

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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THE CHAMBERLAIN GROUP, LLC.  
Petitioner,

v.

OVERHEAD DOOR CORPORATION,  
Patent Owner.

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IPR2022-00842  
Patent 9,869,120 B2

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Before KALYAN K. DESHPANDE, *Vice Chief Administrative Patent Judge*, HUBERT C. LORIN, and THOMAS L. GIANNETTI,  
*Administrative Patent Judges*.

LORIN, *Administrative Patent Judge*.

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

## I. INTRODUCTION

### *A. Background*

The Chamberlain Group LLC (“Petitioner”) filed a Petition (Paper 2, “Pet.”) requesting *inter partes* review of claims 1–6, 8, 10, 11, 13–15, and 17 of U.S. Patent No. 9,869,120 B2 (Ex. 1001, “the ’120 patent”). Overhead Door Corp. (“Patent Owner”) filed a Preliminary Response (Paper 6, “Prelim. Resp.”).

We have jurisdiction under 35 U.S.C. § 6.

Upon consideration of the arguments and evidence presented by Petitioner, we are unpersuaded that Petitioner has demonstrated, under 35 U.S.C. § 314(a), a reasonable likelihood that it would prevail in showing the unpatentability of at least one challenged claim.

For the reasons stated below, we do not institute *inter partes* review as to challenged claims 1–6, 8, 10, 11, 13–15, and 17 of the ’120 patent.

### *B. Related Proceedings*

Petitioner indicates, and Patent Owner agrees, that the ’120 patent is the subject of civil actions in *The Chamberlain Group Inc v. Overhead Door Corporation et al.*, Case 2-22-cv-00044 (E.D. Tex.), and *Overhead Door Corporation v. The Chamberlain Group LLC*, Case 2-22-cv-00065 (E.D. Tex.). Pet. 69; Paper 5, 2.

### *C. The ’120 patent (Ex. 1001)*

#### *1. Disclosure*

The ’120 patent, titled “Programming of Paired Authorization Codes in Wireless Transmitter and Barrier Operator Prior to Use by End User,” relates to the pairing of wireless transmitters with the barrier operator of a barrier opening system. Ex. 1001, code (54), 1:19–21.

The '120 patent explains that:

the typical approach for programming the authorization codes in the door operator is for the end user or installer of the door operator, prior to its operation, to place its microcontroller into the “learn” mode, and then actuate a wireless transmitter in which the authorization code has been stored, to transmit the identical code for storage within the door operator's memory, thus establishing the desired pairing between that transmitter and the door operator.

*Id.* at 2:4-12. The patent seeks to provide an improved “method of pairing authorized wireless transmitters with their designated door operator, [] without user inconvenience or confusion.” *Id.* at 2:26-29. Figure 1, reproduced below, shows a diagram of a typical garage door opening system, which the patent seeks to improve.

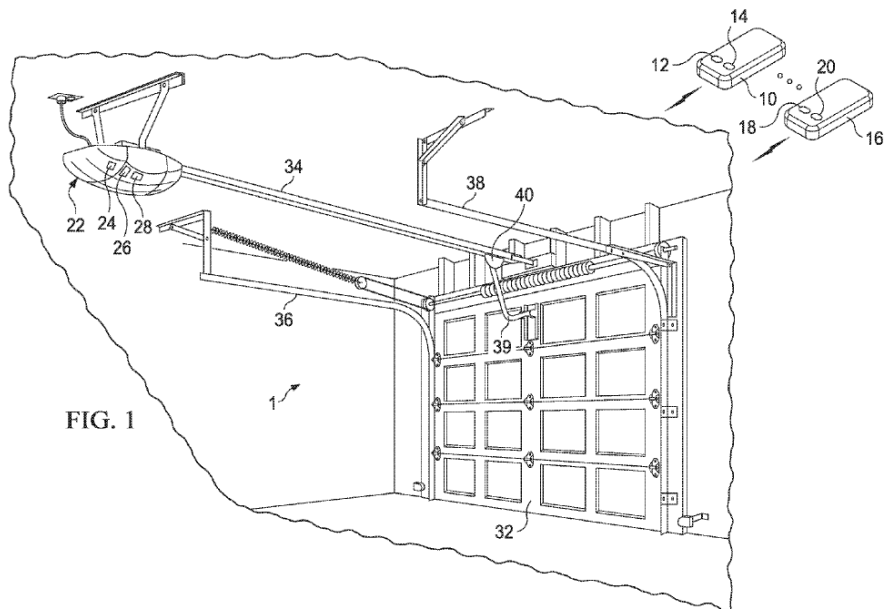


Figure 1 shows power head unit 22, which operates the garage door, and wireless RF transmitters 10 and 16. *Id.* at 3:53-61.

The '120 patent describes that wireless RF transmitters 10 and 16 transmit codes to the head unit, where the authorization codes that are resident in the transmitters 10 and 16 must be identical to the corresponding

codes that are resident in the garage door operator power head unit 22. *Id.* at 4:52-56. The patent proposes that “the required pairing is carried out prior to the delivery of the garage door operator to the user, and specifically at the factory.” *Id.* at 5:1-4.

The patent describes a manufacturing facility where “transmitter 402 [equivalent to transmitters 10 and 16] sequentially proceeds through three different stations along production path 450 in environment 452. At the first station, transmitter 402 has its authorization code pre-programmed into its memory.” *Id.* at 5:17-21. Information representing the authorization code is transmitted from the transmitter, printed for labeling, and stored in database 434. *Id.* at 5:27-51. Then, “each authorization code(s) is then retrieved from database 434 by way of network 430, routed to transmitter 442, and at a next stage, the transmitter 442 is actuated to transmit each authorization code (i.e., the unique transmitter identification code and the function code) to the power head unit 408 [equivalent to power head unit 22], for storage in the power head unit's memory.” *Id.* at 6:10-17.

*2. Claims 1-6, 8, 10, 11, 13-15, and 17*

Petitioner challenges claims 1-6, 8, 10, 11, 13-15, and 17. Pet. 1. Claims 1 and 10 are independent claims. Claim 1 is reproduced below, with Petitioner's annotations.

1. [1.0] A method comprising:
  - [1.1] manufacturing a barrier opening system comprising a barrier operator, and at least one wireless transmitter for wirelessly transmitting commands to the barrier operator;
  - [1.2] prior to delivery of the barrier opening system to an end user, programming an authorization code into the at least one wireless transmitter;

- [1.3] prior to delivery of the barrier opening system to the end user, placing the barrier operator into a learn mode;
- [1.4] prior to delivery of the barrier opening system to the end user, transmitting the authorization code to the barrier operator while the barrier operator is in the learn mode using a transmitter external to the barrier opening system;
- [1.5] prior to delivery of the barrier opening system to the end user, causing the barrier operator to exit the learn mode; and
- [1.6] prior to delivery of the barrier opening system to the end user, packaging the barrier operator together with at least one wireless transmitter.

Ex. 1001, 1:4-24; Pet. v.

