

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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IPR2022-00634  
Patent 8,392,552 B2

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Before JAMESON LEE, MICHAEL R. ZECHER, and  
IFTIKHAR AHMED, *Administrative Patent Judges*.

ZECHER, *Administrative Patent Judge*.

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

## I. INTRODUCTION

### A. *Background*

ADT LLC (“ADT”) filed a Petition requesting *inter partes* review (“IPR”) of claims 1, 2, 9–11, 26, 31, and 33–35 of U.S. Patent No. 8,392,552 B2 (Ex. 1001, “the ’552 patent”). Paper 1 (“Pet.”).<sup>1</sup> Vivint, Inc. (“Vivint”) filed a Preliminary Response. Paper 6 (“Prelim. Resp.”).

Based on the authority delegated to us by the Director under 37 C.F.R. § 42.4(a), we may not institute an IPR unless “the information presented in the petition filed under section 311 and any response filed under section 313 shows that 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) (2018). Taking into account Vivint’s Preliminary Response, we conclude that the information presented in the Petition does not establish that there is a reasonable likelihood that ADT would prevail in challenging any one of claims 1, 2, 9–11, 26, 31, and 33–35 of the ’552 patent as unpatentable. We, therefore, *deny* ADT’s Petition.

### B. *Real Parties in Interest*

ADT identifies itself, ADT Inc., Alarm.com Inc., and Alarm.com Holdings, Inc. as the real parties in interest. Pet. 1. Vivint identifies itself and Vivint Smart Home, Inc. as the real parties in interest. Paper 3, 2 (Vivint’s Mandatory Notices).

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<sup>1</sup> ADT’s Petition does not include page numbers. We consider the page beginning with Section I titled “MANDATORY NOTICES” as page 1 and then proceed from there in numerical order.

*C. Related Matters*

The parties identify the following district court case involving the '552 patent: *Vivint, Inc. v. ADT, LLC*, No. 2:21-cv-00115-CW-DBP (D. Utah). Pet. 1; Paper 3, 2. Although the parties identify no other proceedings, patents, or patent applications related to the '552 patent, we note that IPR2022-00642 involves U.S. Patent No. 8,700,769 B2, which is a continuation of the '552 patent.

*D. The '552 Patent*

The '552 patent is titled “System and Method for Providing Configurable Security Monitoring Utilizing an Integrated Information System.” Ex. 1001, code (54). The '552 patent generally is directed to “a security monitoring network and, in particular, to a system and method for providing variable, remote monitoring of a locally detected event utilizing an integrated information system.” *Id.* at 1:23–26.

According to the '552 patent, “[w]hile the conventional art generally discloses utilizing multiple monitoring devices to perform various functions, conventional systems are deficient in data management functionality and integration. Security data from different monitoring device types is generally not integrated to affect the system reporting and control.” Ex. 1001, 1:53–58. The '552 patent states that “the conventional security system is built around independent stand-alone devices that require human control and interpretation.” *Id.* at 1:58–60. The '552 patent states that “there is a need for an integrated information system that can obtain any variety of monitoring device inputs, process any combination of the inputs, and provide customized outputs according to the needs and rights of an authorized user.” *Id.* at 3:14–18.

The '552 patent purportedly addresses this problem using “[a] system and method for implementing an integrated information system.” Ex. 1001, code (57). Specifically, the '552 patent discloses:

A premises server . . . in communication with a variety of information sources that produce monitoring data for a premises. The premises server collects, presents, and transmits the monitoring device data to a central server capable of processing data from multiple premises servers. The central server receives the data and traverses one or more logical rule sets to determine whether the inputted data violates the rules. Based on an evaluation of the rules, the central server generates outputs in the form of communication to one or more authorized users via a variety of communication mediums and devices and/or the instigation of a variety of acts corresponding to the evaluation of the rules.

*Id.*

Figure 2 of the '552 patent is reproduced below.

