

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 ON REMAND
Inter Partes Review
35 U.S.C. § 144 and 37 C.F.R. § 42.5(a)

I. BACKGROUND

A. Introduction

We address this case on remand after a decision by the U.S. Court of Appeals for the Federal Circuit in *Vivint, Inc. v. Alarm.com Inc.*, 754 F. App'x 999 (Fed. Cir. 2018) (*see* Paper 42).

As background, Petitioner, Alarm.com Inc. (“Alarm.com”), filed a Petition 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”). Paper 1 (“Pet.”).¹ Patent Owner, Vivint, Inc. (“Vivint”), filed a Preliminary Response. Paper 12. Taking into account the arguments presented in Vivint’s Preliminary Response, we determined that the information presented in the Petition established that there was a reasonable likelihood that Alarm.com would prevail in challenging claims 1, 2, 4–15, 17–23, 25–31, and 33–41 of the ’601 patent as unpatentable under 35 U.S.C. § 103(a). Pursuant to 35 U.S.C. § 314, we instituted this *inter partes* review on May 4,

¹ 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 dated January 28, 2016, we stayed the Request, pursuant to 37 C.F.R. § 42.3, pending our decision on the Petition and related petitions filed in Cases IPR2015-02004 and IPR2016-00155, 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. Alarm.com filed its Brief shortly before Vivint filed a Preliminary Response in this case. Paper 11. 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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2016, only as to claims 1, 2, 4–15, 17–23, 25–31, and 33–41. Paper 14 (“Dec. on Inst.”).

During the course of trial, Vivint filed a Patent Owner Response (Paper 20, “PO Resp.”), and Alarm.com filed a Reply to the Patent Owner Response (Paper 26, “Pet. Reply”). Vivint also filed a Motion for Observation regarding certain cross-examination testimony of Alarm.com’s reply declarant, Arthur Zatarain, PE (Paper 32), and Alarm.com filed a Response to Vivint’s Motion for Observation (Paper 34). A consolidated oral hearing with Cases IPR2016-00161 and IPR2016-00173 was held on January 31, 2017, and a transcript of the hearing is included in the record. Paper 38.

On May 2, 2017, we issued a Final Written Decision in this proceeding in accordance with 35 U.S.C. § 318(a) and 37 C.F.R. § 42.73. Paper 39 (“Final Dec.”). We were persuaded that Alarm.com demonstrated by a preponderance of the evidence that claims 1, 2, 4, 6, 7, 10–15, 17, 18, 22, 23, 25, 29, and 38 of the ’601 patent are unpatentable under § 103(a), but that Alarm.com had not demonstrated by a preponderance of the evidence that claims 5, 8, 9, 19–21, 26–28, 30, 31, 33–37, and 39–41 of the ’601 patent are unpatentable under § 103(a). Final Dec. 69–70. Vivint appealed our determinations that claims 1, 2, 4, 6, 7, 10–15, 17, 18, 22, 23, 25, 29, and 38 are unpatentable to the Federal Circuit, and Alarm.com cross-appealed our determinations upholding the patentability of claims 5, 8, 9, 19–21, 26–28, 30, 31, 33–37, and 39–41. Papers 40, 41.

In its decision on appeal, issued on December 20, 2018, the Federal Circuit affirmed our determinations that claims 1, 2, 4, 6, 7, 10–15, 17, 18,

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22, 23, 25, 29, and 38 are unpatentable and that claims 5, 8, 9, 19–21, 30, 31, 37, and 39–41 were not shown to be unpatentable. *Vivint*, 754 F. App’x at 1002–03. The Federal Circuit, however, reversed our construction of the claim term “communication device identification codes” required by claims 26–28 and 33–36,² vacated the related conclusions, and remanded for further proceedings consistent with its decision. *Id.* at 1003–05. The Federal Circuit’s mandate issued on January 29, 2019. Paper 43.

On March 1, 2019, we issued an Order authorizing post-remand briefing narrowly tailored to addressing whether the asserted prior art teaches or suggests the claim term “communication device identification codes,” as construed by the Federal Circuit. Paper 44, 5. We also indicated that no new evidence of any kind was permitted to be filed. *Id.* In compliance with that Order, Alarm.com filed an opening brief (Paper 47), Vivint filed a responsive brief (Paper 51), Alarm.com filed a reply brief (Paper 52), and Vivint filed a sur-reply brief (Paper 54).

As we explain above, claims 1, 2, 4–15, 17–23, 25, 29–31, and 37–41 are not at issue on remand because the Federal Circuit upheld our determinations with respect to these claims. The only claims that remain for

² Claim 26 recites “communication device identification codes . . . configured in a plurality of said user-defined message profiles.” Ex. 1101, 11:25–29. By virtue of their dependency from claim 26, claims 27, 28, 30, 31, 33–37, 40, and 41 also recite the “communication device identification codes” limitation. The Federal Circuit upheld our determinations of patentability with respect to claims 30, 31, 37, 40, and 41, however, on the alternative basis that the “normal status message [required by those claims is] patentable over the prior art.” *Vivint*, 754 F. App’x at 1006.

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our consideration are claims 26–28 and 33–36, each of which recites the “communication device identification codes” limitation but does not recite the “normal status message” limitation, in view of which the Federal Circuit upheld our determination of patentability of claims 30, 31, 37, 40, and 41 over the prior art of record. *Vivint*, 754 F. App’x at 1006. We have considered the record anew by reviewing the parties’ positions on remand as to whether the asserted prior art teaches or suggests the claim term “communication device identification codes,” as construed by the Federal Circuit. For the reasons discussed below, we hold that Alarm.com has demonstrated by a preponderance of the evidence that claims 26–28 and 33–36 are unpatentable under §103(a).

B. Related Matters

The ’601 patent is involved in a district court case captioned *Vivint, Inc. v. Alarm.com Inc.*, No. 2:15-cv-00392-CW-BCW (D. Utah 2015). Pet. 1; Paper 8, 2. In addition to this Petition, Alarm.com filed three other petitions challenging certain claims of the ’601 patent. *Alarm.com Inc. v. Vivint, Inc.*, Case IPR2015-02004 (PTAB Sept. 30, 2015) (Paper 1); *Alarm.com Inc. v. Vivint, Inc.*, Case IPR2016-00155 (PTAB Nov. 5, 2015) (Paper 1); *Alarm.com Inc. v. Vivint, Inc.*, Case IPR2016-01080 (PTAB May 20, 2016) (Paper 1). In the first two of those cases, after taking into account the arguments presented in the corresponding preliminary responses filed by Vivint, we concluded that the information presented in the petitions did not establish that there was a reasonable likelihood that Alarm.com would prevail in challenging any of the challenged claims on the grounds

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