

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 IPR2016-00054
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

Telit Wireless Solutions Inc. and Telit Communications PLC (collectively, “Petitioner”) filed a Petition (“Pet.”) requesting *inter partes* review of claims 1–30 of U.S. Patent No. 8,648,717 B2 (“the ’717 patent,” Ex. 1001), which are all of the claims of the ’717 patent. Paper 1. 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 1–30 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 1–30 of the '717 patent. Pet. 3; IPR2016-00055.

B. Illustrative Claim

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:

Wandel	US 6,034,623	Mar. 7, 2000	Ex. 1013
McGarry et al. (hereinafter “McGarry”)	US 6,038,491	Mar. 14, 2000	Ex. 1025
Boden et al. (hereinafter “Boden”)	US 6,182,228 B1	Jan. 30, 2001 (filed Aug. 17, 1998)	Ex. 1027
Fernandez et al. (hereinafter “Fernandez”)	US 6,697,103 B1	Feb. 24, 2004 (filed Mar. 19, 1998)	Ex. 1023
Whitley	WO 99/49680	Sept. 30, 1999	Ex. 1026
Sonera	WO 00/14984	Mar. 16, 2000	Ex. 1019

D. Asserted Grounds of Unpatentability

Petitioner challenges claims 1–30 of the ’717 patent based on the asserted grounds of unpatentability set forth in the table below.

Reference(s)	Basis	Claim(s) Challenged
Wandel	§ 102(b)	1–3, 5–15, 18, and 23–28
Wandel and Sonera	§ 103(a)	4
Wandel and Fernandez	§ 103(a)	16, 17, 19, 20, and 22
Wandel and McGarry	§ 103(a)	21
Wandel and Whitley	§ 103(a)	29 and 30
Wandel and Boden ¹	§ 103(a)	1–3, 5–15, 18, and 23–28
Wandel, Boden, and Sonera	§ 103(a)	4
Wandel, Boden, and Fernandez	§ 103(a)	16, 17, 19, 20, and 22

¹ Petitioner proposes the challenges based on Boden as alternative grounds to address the possibility of a narrower claim construction. Pet. 4–5, 55–58.

Wandel, Boden, and McGarry	§ 103(a)	21
Wandel, Boden, and Whitley	§ 103(a)	29 and 30

II. CLAIM CONSTRUCTION

Petitioner and Patent Owner propose constructions for two terms of the '717 patent. Pet. 8–11; Prelim. Resp. 2–5. 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 Wandel anticipates independent claims 1 and 24 and that the combination of Wandel and Whitley renders obvious claim 29. Pet. 12–25, 35–36, 51–54. Petitioner further contends that the combination of Wandel and Boden renders obvious claims 1 and 24, and the combination of Wandel, Boden, and Whitley renders obvious claim 29. Pet. 55–58. All of the asserted grounds of unpatentability in this Petition rely on Wandel as allegedly disclosing storing an IP address, as recited in independent claims 1, 24, and 29. *See id.* at 21–22, 36, 51–53, 55–58.

A. Wandel

Wandel discloses a radio modem for a Mobitex network having “a stored autonomous radio telemetry (ART) program that converts the otherwise general purpose radio modem into a special purpose radio telemetry device.” Ex. 1013, 4:29–37, 5:44–47. Wandel discloses that “the ART program reconfigures the serial port of the radio modem from a standard Mobitex MASC [(Mobitex Asynchronous Protocol)] protocol to a general purpose input/output system that supports TTL logic, simple switches, and an I²C bus.” *Id.* at 5:52–56.

B. “Store at least one telephone number or IP address”

Claims 1, 24, and 29 recite (emphasis added):

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.

Petitioner argues that Wandel discloses IP addresses as part of an alleged “IP-based CDPD [cellular digital packet data] network.” Pet. 21–22.