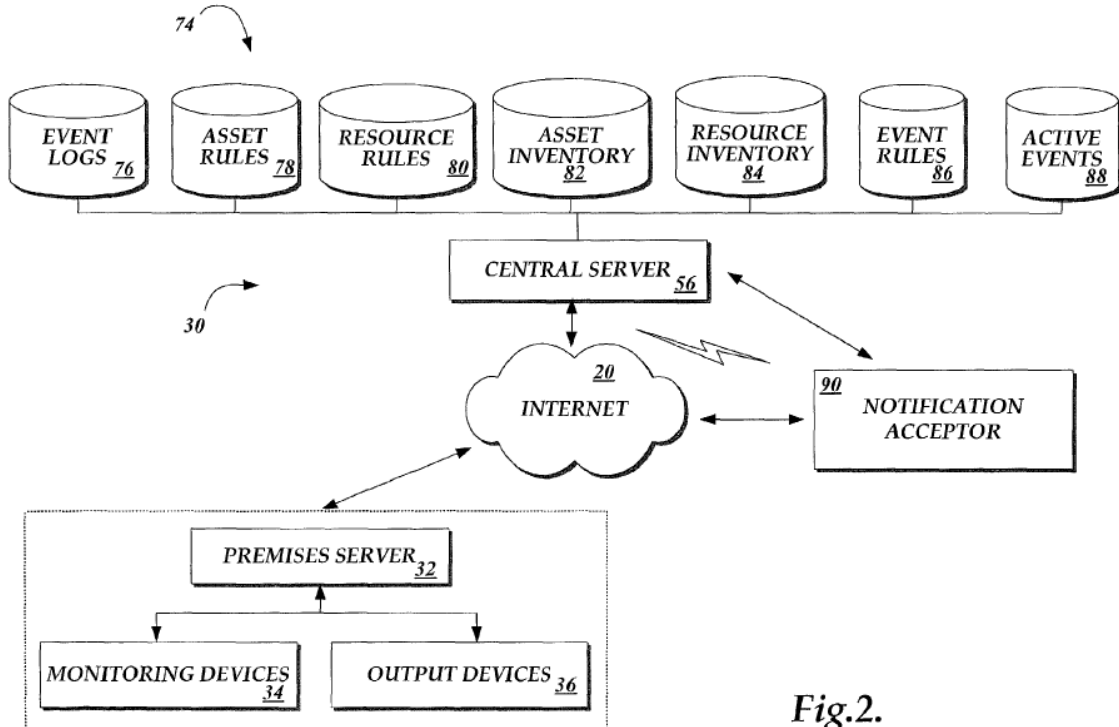


Fig.2.

Figure 2, reproduced above, “is a block diagram of an integrated information system in accordance with the present invention.” Ex. 1001, 4:44–45. More specifically, Figure 2 shows “integrated information system 30 is a subscriber-based system allowing a number of monitoring devices within one or more premises to be processed at a single control location.” *Id.* at 6:21–24.

Figure 2 further shows, among other things, “integrated information system 30 includ[ing] a premises server 32 located on a premises.” Ex. 1001, 6:32–33. “[P]remises server 32 communicates with one or more monitoring devices 34,” which can include smoke detectors, door and window access detectors, computer network monitors, biometric identification devices, geographic locators, and the like. *Id.* at 6:33–49. “[P]remises server 32 also communicates with one or more output devices 36,” including audio speakers, electrical or electromechanical devices that allow the system to perform actions, computer system interfaces, door and window locking mechanisms, and the like. *Id.* at 6:53–61.

“[P]remises server 32 is in communication with a central server 56. Generally described, the central server 56 obtains various monitoring device data, processes the data and outputs the data to one or more authorized users.” Ex. 1001, 8:14–18. “The monitoring device data is obtained by the monitoring devices 34 on the premises server 32 and transmitted to the central server 56. The central server 56 receives the monitoring device data and processes the data according to a rules-based decision support logic.” *Id.* at 10:11–15. Specifically, “central server 56 maintains databases 74 having logic rules for asset data, resource data and event data.” *Id.* at 10:15–18. In addition, “central server 56 communicates with one or more notification acceptors 90,” which “include one or more authorized users,”

each with “a preference of notification means as well as rights to the raw and processed monitoring data.” *Id.* at 9:24–29.

*E. Illustrative Claim*

Claims 1, 11, 26, and 35 are independent. Independent claims 1 and 26 are directed to method claims, whereas independent claim 11 is directed to “[a] non-transitory computer-readable medium having computer executable instructions for performing a method,” and independent claim 35 is directed to “[a] computer system having a processor, a memory, and an operating system, the computer system operable to perform a method.” *Compare* Ex. 1001, 20:18, *with id.* at 21:15–17, *id.* at 22:48, *and id.* at 24:5–7. Claims 2, 9, and 10 directly depend from independent claim 1; and claims 31, 33, and 34 directly depend from independent claim 26. Independent claim 1, reproduced below, is illustrative of the challenged claims.

