UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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TV MANAGEMENT, INC., d/b/a GPS NORTH AMERICA,
Petitioners,

v.

PERDIEMCO LLC,
Patent Owner.

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Case IPR2016-01061
Patent 8,223,012 B1

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Before WILLIAM V. SAINDON, CARL M. DEFRANCO, and
AMBER L. HAGY, *Administrative Patent Judges.*

DEFRANCO, *Administrative Patent Judge.*

FINAL WRITTEN DECISION
35 U.S.C. § 318(a) and 37 C.F.R. § 42.73

I. INTRODUCTION

PerDiemCo LLC ("PerDiem") is the owner of U.S. Patent No. 8,223,012 B1 ("the '012 patent"). TV Management, Inc., d/b/a GPS North America ("GPSNA") filed a Petition seeking *inter partes* review of claims 1–13, 18, 19, 22–24, and 27 of the '012 patent.[1] Paper 5 ("Pet."). We instituted *inter partes* review of all the challenged claims (Paper 21, "Inst. Dec.") because GPSNA demonstrated a reasonable likelihood of prevailing on "at least 1 of the claims challenged in the petition." 35 U.S.C. § 314(a).

After institution, PerDiem filed a Patent Owner Response (Paper 35, "PO Resp."), and GPSNA followed with a Reply (Paper 39, "Pet. Reply"). Each party had an opportunity to present its case in a hearing conducted on September 12, 2017, a transcript of which is in the record. Paper 49 ("Tr.").

We have jurisdiction over these proceedings under 35 U.S.C. § 6. After considering the evidence and arguments of the parties, we determine that GPSNA has proven by a preponderance of the evidence that claims 1–13, 18, 19, 22–24, and 27 of the '012 patent are unpatentable. *See* 35 U.S.C. § 316(e). We issue this Final Written Decision pursuant to 35 U.S.C. § 318(a).

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[1] The Petition originally included three additional parties: Teletrac Inc., Navman Wireless North America, Ltd., and Geotab Inc. Prior to institution, Teletrac and Navman filed a motion to terminate themselves from the proceeding (Paper 12), which we granted on August 24, 2016 (Paper 14). After institution, Geotab filed a motion to terminate itself from the proceeding (Paper 26), which we granted on December 29, 2016 (Paper 28). That left GPSNA as sole petitioner.

II. BACKGROUND

A.   Related Matters

The '012 patent is part of a family of eleven related patents, which includes U.S. Patent Nos. 8,149,113 ("the '113 patent"), 8,493,207 ("the '207 patent"), 8,717,166 ("the '166 patent"), 9,003,499 ("the '499 patent"), 9,071,931 ("the '931 patent"), 9,119,033 ("the '033 patent"), 9,319,471 ("the '471 patent"), 9,485,314 ("the '314 patent"), 9,621,661 ("the '661 patent"), and 9,680,941 ("the'941 patent"). We have previously instituted *inter partes* review ("IPR") of all the patents from this family. Specifically, in addition to the instant IPR, pending before us are IPR2016-01064 (the '499 patent), IPR2016-01278 (the '931 patent), IPR2017-00968 (the '314 patent), IPR2017-00969 (the '113 patent), IPR2017-00973 (the '471 patent), IPR2017-01007 (the '033 patent), and IPR2017-01269 (the '661 patent).[2] In the 1064 and 1278 IPRs, GPSNA is the petitioner, as it is here, while in the 968, 969, 973, 1007, and 1269 IPRs, Telular Corporation is the petitioner and GPSNA is named as a real party-in-interest.[3]

The '012 patent, along with the '113, '499, '931, '033, '471, and '314 patents, is currently the subject of an infringement action brought by PerDiem against GPSNA in the U.S. District Court for the Eastern District of Texas ("the Texas action"). Paper 37 (identifying *PerdiemCo LLC v. Telular Corp. et al.*, 2:16-cv-01408 (E.D. Tex.)). The Texas action is currently stayed pending resolution of this IPR and the related IPRs.

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[2] We also instituted IPRs for the related '207 and '166 patents, but those IPRs were terminated after PerDiem filed a statutory disclaimer of all the challenged claims. IPR2016-01062 (Paper 29); IPR2016-01063 (Paper 30).
[3] Telular is named as a real party-in-interest in the instant IPR. Pet. 3.

B.   *The '012 Patent*

The '012 patent relates to a system for conveying information about the location of a person or object to a group of users based on "user identification codes" and "access control codes" associated with each user in the group. Ex. 1001, 1:13–22, 1:66–2:12. The group of users may, for example, be a family, a cadre of friends, or employees of a company. *Id*. at 5:29–35. Global positioning technology is used to track the location of the person or object. *Id.* at 6:10–29, Fig. 1. The person or object may be tracked relative to "user-defined zones," such that when the tracked person or object enters or leaves a zone, location information is conveyed to certain authorized users. *Id.* at 5:8–24, 8:67–9:5.

An administrator, or other authorized user, may configure what location information is conveyed and to whom it is conveyed. *Id*. at 5:41–44. By associating an identification code and an access code with each user, the administrator can control who receives the location information. *Id.* at 2:7–3:6, 6:66–8:25. For instance, a mother might track the location of her daughter's car by equipping it with a tracking beacon and assigning it a user identification code. *Id*. at 9:14–58. With the identification code, the mother may then set up "events" so that when her daughter's car enters or leaves a pre-defined zone, the mother will receive an alert via email. *Id*. at 9:33–48. The mother may also have the location of her daughter's tracked car conveyed to another specified user, such as another guardian, by assigning them a different identification code and associating an access code with that that specific user's identification code to allow them a certain level of access to the daughter's location information. *Id*. at 11:1–44.

C.   *The Challenged Claims*

Of the challenged claims, three are independent—claims 1, 7, and 18.

Claims 1 and 18 are directed to a "method" for conveying location

information about a person or object to authorized users, while claim 7 is

directed to an "apparatus" for doing the same. The remaining claims under

challenge depend, directly or indirectly, from these three claims.

Each of the independent claims requires that the conveyance of

location information to authorized users be based on a "user identification

code" and an "information access code." Claim 1 is illustrative:

> 1.   A method for conveying user location information,
> comprising:
>
> interfacing with an administrator that authorizes *a first
> user* associated with a first user identification code to access an
> object location information from a location information source
> associated with *a second user* identification code that is different
> from the first identification code; and
>
> *conveying the object location information to a third user
> based on an information access code specified by said first user*,
> said information access code being associated with a third user
> identification code that is different from the first and second user
> identification codes.

Ex. 1001, 22:55–67 (emphases added).

D.   *The Instituted Grounds*

In its Petition, GPSNA raises two grounds of unpatentability, the first

based on anticipation under 35 U.S.C. § 102, and the second based on

obviousness under 35 U.S.C. § 103. Pet. 5. We instituted review of all the

challenged claims in each ground, after finding that GPSNA met the

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