”) for non-instituted claims 25, 27, 28 and 30 of U.S. Patent No. 8,648,717 (“the ‘717 Patent”). The Board found the Petition deficient for these non-instituted claims, principally because the supporting arguments incorporated discussion of instituted claims, which recited slightly different language. *See e.g.*, Decision at 20. In doing so, however, the Board (a) misapprehended the incorporated discussion in the Petition, which addressed any and all differences between the instituted and non-instituted claims, and (b) overlooked evidence in the Petition that plainly shows that these claims were anticipated by, or would have been obvious based on, the cited prior art.

II. INTRODUCTION

On October 21, 2015, Petitioner filed a Petition (Paper No. 1) (“Petition”) requesting *inter partes* review of claims 1-30 of the ‘717 Patent (Ex. 1001). On February 1, 2016, M2M Solutions LLC (“Patent Owner”) filed a Preliminary Response (Paper No. 8). On April 22, 2016, the Patent Trial and Appeals Board (“Board”) instituted *inter partes* review of claims 1-24 and 29 based on the following grounds (Paper No. 9) (Decision at 48):

Ground	Claim(s)	Reference(s)	Statute (Pre-AIA)
A	24	Van Bergen	35 U.S.C. § 102(b)
B	1-3, 5-18, 22, 23 and 29	Van Bergen and Bettstetter	35 U.S.C. § 103(a)
C	4	Van Bergen, Bettstetter and Sonera	35 U.S.C. § 103(a)
D	19, 20	Van Bergen, Bettstetter and Kuusela	35 U.S.C. § 103(a)
E	21	Van Bergen, Bettstetter and Eldredge	35 U.S.C. § 103(a)

The Board, however, denied *inter partes* review of claims 25-28 and 30. Decision at 20-22, 43. For the reasons below, this Request seeks the Board's reconsideration and reversal of its Decision concerning claims 25, 27, 28 and 30.

III. PRECISE RELIEF REQUESTED

Because the Board misapprehended or overlooked material in the Petition that shows a reasonable likelihood of prevailing with respect to each of 25, 27, 28 and 30 of the '717 Patent, its decision not to institute *inter partes* review for these claims is based on an erroneous interpretation of the facts that constitutes an abuse of discretion. Accordingly, pursuant to 37 C.F.R. § 42.71(c)-(d), Petitioner requests that the Board reconsider its decision not to institute review of claims 25, 27, 28 and 30 of the '717 Patent, and proceed to institute review of these claims.

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