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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte VIVINT, INC.

Appeal 2020-000371
Reexamination Control 90/014,007¹
Patent No. US 6,147,601
Technology Center 3900

Before JOHN A. JEFFERY, MARC S. HOFF, and CHARLES J.
BOUDREAU, *Administrative Patent Judges*.

HOFF, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellant appeals under 35 U.S.C. § 134 from the rejection of claims 3, 16, 24, 32, 42, and 43.² We have jurisdiction under 35 U.S.C. §§ 134(b) and 306.

We AFFIRM.

¹ We use the word “Appellant” to refer to “applicant” as defined in 37 C.F.R. § 1.42. Appellant states that the real party in interest is Vivint, Inc. App. Br. 7.

² Claims 1, 2, 4, 6, 7, 10–15, 17, 18, 22, 23, 25, 29, and 38 were determined to be unpatentable in a final written decision in Inter Partes Review IPR2016-00116, May 2, 2017. Claims 5, 8, 9, 19–21, 26–28, 30, 31, 33–37, and 39–41 are not subject to reexamination.

The '601 patent issued to Sandelman on November 14, 2000. The '601 patent concerns monitoring remote equipment. When a sensor detects an exception condition in a piece of remote equipment, an interface unit generates an incoming exception message and forwards the message to a server. '601 Patent Abstract. Incoming messages are normalized at a normalization module so that all incoming messages can then be processed without regard to their incoming medium. '601 Patent, col. 7:16–18. Multiple outgoing exception messages may be forwarded to multiple communication devices in accordance with a user-defined message profile. '601 Patent Abstract.

Claim 42 is exemplary of the claims on appeal:

42. A method for monitoring remote equipment comprising the steps of:
- a) determining a state of at least one parameter of at least one piece of the remote equipment;
 - b) communicating a message indicative of the state to a computer server as an incoming message, the incoming message having a respective incoming format;
 - c) normalizing the incoming message to form a corresponding normalized message having a predetermined uniform format;
 - d) storing the normalized message in a normalized message database on the computer server;
 - e) determining from the incoming message whether at least one exception message related to the incoming message is

to be sent to at least one remote communication device specified by a plurality of message profiles stored at the computer server;

f) if it is determined in step e) that at least one exception message related to the incoming message is to be sent, deriving the at least one exception message from the stored normalized message corresponding to the related incoming message and the message profiles, the at least one exception message derived thereby having a respective format suitable for reception by the at least one remote communication device to which the at least one exception message is to be sent; and

g) sending the at least one exception message derived in step f) to the at least one remote communication device specified by the message profiles,

wherein the message profiles may be created or modified at least in part by a user by remote access of the computer server.

The prior art relied upon by the Examiner as evidence is:

Name	Reference	Date
Shetty et al.	US 5,808,907	Sep. 15, 1998
Wewalaarachchi et al.	US 6,067,477	May 23, 2000
Oberlander	US 5,509,000	Apr. 16, 1996
Cheng	US 6,970,081 B1	Nov. 29, 2005

Throughout this decision, we make reference to Appellant's Brief ("App. Br.," filed Aug. 30, 2017), the Reply Brief ("Reply Br.," filed

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Oct. 18, 2019) and the Examiner's Answer ("Ans.," filed Aug. 15, 2019) for their respective details.

REJECTIONS

Claims 3, 16, 24, 42, and 43 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Shetty and Wewalaarachchi.

Claim 32 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Shetty, Oberlander, Cheng, and Wewalaarachchi.

ISSUES

Appellant's arguments present us with the following issues:

1. Does Shetty teach an exception message sent to at least one remote communications device?
2. Does the combination of Shetty and Wewalaarachchi teach or suggest "storing the normalized message in a normalized message database on the computer server"?
3. Does the combination of Shetty and Cheng disclose or suggest an interface unit periodically generating a normal status message indicative of the proper operation of a piece of equipment to which a sensor is connected?
4. Did the Examiner err in combining Shetty and Wewalaarachchi to achieve the claimed invention?

PRINCIPLES OF LAW

Section 103(a) forbids issuance of a patent when "the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains."

