

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

TELIT WIRELESS SOLUTIONS INC. &

TELIT COMMUNICATIONS PLC,

Petitioner,

v.

M2M SOLUTIONS LLC,

Patent Owner.

Inter Partes Review No. 2016-01081

U.S. Patent No. 8,648,717

Issued: Feb. 11, 2014

Title: Programmable Communicator

**PETITION FOR *INTER PARTES* REVIEW
OF U.S. PATENT NO. 8,648,717**

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TABLE OF AUTHORITIES

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Cases

Ex parte Scortecchi, No. 2014-001781, 2016 Pat. App. LEXIS 1052 (Mar. 17, 2016) (emphasis added)11

Ex parte Vesto, No. 2013-009212, 2016 Pat. App. LEXIS 2105 (PTAB, Nov. 7, 2014)11

Ex parte Cruz-Hernandez, No. 2014-000203, 2016 Pat. App. LEXIS 1627 (PTAB, Feb. 1, 2016)11

Ex parte Takahashi, 2004-2192, 2015 Pat. App. LEXIS 9767 (BPAI, Sep. 30, 2015)11, 12

Facebook, Inc. v. Pragmatus AV, LLC, 582 Fed. Appx. 864 (Fed. Cir. 2014) (non-precedential).....10

Hitachi Koki Co. v. Doll, 620 F. Supp. 2d 4 (D. D.C., 2009).....33

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International Business Machines Corp. v. Intellectual Ventures I LLC, IPR2014-01385, Paper 64 (PTAB, Jan. 15, 2016).....10

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Soverain Software v. Newegg, Inc., 705 F.3d 1333 (Fed. Cir. 2013)26

Western Union Co. v. Moneygram Payment Sys. Inc., 626 F.3d 1361 (Fed. Cir. 2010)26

Yahoo! Inc. v. CreateAds LLC, IPR2014-00200, Paper 4210

Statutes

35 U.S.C. § 10218

35 U.S.C. § 102(a)17

35 U.S.C. § 102(a)(1)8

35 U.S.C. § 102(b)17

35 U.S.C. § 102(e)17

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