

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ONE WORLD TECHNOLOGIES, INC.
D/B/A TECHTRONIC INDUSTRIES POWER EQUIPMENT,
Petitioner

v.

THE CHAMBERLAIN GROUP, INC.
Patent Owner

Case No. IPR2017-00432
Patent No. 7,339,336

PATENT OWNER'S PRELIMINARY RESPONSE

TABLE OF CONTENTS

I. INTRODUCTION.....1

II. STATEMENT OF RELIEF REQUESTED1

III. BACKGROUND OF THE '336 PATENT3

IV. TAKING A PREDETERMINED ACTION WHEN EXCESS FORCE IS BEING APPLIED TO THE MOVABLE BARRIER VIA THE MOVABLE BARRIER OPERATOR. CLAIM CONSTRUCTION.....4

A. “a movable barrier operator that has no user-initiable dedicated learning mode of operation” (Claim 1 preamble).....5

V. PETITIONER FAILS TO DEMONSTRATE AT LEAST ONE CLAIM OF THE '336 PATENT IS UNPATENTABLE9

A. Ground 1 – The Petition fails to establish that any challenged claim is anticipated by Mullet.....10

1. Overview of Mullet.....10

2. Claims 1, 12, 13, 15 – Petitioner impermissibly combines two different embodiments in anticipation.....12

3. Claim 1 – Mullet does not disclose “a movable barrier operator that has no user-initiable dedicated learning mode of operation” (Claim 1).....15

B. Ground 2 - The Petition fails to establish that any challenged claim is obvious over Mullet.....16

1. Claim 1 – Obviousness requires a “reason why” a POSITA would have been motivated to combine the references.....16

2. Claim 1 – Petitioner provides no valid “reason why” a POSITA would modify Mullet17

3. Claim 1 –Mullet would be inoperable without a user-initiable learning mode.....20

..

C. Ground 3 - The Petition fails to establish that any challenged claim is obvious over Mullet in view of Murray21

1. Overview of Murray.....22

2. The Petition does not establish that a POSITA would have been motivated to combine Mullet and Murray in the manner proposed22

3. Petitioner’s proposed combination would render Mullet’s method inoperable.....25

4. The Petition mischaracterizes the teachings of Murray26

VI. CONCLUSION28

I. INTRODUCTION

Pursuant to 37 C.F.R. § 42.107(a), the patent owner, The Chamberlain Group, Inc. (“Patent Owner”), hereby submits the following Preliminary Response in response to the Petition for *Inter Partes* Review (“IPR”) of U.S. Patent No. 7,339,336 (“the ’336 patent”).

The ’336 patent, entitled “Movable Barrier Operator Auto-Force Setting Method and Apparatus,” contains 40 claims, of which claims 1, 7, 12, 15, 27, 34, 37, and 39 are independent. The Petition proposes the following three grounds of unpatentability with respect to claims 1, 7, 11-13, and 15 of the ’336 patent (hereinafter the “Challenged Claims”):

- **Ground 1:** Claims 1, 12, 13, and 15 as allegedly anticipated by Mullet;
- **Ground 2:** Claim 1 as allegedly obvious over Mullet; and
- **Ground 3:** Claims 7 and 11 allegedly obvious over Mullet in view of Murray.

For at least the reasons described herein, the Petition is deficient, and should be denied in whole.

II. STATEMENT OF RELIEF REQUESTED

Patent Owner respectfully requests the Board to deny the Petition for the following reasons:

(1) Ground 1 is deficient as to all challenged claims, because Petitioner impermissibly combines two distinct embodiments from the Mullet reference. Such a showing is legally improper in supporting a finding of anticipation by Mullet. *See, e.g., Symantec Corp. v. RPost Communications Ltd.*, IPR2014-00357, Paper 14 at 20 (citing *In re Arkley*, 455 F.2d 586, 587-88 (CCPA 1972); *Net MoneyIN, Inc. v. VeriSign, Inc.*, 545 F.3d 1359, 1371 (Fed. Cir. 2008)). In addition, Ground 1 is deficient with respect to claim 1 of the '336 patent because Mullet does not teach the preamble limitation reciting “a movable barrier operator that has no user-initiable dedicated learning mode of operation.”

(2) Ground 2 is deficient with respect to claim 1 (the only claim challenged in the ground) because Petitioner impermissibly dismisses the preamble limitation reciting “a movable barrier operator that has no user-initiable dedicated learning mode of operation.” Petitioner states that modifying Mullet to meet this limitation would have been “a trivial change,” and thus would have been obvious to a POSITA. Petitioner cites no authority for the proposition that prior art references can be freely modified to teach patent claims merely because the change is allegedly “trivial,” and in fact no such authority exists. Further, Petitioner’s conclusory analysis fails to identify a “reason why” a POSITA would have been motivated to make such a change. Accordingly, Petitioner has not shown that claim 1 is obvious as alleged in Ground 2.

Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

Real-Time Litigation Alerts



Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

Advanced Docket Research



With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

Analytics At Your Fingertips



Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

LAW FIRMS

Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

FINANCIAL INSTITUTIONS

Litigation and bankruptcy checks for companies and debtors.

E-DISCOVERY AND LEGAL VENDORS

Sync your system to PACER to automate legal marketing.