1. A method, comprising:

categorizing monitoring device data based on a source of the monitoring device data, wherein categorizing the monitoring device data includes determining whether the monitoring device data was generated at least in part, by an identifiable object, the identifiable object having a determined capability of independent activity in generating the monitoring device data;

obtaining a set of rules from a database, wherein the set of rules includes at least one of: an asset rule for monitoring device data characterized as asset data, a resource rule for monitoring device data characterized as resource data, and a device rule for monitoring device data characterized as event data;

determining from the set of rules whether one or more rules that are based on the categorization of the monitoring device data are found, wherein at least one rule of the set of rules applies to monitoring device data characterized as corresponding to an independent object and wherein at least another rule of the set of rules applies to monitoring device data characterized as not corresponding to an independent object;

processing the monitoring device data according to the one or more rules that are found by causing instructions to be executed by a computing device in response to any of the one or more rules that are based on the categorization of the monitoring device data; and

determining whether the monitoring device data is outside a range of the one or more rules that are found, where the range defines a rule violation.

*Id.* at 20:18–47.

*F. Prior Art and Asserted Grounds*

ADT relies on the prior art references set forth in the table below.

<b>Name<sup>2</sup></b>	<b>Reference</b>	<b>Dates</b>	<b>Exhibit No.</b>
Ulrich	US 6,344,794 B1	issued Feb. 5, 2002; filed Jan. 7, 2000	1005
Mathias	US 6,300,872 B1	issued Oct. 9, 2001; filed June 20, 2000	1006
Wewalaarachchi	US 6,477,434 B1	issued Nov. 5, 2002, filed Mar. 15, 2000	1007
Dietrich	US 4,689,610	issued Aug. 25, 1987; filed Oct. 17, 1984	1008

ADT also relies on the testimony of Vernon Thomas Rhyne, III, Ph.D., P.E., R.P.A. (Ex. 1009 (Declaration of Dr. Rhyne in support of the Petition)).

*G. Asserted Grounds of Unpatentability*

ADT asserts that claims 1, 2, 9–11, 26, 31, and 33–35 of the '552 patent would have been unpatentable based on the grounds set forth in the table below. Pet. 2–3, 10–58.

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<sup>2</sup> For clarity and ease of reference, we only list the first named inventor.

<b>Claim(s) Challenged</b>	<b>35 U.S.C. §<sup>3</sup></b>	<b>Reference(s)/Basis</b>
1, 2, 9–11	103(a)	Ulrich, Mathias
1, 2, 9–11	103(a)	Ulrich, Mathias, Wewalaarachchi
26, 31, 33–35	103(a)	Ulrich, Mathias, Dietrich
26, 31, 33–35	103(a)	Ulrich, Mathias, Dietrich, Wewalaarachchi

## II. ANALYSIS

### A. *Legal Standards*

In *Graham v. John Deere Co. of Kansas City*, 383 U.S. 1 (1966), the Supreme Court set out a framework for assessing obviousness under 35 U.S.C. § 103(a) that requires consideration of four factors: (1) the “level of ordinary skill in the pertinent art,” (2) the “scope and content of the prior art,” (3) the “differences between the prior art and the claims at issue,” and (4) when in evidence, “secondary considerations” of non-obviousness such as “commercial success, long[-]felt but unsolved needs, failure of others, etc.” *Id.* at 17–18. “While the sequence of these questions might be reordered in any particular case,” *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 407 (2007), the U.S. Court of Appeals for the Federal Circuit has repeatedly emphasized that “it is error to reach a conclusion of obviousness until all those factors are considered,” *WBIP, LLC v. Kohler Co.*, 829 F.3d 1317, 1328 (Fed. Cir. 2016).

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<sup>3</sup> The Leahy-Smith America Invents Act (“AIA”) included revisions to 35 U.S.C. §§ 102, 103 that became effective on March 16, 2013. Because the ’552 patent claims the benefit of the priority date of U.S. Patent Application No. 10/116,351, which was filed before March 16, 2013, and neither party has argued that the provisions of the AIA apply, we apply the pre-AIA versions of the statutory bases for unpatentability. *See* Ex. 1001, codes (21), (22).



*B. Level of Ordinary Skill in the Art*

In determining whether an invention would have been obvious at the time it was made, we consider the level of ordinary skill in the pertinent art at the time of the invention. *Graham*, 383 U.S. at 17. “The importance of resolving the level of ordinary skill in the art lies in the necessity of maintaining objectivity in the obviousness inquiry.” *Ryko Mfg. Co. v. Nu-Star, Inc.*, 950 F.2d 714, 718 (Fed. Cir. 1991). The “person having ordinary skill in the art” is a hypothetical construct, from whose vantage point obviousness is assessed. *In re Rouffet*, 149 F.3d 1350, 1357 (Fed. Cir. 1998).