*D. Asserted References*

Petitioner relies on the following references:

<b>Name<sup>1</sup></b>	<b>Reference</b>	<b>Ex. No.</b>
Sommer	U.S. Patent Application Publication No. US 2006/0176148 A1, published Aug. 10, 2006	1004
Fitzgibbon	U.S. Patent No. US 5,751,224, issued May 12, 1998	1005
Marchetto	U.S. Patent Application Publication No. US 2009/0251280 A1, published Oct. 8, 2009	1007
Romine	U.S. Patent No. US 8,639,240 B2, issued Jan. 28, 2014	1012
Thomas	U.S. Patent No. US 8,042,140 B2, issued Oct. 18, 2011	1013

Petitioner also relies on the Declaration of Nathan J. Davis IV, Ph.D. (Ex. 1003, “Davis Declaration”) and the prosecution file for the ’120 patent (Ex. 1002) as support for the various contentions.

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<sup>1</sup> We refer to publications only by the first named inventor.

*E. Asserted Grounds*

Petitioner contends that claims 1–6, 8, 10, 11, 13–15, and 17 of the '120 patent are unpatentable under the following grounds:

<b>Ground</b>	<b>Claims Challenged</b>	<b>35 U.S.C. §</b>	<b>Reference(s)/Basis</b>
1A	1, 4, 10, 11, 13	103 <sup>2</sup>	Sommer, Marchetto
1B	5, 6, 8, 14, 15, 17	103	Sommer, Marchetto, Thomas
2A	1–4, 10, 11, 13	103	Fitzgibbon, Romine
2B	5, 6, 8, 14, 15, 17	103	Fitzgibbon, Romine, Thomas

Pet. 2.

## II. ANALYSIS

### *A. Principles of Law for Patentability*

A patent claim is unpatentable under 35 U.S.C. § 103(a) if the differences between the claimed subject matter 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). The question of obviousness is resolved on the basis of

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<sup>2</sup> The Leahy-Smith America Invents Act, Pub. L. No. 112-29, 125 Stat. 284 (2011) (“AIA”), amended 35 U.S.C. §§ 102 and 103. Because the challenged claims of the '120 patent have an effective filing date after the effective date of the applicable AIA amendments, we refer to the AIA versions of 35 U.S.C. § 103 throughout this Decision.

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 ordinary skill in the art; and (4) when in evidence, objective evidence of nonobviousness. *Graham v. John Deere Co.*, 383 U.S. 1, 17–18 (1966).

“In an [*inter partes* review], the petitioner has the burden from the onset to show with particularity why the patent it challenges is unpatentable.” *Harmonic*, 815 F.3d at 1363 (citing 35 U.S.C. § 312(a)(3) (requiring *inter partes* review petitions to identify “with particularity . . . the evidence that supports the grounds for the challenge to each claim”). This burden of persuasion never shifts to Patent Owner. *See Dynamic Drinkware, LLC v. Nat’l Graphics, Inc.*, 800 F.3d 1375, 1378 (Fed. Cir. 2015) (discussing the burden of proof in *inter partes* review).

#### *B. Level of Ordinary Skill in the Art*

Petitioner contends a person of ordinary skill in the art at the time of the ’120 patent

would have had a Bachelor of Science degree in an academic discipline emphasizing the design of electrical, computer, or software technologies, in combination with training or at least one to two years of related 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. 4 (citing Ex. 1003 ¶ 31). Patent Owner does not address the level of skill of the ordinary artisan. *See, generally*, Prelim. Resp.

Petitioner’s proposed definition of a person of ordinary skill in the art appears reasonable, and we adopt that definition for our analysis in this decision.

Moreover, we see no reason why the level of ordinary skill in the art is not adequately reflected by the prior art of record. *See Okajima v. Bourdeau*, 261 F.3d 1350, 1355 (Fed. Cir. 2001); *In re GPAC Inc.*, 57 F.3d 1573, 1579 (Fed. Cir. 1995); *In re Oelrich*, 579 F.2d 86, 91 (CCPA 1978).

### C. Claim Construction

For petitions filed on or after November 13, 2018, “[claims] of a patent . . . shall be construed using the same claim construction standard that would be used to construe the [claims] in a civil action under 35 U.S.C. § 282(b), including construing the [claims] in accordance with the ordinary and customary meaning of such claims as understood by one of ordinary skill in the art and the prosecution history pertaining to the patent.”

37 C.F.R. § 42.100 (2019); *see also Phillips v. AWH Corp.*, 415 F.3d 1303, 1312–14 (Fed. Cir. 2005).

Petitioner does not submit constructions for any claim terms. Pet. 4. Patent Owner contends no claim construction is necessary. Prelim. Resp. 6.

Only those terms that are in controversy need to be construed, and only to the extent necessary to resolve the controversy. *Vivid Techs., Inc. v. Am. Sci. & Eng’g, Inc.*, 200 F.3d 795, 803 (Fed. Cir. 1999). To the extent the meaning of any term requires discussion, however, we provide it in our analysis of the patentability challenges.

### D. Overview of the Prior Art References

#### 1. Sommer (Ex. 1004)

Sommer is titled “Closing System and Method for Operating the Same,” and relates to a closing system comprising “a transmitter/receiver unit for the remote operation of a garage door by means of at least one transmitter and one receiver.” Ex. 1004, code (54), ¶ 2.



Fig. 1, reproduced below, depicts Sommer's system for opening/closing garage door 1 using transmitter 3 that interacts with receiver 4.

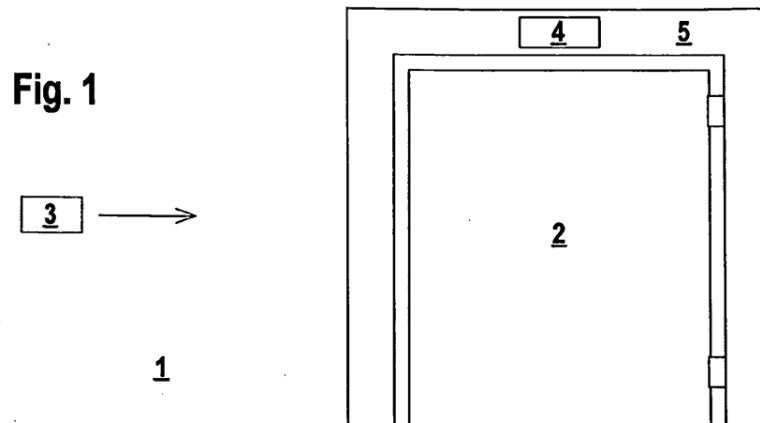


Fig. 1 shows closing system 1 comprising door 2, transmitter 3, receiver 4, and frame 5 into which receiver 4 is integrated. *See id.* 28.

The design of receiver 4 is depicted in Fig. 3, reproduced below.

