UNITED STATES PATENT AND TRADEMARK OFFICE
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BEFORE THE PATENT TRIAL AND APPEAL BOARD
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ONE WORLD TECHNOLOGIES, INC.
d/b/a TECHTRONIC INDUSTRIES POWER EQUIPMENT,
Petitioner,

v.

THE CHAMBERLAIN GROUP, INC.,
Patent Owner.
_____

Case IPR2017-00214
Patent 7,196,611 B2
_____

Before JONI Y. CHANG, JUSTIN T. ARBES, and JOHN F. HORVATH,
Administrative Patent Judges.

ARBES, *Administrative Patent Judge*.

DECISION
Institution of *Inter Partes* Review
37 C.F.R. § 42.108

Petitioner One World Technologies, Inc. d/b/a Techtronic Industries Power Equipment filed a Petition (Paper 2, "Pet.") requesting *inter partes* review of claims 18–25 of U.S. Patent No. 7,196,611 B2 (Ex. 1001, "the '611 patent") pursuant to 35 U.S.C. § 311(a). Patent Owner The Chamberlain Group, Inc. filed a Preliminary Response (Paper 6, "Prelim. Resp.") pursuant to 35 U.S.C. § 313. According to 35 U.S.C. § 314(a), the Director may not authorize an *inter partes* review unless the information in the petition and preliminary response "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." For the reasons that follow, we have decided to institute an *inter partes* review as to claims 18–25 on two grounds of unpatentability.

I. BACKGROUND

A. The '611 Patent[1]

The '611 patent pertains to "human interface methods" for "barrier movement operators." Ex. 1001, col. 1, ll. 6–8. Barrier movement operators (e.g., gate operators and garage door operators) including "a motor for moving a barrier between open and closed positions and a controller for

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[1] Petitioner also challenges claims 1–8 and 10–14 of the '611 patent in Case IPR2017-00073. We instituted an *inter partes* review in that proceeding. *One World Techs., Inc. v. The Chamberlain Group, Inc.*, Case IPR2017-00073 (PTAB Apr. 25, 2017) (Paper 8) ("-73 Dec. on Inst."). Other cases involve the same parties and different patents. Pet. 1–2. In Cases IPR2016-01772, IPR2016-01774, and IPR2016-01846, the petitions were denied. In Case IPR2017-00126, we instituted an *inter partes* review. Cases IPR2017-00432, IPR2017-01040, IPR2017-01042, IPR2017-01132, and IPR2017-01137 are pending.

selectively energizing the motor to move the barrier" were known in the art. *Id.* at col. 1, ll. 9–14. According to the '611 patent, as new features were added to such systems, installation and maintenance became more complicated, resulting in a need for "improved human interaction with barrier movement operators to simplify their installation and maintenance." *Id.* at col. 1, ll. 20–28.

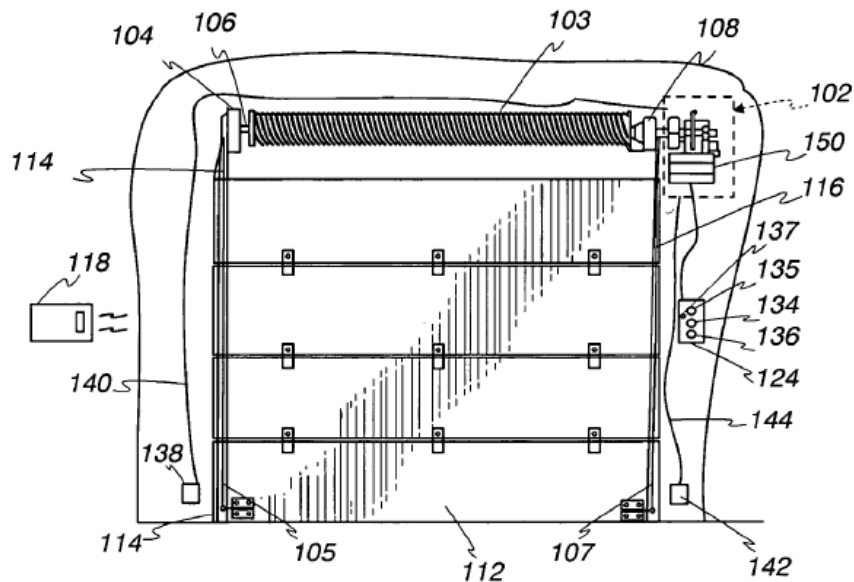Figure 1 of the '611 patent is reproduced below.

Figure 1 depicts a barrier movement operator comprising panel door 112, head end 102, motor 150, controller 208 (not shown), RF transmitter 118, and wall control 124 with light-emitting diode (LED) 137, close push button 134, open push button 135, and stop push button 136. *Id.* at col. 1, l. 47–col. 2, l. 22. When the user presses one of the buttons, wall control unit 124 signals controller 208, which energizes motor 150 to move or stop movement of panel door 112. *Id.* at col. 2, ll. 18–29, Fig. 2. Controller 208

also is connected to input/output devices 147, typically located in head end 102, which are "useful to installers and maintainers of the barrier movement operator." *Id.* at col. 2, ll. 41–45, Fig. 2.

