

UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE PATENT TRIAL AND APPEAL BOARD

GEOTAB INC., AND
TV MANAGEMENT, INC., D/B/A GPS NORTH AMERICA
Petitioners,

v.

PERDIEM CO., LLC.
Patent Owner

Case IPR2016-01063
U.S. Patent 8,717,166

OPPOSITION TO PATENT OWNER'S MOTION TO TERMINATE

EXHIBIT LIST¹

- Ex. 1001 U.S. Patent No. 8,717,166 (“’166 Patent”)
- Ex. 1002 The file history of the ’166 Patent
- Ex. 1003 U.S. Patent No. 7,327,258 (“Fast”)
- Ex. 1004 U.S. Provisional Patent App. No. 60/542,208 (“Fast Provisional”)
- Ex. 1005 U.S. Patent Pub. No. US 2005/0156715 (“Zou”)
- Ex. 1006 Discrete Wireless’s Marcus GPS Fleet Management Application
Product Brochure (“Marcus”)
- Ex. 1007 U.S. Patent App. No. 14/629,336, Response to Non-Final Office
Action (Feb. 11, 2016)
- Ex. 1008 Success Stories in Fleet Tracking (Sept. 1, 2005)
- Ex. 1009 U.S. Patent No. 7,949,608 (“Li”)
- Ex. 1010 Software as a Service Article (“SaaS Article”)
- Ex. 1011 Infringement Contentions in related litigation
- Ex. 1012 Declaration of Dr. Stephen Heppe
- Ex. 1013 Declaration of Vivek Ganti, Esq.
- Ex. 1014 Declaration of William Steckel**
- Ex. 1015 Declaration of Steven G. Hill**
- Ex. 1016 Declaration of Michael Femal**

¹ Newly Filed exhibits in Bold

Patent Owner moved to terminate (Paper 15, “PO Motion”), arguing that SkyBitz Inc. (“SkyBitz”) should have been identified as a real party-in-interest (RPI). Because SkyBitz has neither controlled nor funded this petition, Patent Owner is wrong. For the following reasons, the Petition has correctly identified any and all RPIs.

Factual Background

Telular Corp. (“Telular”), a named RPI, acquired SkyBitz in 2012 and wholly owns SkyBitz. (Ex. 1014, ¶3-4). As the parent of Petitioner TV Management, Inc. dba GPS North America (“GPSNA”), Telular funded and controlled the instant IPR.² (Id., ¶8). Telular approved naming GPSNA as Petitioner because it was identified as a defendant in the co-pending litigation. (Id., ¶9). Telular did not name SkyBitz as an RPI because, absent permission from Telular, SkyBitz has no ability to take any legal action, participate in any legal action, or supply any funds in relation to legal action. (Id., ¶10). In addition, SkyBitz has no financial interest in the co-pending litigation because Telular is fully responsible for all accused products, attorney’s fees and payment of any judgment in relation to the co-pending litigation. (Id., ¶12).

² This IPR was also funded and controlled by Geotab Inc., whose RPI status is not at issue.

Telular’s five-member Board of Directors unanimously approved participation in and funding of this proceeding, four of which are not affiliated with SkyBitz. (Id., ¶¶7-8).

SkyBitz has no power to act on its own in any capacity without obtaining Telular’s Board approval. (Id., ¶10). SkyBitz must first receive Telular Board approval before embarking on any involvement in engineering projects, setting sales prices, engaging in financial transactions, and/or participating in legal action. (Id.). SkyBitz also must seek Telular’s approval to spend any money. (Id.).

In 2015, Telular authorized and provided the necessary funding for SkyBitz to acquire TV Management Inc., d/b/a GPS North America (“GPSNA”). (Id., ¶3-4). Petitioners do not dispute that the shares of GPSNA were acquired by SkyBitz. (PO Motion, p.1). However, the GPSNA acquisition required Telular’s approval and its authorization to transfer funds to finance the acquisition. (Id., ¶3-4). After the acquisition, Telular took ownership of all GPSNA product lines and trademarks. (Id., ¶5).

Legal standard for RPI

“A petition filed under section 311 may be considered only if ... the petition identifies all real parties in interest[.]” 35 U.S.C. § 312(a)(2); *see also* 37 CFR 42.8. The RPI inquiry depends on the relationship between a non-party and the proceeding. *Aruze Gaming v. MGT Gaming*, IPR2014-01288, paper 13, p. 11

(PTAB 2015). The RPI status does not depend on the relationship between the parties. *Id.* For example, the fact that a non-party is a subsidiary or a spinout of a named party does not alone transform the non-party into an RPI. *Compass Bank v. Intellectual Ventures II LLC*, IPR2014-00724, paper 12, pp. 10–11 (PTAB 2014) (holding that a subsidiary is not an RPI); *Hughes Network Systems, LLC et al v. California Institute of Tech.*, IPR2015-00059, paper 42, pp. 10-11 (PTAB 2016) (holding that a spinout company is not an RPI).

A “common consideration [in determining RPI status] is whether the non-party exercised or could have exercised control over a party’s participation in a proceeding.” *Cox Communications v. AT&T Intellectual Property I, LP*, IPR2015-01227, paper 13, pp.8-9 (PTAB 2015) (internal citations omitted). The Board looks at the involvement in the filing, and the funding of the petition. *See* Trial Practice Guide, 77 Fed. Reg. at 48,760.

To demonstrate control, the Patent Owner must show persuasive evidence that the non-party engaged in strategic planning, preparation, and review of the *inter partes* review petition. *TRW Automotive US LLC v. Magna Electronics Inc.*, IPR2014-01497, paper 7, p.9 (PTAB 2015) (emphasis added). In fact, reviewing an IPR petition to address the citation format and “small nits” does not rise to the level of control over the IPR petition. *See The Mangrove Partners Master Fund, Ltd. v. Virnetx Inc.*, IPR2015-01046, paper 74, p.4 (PTAB 2016). Generalized

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