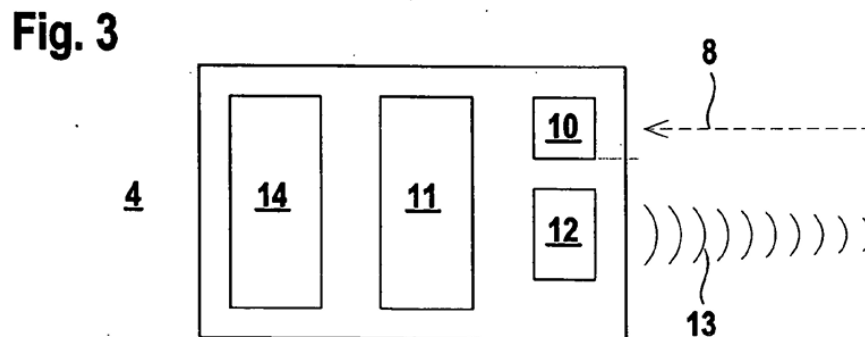


Fig. 3 shows receiver 4, radio receiving module 10 for receiving radio signal 8 from transmitter 3, computer unit 11, acoustic signal transmitter 12 which emits acoustic signal 13 in response to signal 8, and storage unit 14 which stores a predetermined number of transmitting codes from different transmitters 3 that are transmitted via signals 8. *See id.* ¶¶ 32-33.

Sommer explains that the transmitters authorized to engage with the receiver are those whose transmitting codes have been read by the receiver when the receiver is in a “teach-in mode,” as follows:

To operate the door [2] or gate, a transmitting code is transmitted by an authorized transmitter [3] to the receiver [4] of the transmitter/receiver unit, wherein authorized transmitters are defined as those for which *the transmitting codes can be read into the receiver by means of a teach-in mode*. The receiver can be switched to the teach-in mode upon receiving an identification code emitted by a freely selectable transmitter if the number of transmitting codes stored in the receiver is lower than a limit value preset in the receiver. If the number of transmitting codes for authorized transmitters stored in the receiver corresponds to the limit value, the receiver can be switched to the teach-in mode only upon receiving an identification code emitted by an authorized transmitter.

*Id.* ¶ 11 (emphasis added).

In particular, “[u]pon receiving an identification code [from transmitter 3], the receiver 4 automatically switches from its normal operation to the teach-in mode and this switch is indicated to the user with an individual acoustic signal 13 emitted by the acoustic signal transmitter 12.” *Id.* ¶ 36.

Sommer further states that it would be advantageous “if the number of transmitters purchased form a set that corresponds to the limit value for transmitters preset in the receiver, wherein these transmitters are read into the receiver either at the factory level or at the specialty store, prior to delivery.” *Id.* ¶ 19. In doing so, “[t]he end user thus can be assured that the purchased closing system can be switched to the teach-in mode *only by the transmitters supplied with the system, but not by system external transmitters.*” *Id.* ¶ 20 (emphasis added).

2. Fitzgibbon (Ex. 1005)

Fitzgibbon is titled “Code Learning System for a Movable Barrier Operator,” and relates to “garage door operators having systems for receiving radio frequency transmissions that are encoded or encrypted to identify an authorized user of one or more transmitters.” Ex. 1005, code (54), 1:5–9. Fitzgibbon describes seeking an actuator system employing coded transmissions, which provide good security while enabling a code to be easily and conveniently altered, such as without physical contact with a receiving unit, which may be mounted on a hard-to-reach ceiling. *Id.* at 1:54–57.

Figure 1 of Fitzgibbon, reproduced below, shows a perspective view of its opening system.

Fig. 1

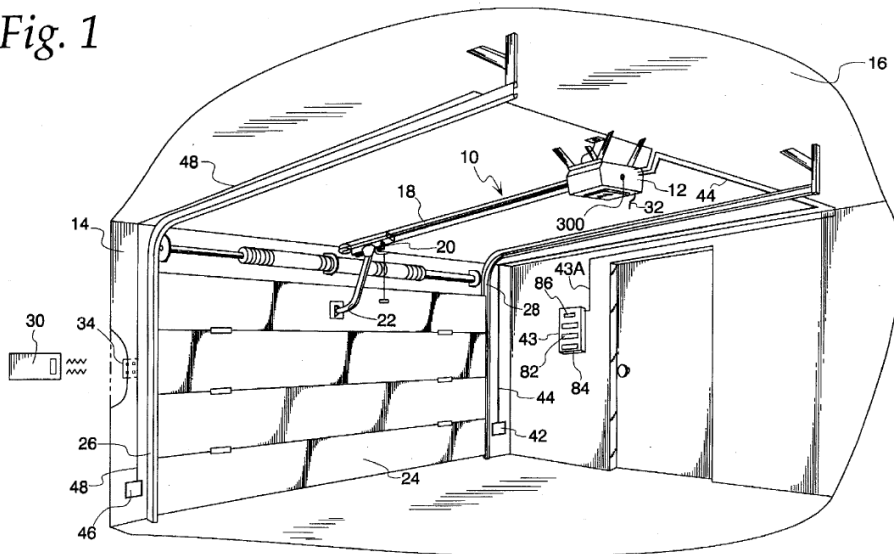


Figure 1 shows head unit 12 (with antenna 32), mounted to ceiling of garage 14, rail 18, garage door 24, hand-held transmitter 30, external control pad 34, and wall control panel 43 (which includes learn switch 82, not shown). *Id.* at 3:13–37.

Fitzgibbon describes a learning process, as follows:

In an alternative mode of operating the code learning system, a radio frequency transmitter or the like may be used to enter a code which is to be stored within a receiver in the head unit. If such a radio frequency transmitter is to be used, the security to prevent unauthorized changing of the transmitter code is achieved through the use of the control pad which is located on the inside of the garage.

*Id.* at 2:12-18. “[T]he ability to reprogram either directly from the RF keypad mounted on the outside of the garage or by using the inside wired control allows rapid and easy reprogramming without subjecting the user to the inconvenience of having to actuate the learn button on the head unit.”

*Id.* at 2:41-48.

### 3. Marchetto (*Ex. 1007*)

Marchetto is titled “Radio Receiver and Transmitter Apparatus for Radio-Controlled Automation Systems for Opening/Closure,” and relates to a radio transmitter and a radio receiver for radio-controlled automation systems, such as the opening/closure of doors. *Ex. 1007*, code (54), ¶ 1.

Fig. 1 of Marchetto, reproduced below, depicts Marchetto’s system.

