

UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE PATENT TRIAL AND APPEAL BOARD

ALARM.COM INC.
Petitioner

v.

VIVINT, INC.
Patent Owner

Case IPR2015-02004
Patent 6,147,601

**PETITIONER'S REPLY BRIEF CONCERNING PATENT OWNER'S
REQUEST FOR CERTIFICATE OF CORRECTION**

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By written order of the Patent Trial and Appeal Board, entered on January 28, 2016, Petitioner Alarm.com Inc. (“Alarm.com”) hereby respectfully submits this reply brief addressing the Request for Certificate of Correction filed by Patent Owner Vivint, Inc. (“Vivint”) as to U.S. Patent No. 6,147,601 (the “’601 Patent” or “Patent”), filed December 17, 2015, and attached to Vivint’s January 8, 2016 Preliminary Response to Alarm.com’s Petition for *Inter Partes Review* (“IPR”), Paper 1, in Case IPR2015-02004 (“Petition”).

Petitioner Alarm.com respectfully submits this reply brief to address:

(1) whether Vivint’s proposed change to the ’601 Patent is properly characterized as a correction under 35 U.S.C. § 255, (2) why Petitioner could not discern the correction unassisted and (3) the impact of this proposed change on Alarm.com’s Petition—namely, whether the prior art Alarm.com cited in its Petition discloses the proposed changed claim limitation.

I. Petitioner’s Views on Vivint’s Proposed Correction and Reasons Why Petitioner Could Not Discern the Correction Unassisted

Vivint proposes one change to claim 39 of the ’601 Patent, changing “which said normal status” to “which a normal status.”

Claim	Vivint’s Proposed Corrected Claim Language	Dependent Claims Affected
39	A system according to claim 38, wherein said outgoing exception message comprises exception information and identification information concerning said piece of remote equipment to which said normal status which a normal	none

Claim	Vivint's Proposed Corrected Claim Language	Dependent Claims Affected
	status message pertains.	

Petitioner does not agree that Vivint's proposed change to claim 39 constitutes an allowable correction under 35 U.S.C. § 255. Under that statute, corrections are permitted only for "a mistake of a clerical or typographical nature" or "a mistake . . . of minor character." The proposed change does not meet the requirements for either of these two categories of corrections.

First, the change does not constitute a correction, because even assuming the change is meant to correct a clerical or typographical error, it is not "clearly evident from the specification, drawings, and prosecution history how the error should appropriately be corrected." *Superior Fireplace Co. v. Majestic Prods. Co.*, 270 F.3d 1358, 1373 (Fed. Cir. 2001).

One defect in claim 39 as issued is that it lacks an antecedent basis for the element "to which said normal status message pertains." Like claim 39, neither of the claims from which claim 39 depends (claims 22 and 38) refers to a *normal* status message; instead, each refers to an *exception* message that is "indicative of the exception condition."

A second difficulty with claim 39—both as issued and as revised by Vivint—is that it supposes that the server could receive contradictory messages—specifically, an "exception message" (claims 22 and 38 and the preceding language

of claim 39) and a “normal status message” (dependent claim 39)—pertaining to the same piece of remote equipment at the same time. An “exception condition,” according to the Patent, exists “whenever a piece of equipment operates outside its preferred parameters.” Ex. 1001 at 3:46-47. In other words, the equipment is *not* operating normally. By contrast, the Patent describes the use of a status message to indicate that a piece of equipment is “okay.” *See* Ex. 1001 at 4:60-63. In addition, the Patent expressly teaches that the preferred embodiment differentiates between a status message and an exception message using the first digit of the multi-digit code sent from a device to the message delivery system, further reinforcing the mutually exclusive nature of the two conditions. *See* Ex. 1001 at 5:24-27. Vivint’s proposed correction does not follow from or correspond to the Patent’s description of the invention. Further, it does not resolve the defect in claim 39, rendering it improbable.

A more probable correction to claim 39 would change “said normal status message” to “said exception condition,” resolving the contradiction explained above. However, there are other possible ways to correct claim 39, including, making it depend from claim 31, instead of claim 38, since claim 31 requires that the server generate exception messages when the server has *not* received a normal status message for a particular piece of remote equipment “within a predetermined period of time.” However, because nothing in the Patent or its prosecution history

indicates how the error should be corrected and because there is no clearly evident correction, Vivint's proposed change cannot be an allowable correction under Section 255.

Second, Vivint's proposed change is not of a "minor character" because it seeks to broaden an element from referring to a *specific* normal status message (if an antecedent could be found) to *any* normal status message, thereby substantively altering the scope of the claim. *See id.* at 1375 ("A mistake that, if corrected, would broaden the scope of a claim must thus be viewed as highly important and thus cannot be a mistake of 'minor character.'"); Manual of Patent Examining and Procedure (MPEP) § 1480.01 (9th Ed. Rev. Nov. 2013) ("A mistake is not considered to be of the 'minor' character . . . if the requested change would materially affect the scope or meaning of the patent.").

In addition, because Vivint's proposed correction, as explained above, is contradictory and because there are multiple ways to fix the defect in claim 39, reexamination—rather than correction—would be required to determine the correct change to claim 39, if any. *See* 35 U.S.C. § 255 (correction proper only if "[it] does not involve such changes as would require . . . re-examination").

Petitioner could not discern the proposed correction in advance because, while it was apparent the claim contained a mistake—specifically, the lack of antecedent basis—there are a number of ways the claim could have been corrected

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