UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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AMX, LLC,
Petitioner,

v.

CHRIMAR SYSTEMS, INC.,
Patent Owner.

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Case IPR2016-00573
Patent 9,019,838 B2

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Before KARL D. EASTHOM, GREGG I. ANDERSON, and
ROBERT J. WEINSCHENK, *Administrative Patent Judges*.

WEINSCHENK, *Administrative Patent Judge*.

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

I. INTRODUCTION

AMX, LLC ("Petitioner") filed a Petition (Paper 1, "Pet.") requesting an *inter partes* review of claims 1, 2, 7, 26, 29, 38, 40, 47, 55, and 69 of U.S. Patent No. 9,019,838 B2 (Ex. 1005, "the '838 patent"). Chrimar Systems, Inc. ("Patent Owner") filed a Preliminary Response (Paper 16, "Prelim. Resp.") to the Petition. An *inter partes* review may not be instituted "unless . . . there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition." 35 U.S.C. § 314(a).

For the reasons set forth below, Petitioner demonstrates a reasonable likelihood of prevailing in showing the unpatentability of claims 1, 2, 7, 26, 29, 38, 40, 47, 55, and 69 of the '838 patent. Accordingly, we institute an *inter partes* review as to claims 1, 2, 7, 26, 29, 38, 40, 47, 55, and 69 of the '838 patent on the grounds specified below.

A. *Related Proceedings*

The parties indicate that the '838 patent is the subject of several district court cases. Pet. 1; Paper 5, 2–3; Ex. 1014.

B. *The '838 Patent*

The '838 patent relates to a system for managing, tracking, and identifying remotely located electronic equipment. Ex. 1005, col. 1, ll. 27–30. According to the '838 patent, one of the difficulties in managing a computerized office environment is keeping track of a company's electronic assets. *Id.* at col. 1, ll. 32–57. Previous systems for tracking electronic assets suffered from several deficiencies. *Id.* at col. 1, ll. 62–65. For example, previous systems could not determine the connection status or

physical location of the asset and could only track those assets that were powered-up. *Id.* at col. 1, l. 65–col. 2, l. 2.

To address these deficiencies, the '838 patent describes a system for tracking an electronic asset using existing network wires. *Id.* at col. 2, ll. 3–6, col. 3, ll. 23–27. The system includes a central module and a remote module. *Id.* at col. 3, ll. 27–30. The remote module attaches to the electronic asset and transmits information to the central module by impressing a low frequency signal on the existing network wires. *Id.* A receiver in the central module monitors the information transmitted by the remote module. *Id.* at col. 3, ll. 30–32. The central module can determine if the location of the electronic asset changes, and a database can be updated accordingly. *Id.* at col. 3, ll. 37–40.

C.   *Illustrative Claim*

Claim 1 is independent and is reproduced below.

> 1. A central piece of network equipment comprising:
>
> at least one Ethernet connector comprising first and second pairs of contacts used to carry BaseT Ethernet communication signals; and
>
> the central piece of network equipment to detect different magnitudes of DC current flow via at least one of the contacts of the first and second pairs of contacts and to control application of at least one electrical condition to at least one of the contacts of the first and second pairs of contacts in response to at least one of the magnitudes of the DC current flow.

Ex. 1005, col. 17, ll. 13–23.

D.   *Evidence of Record*

Petitioner relies on the following references and declaration (Pet. 13):

Reference or Declaration	Exhibit No.
Declaration of Rich Seifert ("Seifert Declaration")	Ex. 1009

Reference or Declaration	Exhibit No.
De Nicolo, U.S. Patent No. 6,115,468 (issued Sept. 5, 2000) ("De Nicolo '468")	Ex. 1019
De Nicolo, U.S. Patent No. 6,134,666 (issued Oct. 17, 2000) ("De Nicolo '666")	Ex. 1020
Katzenberg et al., U.S. Patent No. 6,218,930 B1 (issued Apr. 17, 2001) ("Katzenberg")	Ex. 1037

Patent Owner relies on the Declaration of Dr. Vijay K. Madisetti (Ex. 2015) to support some of the arguments in the Preliminary Response. We note that, for purposes of deciding whether to institute an inter partes review, any genuine issue of material fact created by Dr. Madisetti's testimony will be viewed in the light most favorable to Petitioner. 37 C.F.R. § 42.108(c).

E.   *Asserted Grounds of Unpatentability*

Petitioner asserts that the challenged claims are unpatentable on the following grounds (Pet. 13):

Claim(s)	Basis	Reference(s)
1, 2, 7, 26, 29, 38, 40, 47, 55, and 69	35 U.S.C. §§ 102(e), 103(a)	Katzenberg
1, 2, 7, 26, 29, 38, 40, 47, 55, and 69	35 U.S.C. § 103(a)	De Nicolo '468 and De Nicolo '666

II.   ANALYSIS

A.   *Claim Construction*

The claims of an unexpired patent are interpreted using the broadest reasonable interpretation in light of the specification of the patent in which they appear. 37 C.F.R. § 42.100(b); *Cuozzo Speed Techs., LLC v. Lee*, 136 S. Ct. 2131, 2144–45 (2016). On this record and for purposes of this decision, we determine that no claim terms require express construction.

      B.   *Asserted Grounds of Unpatentability*

          1.   *Anticipation of Claims 1, 2, 7, 26, 29, 38, 40, 47, 55, and 69 by Katzenberg*

Petitioner argues that claims 1, 2, 7, 26, 29, 38, 40, 47, 55, and 69 are anticipated by Katzenberg. Pet. 13. We have reviewed the parties' assertions and supporting evidence. For the reasons discussed below, Petitioner does not demonstrate a reasonable likelihood of prevailing in showing that claims 1, 2, 7, 26, 29, 38, 40, 47, 55, and 69 are anticipated by Katzenberg.

Petitioner argues that Katzenberg is prior art to the '838 patent under 35 U.S.C. § 102(e). Pet. 14. Petitioner acknowledges, though, that Katzenberg is *not* prior art under § 102(e), if the '838 patent is entitled to the benefit of the filing date of U.S. Provisional Application No. 60/081,279 (Ex. 1027, "the '279 provisional").[1] Pet. 6–9, 14. As a result, Petitioner argues that the '838 patent is not entitled to the benefit of the filing date of the '279 provisional because it does not provide sufficient written description of claim 1 of the '838 patent. *Id.* at 6–9.

Petitioner focuses on the limitation in claim 1 of the '838 patent that requires a central piece of network equipment for controlling application of at least one electrical condition "in response to at least one of the magnitudes of the DC current flow." *Id.* at 6. Petitioner specifically argues that the only example provided in the '279 provisional describes a transmitter that sends an identification number to a central piece of network equipment using

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[1] Petitioner does not dispute that the '838 patent is entitled to the benefit of the filing date of International Application No. PCT/US99/07846, which was filed on April 8, 1999. Pet. 14.

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