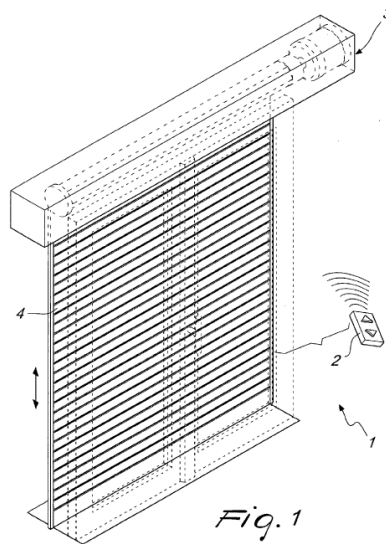
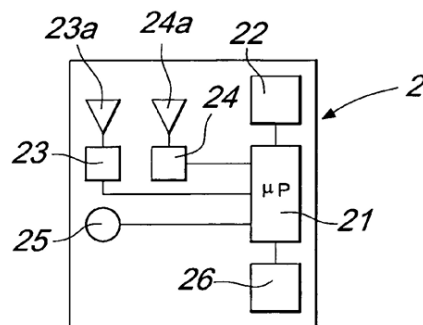


Fig. 1 shows Marchetto's system 1 comprising a "radio transmitter (TX) 2, which is connected to a radio receiver (RX) 3 for remote control of the opening/closure, for example, of a blind 4." *Id.* ¶ 46.

The radio transmitter 2 is depicted in Fig. 2 of Marchetto, reproduced below. When control button 25 is pressed it transmits a recognition code to receiver 3 as part of an actuation signal assembled and transmitted by microcontroller 21.



*Fig. 2*

Fig. 2 shows Marchetto transmitter 2 powered by batteries 26, comprising control button 25, microcontroller 21, transmitter antenna 23a, transmitter circuit 23, receiver antenna 24a, and receiver circuit 24. *See id.* ¶¶ 50–53.

To securely store new transmitters 2 in the memory of receiver 3 – without requiring physical access to the radio receiver in order to activate learning or prior availability of a working radio transmitter – Marchetto employs a programming unit which is external to said transmitter 2 and receiver 3. *Id.* ¶¶ 26–28.

Marchetto's external programming unit 5 is depicted in Fig. 4, reproduced below.

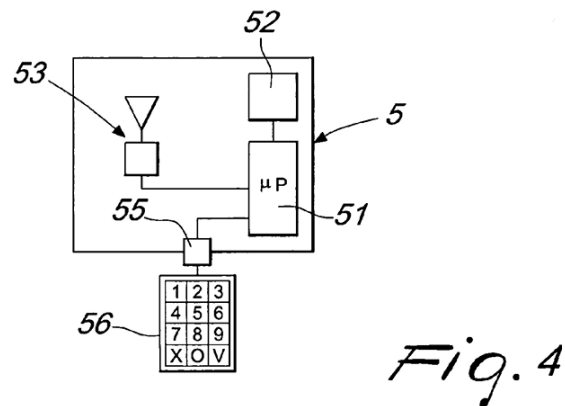


Fig. 4 shows Marchetto’s external programming unit 5 comprising microprocessor 51 which stores management instructions, memory 52, a radio transceiver 53 adapted to exchange radio signals with RX 3 and/or with TX 2, interface 55 for inputs, and keypad 56. *Id.* ¶ 66.

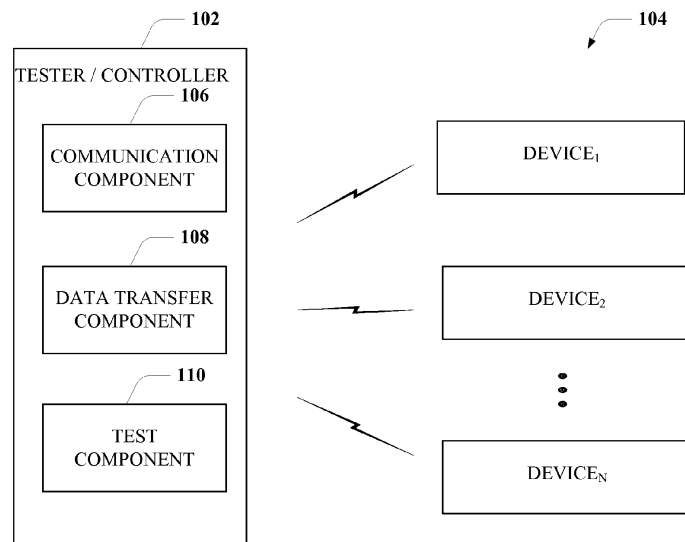
The programming unit 5 is capable of activating a new transmitter by first entering a certificate via its keypad 56. *See id.* ¶ 87 (“To activate a TX, it is sufficient to use the programming unit 5 by entering the certificate read from the label [of receiver 3] on the keypad 56, . . . place the TX close to the programming unit [5] and activate the certificate transfer function [ ].”). It can also be used to download stored codes from a receiver unit and retransmit them to its replacement (*id.* ¶ 94), or to delete a code in the receiver corresponding to a lost transmitter (*id.* ¶ 95).

#### 4. Romine (Ex. 1012)

Romine is titled “Device Manufacturing Using the Device’s Embedded Wireless Technology,” and relates to ensuring “that the wireless computing devices are successfully programmed in the event a disruption to the manufacturing, programming, testing and servicing process flow occurs.” Ex. 1012, code (54), Abstract.

Because of the cost of supplying and using direct-wired hardware for manufacturing, programming, and testing devices with wireless technology features, Romine presents a method of utilizing the embedded wireless technology (“regardless of technology”) in the manufactured devices to aid in programming and testing. *Id.* at 1:23–2:4.

Romine describes “system 100 that facilitates wireless testing and/or transfer of data to a wireless device (and associated subcomponents) during device manufacturing, configuration, programming, and/or testing, including reliability and quality assurance processes.” *Id.* at 4:51–56. Figure 1, reproduced below, shows a schematic of Romine’s system 100.



System 100 includes tester/controller 102 that tests wireless devices 104 (Devices 1 to N), which are “electronic and/or communication devices that communicate wirelessly.” *Id.* at 4:56–63. Romine also describes that the programming process may involve downloading software or configuration data to the devices. *Id.* at 8:44–66.

5. *Thomas (Ex. 1013)*

Thomas is titled “Buffering Content on a Handheld Electronic Device,” and relates to buffering video, audio, and other content at handheld electronic devices.” Ex. 1013, code (54), 2:62–63.

Thomas describes a handheld device which, when received, goes through a registration process that includes authentication. *Id.* at 45:43–45. Thomas describes the use of a “unique identifier,” which “can be placed on a removable sticker on the handheld device 16 or on the box in which it is shipped from the manufacturer.” *Id.* at 45:45–47, 45:54–56.

*E. Ground 1A – Alleged Obviousness of Claims 1, 4, 10, 11, and 13 over Sommer and Marchetto*

Petitioner challenges claims 1, 4, 10, 11, and 13 as unpatentable under 35 U.S.C. § 103 over the combination of Sommer and Marchetto. Pet. 5–30.

1. *Independent Claim 1*

Petitioner contends that Sommer (Ex. 1004) meets all that claim 1 recites but for limitation [1.4], for which Marchetto (Ex. 1007) is relied upon. *See* Pet. 22–24. Petitioner, argues, *inter alia*, that “[a] POSITA [person of ordinary skill in the art] would have been motivated and found it obvious to implement Sommer’s process of programming a receiver using an external programming device based on the teachings of Marchetto.” *Id.* at 11. Patent Owner disagrees arguing, *inter alia*, that Marchetto would lead one “away from Petitioner’s proposed combination.” Prelim. Resp. 14.

