

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

TRICKLESTAR LLC,
Petitioner,

v.

EMBERTEC PTY LTD.,
Patent Owner.

Case IPR2017-00839
Patent 9,106,099 B2

Before BARBARA A. BENOIT, LYNNE E. PETTIGREW, and
STACY B. MARGOLIES, *Administrative Patent Judges*.

MARGOLIES, *Administrative Patent Judge*.

FINAL WRITTEN DECISION
35 U.S.C. § 318(a) and 37 C.F.R. § 42.73

I. INTRODUCTION

In this *inter partes* review, instituted pursuant to 35 U.S.C. § 314, TrickleStar LLC (“Petitioner”) challenges the patentability of claims 8 and 10–16 of U.S. Patent No. 9,106,099 B2 (Ex. 1001, “the ’099 patent”), owned by Embertec Pty Ltd. (“Patent Owner”). We have jurisdiction under 35 U.S.C. § 6. This Final Written Decision is entered pursuant to 35 U.S.C. § 318(a) and 37 C.F.R. § 42.73. For the reasons discussed below, Petitioner has shown by a preponderance of the evidence that claims 8 and 10–16 of the ’099 patent are unpatentable.

A. Procedural History

Petitioner filed a Petition for *inter partes* review of claims 8 and 10–16 of the ’099 patent. Paper 2 (“Pet.”). Patent Owner filed a Preliminary Response. Paper 10 (“Prelim. Resp.”). On July 10, 2017, we instituted an *inter partes* review of claims 8 and 10–16 of the ’099 patent on the following grounds¹: (1) claim 10 of the ’099 patent is unpatentable as obvious under 35 U.S.C. § 103(a)² over EP ’379³ and the ’707 patent⁴; and (2) claims 8 and 11–16 of the ’099 patent are unpatentable as obvious under

¹ We instituted on all claims and all grounds set forth in the Petition. *See* Pet. 3.

² The Leahy-Smith America Invents Act, Pub. L. No. 112-29, 125 Stat. 284 (2011) (“AIA”), amended 35 U.S.C. §§ 102 and 103. Because the ’099 patent has an effective filing date before the effective date of the applicable AIA amendments, we refer to the pre-AIA versions of 35 U.S.C. §§ 102 and 103.

³ EP 2 051 379 A1, filed Oct. 16, 2008, published Apr. 22, 2009 (Ex. 1002).

⁴ U.S. Patent No. 7,034,707, issued Apr. 25, 2006 (Ex. 1007).

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35 U.S.C. § 103(a) over EP '379, the '707 patent, and EP '752.⁵ Paper 11 (“Inst. Dec.”), 33.

Subsequent to institution, Patent Owner did not file a Patent Owner Response. *See* Ex. 3003 (email stating that Patent Owner “will not be filing a Patent Owner Response”); 37 C.F.R. § 42.120(a) (providing that “[a] patent owner may file a response to the petition addressing any ground for unpatentability not already denied”). Neither party requested oral argument. *See* Paper 14 (noting that neither party requested oral argument and ordering that no oral argument take place); 37 C.F.R. § 42.70(a) (providing that “[a] party may request oral argument on an issue raised in a paper”).

B. Related Matters

The parties do not identify any related district court proceedings, but identify IPR2016-01336, in which the Board instituted *inter partes* review of claims 1–7 and 9 of the '099 patent. *See* Pet. 1; Paper 7, 1. In IPR2016-01336, we issued a Final Written Decision on December 20, 2017, determining that Petitioner demonstrated by a preponderance of the evidence that claims 1–7 and 9 of the '099 patent are unpatentable. *TrickleStar LLC v. Embertec Pty Ltd.*, Case IPR2016-01336 (“IPR2016-01336”), Paper 11 (PTAB Dec. 20, 2017).

C. The '099 Patent

The '099 patent is directed to an energy saving device that monitors the electrical power supply to electrical equipment to reduce unnecessary power consumption. Ex. 1001, [57], 1:14–18. The '099 patent explains that “[m]onitoring can have many advantages, especially in detecting abnormal

⁵ EP 1 223 752 A2, filed Nov. 30, 2001, published July 17, 2002 (Ex. 1003).

usage, faults and theft.” *Id.* at 2:60–61. For example, according to the ’099 patent, the system may detect excessive power consumption in an office due to use of a portable heater and alert supervisory personnel to the abnormal energy usage. *Id.* at 2:62–67. The patent also describes alerting a user to cessation of power consumption, such as that caused by breakdown of a refrigerator or freezer. *Id.* at 3:1–4.

