

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.

Case 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*.

DECISION
Institution of *Inter Partes* Review
35 U.S.C. § 314

I. INTRODUCTION

Apple Inc. and August Home, Inc. (collectively, “Petitioner”) have 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”), the solely named inventor and the owner of the ’795 patent, has filed a Preliminary Response (Paper 8, “Prelim. Resp.”). Patent Owner later, as authorized by the Board (Paper 9), supplemented the Preliminary Response (Paper 10, “Supp. Prelim. Resp.”).

Applying the standard set forth in 35 U.S.C. § 314(a), which requires demonstration of a reasonable likelihood that Petitioner would prevail with respect to at least one challenged claim, we institute, on behalf of the Director (37 C.F.R. § 42.4(a)), an *inter partes* review to determine whether Petitioner demonstrates by a preponderance of the evidence that claims 11–17 are unpatentable. We do not institute review as to claims 18–20, which have been disclaimed by Patent Owner. *See* 37 C.F.R. § 42.107(e).

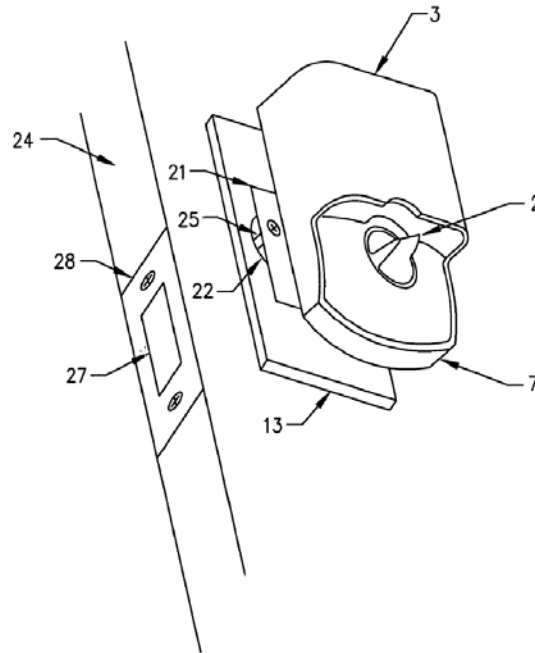
II. BACKGROUND

A. *Real Parties in Interest and Related Proceedings*

Petitioner identifies Apple Inc.; August Home, Inc.; ASSA ABLOY Inc.; and ASSA ABLOY AB as the real parties-in-interest. Pet. 1, 4–5, 7. Patent Owner identifies himself as the 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.

B. The '795 Patent

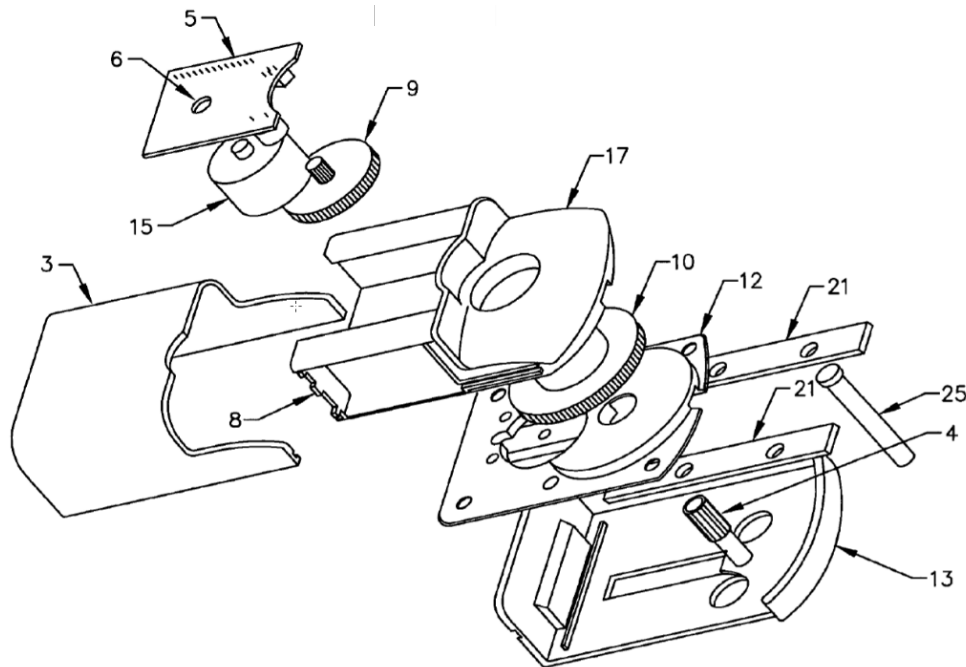
The '795 patent discloses systems and methods for electronically extending or retracting the deadbolt of an internal door locking apparatus. Ex. 1001, Abstract, 6:47–51, 6:65–7:19. Figure 5 of the '795 patent is reproduced below:



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

Id. at 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 area 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. Deadbolt 27 may be extended or retracted either manually by turning knob 2, or electronically by controlling a motor within unit 7. *Id.* at 5:4–11, 6:4–17.

