

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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TELULAR CORPORATION,  
Petitioner,

v.

PERDIEMCO LLC,  
Patent Owner.

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Case IPR2017-00969  
Patent 8,149,113 B2

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

HAGY, *Administrative Patent Judge*.

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

## I. INTRODUCTION

By way of a Petition accorded a filing date of March 29, 2017 (*see* Paper 5), Petitioner Telular Corporation (“Petitioner”) requests an *inter partes* review of claims 1–62 of U.S. Patent No. 8,149,113 B2 (Ex. 1001, “the ’113 patent”). Paper 2 (“Pet.”). Patent Owner PerdiemCo LLC (“Patent Owner”) filed a Preliminary Response to the Petition on June 29, 2017. Paper 7 (“Prelim. Resp.”). Patent Owner included with its Preliminary Response a Statutory Disclaimer under 37 C.F.R. § 1.321(a), wherein Patent Owner has disclaimed claims 1–3, 7–44, 46–56, and 59. Ex. 2017. The claims remaining after disclaimer are claims 4–6, 45, 57, 58, and 60–62 (“the remaining challenged claims”).

We have jurisdiction under 35 U.S.C. § 314, which provides that an *inter partes* review may not be instituted “unless . . . there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.” *See also* 37 C.F.R. § 42.4(a). After considering the Petition and Patent Owner’s Preliminary Response, we conclude that Petitioner has demonstrated a reasonable likelihood of proving that the remaining challenged claims of the ’113 patent are unpatentable. Accordingly, we authorize *inter partes* review of *all* of the remaining challenged claims of the ’113 patent.

Our factual findings and conclusions at this stage of the proceeding are based on the evidentiary record developed thus far. This is not a final decision as to the patentability of claims for which *inter partes* review is instituted. Our final decision will be based on the record as fully developed during trial.

*A. Related Matters*

Petitioner represents that the '113 patent “is one of a portfolio of ten related patents and two pending applications,” and “relates to U.S. Patent Nos. 7,525,425; 8,493,207; 8,717,166; 8,223,012; 9,003,499; 9,485,314; 9,119,033; 9,319,471; and 9,071,931.” Pet. 3. Petitioner also identifies pending U.S. patent application nos. 14/629,347 and 15/200,592 as related to the '113 patent. Pet. 4. On April 11, 2017, subsequent to the filing of the present Petition, application no. 15,200,592 issued as U.S. Patent No. 9,621,661 B2. On June 13, 2017, application no. 14,629,347 issued as U.S. Patent No. 9,680,941.

The Board has instituted the following *inter partes* reviews (“IPRs”) directed to certain claims of the following patents within this portfolio:

1. IPR2016-01061 (the '012 patent);
2. IPR2016-01062 (the '207 patent);
3. IPR2016-01063 (the '166 patent);
4. IPR2016-01064 (the '499 patent); and
5. IPR2016-01278 (the '931 patent).

The remaining petitioner in each of these proceedings is TV Management, Inc., d/b/a GPS North America (“GPS NA”). *E.g.*, IPR2016-01061, Paper 28. Current petitioner Telular Corporation is named in each of those proceedings as a real party-in-interest. *E.g.*, IPR2016-01061, Paper 5 at 10. 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). Oral arguments were held on September 12, 2017, in the remaining instituted IPRs.

Petitioner has also filed IPR petitions challenging certain claims of the '314, '471, '033, and '661 patents, respectively: IPR2017-00968; IPR2017-00973; IPR2017-01007; and IPR2017-01269.

Petitioner represents that the '113, '314, '033, and '471 patents are all the subject of a co-pending lawsuit in the Eastern District of Texas: *PerdiemCo LLC v. Telular Corp. et al.*, 2-16-cv-01408. Pet. 3–4. A review of the complaint filed in that case reveals that the '012, '499, and '931 patents, for which reviews have been instituted and are pending as noted above, are also at issue in that litigation.

*B. Statutory Disclaimer of Claims 1–3, 7–44, 46–56, and 59*

After Petitioner filed its Petition, Patent Owner filed a statutory disclaimer of challenged claims 1–3, 7–44, 46–56, and 59 under 35 U.S.C. § 253(a). Prelim. Resp. 4; Ex. 2017. Rule 42.107(e) provides that “[t]he patent owner may file a statutory disclaimer under 35 U.S.C. 253(a) in compliance with § 1.321(a) of this chapter, disclaiming one or more claims in the patent. No *inter partes* review will be instituted based on disclaimed claims.” 37 C.F.R. § 42.107(e); *see also* Office Patent Trial Practice Guide, 77 Fed. Reg. 48,756, 48,764-65 (Aug. 14, 2012) (“[A] patent owner may file a statutory disclaimer of one or more challenged claims to streamline the proceedings. Where no challenged claims remain, the Board would terminate the proceeding. Where one or more challenged claims remain, the Board’s decision on institution would be based solely on the remaining claims.”).

Patent Owner’s disclaimer, Exhibit 2017, is in compliance with 37 C.F.R. § 1.321(a). Accordingly, we do not institute an *inter partes* review of disclaimed claims 1–3, 7–44, 46–56, and 59.

Patent Owner's disclaimer leaves claims 4–6, 45, 57, 58, and 60–62 of the '113 patent to be considered for review, of which claim 60 is the sole independent claim.

*C. The '113 Patent (Ex. 1001)*

The '113 patent relates to a method for tracking the location of an object, such as a person, vehicle, or package, using, for example, Global Positioning Systems (“GPS”). Ex. 1001, 6:20–32 and Fig. 1. The object may be tracked relative to “user-defined zones,” which are compared against the object's tracked location to convey location information to authorized users by, for example, sending them a notification when an object's location passes over a zone boundary. *Id.* at 2:39–44, 19:53–56.

An administrator, or other authorized user, may configure what location information is conveyed and to whom it is conveyed. *Id.* at 5:41–44, 13:22–25. In addition to associating user identification codes with each user, the administrator can associate an “access code” with the user to control who receives the location information. *Id.* at 2:48–3:6, 6:66–8:25. For instance, a mother can track the location of her daughter's car by equipping it with a tracking beacon and assigning it a user identification code. *Id.* at 9:16–58. The mother then uses 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 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 a particular level of access, i.e., an access privilege, with that user's identification code. *Id.* at 10:33–67.

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