

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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ADT LLC,  
Petitioner,

v.

VIVINT, INC.,  
Patent Owner.

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IPR2022-00612  
Patent 9,349,262 B2

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Before MICHAEL R. ZECHER, CHARLES J. BOUDREAU, and  
IFTIKHAR AHMED, *Administrative Patent Judges*.

BOUDREAU, *Administrative Patent Judge*.

DECISION  
Denying Institution of *Inter Partes* Review  
35 U.S.C. § 314(a)

## I. INTRODUCTION

ADT LLC (“Petitioner”) filed a Petition requesting *inter partes* review of claims 1, 2, 4–8, and 11–13 of U.S. Patent No. 9,349,262 B2 (Ex. 1001, “the ’262 patent”). Paper 1 (“Pet.”). Vivint, Inc. (“Patent Owner”) filed a Preliminary Response. Paper 7 (“Prelim. Resp.”).

After considering the Petition, the Preliminary Response, and associated evidence, we exercise our discretion to deny institution of *inter partes* review under 35 U.S.C. § 325(d) (2012).

## II. BACKGROUND

### A. *Real Parties in Interest*

Petitioner identifies itself, along with ADT Inc., Alarm.com Inc., and Alarm.com Holdings, Inc., as real parties in interest. Pet. 1. Patent Owner identifies itself and Vivint Smart Home, Inc., of which it is “a wholly owned subsidiary,” as real parties in interest. Paper 6, 2 (Patent Owner’s Mandatory Notices).

### B. *Related Matters*

The parties advise us that the ’262 patent is involved in district court litigation between the parties, captioned as *Vivint, Inc. v. ADT LLC*, No. 2:21-cv-00115-CW-DBP (D. Utah). Pet. 1; Paper 6, 2.

We also note that Alarm.com Inc. filed a petition substantially identical to the instant Petition on March 18, 2022, stating that in the event that *inter partes* review is instituted based on the instant Petition, Alarm.com Inc. intends to move to join this proceeding. IPR2022-00728, Paper 2.

### C. *The ’262 Patent*

The ’262 patent, titled “Security System Providing a Localized Humanly-Perceivable Alert for Identifying a Facility to Emergency Personnel,” is directed to systems and methods for guiding emergency

personnel to a location in a facility proximate to an alarm that has been generated, including security systems that use lights or other indicators to help emergency responders identify the facility that generated the alarm to which they are responding. Ex. 1001, codes (54), (57), 1:17–20, 5:35–37. According to the '262 patent, security systems may generate an alarm, for example, in the case of “unauthorized entry, fire, medical emergency, or manual alarm activation,” and send a notification signal to a central station, which, in turn, contacts an appropriate emergency response agency. *Id.* at 1:29–44. A challenge exists, however, for emergency personnel in finding the facility that generated the alarm. *Id.* at 1:45–46.

To address this challenge, the '262 patent describes, *inter alia*, a security system that “includes one or more sensors that generate an alarm condition message in response to an alarm condition” and “may also include a control unit that is communicatively coupled to the sensor and that receives the alarm condition message from the sensor and that sends an identification message to a controller for an indicator.” Ex. 1001, 1:61–2:1. “The controller receives the identification message from the control unit and causes the indicator to generate an identifying alert” that “may be humanly perceivable from the exterior of the facility protected by the security system.” *Id.* at 2:1–5. “In certain embodiments, the indicator may also localize the identifying alert to a location of the facility where the alarm condition occurred.” *Id.* at 2:11–13. “For example, if a smoke detector detects smoke, the selected indicator may be the interior light in the room containing the smoke detector.” *Id.* at 2:13–15.

Figure 3 of the '262 patent is reproduced below.

300

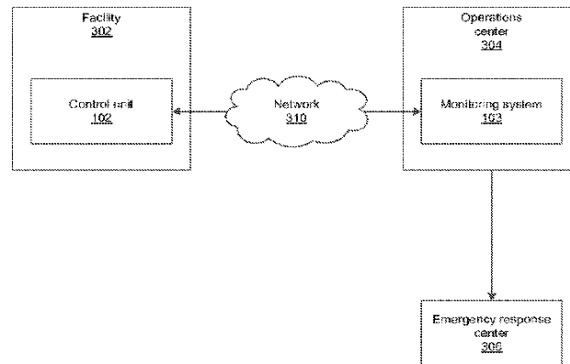


FIG. 3

Figure 3, above, is a schematic block diagram of system 300 according to the '262 patent. Ex. 1001, 2:62–64, 5:61–63. System 300 includes facility 302, which is a physical location, such as a residence or place of business, and includes control unit 102. *Id.* at 5:63–67. System 300 also includes operations center 304, which implements monitoring system 103, and emergency response center 306. *Id.* at 6:3–4, 6:18–20. Network 310 may connect monitoring system 103 with control unit 102. *Id.* at 6:46–49. In operation, control unit 102 may send an alarm condition notification to monitoring system 103, for example, indicating that a fire alarm at facility 302 has been triggered. *Id.* at 6:21–23. In response, a security

representative at operations center 304 may confirm that there is a fire at facility 302 and request the dispatch of firefighters. *Id.* at 6:27–29. The security representative may then cause an exterior light at facility 302 to flash on and off for help in locating facility 302. *Id.* at 6:33–37. In addition, the security representative may also cause interior or exterior lights “near the location of the alarm condition (e.g. in close proximity to the sensor(s) 101 [not shown in Figure 3] from which the alarm condition message originated) to flash on and off,” in order to identify “the particular location or area, room, etc., within facility 302” with the alarm condition. *Id.* at 6:37–45.

