

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

TELULAR CORPORATION,
Petitioner,

v.

PERDIEMCO LLC,
Patent Owner.

Case IPR2017-01007
Patent 9,119,033 B2

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

DEFRANCO, *Administrative Patent Judge*.

DECISION TO INSTITUTE
37 C.F.R. § 42.108

I. INTRODUCTION

This is a preliminary proceeding to decide whether *inter partes* review of U.S. Patent No. 9,119,033 B2 (“the ’033 patent”) should be instituted under 35 U.S.C. § 314. PerDiemCo LLC (“PerDiem”) is the owner of the ’033 patent. Telular Corporation filed a Petition seeking *inter partes* review

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of claims 1–20 of the '033 patent. Paper 2 (“Pet.”). PerDiem, in turn, filed a Preliminary Response. Paper 7 (“Prelim. Resp.”). After considering the Petition and Preliminary Response, we conclude that Telular has demonstrated a reasonable likelihood of proving that at least independent claim 1 is unpatentable. Because Telular has met the threshold for institution of “at least 1 of the claims challenged *in the petition*,” we authorize *inter partes* review (“IPR”) of all the challenged claims. 35 U.S.C. § 314(a) (emphasis added).

II. BACKGROUND

A. *Related Matters*

PerDiem filed a patent infringement action asserting the '033 patent against Telular in the U.S. District Court for the Eastern District of Texas: *PerdiemCo LLC v. Telular Corp.*, 2:16-cv-01408 (“the Texas action”). Paper 6 (PO Mandatory Notice). In the Texas action, PerDiem also asserts a number of related patents, each of which shares a similar specification with the '033 patent. The related patents include U.S. Patent Nos. 8,149,113 (“the '113 patent”), 8,223,012 (“the '012 patent”), 9,003,499 (“the '499 patent”), 9,071,931 (“the '931 patent”), 9,319,471 (“the '471 patent”), and 9,485,314 (“the '314 patent”). Ex. 2003.

With our decision today, we will have instituted *inter partes* review (“IPR”) on all of the patents at issue in the Texas action. In addition to instituting review of the '033 patent here, we have instituted review on the remaining patents in the following related proceedings: IPR2016-01061 (the '012 patent); IPR2016-01064 (the '499 patent); IPR2016-01278 (the '931 patent); IPR2017-00968 (the '314 patent); IPR2017-00969 (the '113 patent); and IPR2017-00973 (the '471 patent). TV Management, Inc., d/b/a GPS

North America (“GPS NA”) is the petitioner in the 1061, 1064, and 1278 proceedings, while Telular is the petitioner in the 968, 969, and 973 proceedings, as it is here.¹

B. The '033 Patent

The '033 patent relates to a system for sharing location information about various groups of drivers or objects with a group of persons interested in tracking the drivers or objects. Ex. 1001, 1:1–4, 5:36–38. The interested persons are provided with user interfaces both for selecting from “one or more defined groups” and for receiving location information about the drivers/objects within the defined group. *Id.* at 6:57–7:5, 13:4–32. Global positioning system (GPS) technology is used to track the location of the group of drivers/objects. *Id.* at 5:64–6:56, Fig. 1. The location of the driver/object within the selected group is tracked relative to “user-defined zones,” and the driver/object’s tracked location is shared with the interested persons. *Id.* at 4:61–5:19, 16:13–24. The shared location information may also pertain to an “event,” such as when the tracked driver/object enters or leaves a zone. *Id.* at 8:47–9:4, 16:25–47. Anytime the tracked driver/object crosses a zone, an exit or entry alert is sent to the interested persons. *Id.* at 19:41–44.

C. The Challenged Claims

Of the challenged claims, three are independent—claims 1, 6, and 11. These claims are similar in scope in that they require a system for sharing location information among a “first,” “second,” and “third” group, differing

¹ Telular is named as a real party-in-interest in the 1061, 1064, and 1278 proceedings. Oral argument was held in those proceedings on September 12, 2017.

mainly in the definition of the “group.” Claim 1 relates to groups of “drivers”; claim 6 to groups of “mobile devices”; and claim 11 to groups of “objects.” Claim 1 is representative:

1. A system for sharing information about a group of drivers, the system comprising:

one or more servers capable of communicating with a plurality of mobile devices, each mobile device is associated with at least one location information source that provides location information for the mobile device;

the one or more servers configured to:

store information for:

a first group of mobile devices associated with *a first group of drivers*;

a second group of mobile devices associated with *a second group of drivers*; and

a third group of mobile devices associated with *a group of individuals interested in locating a driver*;

wherein the information includes a phone number for each mobile device in each group;

provide one or more interfaces for a driver to select one of the groups of drivers;

receive a request from a driver to join one of the groups of drivers;

check the request before adding the driver to the requested group of drivers;

provide one or more interfaces for an individual to obtain information about a group of drivers, where the one or more interfaces:

allow the individual to select one of the first group of drivers or the second group of drivers;

provide a map showing streets of a city, location of the individual, and location of one or more drivers in the selected group of drivers; and

allow the individual to use the map to set a location;

receive location information for at least one driver in the selected group of drivers;

compare the location information for the at least one driver in the selected group of drivers with the location to determine whether to send an alert to the individual's mobile device phone number; and

cause the alert to be sent to the individual's mobile device phone number.

Ex. 1001, 22:43–23:14 (emphases added).

D. The Asserted Grounds of Unpatentability

Telular raises four grounds in challenging claims 1–20 of the '033 patent—*first*, that claims 1–20 are anticipated by Phillips²; *second*, that claims 6–20 are anticipated by Haney³; *third*, that claims 1–5 would have been obvious over Haney; and, *finally*, that claims 1–20 would have been obvious over Haney and Fast.⁴ Pet. 7. In further support, Telular relies on the declaration of Dr. Stephen Heppe, an expert witness retained by Telular for purposes of this proceeding.⁵ Ex. 1018.

² U.S. Patent No. 7,848,765 B2 (Ex. 1007, “Phillips”).

³ U.S. Patent No. 7,353,034 B2 (Ex. 1005, “Haney”).

⁴ U.S. Patent No. 7,327,258 B2 (Ex. 1003, “Fast”).

⁵ Dr. Heppe has previously submitted declarations in the related proceedings.

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