Figure 3 of the '611 patent is reproduced below.
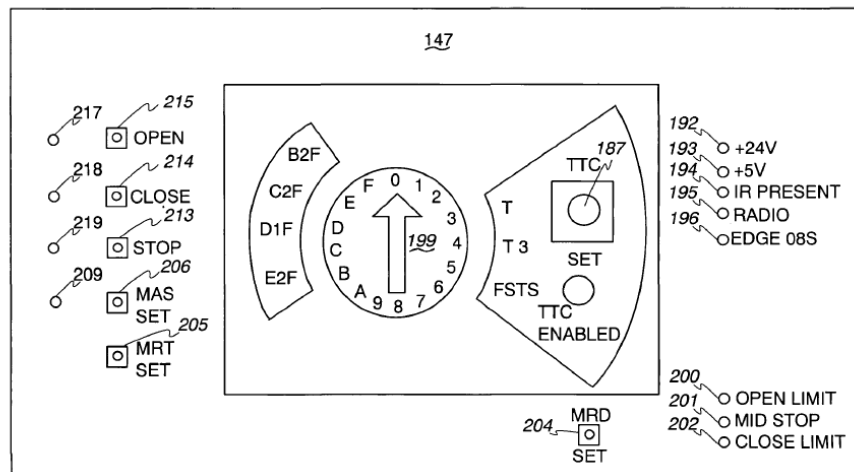
Fig. 3

Figure 3 depicts input/output devices 147 including switches (open switch 215, close switch 214, and stop switch 213) with corresponding LEDs 217, 218, and 219 to "allow maintenance personnel to control the barrier from the head end 102"; "indicator LEDs" to "advise a user of the status of particular controller functions" (24V status 192, 5V status 193, IR present 194, radio present 195, and edge obstruction 196); and LEDs that indicate the "status of the barrier" (LED 200 for the barrier's open limit, LED 201 for the mid-travel limit, and LED 202 for the closed limit).[2] *Id.* at col. 2, ll. 41–60, col. 3, ll. 7–12. Controller 208 monitors the conditions represented by the "status" LEDs and causes the LEDs to be activated as necessary. *Id.* at

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[2] The barrier status LEDs appear to be numbered incorrectly in the Specification of the '611 patent. *See* Ex. 1001, col. 2, ll. 57–60 ("LEDs 197, 198 and 199").

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col. 2, ll. 55–57. Controller 208 also detects errors and stores representations of the errors in memory. *Id.* at col. 3, ll. 23–27.

The '611 patent describes a "diagnostic mode of operation" of controller 208, entered when the user sets switch 199 shown in Figure 3 above to diagnostic position 9. *Id.* at col. 3, ll. 36–38. The diagnostic mode allows the user to access the error codes stored in the memory of controller 208 from wall control 124. *Id.* at col. 3, ll. 38–42, Fig. 4. Specifically, when the user presses open push button 135, controller 208 communicates with wall control 124 to cause LED 137 to "pulse once for each stored error code," allowing the user to determine "the number of error codes" stored in the memory of controller 208. *Id.* at col. 3, ll. 49–54. Similarly, when the user presses close push button 134, controller 208 causes LED 137 to "pulse . . . a number of times corresponding" to each error code stored in its memory in sequence. *Id.* at col. 3, ll. 60–67, Fig. 5 (showing each error code and its corresponding number of LED blinks).

The '611 patent further describes a "learn mode operation" to "guide a user through installation and learn mode actions." *Id.* at col. 4, ll. 13–19, Fig. 6. Controller 208 "determines the user activities or steps needed during the learn process," identifies the beginning status (e.g., open or closed) of the barrier movement operator, and checks to determine whether the user has taken each determined action in sequence. *Id.* at col. 4, ll. 15–42. The '611 patent provides an example of learning "a time value for the max run timer," which is used to "determine whether the movement of the barrier has been going on for too long without reaching the destination limit." *Id.* at col. 4, ll. 43–47. The user presses MRT set button 205 (shown in Figure 3 above), LED 202 flashes to inform the user that the barrier should be moved

to the closed limit, and after the barrier is closed, LED 217 flashes to direct the user to open the barrier by pressing open switch 215. *Id.* at col. 4, ll. 50–63. Controller 208 then "counts the time of travel and adds five seconds to the counted value and stores the result for use" as the max run timer limit. *Id.* at col. 4, l. 66–col. 5, l. 3.

B. Illustrative Claims

Claims 18 and 21 of the '611 patent recite:

18. A method of assisting in the installation and maintenance of a barrier movement operator including a controller, comprising:

activating a learn mode activity of the controller of the barrier movement operator which learning mode requires pre-determined activities by a user;

first identifying by the controller the present status of the barrier movement operator;

second identifying by the controller, the activities to be completed by a user of the barrier movement operator; and

responsive to the first and second identifying steps transmitting guidance signals to an annunciating unit for guidance of the user.

21. A method of controlling a barrier movement operator comprising:

identifying a user interactive mode of operation;

determining the operator statuses and the user actions to complete the interactive mode;

signaling the user to perform a first action in furtherance of the interactive mode operation;

determining that the first action has been correctly performed and signaling the user of a next action in the interactive mode operation.

C. The Prior Art

Petitioner relies on the following prior art:

U.S. Patent No. 4,638,433, issued Jan. 20, 1987 (Ex. 1004, "Schindler"); and

The Chamberlain Group, Inc., OWNER'S MANUAL, MODELS: J + H + HJ, LOGIC CONTROL (VER. 2.0) INDUSTRIAL DUTY DOOR OPERATOR (2000) (Ex. 1009, "LiftMaster").[3]

D. The Asserted Grounds

Petitioner challenges claims 18–25 of the '611 patent on the following grounds:

Reference(s)	Basis	Claims Challenged
Schindler	35 U.S.C. § 102(b)	18–25
Schindler and LiftMaster	35 U.S.C. § 103(a)[4]	23 and 24

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[3] Based on the current record, Petitioner has made a threshold showing that LiftMaster is a prior art printed publication under 35 U.S.C. § 102(b). *See* Pet. 3–4 & n.1; Ex. 1009, 1, 28; *Kyocera Wireless Corp. v. ITC*, 545 F.3d 1340, 1350–51 (Fed. Cir. 2008) (holding that a "reference is publicly accessible 'upon a satisfactory showing that such document has been disseminated or otherwise made available to the extent that persons interested and ordinarily skilled in the subject matter or art exercising reasonable diligence, can locate it'" (citation omitted)).

