

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 IPR2015-01762
Patent 7,397,363

Before STACEY G. WHITE, JASON J. CHUNG, and BETH Z. SHAW,
Administrative Patent Judges.

SHAW, *Administrative Patent Judge.*

DECISION
Final Written Decision
35 U.S.C. § 318(a) and 37 C.F.R. § 42.73

I. INTRODUCTION

Petitioner, CoxCom, LLC, filed a Petition requesting *inter partes* review of claims 1, 3–5, 8, 13–17, 20, 42–46, 48–49, 53–54, and 84–86 of U.S. Patent No. 7,397,363 (“the ’363 patent”). Paper 1 (“Pet.”). Patent Owner, Joao Control & Monitoring Systems, LLC, filed a Preliminary

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Response pursuant to 35 U.S.C. § 313. Paper 7 (“Prelim. Resp.”). Based on our review of these submissions, we instituted *inter partes* review of claims 1, 3–5, 8, 13–17, 20, 44, and 84–86 (“the instituted claims”) but did not institute *inter partes* review of claims 42, 43, 45, 46, 48, 49, 53, and 54. Paper 11 (“Dec.”).

Patent Owner filed a Patent Owner’s Response (Paper 20, “PO Resp.”), and Petitioner filed a Reply (Paper 23, “Pet. Reply”). An oral hearing was held for this case on November 17, 2016. A transcript of the oral hearing is included in the record. Paper 22.

We have jurisdiction under 35 U.S.C. § 6. This final written decision is issued pursuant to 35 U.S.C. § 318(a) and 37 C.F.R. § 42.73. For the reasons discussed below, Petitioner has demonstrated by a preponderance of the evidence that claims 1, 3–5, 8, 13–17, 20, and 84–86 of the ’363 patent are unpatentable, but has not shown by a preponderance of the evidence that claim 44 of the ’363 patent is unpatentable.

A. *Related Matters*

Petitioner and Patent Owner indicate that the ’363 patent or related patents have been asserted in a significant number of related cases. *See* Pet. 1–2; Paper 5. The ’363 patent also is the subject of two other *inter partes* reviews (IPR2015-01612 and IPR2015-01645).

B. The Instituted Grounds

We instituted review based on following grounds of unpatentability: claims 1, 3–5, 8, 13–17, 20, 44, and 84–86 under 35 U.S.C. § 103(a) as obvious over the combination of Koether (Ex. 1008)¹ and Crater (Ex. 1009)².

C. The '363 Patent

The '363 patent is directed to controlling a vehicle or premises. Ex. 1001, Abst. The '363 patent describes a first control device, which generates a first signal and is associated with a web site and located remote from a premises or vehicle. *Id.* The first control device generates the first signal in response to a second signal that is transmitted via the Internet from a second control device located remote from the first device and remote from the premises or vehicle. *Id.* The first device determines whether an action associated with the second signal is allowed, and if so, transmits the first signal to a third device located at the premises. *Id.* The third device generates a third signal for activating, de-activating, disabling, re-enabling, or controlling an operation of a system, device, or component of the premises or vehicle. *See id.*

D. Illustrative Claim

We instituted *inter partes* review of claims 1, 3–5, 8, 13–17, 20, 44, and 84–86, of which claims 1 and 84 are the only independent claim. Claim 1 is illustrative and is reproduced below:

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

² U.S. Patent No. 5,805,442, filed May 30, 1996.

1. An apparatus, comprising:

a first processing device, wherein the first processing device at least one of generates a first signal and transmits a first signal for at least one of activating, de-activating, disabling, re-enabling, and controlling an operation of, at least one of a premises system, a premises device, a premises equipment, a premises equipment system, a premises component, and a premises appliance, of or located at a premises, wherein the first processing device is associated with a web site, and further wherein the first processing device is located at a location remote from the premises,

wherein the first processing device at least one of generates the first signal and transmits the first signal in response to a second signal, wherein the second signal is at least one of generated by a second processing device and transmitted from a second processing device, wherein the second processing device is located at a location which is remote from the first processing device and remote from the premises, wherein the first processing device determines whether an action or an operation associated with information contained in the second signal, to at least one of activate, deactivate, disable, re-enable, and control an operation of, the at least one of a premises system, a premises device, a premises equipment, a premises equipment system, a premises component, and a premises appliance, is an authorized or an allowed action or an authorized or an allowed operation, and further wherein the first processing device at least one of generates the first signal and transmits the first signal to a third processing device if the action or the operation is determined to be an authorized or an allowed action or an authorized or an allowed operation, wherein the third processing device is located at the premises,

wherein the second signal is transmitted to the first processing device via, on, or over, at least one of the Internet and the World Wide Web, and further wherein the second signal is automatically received by the first processing device, wherein the first signal is transmitted to and automatically received by the third processing device, wherein the third

processing device at least one of generates a third signal and transmits a third signal for at least one of activating, de-activating, disabling, re-enabling, and controlling an operation of, the at least one of a premises system, a premises device, a premises equipment, a premises equipment system, a premises component, and a premises appliance, in response to the first signal.

II. ANALYSIS

A. *Real Party in Interest*

“To challenge that identification of real party in interest a patent owner must provide sufficient rebuttal evidence to bring reasonably into question the accuracy of Petitioner’s identification of RPIs.” *See* Office Patent Trial Practice Guide, 77 Fed. Reg. 48,680, 48,695 (Aug. 14, 2012). Whether a non-party is a real party in interest is a “highly fact-dependent question” that is addressed on a “case-by-case” basis. *See* 77 Fed. Reg. 48,759. “A common focus of the inquiry is . . . whether the non-party exercised or could have exercised control over a party’s participation in a proceeding.” *Id.*

The concept of control means that “the non-party ‘had the opportunity to present proofs and argument’ . . . or ‘to direct or control the content’ of the filing.” *JP Morgan Chase & Co., et al. v. Maxim Integrated Prods., Inc.*, Case CBM2014-00179, slip op. at 10 (PTAB Feb. 20, 2015) (Paper 11) (“JP Morgan”). “‘The evidence as a whole must show that the non-party possessed effective control over a party’s conduct of the [proceeding] as measured from a practical, as opposed to a purely theoretical standpoint.’” *Id.* (quoting *Gonzalez v. Banco Cent Corp.*, 27 F.3d 751, 759 (1st Cir. 1994)).

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