First, Petitioner argues:

The ART radio modem receives ART command packets that programs the “*destination addressing* for log packets.” Ex. 1013 10:20-26. Wandel disclosed a CDPD network, *Id.* 4:40, which is an Internet Protocol (IP) network, Ex. 1015, 444:2-3. The addresses of devices in an IP network are referred to as “IP addresses,” Ex. 1001, 9:32-34, so a “destination address[]” in Wandel’s CDPD network is an IP address. Ex. 1005 ¶106.

Id. at 21 (brackets in original). Petitioner then argues that

the destination IP address must have been stored in memory in order to address each log packet to its destination. *Id.* 4:59-63; Ex. 1005 ¶108, citing Ex. 1018, 11, Fig. 4, showing that the headers of all IP packets include the “Destination Address” in Wandel’s IP-based CDPD network. Ex. 1013 4:40; Ex. 1015 444:2-3.

Id. at 22.

Petitioner has not directed us to any express disclosure in Wandel of storing an IP address in the disclosed radio modem. In support of its argument, Petitioner cites the following passage from Wandel:

The ART Configuration Command packet contains configuration data for all of ART except the auxiliary state machine. This packet includes configuration data for the three intrinsic state machines 204–208, the I²C I/O subsystem 200, 210, 212, as well as global ART parameters such as state machine iteration rate, *destination addressing for log packets*, automatic packet triggering, log flags, etc.

Ex. 1013, 10:20–26 (emphasis added). Although this passage discloses “destination addressing for log packets,” Wandel’s disclosure is directed to a radio modem deployed in a Mobitex network, as Patent Owner correctly notes. Prelim. Resp. 21 (citing Ex. 1013, 4:29–37).

Petitioner does not assert that addresses in the Mobitex network are IP addresses. Rather, Petitioner asserts Wandel discloses “a CDPD network, [Ex. 1013,] 4:40, which is an Internet Protocol (IP) network, Ex. 1015, 444:2-3.” Pet. 21. Therefore, according to Petitioner, “a ‘destination address[]’ in Wandel’s CDPD network is an IP address.” *Id.* at 21 (citing Ex. 1005 ¶ 106). Petitioner also refers to “Wandel’s IP-based CDPD network” (*id.* at 22) and argues that “Wandel’s radio modem communicated over the CDPD network” (*id.* at 23 (citing Ex. 1013, 4:40)).

Petitioner has not proffered sufficient evidence to persuade us that Wandel’s CDPD network is an “IP-based CDPD network” or that Wandel teaches storing an IP address in the context of such a network.

As an initial matter, we agree with Petitioner that Wandel mentions CDPD (cellular digital packet data), albeit only in a list of networks. See Ex. 1013, 4:38–40 (“There are many types of radio networks currently in widespread

use, such as Ardis, Mobitex, GSM, SMR, PCS, analog cellular, CDPD, etc. . . .”).

Petitioner’s arguments that the CDPD network mentioned in Wandel is an “IP-based CDPD network” and uses IP addresses, however, are not sufficiently supported by the evidence of record. See Pet. 21–22. First, as mentioned above, CDPD is mentioned once within Wandel, but Wandel does not identify it as an IP-based CDPD network. In support of its assertion that CDPD is an IP network, Petitioner cites two lines from a book entitled *Broadband Networking*. See Pet. 21 (citing Ex. 1015, 444:2–3). Although the cited lines state that “CDPD supports the Internet protocol (IP)” (Ex. 1015, 444:2–3), Patent Owner correctly notes that the same reference states that CDPD supports other protocols. Prelim. Resp. 22 (citing Ex. 1015, 443–44). The larger passage from *Broadband Networking*, in which the two lines cited by Petitioner appear, provides additional context, and reads as follows:

Protocol Support. CDPD can be used in conjunction with most existing connectionless networking protocols and supports several of the leading open networking architectures. Specifically, CDPD supports the connectionless network services (CLNS) protocol, which routes each packet individually according to its destination.

The CLNS protocol is a centerpiece of the Open Systems Interconnection (OSI) architecture. The design of many CDPD systems uses another OSI protocol, the X.400 messaging standard, to pass data to the accounting and billing applications. In addition, CDPD supports the Internet protocol (IP), which in turn supports many Internet-related applications and protocols, such as the World Wide Web, the simple mail transfer protocol, and the file transfer protocol.

