

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ALARM.COM INC.,
Petitioner,

v.

VIVINT, INC.,
Patent Owner.

Case IPR2016-00155
Patent 6,147,601

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

ZECHER, *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

Petitioner, Alarm.com Incorporated (“Alarm.com”), filed a Petition requesting an *inter partes* review of claims 1–3, 22–24, 26, 30, 32, 42, and 43 of U.S. Patent No. 6,147,601 (Ex. 1201, “the ’601 patent”). Paper 1 (“Pet.”). Patent Owner, Vivint, Incorporated (“Vivint”), filed a Preliminary Response. Paper 12 (“Prelim. Resp.”). We also authorized Alarm.com to file a Brief limited to addressing certain aspects of Vivint’s Request for Certificate of Correction for the ’601 patent, which was filed on December 17, 2015. Paper 9. Alarm.com filed its Brief shortly before Vivint filed its Preliminary Response. Paper 11 (“Pet. Brief”).

Under 35 U.S.C. § 314(a), an *inter partes* review may not be instituted unless the information presented in the Petition shows “there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.” Taking into account the arguments presented in Vivint’s Preliminary Response, we conclude that the information presented in the Petition does not establish that there is a reasonable likelihood that Alarm.com would prevail in challenging any of claims 1–3, 22–24, 26, 30, 32, 42, and 43 of the ’601 patent as unpatentable under 35 U.S.C. § 103(a). We, therefore, *deny* the Petition.

A. *Related Matters*

The ’601 patent is involved in a district court case titled *Vivint, Inc. v. Alarm.com Inc.*, No. 2:15-cv-00392-CW-BCW (D. Utah 2015). Pet. 1; Paper 7, 2. In addition to this Petition, Alarm.com filed petitions challenging certain subsets of claims of the ’601 patent in the following two cases: (1) Case IPR2015-02004, Paper 1; and Case IPR2016-00116, Paper

1. Pet. 1; Paper 7, 1. Alarm.com also filed other petitions challenging the patentability of certain subsets of claims in the following patents owned by Vivint: (1) U.S. Patent No. 6,462,654 B1 (Cases IPR2015-02003 and IPR2016-00161); (2) U.S. Patent No. 6,535,123 B2 (Cases IPR2015-01995 and IPR2016-00173); (3) U.S. Patent No. 6,717,513 B1 (Case IPR2015-01997 and IPR2016-00129); (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. 1; Paper 7, 1–2.

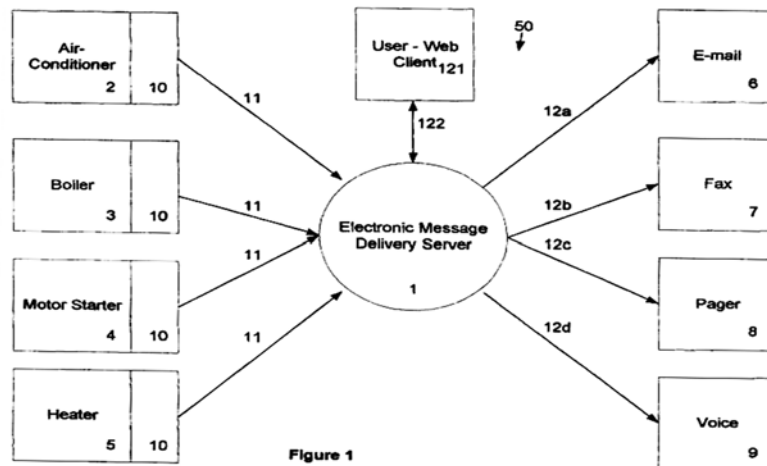
B. The '601 Patent

The '601 patent, entitled “Electronic Message Delivery System Utilizable in the Monitoring of Remote Equipment and Method of Same,” issued November 14, 2000, from U.S. Patent Application No. 09/317,235, filed May 24, 1999. Ex. 1201, at [54], [45], [21], [22]. The '601 patent claims the benefit of U.S. Provisional Application No. 60/115,305, filed January 9, 1999. *Id.* at [60], 1:6–7.