Figure 5 of the '262 patent is reproduced below.

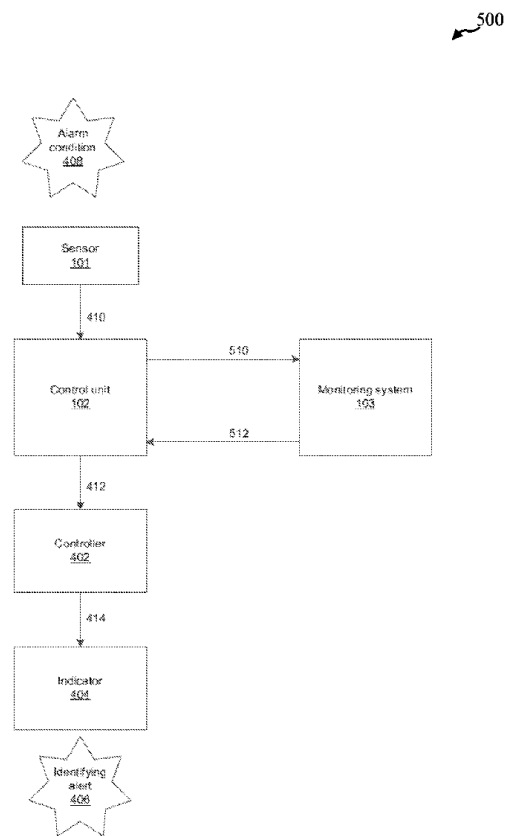


FIG. 5

Figure 5, above, is a schematic block diagram of another embodiment of the '262 patent. Ex. 1001, 3:1–3; 8:48–49. Here, upon a security representative

dispatching emergency personnel to facility 302, “monitoring system 103 may send a dispatch notification 512 to the control unit 102.” *Id.* at 8:59–66. Control unit 102 may then send identification message 412 to controller 402, where controller 402 “may be an electronic device communicatively coupled to the control unit 102 and the indicator 404.” *Id.* at 9:4–7; 7:40–41.

“[I]ndicator 404 may be a physical device capable of generating a humanly perceivable identifying alert,” for example, “an interior light that is visible from the street through a window,” “an exterior light, such as a porch light or street lamp, that is visible from the street,” or “an audible alarm.” *Id.* at 7:60–62; 8:1–4; 8:17. Identification message 412 instructs controller 402 to generate identifying alert 406 via indicator 404. *Id.* at 7:26–28.

*D. Overview of the Challenged Claims*

Of the challenged claims, claims 1, 8, and 11 are independent.

Claim 1, reproduced below, is illustrative of the challenged claims:

1. A security and automation system comprising:

a sensor, at a premises, configured to generate an alarm condition message in response to an alarm condition;

a control unit, at the premises, communicatively coupled to the sensor and to at least one indicator, the control unit configured to:

receive the alarm condition message from the sensor;

determine a location of the alarm condition based at least in part on the alarm condition message; and

send the alarm condition message to a remote monitoring service, wherein the remote monitoring service filters out false alarms from received alarm condition messages;

receive a command from the remote monitoring service, the command identifying a specific light at the premises and including an instruction to turn on the specified light, wherein the command is based at least in part on sending the alarm condition to the remote monitoring service;

execute the command from the remote monitoring service to turn on the specified light;

receive, from the remote monitoring service, a dispatch notification indicating that emergency personnel are dispatched to the premises in response to the remote monitoring service contacting the emergency personnel.

Ex. 1001, 12:62–13:20.

*E. Prosecution History*

The '262 patent issued May 24, 2016, from an application filed March 14, 2014, and claims priority from a provisional application filed March 15, 2013. Ex. 1001, codes (22), (45), (60).

During prosecution, the examiner issued a first non-final Office Action rejecting each of the original independent claims as being anticipated by, and certain of the original dependent claims as being either anticipated by or obvious over, U.S. Patent 8,624,735 B2 (“Kellen,” Ex. 2003). *See* Ex. 1002, 150–53.<sup>1</sup> The examiner also included with the first Office Action a Notice of References Cited, listing a total of thirteen references, including, among others, Kellen and U.S. Patent 6,400,265 B1 to Saylor (hereinafter, “Saylor '265”). *Id.* at 155. A copy of Saylor '265 is included in the record of this proceeding as Exhibit 2001.

