

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ALARM.COM, INC.,
Petitioner,

v.

VIVINT, INC.,
Patent Owner.

IPR2022-00728
Patent 9,349,262 B2

Before MICHAEL R. ZECHER, CHARLES J. BOUDREAU, and
IFTIKHAR AHMED, *Administrative Patent Judges*.

BOUDREAU, *Administrative Patent Judge*.

DECISION
Denying Institution of *Inter Partes* Review
35 U.S.C. § 314(a)

I. INTRODUCTION

Alarm.com, Inc. (“Petitioner”) filed a Petition requesting *inter partes* review of claims 1, 2, 4–8, and 11–13 of U.S. Patent No. 9,349,262 B2 (Ex. 1001, “the ’262 patent”). Paper 2 (“Pet.”). Patent Owner did not file a preliminary response.

After considering the Petition and associated evidence, we exercise our discretion to deny institution of *inter partes* review under 35 U.S.C. § 325(d) (2012).

II. BACKGROUND

A. *Real Parties in Interest*

Petitioner identifies itself and Alarm.com Holdings, Inc. as real parties in interest. Pet. 1.

Regarding real parties in interest for Patent Owner, Vivint, Inc. identifies itself as the owner by assignment of the ’262 patent and states that it is “a wholly owned subsidiary of Vivint Smart Home, Inc.” Paper 3, 2 (Patent Owner’s Mandatory Notices).

B. *Related Matters*

The parties advise us that the ’262 patent is involved in district court litigation between the parties, captioned as *Vivint, Inc. v. ADT LLC*, No. 2:21-cv-00115-CW-DBP (D. Utah). Pet. 1; Paper 3, 2.

Petitioner further advises us that the instant Petition is substantially identical to a petition filed by ADT LLC on February 15, 2022 (“the ADT Petition”),¹ and that “[i]n the event that *Inter Partes* Review is instituted

¹ Notably, ADT LLC also identified Alarm.com, Inc. and Alarm.com Holdings, Inc.—i.e., both of the real parties in interest for Petitioner in the instant proceeding—as real parties in interest in the ADT Petition. See IPR2022-00612, Paper 1 (ADT Petition) at 1.

based on the ADT Petition, Petitioner intends to move to join in that proceeding.” Pet. 1. In a decision dated August 22, 2022, we denied institution of *inter partes* review based on the ADT Petition. *ADT LLC v. Vivint, Inc.*, IPR2022-00612, Paper 8 (PTAB Aug. 22, 2022) (Decision Denying Institution). ADT LLC filed a request for rehearing of that decision on September 21, 2022. IPR2022-00612, Paper 9. We denied ADT LLC’s request on October 28, 2022. IPR2022-00612, Paper 10.

C. The ’262 Patent

The ’262 patent, titled “Security System Providing a Localized Humanly-Perceivable Alert for Identifying a Facility to Emergency Personnel,” is directed to systems and methods for guiding emergency personnel to a location in a facility proximate to an alarm that has been generated, including security systems that use lights or other indicators to help emergency responders identify the facility that generated the alarm to which they are responding. Ex. 1001, codes (54), (57), 1:17–20, 5:35–37. According to the ’262 patent, security systems may generate an alarm, for example, in the case of “unauthorized entry, fire, medical emergency, or manual alarm activation,” and send a notification signal to a central station, which, in turn, contacts an appropriate emergency response agency. *Id.* at 1:29–44. A challenge exists, however, for emergency personnel in finding the facility that generated the alarm. *Id.* at 1:45–46.

To address this challenge, the ’262 patent describes, *inter alia*, a security system that “includes one or more sensors that generate an alarm condition message in response to an alarm condition” and “may also include a control unit that is communicatively coupled to the sensor and that receives the alarm condition message from the sensor and that sends an identification message to a controller for an indicator.” Ex. 1001, 1:61–2:1.

“The controller receives the identification message from the control unit and causes the indicator to generate an identifying alert” that “may be humanly perceivable from the exterior of the facility protected by the security system.” *Id.* at 2:1–5. “In certain embodiments, the indicator may also localize the identifying alert to a location of the facility where the alarm condition occurred.” *Id.* at 2:11–13. “For example, if a smoke detector detects smoke, the selected indicator may be the interior light in the room containing the smoke detector.” *Id.* at 2:13–15.

Figure 3 of the '262 patent is reproduced below.

