

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

TERREMARK NORTH AMERICA LLC, VERIZON BUSINESS NETWORK
SERVICES INC., VERIZON SERVICES CORP., TIME WARNER CABLE
INC., ICONTROL NETWORKS, INC. and COXCOM, LLC

Petitioners,

v.

JOAO CONTROL & MONITORING SYSTEMS, LLC

Patent Owner

Case IPR2015-01485

Patent 7,397,363

PRELIMINARY RESPONSE OF PATENT OWNER

TABLE OF CONTENTS

	<u>Page</u>
I. INTRODUCTION.....	1
II. BACKGROUND	2
A. Overview of the ‘363 Patent	2
B. Prosecution History of the ‘363 Patent	6
C. Petition Overview	6
III. THE PETITION SHOULD BE DENIED BECAUSE IT IS BARRED UNDER 35 U.S.C. § 315(b).....	9
A. Background.....	10
B. The Petition is Time Barred.....	12
C. Petitioners’ Motion	12
D. The Petitions Were Not Timely Filed, Fees Were Not Timely Paid and the Petitions Were Not Timely Served.....	13
E. Petitioners have Engaged in a Course of Conduct that has Deprived the PTAB of Jurisdiction Over This Petition.....	17
F. Petitioners Intentionally Delayed Completing the Filing of the Petition Until June 24, 2015	17

G. Petitioners’ Counsel have Breached Their Duties of Candor and Good Faith 18

H. The Board’s Prior Decisions are Distinguishable..... 21

IV. CLAIM CONSTRUCTION 22

 A. Legal Standards..... 22

 B. Petitioners have Failed to Submit Claim Constructions for any of the Key Terms Supporting Its Invalidity Arguments 25

 C. “first signal,” “second signal” and “third signal” 27

 D. “automatically received” 27

 E. “at least one of activate, de-activate, disable, re-enable and control” 28

 F. “premises” 28

 G. “remote” 29

 H. “located at” 29

V. RESPONSE TO PROPOSED GROUNDS OF INVALIDITY 30

 A. Petitioners’ Proposed Grounds Fail to Comply with the Applicable Rules 30

 B. The Proposed Grounds Fail to Meet the Burden of Showing a Reasonable Likelihood of Prevailing..... 34

 C. Ground 1 36

 1. Goldberg fails to teach a first processing device remote from the premises 37

2. Goldberg fails to teach that the first processing device determines whether an action or an operation associated with information contained in the second signal is an authorized or allowed action..... 38

D. Ground 2 40

E. Ground 3..... 40

VI. CONCLUSION 40

LIST OF EXHIBITS

Exhibit	Description
EX2001	Declaration of René A. Vazquez
EX2002	Proof of Service indicating that Verizon Communications, Inc. was served with a Complaint alleging infringement of the '363 Patent on June 23, 2104 in the matter of <i>JCMS v. Terremark North America LLC</i> , C.A. No. 14-525-GMS (D. Del.)
EX2003	Terremark's Rule 7.1 Disclosure Statement in the matter of <i>JCMS v. Terremark North America LLC</i> , C.A. No. 14-525-GMS (D. Del.)
EX2004	Substitution of Terremark North America LLC in place of Verizon Communications Inc. in the matter of <i>JCMS v. Terremark North America LLC</i> , C.A. No. 14-525-GMS (D. Del.)
EX2005	Proof of Service indicating that Time Warner Inc. was served with a Complaint alleging infringement of the '363 Patent on June 23, 2104 in the matter of <i>JCMS v. Time Warner Cable, Inc.</i> , C.A. No. 14-524-GMS (D. Del.)
EX2006	USPS Tracking data for package containing service copies of IPR2015-01482, -01485 and -01486, indicating shipment on June 24, 2105
EX2007	FedEx Tracking data for package containing service copies of IPR2015-01466, -01477, -01478 and -01484, indicating shipment on June 24, 2105
EX2008	Email dated July 17, 2015 from Patent Owner's counsel R. Vazquez to Petitioners' counsel C. Holloway
EX2009	Email dated July 29, 2015 from Petitioners' counsel C. Holloway to Patent Owner's counsel R. Vazquez
EX2010	Email dated July 31, 2015 from Petitioners' counsel C. Holloway to Patent Owner's counsel R. Vazquez
EX2011	U.S. Patent No. 6,204,760 to Brunius
EX2012	"Supplement to the Remarks for the Amendment filed on October 24, 2007" filed on November 23, 2007 during prosecution of the patent application that issued as related U.S. Patent No. 7,397,363

Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

Real-Time Litigation Alerts



Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

Advanced Docket Research



With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

Analytics At Your Fingertips



Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

LAW FIRMS

Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

FINANCIAL INSTITUTIONS

Litigation and bankruptcy checks for companies and debtors.

E-DISCOVERY AND LEGAL VENDORS

Sync your system to PACER to automate legal marketing.