We have reviewed Petitioner’s various contentions and supporting evidence, and Patent Owner’s opposing arguments, and determine that Petitioner does not demonstrate a reasonable likelihood of prevailing in



showing that claim 1 would have been obvious over the combination of Sommer and Marchetto to one of ordinary skill in the art.

*a. Contentions regarding subject matter of limitation [1.4]*

Limitation [1.4] requires “using a transmitter external to the barrier opening system.” Petitioner contends that Marchetto discloses such a device. *See* Pet. 23, discussed at *id.* 10–15.

The evidence supports Petitioner’s contention. *See* e.g., Ex. 1007 ¶ 66 (“a programming unit 5, which is external to the RX 3 and to the TX 2”); Pet. 23.

Limitation [1.4] further requires using said external transmitter to “transmit[ ] the authorization code to the barrier operator.” Petitioner contends that Marchetto discloses “[t]he programming unit 5 is configured to ‘updat[e] the information contained in the memor[y] of the RX3’ by transmitting commands ‘wirelessly’ to the RX3.” Pet. 10 (citing Ex. 1007 ¶¶ 66–68).

The evidence supports Petitioner’s contention. Marchetto provides an example whereby “[b]y means of the programming unit 5, it is possible to ... retrieve all the enabled recognition codes” from a particular receiver “and store them locally on the programming unit.” Ex. 1007 ¶ 94. The “list of codes can thus be retransmitted to the memory of the new motor” of a new receiver via programming unit 5. *Id.*; Pet. 10.

For that portion of limitation [1.4] that requires “the barrier operator [to be] in *the learn mode*” when the “transmitter external to the barrier opening system” is used to “transmit[ ] the authorization code to the barrier operator,” Petitioner relies on the combination of Sommer and Marchetto. Pet. 11. In that regard, however, Patent Owner contends that “Sommer

teaches away from the combination.” Prelim. Resp. 13. Patent Owner asserts that a “POSA [person of ordinary skill in the art] reading Marchetto also would have been led away from Petitioner’s proposed combination.” *Id.* at 14.

*b. Teaching Away*

*i. Principles of Law*

A reference does not teach away “if it merely expresses a general preference for an alternative invention but does not ‘criticize, discredit, or otherwise discourage’ investigation into the invention claimed.” *DePuy Spine, Inc. v. Medtronic Sofamor Danek, Inc.*, 567 F.3d 1314, 1327 (Fed. Cir. 2009) (quoting *In re Fulton*, 391 F.3d 1195, 1201 (Fed. Cir. 2004)). However, “[a] reference may be said to teach away when a person of ordinary skill, upon reading the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that was taken by the applicant.” *Id.* (quoting *In re Gurley*, 27 F.3d 551, 553 (Fed. Cir. 1994)).

*ii. Sommer – regarding “using a transmitter external to the barrier opening system”*

Patent Owner contends Sommer would have led a person with ordinary skill away from the claimed invention because Sommer explains that “allowing the ‘memory of receiver’ to be accessed by an external transmitter directly contradicts Sommer’s intended purpose.” Prelim. Resp. 12 (quoting Pet. 23).

Patent Owner cites, *inter alia*, ¶¶ 8, 17, 20, and 21 of Sommer (Ex. 1004) in support of its contention. Prelim. Resp. 12–14.

Sommer expressly states that its system is designed so that “outside transmitters can no longer switch the receiver to the teach-in mode.” Ex. 1004 ¶ 17. The result is a “purchased closing system [that] can be switched to the teach-in mode only by the transmitters supplied with the system, *but not by system-external transmitters.*” *Id.* at ¶ 20 (emphasis added).

Sommer does not merely express a general preference for a system with a learn mode over one that employs an external transmitter. Sommer prevents external transmitters from accessing the system so that its system can provide “efficient protection against manipulations.” *Id.* at ¶ 17. Its system also overcomes other disadvantages associated with the use of external devices, including “undesirably high costs for the closing system” and they are “difficult to handle since the programming device must be installed at a location of the door or gate region that is protected against theft”. *Id.* at ¶ 8. These stated disadvantages “criticize, discredit, [and] otherwise discourage” using external transmitting devices to engage with its receiver. *DePuy*, 567 F.3d at 1327.

Accordingly, Sommer presents a structural solution (by employing a receiver with a learning mode) that addresses, for example, security problems associated with a system like Marchetto that employs an external programming unit to access a receiver. *See e.g.*, Ex. 1004 ¶ 21 (“the end user is ensured that the receiver *cannot be switched to the teach-in mode by system-external transmitters*” (emphasis added)).

This would have discouraged a person with ordinary skill in the art from controlling Sommer’s closing system with an external transmitting device like that of Marchetto. *See* Ex. 1004 ¶¶ 17, 20, 21; *see In re Ethicon, Inc.*, 844 F.3d 1344, 1351 (Fed. Cir. 2017). One of ordinary skill in the art

would have been led on a path away from using a “transmitter external to the barrier opening system” to “transmit[ ] the authorization code to the barrier operator” (i.e., a receiver) while “the barrier operator is in the learn mode” as claimed.

*iii. Marchetto – regarding “the barrier operator is in the learn mode”*

Patent Owner also contends a person with ordinary skill in the art “reading Marchetto also would have been led away from Petitioner’s proposed combination.” Prelim. Resp. 14.

Patent Owner cites, *inter alia*, ¶¶ 17, 25, 58, and 102, of Marchetto (Ex. 1007) in support of its contention. Prelim. Resp. 10–11; 14–15.

Marchetto expressly states that its external programming unit is designed to directly program a new transmitter into a receiver “without” a learn mode. Ex. 1007 ¶ 102. Marchetto states, *inter alia*, that

*it has been found that the apparatus according to the invention fully achieves the intended aim, since it allows to enable new radio transmitters to control the automation system securely and without having to physically access the interior of the radio receiver to activate learning even without placing oneself in its proximity.*

*Id.* (emphases added).

Marchetto does not merely express a general preference for a system “without” a learn mode. Marchetto seeks to overcome a drawback with barrier systems using a learn mode; that is, “the operation must be performed in the vicinity of the receiver.” Ex. 1007 ¶ 17. “[I]t is not possible to go to a shop or to the installer of the system, buy a new TX, and return home with the TX already working.” *Id.* Marchetto’s “aim . . . is to overcome [such] drawbacks . . . by providing an apparatus for automation systems with

radio-controlled actuation.” *Id.* at 25. These drawbacks “criticize, discredit, [and] otherwise discourage” control systems that use a learn mode. *DePuy*, 567 F.3d at 1327.

Marchetto presents a structural solution (via using an external programming unit) for addressing problems associated with a system like Sommer’s (such as proximity to the radio receiver) that requires a learn-in mode to operate. *See e.g.*, Ex. 1007 ¶ 102. Marchetto’s solution is a secure certificate that allows new radio transmitters to control the automation system. *Id.* Marchetto explains that “[t]he certificate is a numeric code which is stored in the memory 32 during the manufacture of the RX and allows to identify each RX uniquely.” *Id.* at 58.