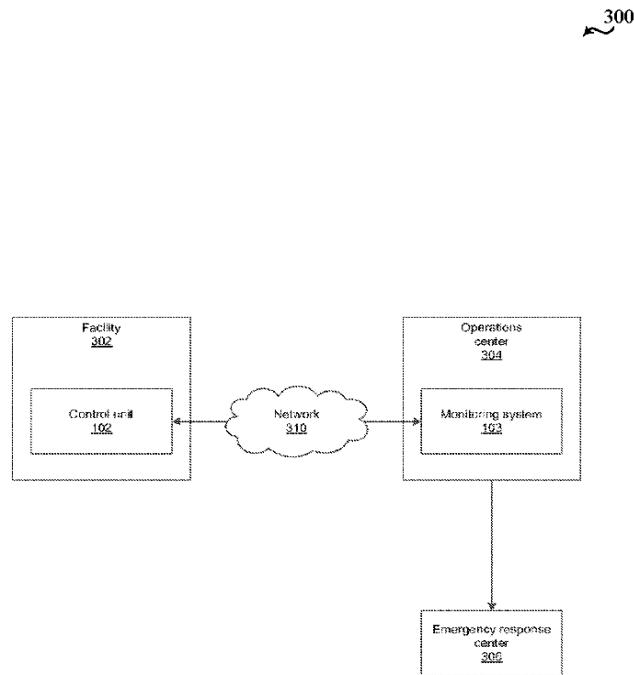


FIG. 3

Figure 3, above, is a schematic block diagram of system 300 according to the '262 patent. Ex. 1001, 2:62–64, 5:61–63. System 300 includes

facility 302, which is a physical location, such as a residence or place of business, and includes control unit 102. *Id.* at 5:63–67. System 300 also includes operations center 304, which implements monitoring system 103, and emergency response center 306. *Id.* at 6:3–4, 6:18–20. Network 310 may connect monitoring system 103 with control unit 102. *Id.* at 6:46–49. In operation, control unit 102 may send an alarm condition notification to monitoring system 103, for example, indicating that a fire alarm at facility 302 has been triggered. *Id.* at 6:21–23. In response, a security representative at operations center 304 may confirm that there is a fire at facility 302 and request the dispatch of firefighters. *Id.* at 6:27–29. The security representative may then cause an exterior light at facility 302 to flash on and off for help in locating facility 302. *Id.* at 6:33–37. In addition, the security representative may also cause interior or exterior lights “near the location of the alarm condition (e.g. in close proximity to the sensor(s) 101 [not shown in Figure 3] from which the alarm condition message originated) to flash on and off,” in order to identify “the particular location or area, room, etc., within facility 302” with the alarm condition. *Id.* at 6:37–45.

Figure 5 of the '262 patent is reproduced below.

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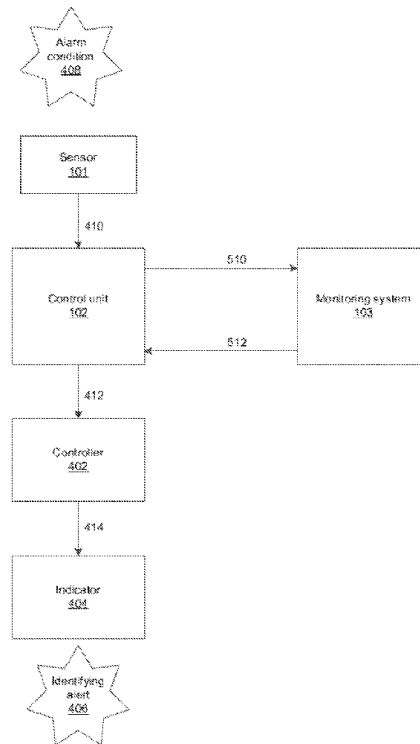


FIG. 5

Figure 5, above, is a schematic block diagram of another embodiment of the '262 patent. Ex. 1001, 3:1–3; 8:48–49. Here, upon a security representative dispatching emergency personnel to facility 302, “monitoring system 103 may send a dispatch notification 512 to the control unit 102.” *Id.* at 8:59–66. Control unit 102 may then send identification message 412 to controller 402, where controller 402 “may be an electronic device communicatively coupled to the control unit 102 and the indicator 404.” *Id.* at 9:4–7; 7:40–41. “[I]ndicator 404 may be a physical device capable of generating a humanly perceivable identifying alert,” for example, “an interior light that is visible from the street through a window,” “an exterior light, such as a porch light or street lamp, that is visible from the street,” or “an audible alarm.” *Id.*

at 7:60–62; 8:1–4; 8:17. Identification message 412 instructs controller 402 to generate identifying alert 406 via indicator 404. *Id.* at 7:26–28.