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KSR Int'l Co. v. Teleflex, Inc., 550 U.S. 398, 406 (2007) (quoting 35 U.S.C. § 103(a) (2000)). The question of obviousness is resolved on the basis of underlying factual determinations including (1) the scope and content of the prior art, (2) any differences between the claimed subject matter and the prior art, (3) the level of skill in the art, and (4) where in evidence, so-called secondary considerations. *Graham v. John Deere Co.*, 383 U.S. 1, 17–18 (1966). *See also KSR*, 550 U.S. at 407 (“While the sequence of these questions might be reordered in any particular case, the [*Graham*] factors continue to define the inquiry that controls.”).

If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims prima facie obvious. *In re Ratti*, 270 F.2d 810 (CCPA 1959).

ANALYSIS

Claims 42 and 43

We are not persuaded by Appellant’s argument that Shetty does not teach an exception message sent to at least one remote communications device specified by a plurality of message profiles stored at the computer server, as required in claim 42. App. Br. 18. We agree with the Examiner’s finding that Shetty teaches notification means 112 capable of delivering facsimile reports, email reports and pager reports. Ans. 35. We agree with the Examiner that the facsimile machine, computer, and pager implied by these types of reports “represent the claimed ‘remote communication devices.’” Ans. 35.

Appellant further contends that the combination of Shetty and Wewalaarachchi does not teach “storing the normalized message in a normalized message database on the computer server,” as required by claim 42. App. Br. 19. We are not persuaded, however, that the Examiner erred in combining Shetty and Wewalaarachchi to obtain the claimed invention. Contrary to Appellant’s assertions, the Examiner’s rejection relies on Wewalaarachchi merely to teach the concept of normalizing incoming messages into a uniform format to create normalized messages. Ans. 36; Final Act. 11–12; Wewalaarachchi col. 8:22–46. The Examiner relied on Shetty for a teaching of storing messages. Ans. 36.

Appellant further asserts that the combination of Shetty and Wewalaarachchi does not teach deriving the at least one exception message from the stored normalized message, as recited in claim 42. App. Br. 21. Appellant’s argument is not persuasive. As discussed *supra*, the Examiner’s proposed combination of Shetty and Wewalaarachchi relies on Shetty for a teaching of storing messages. The Examiner relies on Wewalaarachchi, rather than Shetty, for a teaching of normalizing incoming messages into a uniform format, and proposes to modify Shetty in view of Wewalaarachchi’s teachings. Ans. 37.

Appellant argues that the Examiner does not explain how the combination of Shetty and Wewalaarachchi generates outgoing exception messages. App. Br. 23. We are not persuaded that the Examiner erred. The Examiner finds that Shetty teaches “forwarding at least one outgoing exception message based on the incoming message to at least one user-defined communication device,” as recited in claim 1. Final Act. 6; Shetty

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col. 1:33–35, col. 2:42–45. As explained *supra*, the Examiner relies on Wewalaarachchi for a teaching of *normalizing* incoming messages into a uniform format. Ans. 37.

Claims 3 and 24

Appellant argues that the Examiner admits that “Shetty does not explicitly call for normalizing the incoming message into a uniform format” and relies on Wewalaarachchi to teach standardizing data, but that the Examiner does not explain how the cited references teach generating outgoing exception messages. App. Br. 23; Final Act. 14, 17.

We do not find Appellant’s argument persuasive of Examiner error. As discussed with reference to claims 42 and 43, *supra*, the Examiner finds that Shetty discloses forwarding at least one outgoing exception message, as claimed. Final Act. 6; Shetty col. 1:33–35, col. 2:42–45. Also as discussed *supra*, the Examiner proposes to modify Shetty in view of Wewalaarachchi’s teaching of normalizing incoming messages into a uniform format. Ans. 36–37; Final Act. 11–12; Wewalaarachchi col. 8:22–46.

Claim 16

Claim 1, from which claim 16 depends, recites “communicating a message indicative of the state from the piece of remote equipment to a computer server as an incoming message,” and “determining whether an incoming message is an incoming exception message indicative of improper operation of the piece of remote equipment.” Dependent claim 16 further recites “wherein the remote equipment includes heating, ventilating, and cooling equipment.”