Factors pertinent to a determination of the level of ordinary skill in the art include “(1) the educational level of the inventor; (2) type of problems encountered in the art; (3) prior art solutions to those problems; (4) rapidity with which innovations are made; (5) sophistication of the technology; and (6) educational level of active workers in the field.” *Env’t Designs, Ltd. v. Union Oil Co. of Cal.*, 713 F.2d 693, 696 (Fed. Cir. 1983) (citing *Orthopedic Equip. Co. v. All Orthopedic Appliances, Inc.*, 707 F.2d 1376, 1381–82 (Fed. Cir. 1983)). “Not all such factors may be present in every case, and one or more of these or other factors may predominate in a particular case.” *Id.* at 696–97.

In its Petition, ADT argues that a person having ordinary skill in the art “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 experience in remote monitoring and information systems.” Pet. 5 (citing Ex. 1009 ¶¶ 29, 30). In its Preliminary Response, Vivint does not address the level of skill in the art. *See* Prelim. Resp.

Accordingly, for purposes of this Decision, we adopt ADT’s proposed formulation of the level of ordinary skill in the art, but delete the qualifier “at least” for both the level of education and level of experience to keep the articulated level of ordinary skill in the art from being open-ended and, therefore, vague and over-encompassing. As modified, the articulation appears to be consistent with the ’552 patent and the asserted prior art.

*C. Claim Construction*

We apply the same claim construction standard used in the federal courts, in other words, the claim construction standard that would be used to construe the claim in a civil action under 35 U.S.C. § 282(b), which is articulated in *Phillips v. AWH Corp.*, 415 F.3d 1303 (Fed. Cir. 2005) (en banc). See 37 C.F.R. § 42.100(b) (2021). Under the *Phillips* standard, “the words of a claim ‘are generally given their ordinary and customary meaning,’” which is “the meaning that the term would have to a person of ordinary skill in the art in question at the time of the invention, i.e., as of the effective filing date of the patent application.” *Phillips*, 415 F.3d at 1312–13.

In its Petition, ADT proposes express constructions for the following claim terms: (1) “object” and “identifiable object”; (2) “object capable of independent action,” “independent object,” “object having a determined capability of independent activity [in generating the / for generating] monitoring device data”; (3) “object not capable of independent action”; (4) “an asset rule for monitoring device data characterized as asset data”; (5) “a resource rule for monitoring device data characterized as resource data”; and (6) “a device rule for monitoring device data characterized as event data”; and (7) “access control monitoring device.” Pet. 5–10 (citing Ex. 1009 ¶¶ 40–50). In its Preliminary Response, Vivint does not dispute

ADT's proposed constructions or propose alternative constructions. *See* Prelim. Resp.

Based on the preliminary record, there is no readily discernible controversy between the parties that requires us to construe any claim terms at this time. *See Nidec Motor Corp. v. Zhongshan Broad Ocean Motor Co.*, 868 F.3d 1013, 1017 (Fed. Cir. 2017) (noting that “we 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))).

*D. Obviousness Over the Combined Teachings of Ulrich and Mathias*

ADT argues that claims 1, 2, and 9–11 would have been obvious over the combination of Ulrich and Mathias. *See* Pet. 10–25. Based on the current record, we are not persuaded that ADT has established a reasonable likelihood of prevailing on this asserted obviousness ground with respect to at least one of claims 1, 2, and 9–11. Specifically, ADT has failed to articulate, with reasonable clarity, (1) which teachings of each prior art reference it relies on to show that the combination of Ulrich and Mathias accounts for all the limitations of claims 1, 2, and 9–11 and (2) why a person having ordinary skill in the art would have been motivated to combine the teachings of these references.

*1. Principles of Law*

“At the outset, a party must file a petition to institute review, 35 U.S.C. § 311(a), that identifies the challenged claims and the grounds for challenge with particularity, [35 U.S.C.] § 312(a)(3).” *SAS Inst., Inc. v. Iancu*, 138 S. Ct. 1348, 1351 (2018); *see also* 37 C.F.R. § 42.104(b) (specifying necessary elements of a petition). Under 35 U.S.C. § 314(a), an

IPR can be instituted only if there is a reasonable likelihood that the petitioner would prevail with respect to at least one of the claims challenged in the petition. 35 U.S.C. § 314(a). Even when a petitioner demonstrates a reasonable likelihood as to at least one claim, however, institution of an IPR remains discretionary. *SAS Inst.*, 138 S. Ct. at 1351 (“§ 314(a) invests the Director with discretion on the question *whether* to institute review”); *Harmonic Inc. v. Avid Tech., Inc.*, 815 F.3d 1356, 1367 (Fed. Cir. 2016) (“First of all, the [U.S. Patent and Trademark Office] is permitted, but never compelled, to institute an IPR proceeding.” (citing 35 U.S.C. § 314(a))). As explained in our Trial Practice Guide Update, “[t]he Director’s discretion is informed by 35 U.S.C. §§ 316(b) and 326(b), which require the Director to ‘consider the effect of any such regulation [under this section] on the economy, the integrity of the patent system, the efficient administration of the Office, and the ability of the Office to timely complete proceedings instituted under this chapter.’” Consolidated Trial Practice Guide (Nov. 2019) at 56.<sup>4</sup>