In response to the first Office Action, the applicant amended each of the original independent claims to recite “receiv[ing] a dispatch of emergency personnel to the facility protected by the security system, wherein causing the identifying alert is based at least in part on the received dispatch of emergency personnel,” which is a limitation that had previously

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<sup>1</sup> All references to the page numbers in the prosecution history of the '262 patent refer to the page numbers inserted by Petitioner in the lower-right corner of each page in Exhibit 1002.

been recited in a dependent claim that the examiner had determined to be allowable if rewritten in independent form. Ex. 1002, 138–41, *see also id.* at 211 (original dependent claim 12).

Following the amendment, the examiner issued a second non-final Office Action, rejecting all then-pending claims under 35 U.S.C. § 103 over the combination of Kellen and U.S. Patent 5,991,393 (“Thomson,” Ex. 2004). Ex. 1002, 116–19.

In response to the second non-final Office Action, the applicant again amended the claims, adding, among other things, the “send[ing] the alarm condition,” “receiv[ing] a command,” and “execut[ing] the command” limitations to each of the then-pending independent claims. Ex. 1002, 72–77. The applicant argued that “[n]either Kellen, nor Thomson, individually or in combination, can be relied upon to teach or suggest” those limitations. *Id.* at 79. For example, the applicant acknowledged that Kellen describes an alarm system that includes “a light control system responsive to [a] specific intrusion location signal” and “configured to control light emitted from an indicator light . . . located within an outer perimeter zones of [an] enclosed space, the indicator light being configured . . . to direct light towards the specific location of the intrusion,” but argued that “[a]n alarm system that detects an intrusion and controls an outside light based on the detected intrusion does not teach or suggest sending a message to a remote monitoring service, much less receiving a command from the remote monitoring service regarding ‘a specific light at the premises,’ as recited in claim 1.” *Id.*



Responsive to the applicant's amendment, the examiner entered a Notice of Allowability, allowing all of the then-pending claims. Ex. 1002, 46–48. In the Notice of Allowability, the examiner stated:

The following is an examiner's statement of reasons for allowance: *the prior art of record* fails to describe and/or suggest a security and automation system comprising a sensor, at a premises, configured to generate an alarm condition message in response to an alarm condition; a control unit, at the premises, communicatively coupled to the sensor and to at least one indicator, the control unit configured to: receive the alarm condition message from the sensor; determine a location of the alarm condition based at least in part on the alarm condition message; and send the alarm condition message to a remote monitoring service, wherein the remote monitoring service filters out false alarms from received alarm condition messages; receive a command from the remote monitoring service, the command identifying a specific light at the premises and including an instruction to turn on the specified light, wherein the command is based at least in part on sending the alarm condition to the remote monitoring service.

These, along with further limitations set forth by the claims render the application allowable over *the prior art of record*.

*Id.* at 47 (italics added).

*F. Asserted Grounds*

Petitioner asserts the following grounds of unpatentability (Pet. 7):

<b>Claims Challenged</b>	<b>35 U.S.C. §<sup>2</sup></b>	<b>Basis</b>
1, 2, 4–8, 11–13	103	Saylor, <sup>3</sup> Gregory, <sup>4</sup> Elliot <sup>5</sup>
1, 2, 4–8, 11–13	103	Saylor, Gregory, Elliot, Siegler <sup>6</sup>
1, 2, 4–8, 11–13	103	Saylor, Gregory, Elliot, Gagvani <sup>7</sup>
1, 2, 4–8, 11–13	103	Saylor, Gregory, Elliot, Gagvani, Siegler

Pet. 3, 6–48. Petitioner also relies on a Declaration of Peter Rysavy. (Ex. 1009).

III. ANALYSIS

As noted in the above Introduction, we exercise our discretion to deny institution of an *inter partes* review pursuant to 35 U.S.C. § 325(d). Accordingly, we need not discuss in depth the merits of Petitioner’s obviousness challenge. Nevertheless, to the extent the definition of a person of ordinary skill in the art or the meaning of certain claim terms is relevant

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<sup>2</sup> The Leahy-Smith America Invents Act, Pub. L. No. 112-29, 125 Stat. 284 (2011) (“AIA”), amended 35 U.S.C. § 103. Because the ’262 patent is alleged to have an effective filing date before March 16, 2013, which is the effective date of the applicable AIA amendments, we refer to the pre-AIA version of 35 U.S.C. § 103. *See* Ex. 1001, code (60).

<sup>3</sup> Saylor et al., US 6,661,340 B1, issued Dec. 9, 2003 (Ex. 1004).

<sup>4</sup> Gregory, US 2010/0265089 A1, published Oct. 21, 2010 (Ex. 1005).

<sup>5</sup> Elliot et al., US 7,734,020 B2, issued June 8, 2010 (Ex. 1006).