Appellant argues that Wewalaarachchi does not teach receiving messages from heating, ventilation, and/or cooling devices sensors indicative of their improper operation. App. Br. 24–25.

The Examiner finds that Wewalaarachchi teaches remote monitoring of equipment using sensors, including “raw, real time data from the field devices . . . such as lights, heating units, thermostats, window controls, ventilation systems, elevator banks, and so forth.” Final Act. 12; Wewalaarachchi col. 4:22–26. We agree with the Examiner that Wewalaarachchi thus teaches monitoring of heating, ventilating, and cooling equipment for improper operation. Ans. 39. The Examiner finds, and we agree, that the Specification suggests that “improper operation” is an operating condition where an operating parameter is outside its preferred range. Ans. 39; ’601 Patent col. 3:46–48. Wewalaarachchi teaches notifying the user “of a critical temperature level,” and teaches testing “whether the temperature exceeds a threshold value.” Ans. 39; Wewalaarachchi col. 16: 53–54, col. 18:33–34. Given such teaching in Wewalaarachchi, we agree with the Examiner that it would have been obvious to monitor such equipment using Shetty’s approach so that Shetty could monitor a wide variety of remote equipment. Ans. 39.

Claim 30

Appellant argues that the combination of Shetty and Cheng does not disclose or suggest an interface unit periodically generating a normal status message indicative of the proper operation of a piece of equipment to which a sensor is connected. App. Br. 25. Appellant argues that Cheng provides the

same teaching as Britton,³ which the Board previously found did not provide a message “specifically indicative of the proper operation of the piece of remote equipment.” App. Br. 25–26.

Appellant’s argument is not persuasive. We agree with the Examiner’s finding that Cheng teaches “normal status message reflecting the integrity of actual remote equipment being monitored.” Ans. 41. “[E]ach appliance 100 includes a status reporter 120 that communicates messages regarding the status of the appliance 100.” Ans. 41; Cheng col. 3:46–48. “[T]he communicated status 121 of the appliance 100 is used as a direct or indirect indication of the security status of the appliance 100. For example . . . the status reporter 120a within the computer 100a reports an ‘I’m OK’, or ‘I am appliance XYZ’, message periodically. The absence of an expected ‘I’m OK’ message from the status reporter 120a could be cause for an alarm.” Ans. 41; Cheng col. 3:55–63.

Further, we do not agree with Appellant that the teachings of Britton, a reference not applied against the claim, are relevant to this ground of rejection. App. Br. 26–27. The Board’s prior conclusions concerning a combination of references including Britton, rather than Cheng, are not binding upon this panel in this matter. *See* Ans. 40–41; App. Br. 27.

Combinability of Shetty and Wewalaarachchi

Appellant contends that the Examiner has not shown exactly how Shetty and Wewalaarachchi would be combined, or *why* the person having ordinary skill in the art would have combined them. App. Br. 28. Appellant

³ U.S. Patent No. 6,040,770.

argues that the fact that a person of ordinary skill “could have made” the combination is legally insufficient. App. Br. 28–29.

With specific regard to claims 3, 24, 42, and 43, Appellant alleges that the Examiner does not explain how a person of ordinary skill would have used Wewalaarachchi’s real-time system in Shetty’s non-real-time system. App. Br. 30. Appellant further argues that (a) Shetty modified by Wewalaarachchi would be inoperable and unsatisfactory for its intended purpose, (b) the Examiner does not consider the teachings of Shetty and Wewalaarachchi in their entirety, and (c) Shetty’s principle of operation must be changed if combined with Wewalaarachchi. App. Br. 30–31.

We are not persuaded that the Examiner erred in combining Shetty and Wewalaarachchi. We agree with the Examiner that the asserted combination of references does not propose to convert the system of Shetty to handle real-time data. Ans. 43. Rather, the Examiner’s asserted combination would have allowed Shetty’s batch mode system to use converted / normalized data, as suggested by Wewalaarachchi, so that Shetty could monitor a wide variety of remote equipment, by combining prior art elements according to known methods to yield predictable results. *Id.* Thus, we also agree with the Examiner that there is no issue of Shetty being rendered inoperable or unsatisfactory for its intended purpose.