Marchetto would therefore have discouraged a person with ordinary skill in the art from using a learn mode that requires proximity to the radio receiver, providing instead a secure certificate that allows new radio transmitters to control the automation system. *See* Ex. 1007 ¶¶ 58, 102; *see Ethicon*, 844 F.3d 1351. One of ordinary skill in the art would have been led on a path away from using a “transmitter external to the barrier opening system” to “transmit[ ] the authorization code to the barrier operator” (i.e., a receiver) while “the barrier operator is in the learn mode” as claimed.

*iv. Conclusion as to Teaching Away*

Given the evidence, we find that Sommer and Marchetto teach away from combining Sommer and Marchetto to reach the claimed subject matter.

*c. Motivation to Combine*

Notwithstanding our conclusion that Sommer and Marchetto both teach away from using a “transmitter external to the barrier opening system” to “transmit[ ] the authorization code to the barrier operator” while “the

barrier operator is in the learn mode” as claimed, we also address four rationales to combine Sommer and Marchetto. Pet. 11–15. Patent Owner addresses each reason, arguing that “Petitioner’s motivations for combining Sommer and Marchetto are wrong.” Prelim. Resp. 17.

*i. Cost Savings*

First, Petitioner contends that a person of ordinary skill in the art would have been motivated and found it obvious to implement Sommer’s process of programming a receiver using an external programming device because using Marchetto’s external transmitter “would [ ] alleviate the need for a human to locate, physically handle, and manually actuate each wireless transmitter in order to transmit the code for that transmitter to the receiver,” yielding “cost savings.” Pet. 12 (citing, *inter alia*, Ex. 1003 ¶ 47). Petitioner explains that it would be less labor intensive to “store codes of transmitters to be authorized” in Marchetto’s programming device and then use that device to “transmit these codes to the receiver to store the codes in the receiver’s memory” than it would be to “manually actuate each wireless transmitter in order to transmit the code for that transmitter to the receiver” per Sommer. *Id.* at 11–12 (citing Ex. 1003 ¶ 48).

Patent Owner disagrees, arguing that using Marchetto’s external transmitter would “likely increase” human labor rather than “alleviate” it. Prelim. Resp. 17. This is so, according to Patent Owner because, *inter alia*, while

Sommer’s system allows for transmitters to be taught to a receiver by pressing the transmitter button (when the receiver is in its teach-in mode (Sommer, [0014])), Marchetto’s programming unit requires a user to

enter recognition codes on the programming unit’s keypad manually. (Marchetto, [0069].)

*Id.* at 18.

We find that Patent Owner’s argument is supported by Marchetto’s disclosure, which explains that one must first enter a certificate via the programming unit’s keypad 56 in order to activate a new transmitter (*see* Ex. 1007 ¶ 87). Thus, using Marchetto’s external device would involve an extra step of manually entering recognition codes. This is in contrast to Sommer, which actuates transmitters simply by transmitting a code to the receiver once its learn–in mode is activated (*see* Ex. 1004 ¶ 11). Adding an extra manual–entering step would increase, rather than “alleviate,” the labor needed to activate transmitters per Sommer’s system.

Petitioner relies on the testimony of Dr. Davis. *See* Ex. 1003 ¶ 47; Pet. 12. But it simply repeats the argument in the Petition. Dr. Davis states that “[u]sing an external programming device ... alleviate[s] the need for a human to locate, physically handle, and manually actuate each wireless transmitter [as in Sommer]” (*id.*; Pet. 12) but does not elaborate. Dr. Davis does not, address, for example, Marchetto’s stated need to additionally enter recognition codes into the external device and whether the combination of Sommer and Marchetto still yields an alleviation from having to do so. Absent evidentiary support or persuasive explanation, we afford Dr. Davis’s conclusory testimony little weight.

There is insufficient evidence on this record showing one of ordinary skill in the art would have combined Sommer and Marchetto because it would “alleviate” the human labor associated with actuating transmitters per Sommer’s procedure.

*ii. Increased Efficiency and Reliability*

Second, Petitioner contends that “use [of] an external programming device [as taught by Marchetto] to configure Sommer’s receiver with the authorized transmitting codes” would be more efficient and reliable than using individual transmitters. Pet. 12–13 (citing, *inter alia*, Ex. 1003 ¶ 48). This is so, according to Petitioner, because, *inter alia*, “the external programming device taught by Marchetto is not subject to the same power and size constraints as the individual transmitters described in Sommer.” *Id.* at 13.

[T]he external programming device can be configured to transmit signals at a higher power, since it is not constrained to run on batteries, and not constrained in antenna size (e.g., it can include a larger antenna sized and shaped for optimal transmission, since it need not be sized to be portable).

*Id.* (citing Ex. 1003 ¶ 48; Ex. 1007 ¶¶ 66-70, 87, 94).

Patent Owner disagrees, arguing that “Petitioner does not provide evidence for its assertion that ‘the external programming device taught by Marchetto’ purportedly would not have been ‘subject to the same power and size constraints as the individual transmitters described in Sommer.’”

Prelim. Resp. 18.

We agree with Patent Owner that Petitioner’s assertion that Marchetto’s external programming device is not subject to the same power and size constraints as Sommer’s transmitters is not sufficiently supported.

Petitioner relies on the testimony of Dr. Davis. *See* Ex. 1003 ¶ 48; Pet. 13. But Dr. Davis simply repeats the assertion that the “external programming device taught by Marchetto is not subject to the same power



and size constraints as the individual transmitters described in Sommer” (*id.*; Pet. 13) without further elaboration or support.

Petitioner cites various passages in Marchetto. *See* Pet. 13 (citing Ex. 1007 ¶¶ 66-70, 87, 94). We have reviewed those passages and do not find them convincing. There is no discussion there about the programming device’s configuration. The cited passages do not address, for example, the programming device’s size and power, let alone whether the programming device contrasts with Sommer’s transmitters in terms of its ability to be differently configured.

There is, therefore, insufficient evidentiary support showing that Marchetto’s programming device is more configurable than individual transmitters like those Sommer discloses so as to render it more efficient and reliable.

