

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC. and AUGUST HOME, INC.,
Petitioner,

v.

MARK W. KILBOURNE,
Patent Owner.

IPR2019-00233
Patent 7,373,795 B2

Before GEORGE R. HOSKINS, RICHARD H. MARSCHALL, and
JASON W. MELVIN, *Administrative Patent Judges*.

HOSKINS, *Administrative Patent Judge*.

JUDGMENT
Final Written Decision
Determining All Challenged Claims Unpatentable
35 U.S.C. § 318(a)

I. INTRODUCTION

Apple Inc. and August Home, Inc. (collectively, “Petitioner”) filed a Petition (Paper 3, “Pet.”) pursuant to 35 U.S.C. §§ 311–319 to institute an *inter partes* review of claims 11–20 of U.S. Patent No. 7,373,795 B2 (“the ’795 patent”).

Mark W. Kilbourne (“Patent Owner” or “Mr. Kilbourne”), the solely named inventor and the owner of the ’795 patent, filed a Preliminary Response (Paper 8).

We instituted a trial to determine whether claims 11–17 are unpatentable, on all challenges to claims 11–17 presented in the Petition. Paper 13 (“Institution Decision” or “Inst. Dec.”), 2, 7, 37. We did not institute trial as to claims 18–20, because Patent Owner filed a statutory disclaimer of those claims prior to institution. *Id.* at 1, 32–34, 37.

Patent Owner filed a Patent Owner Response (Paper 17, “PO Resp.”) to the Petition. Petitioner filed a Reply (Paper 20, “Pet. Reply”) to the Patent Owner Response. Patent Owner filed a Sur-reply (Paper 25, “Sur-reply”) to Petitioner’s Reply.

Patent Owner filed a Motion to Exclude Evidence (Paper 33). Petitioner filed an Opposition (Paper 34) to the Motion. Patent Owner filed a Reply (Paper 35).

An oral hearing was held, for which the transcript was entered into the record (Paper 38, “Tr.”).

We have jurisdiction under 35 U.S.C. § 6(b)(4) and § 318(a). This Decision is a Final Written Decision under 35 U.S.C. § 318(a) and 37 C.F.R. § 42.73 as to the patentability of claims 11–17 of the ’795 patent. We

determine Petitioner has shown, by a preponderance of the evidence, that claims 11–17 are unpatentable.

II. BACKGROUND

A. Real Parties in Interest and Related Proceedings

Petitioner identifies Apple Inc.; August Home, Inc.; ASSA ABLOY Inc.; and ASSA ABLOY AB as real parties-in-interest. Pet. 1, 4–5, 7. Patent Owner identifies only himself, Mr. Kilbourne, as a real party-in-interest. Paper 6, 1. The parties identify one U.S. District Court litigation as related to this proceeding: *Mark W. Kilbourne v. Apple Inc.*, Case No. 4:18-cv-04619 (N.D. Cal.) (hereafter “the District Court Litigation”). Pet. 6; Paper 6, 1; Paper 32, 2.

B. Patent Owner’s Pre-Institution Disclaimer of Claims 18–20 of the ’795 Patent

The Petition asserts claims 18–20 of the ’795 patent are unpatentable under 35 U.S.C. § 103(a). Pet. 8, 57–70. Patent Owner disclaimed claims 18–20 prior to institution of trial, as discussed in the Institution Decision. Inst. Dec. 32–33; *see also* PO Resp. 27 (acknowledging disclaimer). Accordingly, we did not institute trial as to claims 18–20. Inst. Dec. 33–34. Therefore we do not address claims 18–20 any further.

C. The ’795 Patent Disclosure

Our discussion of the ’795 patent here focuses on the disclosures that pertain to the issues presented in this *inter partes* review, which are limited in scope.

The '795 patent discloses systems and methods for electronically extending or retracting the deadbolt of an internal door locking apparatus, which are particularly useful in adapting an electronic actuator to pre-existing deadbolt systems. Ex. 1001, Abstract, 6:47–51, 6:65–7:19. Figure 5 of the '795 patent is reproduced below:

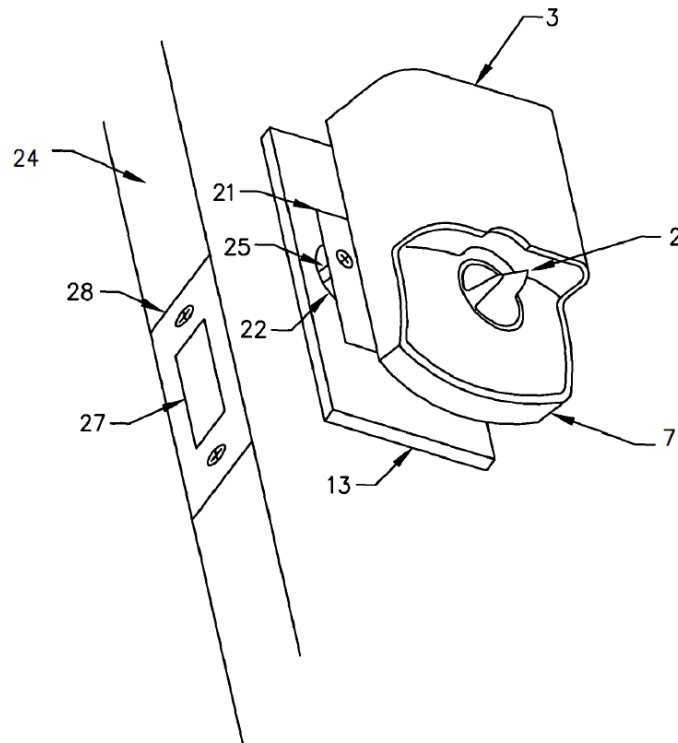


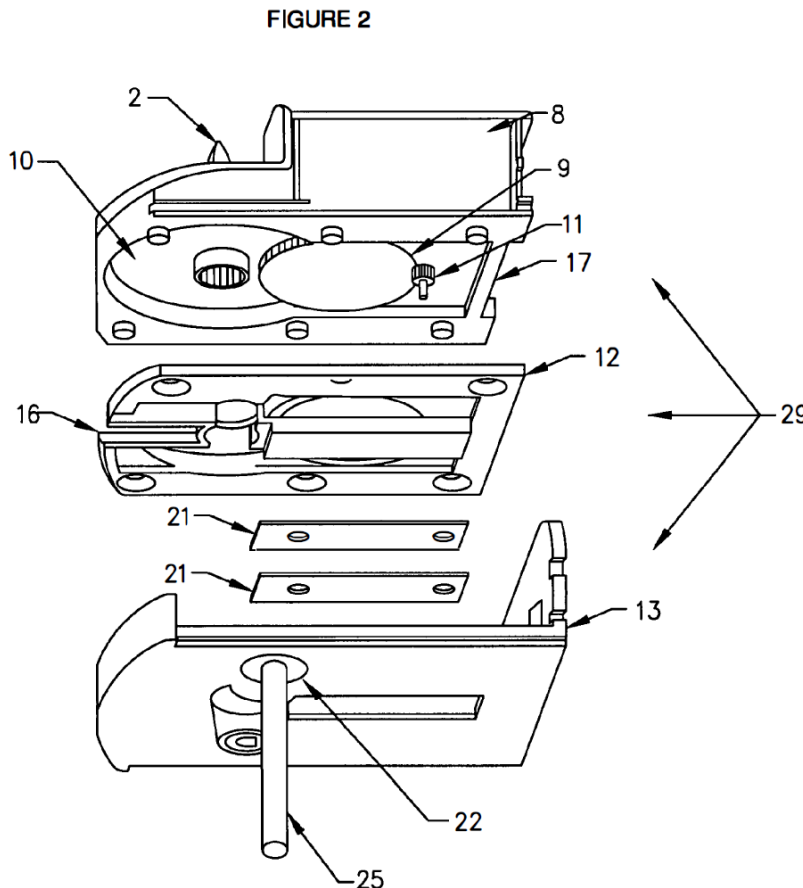
FIGURE 5

**Figure 5 of the '795 Patent
(partially exploded view of door and deadbolt activation apparatus).**

Id. at 1:6–10, 1:54–56. Figure 5 illustrates door 24 and standard internal deadbolt apparatus 28, wherein apparatus 28 includes deadbolt 27 and two bolts 25 (only one of which is shown). *Id.* at 4:41–43, 6:18–20, 6:24–31. Template unit 13 is secured to door 24, using bolts 25 and two brackets 21 (only one of which is shown), on the side of door 24 facing the inside of the

room to be secured. *Id.* at 6:24–38, 7:19–26. Motor and battery housing unit 7, with casing 3, is then attached to template unit 13. *Id.* at 7:52–57.

Figure 2 of the '795 patent is reproduced below:



**Figure 2 of the '795 Patent
(partially exploded bottom view of deadbolt activation apparatus).**

Id. at 1:48–49. Figure 2 illustrates gear encasement assembly 29, comprised of template unit 13 (also seen in Figure 5 above), along with gear casing 12 and motor and battery housing unit carriage 17 (both part of unit 7 in Figure 5 above). *Id.* at 4:61–64. “The empty motor and battery housing unit carriage 17 preferably rests on top of gear casing 12 such that gears 9, 10 and 11 are securely held between empty motor and battery housing unit carriage 17 and top of gear casing 12.” *Id.* at 4:28–32.

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