D. Overview of the Challenged Claims

Of the challenged claims, claims 1, 8, and 11 are independent. Claim 1, reproduced below, is illustrative of the challenged claims:

1. A security and automation system comprising:
 - a sensor, at a premises, configured to generate an alarm condition message in response to an alarm condition;
 - a control unit, at the premises, communicatively coupled to the sensor and to at least one indicator, the control unit configured to:
 - receive the alarm condition message from the sensor;
 - determine a location of the alarm condition based at least in part on the alarm condition message; and
 - send the alarm condition message to a remote monitoring service, wherein the remote monitoring service filters out false alarms from received alarm condition messages;
 - receive a command from the remote monitoring service, the command identifying a specific light at the premises and including an instruction to turn on the specified light, wherein the command is based at least in part on sending the alarm condition to the remote monitoring service;
 - execute the command from the remote monitoring service to turn on the specified light;
 - receive, from the remote monitoring service, a dispatch notification indicating that emergency personnel are dispatched to the premises in response to the remote monitoring service contacting the emergency personnel.

Ex. 1001, 12:62–13:20.

E. Prosecution History

The '262 patent issued May 24, 2016, from an application filed March 14, 2014, and claims priority from a provisional application filed March 15, 2013. Ex. 1001, codes (22), (45), (60).

During prosecution, the examiner issued a first non-final Office Action rejecting each of the original independent claims as being anticipated by, and certain of the original dependent claims as being either anticipated by or obvious over, U.S. Patent No. 8,624,735 B2 (“Kellen,” Ex. 3001). *See* Ex. 1002, 150–53.² The examiner also included with the first Office Action a Notice of References Cited, listing a total of thirteen references, including, among others, Kellen and U.S. Patent No. 6,400,265 B1 to Saylor (hereinafter, “Saylor ’265”). *Id.* at 155. A copy of Saylor ’265 is included in the record of this proceeding as Exhibit 3002.

In response to the first Office Action, the applicant amended each of the original independent claims to recite “receiv[ing] a dispatch of emergency personnel to the facility protected by the security system, wherein causing the identifying alert is based at least in part on the received dispatch of emergency personnel,” which is a limitation that had previously been recited in a dependent claim that the examiner had determined to be allowable if rewritten in independent form. Ex. 1002, 138–41, *see also id.* at 211 (original dependent claim 12).

Following the amendment, the examiner issued a second non-final Office Action, rejecting all then-pending claims under 35 U.S.C. § 103 over

² All references to the page numbers in the prosecution history of the '262 patent refer to the page numbers inserted by Petitioner in the lower-right corner of each page in Exhibit 1002.

the combination of Kellen and U.S. Patent No. 5,991,363 (“Thomson,” Ex. 3003). Ex. 1002, 116–19.

In response to the second non-final Office Action, the applicant again amended the claims, adding, among other things, the “send[ing] the alarm condition,” “receiv[ing] a command,” and “execut[ing] the command” limitations to each of the then-pending independent claims. Ex. 1002, 72–77. The applicant argued that “[n]either Kellen, nor Thomson, individually or in combination, can be relied upon to teach or suggest” those limitations. *Id.* at 79. For example, the applicant acknowledged that Kellen describes an alarm system that includes “a light control system responsive to [a] specific intrusion location signal” and “configured to control light emitted from an indicator light . . . the indicator light being located within an outer perimeter zones of [an] enclosed space, the indicator light being configured . . . to direct light towards the specific location of the intrusion,” but argued that “[a]n alarm system that detects an intrusion and controls an outside light based on the detected intrusion does not teach or suggest sending a message to a remote monitoring service, much less receiving a command from the remote monitoring service regarding ‘a specific light at the premises,’ as recited in claim 1.” *Id.*

Responsive to the applicant’s amendment, the examiner entered a Notice of Allowability, allowing all of the then-pending claims. Ex. 1002, 46–48. In the Notice of Allowability, the examiner stated:

The following is an examiner’s statement of reasons for allowance: *the prior art of record fails to describe and/or suggest a security and automation system comprising a sensor, at a premises, configured to generate an alarm condition message in response to an alarm condition*; a control unit, at the premises, communicatively coupled to the sensor and to at least one indicator, the control unit configured to: receive the alarm

condition message from the sensor; determine a location of the alarm condition based at least in part on the alarm condition message; and send the alarm condition message to a remote monitoring service, wherein the remote monitoring service filters out false alarms from received alarm condition messages; receive a command from the remote monitoring service, the command identifying a specific light at the premises and including an instruction to turn on the specified light, wherein the command is based at least in part on sending the alarm condition to the remote monitoring service.

These, along with further limitations set forth by the claims render the application allowable over *the prior art of record*.

Id. at 47 (italics added).

F. Asserted Grounds

Petitioner asserts the following grounds of unpatentability:

Claims Challenged	35 U.S.C. §³	Basis
1, 2, 4–8, 11–13	103	Saylor, ⁴ Gregory, ⁵ Elliot ⁶
1, 2, 4–8, 11–13	103	Saylor, Gregory, Elliot, Siegler ⁷

³ The Leahy-Smith America Invents Act, Pub. L. No. 112-29, 125 Stat. 284 (2011) (“AIA”), amended 35 U.S.C. § 103. Because the ’262 patent is alleged to have an effective filing date before March 16, 2013, which is the effective date of the applicable AIA amendments, we refer to the pre-AIA version of 35 U.S.C. § 103. *See* Ex. 1001, code (60).

