

UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE PATENT TRIAL AND APPEAL BOARD

ALARM.COM INCORPORATED
Petitioner

v.

VIVINT, INC.
Patent Owner

Case IPR2016-00116
Patent 6,147,601

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

Mail Stop PATENT BOARD
Patent Trial and Appeal Board
US Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

The *only* argument Vivint made in its Patent Owner's Response concerning CDICs was that email addresses and telephone numbers are not CDICs. If the Board had decided that issue in favor of Alarm.com, the relevant claims would have been found unpatentable. The Federal Circuit reversed on the CDIC interpretation issue. Therefore the relevant claims must now be held unpatentable.

The arguments Vivint presents on remand are entirely new. As such, all of Vivint's arguments have been waived. Scheduling Order, Paper 15 at 3 ("any arguments for patentability not raised in the response will be deemed waived"); *see also Broad Ocean Techs., LLC v. NIDEC Motor Corp.*, IPR2015-01617, Paper 70 at 36 (P.T.A.B. April 25, 2019) (noting "new and materially different argument[s]" are "improper" on remand).

If the Board considers Vivint's belated, improper arguments, they must be rejected. Vivint's contentions consist solely of unsubstantiated attorney arguments that are flatly inconsistent with the Board's prior findings and the record evidence.

I. ARGUMENT

Vivint argues that although Shetty discloses sending email messages and fax messages, the reference fails to disclose (1) email addresses or telephone numbers, or (2) that email addresses and telephone numbers are configured in message profiles. Patent Owner's Resp. to Pet'r's Opening Br. on Remand, 2 ("Resp. Br."). These contentions are untenable.

Disclosure of email addresses and phone numbers. Vivint asserts that

“Shetty mentions page, email, and fax modes of communication, but does not mention email *addresses* or phone *numbers* at all.” *Id.* at 5 (emphasis in original).

But, of course, the Board has already recognized that email addresses and telephone numbers are disclosed in Shetty. *See* Final Written Decision, Paper 39 at 52 (discussing “Shetty’s telephone numbers and email addresses”) (“FWD”). The relevant claims were held patentable only because the Board found that Shetty’s telephone numbers and email addresses did not meet its interpretation of CDIC.

Id.

In any event, Vivint’s argument amounts to a contention that a prior art reference can only disclose an element if it does so in *ipsissimis verbis*—which is not the proper test for obviousness. *Google Inc. v. Intellectual Ventures II LLC*, 701 F. App’x 946, 953 (Fed. Cir. 2017) (vacating finding of patentability where alleged lack of disclosure was based on a “word search” of the prior art); *see also In re Gleave*, 560 F.3d 1331, 1334 (Fed. Cir. 2009) (explaining that a “reference need not satisfy an *ipsissimis verbis* test” to disclose a claim limitation). A prior art reference “must be considered not only for what it expressly teaches, but also for what it fairly suggests” to one skilled in the art. *In re Burckel*, 592 F.2d 1175, 1179 (C.C.P.A. 1979); *see also In re Preda*, 401 F.2d 825, 826 (C.C.P.A. 1968) (“[I]t is proper to take into account not only specific teachings of the reference but

also the inferences which one skilled in the art would reasonably be expected to draw therefrom.”).

Here, the evidence demonstrates that one skilled in the art would understand Shetty’s disclosures to teach or suggest the use of email addresses and telephone numbers to identify devices that are to receive email, pager and fax notifications. Both parties’ experts properly reviewed Shetty from the perspective of one having ordinary skill in the art, and came to the inescapable conclusion that Shetty taught the use of email addresses and telephone numbers to send notifications.

Indeed, it is undisputed that to send an email message one must use an email address, and to send a fax or pager message, one must use a telephone number. Alarm.com’s expert, Mr. Zatarain, explained that Shetty’s profiles were customized with the “operator’s email address, pager number, or fax number”. Ex. 1130 ¶ 48; *see also id.* at ¶¶ 143, 151, 157, 162, 163, 164. Vivint’s expert, Mr. Denning, agreed that “for Shetty’s notification means to send out notifications”, email addresses and telephone numbers “would have to be stored”. Ex. 1118, 48:13-18; *see also* Ex. 2010 ¶¶ 130, 131.

Storage of email addresses and telephone numbers in message profiles.

Vivint contends that “Shetty does not (and cannot) disclose CDICs ‘configured in a plurality of said user-defined message profiles’ as required by claim 26.” Resp. Br., 2. But, in fact, the Board has already found that “Shetty’s user profile . . .

specifies at least one communication device (*e.g.*, device capable of receiving email, pager, fax, etc.) to which an outgoing message is routed”. FWD, 50. Vivint made no argument to the contrary in the prior proceedings and cannot now revisit the Board’s finding. Combined with the Federal Circuit’s ruling that email addresses and telephone numbers are CDICs, the Board’s finding forecloses Vivint’s belated contention.

In any event, the record evidence fully supports that email addresses and telephone numbers are stored in the user profiles in Shetty’s user profile database. Shetty discloses a user profile database that “contains information relating to all users of the data manager including a user profile”, and that the user profiles define the “method of notification”. Ex. 1103, 2:18-21; 2:43-45. The reference further explains that “if the conditions of an alias for a particular user are met then *the user is notified, as defined in the user profile*”. *Id.* at 3:16-18 (emphasis added). Thus, contrary to Vivint’s assertion that Shetty is silent (Resp. Br., 7), in actuality Shetty explains that the information about *how* a user is notified is defined in the user profiles contained in the user profile database. Alarm.com’s expert, Mr. Zatarain, relied on Shetty’s disclosures in identifying the user profile database as the claimed “memory” where the CDICs are stored and configured in user-defined message profiles. Ex. 1107, 55. Mr. Zatarain also explained Shetty’s user profiles in detail (Ex. 1130 ¶¶ 44-50), including the fact that email addresses and telephone

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