<sup>6</sup> Siegler, II et al., US 8,310,365 B2, issued Nov. 13, 2012 (Ex. 1007).

<sup>7</sup> Gagvani et al., US 2009/0022362 A1, published Jan. 22, 2009 (Ex. 1008).

to this proceeding, we address them below. We further note that Patent Owner's arguments with respect to § 325(d) substantially relate to the Saylor and Gregory references that constitute two of the three primary references in each of the asserted grounds. To provide context for those arguments, we also provide an overview of those references.

*A. Level of Ordinary Skill in the Art*

Petitioner proposes that a person having ordinary skill in the art “at the time of the alleged invention would have had at least a bachelor’s degree in computer science, electrical engineering, or computer engineering (or equivalent experience), and at least two years of professional experience in remote monitoring and control systems, Internet of Things (‘IoT’), home security systems, building automation systems, machine-to-machine (‘M2M’) communications, or other similarly relevant industry experience.” Pet. 6 (citing Ex. 1009 ¶ 25). Patent Owner does not provide its own assessment regarding the level of skill in the art, or otherwise dispute Petitioner’s assertion. *See* Prelim. Resp.

Based on our review of the record at this stage, we find that Petitioner’s proposal is consistent with the level of skill reflected in the prior art references of record. *See Daiichi Sankyo Co. v. Apotex, Inc.*, 501 F.3d 1254, 1256 (Fed. Cir. 2007) (listing the type of problems encountered in the art, prior art solutions to those problems, and the sophistication of the technology as factors that may be considered in determining the level of ordinary skill in the art). *See also Okajima v. Bourdeau*, 261 F.3d 1350, 1355 (Fed. Cir. 2001) (explaining that specific findings regarding ordinary skill level are not required “where the prior art itself reflects an appropriate level and a need for testimony is not shown”).

Accordingly, for purposes of this decision and to the extent necessary, we adopt Petitioner’s definition of the person of ordinary skill in the art.

*B. Claim Construction*

In an *inter partes* review based on a petition filed on or after November 13, 2018, we interpret claim terms using “the same claim construction standard that would be used to construe the claim in a civil action under 35 U.S.C. 282(b), including construing the claim in accordance with the ordinary and customary meaning of such claim as understood by one of ordinary skill in the art and the prosecution history pertaining to the patent.” 37 C.F.R. § 42.100(b) (2021).

Neither party proposes specific claim constructions for any terms. Pet. 5; *see* Prelim. Resp. On this record, we determine that no terms or phrases in the claims require express construction. *See Nidec Motor Corp. v. Zhongshan Broad Ocean Motor Co.*, 868 F.3d 1013, 1017 (Fed. Cir. 2017) (“[W]e need only construe terms ‘that are in controversy, and only to the extent necessary to resolve the controversy’ . . . .” (quoting *Vivid Techs., Inc. v. Am. Sci. & Eng’g, Inc.*, 200 F.3d 795, 803 (Fed. Cir. 1999))).

*C. Overview of Saylor, Gregory, and Elliot*

*1. Saylor*

Saylor, titled “System and Method for Connecting Security Systems to a Wireless Device,” describes a personal security network for a system of security devices that may be connected to a central security network and that allows the user to personalize alert notifications. Ex. 1004, codes (54), (57), 3:41–43.

Figure 2 of Saylor is reproduced below.

