

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ALARM.COM INC.,
Petitioner,

v.

VIVINT, INC.,
Patent Owner.

Cases

IPR2016-00116 (Patent 6,147,601)
IPR2016-00161 (Patent 6,462,654 B1)
IPR2016-00173 (Patent 6,535,123 B2)

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

ZECHER, *Administrative Patent Judge*.

ORDER
Outlining Briefing Schedule Post-Remand
37 C.F.R. § 42.5(a)

IPR2016-00116 (Patent 6,147,601)
IPR2016-00161 (Patent 6,462,654 B1)
IPR2016-00173 (Patent 6,535,123 B2)

I. INTRODUCTION

A conference call was held on February 27, 2019, between counsel for the respective parties and Judges Zecher, Arpin, and Boudreau. We initiated the conference call to discuss the procedure on remand following a decision by the U.S. Court of Appeals for the Federal Circuit in *Vivint, Inc. v. Alarm.com Inc.*, Nos. 2017-2218, 2017-2219, 2017-2220, 2017-2260, 2017-2261, 2017-2262, 2018 WL 6720031 (Fed. Cir. Dec. 20, 2018) (non-precedential) (Paper 42).¹ In particular, we discussed whether additional briefing and evidence was necessary to determine whether Petitioner, Alarm.com Inc. (“Alarm.com”), demonstrated that the asserted prior art teaches or suggests the claim term “communication device identification codes,” which is required by claims 26–28, 30, 31, 33–37, 40, and 41 of U.S. Patent No. 6,147,601 (“the ’601 patent), and claims 3–5, 7–12, 14–16, and 18–20 of U.S. Patent No. 6,535,123 B2 (“the ’123 patent”), in light of the Federal Circuit’s construction of that term.²

¹ Unless otherwise noted, we refer to the papers filed in Case IPR2016-00116. The same papers were filed in Cases IPR2016-00161 and IPR2016-00173.

² Although the Federal Circuit recognized that certain claims of U.S. Patent No. 6,462,654 B1 (“the ’654 patent) also require the “communication device identification codes” limitation, it indicated that the proper construction of this claim term in the ’654 patent was “not presented here.” Paper 42, 6 n.3. During the conference call, we explained to the parties that, because of this footnote, we did not view the ’654 patent as falling within the limited scope of this remand. The parties raised no objection and agreed that the ’654 patent would not be subject to this remand. Consequently, our discussion going forward is limited to the claims in the ’601 and ’123 patents that require the “communication device identification codes” limitation.

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II. PROCEDURAL HISTORY

On May 2, 2017, we issued the following: (1) a Final Written Decision for Case IPR2016-00116, in which we determined that Alarm.com demonstrated by a preponderance of the evidence that claims 1, 2, 4, 6, 7, 10–15, 17, 18, 22, 23, 25, 29, and 38 of the '601 patent are unpatentable under 35 U.S.C. § 103(a), but that Alarm.com had not demonstrated by a preponderance of the evidence that claims 5, 8, 9, 19–21, 26–28, 30, 31, 33–37 and 39–41 of the '601 patent were unpatentable (Case IPR2016-00116, Paper 39); and (2) a Final Written Decision for Case IPR2016-00173, in which we determined that Alarm.com demonstrated by a preponderance of evidence that claims 1, 2, 4–6, 10, 13, and 15–17 of the '123 patent are unpatentable under § 103(a), but that Alarm.com had not demonstrated by a preponderance of the evidence that claims 3, 7–9, 11, 12, 14, and 18–20 of the '123 patent are unpatentable under § 103(a) (Case IPR2016-00173, Paper 62). Patent Owner, Vivint, Inc. (“Vivint”), appealed our determinations that certain subsets of claims of the '601 and '123 patents are unpatentable, and Alarm.com cross-appealed our determinations upholding the patentability of certain subsets of claims of the '601 and '123 patents. Case IPR2016-00116, Papers 40, 41; Case IPR2016-00173, 41, 42.

On December 20, 2018, the Federal Circuit affirmed our determinations that certain subsets of claims in the '601 and '123 patent are unpatentable. Paper 42, 2. The Federal Circuit, however, reversed our construction of the claim term “communication device identification codes,” vacated the related conclusions, and remanded for further proceedings consistent with its decision. *Id.* at 2, 15. The Federal Circuit affirmed our determinations upholding the patentability of certain subsets of claims in the '601 and '123 patent in all other respects. *Id.* The Federal Circuit’s mandate issued on January 29, 2019. Paper 43.

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III. DISCUSSION

During the conference call, we inquired as to whether additional briefing and evidence was necessary to determine whether Alarm.com demonstrated that the asserted prior art teaches or suggests the claim term “communication device identification codes,” as construed by the Federal Circuit. *See* Paper 42, 10 (stating “the Board’s conclusion that a phone number and email address cannot uniquely identify a communication device defies the . . . teachings” of the ’601 and ’123 patents). The parties represented that, prior to the conference call, they had met and conferred to discuss this particular issue. The parties proposed the following briefing schedule: (1) Alarm.com be permitted to file a ten page opening brief narrowly tailored to address whether the asserted prior art teaches or suggests the claim term “communication device identification codes,” as construed by the Federal Circuit, due no later than Thursday, March 28, 2019; (2) Vivint be permitted to file a ten page responsive brief due no later than Thursday, April 25, 2019; and (3) Alarm.com be permitted to file a five page reply brief due no later than Thursday, May 9, 2019. The parties also proposed that no new evidence of any kind may be filed with the opening brief, responsive brief, or reply brief.

In addition, Vivint requested a three page sur-reply brief due no later than Thursday, May 16, 2019. In support of its request, Vivint noted the Office Trial Practice Guide Update (Aug. 13, 2018),³ which now permits a patent owner to file a sur-reply as a matter of right. In response, Alarm.com opposed Vivint’s request for a sur-reply because Alarm.com bears the burden of persuasion and, therefore, should be entitled to the last word on this particular issue.

³https://www.uspto.gov/sites/default/files/documents/2018_Revised_Trial_Practice_Guide.pdf

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After a brief deliberation, we accepted the parties' proposed briefing schedule in Cases IPR2016-00116 and IPR2016-00173 because it was consistent with the guidance provided in the Federal Circuit's remand decision. We also granted Vivint's request for a three page sur-reply brief in Cases IPR2016-00116 and IPR2016-00173 because we could discern no reason why the new provision in the Office Trial Practice Guide Update that permits a patent owner to file a sur-reply as a matter of right should not apply to proceedings on remand from the Federal Circuit. As with the other briefing, no new evidence of any kind may be filed with the sur-reply.

IV. ORDER

It consideration of the foregoing, it is

ORDERED that, in Cases IPR2016-00116 and IPR2016-00173,

(1) Alarm.com is authorized to file a ten page opening brief due no later than Thursday, March 28, 2019; (2) Vivint is authorized to file a ten page responsive brief due no later than Thursday, April 25, 2019; and (3) Alarm.com is authorized to file a five page reply brief due no later than Thursday, May 9, 2019;

FURTHER ORDERED that, in Cases IPR2016-00116 and IPR2016-00173, we *grant* Vivint's request to file a three page sur-reply brief due no later than Thursday, May 16, 2019;

FURTHER ORDERED that all briefing must be narrowly tailored to address whether the asserted prior art teaches or suggests the claim term "communication device identification codes" of the '601 and '123 patents, as construed by the Federal Circuit; and

FURTHER ORDERED that no new evidence of any kind may be filed with each opening brief, responsive brief, reply brief, and sur-reply brief.

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