*iii. Decreased Production Costs*

Third, Petitioner asserts that a “POSITA would have understood that implementing Sommer’s transmitter 3 using a programmed microcontroller, as described by Marchetto, would have led to decreased production costs compared to other approaches (e.g., designing a custom circuit) due to the commoditization of general purpose microcontrollers.” Pet. 13–14 (citing, *inter alia*, Ex. 1003 ¶ 49). Patent Owner disagrees, arguing that “Sommer never states that his transmitters require ‘designing a custom circuit,’ as suggested by Petitioner.” Prelim. Resp. 19. According to Patent Owner, “Marchetto does not indicate that its transmitter is simpler or that using it to replace Sommer’s transmitter would, as Petitioner argues, lead to a ‘shorter, and consequently cheaper, development process.’ (Pet. 14.)” *Id.*

We agree with Patent Owner that Petitioner's assertion that implementing Marchetto's programmable unit in Sommer's transmitter "would have led to decreased production costs compared to other approaches" lacks sufficient support. Petitioner does not specify the "other approaches" that increase production cost. Assuming that Petitioner is referring to the approach that would be used to produce Sommer's transmitters, there is insufficient evidence to show that production of Sommer's transmitter is more or less complicated than if the transmitter was implemented with a "programmed controller." Petitioner appears to rely on paragraph 37 of Sommer for support (Pet. 13-14), however, that paragraph discusses identification codes.

Petitioner also relies on the testimony of Dr. Davis. *See* Ex. 1003 ¶ 49; Pet. 13. But Dr. Davis simply repeats the argument made in the Petition. Dr. Davis states that the combination would have "led to a shorter, and thus cheaper, development process for the transmitters 3, due to the relative ease of developing and testing software to program the microcontroller compared to developing and testing hardware (e.g., a customer circuit or chip)." *Id.*; Pet. 13). But there is no elaboration. Dr. Davis does not explain, for example, why Sommer's transmitters would have been more expensive to develop than the seemingly more complicated combination of Sommer's transmitter with a "programmed controller." Absent evidentiary support or persuasive explanation, we afford Dr. Davis's conclusory testimony little weight.

Accordingly, we do not find the evidence sufficiently supports Petitioner's contention that a "POSITA would have understood that implementing Sommer's transmitter 3 using a programmed microcontroller .

. . . would have led to decreased production costs compared to other approaches.” Pet. 13–14.

*iv. Predictable Results*

Finally, Petitioner argues that a “POSITA would have recognized that applying Marchetto’s teachings to Sommer’s system would have led to predictable results without significantly altering or hindering the functions performed by Sommer’s system.” *Id.* at 14 (citing, *inter alia*, Ex. 1003 ¶ 50, and *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 417 (2007)). Furthermore, according to Petitioner, “[a] POSITA would have had a reasonable expectation of success in making this modification, and would have reasonably expected to reap the benefits of the techniques described in Marchetto.” *Id.* at 15 (citing, *inter alia*, Ex. 1003 ¶ 51).

Patent Owner disagrees, arguing that Petitioner’s rationale is a collection of “boilerplate recitations of *KSR* factual scenarios.” *Id.* at 20.

Petitioner cites the Davis Declaration in support of its argument. *See* Ex. ¶ 50; Pet. 14. But the Davis Declaration simply repeats the statements in the Petition. The Declaration does not buttress Petitioner’s “*KSR*” argument with additional explanation as to why adding Marchetto’s external programming device to Sommer’s system would *not* have significantly altered or hindered the functions performed by Sommer’s system. This would have been important to explain because, as we have discussed, both Sommer and Marchetto expressly teach away from combining Sommer’s learn mode and Marchetto’s external programming unit. “[W]hen the prior art teaches away from combining certain known elements, discovery of a successful means of combining them is more likely to be nonobvious.”

*KSR*, 550 U.S. at 416. Since that has not been done, we do not find the evidence on this record sufficiently supports Petitioner’s “*KSR*” argument.

*d. Conclusion as to Claim 1*

After considering Petitioner’s and Patent Owner’s positions, as well as the supporting evidence on this record, we find that the record insufficiently supports the rationales Petitioner has put forward as motivations for combining Sommer and Marchetto to reach the claimed method. Coupling that with express statements in Sommer and Marchetto criticizing each other’s systems that teach away from making the combination, we conclude that the record insufficiently shows claim 1 of the ’120 patent would have been obvious over Sommer and Marchetto.

On this record, Petitioner has not demonstrated a reasonable likelihood of prevailing in demonstrating that claim 1 of the ’120 patent would have been obvious over Sommer and Marchetto.

*2. Independent Claim 10*

Independent claim 10 parallels claim 1. Similar to [1.4], claim 10 calls for “transmitting each unique authorization code to the barrier operator, using a transmitter external to the barrier opening system, such that the barrier opening system learns each unique authorization code.” Ex. 1001 7:62–65.

Petitioner’s position is essentially the same as the one taken with respect to claim 1. Pet. 26–29.

For the reasons discussed with respect to the challenge of claim 1, the record insufficiently supports the rationales Petitioner has put forward as motivations for combining Sommer and Marchetto to reach the claimed method. Coupling that with express statements in Sommer and Marchetto

criticizing each other's systems that teach away from combining Sommer's learn mode and Marchetto's external programming unit, the record insufficiently shows claim 10 of the '120 patent is rendered obvious over Sommer and Marchetto.

*a. Conclusion as to Claim 10*

On this record, Petitioner has not demonstrated a reasonable likelihood of prevailing in demonstrating that claim 10 of the '120 patent would have been obvious over Sommer and Marchetto.

*3. Claims 4, 11, and 13*

Claim 4 depends from claim 1 and claims 11 and 13 depend directly or indirectly from claim 10. Petitioner addresses the subject matter of claims 4, 11 and 13. *See* Pet. 26, 29–30. But Petitioner otherwise relies on its reasoning with respect to its challenge of the independent claims from which these claims depend.

By virtue of their dependency, claims 4, 11 and 13 include the same limitations as the independent claims from which they depend. Therefore, for the same reasons discussed above with respect to independent claims 1 and 10, Petitioner also has not demonstrated a reasonable likelihood that it would prevail in showing that dependent claims 4, 11, and 13 would have been obvious over the combination of Sommer and Marchetto. *Cf. In re Fine*, 837 F.2d 1071, 1076 (Fed. Cir. 1988) (“Dependent claims are nonobvious under section 103 if the independent claims from which they depend are nonobvious.”).

*F. Ground 1B – Alleged Obviousness of Claims 5, 6, 8, 14, 15, and 17 over Sommer, Marchetto, and Thomas*

Claims 5, 6, 8, and 17 depend directly or indirectly from claim 1 and claims 14 and 15 depend directly or indirectly from claim 10. Petitioner challenges claims 5, 6, 8, 14, 15, and 17 as unpatentable under 35 U.S.C. § 103(a) over the combination of Sommer, Marchetto, and Thomas. Pet. 30–41. Petitioner addresses the subject matter of claims 5, 6, 8, 14, 15, and 17 but otherwise relies on its reasoning with respect to its challenge of the independent claims from which these claims depend. *Id.*

By virtue of their dependency, claims 5, 6, 8, 14, 15, and 17 include the same limitations as the independent claims from which they depend. Therefore, for the same reasons discussed above with respect to independent claims 1 and 10, Petitioner also has not demonstrated a reasonable likelihood that it would prevail in showing that dependent claims 5, 6, 8, 14, 15, and 17 would have been obvious over Sommer, Marchetto, and Thomas.