“Because the Board’s practice, in light of *SAS*, is to institute on all grounds asserted in a petition, the Board may consider whether a lack of particular[ity] as to one or more of the asserted grounds justifies denial of an entire petition.” *Adaptics Ltd. v. Perfect Co.*, IPR2018-01596, Paper 20 at 17 (PTAB March 6, 2019) (designated informative). For example, in *Adaptics*, the Board found that the petition contained voluminous or excessive grounds and that “the Petition fail[ed] to specify what Petitioner regard[ed] as the difference(s) between [the references] and the challenged claims.” *Id.* at 18–20 (citing *Graham*, 383 U.S. at 17 (requiring that the

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<sup>4</sup> Available at <https://www.uspto.gov/TrialPracticeGuideConsolidated>.

differences between the prior art and the claims at issue be ascertained as part of an obviousness analysis)). More specifically, the Board found that “Petitioner’s ‘catch-all’ ground attempt[ed] to require Patent Owner to address whether each and every claim limitation [was] taught not only by each of [two primary references], but by each of these references in combination with one or more of the other references asserted in the proceeding.” *Id.* at 20–21. Accordingly, the Board concluded that “Petitioner’s ‘catch-all’ ground [was] not reasonably bounded in scope and unduly burdensome for both Patent Owner and the Board to address.” *Id.* at 21.

## 2. *Proposed Combination Lacks Particularity*

Based on the express statements in ADT’s Petition, we understand ADT to be arguing that each of claims 1, 2, and 9–11 would have been obvious over “the combination of Ulrich and Mathias.” Pet. 13, 22–24. ADT, however, maps each limitation of independent claims 1 and 11 and dependent claims 2, 9, and 10 to Ulrich and Mathias independently. *Id.* at 13–25. Because ADT expressly relies on “the combination of Ulrich and Mathias” but maps each limitation of the challenged claims to each reference without acknowledging any shortcomings or deficiencies of the references, it is not clear which teachings of each reference ADT combines to account for all the limitations of claims 1, 2, and 9–11. Prelim. Resp. 12–22.

For example, ADT contends that Ulrich teaches the preamble and first limitation—identified in the Petition as limitation “[1a] categorizing monitoring device data based on a source of the monitoring device data”—because “Ulrich disclosed a tracking system that performed a method.” Pet. 13–14 (citing Ex. 1005, code (54)). In addition, ADT argues that “Ulrich’s tracking system performed each step of claim 1.” *Id.* at 14. ADT

further contends that Mathias teaches the preamble and limitation [1a] because “Mathias also taught a method wherein monitoring device data was categorized based on source.” *Id.* Similarly, ADT maps each limitation of independent claims 1 and 11 and dependent claims 2, 9, and 10 to Ulrich and Mathias individually without any discussion of the interplay between these two references. *Id.* at 13–25.

To the extent ADT expects us to scour the prior art references and piece together an obviousness ground based on “the combination of Ulrich and Mathias,” or ignore ADT’s express framing of this obviousness ground and rely on the teachings of either reference alone, we decline to do so. It is well-settled that ADT—as the Petitioner—is “master of its complaint.” *SAS Inst.*, 138 S. Ct. at 1355. We are constrained by the arguments and evidence presented and developed in ADT’s Petition, and we are not at liberty to “raise, address, and decide . . . theories never presented by [ADT] and not supported by record evidence.” *In re Magnum Oil Tools Int’l, Ltd.*, 829 F.3d 1364, 1381 (Fed. Cir. 2016). Moreover, even if we were to overlook the above-noted deficiency in ADT’s mapping of independent claim 1 and institute an IPR proceeding, the lack of clarity in ADT’s asserted obviousness ground might enable ADT to deviate from the arguments initially presented in the Petition in a manner that may prejudice Vivint. *See Wasica Fin. GmbH v. Cont’l Auto. Sys., Inc.*, 853 F.3d 1272, 1286 (Fed. Cir. 2017) (explaining that “[s]hifting arguments” during the course of a trial are “foreclosed by statute, [Federal Circuit] precedent, and Board guidelines”).

