

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

T-MOBILE US, INC., T-MOBILE USA, INC., TELECOMMUNICATION
SYSTEMS, INC., ERICSSON INC., AND
TELEFONAKTIEBOLAGET LM ERICSSON,
Petitioner,

v.

TRACBEAM, LLC,
Patent Owner.

Case IPR2016-00729
Patent 7,298,327 B2

Before KEVIN F. TURNER, DAVID C. McKONE, and
BARBARA A. PARVIS, *Administrative Patent Judges*.

PARVIS, *Administrative Patent Judge*.

DECISION

Denying Motion for Joinder and
Denying Institution of *Inter Partes* Review
37 C.F.R. § 42.122(b) and 37 C.F.R. § 42.108

I. INTRODUCTION

A. Background

Petitioner, T-Mobile US, Inc., T-Mobile USA, Inc., TeleCommunication Systems, Inc., Ericsson Inc., and Telefonaktiebolaget LM Ericsson, filed a Petition (Paper 1, “Pet.”) requesting that we institute an *inter partes* review of claims 1, 2, and 44 of U.S. Patent No. 7,298,327 B2 (Ex. 1004, “the ’327 Patent”). Petitioner also filed a motion for joinder (Paper 3, “Motion”) seeking to join this case with the instituted proceeding *T-Mobile US, Inc. v. TracBeam, LLC*, Case IPR2015-01712 (“IPR2015-01712”).

Patent Owner, TracBeam, LLC, filed an Opposition to the Motion for Joinder (Paper 8, “Opp.”) and a Preliminary Response (Paper 9, “Prelim. Resp.”). Petitioner filed a Reply in support of its Motion for Joinder (Paper 10).

In the Petition, Petitioner asserts the following ground of unpatentability (Pet. 12):

References	Basis	Claims challenged
Loomis ¹ and Wortham ²	§ 103(a)	1, 2, and 44

Petitioner previously sought institution of an *inter partes* review of claims 1, 2, and 44 of the ’327 Patent. See IPR2015-01712, Paper 1 (“1712-Pet.”).³ We instituted trial in IPR2015-01712 on claim 60 of the ’327 Patent, but further determined that the information presented by Petitioner

¹ U.S. Patent No. 5,936,572, issued Aug. 10, 1999 (Ex. 1008) (“Loomis”).

² U.S. Patent No. 6,748,226 B1, issued June 8, 2004 (Ex. 1009) (“Wortham”).

³ We refer to Papers and Exhibits in IPR2015-01712 using the prefix “1712-” throughout this Decision.

failed to demonstrate a reasonable likelihood that Petitioner would prevail in showing the unpatentability of claims 1, 2, and 44 of the '327 Patent. See IPR2015-01712, Paper 10 (“the 1712-Decision”). Petitioner did not request rehearing in IPR2015-01712 of our decision to deny institution of trial for claims 1, 2, and 44 of the '327 Patent.

Petitioner subsequently filed the instant Petition challenging the patentability of the same claims that were denied review in IPR2015-01712. For the reasons that follow, we exercise our discretion under 35 U.S.C. § 325(d) to deny the asserted challenges to claims 1, 2, and 44. Pursuant to 35 U.S.C. § 315(c), we also deny Petitioner’s request to join IPR2016-00729 with IPR2015-01712.

B. Additional Related Proceedings

Petitioner and Patent Owner also identify, as related proceedings, a lawsuit in which the '327 Patent is asserted against T-Mobile US, Inc., pending in the United States District Court for the Eastern District of Texas captioned *TracBeam, LLC v. T-Mobile US, Inc.*, Case Number 6:14-cv-678. Pet. 9; Paper 6, 1. Petitioner and Patent Owner identify additional proceedings involving Patent Owner’s patents. Pet. 9–10; Paper 6, 1–5.

C. The '327 Patent

The '327 Patent relates to a system and method for locating people or objects using mobile station location estimators. Ex. 1004, 1:18–22. Figure 4 is illustrated below.