[4] The Leahy-Smith America Invents Act, Pub. L. No. 112-29, 125 Stat. 284 (2011) ("AIA"), amended 35 U.S.C. §§ 102, 103, and 112. Because the challenged claims of the '611 patent have an effective filing date before the effective date of the applicable AIA amendment, we refer to the pre-AIA versions of 35 U.S.C. §§ 102, 103, and 112.

E. Claim Interpretation

The Board interprets claims in an unexpired patent using the "broadest reasonable construction in light of the specification of the patent in which [they] appear[]." 37 C.F.R. § 42.100(b); *see also Cuozzo Speed Techs., LLC v. Lee*, 136 S. Ct. 2131, 2144–2146 (2016) (upholding the use of the broadest reasonable interpretation standard). The parties provide proposed interpretations for various claim limitations. *See* Pet. 16–25; Prelim. Resp. 4–7. For purposes of this Decision, however, we conclude that only claims 19 and 20 require interpretation.[5]

Petitioner argues that claims 19 and 20 are indefinite under 35 U.S.C. § 112, second paragraph, because they each recite an apparatus in the preamble ("[a] barrier movement operator according to claim 18" and "[a] barrier movement operator according to claim 19," respectively) as well as steps of a method for using the apparatus. Pet. 41–42; *see IPXL Holdings, L.L.C. v. Amazon.com, Inc.*, 430 F.3d 1377, 1384 (Fed. Cir. 2005) (concluding that a claim was indefinite because it "recites both a system and the method for using that system," and thus "does not apprise a person of ordinary skill in the art of its scope").

At this stage of the proceeding, and based on the record currently before us, we are able to determine the scope of claims 19 and 20. Claim 19 depends from method claim 18 and recites two additional method steps: "receiving indications of activities performed by a user during the learn mode" and "annunciating the next activity to the user after the performance

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[5] We preliminarily interpreted various terms in claims 1–8 and 10–14 of the '611 patent in Case IPR2017-00073. *See* -73 Dec. on Inst. 7–19. The interpreted terms do not appear in claims 18–25.

of a prior activity by the user, when the prior activity meets pre-determined parameters." Similarly, claim 20 depends from claim 19 and recites an additional method step: "annunciating incorrect performance to a user when the prior activity does not meet pre-determined parameters." Neither claim recites components of the "barrier movement operator." Indeed, the only component of the "barrier movement operator" recited in the claims is the "controller," which appears in the preamble of method claim 18. Claim 18 clearly recites "[a] method of assisting in the installation and maintenance of a barrier movement operator including a controller." Various steps of the method refer to "the" barrier movement operator and "the" controller recited in the preamble, but, like claims 19 and 20, there are no separately recited components of an apparatus. Reading the claims in context, we are persuaded that a person of ordinary skill in the art would understand claims 19 and 20 to each recite a method, rather than an apparatus.

II. DISCUSSION

A. Anticipation Ground Based on Schindler
(Claims 18–25)

Petitioner contends that claims 18–25 are anticipated by Schindler[6] under 35 U.S.C. § 102(b), citing the testimony of Stuart Lipoff (Ex. 1003) and Nikolaus Baer (Ex. 1006) as support. Pet. 25–69. We are persuaded that Petitioner has established a reasonable likelihood of prevailing on its asserted ground for the reasons explained below.

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[6] Schindler was not considered during prosecution of the '611 patent. *See* Ex. 1001; Pet. 3–4. Schindler is assigned to Patent Owner.

1. *Schindler*

Schindler discloses a "microprocessor controlled garage door operator which eliminates lower and upper limit switches on the garage door in that the upper and lower limits are set in a program mode of the microprocessor with up and down control switches by the operator." Ex. 1004, Abstract. Figure 1 of Schindler is reproduced below.
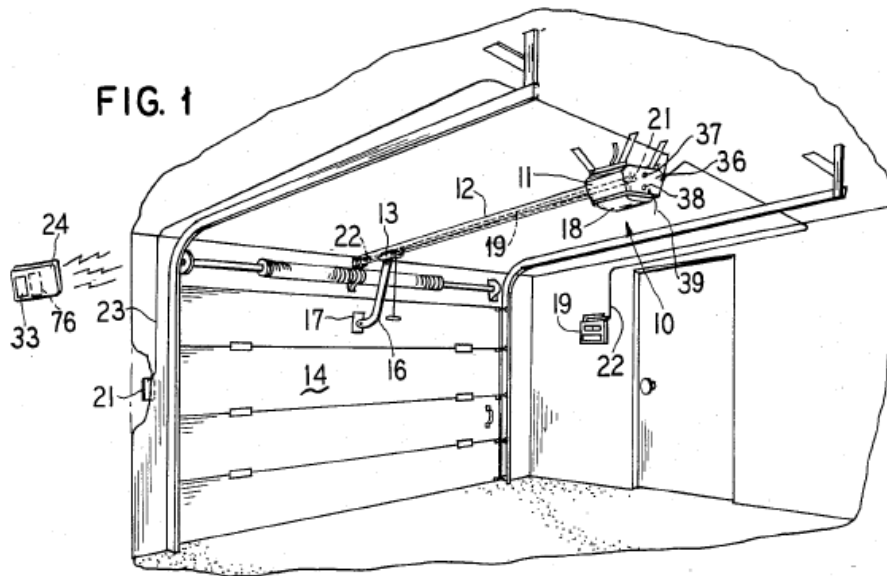