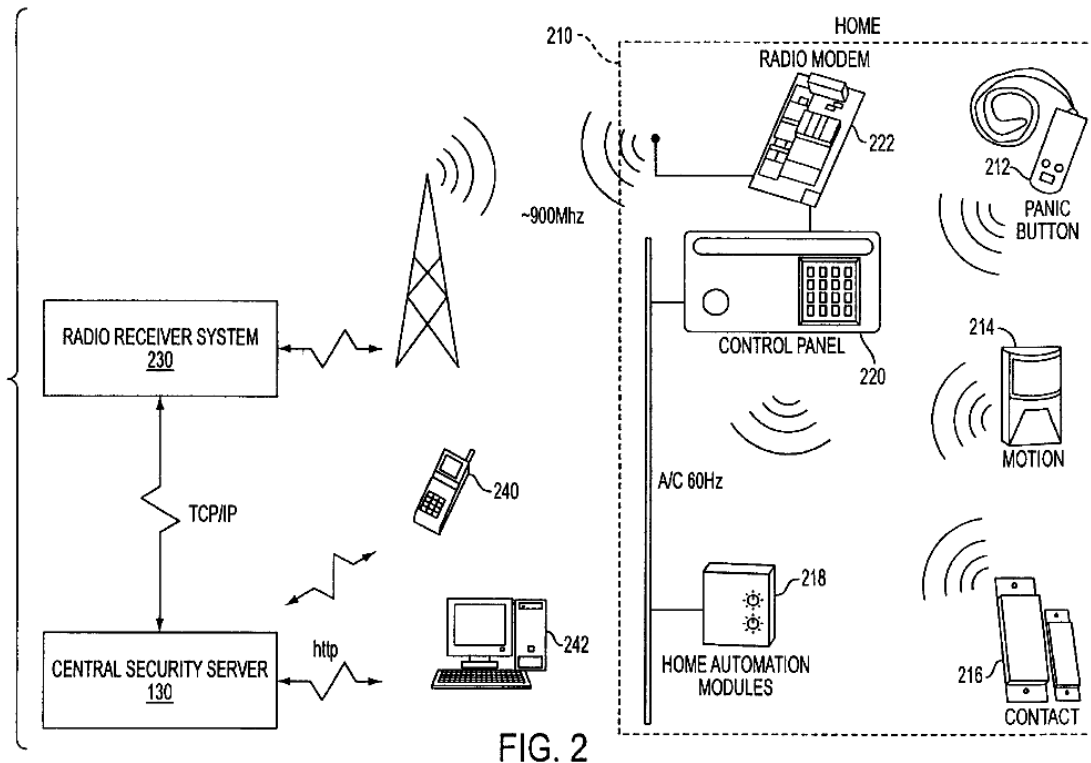


FIG. 2

Figure 2, above, is “an example of an alarm transmission, according to an embodiment of [Saylor’s] invention.” *Id.* at 5:50–51. In this example, home 210 includes a number of devices 212, 214, 216, and 218 in communication with control panel 220. *Id.* at 5:51–55. Control panel 220 may send alarm and other data to central security server 130. *Id.* at 5:55–62. “Central security server 130 may then alert users and other identified entities via wireless and/or other devices, such as mobile device 240, via a voice alarm, text message and other notifications.” *Id.* at 5:62–65. A user may define various preferences as to the timing of notifying the user, sounding an alarm, and contacting an emergency entity, in order to reduce false alarms. *See id.* at 6:40–55.

2. *Gregory*

Gregory, titled “Emergency Location Finder,” describes “[a] light system for identifying a target location for emergency vehicles.” Ex. 1005, codes (54), (57), ¶¶ 8, 14. Gregory’s light system may include “a light fixture suitable for use outdoors, a bulb suitable for use in the fixture, and an activation mechanism for selecting and changing between a ‘constant on’ mode, a ‘constant off’ mode, and a ‘blinking’ mode.” *Id.* ¶¶ 8, 14, 19, 20. According to Gregory, the light system may be incorporated into or activated by a security system for alerting a homeowner or security company when an emergency is indicated at the location. *Id.* ¶ 17. The emergency lighting system can cooperate with a home security system “to provide a strong visual indicator of the location of the home when the security system is instructed to provide the emergency location lights.” *Id.* ¶ 28.

Figure 1 of Gregory is reproduced below.



**Fig. 1**

Figure 1, above, shows “a lighting system according to one embodiment of [Gregory’s] invention, installed on a house.” Ex. 1005 ¶ 11. As depicted in Figure 1, Gregory discloses that “[t]he emergency light or lights (12) are preferably located on the outside of a building where they can easily be seen by emergency personnel.” *Id.* ¶ 29. “The lights are positioned so as to easily be noticed by emergency response personnel. *Id.* “For example, the lights may be on the building itself, or on another, nearby structure such as a mailbox or lamppost.” *Id.* In a preferred embodiment, the lights may be “dual-purpose” lights that are designed and adapted to act as, for example, standard porch, outer garage area, driveway, or front entrance lights. *Id.* ¶¶ 18, 23, 30, 31. In this case, a light may be controlled by a manual switch for standard use, and by an emergency light controller when used as emergency location identifiers. *Id.* ¶ 32. The controller may either be activated “automatically when the home security system detects an emergency situation,” or “when directed to do so by personnel monitoring the home security system.” *Id.* ¶ 33. Further, “[t]he light controller preferably cause the lights to flash in a manner effective to draw attention from an emergency responder who is looking for the location.” *Id.* ¶ 34.

### 3. *Elliot*

*Elliot*, titled “Two-Way Voice and Voice Over IP Receivers for Alarm Systems,” recognizes a problem where “Voice-over-IP service may impact the reliability of a security (alarm) system by interfering with its ability to report alarms to a consumer’s monitoring station.” Ex. 1006, code (54), 2:4–6. Accordingly, *Elliot* describes “placing an alarm receiver (at security system central station) directly onto a private Voice-over-IP network shared by the customer, thereby eliminating the need for a Voice-over-IP system to re-dial the central station over a standard telephone line.”

*Id.* at 3:42–46. In an embodiment, an alarm panel can “enter ‘speakerphone’ mode, whereby an operator at the central station can listen in to the room where the alarm panel is located, and optionally engage in conversation with persons in the alarm-monitored premise.” *Id.* at 5:47–52. This can allow an alarm monitoring company to quickly determine whether there is a false alarm. *Id.* at 5:52–54. Elliot also discloses that “the system may be used in a one-way mode of operation to send voice messages to the alarm panel that may be played on a speaker at the alarm site (e.g., ‘help is on the way, the Police/Fire/EMT have been called’),” where “[s]uch one way messages may reassure the consumer and/or frighten off potential burglars or the like.” *Id.* at 9:36–48.

