

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 IPR2017-00973  
Patent 9,319,471 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 1–20 of U.S. Patent No. 9,319,471 B2 (Ex. 1001, “the ’471 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.”).

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 Preliminary Response, we conclude that Petitioner has demonstrated a reasonable likelihood of proving that the challenged claims are unpatentable. Accordingly, we authorize *inter partes* review of *all* of the challenged claims of the ’471 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 ’471 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; 8,149,113; 9,119,033; 9,485,314; and 9,071,931.” Pet. 4. Petitioner also identifies pending U.S. patent application nos. 14/629,347 and 15/200,592 as related to

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the '471 patent. Pet. 5. 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, '113, '033, and '661 patents, respectively: IPR2017-00968; IPR2017-00969; IPR2017-01007; and IPR2017-01269.

Petitioner represents that the '471, '113, '033, and '314 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. 4–5. 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. The '471 Patent (Ex. 1001)*

The '471 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, 6:18–30 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 2:35–44, 19:49–52.

One or more administrators may be given privileges to configure an information-sharing environment by “specifying authorized users of the [information-sharing] environment and their access privileges.” *Id.* at 5:39–42; 13:19–23. 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. Each user may be associated with a level of access, thereby limiting who may receive the location information. *Id.* at 2:45–3:3, 6:64–7:60. 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 9:14–56. 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, i.e., an access privilege, with each user's identification code. *Id.* at 10:30–54.

### C. Challenged Claims

Petitioner challenges claims 1–20, of which claims 1, 8, and 12 are independent. Challenged claim 1 is reproduced below, with formatting added.<sup>1</sup>

[1P] A tracking system comprising:

[1.1] one or more servers capable of communicating object location information to a group comprising a plurality of users having user IDs, said group having a group ID, said group being one of a plurality of groups each having corresponding group IDs and user IDs,

[1.2] said object location information relating to a plurality of mobile objects having object IDs,

[1.3] wherein a first object ID of a first mobile object of said plurality of mobile objects is associated with a first location information source that provides a first location information corresponding to first coordinates of said first mobile object within a first coordinate system, and wherein a second object ID of a second mobile object of said plurality of mobile objects is associated with a second location information source that provides a second location information corresponding to second coordinates of said second mobile object within a second coordinate system,

[1.4] said second coordinates being relative to said first coordinates based on proximity of the first mobile object to the second mobile object,

[1.5] the one or more servers being configured to:

[1.6] define first level administrative privileges to control user membership in said group;

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<sup>1</sup> For expediency, Petitioner breaks claim 1 into limitations 1P and 1.1–1.18. Pet. 15–16. We adopt that format herein for ease of reference.

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