⁴ Saylor et al., US 6,661,340 B1, issued Dec. 9, 2003 (Ex. 1004).

⁵ Gregory, US 2010/0265089 A1, published Oct. 21, 2010 (Ex. 1005).

⁶ Elliot et al., US 7,734,020 B2, issued June 8, 2010 (Ex. 1006).

⁷ Siegler, II et al., US 8,310,365 B2, issued Nov. 13, 2012 (Ex. 1007).

Claims Challenged	35 U.S.C. §³	Basis
1, 2, 4–8, 11–13	103	Saylor, Gregory, Elliot, Gagvani ⁸
1, 2, 4–8, 11–13	103	Saylor, Gregory, Elliot, Gagvani, Siegler

Pet. 2–3, 6–48. Petitioner also relies on a Declaration of Peter Rysavy. (Ex. 1009).

III. ANALYSIS

As noted in the above Introduction, we exercise our discretion to deny institution of an *inter partes* review pursuant to 35 U.S.C. § 325(d). Accordingly, we need not discuss in depth the merits of Petitioner’s obviousness challenge. Nevertheless, to the extent the definition of a person of ordinary skill in the art or the meaning of certain claim terms is relevant to this proceeding, we address them below. We further note that our analysis with respect to § 325(d) substantially relates to the Saylor and Gregory references that constitute two of the three primary references in each of the asserted grounds. To provide context for those arguments, we also provide an overview of those references and Elliot, the third reference common to all asserted grounds.

A. Level of Ordinary Skill in the Art

Petitioner proposes that a person having ordinary skill in the art “at the time of the alleged invention would have had at least a bachelor’s degree in computer science, electrical engineering, or computer engineering (or equivalent experience), and at least two years of professional experience in remote monitoring and control systems, Internet of Things (‘IoT’), home

⁸ Gagvani et al., US 2009/0022362 A1, published Jan. 22, 2009 (Ex. 1008).

security systems, building automation systems, machine-to-machine (‘M2M’) communications, or other similarly relevant industry experience.” Pet. 6 (citing Ex. 1009 ¶ 25).

Based on our review of the record at this stage, we find that Petitioner’s proposal is consistent with the level of skill reflected in the prior art references of record. *See Daiichi Sankyo Co. v. Apotex, Inc.*, 501 F.3d 1254, 1256 (Fed. Cir. 2007) (listing the type of problems encountered in the art, prior art solutions to those problems, and the sophistication of the technology as factors that may be considered in determining the level of ordinary skill in the art). *See also Okajima v. Bourdeau*, 261 F.3d 1350, 1355 (Fed. Cir. 2001) (explaining that specific findings regarding ordinary skill level are not required “where the prior art itself reflects an appropriate level and a need for testimony is not shown”).

Accordingly, for purposes of this decision and to the extent necessary, we adopt Petitioner’s definition of the person of ordinary skill in the art.

B. Claim Construction

In an *inter partes* review based on a petition filed on or after November 13, 2018, we interpret claim terms using “the same claim construction standard that would be used to construe the claim in a civil action under 35 U.S.C. 282(b), including construing the claim in accordance with the ordinary and customary meaning of such claim as understood by one of ordinary skill in the art and the prosecution history pertaining to the patent.” 37 C.F.R. § 42.100(b) (2021).

Petitioner does not propose constructions for any claim terms. *See* Pet. 6 (citing 37 C.F.R. § 42.100(b)). On this record, we determine that no terms or phrases in the claims require express construction. *See Nidec Motor Corp. v. Zhongshan Broad Ocean Motor Co.*, 868 F.3d 1013, 1017

(Fed. Cir. 2017) (“[W]e need only construe terms ‘that are in controversy, and only to the extent necessary to resolve the controversy’” (quoting *Vivid Techs., Inc. v. Am. Sci. & Eng’g, Inc.*, 200 F.3d 795, 803 (Fed. Cir. 1999))).

C. Overview of Saylor, Gregory, and Elliot

1. Saylor

Saylor, titled “System and Method for Connecting Security Systems to a Wireless Device,” describes a personal security network for a system of security devices that may be connected to a central security network and that allows the user to personalize alert notifications. Ex. 1004, codes (54), (57), 3:41–43.

Figure 2 of Saylor is reproduced below.

