

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”).

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) <sup>1</sup>	§ 103(a) <sup>2</sup>	1, 8, 12, 15, 17, 98, 145, and 149
Koether and Crater (Ex. 1009) <sup>3</sup>	§ 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.

---

<sup>1</sup> U.S. Patent No. 5,875,430, filed May 2, 1996.

<sup>2</sup> 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.

<sup>3</sup> 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. Conceptronic, 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.”).

# 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.