

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 IPR2016-01073
Patent 8,648,717 B2

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

Opinion for the Board filed by *Administrative Patent Judge* ARBES.

Opinion Concurring filed by *Administrative Patent Judge* GALLIGAN.

ARBES, *Administrative Patent Judge*.

DECISION

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

Granting Petitioner's Motion for Joinder
37 C.F.R. § 42.122

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Petitioners Sierra Wireless America, Inc., Sierra Wireless, Inc., and RPX Corp. (collectively, “Petitioner”) filed a Petition (Paper 1, “Pet.”) requesting *inter partes* review of claims 1–24 and 29 of U.S. Patent No. 8,648,717 B2 (Ex. 1101, “the ’717 patent”) pursuant to 35 U.S.C. § 311(a) and a Motion for Joinder (Paper 2, “Mot.”) with Case IPR2016-00055 (“the -55 Case”). Patent Owner M2M Solutions LLC filed an Opposition (Paper 12, “Opp.”) to the Motion for Joinder, to which Petitioner filed a Reply (Paper 15, “Reply”). Patent Owner did not file a preliminary response pursuant to 35 U.S.C. § 313. Pursuant to 35 U.S.C. § 314(a), the Director may not authorize an *inter partes* review unless the information in the petition and preliminary response “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.” For the reasons that follow, we institute an *inter partes* review as to claims 1–24 and 29 of the ’717 patent on certain grounds of unpatentability, and grant Petitioner’s Motion for Joinder.

I. BACKGROUND

A. Related Proceedings

Petitions requesting *inter partes* review of the ’717 patent were filed previously in Cases IPR2015-01670, IPR2015-01672, IPR2016-00054, and IPR2016-00853, all of which were denied.

On August 26, 2015, Petitioner filed a petition requesting *inter partes* review of claims 1–3, 5–7, 10–24, 29, and 30 of the ’717 patent, asserting four grounds of unpatentability based on five prior art references.

IPR2015-01823, Paper 1. On March 8, 2016, we instituted an *inter partes*

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review as to claims 1, 3, 5, 6, 10–13, 15–24, and 29 on three of the asserted grounds, but denied institution as to claims 2, 7, 14, and 30.

IPR2015-01823, Paper 16.

On October 21, 2015, Telit Wireless Solutions Inc. and Telit Communications PLC (collectively, “Telit”) filed a petition requesting *inter partes* review of claims 1–30 of the ’717 patent in the -55 Case, asserting 14 grounds of unpatentability based on seven prior art references.

IPR2016-00055, Paper 1. On April 22, 2016, we instituted an *inter partes* review as to claims 1–24 and 29 on five of the asserted grounds, but denied institution as to claims 25–28 and 30. IPR2016-00055, Paper 9 (“-55 Dec. on Inst.”). Telit filed a request for rehearing, which was denied. *See* IPR2016-00055, Papers 11, 13. Petitioner filed its Petition and Motion for Joinder with the -55 Case in the instant proceeding on May 19, 2016.

Also, on May 23, 2016, Telit filed a petition requesting *inter partes* review of claims 25–28 and 30 of the ’717 patent and a motion for joinder with the -55 Case. IPR2016-01081, Papers 1, 3. In a concurrently issued decision, we deny Telit’s petition and motion for joinder.

B. Illustrative Claim

Claim 1 of the ’717 patent recites:

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. The Prior Art

Petitioner relies on the following prior art:

International Patent Application Publication No. WO 95/05609, published February 23, 1995 (Ex. 1129, “Eldredge”);

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International Patent Application Publication
No. WO 97/49077, published December 24, 1997 (Ex. 1128,
“Kuusela”);

International Patent Application Publication
No. WO 00/14984, published March 16, 2000 (Ex. 1125,
“Sonera”);

International Patent Application Publication
No. WO 00/17021, published March 30, 2000 (Ex. 1113, “Van
Bergen”); and

C. Bettstetter *et al.*, “GSM Phase 2+ General Packet
Radio Service GPRS: Architecture, Protocols, and Air
Interface,” IEEE COMMUNICATIONS SURVEYS, vol. 2, no. 3
(1999) (Ex. 1114, “Bettstetter”).¹

D. The Asserted Grounds

Although the Petition presents unpatentability challenges to claims 1–30 of the ’717 patent, Petitioner states that the Petition “is narrowly tailored to the identical grounds of unpatentability that are [the] subject of [the -55 Case]” and that Petitioner “agree[s] to be bound by the Board’s

¹ Based on the current record, Petitioner has made a threshold showing that Bettstetter is a prior art printed publication under 35 U.S.C. §§ 102(a) and (b). *See* Pet. 14; *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.’” (citation omitted)). Also, the Leahy-Smith America Invents Act, Pub. L. No. 112-29, 125 Stat. 284 (2011) (“AIA”), amended 35 U.S.C. §§ 102 and 103. Because the ’717 patent has an effective filing date before the effective date of the applicable AIA amendment, we refer to the pre-AIA versions of 35 U.S.C. §§ 102 and 103.

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