

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ALARM.COM INC.,
Petitioner,

v.

VIVINT, INC.,
Patent Owner.

Case IPR2015-01995, Case IPR2015-01997, Case IPR2015-02003,
Case IPR2015-02004, Case IPR2016-00116, Case IPR2016-00129,
Case IPR2016-00155, Case IPR2016-00161, and Case IPR2016-00173
(Patents 6,147,601, 6,462,654 B1, 6,535,123 B2, and 6,717,513 B1)¹

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

BOUDREAU, *Administrative Patent Judge*.

ORDER
Conduct of Proceeding
37 C.F.R. § 42.5

On January 19, 2016, Petitioner requested a telephone conference
with the panel regarding Patent Owner's December 17, 2015, filing of

¹ This Order addresses an issue pertaining to all nine identified cases.
Therefore, we exercise our discretion to issue one Order to be filed in each

Case IPR2015-01995, Case IPR2015-01997, Case IPR2015-02003, Case IPR2015-02004, Case IPR2016-00116, Case IPR2016-00129, Case IPR2016-00155, Case IPR2016-00161, and Case IPR2016-00173 (Patents 6,147,601, 6,462,654 B1, 6,535,123 B2, and 6,717,513 B1)

Requests for Certificates of Correction (“Requests”) with respect to each of the four patents involved in the above-captioned proceedings. Pursuant to Petitioner’s request, we held a telephone conference on January 27, 2016. Counsel for the parties participated, along with Administrative Patent Judges Arpin, Boudreau, and Zecher.

BACKGROUND

Petitioner filed Petitions in these proceedings on various dates ranging from September 28, 2015, to November 9, 2015, seeking *inter partes* review of certain claims of U.S. Patent Nos. 6,147,601,² 6,462,654 B1,³ 6,535,123 B2,⁴ and 6,717,513 B1⁵ (collectively, “the Involved Patents”). On December 17, 2015, Patent Owner filed the Requests with respect to the respective Involved Patents in the Office. Patent Owner did not request authorization from the panel prior to filing the Requests and did not notify the panel of the filing of the Requests upon their filing. On January 8, 2016, Patent Owner filed Preliminary Responses in Cases IPR2015-01995,

case. The parties are not authorized to use this style heading for any subsequent papers.

² See Case IPR2015-02004 (Paper 1); Case IPR2016-00116 (Paper 1); Case IPR2016-00155 (Paper 1).

³ See Case IPR2015-02003 (Paper 1); Case IPR2016-00161 (Paper 1).

⁴ See Case IPR2015-01995 (Paper 1); Case IPR2016-00173 (Paper 1).

⁵ See Case IPR2015-01997 (Paper 1); Case IPR2016-00129 (Paper 1).

Case IPR2015-01995, Case IPR2015-01997, Case IPR2015-02003, Case IPR2015-02004, Case IPR2016-00116, Case IPR2016-00129, Case IPR2016-00155, Case IPR2016-00161, and Case IPR2016-00173 (Patents 6,147,601, 6,462,654 B1, 6,535,123 B2, and 6,717,513 B1)

IPR2015-01997, IPR2015-02003, and IPR2015-02004.⁶ Those Preliminary Responses reference the respective Requests.⁷

Petitioner represented during the telephone conference that it disputes Patent Owner’s characterization of the corrections in the Requests as being “of a clerical or typographical nature, or of a minor character,” at least with respect to certain of the corrections. 35 U.S.C. § 255.

DISCUSSION

Under 37 C.F.R. § 42.3, “[t]he Board may exercise exclusive jurisdiction within the Office over *every* involved application and patent *during [a] proceeding*, as the Board may order” (emphases added). Under 37 C.F.R. § 42.2, “*Proceeding* means a trial or preliminary proceeding,” where a “*Preliminary Proceeding* begins with the filing of a petition for instituting a trial and ends with a written decision as to whether a trial will be instituted.”

Pursuant to 37 C.F.R. § 42.3, we hereby exercise jurisdiction over the Requests, filed as they were after the Petitions in these proceedings, pending our determination whether or not to institute *inter partes* review. For any

⁶ Patent Owner’s Preliminary Responses in the remaining cases are due on February 5, 2016 (Case IPR2016-00116), February 16, 2016 (Cases IPR2016-00129, IPR2016-00155, and IPR2016-00161), and February 18, 2016 (Case IPR2016-00173)

⁷ Case IPR2015-01995 (Paper 9, 2 n.1); IPR2015-01997 (Paper 9, 34 n.4); IPR2015-02003 (Paper 9, 27); IPR2015-02004 (Paper 9, iv n.1).

