

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ENFORA, INC., NOVATEL WIRELESS SOLUTIONS, INC., and
NOVATEL WIRELESS, INC.,
Petitioner,

v.

M2M SOLUTIONS LLC,
Patent Owner.

Case IPR2015-01672
Patent 8,648,717 B2

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

GALLIGAN, *Administrative Patent Judge*.

DECISION

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

I. INTRODUCTION

Enfora, Inc., Novatel Wireless Solutions, Inc., and Novatel Wireless, Inc. (collectively, “Petitioner”) filed a Petition (“Pet.”) requesting *inter partes* review of claims 1–7, 10–14, 18, and 21–30 of U.S. Patent No. 8,648,717 B2 (“the ’717 patent,” Ex. 1001). Paper 2. M2M Solutions LLC (“Patent Owner”) timely filed a Preliminary Response. Paper 8 (“Prelim. Resp.”). We have jurisdiction under 35 U.S.C. § 314 and 37 C.F.R. § 42.4(a).

The standard for instituting an *inter partes* review is set forth in 35 U.S.C. § 314(a), which provides:

THRESHOLD—The Director may not authorize an *inter partes* review to be instituted unless the Director determines that the information presented in the petition filed under section 311 and any response filed under section 313 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.

Upon consideration of the information presented in the Petition and the Preliminary Response, we are not persuaded that Petitioner has established a reasonable likelihood that it would prevail in its challenges to claims 1–7, 10–14, 18, and 21–30 of the ’717 patent. Accordingly, we decline to institute an *inter partes* review of those claims.

A. *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. 1–2; Paper 5. Petitioner concurrently filed another Petition for *inter partes* review challenging claims 1–7, 10–20, and 23–30. Pet. 2; IPR2015-

01670. Three additional Petitions for *inter partes* review have been filed by other petitioners challenging various claims of the '717 patent. See IPR2015-01823; IPR2016-00054; IPR2016-00055.

B. The '717 Patent (Ex. 1001)

The '717 patent is generally directed to a programmable communicator device. Ex. 1001, 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.

C. Prior Art Relied Upon

Petitioner relies upon the following prior art references:

Ardalan et al. (hereinafter “Ardalan”)	US 6,900,737 B1	May 31, 2005 (filed Feb. 12, 1998)	Ex. 1027
Eldredge	WO 95/05609	Feb. 23, 1995	Ex. 1028
Whitley	WO 99/49680	Sept. 30, 1999	Ex. 1026
Van Bergen	WO 00/17021	Mar. 30, 2000	Ex. 1029
Specification of the Bluetooth System, v1.0B (1999) (hereinafter “Bluetooth Specification”)			Ex. 1033

D. Asserted Grounds of Unpatentability

Petitioner challenges claims 1–7, 10–14, 18, and 21–30 of the ’717 patent based on the asserted grounds of unpatentability set forth in the table below.

References	Basis	Claim(s) Challenged
Whitley and Ardalan	§ 103(a)	1–7, 10–14, 18, 22, and 24–30
Whitley, Ardalan, and Eldredge	§ 103(a)	21
Whitley, Ardalan, and Van Bergen	§ 103(a)	23
Whitley, Ardalan, and Bluetooth Specification ¹	§ 103(a)	4

¹ Petitioner proposes this as an alternative ground. Pet. 42.

II. CLAIM CONSTRUCTION

Petitioner and Patent Owner propose constructions for various terms of the '717 patent. Pet. 10–16; Prelim. Resp. 2–6; Papers 10, 12. Based on Petitioner’s unpatentability challenges, we determine that these terms, as well as all remaining terms, need not be construed explicitly at this time.

III. ANALYSIS

Petitioner contends that a combination of Whitley and Ardalan renders obvious the subject matter of independent claims 1, 24, and 29. Pet. 4, 26–40, 49–51, 53–55.

A. “*Processing Module for Authenticating*”

All of the asserted grounds of unpatentability in this Petition rely on Whitley alone or in combination with Ardalan as allegedly teaching or suggesting the following limitation of independent claims 1, 24, and 29: “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.” See Pet. 30–33, 49–50, 54.

