UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL
AND APPEAL BOARD

TransCore, LP
Petitioner

v.

Axcess International, Inc.
Patent Owner

PETITION FOR INTER PARTES REVIEW
OF U.S. PATENT NO. 7,286,158

TABLE OF CONTENTS

EXHIBIT LIST

Exhibit	Description
Ex. 1001	U.S. Patent No. 7,286,158 to Griebenow ("the '158 patent")
Ex. 1002	Declaration of Anthony Wechselberger
Ex. 1003	Reserved
Ex. 1004	U.S. Patent No. 5,745,036 to Clare ("Clare")
Ex. 1005	U.S. Patent No. 6,271,752 to Vaios ("Vaios")
Ex. 1006	European Patent Application EP 0 921 505 to Cox ("Cox")
Ex. 1007	U.S. Patent No. 6,583,813 to Enright et al. ("Enright")
Ex. 1008	U.S. Patent No. 7,005,985
Ex. 1009	U.S. Patent No. 6,294,953
Ex. 1010	File History for Inter Partes Reexamination filed February 27, 2012 for the '158 patent
Ex. 1011	File History for the '158 patent
Ex. 1012	Proof of Service of Complaint

I. INTRODUCTION

Petitioner requests an *inter partes* review of claims 1-5, 8-12 and 19-21 of U.S. Patent No. 7,286,158 ("the '158 patent") (Ex. 1001). This Petition shows that the challenged claims of the '158 patent are unpatentable based on a combination of prior art not considered during prosecution.

This Petition relies upon Clare as a primary reference (Ex. 1004), in addition to various secondary references, to render the challenged claims unpatentable. Clare was asserted by another party in an *inter partes* reexamination filed on February 27, 2012 (Ex. 1010), prior to implementation of *inter partes* reviews associated with the America Invents Act (AIA). In that *inter partes* reexamination, the Requestor alleged Clare anticipated independent claims 1 and 19 of the '158 patent, as well as various dependent claims. The Primary Examiner denied the *inter partes* reexamination, finding Clare was deficient with respect to a single claim element of each of independent claims 1 and 19 of the '158 patent. With respect to claim 1, the Primary Examiner asserted Clare did not teach "providing the subscriber with access to and control of a video camera in the video system at the facility." With respect to independent claim 19, the Primary Examiner asserted Clare did not disclose "electronically transmitting notice of the alert condition along with the video image for delivery to a manager of the facility" (Ex. 1010 – Order Granting/Denying Request dated March 26, 2012, Section 5 at pages 3-5).

This Petition, however, does not allege Clare anticipates any of the claims of the '158 patent. Rather, this Petition asserts obviousness under 35 U.S.C. § 103. That is, the Petition uses Clare in combination with various secondary references, or Clare itself, to render obvious the challenged claims as unpatentable under 35 U.S.C. § 103. These grounds of rejection were never asserted in the previous *inter partes* reexamination or during prosecution of the '158 patent.

One of these secondary references, Vaios (Ex. 1005), used to challenge some of the claims in this Petition (in combination with Clare) was considered by the Examiner during prosecution of the '158 patent (Ex. 1011). However, since Clare was not considered by the Examiner during prosecution of the '158 patent, a possible combination of Clare and Vaios was not considered during prosecution of the '158 patent or in the previous *inter partes* reexamination.

In addition, Vaios was used by the Examiner during prosecution of the '158 to disclose the same element the Primary Examiner argued was missing from Clare during the prior *inter partes* reexamination, i.e., "providing a subscriber with access to and control of a video camera in the video system facility" (Ex. 1011 – e.g., Office Action dated April 4, 2006 at page 3). The Patent Owner never successfully rebutted the teachings of Vaios during the prosecution of the '158 patent and it appears that the '158 patent was allowed for other reasons. These facts alone suggest that a combination of Clare with Vaios could render at least

DOCKET ALARM

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.