

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

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ALARM.COM INCORPORATED  
Petitioner

v.

VIVINT, INC.  
Patent Owner

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Case IPR2016-00116  
Patent 6,147,601

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**PETITIONER'S OPENING BRIEF ON REMAND**

Mail Stop PATENT BOARD  
Patent Trial and Appeal Board  
US Patent and Trademark Office  
P.O. Box 1450  
Alexandria, VA 22313-1450

The Board's Final Written Decision ("FWD") found claims 26, 27, 28, 33, 34, 35 and 36 of U.S. Patent No. 6,147,601 (the "'601 Patent") patentable solely on the basis that (1) the broadest reasonable interpretation of "communication device identification codes" ("CDICs") *excluded* email addresses and telephone numbers, and (2) based on that construction, prior art U.S. Patent No. 5,808,907 ("Shetty") did not disclose CDICs. On appeal, the Court of Appeals for the Federal Circuit ("Federal Circuit") expressly reversed the Board's construction. There is no dispute that Shetty discloses email addresses and telephone numbers. Patent Owner Vivint, Inc. ("Vivint") has raised no other basis to distinguish the limitations of dependent claims 26, 27, 28, 33, 34, 35 and 36 over Shetty, and the unpatentability of their parent claim 22 has been affirmed on appeal. Therefore Petitioner Alarm.com Incorporated ("Alarm.com") respectfully submits that the Board should now find claims 26, 27, 28, 33, 34, 35 and 36 unpatentable.

## **I. BACKGROUND**

On October 30, 2015, Alarm.com filed a request for *inter partes* review ("IPR") of certain claims of the '601 Patent. (Paper 1.) On May 4, 2016, the Board instituted IPR of the '601 Patent as to claims 1 and 22 and several claims that depend, directly or indirectly, from those two independent claims. (Paper 14.) On August 2, 2016, Vivint filed a Patent Owner Response. (Paper 20.) As to claims 26, 27, 28, 33, 34, 35 and 36, the only argument Vivint made for

patentability, apart from its arguments for the patentability of their parent claim 22, was that Shetty did not disclose CDICs. Response, 37-39. The Board held a hearing in this IPR on January 31, 2017. (Paper 38.)

On May 2, 2017, the Board issued its FWD, finding many of the challenged claims unpatentable. (Paper 39.) Notably, for purposes of this remand, the Board determined that independent claim 22 was unpatentable because it would have been obvious in view of Shetty, rejecting all of Vivint’s arguments for patentability. FWD, 50.

However, the Board found claim 26 (which depends from claim 22) and claims 27, 28, 33, 34, 35 and 36 (all of which depend from claim 26) patentable. FWD, 70. The Board first construed the term CDIC in claim 26 as “referring to a device ID or a serial number capable of uniquely identifying communication devices” and rejected Alarm.com’s position that email addresses and telephone numbers should also be included in the construction. *Id.* at 20. The Board then applied its construction of CDIC to Shetty, reasoning that “Shetty’s telephone numbers and email addresses are not consistent with this construction [of CDICs] because they do not identify uniquely a specific device”. *Id.* at 52, 58, 62.

Both parties appealed aspects of the FWD to the Federal Circuit. (Papers 40, 41.) On December 20, 2018, the Federal Circuit issued an opinion (the “Opinion”) affirming the FWD in all respects, except as to the claim term CDICs. (Paper 42.)

The Board’s conclusion that claim 22 is unpatentable in view of Shetty was upheld on appeal and is not at issue on remand. With respect to the term CDIC in claim 26, the Federal Circuit held that “the Board’s conclusion that a phone number or email address cannot uniquely identify a communication device defies the . . . teachings” of the ’601 Patent. *Op.*, 9. Accordingly, the Federal Circuit reversed the Board’s construction of CDIC, vacated the related conclusions and remanded for further consideration consistent with the Opinion. *Id.* at 15.

On February 27, 2019, the Board held a conference call with the parties regarding the procedure on remand. On March 1, 2019, the Board issued an order instructing, among other things, that “all briefing must be narrowly tailored to address whether the asserted prior art teaches or suggests the claim term [CDIC] of the ’601 . . . patent[ ], as construed by the Federal Circuit”. Order Outlining Briefing Schedule Post-Remand, Paper 44 at 5.

## **II. ARGUMENT**

This remand is directed to a single issue: “whether the asserted prior art teaches or suggests the claim term [CDIC] of the ’601 . . . patent[ ], as construed by the Federal Circuit”.

### **A. The Federal Circuit’s Interpretation of CDIC**

In the FWD, the Board determined that the “the broadest reasonable interpretation of the claim term [CDIC] includes either a device ID (*e.g.*, a [mobile

identification number]) or a serial number of a device (*e.g.*, an [electronic serial number])”. FWD, 21. The Board also found that the specification and claims of the ’601 Patent required the interpretation of CDIC to exclude email addresses and telephone numbers. *Id.* at 20. On appeal, however, the Federal Circuit ruled that the Board erred in excluding email addresses and telephone numbers from its interpretation of CDIC. *Op.*, 8-9. In particular, the Federal Circuit noted the ’601 Patent teaches that “a mobile identification number refers to a device in the same way that a phone number refers to a cellular phone, *i.e.* a communication device” (*id.* at 9, citing ’601 Patent, 6:61-65) and that “an email address is used to identify a certain communication device” (*id.* at 9 n.4, citing ’601 Patent, 6:7-23).

In view of the Federal Circuit’s ruling, the broadest reasonable interpretation of CDIC must include email addresses and telephone numbers. Alarm.com therefore proposes that CDIC be construed as “an identifier (such as a device ID, serial number, telephone number, or email address) capable of identifying a communication device”.<sup>1</sup>

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<sup>1</sup> This construction of CDIC is identical to the construction to which Vivint and Alarm.com have agreed in the related District Court litigation. *See* Joint Notice of Stipulated Claim Construction Term, *Vivint, Inc. v. Alarm.com Inc.*, No. 2:15-cv-00392-CW (D. Utah), ECF No. 261 (Mar. 22, 2019).

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