Figure 1 depicts garage door operator 10, which includes head unit 11 with a motor for moving garage door 14, and control unit 19 "mounted on the inside wall of the garage and . . . connected by an electrical cable 22 to the microprocessor mounted in the head unit" of garage door operator 10. *Id.* at col. 2, ll. 53–66. Figure 1B of Schindler is reproduced below.
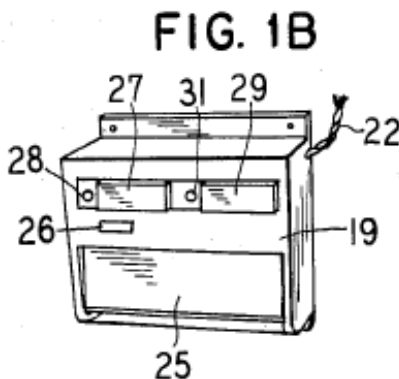
Figure 1B depicts control unit 19, which includes control push button 25
"for operating the door up and down"; control indicator light 26 that
"indicates when the garage door operator is being actuated"; vacation/down
switch 27 and corresponding indicator 28; and work light/up switch 29 and
corresponding indicator 31. *Id.* at col. 3, ll. 7–15. The control unit is
connected to a microprocessor, which is used to control various functions of
the garage door operator. *Id.* at col. 1, ll. 45–47, col. 4, ll. 22–39, Fig. 4B
(microprocessor 101).

A user can put the control unit and microprocessor into a "program
mode" or "operate mode" using program/operate mode button 38 on head
unit 11. *Id.* at col. 3, ll. 24–27, col. 6, ll. 62–65, col. 24, ll. 1–3. The
program mode allows the user to set the upper and lower limits of the garage
door using switches 27 and 29 on control unit 19. *Id.* at col. 11, l. 30–col.
13, l. 58. Schindler discloses that

> [t]he control unit and microprocessor may be put into a
> program mode in which condition the door may be moved
> downwardly with a down switch mounted on the control unit to
> the desired down position of the door and this position will be
> automatically set into the microprocessor memory. Then the
> door may be moved to the full up position with [an] up switch
> which will set the up limit of the garage door in the
> microprocessor memory.
>
> After the up and down limits have been set, the unit is
> placed out of the program mode and into the operate mode and
> the garage door is operated through a complete cycle which will
> automatically set the up and down force limits for the door.
> Subsequently, the door may be operated up and down with the
> up and down set limits and with the set force.

Id. at col. 1, ll. 47–62. The microprocessor communicates with the control
unit to "flash the proper LED [on the control unit] to indicate which limit is

being programmed. The work light LED indicates the up limit and the vacation LED indicates the down limit." *Id.* at col. 12, ll. 59–67, col. 24, ll. 1-8. Finally, Schindler includes a lengthy program of "SOFTWARE FOR MICROPROCESSOR" written in assembly code. *Id.* at col. 24, l. 60–col. 142, l. 30.

2. Level of Ordinary Skill in the Art

> 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."

KSR Int'l Co. v. Teleflex Inc., 550 U.S. 398, 406 (2007) (quoting 35 U.S.C. § 103(a)). Petitioner argues that a person of ordinary skill in the art at the time of the '611 patent would have had "at least an undergraduate degree in electrical or computer engineering, or equivalent education, and two years of work experience in the fields of access control or automated door control systems, or equivalent work experience or training in the field of such technologies." Pet. 16 (citing Ex. 1003 ¶ 29). Patent Owner does not propose a different level of ordinary skill in the art in its Preliminary Response. Based on the current record, including our review of the '611 patent and the types of problems and solutions described in the '611 patent and cited prior art, we agree with Petitioner's assessment of the level of ordinary skill in the art and apply it for purposes of this Decision.

3. Claim 18

Petitioner asserts that Schindler discloses all of the limitations of independent claim 18. Pet. 8–16, 25–41. For example, Petitioner argues that Schindler discloses a method of assisting in the installation and maintenance of a "barrier movement operator" (i.e., garage door operator 10) including a "controller" (i.e., microprocessor 101), comprising activating a "learn mode activity" (i.e., activating the program mode for learning the upper and lower limits of the garage door when the user presses program/operate mode button 38), identifying the "present status" of the barrier movement operator (i.e., "the position [e.g., up or down] in which the barrier movement operator is holding the barrier"), identifying "activities to be completed by a user of the barrier movement operator" (i.e., setting the up and down travel limit positions), and transmitting guidance signals to an "annunciating unit" (i.e., control unit 19) for guidance of the user. *Id.* at 26–41. With respect to the "activating" and two "identifying" steps of claim 18, Petitioner relies on portions of Schindler's assembly source code, as well as the testimony of Mr. Baer, who "analyzed the assembly source code relating to [the] routines" for Schindler's limit-setting process. *Id.* at 10–16, 28–38 (citing Ex. 1006).

