

UNITED STATES PATENT AND TRADEMARK OFFICE

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

BOUDREAU, *Administrative Patent Judge*.

FINAL WRITTEN DECISION  
*Inter Partes* Review  
35 U.S.C. § 318(a) and 37 C.F.R. § 42.73

## I. INTRODUCTION

Alarm.com Incorporated (“Alarm.com”) filed a Petition (Paper 1, “Pet.”) requesting an *inter partes* review of claims 1, 2, 4–23, 25–31, and 33–41 of U.S. Patent No. 6,147,601 (Ex. 1101, “the ’601 patent”), owned by Vivint, Inc. (“Vivint”). Pet. 3.<sup>1</sup> On May 4, 2016, we issued a Decision granting institution of *inter partes* review of claims 1, 2, 4–15, 17–23, 25–31, and 33–41 of the ’601 patent. Paper 14 (“Dec. on Inst.”), 46. Vivint then filed a Patent Owner’s Response (Paper 20, “PO Resp.”), and Alarm.com filed a Reply (Paper 26, “Pet. Reply”). A consolidated hearing for the instant proceeding and related Cases IPR2016-00161 and IPR2016-00173 was held on January 31, 2017. A transcript of that hearing is included in the record. Paper 38 (“Tr.”).

We have jurisdiction under 35 U.S.C. § 6, and we issue this Final Written Decision pursuant to 35 U.S.C. § 318(a) and 37 C.F.R. § 42.73. For the reasons discussed below, we determine that Alarm.com has met its burden to prove by a preponderance of the evidence that claims 1, 2, 4, 6, 7,

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<sup>1</sup> On December 17, 2015, after Alarm.com’s filing of the Petition, Vivint filed a Request for Certificate of Correction with respect to the ’601 patent, seeking to correct an alleged mistake in claim 39. Ex. 2003 (“Request”), 3. By Order, pursuant to 37 C.F.R. § 42.3, dated January 28, 2016, we stayed the Request pending our decision on the Petition and the petitions filed in Cases IPR2015-02004 and IPR2016-00155 also involving the ’601 patent, and we also authorized Alarm.com to file a Brief limited to addressing certain issues related to the requested Certificate of Correction. *See* Paper 9 (“Order”). Alarm.com filed its Brief shortly before Vivint filed a Preliminary Response in this case. Paper 11 (“Pet. Brief”). On June 1, 2016, we lifted the stay of the Request (Paper 16), and the Certificate of Corrections Branch of the Office subsequently denied the Request (Ex. 3001).

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10–15, 17, 18, 22, 23, 25, 29, and 38 of the '601 patent are unpatentable on the grounds upon which we instituted *inter partes* review, but that Alarm.com has not proven by a preponderance of the evidence that claims 5, 8, 9, 19–21, 26–28, 30, 31, 33–37, and 39–41 are unpatentable.

## II. BACKGROUND

### A. *Related Proceedings*

The '601 patent is the subject of a district court action between the parties titled *Vivint, Inc. v. Alarm.com Inc.*, 2:15-cv-00392-CW-BCW (D. Utah 2015). Pet. 1; Paper 8, 2. Alarm.com also filed three other petitions challenging certain claims of the '601 patent (Cases IPR2015-02004, IPR2016-00155, and IPR2016-01080), and fourteen petitions challenging certain claims of the following other patents owned by Vivint: (1) U.S. Patent No. 6,462,654 B1 (Cases IPR2015-02003, IPR2016-00161, IPR2016-01110, and IPR2016-01124); (2) U.S. Patent No. 6,535,123 B2 (Cases IPR2015-01995, IPR2016-00173, and IPR2016-01126); (3) U.S. Patent No. 6,717,513 B1 (Cases IPR2015-01997, IPR2016-00129, and IPR2016-01091); (4) U.S. Patent No. 6,924,727 B2 (Cases IPR2015-01977 and IPR2015-02008); and (5) U.S. Patent No. 7,884,713 B1 (Cases IPR2015-01965 and IPR2015-01967). Paper 17, 2–3; Paper 18, 1–2.