*D. Discretion under 35 U.S.C. § 325(d)*

*1. Framework*

“In determining whether to institute or order [an *inter partes* review], the Director may take into account whether, and reject the petition or request because, the same or substantially the same prior art or arguments previously were presented to the Office.” 35 U.S.C. § 325(d). The Director has delegated that discretion to the Board. 37 C.F.R. § 42.4(a).

In *Advanced Bionics, LLC v. Med-El Elektromedizinische Geräte GMBH*, IPR2019-01469, Paper 6 (PTAB Feb. 13, 2020) (precedential) (“*Advanced Bionics*”), the Board applied a two-part framework in considering whether to exercise discretion to deny institution under § 325(d): “(1) whether the same or substantially the same art previously was presented to the Office or whether the same or substantially the same arguments previously were presented to the Office; and (2) if either condition of first part of the framework is satisfied, whether the petitioner



has demonstrated that the Office erred in a manner material to the patentability of challenged claims.” *Advanced Bionics*, Paper 6 at 8.

Within this two-part framework, the Board considers a number of non-exclusive factors in evaluating whether to exercise its discretion under § 325(d). *See Becton, Dickinson & Co. v. B. Braun Melsungen AG*, IPR2017-01586, Paper 8 (PTAB Dec. 15, 2017) (precedential as to § III.C.5, first para.) (“*Becton, Dickinson*”); *see also Advanced Bionics*, Paper 6 at 9–

11. The factors set forth in *Becton, Dickinson* are as follows:

- (a) the similarities and material differences between the asserted art and the prior art involved during examination;
- (b) the cumulative nature of the asserted art and the prior art evaluated during examination;
- (c) the extent to which the asserted art was evaluated during examination, including whether the prior art was the basis for rejection;
- (d) the extent of the overlap between the arguments made during examination and the manner in which petitioner relies on the prior art;
- (e) whether petitioner has pointed out sufficiently how the examiner erred in its evaluation of the asserted prior art; and
- (f) the extent to which additional evidence and facts presented in the petition warrant reconsideration of the prior art or arguments.

*Becton, Dickinson*, Paper 8 at 17–18.

Factors (a), (b), and (d) of the *Becton, Dickinson* factors relate to whether the art or arguments presented in the Petition are the same or substantially the same as those previously presented to the Office. *Advanced Bionics*, Paper 6 at 10. Factors (c), (e), and (f) “relate to whether the

petitioner has demonstrated a material error by the Office” in its prior consideration of that art or arguments. *Id.* Only if the same or substantially the same art or arguments were previously presented to the Office do we then consider whether petitioner has demonstrated a material error by the Office. *Id.* “At bottom, this framework reflects a commitment to defer to previous Office evaluations of the evidence of record unless material error is shown.” *Id.* at 9.

### 2. *Petitioner’s Obviousness Challenges*

As set forth in section II.F above, Petitioner contends that the challenged claims are unpatentable over the combination of Saylor, Gregory, and Elliot, either alone or in further combination with Siegler, Gagvani, or both. Pet. 3, 6–48. In each combination, Petitioner relies on Saylor as teaching all limitations of each of independent claims 1, 8, and 11, with the exception of “configuring the system to turn on a specified light in response to an alarm,” for which Petitioner relies on Gregory, and “receiving . . . a dispatch notification indicating that emergency personnel are dispatched to the premises,” for which Petitioner relies on Elliot. *Id.* at 17–28, 33–38. In certain of the asserted grounds, Petitioner also relies on Siegler in the alternative to Saylor alone for the disclosure of determining a location of an alarm condition based on the alarm condition message (*id.* at 39–42, 47–48) and on Gagvani in the alternative to Saylor alone for the disclosure of filtering out false alarms from received alarm condition messages (*id.* at 42–48).

### 3. *Patent Owner’s Contentions*

In response to Petitioner’s contentions, Patent Owner contends the Board should exercise its discretion to deny institution under 35 U.S.C. § 325(d) “because the prior art relied on by [Petitioner] was previously

considered and distinguished during prosecution of the '262 patent, and the arguments presented by [Petitioner] add nothing new from what was already known and considered by the Office during prosecution.” Prelim. Resp. 24.

More particularly, Patent Owner argues:

[Petitioner’s] primary reference for all grounds, Saylor, has already been considered by the Office during prosecution by virtue of the Office having considered Saylor '265. Saylor '265 was filed on the same day as Saylor, naming the same set of inventors, and sharing the same written description and drawings. (Ex. 1004; Ex. 2001; Ex. 2002.) . . .