Mr. Baer provides the following process flow chart on page 7 of his declaration.
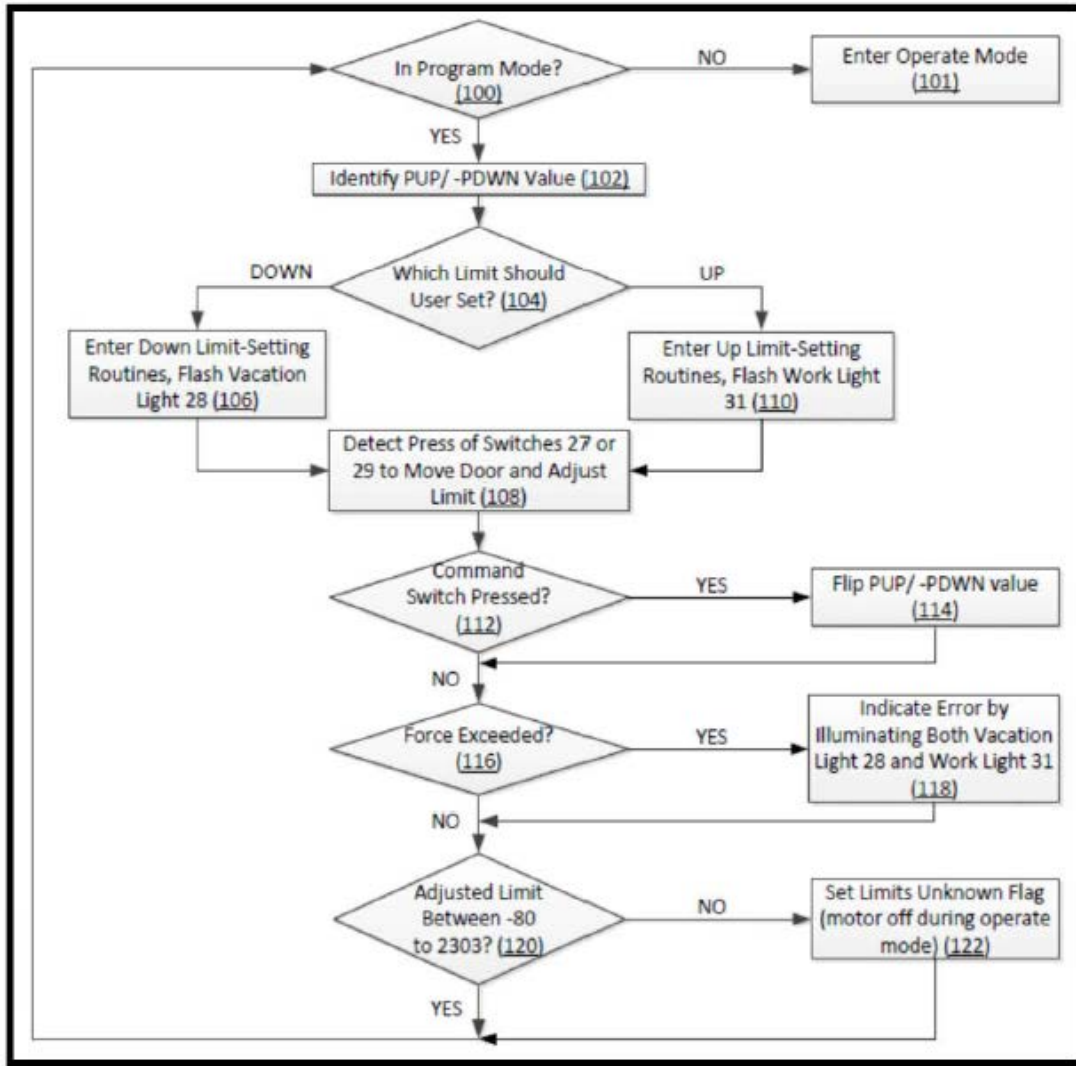
The chart "illustrate[s] how the assembly source code in Schindler is executed to allow a user to set door travel limit positions" according to Mr. Baer. Ex. 1006 ¶ 14; *see* Pet. 11.

Petitioner contends that the microprocessor in Schindler "activat[es] a learn mode activity" in step 100 above when the program checks to see whether the program mode has been activated (i.e., whether program/operate mode button 38 was moved to the program position). Pet. 30–31 (citing

Ex. 1006 ¶¶ 15–17). Petitioner further argues that the microprocessor "identif[ies] . . . the present status of the barrier movement operator" in step 102 when the program checks the "PUP/-PDWN" flag, which indicates the last direction of door travel and, correspondingly, the current position of the door. *Id.* at 31–35 (citing Ex. 1006 ¶¶ 19–22); *see* Ex. 1004, col. 22, ll. 7–9 (stating that the "PUP/-PDWN" flag "[r]emembers [the] direction of door travel"). Finally, Petitioner contends that the microprocessor "identif[ies] . . . activities to be completed by a user of the barrier movement operator" in steps 104, 106, and 110 when the program determines whether the user must perform the activities of setting the up or down limit positions and enters the corresponding routine for the activities. Pet. 35–38 (citing Ex. 1006 ¶¶ 19–20, 23–27). Upon review of Petitioner's analysis and the supporting testimony of Mr. Lipoff and Mr. Baer, we are persuaded that Petitioner has demonstrated a reasonable likelihood of prevailing as to claim 18.