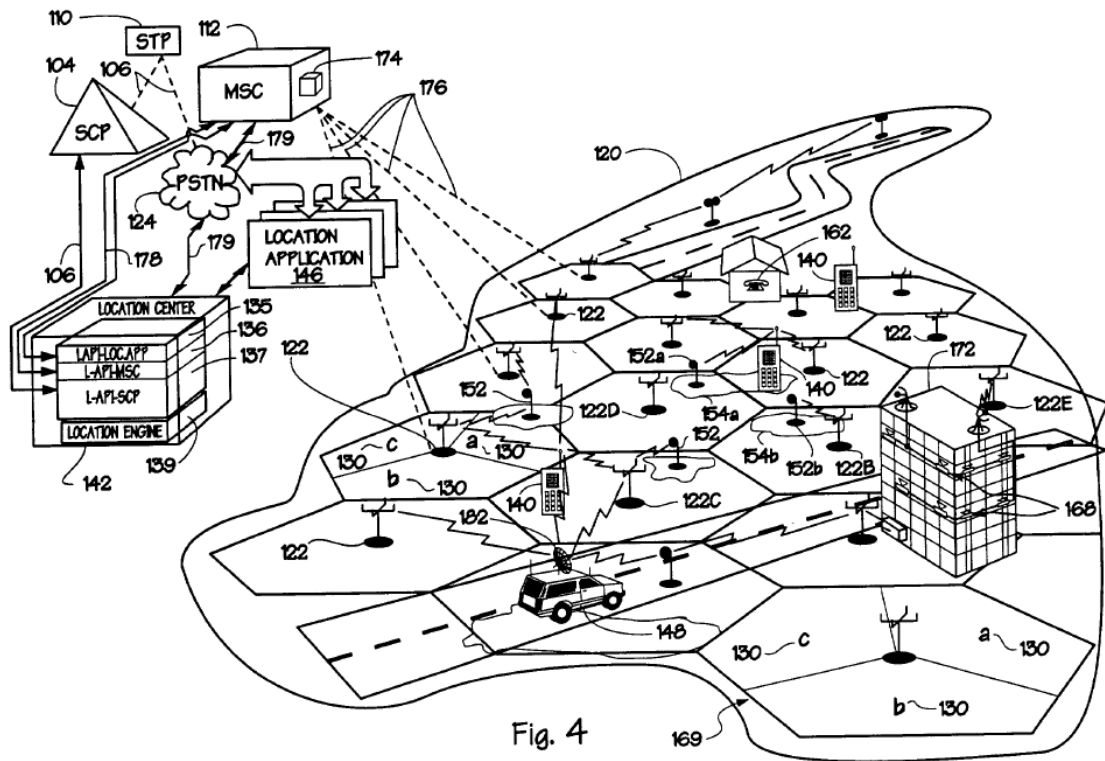


Figure 4 illustrates a view of a wireless radio location network architecture.

As shown in Figure 4, the wireless radio location network comprises wireless mobile stations (MSs) 140, mobile switching center (MSC) 112, infrastructure base stations 122A–122D in radio coverage area 120, and a public switched telephone network (PSTN) 124. *Id.* at 26:1–38. The wireless radio location network further comprises additional components including location center 142 for determining a location of a target MS, mobile base stations 148 for tracking the target MS, and location base stations 152. *Id.* at 26:39–50.

D. Illustrative Claim

Of the challenged claims, claim 1 is independent. The other challenged claims depend, directly or indirectly, from claim 1. Claim 1 is illustrative and is reproduced below with emphasis on an element that is the

focus of Petitioner's contentions as to why the instant Petition remedies deficiencies in the previous 1712-Petition.

1. A method for locating communication devices in communication with a communications network having a plurality of geographically dispersed network communication components operably connected together for communicating with the communication devices, comprising:

performing the steps (1) and (2) following for locating each communication device (CD) of various ones of the communication devices, wherein each one of a plurality of location determiners is used for determining corresponding geographic location information for locating each communication device of various ones of the communication devices, and wherein at least a first and a second of the location determiners utilize a different geographic location process from the other, such that (A1) and (A2) following hold:

(A1) for at least one actual geographic location (L) of at least one of the communication devices, a difference between the first location determiner and the second location determiner includes one or more processing steps that result in a geographical location or extent such that (A1-1) and (A1-2) following hold:

(A1-1) an identification of a potential geographic location of L, output by the first location determiner, is substantially dependent upon an instance of the geographical location or extent resulting from performing the one or more processing steps, and an identification of a potential geographic location of L, output by the second location determiner, is not substantially dependent upon an instance of the geographical location or

