

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ALARM.COM INC.,
Petitioner,

v.

VIVINT, INC.,
Patent Owner.

Cases IPR2015-01995, IPR2015-01997, IPR2015-02003,
IPR2015-02004, IPR2016-00116, IPR2016-00129,
IPR2016-00155, IPR2016-00161, and IPR2016-00173
(Patents 6,147,601, 6,462,654 B1, 6,535,123 B2, and 6,717,513 B1)¹

Before MICHAEL R. ZECHER, JAMES B. ARPIN, and
CHARLES J. BOUDREAU, *Administrative Patent Judges*.

BOUDREAU, *Administrative Patent Judge*.

ORDER
Conduct of Proceeding
37 C.F.R. § 42.5

On January 28, 2016, we issued a set of Orders staying certain
Requests for Certificates of Correction filed by Patent Owner with respect to

¹ This Order addresses an issue pertaining to each of the nine identified cases. Therefore, we exercise our discretion to issue one Order to be filed in

Cases IPR2015-01995, IPR2015-01997, IPR2015-02003, IPR2015-02004, IPR2016-00116, IPR2016-00129, IPR2016-00155, IPR2016-00161, and IPR2016-00173 (Patents 6,147,601, 6,462,654 B1, 6,535,123 B2, and 6,717,513 B1)

U.S. Patent Nos. 6,147,601, 6,462,654 B1, 6,535,123 B2, and 6,717,513 B1, pending our decisions on institution in each of the above-identified cases.²

In a telephone conference held on May 25, 2016, we notified the parties³ of our intention to lift the stay of the Requests for Certificates of Correction, in view of the fact that decisions on institution have now been entered in each identified case.⁴

In the telephone conference, Petitioner initially objected to our lifting of the stay, citing its intention to request partial rehearing of our Decision on

each case. The parties are not authorized to use this style heading for any subsequent papers.

² Case IPR2015-01995 (PTAB Jan. 28, 2016) (Paper 10), Case IPR2015-01997 (PTAB Jan. 28, 2016) (Paper 10), Case IPR2015-02003 (PTAB Jan. 28, 2016) (Paper 10), Case IPR2015-02004 (PTAB Jan. 28, 2016) (Paper 10), Case IPR2016-00116 (PTAB Jan. 28, 2016) (Paper 9), Case IPR2016-00129 (PTAB Jan. 28, 2016) (Paper 9), Case IPR2016-00155 (PTAB Jan. 28, 2016) (Paper 9), Case IPR2016-00161 (PTAB Jan. 28, 2016) (Paper 9), and Case IPR2016-00173 (PTAB Jan. 28, 2016) (Paper 9) (collectively, “the Stay Orders”).

³ Petitioner was represented in the telephone conference by William Mandir, Brian Shelton, and Teena-Ann Sankoorikal; and Patent Owner was represented by Robert Sterne, Jason Eisenberg, and Joseph Mutschelknaus.

⁴ Case IPR2015-01995 (PTAB Apr. 4, 2016) (Paper 14), Case IPR2015-01997 (PTAB Apr. 7, 2016) (Paper 14), Case IPR2015-02003 (PTAB Mar. 31, 2016) (Paper 15), Case IPR2015-02004 (PTAB Mar. 31, 2016) (Paper 14), Case IPR2016-00116 (PTAB May 4, 2016) (Paper 14), Case IPR2016-00129 (PTAB May 3, 2016) (Paper 13), Case IPR2016-00155 (PTAB Apr. 28, 2016) (Paper 14), Case IPR2016-00161 (PTAB May 12, 2016) (Paper 16), and Case IPR2016-00173 (PTAB May 10, 2016) (Paper 14).

Cases IPR2015-01995, IPR2015-01997, IPR2015-02003, IPR2015-02004, IPR2016-00116, IPR2016-00129, IPR2016-00155, IPR2016-00161, and IPR2016-00173 (Patents 6,147,601, 6,462,654 B1, 6,535,123 B2, and 6,717,513 B1)

Institution that only granted review based on a subset of the challenged claims in Case IPR2016-00161, as well as its intention to file additional petitions for *inter partes* review of certain claims subject to Patent Owner's Requests for Certificates of Correction. Petitioner also repeated its previous position that certain changes sought in Patent Owner's Requests for Certificates of Correction are not properly characterized as "corrections" within the meaning of 35 U.S.C. § 255.⁵ Patent Owner indicated that it does not oppose lifting of the stay of its Requests for Certificates of Correction.

With regard to Petitioner's initial objections, Petitioner conceded, however, that its request for rehearing would not turn on whether or not the requested corrections are entered,⁶ as well as that it could address the corrected claim language in any additional petitions filed. Accordingly, Petitioner withdrew its initial objection. Further, we explained that we are not persuaded that Petitioner's argument under § 255 warrants further maintenance of the stay. The Certificate of Corrections Branch of the Office

⁵ See Case IPR2015-01995 (Paper 12, 1–4), Case IPR2015-02003 (Paper 12, 1–3), Case IPR2015-02004 (Paper 12, 2–5), Case IPR2016-00116 (Paper 11, 1–4), Case IPR2016-00161 (Paper 11, 1–3), and Case IPR2016-00173 (Paper 11, 1–4).

⁶ Petitioner's Request for Rehearing has since been filed as Paper 18 in Case IPR2016-00161.

Cases IPR2015-01995, IPR2015-01997, IPR2015-02003,
IPR2015-02004, IPR2016-00116, IPR2016-00129,
IPR2016-00155, IPR2016-00161, and IPR2016-00173
(Patents 6,147,601, 6,462,654 B1, 6,535,123 B2, and 6,717,513 B1)

is equipped to determine the propriety of Patent Owner's Requests for
Certificates of Correction, and we defer to its determination.

Accordingly, it is

ORDERED that the stay of Patent Owner's Requests for Certificates
of Correction with respect to U.S. Patent Nos. 6,147,601, 6,462,654 B1,
6,535,123 B2, and 6,717,513 B1, imposed by our Stay Orders dated January
28, 2016, hereby is lifted; and

FURTHER ORDERED that said Requests are returned to the
jurisdiction of the Certificate of Corrections Branch of the Office for
processing in due course.

Cases IPR2015-01995, IPR2015-01997, IPR2015-02003,
IPR2015-02004, IPR2016-00116, IPR2016-00129,
IPR2016-00155, IPR2016-00161, and IPR2016-00173
(Patents 6,147,601, 6,462,654 B1, 6,535,123 B2, and 6,717,513 B1)

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