### B. *The '601 Patent*

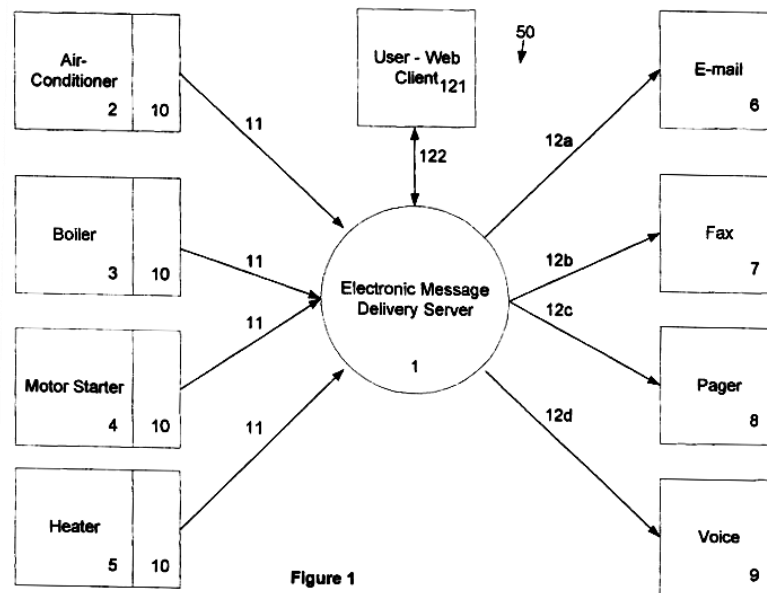
The '601 patent, titled “Electronic Message Delivery System Utilizable in the Monitoring of Remote Equipment and Method of Same,” issued November 14, 2000, from U.S. Patent Application No. 09/317,235, filed May 24, 1999. Ex. 1101, at [21], [22], [45], [54]. The '601 patent also

claims the benefit of U.S. Provisional Application No. 60/115,305, filed January 9, 1999 (“the ’305 provisional”). *Id.* at [60], 1:6–7.

The ’601 patent describes systems and methods for monitoring remote equipment such as “devices . . . employed in heating, ventilating, and [air conditioning] (HVAC) systems.” Ex. 1101, Abstract, 1:11–14. The ’601 patent explains that “[i]t is desirable to be able to monitor remotely equipment that may require periodic preventive maintenance and/or that may require rapid response time should a catastrophic failure occur.” *Id.* at 1:15–18. According to the ’601 patent, prior art systems were limited insofar as they did not “allow for sufficient flexibility in routing fault messages to a variety of different potential recipients of such messages via a variety of different media, depending on the urgency or nature of the fault.” *Id.* at 1:66–2:3. The ’601 patent provides, as an example, that an HVAC customer may want to send “certain non-emergency condition notifications (e.g., filter needs cleaning) to certain individuals (e.g., contractor/maintenance personnel) via a certain medium (e.g., e-mail) and emergency condition notifications (e.g., low or high refrigerant pressure) to other individuals (building owner, contractor, etc.) via other means (e.g., via beeper or other personal communication device).” *Id.* at 2:5–14. “Such a list of who to contact via what means depending on which fault has occurred may be referred to as a ‘message profile.’” *Id.* at 2:14–16. According to the ’601 patent, conventional systems did not allow for “easy customer modifications to the message profile.” *Id.* at 2:21–22.

The ’601 patent purportedly solves these problems by describing a system for remotely monitoring electrical or mechanical equipment that can deliver fault notification messages to different individuals for different fault

conditions via different electronic media, and in which a customer may modify its message profile interactively. Ex. 1101, 2:33–41. Figure 1 of the '601 patent, reproduced below, illustrates a schematic diagram of the preferred embodiment of this system. *Id.* at 3:24–25, 5:38–39.



As shown in Figure 1, system 50 monitors existing pieces of electronic equipment, such as air-conditioner 2, boiler 3, motor starter 4, heater 5, or any other equipment that a prospective user desires to monitor. Ex. 1101, 5:39–42. Each piece of equipment is fitted with interface 10 that periodically sends a status signal to electronic message delivery server 1 indicating whether the piece of equipment and its corresponding interface are functioning correctly. *Id.* at 5:43–47. When a predetermined “exception” condition, e.g., a fault condition, occurs in a piece of equipment being monitored, interface unit 10 sends a message to electronic message delivery server 1. *Id.* at 5:47–51. Electronic message delivery server 1 then routes the message to the appropriate user interface, such as e-mail 6, fax 7,

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