- extent resulting from performing the one or more processing steps, and
- (A1 -2)) the one or more processing steps are used by the first location determiner for locating communication devices in a plurality of geographically spaced apart locations; and
- (A2) *for at least one actual geographical location of at least one of the communication devices, each of (A2-1) and (A2-2) following does not substantially affect a determination of the other of (A2-1) and (A2-2):*
- (A2-1) *a first identification of a potential first geographic location or geographic extent output by the first location determiner, and*
- (A2-2) *a second identification of a potential second geographic location or geographic extent output by the second location determiner;*
- (1) obtaining, from each of one or more of the location determiners, corresponding output geographic location information for locating CD when the one or more location determiners are each provided with a corresponding input of geolocation indicative data from transmissions between the communication device CD and at least one of the network communication components, wherein the corresponding output geographic location information for at least one of the location determiners includes one or more geographic identifications, each geographic identification representing at least one of: a potential geographic location and a potential geographic extent for an actual location of CD;

(2) providing resulting geographic location information of the communication device CD, wherein said resulting location information is obtained by accessing, for each of the one or more of the location determiners, its corresponding output geographic location information;

wherein for at least one instance of locating the communications device CD, a corresponding performance of said steps of obtaining and providing includes performing at least two of (B1) through (B4) following:

(B1) for at least two of the geographic identifications (GI_1 and GI_2) for CD, obtained, in said obtaining step, from different ones of the location determiners, a step of at least one of: (a) combining, or (b) resolving a difference between; (i) GI_1 (or location data derived therefrom) and (ii) GI_2 (or location data derived therefrom) so that said resulting geographic location information is dependent on each of GI_1 and GI_2 ;

(B2) for each of at least two of the geographic identifications (GI_3 and GI_4) for CD, obtained from different corresponding ones of the location determiners, a step of obtaining a corresponding rating value for each of GI_3 (or location data derived therefrom), and GI_4 (or location data derived therefrom), wherein said rating values are indicative of relative expected performances of the different corresponding location determiners in locating the communication devices, and wherein each corresponding rating value is determined after its corresponding geographic identification is identified by its location determiner;

(B3) for each of at least two of the geographic identifications (GI_5 and GI_6) for CD,

obtained from different corresponding ones of the location determiners, a step of selecting one of: GI₅ (or location data derived therefrom), and GI₆ (or location data derived therefrom), for receiving a preference in determining said resulting geographic location information; and
(B4) obtaining information indicative of a reliability of at least one geographic identification (GI₇) of CD from one of the one or more location determiners, wherein the reliability represents a likelihood that CD is within the potential geographic location or the potential geographic extent identified by GI₇, and wherein the reliability is determined after the at least one geographic identification is obtained from its location determiner.

Ex. 1004, 259:2–260:44.

II. ANALYSIS

A. *The Instant Petition*

In determining whether to institute *inter partes* review, we may “deny some or all grounds for unpatentability for some or all of the challenged claims.” 37 C.F.R. § 42.108(b). Our discretionary determination of whether to institute review is guided by 35 U.S.C. § 325(d), which states, in relevant part, that “[i]n determining whether to institute or order a proceeding under this chapter, chapter 30, or chapter 31, the Director may take into account whether, and reject the petition or request because, the same or substantially the same prior art or arguments previously were presented to the Office.”⁴ Petitioner’s second attempt to challenge claims 1, 2, and 44 of the ’327

⁴ Chapter 31 of the Patent Act covers *inter partes* review proceedings.

Patent relies on the same prior art references that Petitioner asserted in the 1712-Petition. *Compare* Pet. 12 with 1712-Pet. 4.

Regarding whether Petitioner's second attempt also presents substantially the same arguments, Petitioner again bases its challenge on solely the ground that claims 1, 2, and 44 are obvious over Loomis and Wortham. *Compare* Pet. 12 with 1712-Pet. 4. Additionally, Petitioner again argues that location techniques providing independent position results were known and again points to Loomis's teaching of using satellites to estimate location as evidence of one of those techniques. *Compare* Pet. 1–9, 12–60 with 1712-Pet. 4–23, 32–51.