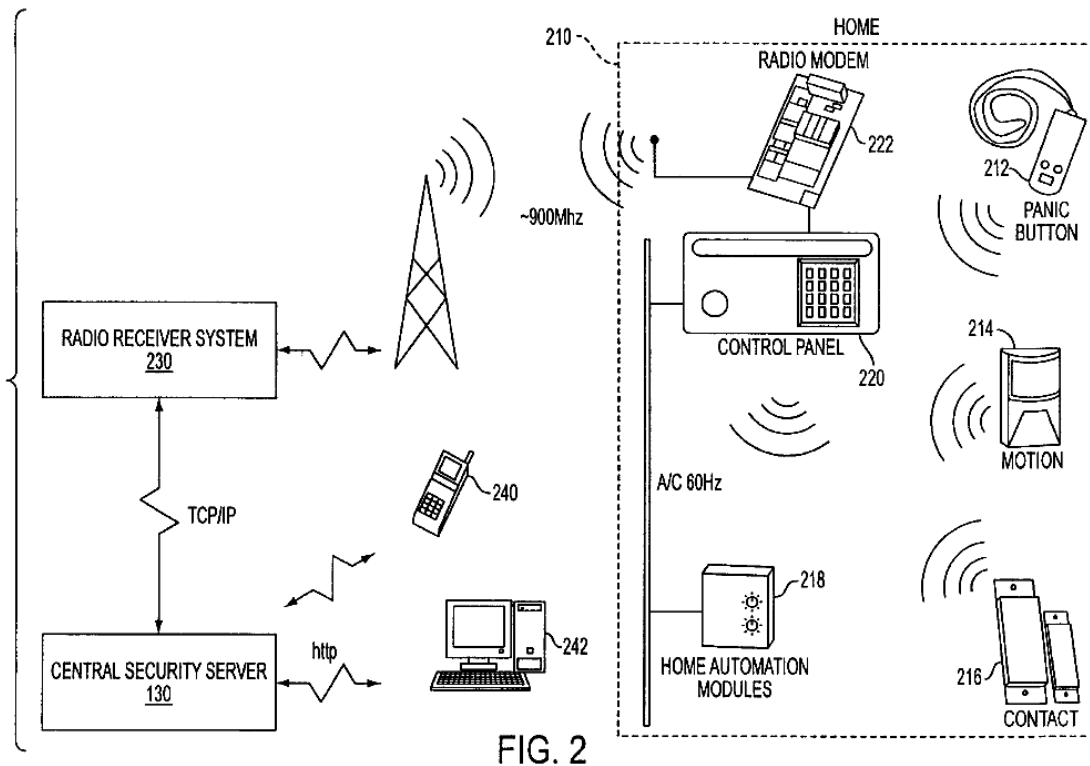


Figure 2, above, is “an example of an alarm transmission, according to an embodiment of [Saylor’s] invention.” *Id.* at 5:50–51. In this example,

home 210 includes a number of devices 212, 214, 216, and 218 in communication with control panel 220. *Id.* at 5:51–55. Control panel 220 may send alarm and other data to central security server 130. *Id.* at 5:55–62. “Central security server 130 may then alert users and other identified entities via wireless and/or other devices, such as mobile device 240, via a voice alarm, text message and other notifications.” *Id.* at 5:62–65. A user may define various preferences as to the timing of notifying the user, sounding an alarm, and contacting an emergency entity, in order to reduce false alarms. *See id.* at 6:40–55.

2. *Gregory*

Gregory, titled “Emergency Location Finder,” describes “[a] light system for identifying a target location for emergency vehicles.” Ex. 1005, codes (54), (57), ¶¶ 8, 14. *Gregory*’s light system may include “a light fixture suitable for use outdoors, a bulb suitable for use in the fixture, and an activation mechanism for selecting and changing between a ‘constant on’ mode, a ‘constant off’ mode, and a ‘blinking’ mode.” *Id.* ¶¶ 8, 14, 19, 20. According to *Gregory*, the light system may be incorporated into or activated by a security system for alerting a homeowner or security company when an emergency is indicated at the location. *Id.* ¶ 17. The emergency lighting system can cooperate with a home security system “to provide a strong visual indicator of the location of the home when the security system is instructed to provide the emergency location lights.” *Id.* ¶ 28.

Figure 1 of *Gregory* is reproduced below.



Fig. 1

Figure 1, above, shows “a lighting system according to one embodiment of [Gregory’s] invention, installed on a house.” Ex. 1005 ¶ 11. As depicted in Figure 1, Gregory discloses that “[t]he emergency light or lights (12) are preferably located on the outside of a building where they can easily be seen by emergency personnel.” *Id.* ¶ 29. “The lights are positioned so as to easily be noticed by emergency response personnel.” *Id.* “For example, the lights may be on the building itself, or on another, nearby structure such as a mailbox or lamppost.” *Id.* In a preferred embodiment, the lights may be “dual-purpose” lights that are designed and adapted to act as, for example, standard porch, outer garage area, driveway, or front entrance lights. *Id.* ¶¶ 18, 23, 30, 31. In this case, a light may be controlled by a manual switch for standard use, and by an emergency light controller when used as emergency location identifiers. *Id.* ¶ 32. The controller may either be activated “automatically when the home security system detects an emergency situation,” or “when directed to do so by personnel monitoring

the home security system.” *Id.* ¶ 33. Further, “[t]he light controller preferably cause the lights to flash in a manner effective to draw attention from an emergency responder who is looking for the location.” *Id.* ¶ 34.