Patent Owner argues that Petitioner's asserted ground is "legally deficient" because Petitioner relies on the declaration of Mr. Baer, who testifies from the perspective of a software expert, not a person of ordinary skill in the art. Prelim. Resp. 7–16 (citing *Life Techs., Inc. v. Clontech Labs., Inc.*, 224 F.3d 1320, 1325 (Fed. Cir. 2000) ("patentability is assessed from the perspective of the hypothetical person of ordinary skill in the art")). Patent Owner points out that a person of ordinary skill in the art, according to Petitioner and Mr. Lipoff, would have had "at least . . . one to two years of work experience in the fields of access control or automated door control systems, or equivalent work experience or training in the field of such technologies," but Mr. Baer has no such work experience. *Id.* at 14–15 (quoting Pet. 16; Ex. 1003 ¶ 29) (emphasis omitted). Patent Owner also

points to portions of Mr. Baer's declaration where he states that "[i]n
forming *my opinions*, I have reviewed the entire Schindler reference in
detail," and "[t]o help inform *my understanding* of how certain instructions
operate in Schindler's assembly source code, I also reviewed an Intel User's
Manual." *Id.* at 13 (quoting Ex. 1006 ¶¶ 9, 11). According to Patent Owner,
Mr. Baer "fails to take into account what would have been understood by a
[person of ordinary skill in the art] at the time of invention" because he lacks
the requisite experience and testifies "from his own perspective as a software
expert," not a person of ordinary skill in the art. *Id.* at 11, 15–16.

Patent Owner's arguments are not persuasive based on the current
record for two reasons. First, as explained above, we agree with Petitioner
on this record that a person of ordinary skill in the art would have had at
least (1) an undergraduate degree in electrical or computer engineering, or
equivalent education, and (2) two years of work experience in the fields of
access control or automated door control systems, or equivalent work
experience or training in the field of such technologies. *See supra* Section
II.A.2. Although Mr. Baer does not have the latter work experience, he does
have an undergraduate degree in computer engineering and has worked on
projects involving "analyzing and writing assembly source code," including
projects involving "writing assembly source code for microprocessors that
(i) instruct and manage a motor controller and (ii) control timing and
intensity of LEDs in marine research equipment." Ex. 1006 ¶¶ 5–6. Thus,
his background is related to the technology of the '611 patent and Schindler,
albeit in a context other than access control or automated door control
systems. *See, e.g.*, Ex. 1001, col. 1, ll. 64–66, col. 2, ll. 55–60, col. 4,
l. 13–col. 5, l. 3 (describing controller 208 with a "programmed

microprocessor" and how controller 208 lights various LEDs to guide the user), claims 18–25 (reciting a "controller," "annunciating unit" for guiding the user, and "signaling the user"); Ex. 1004, col. 3, l. 7–col. 4, l. 10, col. 12, l. 47–col. 13, l. 58 (describing programmed control unit 19 and how it lights various LEDs to guide the user). We are not persuaded, at this preliminary stage, that Mr. Baer's testimony should be disregarded because of his specific lack of work experience with access control or automated door control systems.

Second, Petitioner's asserted ground is not based solely on Mr. Baer's testimony. Rather, throughout its analysis, Petitioner cites to portions of Schindler's written description apart from the assembly source code, as well as the testimony of Mr. Lipoff. *See* Pet. 25–69 (citing Ex. 1003). Mr. Lipoff testifies that he has "reviewed [Mr. Baer's] analysis," and "[b]ased on [his] review, it is [his] opinion that Mr. Baer's analysis confirms that the limit-setting process of Schindler involves the [steps shown in the process flow chart above]."[7] Ex. 1003 ¶ 44. We have reviewed Petitioner's arguments that Schindler discloses every limitation of claim 18, which are supported by citations to the language of the reference itself and the testimony of both declarants, and conclude that they are sufficient on this record to establish a reasonable likelihood of prevailing on the asserted ground. *See Corning Glass Works v. Sumitomo Elec. U.S.A., Inc.*, 868 F.2d 1251, 1255–56 (Fed. Cir. 1989) ("Anticipation requires that every limitation

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[7] We recognize, as Patent Owner points out, that the process flow chart is not part of Schindler itself. *See* Prelim. Resp. 12–13. Rather, it is a visual depiction of how the assembly source code functions according to Mr. Baer. *See* Ex. 1006 ¶ 14. For each step in the chart, Mr. Baer cites and explains the relevant portion of Schindler's assembly source code. *See id.* ¶¶ 15–52.

of the claim in issue be disclosed, either expressly or under principles of inherency, in a single prior art reference."). Patent Owner will have the opportunity to cross-examine both Mr. Lipoff and Mr. Baer and explore the bases for their opinions as well as Mr. Lipoff's reliance on Mr. Baer's analysis. The ultimate assessment of Petitioner's asserted ground will be based on the complete record at the end of trial.

Based on the current record, Petitioner has demonstrated a reasonable likelihood of prevailing on its assertion that claim 18 is anticipated by Schindler.

4. Claim 21

Claim 21 recites similar limitations to claim 18. Petitioner asserts that Schindler discloses all of the limitations of claim 21, again relying on the testimony of Mr. Lipoff and Mr. Baer, and relying in part on its previous analysis for claim 18. Pet. 57–62. For example, claim 18 recites "activating a learn mode activity of the controller of the barrier movement operator which learning mode requires pre-determined activities by a user," and claim 21 recites "identifying a user interactive mode of operation." For the limitation in claim 21, Petitioner cites its previous analysis for the claim 18 "learn mode activity" limitation and Mr. Lipoff's testimony, and argues that "Schindler teaches such a mode by disclosing the program mode that allows a user to set door travel limits, and teaches that, while in the program mode, the microprocessor cooperates with a user to learn operating parameters (*i.e.*, up and down door travel limits)." *Id.* at 58 (citing Ex. 1003 ¶¶ 133–134).