The '601 patent describes systems and methods for monitoring remote equipment such as “devices . . . employed in heating, ventilating, and [air conditioning] (HVAC) systems.” Ex. 1201, Abstract, 1:11–14. The '601 patent explains that “[i]t is desirable to be able to monitor remotely equipment that may require periodic preventive maintenance and/or that may require rapid response time should a catastrophic failure occur.” *Id.* at 1:16–19. According to the '601 patent, prior art systems were limited insofar as they did not “allow for sufficient flexibility in routing fault messages to a variety of different potential recipients of such messages via a variety of different media, depending on the urgency or nature of the fault.” *Id.* at 1:66–2:3. The '601 patent provides, as an example, that an HVAC customer

may want to send “certain non-emergency condition notifications (e.g., filter needs cleaning) to certain individuals (e.g., contractor/maintenance personnel) via a certain medium (e.g., e-mail) and emergency condition notifications (e.g., low or high refrigerant pressure) to other individuals (building owner, contractor, etc.) via other means (e.g., via beeper or other personal communication device).” *Id.* at 2:5–14. “Such a list of who to contact via what means depending on which fault has occurred may be referred to as a ‘message profile.’” *Id.* at 2:14–16. According to the ’601 patent, conventional systems did not allow for “easy customer modifications to the message profile.” *Id.* at 2:21–22.

The ’601 patent purportedly solves these problems by disclosing a system for remotely monitoring electrical or mechanical equipment that can deliver fault notification messages to different individuals for different fault conditions via different electronic media, and in which a customer may modify its message profile interactively. Ex. 1201, 2:33–41. Figure 1 of the ’601 patent, reproduced below, illustrates a schematic diagram of the preferred embodiment of this system. *Id.* at 3:24–25, 5:38–39.



As shown in Figure 1, system 50 monitors existing pieces of electronic equipment, such as air-conditioner 2, boiler 3, motor starter 4, heater 5, or any other equipment that a prospective user desires to monitor. Ex. 1201, 5:39–42. Each piece of equipment is fitted with interface 10 that periodically sends a status signal to electronic message delivery server 1 indicating whether the piece of equipment and its corresponding interface are functioning correctly. *Id.* at 5:43–47. When a predetermined “exception” condition, e.g., a fault condition, occurs in a piece of equipment being monitored, interface unit 10 sends a message to electronic message delivery server 1. *Id.* at 5:47–51. Electronic message delivery server 1 then routes the message to the appropriate user interface, such as email 6, fax 7, pager 8, voice 9, etc., according to a message profile configured by the user via user-web client 121 connected to Internet 122. *Id.* at 5:51–55, Fig. 1.

In the described systems and methods, a sensor in communication with a piece of remote equipment determines the state of at least one parameter of the remote equipment. Ex. 1201, 2:48–50, 2:55–56. When the sensor detects an “exception” condition, i.e., an operating condition that is either out of the ordinary or beyond nominal parameters, in the remote equipment, an interface unit connected to the sensor and having a message generating mechanism generates an incoming exception message and forwards the message to a central computer server. *Id.* at 2:56–65. The server forwards at least one outgoing exception message to at least one predetermined user-defined end device based on the incoming exception message. *Id.* at 2:65–67.

C. Illustrative Claims

Of the challenged claims, claims 1, 22, 42, and 43 are independent. Independent claims 1 and 42 are directed to methods of monitoring remote equipment, whereas independent claims 22 and 43 are directed to systems for performing the same. Claims 2 and 3 directly or indirectly depend from independent claim 1; and claims 23, 24, 26, 30, and 32 directly or indirectly depend from independent claim 22. Independent claims 1 and 22 are illustrative of the challenged claims 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.

Ex. 1201, 8:51–9:6.