3. *Elliot*

Elliot, titled “Two-Way Voice and Voice Over IP Receivers for Alarm Systems,” recognizes a problem where “Voice-over-IP service may impact the reliability of a security (alarm) system by interfering with its ability to report alarms to a consumer’s monitoring station.” Ex. 1006, code (54), 2:4–6. Accordingly, *Elliot* describes “placing an alarm receiver (at security system central station) directly onto a private Voice-over-IP network shared by the customer, thereby eliminating the need for a Voice-over-IP system to re-dial the central station over a standard telephone line.” *Id.* at 3:42–46. In an embodiment, an alarm panel can “enter ‘speakerphone’ mode, whereby an operator at the central station can listen in to the room where the alarm panel is located, and optionally engage in conversation with persons in the alarm-monitored premise.” *Id.* at 5:47–52. This can allow an alarm monitoring company to quickly determine whether there is a false alarm. *Id.* at 5:52–54. *Elliot* also discloses that “the system may be used in a one-way mode of operation to send voice messages to [the] alarm panel [that] may be played on a speaker at the alarm site (e.g., ‘help is on the way, the Police/Fire/EMT have been called’),” where “[s]uch one way messages may reassure the consumer and/or frighten off potential burglars or the like.” *Id.* at 9:36–48.

D. *Discretion under 35 U.S.C. § 325(d)*

1. *Framework*

“In determining whether to institute or order [an *inter partes* review], the Director may take into account whether, and reject the petition or request

because, the same or substantially the same prior art or arguments previously were presented to the Office.” 35 U.S.C. § 325(d). The Director has delegated that discretion to the Board. 37 C.F.R. § 42.4(a).

In *Advanced Bionics, LLC v. Med-El Elektromedizinische Geräte GMBH*, IPR2019-01469, Paper 6 (PTAB Feb. 13, 2020) (precedential (“*Advanced Bionics*”), the Board applied a two-part framework in considering whether to exercise discretion to deny institution under § 325(d): “(1) whether the same or substantially the same art previously was presented to the Office or whether the same or substantially the same arguments previously were presented to the Office; and (2) if either condition of first part of the framework is satisfied, whether the petitioner has demonstrated that the Office erred in a manner material to the patentability of challenged claims.” *Advanced Bionics*, Paper 6 at 8.

Within this two-part framework, the Board considers a number of non-exclusive factors in evaluating whether to exercise its discretion under § 325(d). See *Becton, Dickinson & Co. v. B. Braun Melsungen AG*, IPR2017-01586, Paper 8 (PTAB Dec. 15, 2017) (precedential as to § III.C.5, first para.) (“*Becton, Dickinson*”); see also *Advanced Bionics*, Paper 6 at 9–11. The factors set forth in *Becton, Dickinson* are as follows:

- (a) the similarities and material differences between the asserted art and the prior art involved during examination;
- (b) the cumulative nature of the asserted art and the prior art evaluated during examination;
- (c) the extent to which the asserted art was evaluated during examination, including whether the prior art was the basis for rejection;
- (d) the extent of the overlap between the arguments made during examination and the manner in which Petitioner relies on the prior art;

- (e) whether Petitioner has pointed out sufficiently how the Examiner erred in its evaluation of the asserted prior art; and
- (f) the extent to which additional evidence and facts presented in the Petition warrant reconsideration of the prior art or arguments.

Becton, Dickinson, Paper 8 at 17–18.

Factors (a), (b), and (d) of the *Becton, Dickinson* factors relate to whether the art or arguments presented in the Petition are the same or substantially the same as those previously presented to the Office. *Advanced Bionics*, Paper 6 at 10. Factors (c), (e), and (f) “relate to whether the petitioner has demonstrated a material error by the Office” in its prior consideration of that art or arguments. *Id.* Only if the same or substantially the same art or arguments were previously presented to the Office do we then consider whether petitioner has demonstrated a material error by the Office. *Id.* “At bottom, this framework reflects a commitment to defer to previous Office evaluations of the evidence of record unless material error is shown.” *Id.* at 9.