Patent Owner argues that Petitioner improperly equates claim 18's "learn mode" with claim 21's "user interactive mode," and fails to explain

how Schindler discloses "identifying" a user interactive mode of operation, as recited in claim 21. Prelim. Resp. 16–19. We are not persuaded by Patent Owner's arguments based on the current record. Petitioner points to Schindler's disclosure of a "program mode" where "the microprocessor cooperates with a user to learn operating parameters (*i.e.*, up and down door travel limits)," and the specific determinations made by Schindler's program of whether the program mode has been activated (by the user pressing program/operate mode button 38 to move out of the operate mode and into the program mode) and which limit-setting routine should be performed (up or down). Pet. 9, 12–13 (steps 100 and 104), 28–31, 58; *see* Ex. 1004, col. 3, ll. 24–27 ("One surface 36 of the head unit 11 has a door condition indicator light 37 and a program/operate mode button 38 to allow the garage door operator to be set in the operate or . . . program mode."), col. 24, ll. 1–3 ("After the garage door opener has been installed, it is placed in the program mode by moving the switch 38 to the program position."). We are persuaded that Petitioner has made a sufficient showing that Schindler's program "identif[ies]" a user interactive mode of operation, as recited in claim 21.[8] Based on the current record, Petitioner has demonstrated a reasonable likelihood of prevailing on its assertion that claim 21 is anticipated by Schindler.

5. Claims 19, 20, and 22–25

Petitioner asserts that Schindler discloses all of the limitations of dependent claims 19, 20, and 22–25. Pet. 43–57, 62–69. Patent Owner does

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[8] The parties are encouraged to address the interpretation of the claim term "identifying" in their papers during trial.

not make any additional arguments in its Preliminary Response regarding these claims.[9] Having reviewed Petitioner's arguments and supporting testimony, we conclude that Petitioner has established a reasonable likelihood of prevailing on its assertion that claims 19, 20, and 22–25 are anticipated by Schindler as well.

B. Obviousness Ground Based on Schindler and LiftMaster (Claims 23 and 24)

Petitioner contends that claims 23 and 24 are unpatentable over Schindler and LiftMaster[10] under 35 U.S.C. § 103(a). Pet. 69–77. We are persuaded that Petitioner has established a reasonable likelihood of prevailing on its asserted ground for the reasons explained below.

1. LiftMaster

LiftMaster is an owner's manual for an "Industrial Duty Door Operator" marketed by Patent Owner. Ex. 1009, 1, 19, 28; *see* Pet. 4. The operator has a "Logic Control board" with "Open, Close and Stop buttons" that "provide easy programming ability and door control at the electrical box." Ex. 1009, 14. LiftMaster discloses:

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[9] Petitioner argues that claims 19 and 20 are indefinite under 35 U.S.C. § 112, second paragraph, but also explains why they are anticipated by Schindler if they are not indefinite. Pet. 41–57. Patent Owner responds that Petitioner's indefiniteness arguments are improper, and "the Board should evaluate Petitioner's anticipation arguments on claims 19 and 20." Prelim. Resp. 32–33. We have done so, and conclude that Petitioner has established a reasonable likelihood of prevailing on its anticipation ground as to claims 19 and 20.

[10] LiftMaster was not considered during prosecution of the '611 patent. *See* Ex. 1001; Pet. 3–4.

Programmable Maximum Run Timer:

Any time a "closing" or "opening" door takes 10 seconds longer than its programmed normal cycle time, the door will stop. The factory default for maximum run time is 90 seconds.

Setting Maximum Run Timer:

Start with the door in the fully closed position. Set DIP switches to "set max run timer" mode. Press the open button. Allow the door to run to the open limit. Once the door has stopped, set DIP switches to the desired operating mode (B2, C2, D1, E2, T, TS, FSTS). The maximum run time is now set to the door's travel time + 10 seconds.

Id.

2. Analysis

Petitioner relies on Schindler as teaching the limitations of parent claim 21, and relies on LiftMaster as teaching the limitations of claims 23 and 24. Pet. 69–77. For example, with respect to the added limitation of claim 23 of "determining that the status of the barrier movement operator is correct before signaling that a first action is to be performed by the user," Petitioner points to LiftMaster's instruction that the user should "[s]tart with the door in the fully closed position" when setting the maximum run timer. *Id.* at 69–70, 73–74 (quoting Ex. 1009, 14). Petitioner argues that a person of ordinary skill in the art

> would have understood that, in order to properly set LiftMaster's maximum run timer, the door is required to start in the fully closed position. In other words, based on the instructions in LiftMaster, a user must look at the door to establish whether it is in the correct position of being fully down/closed. If the door is not in the fully closed position, a [person of ordinary skill in the art] would have understood that

a user is required to take corrective action by moving the door
into the fully closed position.

Id. at 70 (citations omitted). According to Petitioner, "the user is necessarily
required to check whether the door is fully closed (*i.e.*, status is correct) or
the door is open (*i.e.*, status is incorrect) in order to proceed with the
instruction to '[s]tart with the door in the fully closed position.'" *Id.*

Petitioner contends that a person of ordinary skill in the art would
have had reason to incorporate this teaching from LiftMaster into
Schindler's system. *Id.* at 71–75 (citing Ex. 1003 ¶¶ 160–163, 166–167).
Among other reasons, Petitioner asserts that an ordinarily skilled artisan
would have looked to garage door opener owner's manuals of the time for
guidance on how to instruct a user during installation, would have
understood that Schindler's system could be "improved" by establishing
whether the barrier movement operator's status is correct and instructing the
user accordingly prior to performing a programming activity, and would
have recognized that requiring the door to be in a certain position would be
"simpler for users as they must follow a predefined series of programming
steps from a start position to an end position of the door." *Id.* at 71–72.
Upon review of Petitioner's analysis and the supporting testimony of
Mr. Lipoff, we are persuaded that Petitioner has demonstrated a reasonable
likelihood of prevailing as to claims 23 and 24.