Ex. 1015, 443–44 (emphasis removed). Although this reference states that CDPD supports the Internet protocol, it makes clear that CDPD supports other protocols as well.

Petitioner also cites the Declaration of Kimmo Savolainen (“Savolainen Declaration”) (Ex. 1005) in support of its argument that Wandel discloses a radio modem that operates in an IP-based CDPD network and stores IP addresses. *See* Pet. 21–23 (citing Ex. 1005 ¶¶ 106, 108, 110, 111). The cited portions of the Savolainen Declaration are largely identical to corresponding passages in the Petition. *Compare* Pet. 21–23, *with* Ex. 1005 ¶¶ 106–11. Similar to the Petition, the Savolainen Declaration asserts that “Wandel’s radio modem communicated over the CDPD network” (Ex. 1005 ¶ 110 (citing Ex. 1013, 4:40), even though, as explained above, Wandel explicitly states that the disclosed radio modem operates on the Mobitex network. *See* Ex. 1013, 4:29–37. The Savolainen Declaration also asserts that the CDPD network mentioned in Wandel “is an Internet Protocol (IP) network.” Ex. 1005 ¶ 106 (citing Ex. 1013, 4:40; Ex. 1015, 444:2–3). However, the underlying evidence, discussed above, establishes that CDPD supports several protocols, including the Internet protocol. *See* Ex. 1015, 443–44. The Savolainen Declaration does not sufficiently explain why a person of ordinary skill in the art would recognize that the CDPD network mentioned in Wandel is an IP-based network.

The Savolainen Declaration asserts that a destination IP address would have been included in the headers of IP packets. Ex. 1005 ¶ 108 (citing Ex. 1018). With respect to storing IP addresses, the Savolainen Declaration cites Wandel’s disclosures regarding destination addresses in Mobitex network packets. Ex. 1005 ¶ 108 (citing Ex. 1013, 4:59–63, 9:60–

64, 10:20–26). Referring to Wandel column, 4, lines 59–63, the Savolainen Declaration then states: “While this section refers to Mobitex packets (MPAKs), the same is true for all IP-based networks including Wandel’s CDPD network ([Ex. 1013,] 4:40, Ex. 1015, 444:2–3). That is, the destination address would have been included in the headers of all IP packets in Wandel’s CDPD network.” Ex. 1005 ¶ 108 (citing Ex. 1018, 11, Fig. 4). Although the evidence supports the proposition that, in an IP-based network, IP addresses would have been used, this evidence is insufficient to demonstrate that a person of ordinary skill in the art would view Wandel as disclosing a radio modem operating in an IP-based CDPD network, especially in view of Wandel’s express disclosure that the described radio modem is operable in a Mobitex network. Ex. 1013, 4:29–37.

To anticipate, “[t]here must be no difference between the claimed invention and the reference disclosure, as viewed by a person of ordinary skill in the field of the invention.” *Scripps Clinic & Res. Found. v. Genentech, Inc.*, 927 F.2d 1565, 1576 (Fed. Cir. 1991), *overruled on other grounds by Abbott Labs. v. Sandoz, Inc.*, 566 F.3d 1282 (Fed. Cir. 2009). Petitioner has not proffered sufficient evidence to persuade us that Wandel, as viewed by a person of ordinary skill in the art, discloses an “IP-based CDPD network” or that “Wandel’s radio modem communicated over the CDPD network,” such that the “destination address[es] for log packets” disclosed in Wandel would have been IP addresses. Pet. 22–23.

To the extent Petitioner alleges that Wandel inherently discloses IP addresses because it mentions CDPD, we are not persuaded. 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). As Patent Owner correctly notes, the evidence of record makes clear that CDPD networks support several protocols, only one of which is the Internet protocol. Prelim. Resp. 22–23 (citing Ex. 1014, 10:1–8²; Ex. 1015, 443–44). Therefore, a device operating in a CDPD network may or may not have employed IP addresses.

