

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

CHUNG, *Administrative Patent Judge*.

FINAL WRITTEN DECISION
Inter Partes Review
35 U.S.C. § 318(a) and 37 C.F.R. § 42.73

I. 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 of U.S. Patent No. 6,549,130 B1 (“the ’130 patent”). Paper 1 (“Pet.”). Patent

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

Upon consideration of the Petition and the Preliminary Response, on February 17, 2016, we instituted *inter partes* review of claims 1, 8, 10, 12, 17, 98, 119, 124, 145, and 149 (“instituted claims”), pursuant to 35 U.S.C. § 314. Paper 8 (“Dec.”).

Subsequent to institution, Patent Owner filed a Patent Owner Response. Paper 14 (“PO Resp.”). Petitioner filed a Reply to Patent Owner’s Response. Paper 16 (“Reply”). An oral hearing was held on November 17, 2016 and a transcript of the oral hearing is available in the record. Paper 24 (“Tr.”).

We issue this Final Written Decision pursuant to 35 U.S.C. § 318(a) and 37 C.F.R. § 42.73. For the reasons discussed herein, Petitioner has shown by a preponderance of the evidence that claims 1, 8, 10, 12, 17, 98, 119, 124, 145, and 149 of the ’130 patent are unpatentable. *See* 35 U.S.C. § 316(e).

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 Instituted Grounds

We instituted the following grounds of unpatentability:

References	Basis	Instituted Claims
Koether (Ex. 1008) ¹	§ 103(a) ²	1, 8, 12, 17, 98, 145, and 149
Koether and Crater (Ex. 1009) ³	§ 103(a)	10, 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 Leahy-Smith America Invents Act (“AIA”), Pub. L. No. 112–29, revised 35 U.S.C. § 103 and the relevant sections 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 Instituted Claims

We instituted *inter partes* review of claims 1, 8, 10, 12, 17, 98, 119, 124, 145, and 149. Of the instituted claims, 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. 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

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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 an RPI 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)).

The Petition names CoxCom, LLC ("CoxCom") as the real party in interest. Pet. 1. Patent Owner has not articulated sufficient rebuttal evidence to bring reasonably into question the accuracy of Petitioner's identification of CoxCom as the real party in interest. Patent Owner argues CoxCom was one of the named co-petitioners in related IPR2015-01486 involving the '130 patent. PO Resp. 34. Furthermore, Patent Owner argues two of Petitioner CoxCom's co-petitioners in IPR2015-01486, Terremark North America LLC ("Terremark") and Time Warner Cable Inc. ("Time Warner") are time barred and should be named as real parties in interest. *Id.* at 35–38. Moreover, Patent Owner argues Terremark, Time Warner, and CoxCom cooperated in planning, preparation, and review of the present

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