UNITED STATES PATENT AND TRADEMARK OFFICE

_____

BEFORE THE PATENT TRIAL AND APPEAL BOARD

_____

AMX, LLC and DELL INC.,
Petitioner,

v.

CHRIMAR SYSTEMS, INC.,
Patent Owner.

_____

Case IPR2016-00569
Patent 8,942,107 B2

_____

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

ANDERSON, *Administrative Patent Judge*.

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

I. INTRODUCTION

AMX, LLC and Dell Inc. (collectively "Petitioner") filed a Petition (Paper 3, "Pet.") pursuant to 35 U.S.C. §§ 311–19 to institute an *inter partes* review of claims 1, 5, 31, 43, 53, 58, 70, 72, 75, 83, 84, 103, 104, 111, 123, and 125 ("the challenged claims") of U.S. Patent No. 8,942,107 B2 ("the '107 patent," Ex. 1003), filed February 10, 2012.[1] The Petition is supported by the Declaration of Rich Seifert ("Seifert Declaration," Ex. 1009). ChriMar Systems, Inc. ("Patent Owner") filed a Preliminary Response ("Prelim. Resp.," Paper 16). The Preliminary Response is supported by the Declaration of Dr. Vijay K. Madisetti ("Madisetti Declaration," Ex. 2015).

We have jurisdiction under 35 U.S.C. § 314(a), which requires demonstration of a reasonable likelihood that Petitioner would prevail with respect to at least one challenged claim. We institute an *inter partes* review of claims 1, 5, 31, 43, 53, 58, 70, 72, 75, 83, 84, 103, 104, 111, 123, and 125. The Board has not made a final determination of the patentability of any claim.

A. Related Proceedings

Petitioner advises us that the '107 patent is the subject of forty eight (48) civil actions filed in the Eastern District of Michigan, Eastern District of

---

[1] The cover page of the '107 patent alleges it is a "[c]ontinuation of application No. 12/239,001, filed on Sep. 26, 2008, now Pat. No. 8,155,012, which is a continuation of application No. 10/668,708, filed on Sep. 23, 2003, now Pat. No. 7,457,250, which is a continuation of application No. 09/370,430, filed on Aug. 9, 1999, now Pat. No. 6,650,622, which is a continuation-in-part of application No. PCT/US99/07846, filed on Apr. 8, 1999." Ex. 1003 (63).

Texas, and Northern District of California. Pet. 1 (citing *Docket Navigator* printout dated February 2, 2016, Ex. 1013). Pursuant to 37 C.F.R. § 42.8(b)(2), Patent Owner identifies twenty nine (29) related actions. Paper 7, 2–3.[2] Both parties cite to various pending district court cases (hereafter collectively "the District Court") in their claim construction positions. *See* Pet. 12–13, Prelim. Resp. 17.

B. The '107 Patent (Ex. 1003)

The '107 patent "relates generally to computer networks and, more particularly, to a network management and security system for managing, tracking, and identifying remotely located electronic equipment on a network." Ex. 1003, 1:27–30. The '107 patent is "adapted for to be used with an existing Ethernet communications link or equivalents thereof." *Id.* at 3:41–43.

Specifically, a communication system generates and monitors data relating to the electronic equipment on a network using "pre-existing wiring or cables that connect pieces of networked computer equipment to a network." Ex. 1003, 3:24–27. In a first embodiment, the system includes a remote module attached to the electronic equipment being monitored. *Id.* at 3:27–30. The remote module transmits a low frequency signal containing equipment information to a central module over the cable. *Id.* The central module "monitors the low frequency data to determine the transmitted information from the electronic equipment." *Id.* at 3:30–33. The first

_____

[2] 37 C.F.R. § 42.8(b)(2) requires identification of "any other judicial or administrative matter that would affect, or be affected by, a decision" in this proceeding. As the rule requires, both parties need to insure that all related matters are listed accurately.

embodiment communicates only identification information related to the equipment. *Id.* at 4:54–59. However, the invention contemplates collection of other "more general information such as identification of the equipment processor type and the equipment harddrive [sic] capacity." *Id.*

The communication or monitoring of the network equipment is accomplished "over preexisting network wiring or cables without disturbing network communications." Ex. 1003, 12:1–7. This is accomplished "by coupling a signal that does not have substantial frequency components within the frequency band of network communications." *Id.*

C. Illustrative Claims

Of the challenged claims, claims 1 and 104 are independent apparatus claims. Claims 5, 31, 43, 53, 58, 70, 72, 75, 83, 84, and 103 depend directly or indirectly from claim 1. Claims 111, 123, and 125 depend from claim 104. Claims 1 and 104 are reproduced below:

> 1. A piece of Ethernet terminal equipment comprising:
>
> an Ethernet connector comprising:
>
> first and second pairs of contacts used to carry Ethernet communication signals,
>
> at least one path for the purpose of drawing DC current, the at least one path coupled across at least one of the contacts of the first pair of contacts and at least one of the contacts of the second pair of contacts, the piece of Ethernet terminal equipment to draw different magnitudes of DC current flow via the at least one path,
>
> the different magnitudes of DC current flow to result from at least one condition applied to at least one of the contacts of the first and second pairs of contacts,

wherein at least one of the magnitudes of the DC current flow to convey information about the piece of Ethernet terminal equipment.

Ex. 1003, 17:11–25.

104. A powered-off end device comprising:

an Ethernet connector comprising first and second pairs of contacts,

at least one path for the purpose of drawing DC current, the at least one path coupled across at least one of the contacts of the first pair of contacts and at least one of the contacts of the second pair of contacts,

the powered-off end device to draw different magnitudes of DC current flow via the at least one path, the different magnitudes of DC current flow to result from at least one condition applied to at least one of the contacts of the first and second pairs of contacts,

wherein at least one of the magnitudes of the DC current flow to convey information about the powered-off end device.

Id. at 22:17–29.

D. Asserted Grounds of Unpatentability

Petitioner challenges claims 1, 5, 31, 43, 53, 58, 70, 72, 75, 83, 84, 103, 104, 111, 123, and 125 of the '107 patent as unpatentable on the following grounds. Pet. 13–60.

DOCKET ALARM

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.

fastcase
Smarter legal research.