Although “a patent can be obvious in light of a single prior art reference,” the Federal Circuit has held that a single-reference obviousness ground requires that “it would have been obvious to modify that reference to arrive at the patented invention.” *Arendi S.A.R.L. v. Apple Inc.*, 832 F.3d

1355, 1361 (Fed. Cir. 2016). ADT has not framed this asserted obviousness ground as based on a single-reference nor explained why it would have been obvious to modify the teachings of Ulrich or Mathias alone for a single-reference obviousness ground. *See* Pet. 13–25. Rather, ADT expressly contends that it is “the combination of Ulrich and Mathias” that teaches all the limitations of claims 1, 2, and 9–11. *Id.*

### 3. *Rationale to Combine*

Although ADT provides rationales to combine the teachings of Ulrich and Mathias, the reasoning provided is generic and conclusory, and does not clarify sufficiently which teachings from each reference it combines to account for all the limitations of claims 1, 2, and 9–11. In *Belden Inc. v. Berk-Tek LLC*, the Federal Circuit explained that “obviousness concerns whether a skilled artisan not only *could have made* but *would have been motivated to make* the combinations or modifications of prior art to arrive at the claimed invention.” *Belden Inc. v. Berk-Tek LLC*, 805 F.3d 1064, 1073 (Fed. Cir. 2015). Further, a rationale to combine must not rely on hindsight, but must “imply a motivation to pick out those two references and combine them to arrive at the claimed invention.” *Personal Web Techs., LLC v. Apple, Inc.*, 848 F.3d 987, 993–94 (Fed. Cir. 2017); *Metalcraft of Mayville, Inc. v. Toro Co.*, 848 F.3d 1358, 1367 (Fed. Cir. 2017) (“[W]e cannot allow hindsight bias to be the thread that stitches together prior art patches into something that is the claimed invention.”).

Based on the current record, we are not persuaded by ADT’s rationale to combine arguments for three reasons. First, ADT contends that “a [person having ordinary skill in the art] would consider the teachings of one reference applicable to the other and would have been motivated to incorporate desirable features from one system into the other.” Pet. 12.

More specifically, ADT argues that “Ulrich and Mathias are both directed to location monitoring and security systems,” so “a [person having ordinary skill in the art] would naturally look to incorporate features of the Mathias system into the system disclosed by Ulrich and vice-versa.” *Id.* (citing Ex. 1009 ¶¶ 65, 66).

As Vivint correctly notes in its Preliminary Response, it is well-settled that “[s]imilarity in subject matter is insufficient,” by itself, “to establish that a [person having ordinary skill in the art] would have been motivated to combine references.” Prelim. Resp. 25 (citing *Microsoft Corp. v. Enfish, LLC*, 662 F. App’x 981, 990 (Fed. Cir. 2016) (unpublished); *Securus Techs., Inc. v. Global Tel\*Link Corp.*, 701 F. App’x 971, 977 (Fed. Cir. 2017) (unpublished); *Salpeter v. ARP Wave, LLC*, IPR2019-01384, Paper 12 at 17 (PTAB Jan. 27, 2020)). Similar to *Personal Web Technologies*, ADT’s “reasoning seems to say no more than that a skilled artisan, once presented with the two references, would have understood that they *could be* combined.” *Personal Web Techs.*, 848 F.3d at 993; *see* Prelim. Resp. 26–27 (citing *Apple Inc. v. MPH Techs. Oy*, 28 F.4th 254, 262–63 (Fed. Cir. 2022) (finding expert testimony conclusory and improperly guided by hindsight based on use of the phrases: “would naturally have included”; “would be logical”; and “could be, and most logically would be”)). ADT neither explains why a person having ordinary skill in the art would have been motivated to combine the teachings of Ulrich and Mathias—as we understand ADT to be arguing—nor does it explain why a person having ordinary skill in the art would have been motivated to modify either Ulrich or Mathias such that either reference may be asserted in a single-reference obviousness ground. In addition, because Dr. Rhyne’s declaration testimony



mirrors the arguments presented by ADT, his supporting testimony fares no better. *Compare* Pet. 12, with Ex. 1009 ¶¶ 65, 66.

Second, nearly copying Dr. Rhyne’s declaration testimony verbatim, ADT contends that:

Implementing the teachings of Mathias in the system disclosed by Ulrich and vice-versa would have provided the expected benefits of better monitoring and management of personnel, asset and field devices. A [person having ordinary skill in the art] would have recognized that the system and teachings of Mathias can be easily incorporated into the system and teachings of Ulrich and vice-versa.

