

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

COXCOM, LLC,
Petitioner,

v.

JOAO CONTROL & MONITORING SYSTEMS, LLC,
Patent Owner.

Case IPR2015-01760
Patent 6,549,130 B1

Before HOWARD B. BLANKENSHIP, STACEY G. WHITE, and
JASON J. CHUNG, *Administrative Patent Judges*.

CHUNG, *Administrative Patent Judge*.

DECISION
Institution of *Inter Partes* Review
37 C.F.R. § 42.108

INTRODUCTION

Petitioner, Coxcom, LLC, filed a Petition to institute an *inter partes* review of claims 1, 8, 10, 12, 15, 17, 98, 119, 124, 145, and 149 (“the challenged claims”) of U.S. Patent No. 6,549,130 B1 (“the ’130 patent”).

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Patent 6,549,130 B1

Paper 1 (“Pet.”). Patent Owner, Joao Control & Monitoring Systems, LLC, filed a Preliminary Response pursuant to 35 U.S.C. § 313. Paper 7 (“Prelim. Resp.”).

We have authority to determine whether to institute an *inter partes* review. 35 U.S.C. § 314; 37 C.F.R. § 42.4(a). Upon consideration of the Petition and the Preliminary Response, and for the reasons explained below, we determine that the information presented shows a reasonable likelihood that Petitioner would prevail with respect to claims 1, 8, 10, 12, 17, 98, 119, 124, 145, and 149. *See* 35 U.S.C. § 314(a). Accordingly, we institute an *inter partes* review of these claims.

A. Related Matters

Petitioner and Patent Owner indicate that the ’130 patent or related patents may be implicated in approximately seventy lawsuits pending in courts around the country. Pet. 2–3; Paper 5, 2–7.

B. The Asserted Grounds

Petitioner identifies the following as asserted grounds of unpatentability:

References	Basis	Challenged Claims
Koether (Ex. 1008) ¹	§ 103(a) ²	1, 8, 12, 15, 17, 98, 145, and 149
Koether and Crater (Ex. 1009) ³	§ 103(a)	10, 15, 119, and 124

C. The '130 Patent

The '130 patent is directed to controlling a premises. Ex. 1001, Abs. The '130 patent describes three control devices: a first control device is located at a premises, a second control device is located remote from the premises, and a third control device is located remote from the premises and remote from the second control device. *Id.* The first control device generates a first signal in response to a second signal from the second control device. *Id.* The first control device can activate, de-activate, disable or re-enable, one or more of “a respective system, component, device, equipment, equipment system, and/or appliance, of . . . premises with the first signal.” *Id.* The second control device generates the second signal in response to a third signal from the third control device. *Id.* In some instances, the first control device performs the functions of the third control device, and vice-versa. *Id.* at 100:1–27.

¹ U.S. Patent No. 5,875,430, filed May 2, 1996.

² The relevant sections of the Leahy-Smith America Invents Act (“AIA”), Pub. L. No. 112–29, took effect on March 16, 2013. Because the application from which the '130 patent issued was filed before that date, our citations to Title 35 are to its pre-AIA version.

³ U.S. Patent No. 5,805,442, filed May 30, 1996.

D. The Challenged Claims

Petitioner challenges claims 1, 8, 10, 12, 15, 17, 98, 119, 124, 145, and 149. Pet. 3. Claims 1, 98, and 145 are independent. Claim 1 is illustrative and reproduced below:

1. A control apparatus, comprising:

a first control device, wherein the first control device at least one of generates and transmits a first signal for at least one of activating, de-activating, disabling, and re-enabling, at least one of a premises system, a premises device, a premises equipment, a premises equipment system, and a premises appliance, of a premises, wherein the first control device is located at the premises,

wherein the first control device is responsive to a second signal, wherein the second signal is at least one of generated by and transmitted from a second control device, wherein the second control device is located at a location which is remote from the premises, wherein the second signal is transmitted from the second control device to the first control device, and further wherein the second signal is automatically received by the first control device,

wherein the second control device is responsive to a third signal, wherein the third signal is at least one of generated by and transmitted from a third control device, wherein the third control device is located at a location which is remote from the premises and remote from the second control device, wherein the third signal is transmitted from the third control device to the second control device, and further wherein the third signal is automatically received by the second control device.

II. ANALYSIS

A. Claim Construction

As acknowledged by the parties, the '130 patent has expired. *See* Pet. 8; Prelim. Resp. 11. We construe expired patent claims according to the

standard applied by the district courts. *See In re Rambus Inc.*, 694 F.3d 42, 46 (Fed. Cir. 2012). Specifically, we apply the principles set forth in *Phillips v. AWH Corp.*, 415 F.3d 1303 (Fed. Cir. 2005) (en banc). “In determining the meaning of the disputed claim limitation, we look principally to the intrinsic evidence of record, examining the claim language itself, the written description, and the prosecution history, if in evidence.” *DePuy Spine, Inc. v. Medtronic Sofamor Danek, Inc.*, 469 F.3d 1005, 1014 (Fed. Cir. 2006) (citing *Phillips*, 415 F.3d at 1312–17). “Although words in a claim are generally given their ordinary and customary meaning, a patentee may choose to be his own lexicographer and use terms in a manner other than their ordinary meaning, as long as the special definition of the term is clearly stated in the patent specification or file history.” *Vitronics Corp. v. Conceptoronic, Inc.*, 90 F.3d 1576, 1582 (Fed. Cir. 1996).

Patent Owner argues that the terms “first signal,” “second signal,” “third signal,” “automatically received,” and “at least one of activating, de-activating, disabling and re-enabling,” should be construed according to Patent Owner’s constructions; however, we are not persuaded that express constructions of “first signal,” “second signal,” “third signal,” “automatically received,” and “at least one of activating, de-activating, disabling and re-enabling,” are necessary in order to resolve the disputes currently before us. *See* Prelim. Resp. 18–20. Thus, we discern no need to provide express constructions for these terms at this time. *Vivid Techs., Inc. v. Am. Sci. & Eng’g, Inc.*, 200 F.3d 795, 803 (Fed. Cir. 1999) (“[O]nly those terms need be construed that are in controversy, and only to the extent necessary to resolve the controversy.”).

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