UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

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ALARM.COM INC.
Petitioner

v.

VIVINT, INC.
Patent Owner

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Case IPR2016-00116
Patent 6,147,601

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

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US Patent and Trademark Office
P.O. Box 1450
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Petitioner Alarm.com respectfully submits this reply 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 the Petition—

namely, whether the prior art in the Petition discloses the proposed change.

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

Vivint, Inc. ("Vivint") seeks to change "which said normal status" to "which

a normal status" in claim 39 of the 6,147,601 (the "'601 Patent" or "Patent").

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." Neither ground applies here.

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 the preceding

language in claim 39, neither of the claims from which claim 39 depends (claims

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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. Also, 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 results in claim 39 reciting the contradictory conditions of an exception condition and a normal condition.

Petitioner prepared its Petition assuming a more probable correction that 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 piece of remote

equipment "within a predetermined period of time." Because there is no clearly

evident correction, Vivint's proposed change is not allowable under § 255.

Second, Vivint's proposed change is not of a "minor character" because it

would work a substantive change to the claim, as explained above, and require

Petitioner to alter the basis on which it seeks review for claim 39, as explained in

Part II, *infra*. *See Superior Fireplace*, 270 F.3d at 1375; MPEP § 1480.01 (9th Ed.

Rev. Nov. 2013) (mistake not "'minor' . . . 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 is only proper if

"correction 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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(as discussed above), which were equally or more consistent with the other claims and the Patent, including Petitioner's proposed correction to "exception condition." Furthermore, the prosecution history is silent on the issue, and therefore there would be no way for the public—including Petitioner—to know which possible change reflects the intended scope of the Patent. *See, e.g.*, *Superior Fireplace*, 270 F.3d at 1371 (rejecting corrections "public could not discern from the public file").

II.   Assessment of Effect of Proposed Correction on Petition

Petitioner believes Vivint's proposed change cannot be viewed as a correction, including because Petitioner assumed in its Petition a different correction that is more consistent with the specification—specifically, changing "normal status" to "exception." However, if the Board disagrees, Petitioner contends that the prior art it previously identified also discloses a "normal status message." As discussed in Ground 3 of the Petition (pp. 41-42), Britton recites a "check-in message" that indicates that a particular piece of monitored equipment is functioning normally. Ex. 1104 at 4:48-51, 7:54-56, 8:7-10, 11:17-21.

Petitioner included claim 39 in Ground 4. For the added "normal status" limitation, Petitioner would cite Britton (*e.g.*, Pet. pp. 41-42 (Ex. 1104 at 4:48-51)). Since Britton is not in Ground 4, Petitioner would remove claim 39 from Ground 4 and include claim 39 in Ground 3 and in a new Ground 5. (*See* table below.) Because it could not anticipate the correction Vivint proposes, Petitioner seeks this

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