First, Petitioner argues that “Whitley inherently discloses a check to determine if the wireless transmission contains a ‘coded number.’” Pet. 30. Petitioner argues:

Specifically, Whitley discloses that each gateway is “***uniquely addressable*** through, for instance, a phone number, IP address, or similar identifier” so that the customer can send “messages or commands that will be routed directly ... to the gateway.” Ex. 1026 at 6:8-14; see also Ex. 1026 at 3:13-14; 9:6-8; and 12:9-11. Ex. 1004 at ¶ 135. Inherently, messages sent to gateway 20 in SMS or GPRS will only be processed by gateway 20 and applied

to it if the particular message includes gateway 20's unique identifier – here the phone number, IP address, or other identifier. Ex. 1004 at ¶ 135. Messages that are received by gateway 20 that do not include the unique identifier will not be processed by gateway 20. Ex. 1004 at ¶ 135. The gateway's inherent confirmation of the identifier and subsequent acceptance of the message satisfies this claim element. Ex. 1004 at ¶ 135.

Pet. 30–31.

The Federal Circuit has stated:

[t]o establish inherency, the extrinsic evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.

In re Robertson, 169 F.3d 743, 745 (Fed. Cir. 1999) (citations and internal quotation marks omitted).

In support of its inherency argument, Petitioner cites paragraph 135 of the Declaration of Randall A. Snyder (“Snyder Declaration”) (Ex. 1004). *See* Pet. 30–31. Paragraph 135 of the Snyder Declaration states: “I have prepared the following claim chart showing how each and every element of Claim 1 reads on the disclosure of Whitley and Ardalan.” Ex. 1004 ¶ 135. Paragraph 135 then includes a claim chart for claim 1 that appears to be largely identical to the argument in the Petition. *Id.* With respect to this inherency argument, the Snyder Declaration and Petitioner's arguments appear to be identical. Paragraph 135 of the Snyder Declaration does not cite any underlying evidence supporting the assertion that the gateway in Whitley necessarily would check a transmission to determine “if the particular message includes gateway 20's unique identifier” and only would

process those messages having the unique identifier. Ex. 1004 ¶ 135; Pet. 31; *see also* 37 C.F.R. 42.65(a) (“Expert testimony that does not disclose the underlying facts or data on which the opinion is based is entitled to little or no weight.”). Nor does paragraph 135 of the Snyder Declaration provide further analysis supporting the assertion of inherency.

We further note that Whitley’s disclosure of programming multiple gateways simultaneously using a broadcasting function suggests that messages may not include the gateway’s unique identifier in all instances. Specifically, Whitley states:

SMS messages may be configured for delivery to a particular identified terminal, such as handset 32, or they may be broadcast throughout a specific geographical area by using the SMS cell broadcast feature. This broadcasting function, described in the GSM 03.41 and GSM 04.11 that are incorporated herein by this reference, is useful for reprogramming multiple gateways 20 simultaneously or warning customers at various facilities 12 of particular events in their geographic area (e.g., a weather warning or the like).

Ex. 1026, 11:29–12:6. This passage teaches that the “SMS cell broadcast feature” is used to send messages to a specific geographic area, rather than to a particular terminal, suggesting that the terminal’s unique identifier does not need to be included in the message for the message to be processed by the gateway. Therefore, this evidence undermines Petitioner’s conclusory assertion of inherency.

As such, Petitioner has not proffered sufficient evidence to persuade us that the gateway in Whitley necessarily performs a check to see if the unique identifier of the gateway is included in the transmission.

Petitioner further contends that Ardalan teaches using 32-bit identifiers for message originators and recipients and that messages sent to a

meter in Ardalan will only be processed if the message includes the meter's 32-bit identifier. Pet. 31–32 (citing Ex. 1027, 4:28–53, 7:6–12; Ex. 1004 ¶ 135). Petitioner then contends:

One of skill would have been motivated to modify Whitley to include the 32-bit identifier of Ardalan in its SMS message to provide improved identification and authentication of incoming messages, improved organization of associations between devices and telephone numbers on its server side (*see, e.g.*, such teaching at col. 5:6-17 of Ex. 1027), and for at least the reasons described in Section VII(E). Ex. 1004 at ¶ 135.