22. A system for monitoring remote equipment, comprising:
- a sensor in local communication with a piece of remote equipment, said sensor detecting a state of at least one parameter of the piece of remote equipment;
 - an interface unit, locally connected to said sensor, said interface unit having a message generating mechanism; and
 - a computer server in remote communication with said interface unit, said server adapted to receive messages generated by said interface unit, said computer server having a user interface, a user being capable of remotely accessing said computer server via said user interface to remotely configure a user-defined message profile containing outgoing message routing instructions,
- wherein when said sensor detects an exception condition in the piece of remote equipment, said interface unit generates an incoming exception message indicative of the exception condition and forwards said message to said server,
- and wherein said server forwards at least one outgoing exception message to at least one predetermined user-defined remote communication device based on said incoming exception message as specified in said user-defined message profile.

Id. at 10:43–11:2.

D. References Relied Upon

Alarm.com relies upon the following references:

Levac	US 6,034,970	issued Mar. 7, 2000 (filed July 2, 1997)	Ex. 1206
Wewalaarachchi	US 6,067,477	issued May 23, 2000 (filed Jan. 15, 1998)	Ex. 1203

HONEYWELL ENGINEERING MANUAL OF AUTOMATIC CONTROL FOR COMMERCIAL BUILDINGS, Honeywell, Inc. (©1997) (Ex. 1204, “Honeywell”).

D. References Relied Upon (cont.)

BACnet®: A Data Communication Protocol for Building Automation and Control Networks, ANSI/ASHRAE¹ Standard 135-1995 (including ANSI/ASHRAE Addendum 135a-1999), American Society of Heating, Refrigerating and Air-Conditioning Engineers, Inc. (©1995) (Ex. 1205, “BACnet”).

E. Asserted Grounds of Unpatentability

Alarm.com challenges claims 1–3, 22–24, 26, 30, 32, 42, and 43 of the ’601 patent based on the asserted grounds of unpatentability (“grounds”) set forth in the table below. Pet. 4, 11–56.

References	Basis	Challenged Claims
Wewalaarachchi, Honeywell, and BACnet	§ 103(a)	1–3, 22–24, 26, 30, 32, 42, and 43
Wewalaarachchi, Honeywell, BACnet, and Levac	§ 103(a)	1–3, 22–24, 26, 30, 32, 42, and 43

II. ANALYSIS

A. Claim Construction

In an *inter partes* review, we construe claims by applying the broadest reasonable interpretation in light of the specification. 37 C.F.R. § 42.100(b); *In re Cuozzo Speed Techs., LLC*, 793 F.3d 1268, 1278–79 (Fed. Cir. 2015), *cert. granted sub nom. Cuozzo Speed Techs., LLC v. Lee*, 136 S. Ct. 890 (mem.) (2016). Under the broadest reasonable interpretation standard, and absent any special definitions, claim terms or phrases are given their

¹ ANSI is an acronym for the American National Standards Institute, and ASHRAE is an acronym for the American Society of Heating, Refrigerating and Air-Conditioning Engineers.

ordinary and customary meaning, as would be understood by one of ordinary skill in the art, in the context of the entire disclosure. *In re Translogic Tech., Inc.*, 504 F.3d 1249, 1257 (Fed. Cir. 2007).

In its Petition, Alarm.com proposes a construction for the following three claim phrases: (1) “message profile containing outgoing message routing instructions” (claims 1–3, 22–24, 26, 30, and 32); (2) “message generating mechanism” (claims 22–24, 26, 30, and 32); and (3) “normalization module” (claims 24 and 32). Pet. 7–11. In response, Vivint proposes a construction for the claim phrases “message profile” (claims 1–3, 22–24, 26, 30, and 32) and “plurality of message profiles” (claims 42 and 43), as well as alternative constructions for the claim phrases “message generating mechanism” and “normalization module.” Prelim. Resp. 17–28. We, however, need not assess the parties’ proposed constructions because they are not necessary to resolve the dispositive issues discussed below. *See, e.g., Vivid Techs., Inc. v. Am. Sci. & Eng’g, Inc.*, 200 F.3d 795, 803 (Fed. Cir. 1999) (explaining that only those claim terms or phrases that are in controversy need to be construed, and only to the extent necessary to resolve the controversy).