Because the evidence of record shows that CDPD supports the Internet protocol and other protocols, we are not persuaded that the disclosure of CDPD necessarily implicates the use of IP addresses. Therefore, we are not persuaded that Wandel’s mention of CDPD inherently discloses the use of IP addresses.

“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987). Based on the record before us, we are not persuaded Petitioner has demonstrated Wandel discloses, either expressly or inherently, storing an IP address, as required by the independent claims.

Finally, to the extent Petitioner is arguing that a person of ordinary skill in the art would have understood Wandel to teach storing IP addresses

² Patent Owner mistakenly cites the right column for this disclosure.

in the context of a CDPD network, we are not persuaded. Wandel discloses Mobitex and CDPD as example networks that may be used:

The present invention is applicable to any kind of radio modem and any type of radio frequency data network, however for the purpose of setting forth a preferred embodiment of the invention, the remaining drawings and detailed description will refer to a specific radio network, the Mobitex network, and a particular radio modem, the RIM 900 Mobitex radio modem, manufactured by Research In Motion, 295 Phillip Street, Waterloo, Ontario, Canada.

There are many types of radio networks currently in widespread use, such as Ardis, *Mobitex*, GSM, SMR, PCS, analog cellular, *CDPD*, etc, and each of these networks has associated types of radio modems that are used to transmit and receive data over the network. For example, for the Mobitex network, Ericsson, Motorola and Research In Motion manufacture radio modems. Any of these devices could be used in conjunction with the present invention.

Ex. 1013, 4:29–45 (emphasis added). However, the entirety of Wandel’s disclosure, including the one-sentence disclosure of “destination addressing” relied upon by Petitioner, describes how a particular radio modem would work in a Mobitex network. *See id.* at 4:46–13:23; Pet. 21–22. There is no other mention of CDPD, or explanation of how the disclosed invention would work in a CDPD network, in Wandel. What is missing in Petitioner’s analysis is a sufficient explanation for why, if the disclosed invention used a CDPD network (rather than a Mobitex network as in the preferred embodiment), the “destination addressing” referred to in column 10 would be understood by a person of ordinary skill in the art to be IP addressing. Without more, we are not persuaded that the mere disclosure of CDPD, among a list of numerous other potential networks, is sufficient proof that an

ordinarily skilled artisan would have read “destination addressing” to be IP addressing when a CDPD network is used.

Petitioner proposes alternative unpatentability challenges based additionally on certain alleged teachings of Boden in the event we construe the phrase “numbers to which the programmable communicator device is configured to and permitted to send outgoing wireless transmissions,” which appears in each independent claim, to mean an “exclusive” set of numbers such that transmissions to all other numbers are not permitted and are blocked. Pet. 55. Petitioner contends “[i]t would have been obvious to a person of ordinary skill in the art to make Wandel’s ‘destination address[es] for log packets’ . . . an *exclusive* set of permitted addresses by filtering packets to all other addresses as disclosed in Boden.” *Id.* at 57.

Because these alternative unpatentability challenges rely on Wandel as allegedly disclosing storing IP addresses (*see* Pet. 55), a contention with which we disagree, Petitioner’s alternative challenges are not persuasive, and we need not address the construction of the phrase “numbers to which the programmable communicator device is configured to and permitted to send outgoing wireless transmissions.”

Because all challenges in this Petition depend on Wandel as allegedly disclosing storing an IP address, we are not persuaded Petitioner has established a reasonable likelihood of prevailing in showing that the challenged claims are anticipated or 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

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claims 1–30 of the '717 patent are unpatentable under 35 U.S.C. §§ 102(b) or 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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For PETITIONER:

cpollack@pearlcohen.com
meadan@ pearlcohen.com
gyonay@ pearlcohen.com

Pearl Cohen Zedek Latzer Baratz LLP

For PATENT OWNER:

Jeffrey N. Costakos
jcostakos@foley.com

Michelle A. Moran
mmoran@foley.com

Foley & Lardner LLP