Figure 1 of the ’099 patent, below, is a general representation the components of the energy saving device:

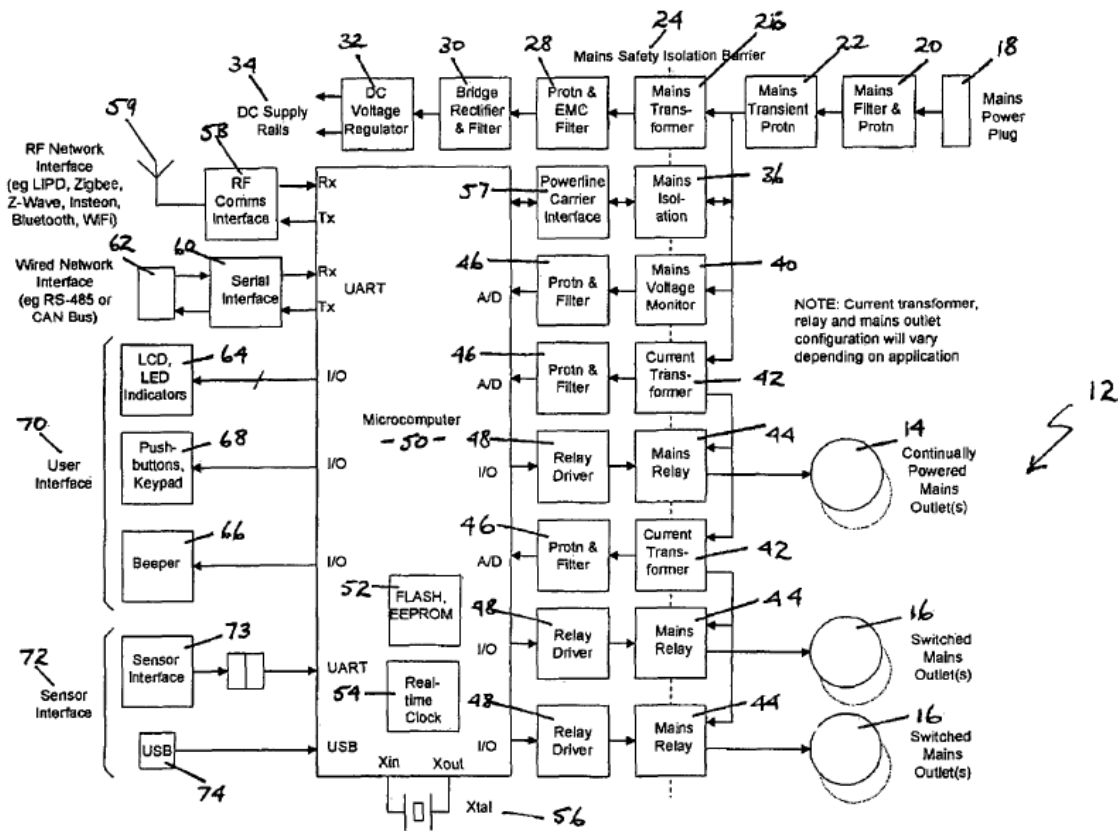


Figure 1

Id. at 5:52–54. As illustrated in Figure 1 above, energy saving device 12 includes one or more continually powered mains outlets 14 and two or more switched mains outlets 16. *Id.* at 5:58–60. According to the patent, electrical devices (not shown) are plugged into mains outlets 14 and

switched mains outlets 16 as required. *Id.* at 5:60–62. Energy saving device 12 also includes mains power plug 18 for connection to a mains power supply (not shown) and microcomputer 50, which implements energy saving algorithms and includes flash and/or EEPROM non-volatile memory 52 for storing energy saving configuration parameters. *Id.* at 5:63–64, 6:56–64.

Figure 1 above also illustrates a number of interfaces. *Id.* at 7:4–5. User interface 70 includes LCD or LED indicators 64, beeper 66, and pushbuttons and keypad 68. *Id.* at 7:20–21. According to the '099 patent, the LCD or LED indicators “output data from monitored power consumption and provide an indication of status to the use[r]” and the beeper “provide[s] an audible output to indicate faults or status change conditions, such as imminent powering down of connected mains powered equipment.” *Id.* at 7:22–24, 7:8–30.

Figure 1 further illustrates “[s]ensor interface 72 and 73,” which according to the '099 patent “provides an interface for wired connection of an external sensor module (not shown) including a remote control [infrared (IR)] sensor for IR remote control activity sensing in audio-visual applications.” *Id.* at 7:35–38. The patent states that “[t]he purpose of this is to enable automatic power reduction or power increase to electrical devices, such as in audio-visual equipment, if power can be reduced depending on user activity.” *Id.* at 7:41–44. For example, in the embodiment illustrated in Figure 3 of the '099 patent for a networked universal wall plug or general power outlet (GPO), “when the user operates the wireless transmitter via its push button or touch sensor, a wireless RF signal would be transmitted and received by wall plug 12*b*, causing it to supply mains power to the appliance.” *Id.* at 8:65–67, 9:34–40. The '099 patent also discloses that the

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