Pet. 12 (citing Ex. 1009 ¶ 67). As an initial matter, ADT’s assertion that combining the teachings of Ulrich and Mathias “provide[s] the expected benefits of better monitoring and management of personnel, asset and field devices” is a generic statement of motivation to combine that cannot, without more, support a conclusion of obviousness. This assertion alone does not clear up the confusion surrounding which teachings of Ulrich that ADT proposes to combine with which teachings of Mathias. In addition, merely stating that the proposed combination results in “better monitoring and management of personnel, asset and field devices,” without providing the necessary factual underpinnings to support achieving these results, is akin to stating in a conclusory fashion that the proposed combination “would have been obvious.” *See In re Van Os*, 844 F.3d 1359, 1362 (Fed. Cir. 2017) (explaining that “a finding that a combination of prior art would have been . . . ‘intuitive’ is no different than merely stating the combination ‘would have been obvious’”).

Moreover, Dr. Rhyne’s declaration testimony on this particular issue fares no better. The Federal Circuit has explained, “[c]onclusory expert testimony does not qualify as substantial evidence.” *TQ Delta, LLC v. Cisco*

*Sys., Inc.*, 942 F.3d 1352, 1358–59 (Fed. Cir. 2019). Specifically, the Federal Circuit has found that, when “[t]he expert failed to explain how specific references could be combined, which combination(s) of elements in specific references would yield a predictable result, or how any specific combination would operate or read on the asserted claims,” that the “expert’s testimony on obviousness was essentially a conclusory statement.” *ActiveVideo Networks, Inc. v. Verizon Commc’ns, Inc.*, 694 F.3d 1312, 1327 (Fed. Cir. 2012); *KSR Int’l*, 550 U.S. at 418 (“A patent composed of several elements is not proved obvious by merely demonstrating that each of its elements was, independently, known in the prior art.”); *Innogenetics, N.V. v. Abbott Lab’ys*, 512 F.3d 1363, 1373–74 (Fed. Cir. 2008)) (finding that “vague testimony would not have been helpful to a lay jury in avoiding the pitfalls of hindsight that belie a determination of obviousness”).

Dr. Rhyne’s declaration testimony sets forth a generic and conclusory statement without explaining how the teachings of Ulrich and Mathias could be combined, which combination of elements in Ulrich and Mathias would yield the “expected benefits,” or how any specific combination would operate or read on the limitations of independent claim 1. Accordingly, Dr. Rhyne’s supporting testimony also is deficient. *See* 37 C.F.R. § 42.65(a) (“Expert testimony that does not disclose the underlying facts or data on which the opinion is based is entitled to little or no weight.”)

Third, ADT contends that “[i]mplementing the teachings of Mathias in the system disclosed by Ulrich would have been technically straightforward” and “merely have required adapting Ulrich’s existing dependent and independent monitoring systems to use Mathias’[s] reasoning and security system which (as Mathias demonstrates) were designed for use in the type of integrated building management system disclosed in Ulrich.”

Pet. 12–13 (citing Ex. 1006, code (57); Ex. 1009 ¶ 68). Similar to ADT’s rationale to combine argument regarding “expected benefits” that we address above, ADT does not explain why a person of ordinary skill in the art would have “adapt[ed] Ulrich’s existing dependent and independent monitoring systems to use Mathias’[s] reasoning and security system.” *See id.* This is also circular reasoning because it appears to assume that a person of ordinary skill in the art would have combined the teachings of Ulrich and Mathias merely because these two references are in the same field of endeavor. *See id.*

ADT then concludes that:

A [person having ordinary skill in the art] thus would have recognized that implementing the known methods described in Mathias in the system disclosed by Ulrich would have yielded the expected result of an integrated building management system that was implemented using Mathias’ reasoning and security system. Therefore, a [person having ordinary skill in the art] would have a reasonable expectation of success in combining Mathias into the system disclosed by Ulrich.

Pet. 13 (citing Ex. 1009 ¶ 69). Once again, neither ADT’s Petition nor Dr. Rhyne’s declaration testimony provide additional factual support or explanation, so we are not persuaded that this rationale to combine argument is anything more than generic and conclusory.

#### 4. *Summary*

In summary, ADT does not present a sufficiently articulated mapping of the teachings of Ulrich and Mathias that ADT proposes to combine to account for each limitation of independent claim 1. Further, ADT’s rationale to combine does not clarify which particular teachings in Ulrich and Mathias would be combined or how each of these references, if applied individually, would need to be modified to arrive at the claimed invention.

For the reasons we discuss above, we determine that ADT's Petition fails to meet the particularity requirement of 35 U.S.C. § 312(a)(3) for independent claim 1 and provides rationales to combine that are generic and conclusory.

By virtue of their dependency, claims 2, 9, and 10 include the same limitations of independent claim 1. Ex. 1001, 20:48–51, 21:8–14.

Independent claim 11 is essentially the same as independent claim 1 and, as a result, ADT contends that “claim [11] is thus satisfied by Ulrich and Mathias in the same way as for claim 1.” Pet. 25; *compare* Ex. 1001, 20:18–47, *with id.* at 21:15–46. Therefore, for the same reasons we discuss above, ADT's Petition fails to meet the particularity requirement of 35 U.S.C. § 312(a)(3) for claims 2 and 9–11 and provides rationales to combine that are generic and conclusory.