Patent Owner makes two arguments against institution on this
obviousness ground. First, Patent Owner argues that Petitioner "fails to
sufficiently explain the differences between the claimed invention and the
prior art, as required under the second step" of *Graham v. John Deere Co.*,
383 U.S. 1, 17–18 (1966). Prelim. Resp. 19–26. Patent Owner points to
Petitioner's assertions that "[t]o the extent that Schindler does not already

disclose" the additional limitations of claims 23 and 24, they are taught by LiftMaster. *Id.* at 22–23 (quoting Pet. 73, 76) (emphasis omitted). Patent Owner further contends that Petitioner's anticipation arguments for claims 23 and 24, which pertain to actions performed by Schindler's microprocessor, contradict its obviousness arguments regarding claims 23 and 24, which pertain to actions performed by the user of the LiftMaster device. *Id.* at 23–25 (citing Pet. 66–67, 70). According to Patent Owner, Petitioner's assertions are "ambiguous and contradictory," requiring Patent Owner and the Board to speculate as to exactly how Petitioner is asserting unpatentability based on the two references. *Id.* at 23–26.

Patent Owner's arguments are not persuasive on this record. Although Petitioner also asserts in its anticipation ground that Schindler discloses the limitations of claims 23 and 24, Petitioner explains in its obviousness ground the particular teachings of LiftMaster being relied upon and how they would be incorporated into Schindler's process. *See* Pet. 69–77. For example, with respect to claim 23, Petitioner argues that a person of ordinary skill in the art would have been motivated to include in Schindler's process a step of determining whether the barrier movement operator's status is correct and instructing the user accordingly before performing a programming activity. *Id.* at 71–72. As to how that combination would be achieved, Petitioner asserts that

> after Schindler's process establishes the operational state of the barrier movement operator (*i.e.*, determines whether the door is up or down), the process then executes the step disclosed in LiftMaster of determining whether the state is correct (*i.e.*, the door is in the fully closed position) for performing a particular programming activity and only proceeding with further steps if the state is correct. As such, Schindler's process would only

> illuminate the LEDs on the wall unit to signal a user to perform subsequent activities if the state is correct for performing these activities (in this case starting with opening the door to program the up limit first).

Id. at 74 (citing Ex. 1003 ¶ 166). Thus, we are able to determine the particular combination of teachings on which Petitioner's challenge is based. For similar reasons, on this record we do not view the Petition as making contradictory arguments. The fact that Petitioner's theory as to how the limitations of claims 23 and 24 allegedly are disclosed by Schindler differs from its theory as to how they allegedly are taught by the combination of Schindler and LiftMaster does not, by itself, indicate that the latter is incorrect. Petitioner's explanation is sufficient at this stage of the proceeding.

Second, Patent Owner argues that Petitioner has not provided sufficient reasoning for why a person of ordinary skill in the art would have combined the teachings of Schindler and LiftMaster. Prelim. Resp. 27–32. Patent Owner asserts that the alleged similarities between the systems of Schindler and LiftMaster cited by Petitioner (e.g., same field of endeavor, addressing the same problem, both references belonging to Patent Owner) are insufficient to demonstrate a reason to combine. *Id.* at 28, 30–32. As explained above, however, Petitioner provides additional bases for the combination beyond the references' similarities, which we find persuasive on this record. *See* Pet. 71–77.

Patent Owner further argues that because Petitioner alleges in its anticipation ground that Schindler already discloses the limitations of claims 23 and 24, a person of ordinary skill in the art in fact would have been discouraged from modifying Schindler's system. Prelim. Resp. 28–30.

According to Patent Owner, an ordinarily skilled artisan would not have "modified Schindler according to the teachings of other references, if those teachings address a problem that Schindler already solves." *Id.* at 28. We are not persuaded based on the current record, as Petitioner explains that a person of ordinary skill in the art would have viewed the combination as an "improve[ment]" to Schindler's process that would make the programming process "simpler for users" to follow. *See* Pet. 71–72 (citing Ex. 1003 ¶ 161). On this record, we do not see why the fact that both references are directed to guiding the user through programming various settings of the barrier movement operator means that a person of ordinary skill in the art, considering Schindler, would have been discouraged from considering references disclosing functionality that would have improved or simplified Schindler's process. Again, the ultimate assessment of Petitioner's arguments will be made at the conclusion of trial.

Based on the current record, Petitioner has demonstrated a reasonable likelihood of prevailing on its assertion that claims 23 and 24 are unpatentable over Schindler and LiftMaster.

C. Conclusion

We conclude that Petitioner has demonstrated a reasonable likelihood of prevailing with respect to at least one claim of the '611 patent challenged in the Petition. The Board, however, has not made a final determination under 35 U.S.C. § 318(a) with respect to the patentability of the challenged claims.

III. ORDER

In consideration of the foregoing, it is hereby:

ORDERED that an *inter partes* review is instituted as to claims 18–25 of the '611 patent;

FURTHER ORDERED that pursuant to 35 U.S.C. § 314(a), *inter partes* review of the '611 patent is hereby instituted commencing on the entry date of this Decision, and pursuant to 35 U.S.C. § 314(c) and 37 C.F.R. § 42.4, notice is hereby given of the institution of a trial; and

FURTHER ORDERED that the trial is limited to the following grounds of unpatentability, and no other grounds set forth in the Petition as to claims 18–25 of the '611 patent are authorized:

Claims 18–25 under 35 U.S.C. § 102(b) as anticipated by Schindler; and

Claims 23 and 24 under 35 U.S.C. § 103(a) as unpatentable over Schindler and LiftMaster.

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