There is no dispute that the primary reference for all grounds, Saylor (in the form of Saylor '265), was before the Office during prosecution of the '262 patent. Therefore, the primary reference running throughout this entire proceeding has already been considered by the Office. The examiner did not expressly apply Saylor '265 in analyzing the claims, but the official “Notice of References Cited” lists Saylor '265 as a reference that the examiner identified as relevant and material. (Ex. 1002 at 1002.0155.) The claims would not have issued if the examiner did not regard them as patentable over Saylor '265, and thus over the Saylor at issue here, i.e., Ex. 1004.

While the Gregory reference was not specifically before the examiner, that reference is simply cumulative of the art that *was* before the examiner.

For example, the examiner cited Kellen and Thomson during prosecution. (Ex. 1002 at 1002.0113–0121, 1002.0148–0155.) Both of those references, like Gregory, teach activating an external light to aid emergency personnel in locating the building or residence that has registered a break-in or other emergency condition. (Ex. 2003 at Abstract; Ex. 2004 at Abstract.) In the Notice of Allowance, the examiner specifically mentioned the “receive a command” element (i.e., [1f], [8c], and [11d]), and acknowledged that the “prior art of record fails to describe and/or suggest” it in combination with the other elements of the challenged claims. (Ex. 1002 at 1002.0047.)

Even if it could be argued that the examiner did not consider Saylor (in the form of Saylor '265), Saylor and Gregory are, at best, merely cumulative of the Kellen and Thomson references, which were

fully evaluated and distinguished during prosecution of the '262 patent. . . .

. . . .

In the Petition, [Petitioner] offers Saylor as teaching *precisely* the same limitations that were considered by the examiner in Kellen above. (*See, e.g., Pet., 19–24.*) Moreover, with respect to the amendment pertaining to “receive a command from the remote monitoring service, the command identifying a specific light at the premises and including an instruction to turn on the specified light,” and “execute the command from the remote monitoring service to turn on the specified light,” the teachings of Gregory are also identical to the teachings of Kellen.

*Id.* at 25–29.

Further, Patent Owner contends, “[w]ith regard to [*Becton, Dickinson*] factor (c), there is no dispute that the examiner rejected the applied-for claims over Saylor ’265—identical to Saylor, and over Thomson and Kellen—cumulative of Saylor and Gregory, and yet ultimately allowed the claims, as amended and now before the Board,” and “[t]he examiner thus considered teachings that are redundant to those relied upon by [Petitioner] and concluded that the claims were patentable.” Prelim. Resp. 30–31.

Regarding *Becton, Dickinson* factor (f), Patent Owner argues that, although Mr. Rysavy’s declaration provides some additional evidence in support of the Petition, “nothing in his declaration changes the core teachings of the references, nor does it provide any helpful analysis of the issues of whether the art is cumulative or whether the examiner erred in their analysis.” *Id.* at 31. Rather, Patent Owner contends, Dr. Rysavy “simply repeats the same conclusory language utilized in the Petition,” which “is unhelpful and does not represent anything new upon which the Board should revisit the decision already made by the Office on the same facts.” *Id.* “Because [Petitioner] has failed to make an adequate showing of material error on the part of the Office,” Patent Owner concludes, “the Board should

defer to the previous evaluations of the Office in which the examiner found the claims patentable over Saylor in conjunction with secondary references.”  
*Id.*

#### 4. Discussion

Notwithstanding Petitioner’s assertion that “considerations under § 325(d) . . . do not apply” because “[t]his is the first and only petition as to the ’262 Patent” (Pet. 48), 35 U.S.C. § 325(d) is not limited to instances where there have been multiple petitions filed against a patent. *See, e.g., Advanced Bionics* (denying institution of a first-filed petition under § 325(d) based on prior art having been previously considered and distinguished during original prosecution).

Having reviewed the parties’ arguments and evidence, we agree with Patent Owner that the Petition presents substantially the same prior art that was already considered by the examiner during prosecution of the challenged claims of the ’262 patent and that Petitioner has not demonstrated material error by the Office in its prior consideration of that art.

##### *a. Whether the Same or Substantially the Same Art Previously Was Presented to the Office*

Notwithstanding Petitioner’s contention that none of the references it relies upon in the Petition were “considered during the prosecution of the ’262 Patent” (Pet. 2), the portions of Saylor relied upon by Petitioner are substantially identical to Saylor ’265 cited by the examiner (*see* Ex. 1002, 155). Indeed, although Petitioner provides a brief summary of the prosecution history of the ’262 patent (Pet. 4–5), Petitioner does not mention the examiner’s citation of Saylor ’265.