2. *Petitioner’s Obviousness Challenges*

As set forth in Section II.F above, Petitioner contends that the challenged claims are unpatentable over the combination of Saylor, Gregory, and Elliot, either alone or in further combination with Siegler, Gagvani, or both. Pet. 3, 6–48. In each combination, Petitioner relies on Saylor as teaching all limitations of each of independent claims 1, 8, and 11, with the exception of “configuring the system to turn on a specified light in response to an alarm,” for which Petitioner relies on Gregory, and “receiving . . . a dispatch notification indicating that emergency personnel are dispatched to the premises,” for which Petitioner relies on Elliot. *Id.* at 17–28, 33–38. In certain of the asserted grounds, Petitioner also relies on Siegler in the

alternative to Saylor alone for the disclosure of determining a location of an alarm condition based on the alarm condition message (*id.* at 39–42, 47–48), and on Gagvani in the alternative to Saylor alone for the disclosure of filtering out false alarms from received alarm condition messages (*id.* at 42–48).

3. Discussion

Notwithstanding Petitioner’s assertion that “considerations under § 325(d) . . . do not apply” because this “is [only] the second petition as to the ’262 Patent” and “is substantially identical to the first petition (the ADT Petition) as it is intended as a duplicate joinder petition” (Pet. 48), 35 U.S.C. § 325(d) is not limited to instances where there have been multiple petitions filed against a patent. *See, e.g., Advanced Bionics* (denying institution of a first-filed petition under § 325(d) based on prior art having been previously considered and distinguished during original prosecution).

Having reviewed the record before us, we find that the Petition presents substantially the same prior art that was already considered by the examiner during prosecution of the challenged claims of the ’262 patent and that Petitioner has not demonstrated material error by the Office in its prior consideration of that art.

a. Whether the Same or Substantially the Same Art Previously Was Presented to the Office

Notwithstanding Petitioner’s contention that none of the references it relies upon in the Petition were “considered during the prosecution of the ’262 Patent” (Pet. 2), we find that the portions of Saylor relied upon by Petitioner are substantially identical to Saylor ’265 cited by the examiner (*see* Ex. 1002, 155). Although Petitioner provides a brief summary of the prosecution history of the ’262 patent, Petitioner does not mention the

examiner's citation of Saylor '265. *See* Pet. 4–5. Saylor '265 was filed on the same day as Saylor, names the same set of inventors, and shares the same written description and drawings in all relevant parts. *Compare* Ex. 3002, *with* Ex. 1004. Accordingly, we find that Saylor, Petitioner's primary reference for all asserted grounds, was, in the form of Saylor '265, before the Office during prosecution of the '262 patent. Although the examiner did not expressly apply Saylor '265 in analyzing the claims, the official "Notice of References Cited" lists Saylor '265 as a reference that the examiner identified as relevant and material. Ex. 1002, 155.

Likewise, Petitioner does not address the similarities between Kellen and Thomson, applied during prosecution of the challenged claims, and Gregory, relied upon in each of the asserted grounds. We find that the portions of Gregory that Petitioner relies upon as allegedly teaching a control unit configured to receive a "command identifying a specific light at the premises and including an instruction to turn on the specified light," as recited in claim 1, and corresponding limitations of claims 8 and 11, are duplicative of Kellen's and Thomson's teachings. *See* Pet. 12, 24, 26–27 (citing Ex. 1005 ¶¶ 14–18, 23–26, 28, 29, 31–33); *see also id.* at 36, 38 (claim charts with respect to claims 8 and 11 referring back to the claim chart with respect to claim 1).

In particular, in support of its contention that the asserted prior art teaches or suggests sending a command that identified "a specific light" to be turned on, Petitioner points to Gregory's disclosure of "an emergency lighting system that cooperates with the home security system to provide a strong visual indicator of the location of the home when the security system is instructed to provide the emergency location lights," where "[t]he emergency lighting system may comprise one or more lights and a control

system to control the lights.” Pet. 26–27 (quoting Ex. 1005 ¶ 28). Petitioner further quotes, *inter alia*, Gregory’s disclosure that “[t]he emergency lights . . . are preferably located on the outside of a building where they can easily be seen by emergency personnel,” such as “on the building itself, or on another, nearby structure such as a mailbox or lamppost.” *Id.* at 27 (quoting Ex. 1005 ¶ 29). We find that disclosure to be, at best, cumulative with respect to—and indeed less explicit in its teaching of turning on a “specific” light than—Kellen’s disclosure of an “alarm system for indicating the specific location of an intrusion,” where “[t]he intrusion causes illumination of *an indicator light . . . indicating the specific location of the intrusion,*” and having a “control system responsive to the specific intrusion location signal [that] causes the indicator light *to emit light that . . . can indicate the specific location of an intrusion by directing light towards the specific intrusion location . . .*”). Ex. 3001, code (57) (emphases added). We similarly find Gregory’s disclosures with regard to this limitation to be cumulative of Thomson’s disclosure of apparatus “that will temporarily identify a building, house, or other structure to which emergency personnel have been dispatched. . . . includ[ing], in one embodiment, a high-intensity stroboscopic light emitting diode (LED) placed in a location that is visible from the exterior of the structure” Ex. 3003, code (57).