In reply, Appellant continues to argue that the Examiner fails to articulate a proper rationale to combine Shetty and Wewalaarachchi (Reply Br. 3–4), but Appellant’s argument continues to rely on the allegation that the Examiner proposes to convert Shetty from batch processing to real-time operation. Reply Br. 5. As emphasized *supra*, the Examiner’s combination

of references does not propose such a modification of Shetty. Appellant's contention that the Examiner fails to demonstrate how Shetty stores normalized messages is not germane to the Examiner's rejection, because the Examiner relies on Wewalaarachchi, rather than Shetty, for a teaching of storing normalized messages. Reply Br. 5.

With regard to claim 16, Appellant again argues that Shetty's principle of operation must be changed if Shetty is reconfigured to permit its batch processing means to operate in real time. App. Br. 31–32. Appellant's argument with respect to claim 16 is unpersuasive, because as discussed *supra*, the Examiner does not propose to change Shetty to real-time operation. We agree with the Examiner that the real-time handling of data taught by Wewalaarachchi is not inseparable from the formatted nature of the standardized data. Ans. 45.

Shetty and Wewalaarachchi – Teaching Away

Appellant argues that Wewalaarachchi teaches away from Shetty's batch processing, because Wewalaarachchi teaches real-time operation and that having a single point of access that is not real-time “degrade[s] performance” App. Br. 34. We are not persuaded by this argument because, as discussed *supra*, we agree with the Examiner's asserted combination of Shetty and Wewalaarachchi does not propose to convert Shetty to real-time operation. Ans. 44.

Shetty and Wewalaarachchi - Impermissible Hindsight

Appellant argues that the Examiner's combination of Shetty and Wewalaarachchi amounts to impermissible hindsight, because the Examiner's asserted rationale for combining the references repeats one of

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the objectives of the '601 Patent, “to be adaptable to all forms of electronic communication.” App. Br. 36.

We do not agree with Appellant’s contention of hindsight reconstruction. We find that the Examiner provided articulated reasoning showing a reason to combine. Contrary to Appellant’s contention, the Examiner did not rely on Wewalaarachchi for the objective of being adaptable to a wide variety of electronic communication. As was cited by the Examiner, Shetty teaches the objective of providing notification by plural methods, such as “electronic mail message or report 114 or by an pager report via a pager 116 or by a facsimile report 122.” Ans. 46; Shetty col. 2:43–48.

Combinability of Shetty, Oberlander, and Cheng

With regard to claims 26 and 30, parent claims to appealed claim 32, Appellant argues that the Examiner’s combination of Shetty, Oberlander, and Cheng would require an improper change to the principle of operation of Shetty, reconfiguring Shetty to have information managers send status check-in messages in real time. App. Br. 38.

Appellant’s argument regarding this combination fails for the same reasons as the combination of Shetty and Wewalaarachchi. The Examiner does not propose changing Shetty to real-time operation. Ans. 49. Further, the Examiner relied on Cheng for its teachings of a normal status message indicating normal operation. We agree with the Examiner that there is no reason why introducing additional messages would destroy the principle of operation of Shetty. Ans. 50.

Appellant again argues that the Examiner exercised impermissible hindsight in combining references, in that the Examiner's stated reasoning repeats one of the objectives of the '601 patent. App. Br. 39. This argument is not persuasive. Just as discussed *supra* with respect to the combination of Shetty and Wewalaarachchi, we find that the Examiner provided articulated reasoning showing motivation to combine. We find that Shetty teaches the objective of providing notification by plural methods, such as "electronic mail message or report 114 or by an pager report via a pager 116 or by a facsimile report 122." Ans. 46, 51; Shetty col. 2:43–48.

Combinability of Shetty, Oberlander, Cheng, and Wewalaarachchi

With respect to the rejection of claim 32, Appellant argues that Shetty, Oberlander, Cheng, and Wewalaarachchi are not properly combinable, in that the Examiner has not explained how and why the combination would take place, the combination would require an improper change in Shetty's principle of operation, Wewalaarachchi teaches away from combination with Shetty, and the combination could only be made through impermissible hindsight. App. Br. 40–46.