Likewise, Petitioner does not address the similarities between the portions of Gregory that it relies upon and the disclosures of Kellen and

Thomson, and we agree with Patent Owner that those references disclose essentially the same subject matter for which Petitioner relies on Gregory. *Compare, e.g.*, Ex. 1005 ¶¶ 23–26, 28, 29, 31–33 (cited at Pet. 24, 26–27 as disclosing “a security system (‘control unit’) that received a command from a remote service to turn on an emergency light based in part on the security system notifying the remote service of the alarm”), *with* Ex. 2003 at code (57) (Kellen’s Abstract describing an “alarm system for indicating the specific location of an intrusion,” where “[t]he intrusion causes illumination of an indicator light . . . indicating the specific location of the intrusion,” and having a “control system responsive to the specific intrusion location signal [that] causes the indicator light to emit light that . . . can indicate the specific location of an intrusion by directing light towards the specific intrusion location . . . .”); Ex. 2004 at code (57) (Thomson’s Abstract describing apparatus “that will temporarily identify a building, house, or other structure to which emergency personnel have been dispatched. . . . includ[ing], in one embodiment, a high-intensity stroboscopic light emitting diode (LED) placed in a location that is visible from the exterior of the structure . . . .”).

Because (1) Saylor ’265 was made of record by the examiner and contains essentially the same disclosure as Saylor, (2) we find that the disclosures of Gregory relied upon by Petitioner are duplicative of Kellen and Thomson evaluated and distinguished during examination, and (3) Petitioner extensively relies on Saylor and Gregory in each of the asserted grounds of unpatentability, we determine that the Petition presents the same or substantially the same prior art that was previously presented to

the Office. As a result, we conclude that the first part of the *Advanced Bionics* framework is satisfied. *See Advanced Bionics*, Paper 6 at 7–8.<sup>8</sup>

*b. Whether the Same or Substantially the Same Arguments Previously Were Presented to the Office*

As discussed above, we determine that the “same or substantially the same prior art” previously was presented to the Office. Accordingly, the first condition of the first part of the *Advanced Bionics* framework is satisfied, and we need not reach whether the “same or substantially the same arguments” previously were presented to the Office. *See Advanced Bionics*, Paper 6 at 20.

*c. Whether Petitioner Sufficiently Demonstrates that the Office Erred*

Having determined that the “same or substantially the same prior art” previously was presented to the Office, we evaluate whether Petitioner sufficiently demonstrates that the Office erred. *See* Section III.E.1.

Under the second part of the *Advanced Bionics* framework, Petitioner must demonstrate that the examiner erred in the evaluation of the prior art, for example, by showing that the examiner misapprehended or overlooked specific teachings in the relevant prior art such that the error by the Office was material to the patentability of the challenged claims. *Advanced Bionics*, Paper 6 at 8 n.9. As discussed above, the examiner allowed the challenged claims over the teachings of the prior art of record—including

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<sup>8</sup> We find no support for Patent Owner’s contention at page 30 of the Preliminary Response that “there is no dispute that the Examiner rejected the applied-for claims over Saylor ’265.” Regardless, for purposes of the first part of the *Advanced Bionics* framework, “[p]reviously presented art includes art made of record by the Examiner . . . in the prosecution history of the challenged patent.” *Advanced Bionics*, Paper 6 at 7–8.

Kellen, Thomson, and Saylor '265—specifically explaining that the prior art of record “fails to describe and/or suggest” a security and automation system comprising, *inter alia*, a control unit configured to “receive a command from [a] remote monitoring service, the command identifying a specific light at the premises and including an instruction to turn on the specified light, wherein the command is based at least in part on sending the alarm condition to the remote monitoring service.” Ex. 1002, 47. Petitioner does not allege that the examiner erred by finding the claims patentable over Thomson and Kellen or by not utilizing Saylor '265 or any other prior art of record as the basis for a rejection. Nor does Petitioner argue that Saylor, Elliot, Siegler, or Gagnavi cures the above-identified deficiency. *See, e.g.*, Pet. 23–27 (arguing that “Saylor does not specifically disclose configuring the system to turn on a specified light in response to an alarm” and relying instead on Gregory for the recited limitation), 27–28, 39–48 (relying on Elliot, Siegler, and Gagnavi only for other limitations). Rather, Petitioner presents an additional reference (i.e., Gregory) that, similar to Kellen and Thomson, discloses an emergency lighting system “comprising one or more lights” that may be activated by a controller when an emergency situation is detected, which does not persuade us that the examiner materially erred in determining the patentability of the challenged claims that more particularly recite receiving a command “identifying a specific light at the premises and including an instruction to turn on the specified light.” Ex. 1001, 13:8–11 (emphasis added).

Thus, considering the record before us, we cannot say that the examiner erred by finding the claims patentable over the prior art of record, which, as noted above, included not only Thomson and Kellen but also Saylor '265. Accordingly, we determine that “the same or substantially the



same prior art previously w[as] presented to the Office” and that Petitioner has not demonstrated that the examiner erred in a manner material to the patentability of the challenged claims of the ’262 patent when considering such prior art.

#### IV. CONCLUSION

For the foregoing reasons, we exercise our discretion to deny institution of *inter partes* review under 35 U.S.C. § 325(d).

#### V. ORDER

In consideration of the foregoing, it is hereby:

ORDERED that the Petition is *denied* as to all challenged claims, and no trial is instituted.

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Patent 9,349,262 B2

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