Figure 3 of the '795 patent is reproduced below:

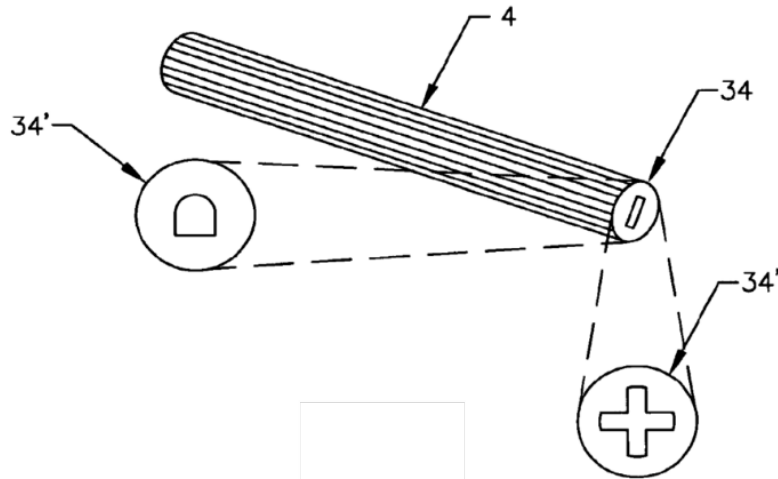


**Figure 3 of the '795 Patent
(fully exploded view of lock apparatus).**

Id. at 1:50–51. Figure 3 illustrates the internal components of unit 7. Knob gear 10 is attached to knob 2 (partially hidden in Figure 3 behind carriage 17) and receives one end of splined stem 4, such that rotation of knob 2 also rotates stem 4. *Id.* at 3:23–35, 3:47–61, 7:58–64. Motor 15 is powered by battery bank 8 and controlled by card 5 to rotate rotary gear 9, which in turn rotates knob gear 10 to rotate stem 4. *Id.* at 3:18–22, 4:17–28, 5:12–17, 5:60–6:4. The motorized operation of unit 7 may be implemented using a separate transmitter 40 (not shown in Figure 3) that communicates wirelessly with motor card 5. *Id.* at Fig. 7, 8:3–14, 10:21–60.

The end of splined stem 4 opposite to the end received in knob gear 10 interacts with a “tailpiece” component of standard internal deadbolt apparatus 28, wherein rotation of stem 4 extends or retracts deadbolt 27. *Id.* at 4:43–45, 5:4–11, 7:67–8:3, 8:64–9:14. The '795 patent indicates it is

beneficial for unit 7 to work with different kinds of standard apparatuses 28, which have different tailpiece structures. *Id.* at 7:12–19, 7:29–37, 7:67–8:3. Figure 6C of the '795 patent is reproduced below:



**Figure 6C of the '795 Patent
(perspective view of splined stem 4,
showing three alternative front face formations 34, 34', 34'').**

Id. at 7:29–37. Figure 6C illustrates that “the user has the option of pulling out the splined stem 4 from its attachment to the manual turn knob 2 and rotate it such that either the front [or rear] face can be utilized.” *Id.* at 7:29–32. The two faces of splined stem 4 may have different “formations,” such as standard slot 34, half oval 34', or cross-slot 34''. *Id.* at 7:32–34. In this way, unit 7 “can be used with [a] plurality of standard deadbolt locks including ones found in most standard configurations.” *Id.* at 7:35–37.

Motor card 5 tracks the position of deadbolt 27, particularly whether it is in the extended and locked position, or in the retracted and unlocked position. *Id.* at 5:26–48. Motor card 5 does this by measuring the rotational position of knob gear 10, using sensors 32, 32'. *Id.* at Fig. 4, 5:37–48, 7:40–48, 9:35–53. Motor card 5 may use a sound emission diode to inform the user of the deadbolt position, via coded beeps for example. *Id.* at 5:26–36.

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