Furthermore, we take into consideration the fact that the instant Petition was filed after our decision denying institution of review of the same challenged claims was entered in IPR2015-01712, and that it seeks to correct deficiencies with the prior petition identified in our denial. Other panels have determined and we agree that such a consideration is a factor that weighs against institution of a second petition. *See, e.g., Valeo North America, Inc. v. Magna Electronics, Inc.*, Case IPR2015-01415, slip. op. 11 (PTAB Dec. 7, 2015) (Paper 10); *see also*, 35 U.S.C. § 316(b) (regulations for AIA post-grant proceedings take into account “the efficient administration of the Office” and “the ability of the Office to timely complete [instituted] proceedings”).

Finally, we have taken into consideration Petitioner's contentions that “several factors” justify filing the Petition in the instant case. Pet. 5. In particular, Petitioner contends:

This Petition is justified by several factors, including: (1) the prejudice to Petitioners caused by Patent Owner's assertion of an unreasonable number of claims in the co-pending litigation; (2) recent deposition testimony from Dr. Dennis Dupray, a named inventor of the '327 Patent, that was not available when IPR proceeding IPR2015-01712 was filed; and (3) the public interest in adjudicating the validity of a clearly invalid claim and having consistent outcomes concerning similar sets of claimed subject matter and prior art.

Id.

The first of the "several factors" asserted by Petitioner pertains to a characterization of Patent Owner's actions in the co-pending lawsuit. *Id.* Petitioner does not provide persuasive legal authority for its assertion that we should make a determination of whether Patent Owner's actions in the co-pending lawsuit were unreasonable. Petitioner's contentions in this regard should not be raised in the instant proceeding.

The second of the factors pertains to "the recent testimony from Dr. Dennis Dupray," who is "a named inventor of the '327 Patent." *Id.* In this regard, Petitioner submits a portion of a deposition transcript in which Dr. Dupray is asked whether a version of cell tower triangulation that did not involve GPS existed prior to his invention. Pet. 6 (citing Ex. 1021, 332:11–333:4, 334:2–12). In response, Dr. Dupray testifies "I don't have any in mind right at this time. My belief is **there probably was.**" *Id.* (emphasis in Petition)). Petitioner has not explained sufficiently why this testimony "illustrates that the prior art teaches the **very limitation** that the Board relied on in declining to institute Claim 1," as Petitioner contends. *Id.* (citation omitted). Petitioner additionally has not explained persuasively why submission of this testimony is a factor that supports filing the instant

Petition, especially in light of the availability of the asserted prior art, as well as the testimony of Dr. Michalson, when the 1712-Petition was filed.

The third of the factors pertains to Petitioner's assertion that claim 1 of the '327 Patent is "a clearly invalid claim." *Id.* For the reasons set forth in IPR2015-01712, to the contrary, we determined that Petitioner had not established a reasonable likelihood that it would prevail with respect to claims 1, 2, and 44 of the '327 Patent. *See generally* 1712-Decision.

Upon review, on this record, we find that the instant Petition presents the same art and substantially the same arguments as previously asserted by Petitioner in IPR2015-01712. Accordingly, we exercise our discretion under 35 U.S.C. § 325(d) to deny institution of review.

B. The Motion for Joinder

The statutory provision governing joinder of *inter partes* review proceedings is 35 U.S.C. § 315(c), which provides:

If the Director institutes an inter partes review, the Director, in his or her discretion, may join as a party to that inter partes review any person who properly files a petition under section 311 that the Director, after receiving a preliminary response, under section 313 or the expiration of time for filing such a response, determines warrants the institution of an inter partes review under section 314.

35 U.S.C. § 315(c)

For the reasons above, based on the circumstances of this case, we exercise our discretion under 35 U.S.C. § 325(d), and deny the Petition requesting institution of *inter partes* review in IPR2016-00729.

Accordingly, we deny Petitioner's request to join IPR2016-00729 with IPR2015-01712.

III. ORDER

For the foregoing reasons, it is:

ORDERED that the Petition in IPR2016-00729 is *denied* and no *inter partes* review is instituted; and

FURTHER ORDERED that Petitioner's motion for joinder of IPR2016-00729 with IPR2015-01712 is *denied*.

IPR2016-00729
Patent 7,298,327 B2

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