As discussed *supra*, Appellant previously presented these arguments concerning the combination of Shetty and Wewalaarachchi alone. We are not persuaded that the Examiner erred. We agree with the Examiner's conclusion that it would have been obvious to modify Shetty in view of Wewalaarachchi's teaching of normalizing incoming messages into a uniform format. Final Act. 33. Appellant's argument concerning principle of operation fails because the Examiner does not propose to convert Shetty from batch to real-time operation. *See* App. Br. 42. Appellant's argument

that Wewalaarachchi teaches away from Shetty is unpersuasive for the same reason: the Examiner does not propose to modify Shetty to real-time operation. *See* App. Br. 44–45; Ans. 52. As mentioned *supra*, we are not persuaded that the Examiner’s combination involves improper hindsight, because Shetty suggests the advantage of adaptability to a variety of forms of electronic communication. *See* App. Br. 46; Shetty col. 2:43–48.

We conclude that the Examiner did not err in rejecting appealed claims 3, 16, 24, 32, 42, and 43, and stated reasons to combine the cited references having a rational underpinning. We sustain the Examiner’s § 103(a) rejection of claims 3, 16, 24, 42, and 43 over Shetty and Wewalaarachchi. We sustain the Examiner’s § 103(a) rejection of claim 32 over Shetty, Oberlander, Cheng, and Wewalaarachchi.

Substantial New Question of Patentability

Appellant argues in the Brief that no substantial new question of patentability exists because the same question was previously presented to the Board. App. Br. 47. Appellant contends that the same references and/or same or “repackaged” arguments were presented in one or more petitions for inter partes review. *Id.* at 50.

Appellant’s arguments, however, are untimely and are, therefore, not before us. Notably, Appellant must first request reconsideration of the SNQ before the Examiner before we can review that issue. Manual of Patent Examining Procedure (MPEP) § 2274(VI) (9th ed. Rev. 08.2017, Jan. 2018). That was not done here.

Appellant’s response to the Examiner’s first action in reexamination, filed September 20, 2018, does not request reconsideration of the SNQ

finding before the Examiner. Appellant's Response to the Final Action in Reexamination argues that the USPTO improperly granted the request for reexamination. However, Appellant's argument was that the Board should deny review under 35 U.S.C. § 325(d) because "the same or substantially the same prior art or arguments previously were presented to the office."

35 U.S.C. § 325(d); Appellant's Response filed Feb. 5, 2019. Appellant did not request reconsideration, before the Examiner, of the conclusion under 35 U.S.C. § 304 that a substantial new question of patentability exists.⁴

Because we conclude that the question of the Examiner's SNQ determination is not properly before us, we are unpersuaded of error in the Examiner's SNQ determination.

CONCLUSIONS

1. Shetty teaches an exception message sent to at least one remote communications device.

2. The combination of Shetty and Wewalaarachchi suggests "storing the normalized message in a normalized message database on the computer server."

⁴ We observe, for completeness of the record, that Appellant petitioned under 37 C.F.R. § 1.181 to vacate the reexamination order, and that the petition was dismissed and ultimately denied. Petition filed November 8, 2017; Decision Dismissing Petition mailed June 15, 2018; Decision Denying and Expunging Petition mailed October 24, 2018. These petition decisions are not reviewable by the PTAB, and the filing of the petitions does not affect our conclusion that Appellant did not request reconsideration of the SNQ before the Examiner.

3. The combination of Shetty and Cheng suggests an interface unit periodically generating a normal status message indicative of the proper operation of a piece of equipment to which a sensor is connected.

4. The Examiner did not err in combining Shetty and Wewalaarachchi to achieve the claimed invention.

DECISION SUMMARY

In summary:

Claims Rejected	35 U.S.C. §	References	Affirmed	Reversed
3, 16, 24, 42, 43	103	Shetty, Wewalaarachchi	3, 16, 24, 42, 43	
32	103	Shetty, Oberlander, Cheng, Wewalaarachchi	32	
Overall Outcome			3, 16, 24, 32, 42, 43	

ORDER

The Examiner's decision to reject claims 3, 16, 24, 32, 42, and 43 is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED

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