

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ALARM.COM INC.,
Petitioner

v.

VIVINT, INC.
Patent Owner

Case IPR2016-00116
Patent 6,147,601

**PATENT OWNER'S RESPONSE TO PETITIONER'S OPENING
BRIEF ON REMAND**

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U.S. Patent and Trademark Office
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Alexandria, VA 22313-1450

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 A. Shetty does not disclose email addresses or phone numbers, and even if argued they are inherent, Shetty does not disclose they are configured in its user profile database. 5

 B. The Board should refuse Alarm.com’s invitation to make an advisory opinion on claims not at issue in this remand. 10

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I. INTRODUCTION

Alarm.com’s Remand Brief (Paper 47) mischaracterizes the issue on remand by only focusing on what a “communication device identification code” (“CDIC”) might be while ignoring other required claim terms. Also, the **only** question the Board must answer on remand¹ is whether the Petition met the threshold burden of proving by a preponderance of the evidence that the evidence *the Petition points to* in Shetty teaches *all* the required features of claim 26 and its dependent claims 27-28 and 33-36², given the Federal Circuit’s claim interpretation. Claim 26 recites:

a second memory in which communication device identification codes of all of said user-defined communication remote devices are stored, *said communication device identification codes being configured in a plurality of said user-defined message profiles.*

The Petition fails to show that this feature is taught in Shetty.

¹ See Section III.C regarding Alarm.com’s inappropriate request for an advisory opinion by the Board.

² This CDIC limitation is also required by claims 30, 31, 37, 40 and 41, but the CAFC affirmed the Board’s finding of patentability for those claims under an alternate basis.

As Vivint explained in its Patent Owner Response (POR), the claims do not just require that the system include a CDIC. Claim 26 recites that the CDICs are “configured in a plurality of said user-defined message profiles.” The Petition did not prove Shetty taught this feature for at least two reasons. **First**, Shetty does not disclose email addresses or phone numbers. So, at best, the Petition is relying on obviousness by inherency – without providing any legal analysis or evidence to prove that theory. Alarm.com cannot fix those holes in the Petition now. **Second**, even if such addresses and numbers are somehow inherently disclosed by virtue of Shetty’s disclosure of email, pages and faxes as communication methods, Shetty is silent on *where* such email addresses and phone numbers *are stored* or *what* they identify. Thus, Shetty does not (and cannot) disclose CDICs “configured in a plurality of said user-defined message profiles” as required by claim 26.

II. STATEMENT OF FACTS

Alarm.com’s IPR petition was the second of five serial attacks that Alarm.com brought on the ’601 patent, including four IPRs and one currently-pending ex parte reexamination, in which Vivint recently filed a notice of appeal to this Board. *See* IPR2015-02004; IPR2016-00155; IPR2016-01080; Control No. 90/014,007.

The entirety of the Petition’s analysis for claim 26 is reproduced below:

Claim 26	Shetty
A system according to claim 22, said system monitoring a plurality of pieces of equipment, each piece having an identification code, said server further comprising:	See chart for claim 22, Ground 1. “A fleet and machine database means 104 contains <i>information defining a fleet of similar or commonly owned or operated machines.</i> ” Ex. 1103 at 2:12-16; <i>see also id.</i> at FIG. 1.
[26a] a first memory on which equipment identification codes of all monitored equipment are stored;	See chart for claim 26 (preamble), Ground 1.
[26a] a second memory in which communication device identification codes of all of said user-defined communication remote devices are stored, said communication device identification codes being configured in a plurality of said user-defined message profiles.	“A <i>user profile database</i> 106 contains information relating to all users of the data manager including a <i>user profile ...</i> ” Ex. 1103 at 2:18-19; <i>see also id.</i> at FIG. 1; 2:49-61. See chart for claim 1(c), Ground 1.

(Petition, 26.) Claims 27, 28 and 33-36 depend from claim 26, and Alarm.com’s analysis for those claims essentially just refers back to claim 26. (Petition, 27, 38, 55.) Claim 26 recites that the claimed server includes a second memory in which “communication device identification codes of all of said user-defined communication remote devices are stored.” It also recites that the “communication device identification codes [are] configured in a plurality of said user-defined message profiles.” As the claim chart above illustrates, Alarm.com relies entirely on Shetty for these elements.

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