

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

TV MANAGEMENT, INC., D/B/A GPS NORTH AMERICA,
Petitioner,

v.

PERDIEMCO LLC,
Patent Owner.

Case IPR2016-01278
Patent 9,071,931 B2

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

HAGY, *Administrative Patent Judge*.

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

I. INTRODUCTION

PerdiemCo LLC (“Patent Owner”) is the owner of U.S. Patent No. 9,071,931 B2 (Ex. 1001, “the ’931 patent”). TV Management, Inc., d/b/a GPS North America (“Petitioner”)¹ requested an *inter partes* review of claims 1–7, 12–16, 20, and 22–26 of the ’931 patent. Paper 5 (“Pet.”). We instituted *inter partes* review of all of the challenged claims (Paper 22, “Inst. Dec.”) based on our determination that Petitioner had demonstrated a “reasonable likelihood” of prevailing on those claims. 35 U.S.C. § 314(a).

After institution, Patent Owner filed a Patent Owner Response (Paper 30, “PO Resp.”), and Petitioner followed with a Reply (Paper 36, “Pet. Reply”). With Board authorization, the parties each filed additional briefing limited to addressing evidence submitted by Patent Owner in support of alleged prior invention. Papers 41–43. 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 50 (“Tr.”).²

We have jurisdiction over these proceedings under 35 U.S.C. § 6. After considering the evidence and arguments of the parties, we determine that Petitioner has proved by a preponderance of the evidence that the subject matter of claims 1–7, 12–16, 20, and 22–26 of the ’931 patent is

¹ On August 15, 2016, prior to institution, petitioners Teletrac Inc. and Navman Wireless North America, Ltd., moved to terminate the proceedings with respect to themselves only. Paper 9. The Board granted that motion on August 31, 2016. Paper 11. After institution, petitioner Geotab Inc. and Patent Owner jointly moved to terminate the proceedings as to Geotab Inc. only, Paper 24, and the Board granted that motion on December 29, 2016, leaving as sole petitioner TV Management, Inc., d/b/a GPS North America. Paper 27.

² An oral hearing in related Cases IPR2016-01061 and IPR2016-01064 occurred on the same day, with similar issues presented and argued.

unpatentable. *See* 35 U.S.C. § 316(e). We issue this Final Written Decision pursuant to 35 U.S.C. § 318(a).

A. Related Matters

The '931 patent is part of a family of patents that share a common specification and claim priority through a continuation chain to U.S. Patent No. 7,525,425, which in turn claims priority to a provisional application filed on December 23, 2005. Other patents in this family include U.S. Patent Nos. 8,149,113; 8,223,012; 8,493,207; 8,717,166; 9,003,499; 9,119,033; 9,319,471; 9,485,314; 9,621,661; and 9,680,941.

In addition to *inter partes* review of the '931 patent, the Board has instituted the following *inter partes* reviews (“IPRs”) directed to certain claims of the following patents within this patent family:

1. IPR2016-01061 (the '012 patent);
2. IPR2016-01062 (the '207 patent);
3. IPR2016-01063 (the '166 patent);
4. IPR2016-01064 (the '499 patent);
5. IPR2017-00968 (the '314 patent);
6. IPR2017-00969 (the '113 patent);
7. IPR2017-00973 (the '471 patent);
8. IPR2017-01007 (the '033 patent); and
9. IPR2017-01269 (the '661 patent).

Subsequent to institution, two of those IPRs were terminated in an adverse judgment in view of Patent Owner’s disclaimer of all challenged claims. IPR2016-01062 (Paper 29); IPR2016-01063 (Paper 30). The Board has issued Final Written Decisions in IPR2016-01061 (Paper 50), and in IPR2016-01064 (Paper 49).

The '931 patent, along with the '207, '012, '166, and '499 patents, was asserted in the following cases in the Eastern District of Texas, all of which have been terminated: *PerdiemCo LLC v. Geotab Inc. et al*, Case No. 2:15-cv-00726; *PerdiemCo, LLC. v. Industrack LLC*, Case No. 2:15-cv-00727; *PerdiemCo, LLC. v. Omnivations II, LLC D/B/A Fleetronix*, Case No. 2:15-cv-00729; *PerdiemCo, LLC. v. Teletrac, Inc. et al*, Case No. 2:15-cv-00730; *Perdiem Co LLC v. GPS Logic, LLC*, Case No. 2:15-cv-01216; *PerdiemCo LLC v. TV Management, Inc. d/b/a GPS North America*, Case No. 2:15-cv-01217; *PerdiemCo, LLC. v. thingtech LLC*, Case No. 2:15-cv-01218; *PerdiemCo, LLC. v. LiveViewGPS, Inc.*, Case No. 2:15-cv-01219.

The '931 patent, along with the '012, '499, '471, '113, '033, and '314 patents, is currently the subject of a co-pending lawsuit in the Eastern District of Texas, which was filed after institution of the present proceeding and after termination of the above-referenced cases: *PerdiemCo LLC v. Telular Corp. et al.*, 2-16-cv-01408. That district court case is currently stayed pending resolution of this IPR proceeding and the related IPR proceedings.

B. The '931 Patent (Ex. 1001)

The '931 patent relates to a location-tracking system for conveying information about the location of an object, such as a person, vehicle, or package, to a group of users. Ex. 1001, 1:8–12, 1:61–2:7. The group of users may include a family, a group of friends, or employees of a company. *Id.* at 5:27–33, 13:10–29. According to the '931 patent, various technologies, such as Global Positioning System (“GPS”) technology, may be used to track the location of the object. *Id.* at 6:9–18, Fig. 1. An object may be tracked relative to “user-defined zones.” *Id.* at 1:62–2:8, 5:7–26.

The system also monitors “events,” which are, for example, instances when a tracked object enters or exits a zone. *Id.*

In one exemplary scenario, a mother can track the location of an object (her daughter’s car) by equipping it with a tracking beacon and assigning it an identification code. *Id.* at 9:12–56. The mother may then use that identification code to set up “events” so that when her daughter’s car enters or leaves a pre-defined “zone,” the mother will receive an “alert” (such as an email). *Id.* The mother may also have the location of her daughter’s tracked car conveyed to one or more other specified users, such as another parent or a guardian, by assigning them identification codes and associating a particular level of access with each user’s identification code. *Id.* at 10:30–54.

Administrative functions may be performed within a group as, for example, a “family can set up its own information-sharing environment.” *Id.* at 5:62–65. Various levels of administrator privileges may exist. *Id.* at 5:51–54. In addition to associating identification codes with each user, the administrator can associate a level of access with the user, and thereby limit who receives the location information. *Id.* at 2:45–3:3, 5:39–54, 6:64–7:60.

C. Challenged Claims

Petitioner challenges claims 1–7, 12–16, 20, and 22–26, of which claim 1 is independent. Challenged claim 1 is reproduced below.³

1. [a] A location tracking system comprising:
 - [b] one or more servers capable of communicating with a plurality of mobile devices, each mobile device is associated with an identification (ID) and at least one location

³ For expediency, Petitioner and Patent Owner break claim 1 into limitations 1(a)–1(n). We adopt that format herein for ease of reference.

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