B. Whether Honeywell and BACnet Qualify as Printed Publications Within the Meaning of 35 U.S.C. § 102

Each of the grounds of unpatentability asserted by Alarm.com in its Petition is based, in part, on Honeywell and BACnet. We begin our analysis by addressing whether Alarm.com has made a threshold showing that these references are printed publications within the meaning of 35 U.S.C. § 102 and, therefore, are available as prior art in an *inter partes* review of the ’601 patent. *See* 35 U.S.C. § 311(b).

1. Honeywell

In its Petition, Alarm.com contends that Honeywell is available as prior art to the '601 patent under §§ 102(a) and 102(b) because it has a copyright date of 1997 and bears Library of Congress Catalog Card Number ("LCCCN") 97-72971. Pet. 3. Alarm.com's declarant, Arthur Zatarain, PE, merely reiterates the same argument advanced in the Petition. *Compare* Ex. 1207 ¶ 22, *with* Pet. 3.

In response, Vivint contends that Alarm.com fails to provide sufficient evidence showing that Honeywell qualifies as prior art to the '601 patent. Prelim. Resp. 2–3. Vivint argues that the copyright date of 1997 on the second page of Honeywell, by itself, is insufficient to show that Honeywell was made publicly accessible in 1997, or at any point prior to January 9, 1999—the earliest effective filing date of the '601 patent. *Id.* at 4. In addition, Vivint contends that Alarm.com provides no explanation as to the meaning of the LCCCN on the second page of Honeywell, thereby leaving us to speculate as to what the LCCCN actually signifies. Prelim. Resp. 4–5. Vivint further argues that, even if we were to assume that the LCCCN shows that Honeywell was cataloged and indexed sometime in 1997, such a showing still would be insufficient to prove Honeywell was made publicly accessible prior to January 9, 1999. *Id.* at 5. To support this argument, Vivint asserts that Alarm.com does not provide evidence or argument regarding the cataloging and indexing processes of the Library of Congress in or around 1997. *Id.* at 5 (citing *In re Cronyn*, 890 F.2d 1158, 1161 (Fed. Cir. 1989)).

We look to the underlying facts to make a legal determination as to whether a reference is a printed publication. *Suffolk Techs., LLC v. AOL*

Inc., 752 F.3d 1358, 1364 (Fed. Cir. 2014). The determination of whether a given reference qualifies as a prior art “printed publication” involves a case-by-case inquiry into the facts and circumstances surrounding its disclosure to members of the public. *In re Klopfenstein*, 380 F.3d 1345, 1350 (Fed. Cir. 2004). The key inquiry is whether the reference was made “sufficiently accessible to the public interested in the art” before the critical date.

Cronyn, 890 F.2d at 1160; *In re Wyer*, 655 F.2d 221, 226 (CCPA 1981). “A given reference is ‘publicly accessible’ upon a satisfactory showing that such document has been disseminated or otherwise made available to the extent that persons interested and ordinarily skilled in the subject matter or art exercising reasonable diligence, can locate it.” *SRI Int’l, Inc. v. Internet Sec. Sys., Inc.*, 511 F.3d 1186, 1194 (Fed. Cir. 2008) (quoting *Bruckelmyer v. Ground Heaters, Inc.*, 445 F.3d 1374, 1378 (Fed. Cir. 2006)).

On this record, we are not persuaded that Alarm.com has made a threshold showing that Honeywell is a printed publication within the meaning of § 102 and, therefore, qualifies as prior art to the ’601 patent. As discussed above, the second page of Honeywell includes the following two indicia: (1) a copyright date of 1997 accompanied by an “[a]ll rights reserved” notice; and (2) LCCCN 97-72971. Ex. 1204, 2²; Ex. 1207 ¶ 22. With respect to the copyright date of 1997, we agree with Vivint’s argument that this copyright date, by itself, is insufficient to demonstrate the date Honeywell was made publicly accessible. Prelim. Resp. 4. This copyright date simply informs readers of the underlying claim to copyright ownership

² All references to the page numbers in Honeywell refer to the page numbers inserted by Alarm.com in the bottom, right-hand corner of each page in Exhibit 1204.

in Honeywell, and the “[a]ll rights reserved” notice informs readers that the copyright holder does not intend to give up any of the exclusive rights it has under copyright law. Without more compelling argument or evidence, this copyright date does not demonstrate that Honeywell was made sufficiently accessible to the public interested in the art at any time in 1997.

