

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ALARM.COM INC.,
Petitioner,

v.

VIVINT, INC.,
Patent Owner.

Case IPR2016-01080
Patent 6,147,601

Before MICHAEL R. ZECHER, JAMES B. ARPIN, and
CHARLES J. BOUDREAU, *Administrative Patent Judges*.

BOUDREAU, *Administrative Patent Judge*.

DECISION

Denying Institution of *Inter Partes* Review
35 U.S.C. § 314(a) and 37 C.F.R. § 42.108

I. INTRODUCTION

On May 20, 2016, Alarm.com Incorporated (“Alarm.com”) filed a Petition (Paper 1, “Pet.”) requesting an *inter partes* review of claims 3, 16, 24, 32, 42, and 43 (“the challenged claims”) of U.S. Patent No. 6,147,601 (Ex. 1301, “the ’601 patent”). Pet. 1. Vivint, Incorporated (“Vivint”) filed a Preliminary Response. Paper 10 (“Prelim. Resp.”).

Based on the particular circumstances of this case, we exercise our discretion under 37 C.F.R. § 42.108 and do not institute an *inter partes* review of the challenged claims.

II. BACKGROUND

A. Related Matters

The ’601 patent is the subject of a district court action between the parties titled *Vivint, Inc. v. Alarm.com Inc.*, No. 2:15-cv-00392-CW-BCW (D. Utah 2015), filed June 2, 2015. Pet. 1; Paper 8, 2. In addition to the present Petition, Alarm.com has filed three other petitions challenging various claims of the ’601 patent. Case IPR2015-02004 (Paper 1) (“the ’2004 petition” or “’2004 Pet.”); Case IPR2016-00116 (Paper 1) (“the ’116 petition” or “’116 Pet.”); Case IPR2016-00155 (Paper 1) (“the ’155 petition” or “’155 Pet.”).

Alarm.com also has filed fourteen other petitions, challenging certain claims of the following other patents owned by Vivint: (1) U.S. Patent No. 6,462,654 B1 (Cases IPR2015-02003, IPR2016-00161, IPR2016-01110, and IPR2016-01124); (2) U.S. Patent No. 6,535,123 B2 (Cases IPR2015-01995, IPR2016-00173, and IPR2016-01126); (3) U.S. Patent No. 6,717,513 B1 (Cases IPR2015-01997, IPR2016-00129, and IPR2016-01091); (4) U.S. Patent No. 6,924,727 B2 (Cases IPR2015-01977 and IPR2015-02008); and

(5) U.S. Patent No. 7,884,713 B1 (Cases IPR2015-01965 and IPR2015-01967). Pet. 2; Paper 8, 1–2.

B. Illustrative Claims

Of the challenged claims, only claims 42 and 43 are independent. Challenged claim 3 depends from unchallenged claim 2, which in turn depends from unchallenged independent claim 1. Challenged claim 16 likewise depends from unchallenged independent claim 1. Challenged claim 24 depends from unchallenged claim 23, which in turn depends from unchallenged independent claim 22. Challenged claim 32 depends from unchallenged claim 30, which depends from unchallenged claim 26, which depends from independent claim 22.

Unchallenged claims 1 and 2 and challenged claims 3 and 16 are illustrative and are reproduced below:

1. A method of monitoring remote equipment comprising the steps of:
 - a) determining a state of at least one parameter of at least one piece of the remote equipment;
 - b) communicating a message indicative of the state from the piece of remote equipment to a computer server as an incoming message;
 - c) enabling a user to remotely configure or modify a user-defined message profile containing outgoing message routing instructions, the user-defined message profile being storable on the computer server;
 - d) determining whether an incoming message is an incoming exception message indicative of improper operation of the piece of remote equipment;
 - e) if it is determined in step d) that an incoming message is an incoming exception message, forwarding at least one outgoing exception message based on the incoming message

to at least one user-defined communication device
specifiable in the user-defined message profile,

wherein the user can remotely configure or modify the user-
defined message profile by remotely accessing the computer
server.

2. A method according to claim 1, wherein said step b) further
comprises the step of communicating a plurality of incoming
messages to the computer server via one of a plurality of
different communication media.

3. A method according to claim 2, further comprising the step
of normalizing the incoming messages into a uniform format to
create normalized messages, wherein the outgoing exception
messages are generated based on the normalized messages.

16. A method according to claim 1, wherein the remote
equipment includes heating, ventilating, and cooling equipment.

Ex. 1301, 8:51–9:15, 10:16–18.

C. References Relied Upon

Alarm.com relies on the following references:

Exhibit	Reference
1303	U.S. Patent No. 5,808,907, issued Sept. 15, 1998 ("Shetty")
1304	U.S. Patent No. 6,067,477, issued May 23, 2000 ("Wewalaarachchi")
1305	U.S. Patent No. 6,040,770, issued Mar. 21, 2000 (filed Sept. 4, 1998) ("Britton")

Pet. 7–8. Alarm.com also relies on a declaration of V. Thomas Rhyne, III,
Ph.D., P.E., R.P.A. (Ex. 1306).

D. Asserted Grounds of Unpatentability

Alarm.com challenges the patentability of the challenged claims on the following grounds:

References	Basis	Claim(s) Challenged
Shetty and Wewalaarachchi	§ 103	3, 16, 24, 42, and 43
Shetty, Wewalaarachchi, and Britton	§ 103	32

Pet. 8.

III. DISCUSSION

A. Discretionary Non-Institution

Institution of *inter partes* review is discretionary. See 35 U.S.C. § 314(a); 37 C.F.R. § 42.108. There is no per se rule against a petitioner filing a second petition to address a patent claim on which the Board previously declined to institute a review. Rather, panels of this Board have considered a variety of factors in deciding whether to exercise their discretion not to institute review, including, *inter alia*:

- (1) the finite resources of the Board;
- (2) the requirement under 35 U.S.C. § 316(a)(11) to issue a final determination not later than one year after the date on which the Director notices institution of review;
- (3) whether the same petitioner previously filed a petition directed to the same claims of the same patent;
- (4) whether, at the time of filing of the earlier petition, the petitioner knew of the prior art asserted in the later petition or should have known of it;¹

¹ See *Conopco, Inc. v. Proctor & Gamble Co.*, Case IPR2014-00506, slip op. at 4 (PTAB Dec. 10, 2014) (Paper 25) (informative), and slip op. at 6 (PTAB July 7, 2014) (Paper 17); *Toyota Motor Corp. v. Cellport Sys., Inc.*, Case

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