Case IPR2015-01995, Case IPR2015-01997, Case IPR2015-02003, Case IPR2015-02004, Case IPR2016-00116, Case IPR2016-00129, Case IPR2016-00155, Case IPR2016-00161, and Case IPR2016-00173 (Patents 6,147,601, 6,462,654 B1, 6,535,123 B2, and 6,717,513 B1)

claims for which correction is sought and for which we institute *inter partes* review, we order that consideration of the Requests by the Certificate of Correction Branch is stayed and will maintain jurisdiction over the Requests for the pendency of trial, including making a determination whether or not the Requests satisfy 35 U.S.C. § 255 and 37 C.F.R. §§ 1.322 and 1.323. Otherwise, if we determine not to institute review of any claims for which correction is sought, Patent Owner's Requests will be returned to the jurisdiction of the Certificate of Correction Branch for further action.

Further, because Petitioner did not have the benefit of having the proposed corrected claim language in the Requests at the time the Petitions were filed, and yet Patent Owner did have the benefit of those proposed corrections when it filed its Preliminary Responses, we authorize Petitioner to file a reply brief, no more than five pages in length, in each of the four cases in which Patent Owner has already filed a Preliminary Response (i.e., Cases IPR2015-01995, IPR2015-01997, IPR2015-02003, and IPR2015-02004). Petitioner's reply briefs shall be limited to arguments, if any, as to (1) why Patent Owner's proposed corrections are not merely "of a clerical or typographical nature, or of a minor character," such that the Certificate of Correction for the respective patent should not be entered; (2) why Petitioner was unable to discern the requested corrections unassisted⁸; and (3) where

⁸ In this regard, we note that Petitioner appears to have been able to discern the requested correction with respect at least to U.S. Patent No. 6,717,513 B1. *See* Case IPR2015-01997 (Paper 1, 18) (recognizing that "[t]here is no

Case IPR2015-01995, Case IPR2015-01997, Case IPR2015-02003, Case IPR2015-02004, Case IPR2016-00116, Case IPR2016-00129, Case IPR2016-00155, Case IPR2016-00161, and Case IPR2016-00173 (Patents 6,147,601, 6,462,654 B1, 6,535,123 B2, and 6,717,513 B1)

the references cited in the respective Petition disclose the corrected claim elements. Petitioner also is authorized to file a brief, subject to the same limitations set forth above for the reply briefs, in each of the five cases in which Patent Owner has not yet filed a Preliminary Response (i.e., Cases IPR2016-00116, IPR2016-00129, IPR2016-0155, IPR2016-00161, and IPR2016-00173).

No further briefing by Patent Owner is authorized at this time in Cases IPR2015-01995, IPR2015-01997, IPR2015-02003, and IPR2015-02004, in which Patent Owner already has filed a Preliminary Response. The Board, nonetheless, will determine upon review of Petitioner's reply briefs whether or not to authorize additional briefing from Patent Owner.

As we explained during the telephone conference, Patent Owner is not authorized to file any papers in the Office while a proceeding is pending before the Board with respect to an involved patent, *except with the Board's prior authorization*. Despite Patent Owner's suggestion during the telephone conference that this is inconsistent with non-precedential decisions by other panels, we note that the same instruction was

antecedent basis for the 'message generating mechanism' of claim 9 unless the 'said message generating mechanism' of claim 9 is intended to refer to the 'message generating means' of claim 8" and recognizing that "[s]uch an error in claim drafting can be corrected 'by interpretation of the patent' where, as here, the error is not 'subject to reasonable debate' and where the 'prosecution history does not suggest a different interpretation.'"); Case IPR2016-00129 (Paper 1, 16) (same).