With respect to the LCCCN, we also agree with Vivint that, even when the LCCCN is considered together with the copyright date of 1997, it does not demonstrate that Honeywell was made sufficiently accessible to the public interested in the art at any time in 1997. Prelim. Resp. 4–7. As Vivint correctly points out in its Preliminary Response (*id.* at 5), it is incumbent upon Alarm.com to explain how Honeywell was cataloged or indexed in a meaningful way, such that it could be located by the public interested in the art by exercising reasonable diligence. *See Cronyn*, 890 F.2d at 1161 (concluding that documents are not accessible to the public if “they had not been either cataloged or indexed in a meaningful way”). Here, although the LCCCN suggests that Honeywell was cataloged at the Library of Congress, neither Alarm.com nor its declarant, Mr. Zatarain, explain adequately how this manner of cataloging was sufficient to make Honeywell reasonably accessible to the public interested in the art. *See Square, Inc. v. Unwired Planet, LLC*, Case CBM2014-00156, slip op. at 18 (PTAB Dec. 24, 2014) (Paper 11) (“Petitioner provides no evidence about what an [International Standard Book Number] actually is, how it is generated, or what it purports to show, which would allow us to assign any weight to it.”). Absent argument or evidence directed to the manner in which Honeywell was cataloged at the Library of Congress, we are not persuaded that as of

January 9, 1999, Honeywell was made sufficiently accessible to render it a printed publication within the meaning of § 102.

2. BACnet

In its Petition, Alarm.com contends that BACnet is available as prior art to the '601 patent under §§ 102(a) and 102(b) because it was approved in, and has a copyright date of, 1995. Pet. 3. Once again, Alarm.com's declarant, Mr. Zatarain, merely reiterates the same argument advanced in the Petition. *Compare* Ex. 1207 ¶ 22, *with* Pet. 3.

In response, Vivint contends that Alarm.com fails to provide sufficient evidence showing that BACnet qualifies as prior to the '601 patent. Prelim. Resp. 7. Vivint argues that the copyright date of 1995 on the face of BACnet, by itself, is insufficient to show that BACnet was made publicly accessible in 1995, or at any point prior to January 9, 1999. *Id.* In addition, Vivint contends that BACnet includes both a 1999 addendum that was approved by the ASHRAE Standards Committee and copyrighted in 2000, and an "*Errata*" dated September 7, 1999, both of which identify dates and detailed changes to BACnet that occurred later than January 9, 1999. *Id.* at 7–8 (citing Ex. 1205, 537–47, 549–614³). Based on the dates and detailed changes identified in the addendum and *Errata*, Vivint asserts that the actual version of BACnet submitted in this proceeding could not have been made publicly accessible in 1995, much less at any time prior to January 9, 1999. *Id.* at 8.

³ All references to the page numbers in BACnet refer to the page numbers inserted by Alarm.com in the bottom, right-hand corner of each page in Exhibit 1205.

On this record, we are not persuaded that Alarm.com has made a threshold showing that BACnet is a printed publication within the meaning of § 102 and, therefore, qualifies as prior art to the '601 patent. Similar to our analysis above with respect to Honeywell, we agree with Vivint's argument that BACnet's copyright date of 1995, by itself, is insufficient to demonstrate the date BACnet was made publicly accessible. Prelim. Resp. 7. This copyright date simply informs readers of the underlying claim to copyright ownership in BACnet, and the "[a]ll rights reserved" notice accompanying this copyright date informs readers that the copyright holder does not intend to give up any of the exclusive rights it has under copyright law. Without more compelling argument or evidence, this copyright date does not demonstrate that BACnet was made sufficiently accessible to the public interested in the art at any time in 1995.