Notwithstanding Kellen’s and Thomson’s teachings, the examiner found in his reasons for allowance of the challenged claims that “the prior art of record”—including Kellen and Thomson, over which the examiner had rejected the pending claims in the immediately prior Office action—“fails to describe and/or suggest a security and automation system comprising . . . a control unit . . . configured to: . . . receive a command . . . identifying a specific light at the premises and including an instruction to

turn on the specified light . . . along with further limitations set forth by the claims” Ex. 1002, 47.

Because (1) Saylor ’265 was made of record by the examiner and contains essentially the same disclosure as Saylor, (2) we find that the disclosures of Gregory relied upon by Petitioner for allegedly teaching turning on a “specific light” based at least, in part, on an alarm condition are duplicative of Kellen and Thomson evaluated and distinguished during examination, and (3) Petitioner extensively relies on Saylor and Gregory in each of the asserted grounds of unpatentability, we determine that the Petition presents the same or substantially the same prior art that was previously presented to the Office. As a result, we conclude that the first part of the *Advanced Bionics* framework is satisfied. *See Advanced Bionics*, Paper 6 at 7–8.

b. Whether the Same or Substantially the Same Arguments Previously Were Presented to the Office

As discussed above, we determine that the “same or substantially the same prior art” previously was presented to the Office. Accordingly, the first condition of the first part of the *Advanced Bionics* framework is satisfied, and we need not reach whether the “same or substantially the same arguments” previously were presented to the Office. *See Advanced Bionics*, Paper 6 at 20.

c. Whether Petitioner Sufficiently Demonstrates that the Office Erred

Having determined that the “same or substantially the same prior art” previously was presented to the Office, we evaluate whether Petitioner sufficiently demonstrates that the Office erred. *See Section III.D.1.*

Under the second part of the *Advanced Bionics* framework, Petitioner must demonstrate that the examiner erred in the evaluation of the prior art, for example, by showing that the examiner misapprehended or overlooked specific teachings in the relevant prior art such that the error by the Office was material to the patentability of the challenged claims. *Advanced Bionics*, Paper 6 at 8 n.9. As discussed above, the examiner allowed the challenged claims over the teachings of the prior art of record—including Kellen, Thomson, and Saylor ’265—specifically explaining that the prior art of record “fails to describe and/or suggest” a security and automation system comprising, *inter alia*, a control unit configured to “receive a command from [a] remote monitoring service, the command identifying a specific light at the premises and including an instruction to turn on the specified light, wherein the command is based at least in part on sending the alarm condition to the remote monitoring service.” Ex. 1002, 47. Although Petitioner acknowledges the prosecution history of the ’262 patent (Pet. 4–5) and contends that “considerations under § 325(d) . . . do not apply” (*id.* at 48), Petitioner does not allege that the Office erred by finding the claims patentable over Thomson and Kellen or by not utilizing Saylor ’265 or any other prior art of record as the basis for a rejection. Nor does Petitioner argue that Saylor, Elliot, Siegler, or Gagnavi cures the above-identified deficiency. *See, e.g.*, Pet. 23–27 (arguing that “Saylor does not specifically disclose configuring the system to turn on a specified light in response to an alarm” and relying instead on Gregory for the recited limitation), 27–28, 39–48 (relying on Elliot, Siegler, and Gagvani only for other limitations). Rather, Petitioner presents an additional reference (i.e., Gregory) that, similar to Kellen and Thomson, discloses an emergency lighting system “comprising one or more lights” that may be activated by a controller when

an emergency situation is detected, which does not persuade us that the examiner materially erred in determining the patentability of the challenged claims that more particularly recite receiving a command “identifying a specific light at the premises and including an instruction to turn on the specified light.” Ex. 1001, 13:8–11 (emphasis added).

Thus, considering the record before us, we cannot say that the Office erred by finding the claims patentable over the prior art of record, which, as noted above, included not only Thomson and Kellen but also Saylor ’265. Accordingly, we determine that “the same or substantially the same prior art previously w[as] presented to the Office” and that Petitioner has not demonstrated that the Office erred in a manner material to the patentability of the challenged claims of the ’262 patent when considering such prior art.

IV. CONCLUSION

For the foregoing reasons, we exercise our discretion to deny institution of *inter partes* review under 35 U.S.C. § 325(d).

V. ORDER

In consideration of the foregoing, it is hereby:

ORDERED that the Petition is *denied* as to all challenged claims, and no trial is instituted.

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