Case IPR2015-01995, Case IPR2015-01997, Case IPR2015-02003, Case IPR2015-02004, Case IPR2016-00116, Case IPR2016-00129, Case IPR2016-00155, Case IPR2016-00161, and Case IPR2016-00173 (Patents 6,147,601, 6,462,654 B1, 6,535,123 B2, and 6,717,513 B1)

communicated by the Board in *ASML Netherlands B.V. v. Energetiq Technology, Inc.*, a case cited by Patent Owner during the telephone conference. *See* IPR2015-01375 (Ex. 2003) (instructing that the patent owner “should not file any papers, including a request to a department of the Office outside of the PTAB to issue a Certificate of Correction, while the case is pending before the PTAB. 37 CFR 42.3.”). Indeed, in the Board’s decision granting the patent owner’s request in that case, it was significant that—unlike in the present proceedings—the errors sought to be corrected were the Office’s errors, not the patentee’s, and were “disclosed clearly in the records of the application”; and “[m]ore importantly,” the patent owner confirmed that the claim sought to be corrected “is not involved in this *inter partes* review” and “[a]s such, a certificate of correction for the aforementioned typographical errors will not impact this review.”

(Paper 11, 2–3). Notably, in *Pharmacosmos A/S v. Luitpold Pharms.*, Case IPR2015-01490, also cited by Patent Owner, the patent owner affirmatively sought authorization from the Board *prior to* filing a request or motion for certificate of correction. Paper 8, 2–3. And in a third case cited by Patent Owner, *International Flavors & Fragrances Inc. v. ZoomEssence, Inc.*, Case IPR2015-01418, the patent owner was not seeking to file a request for a certificate of correction at all, but was instead seeking to file a copy of a certificate of correction that issued from a request filed more than four months before the petition was filed. Paper 8, 2–3. Even then, the patent owner sought authorization from the Board prior to filing that copy. *Id.* at

Case IPR2015-01995, Case IPR2015-01997, Case IPR2015-02003,
Case IPR2015-02004, Case IPR2016-00116, Case IPR2016-00129,
Case IPR2016-00155, Case IPR2016-00161, and Case IPR2016-00173
(Patents 6,147,601, 6,462,654 B1, 6,535,123 B2, and 6,717,513 B1)

1–2. Consequently, Patent Owner’s citation to these non-precedential panel decisions does not persuade us that Patent Owner’s failure to notify the

Case IPR2015-01995, Case IPR2015-01997, Case IPR2015-02003, Case IPR2015-02004, Case IPR2016-00116, Case IPR2016-00129, Case IPR2016-00155, Case IPR2016-00161, and Case IPR2016-00173 (Patents 6,147,601, 6,462,654 B1, 6,535,123 B2, and 6,717,513 B1)

Board promptly of the filing of its Requests in the each of the present Cases was justified.

It is

ORDERED that Patent Owner's Requests for Certificates of Correction filed December 17, 2015, with respect to U.S. Patent Nos. 6,147,601, 6,462,654 B1, 6,535,123 B2, and 6,717,513 B1 are hereby *stayed* pending the Board's decision on institution in each of Cases IPR2015-01995, IPR2015-01997, IPR2015-02003, IPR2015-02004, IPR2016-00116, IPR2016-00129, IPR2016-00155, IPR2016-00161, and IPR2016-00173;

FURTHER ORDERED that Petitioner is authorized to file a brief, no more than five pages in length, and not later than the close of business on February 3, 2016, in each of Cases IPR2015-01995, IPR2015-01997, IPR2015-02003, IPR2015-02004, IPR2016-00116, IPR2016-00129, IPR2016-00155, IPR2016-00161, and IPR2016-00173, limited to arguments, if any, as to (1) why the corrections proposed in the respective Requests are not merely "of a clerical or typographical nature, or of a minor character," such that the Certificates of Correction should not be entered; (2) why Petitioner was unable to discern the requested corrections unassisted; and (3) where the references cited in the respective petition disclose the corrected claim elements; and

Case IPR2015-01995, Case IPR2015-01997, Case IPR2015-02003,
Case IPR2015-02004, Case IPR2016-00116, Case IPR2016-00129,
Case IPR2016-00155, Case IPR2016-00161, and Case IPR2016-00173
(Patents 6,147,601, 6,462,654 B1, 6,535,123 B2, and 6,717,513 B1)

FURTHER ORDERED that no additional filings by Patent Owner are
authorized at this time in Cases IPR2015-01995, IPR2015-01997, IPR2015-
02003, and IPR2015-02004.

Case IPR2015-01995, Case IPR2015-01997, Case IPR2015-02003,
Case IPR2015-02004, Case IPR2016-00116, Case IPR2016-00129,
Case IPR2016-00155, Case IPR2016-00161, and Case IPR2016-00173
(Patents 6,147,601, 6,462,654 B1, 6,535,123 B2, and 6,717,513 B1)

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