UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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ALARM.COM INCORPORATED,
Petitioner

v.

VIVINT, INC.
Patent Owner

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Case IPR2016-00116
U.S. Patent No. 6,147,601

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**PATENT OWNER'S SUR-REPLY TO PETITIONERS' REPLY TO
PATENT OWNER'S RESPONSE BRIEF ON REMAND**

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In its principal brief, Vivint established that Shetty fails to teach a CDIC configured in a message profile as claimed. (Paper 51, *passim*.) In its Reply, Alarm.com argues that (i) Vivint's arguments are waived, (ii) Vivint is asking too much of Shetty, and (iii) Alarm.com's declarant fills any holes that may exist in Shetty's disclosure. (Paper 52, *passim*.) Alarm.com's arguments fail.

I.   The arguments Vivint presented on remand are not waived, and it is appropriate and necessary for the Board to consider them.

In its Response, Alarm.com contends that "[t]he only argument Vivint made in its Patent Owner's Response concerning CDICs was that email addresses and telephone numbers are not CDICs." (*Id.*, 1.) To the contrary, however, the POR argued that "there is nothing in Shetty to suggest that Shetty's different modes of communication correspond to specific remote devices, ***nor that they are represented by identification codes within the [profile] database***." (POR, Paper 20, 37 (emphasis added).) Vivint quoted from this portion of the POR in its principal brief on remand (Paper 51, 4), yet Alarm.com did not explain why this argument in the POR did not preserve the argument presented here.

In its earlier decision, the PTAB didn't need to reach the issue of whether Shetty taught email addresses or telephone numbers as being configured in the user profile database, because the PTAB found that, even if they were, they were not CDICs as claimed. In the prior proceeding, the PTAB stated that email addresses and phone numbers do not qualify as CDICs "because they do not identify

uniquely a specific device." (FWD, 52.) Therefore, the Board held that "Shetty

does not teach or suggest the recited 'communication device identification codes'"

and thus did not need to determine whether such addresses and phone numbers are

disclosed in Shetty as being "configured in a plurality of said user-defined message

profiles" as claimed. (*Id.*, 17, 52.) On appeal, the Federal Circuit reversed the

PTAB's conclusion that CDIC excludes email addresses and phone numbers.

(CAFC Decision, 9-11.) The Federal Circuit did not address the issue of whether

such addresses and phone numbers, if they did exist in Shetty, are "configured in a

plurality of said user-defined message profiles" as claimed. Rather, the Federal

Circuit asked the Board to answer that question on remand.

II.   Shetty lacks explicit disclosure of email and telephone numbers, let alone where they are stored.

Alarm.com argues that Vivint is requiring Shetty to provide disclosure

ipsissimis verbis, or in the same words. (Paper 52, 2.) That is untrue. For example,

Vivint is not arguing that Shetty's "user profile" is not the '601 patent's "message

profile" because the two documents use different words. That said, to teach the

claims, Shetty must still have words stating that its user profile configures a CDIC.

As described in Vivint's principal brief, Shetty's statement that the "'[u]ser profile

defines … the method of notification'… (*Id.*, 2:43-45)," only teaches that the

profile defines the method of notification, that is, whether to use email, page, or

fax. (Paper 51, 4.) Alarm.com's argument claiming that "[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" implicitly acknowledges that Shetty lacks an explicit disclosure of email addresses or phone numbers. (Paper 52, 2.) Shetty never teaches that CDICs are configured in the message profile as claimed.

III. Neither Alarm.com nor its declarant provide basis for obviousness or inherency.

Lacking explicit disclosure, Alarm.com turns to testimony from its declarant, not offered with the Petition, but improperly late in the proceeding with Alarm.com's reply. (*Id.*, 3, 5; *see also* 2018 Trial Practice Guide Update, 14.) But, none of this testimony establishes what is needed for Alarm.com to show that such a feature is inherent or obvious over Shetty. For inherency, Alarm.com's declarant would need to show that configuring the CDICs in Shetty's user profile is somehow a "necessary feature or result" of Shetty. *Toro Co. v. Deere & Co.*, 355 F.3d 1313, 1321 (Fed. Cir. 2004). For obviousness, Alarm.com's declarant would need to provide an articulated reason why a skilled artisan would modify Shetty to include CDICs configured in its user profile. *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398 (2007). The cited testimony fails to do either. Thus, Alarm.com has not shown that a CDIC configured in a message profile is disclosed in or obvious over Shetty.

IV. Conclusion

For these reasons, the CDIC claims are patentable over Shetty.

Respectfully submitted,

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