

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ALARM.COM INC.,
Petitioner,

v.

VIVINT, INC.,
Patent Owner.

Case IPR2016-00155
Patent 6,147,601

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

ZECHER, *Administrative Patent Judge*.

DECISION

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

I. INTRODUCTION

Petitioner, Alarm.com Incorporated (“Alarm.com”), filed a Petition requesting an *inter partes* review of claims 1–3, 22–24, 26, 30, 32, 42, and 43 of U.S. Patent No. 6,147,601 (Ex. 1201, “the ’601 patent”). Paper 1 (“Pet.”). Patent Owner, Vivint, Incorporated (“Vivint”), filed a Preliminary Response. Paper 12 (“Prelim. Resp.”). We also authorized Alarm.com to file a Brief limited to addressing certain aspects of Vivint’s Request for Certificate of Correction for the ’601 patent, which was filed on December 17, 2015. Paper 9. Alarm.com filed its Brief shortly before Vivint filed its Preliminary Response. Paper 11 (“Pet. Brief”).

Under 35 U.S.C. § 314(a), an *inter partes* review may not be instituted unless the information presented in the Petition shows “there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.” Taking into account the arguments presented in Vivint’s Preliminary Response, we conclude that the information presented in the Petition does not establish that there is a reasonable likelihood that Alarm.com would prevail in challenging any of claims 1–3, 22–24, 26, 30, 32, 42, and 43 of the ’601 patent as unpatentable under 35 U.S.C. § 103(a). We, therefore, *deny* the Petition.

A. *Related Matters*

The ’601 patent is involved in a district court case titled *Vivint, Inc. v. Alarm.com Inc.*, No. 2:15-cv-00392-CW-BCW (D. Utah 2015). Pet. 1; Paper 7, 2. In addition to this Petition, Alarm.com filed petitions challenging certain subsets of claims of the ’601 patent in the following two cases: (1) Case IPR2015-02004, Paper 1; and Case IPR2016-00116, Paper

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1. Pet. 1; Paper 7, 1. Alarm.com also filed other petitions challenging the patentability of certain subsets of claims in the following patents owned by Vivint: (1) U.S. Patent No. 6,462,654 B1 (Cases IPR2015-02003 and IPR2016-00161); (2) U.S. Patent No. 6,535,123 B2 (Cases IPR2015-01995 and IPR2016-00173); (3) U.S. Patent No. 6,717,513 B1 (Case IPR2015-01997 and IPR2016-00129); (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). Pet. 1; Paper 7, 1–2.

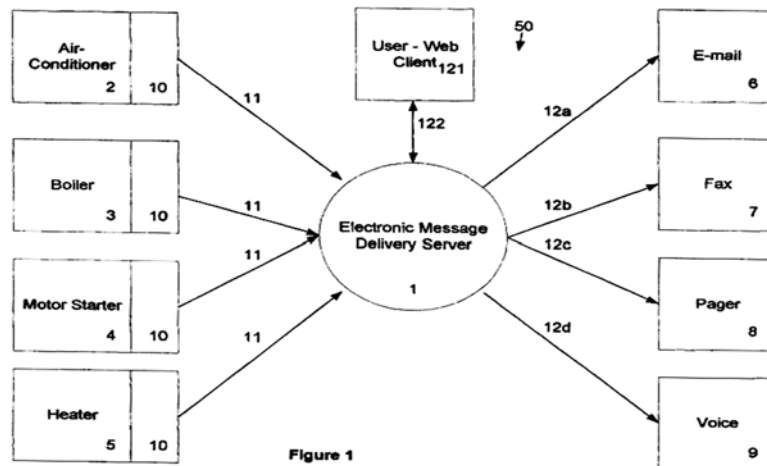
B. The '601 Patent

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. 1201, at [54], [45], [21], [22]. The '601 patent claims the benefit of U.S. Provisional Application No. 60/115,305, filed January 9, 1999. *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. 1201, 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. 1201, 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. 1201, 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 email 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, Fig. 1.

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. 1201, 2:48–50, 2:55–56. 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.

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