As mentioned above, there is at least one additional consideration that weighs in favor of determining that Alarm.com has not made a threshold showing that BACnet qualifies as prior art to the '601 patent. BACnet references a 1999 addendum that was approved by the ASHRAE Standards Committee and copyrighted in 2000. Ex. 1205, 1, 549. According to BACnet, "[t]he purpose of this addendum is to add a number of independent substantive changes to the BACnet standard." *Id.* at 551. BACnet then proceeds to summarize these substantive changes. *Id.* at 551–52.

In its Petition, Alarm.com does not acknowledge the aforementioned substantive changes made by the addendum to BACnet in 1999, nor does Alarm.com address whether it relies upon these substantive changes to formulate its asserted grounds based on obviousness. We, therefore, are left to examine each asserted ground based on obviousness to unearth whether

Alarm.com relies upon these substantive changes to support its analysis. *See DeSilva v. DiLeonardi*, 181 F.3d 865, 866–67 (Fed. Cir. 1999) (“A brief must make all arguments accessible to the judges, rather than ask them to play archeologist with the record.”). This we will not do. Section 314(a) of Title 35 of the United States Code imposes a burden on Alarm.com—not the Board—to establish in its Petition a reasonable likelihood of success, which includes, among other things, making a threshold showing that the subject matter of BACnet relied upon in the Petition indeed was made publicly accessible before January 9, 1999. Alarm.com does not satisfy this burden because it does not attempt to delineate whether the subject matter of BACnet relied upon in its Petition is entitled to a 1995 or 1999 priority date.

In any event, to the extent Alarm.com relies upon the substantive changes made to BACnet in 1999 to formulate its asserted grounds based on obviousness, there is insufficient argument or evidence in this record to support a determination that these changes were made publicly accessible in the mere eight days of 1999 prior to January 9. Consequently, we are not persuaded that as of January 9, 1999, the subject matter of BACnet relied upon by Alarm.com in its Petition was made sufficiently accessible to the public interested in the art and, therefore, qualifies as prior art to the ’601 patent.

C. Obviousness Grounds Based, In-Part, on Honeywell and BACnet

As we explained previously, each of the grounds asserted by Alarm.com in its Petition is based, in part, on Honeywell and BACnet. Alarm.com has not demonstrated sufficiently that Honeywell and BACnet are available as prior art to the ’601 patent under §§ 102(a) and 102(b). Consequently, Alarm.com has not demonstrated a reasonable likelihood that

it would prevail in its assertions that (1) claims 1–3, 22–24, 26, 30, 32, 42, and 43 would have been obvious over the combination of Wewalaarachchi, Honeywell, and BACnet; and (2) these same claims would have been obvious over the combination of Wewalaarachchi, Honeywell, BACnet, and Levac.

D. Other Considerations

Alarm.com filed a Brief limited to addressing certain aspects of Vivint’s Request for Certificate of Correction for the ’601 patent, which was filed on December 17, 2015 (“the ’601 Request”). Pet. Brief 1–2. In its Brief, Alarm.com represents that the ’601 Request only seeks to correct the claim language of dependent claim 39. *Id.* at 1. The current situation does not require us to assess the possible impact of this proposed correction on the arguments and evidence advanced by Alarm.com in its Petition because dependent claim 39 is not challenged. We will reassess the stay imposed on the ’601 Request following consideration of Alarm.com’s request for an *inter partes* review of claims 1, 2, 4–23, 25–31, and 33–41 of the ’601 patent in Case IPR2016-00116.

III. CONCLUSION

Taking into account the arguments presented in Vivint’s Preliminary Response, we conclude that the information presented in the Petition does not establish that there is a reasonable likelihood that Alarm.com would prevail in challenging any of claims 1–3, 22–24, 26, 30, 32, 42, and 43 of the ’601 patent as unpatentable under § 103(a).

IV. ORDER

In consideration of the foregoing, it is ORDERED that the Petition is DENIED, and no trial is instituted.

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Patent 6,147,601

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