Pet. 32. Patent Owner argues Petitioner has not explained adequately why a person of ordinary skill in the art would make this proposed modification of Whitley and Ardalan. Prelim. Resp. 25. We agree.

The Supreme Court, quoting *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006), has stated that obviousness conclusions “cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 418 (2007). Based on the record before us, we are persuaded Petitioner has not provided an adequate rationale for why a person of ordinary skill in the art would have modified Whitley with Ardalan’s teachings of using a 32-bit identifier.

Petitioner cites the following disclosure from Ardalan to support its proposed modification:

The AMR server 23 and database 25 work with meter IDs. The AMR server sends and receives packets that refer to meters using the 32-bit IDs. The communications gateway 24 is responsible for remembering which phone number is used to reach a given meter. The association between each meter ID and phone number is stored in a meter/phone database 26 accessible by the communications gateway. The gateway 24 passes the phone number for a given meter ID to the SMS along with the packet

from the AMR server 23 encapsulated as a SMS packet. For example, the AMR server and communications gateway would cooperate as follows to initiate the reading of a meter.

Ex. 1027, 5:6–17. This passage teaches that, in Ardalan, it is necessary to associate phone numbers with 32-bit device identifiers because “[t]he AMR server 23 and database 25 work with meter IDs.” *Id.* at 5:6. However, as highlighted by Petitioner’s arguments with respect to Whitley, the unique identifier in Whitley is the gateway’s phone number, IP address, or other identifier by which the device is “uniquely addressable.” *See* Pet. 30–31 (citing Ex. 1026, 6:8–14, 3:13–14; 9:6–8, 12:9–11). Petitioner has not explained adequately why adding another unique identifier to the system of Whitley, which already teaches that each gateway has a unique identifier, would improve “identification and authentication of incoming messages” and “organization of associations between devices and telephone numbers on its server side,” as argued by Petitioner. *See* Pet. 32; Prelim. Resp. 25.

Petitioner cites paragraph 135 of the Snyder Declaration in support of its argument. *See id.* However, the Snyder Declaration provides no additional persuasive explanation supporting Petitioner’s argument. Rather, on this point, the Snyder Declaration and Petitioner’s arguments appear to be identical.

Petitioner also cites Section VII(E) of the Petition, entitled “Reasons to Combine the References,” in support of its proposed modification of Whitley with the 32-bit identifiers of Ardalan. Pet. 32. This section offers general reasons for combining the asserted prior art references, such as: a person of ordinary skill in the art would “consult each reference and combine the teachings to provide the most efficient and capable monitoring system with the most efficient and capable programming provisions” (*id.* at

24–25); “[i]t would have been a simple matter” to combine the teachings “to provide additional functionality and improved performance” (*id.* at 25); and “[o]ne of skill would have been motivated to utilize the techniques in any of these references to improve the system in each, particularly because the improvements yield predictable results – *e.g.*, the added functionality of Ardalan, Eldredge, and Van Bergen as compared to Whitley” (*id.*).

However, these general statements do not address why a person of ordinary skill in the art would have had a reason to include the additional unique identifier disclosed in Ardalan into the system of Whitley, which already teaches a unique identifier for each gateway. The Snyder Declaration’s section entitled “Reasons to Combine the References” appears to be identical to Section VII(E) of the Petition and provides no further elaboration or explanation supporting Petitioner’s contentions. *See* Ex. 1004 ¶¶ 127–33.

Based on the record before us, we are not persuaded that Whitley inherently teaches or suggests “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,” or that Petitioner has explained sufficiently why a person of ordinary skill in the art would modify the system of Whitley to include the 32-bit identifier of Ardalan and thereby meet the “processing module” limitation. Because all challenges in this Petition depend on Whitley alone or in combination with Ardalan as teaching or suggesting this limitation, we are not persuaded Petitioner has established a reasonable likelihood of prevailing in showing that the challenged claims would have been obvious as alleged.

IV. CONCLUSION

For the foregoing reasons, we are not persuaded that the Petition establishes a reasonable likelihood that Petitioner would prevail in showing claims 1–7, 10–14, 18, and 21–30 of the '717 patent are unpatentable under 35 U.S.C. § 103(a).

V. ORDER

In consideration of the foregoing, it is hereby:

ORDERED that the Petition is *denied*, and no trial is instituted.

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