*E. Obviousness Over the Combined Teachings of Ulrich, Mathias, and Wewalaarachchi*

ADT argues that claims 1, 2, and 9–11 would have been obvious over the combination of Ulrich, Mathias, and Wewalaarachchi. *See* Pet. 25–40. Based on the current record, we are not persuaded that ADT has established a reasonable likelihood of prevailing on this asserted obviousness ground with respect to at least one of claims 1, 2, and 9–11. ADT does not cure the deficiencies we discuss above with respect to its mapping of independent claim 1 by additionally relying on the teachings of Wewalaarachchi in this asserted obviousness ground. More specifically, ADT maps each limitation of independent claims 1 and 11 and dependent claims 2, 9, and 10 to the teachings of Wewalaarachchi without any discussion of the interplay between Ulrich, Mathias, and Wewalaarachchi. *See id.* This mapping further compounds the confusion by relying on multiple references without clarifying the role each reference plays in teaching all the limitations of

claims 1, 2, and 9–11. In fact, this asserted obviousness ground presents seven possible combinations of references (i.e., Ulrich alone, Mathias alone, Wewalaarachchi alone, the combination of Ulrich and Mathias, the combination of Ulrich and Wewalaarachchi, the combination of Mathias and Wewalaarachchi, and the combination of Ulrich, Mathias, and Wewalaarachchi). Thus, the extent to which the teachings of Wewalaarachchi may be relied upon independently or in combination with the teachings of Ulrich and/or Mathias further indicates that the Petition lacks the required particularity. The addition of Wewalaarachchi only further exacerbates the lack of clarity in this asserted obviousness ground, making it unduly burdensome for both Vivint and us to address. Therefore, for the same reasons we discuss above, ADT’s Petition fails to meet the particularity requirement of 35 U.S.C. § 312(a)(3) for claims 1, 2, and 9–11 and provides rationales to combine that are generic and conclusory.

*F. Obviousness Over the Combined Teachings Ulrich, Mathias, and Dietrich or the Combined Teachings of Ulrich, Mathias, Dietrich and Wewalaarachchi*

ADT argues that claims 26, 31, and 33–35 would have been obvious over the combination of Ulrich, Mathias, and Dietrich or, alternatively, the combination of Ulrich, Mathias, Dietrich, and Wewalaarachchi. Pet. 40–58. For example, ADT argues that, “[a]s explained with respect to limitation [1a], Ulrich and Mathias both disclosed all requirements of [claim 26] except that they did not specifically discuss use of an access control monitoring device.” Pet. 43. ADT further argues that “a [person having ordinary skill in the art] would have found it obvious to apply the teachings of each of those references to an access control monitoring device, such as a

card reader positioned at an entry door that opened with an electronic lock,” as taught by Dietrich. *Id.* at 43–44 (citing Ex. 1009 ¶ 138).

Based on the current record, we are not persuaded that ADT has established a reasonable likelihood of prevailing on this asserted obviousness ground with respect to at least one of claims 26, 31, and 33–35. Despite ADT’s mapping of the limitations regarding an access control monitoring device to the teachings of Dietrich, ADT does not present a sufficiently articulated mapping of the remaining limitations of claims 26, 31, and 33–35. *See* Pet. 40–58. Rather, ADT relies directly or indirectly on the same deficient mapping of independent claim 1 to teach the remaining limitations of claims 26, 31, and 33–35. *See id.* In addition, ADT’s rationales to combine do not clarify which teachings of the references would be combined or how the references would need to be modified, if applied individually. *See id.* at 41–43, 50–52. Therefore, for the same reasons we discuss above, ADT’s Petition fails to meet the particularity requirement of 35 U.S.C. § 312(a)(3) for claims 26, 31, and 33–35 and provides rationales to combine that are generic and conclusory.

### III. CONCLUSION

After considering the parties’ arguments and evidence, we determine that ADT’s Petition fails to meet the particularity requirement of 35 U.S.C. § 312(a)(3) and provides rationales to combine that are generic and conclusory. *See* 35 U.S.C. § 316(b). Because we conclude that the information presented in the Petition does not establish that there is a reasonable likelihood that ADT would prevail in challenging any one of claims 1, 2, 9–11, 26, 31, and 33–35 of the ’552 patent as unpatentable, we *deny* ADT’s Petition.

IV. ORDER

Accordingly, it is ORDERED that the Petition is *denied* and no trial is instituted.

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Patent 8,392,552 B2

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