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Paper No. 14
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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

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

BOUDREAU, *Administrative Patent Judge.*

DECISION
Institution of *Inter Partes* Review
35 U.S.C. § 314(a) and 37 C.F.R. § 42.108

I. INTRODUCTION

Alarm.com Incorporated ("Petitioner") 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"). Pet. 3. Vivint, Incorporated ("Patent Owner") filed a Preliminary Response. Paper 12 ("Prelim. Resp.").[1] We review the Petition under 35 U.S.C. § 314, which provides that an *inter partes* review may not be instituted "unless . . . there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition." 35 U.S.C. § 314(a).

For the reasons that follow, and on this record, we are persuaded that Petitioner demonstrates a reasonable likelihood of prevailing in showing the unpatentability of claims 1, 2, 4–15, 17–23, 25–31, and 33–41 of the '601 patent. We, however, are not persuaded that Petitioner demonstrates a reasonable likelihood of prevailing in showing the unpatentability of claim 16 of the '601 patent. Accordingly, we institute an *inter partes* review only as to claims 1, 2, 4–15, 17–23, 25–31, and 33–41 of the '601 patent.

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[1] On December 17, 2015, after Petitioner's filing of the Petition, but before Patent Owner's filing of the Preliminary Response, Patent Owner 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 dated January 28, 2016, we stayed the Request, pursuant to 37 C.F.R. § 42.3, pending our decision on this Petition and the related petitions in Cases IPR2015-02004 and IPR2016-00155, and we also authorized Petitioner to file a Brief limited to addressing certain issues related to the requested Certificate of Correction. *See* Paper 9 ("Order"). Petitioner filed its Brief shortly before Patent Owner filed its Preliminary Response. Paper 11 ("Pet. Brief").

A. The '601 Patent

The '601 patent, entitled "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 1:16–19. 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 disclosing 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.

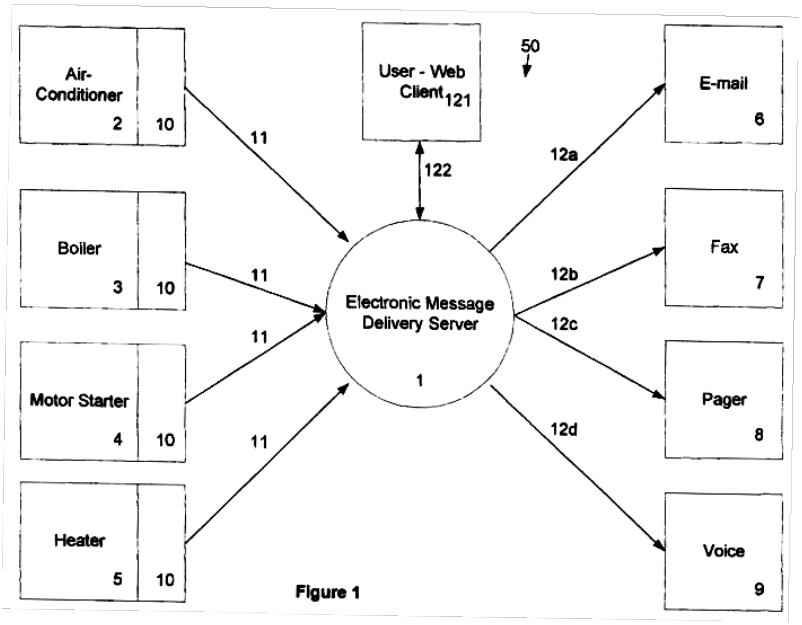

Figure 1

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, pager 8, voice 9, etc., according to a message profile configured by the user via user-web client 121 connected to Internet 122. *Id.* at 5:51–55.

In the described systems and methods, a sensor in communication with a piece of remote equipment determines the state of at least one parameter of the remote equipment. Ex. 1101, 2:48–50, 55–56. When the sensor detects an "exception" condition (i.e., an operating condition that is either out of the ordinary or beyond nominal parameters) in the remote equipment, an interface unit connected to the sensor and having a message generating mechanism generates an incoming exception message and forwards the message to a central computer server. *Id.* at 2:56–65. The server forwards at least one outgoing exception message to at least one predetermined user-defined end device based on the incoming exception message. *Id.* at 2:65–67.

B. 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. In addition to this Petition, Petitioner also filed two other petitions challenging certain claims of the '601 patent (Cases IPR2015-02004 and IPR2016-00155). In those cases, after taking into account the arguments presented in the preliminary responses filed by Patent Owner, we concluded that the information presented in the petitions did not establish that there was a reasonable likelihood that Petitioner would

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