*G. Ground 2A – Alleged Obviousness of Claims 1–4, 10, 11, and 13 over Fitzgibbon and Romine*

Petitioner challenges claims 1–4, 10, 11, and 13 as unpatentable under 35 U.S.C. § 103 over the combination of Fitzgibbon and Romine. Pet. 41–59.

*1. Independent claim 1*

Petitioner contends, *inter alia*, that Fitzgibbon (Ex. 1005) discloses all that claim 1 recites but for performing the steps “prior to delivery of the barrier opening system to the end use” (see e.g., limitation [1.4]), for which Romine (Ex. 1012) is relied upon. See Pet. 47–54. Petitioner, argues, *inter alia*, that “[a] POSITA would have been motivated and found it obvious to perform Fitzgibbon’s process for utilizing the ‘learn mode’ of the ‘movable

barrier or garage door operator’ to store codes of authorized transmitters utilizing a tester/controller ‘during a manufacturing process,’ as taught by Romine.” *Id.* at 44. Patent Owner disagrees arguing, *inter alia*, that Romine is non-analogous prior art.” Prelim. Resp. 26–32.

We have reviewed Petitioner’s various contentions and supporting evidence, and Patent Owner’s opposing arguments, and determine that Petitioner does not demonstrate a reasonable likelihood of prevailing in showing that claim 1 would have been obvious over the combination of Fitzgibbon and Romine to one of ordinary skill in the art.

*a. Contentions regarding subject matter of limitation [1.4]*

Regarding “transmitting the authorization code to the barrier operator while the barrier operator is in the learn mode” (Ex. 1001, 7:15–16) of limitation [1.4], Petitioner contends, *inter alia*, that “Fitzgibbon describes that when the head unit is in learn mode, ‘a radio frequency transmitter or the like may be used to enter a code which is to be stored within a receiver in the head unit’ by ‘transmitting’ the code to the head unit.” *Id.* at 51 (citing Ex. 1005, 2:13-15).

Romine is relied upon for “using a transmitter external to the barrier opening system” (Ex. 1001, 7:17–18) to perform said “transmitting” and to do so “prior to delivery of the barrier opening system to the end user” (*id.* at 7:14–15). In that regard, Petitioner contends:

Romine teaches a “**tester/controller 102**” (i.e., a transmitter external to the barrier opening system) “located in one of a plurality of locations in a manufacturing environment *to facilitate data transfer, configuration, and/or testing of wireless devices,*” such as the receiver described in Sommer.

*Id.* (citing, *inter alia*, Ex. 1012, 4:66–5:2). Petitioner argues that “[a] POSITA would have understood Romine [i.e., “tester/controller 102”] as teaching programming with a transmitter external to the system . . . .” *Id.* According to Petitioner, “it would have been obvious to use the tester/controller of Romine to wirelessly transmit the transmitting codes to be authorized to Fitzgibbon’s garage door operator.” *Id.* at 52 (citing Ex. 1003 ¶ 141).

Additionally, according to Petitioner, Romine uses its tester/controller 102 “to facilitate data transfer, configuration, and/or testing of wireless devices” “*in a manufacturing environment*” (Ex. 1012, 4:66–5:2, emphasis added). According to Petitioner, “a POSITA would have understood that Romine’s ‘manufacturing process’ occurs prior to delivery of Fitzgibbon’s garage door operator to an end user” (*id.* at 53 (citing Ex. 1003 ¶ 142), thereby disclosing using a transmitter external to the system “prior to delivery of the barrier opening system to the end user” as the claim requires.

Patent Owner raises a shortcoming in Petitioner’s reliance on Romine to reach the claimed subject matter; that is, according to Patent Owner, “Petitioner does not even address whether Romine is analogous art, whether it is in the same field of endeavor as the ’120 patent, or whether it is reasonably pertinent to the problems addressed by the ’120 patent.” Prelim. Resp. 26 (citing *In re Nat. Alternatives, LLC*, 659 F. App’x 608, 614 (Fed. Cir. 2016)).

*b. Non-analogous Art*

Patent Owner contends that “Romine is non-analogous art and cannot be used in an obviousness analysis for the ’120 patent.” Prelim. Resp. 27.



There are

[t]wo separate tests defin[ing] the scope of analogous prior art: (1) whether the art is from the same field of endeavor, regardless of the problem addressed and, (2) if the reference is not within the field of the inventor's endeavor, whether the reference still is reasonably pertinent to the particular problem with which the inventor is involved.

*In re Bigio*, 381 F.3d 1320, 1325 (Fed. Cir. 2004).

Regarding the first test, Patent Owner argues “[a] POSA would have understood that because Romine relates primarily to the manufacture of cellular phones and does not disclose the use of transmitters and receivers or the operation of a barrier opening system, Romine is not in the same field of endeavor as the ’120 patent.” Prelim. Resp. 29.

Patent Owner explains that “[a] POSA would have understood that references in the same field of barrier opening systems disclose the use of wireless transmitters and receivers that would actuate the door.” *Id.* at 28. In contrast, according to Patent Owner, “Romine is a Qualcomm patent that has nothing to do with barrier operator systems. Romine is, instead, directed to manufacturing wireless computing devices, such as cellphones.” *Id.* at 24 (citing Ex. 1012, 5:4-29 (e.g., “wireless device”), 2:13-14 (e.g., “phones”); 7:10-13 (e.g., “phones”); 12:4-30 (e.g., “phone”)). Patent Owner argues: “Romine does not describe any barrier opening system, much less the manufacture of such a system including a receiver and transmitter(s). Romine’s field of endeavor is manufacturing ‘wireless devices’ with ‘embedded wireless technology.’” *Id.* at 28 (citing Ex. 1012, 1:18-21).

Patent Owner accurately characterizes Romine as directed to manufacturing wireless devices. The Background section of Romine

describes the invention as an improvement over past practices for manufacturing wireless devices that required, *inter alia*, “a significant amount of handling (human labor) [ ] to connect and disconnect the device to/from the tester, controller, programmer, etc..” Ex. 1012, 1:46–49.

Romine’s field of endeavor is indicated as being the “efficient manufacturing, programming, testing, and servicing of wireless devices utilizing the device's embedded wireless technology.” *Id.* at 1:19–21 (under “1. Field”); *see also* Section I.C.2. above.

The claimed subject matter is directed “to barrier opening systems, and more particularly to the pairing of wireless transmitters with the barrier operator of a barrier opening system” and seeks to improve on users’ experience when pairing wireless transmitters in operating barrier systems. Ex. 1001, 1:19–22 (under “Field of the Invention”); 2:17–19. This contrasts with Romine which is directed to improving the manufacture of wireless devices by, *inter alia*, employing a wireless communication approach to test the devices and thereby reduce human labor. Ex. 1012, 1:19–21; 1:46–49. These disparate technologies and goals raise a question as to whether Romine is from the same field of endeavor as that of the claimed subject matter. Petitioner does not address this question. Based on the evidence, Petitioner does not sufficiently show that Romine and the claimed subject matter are from the same field of endeavor.

Even though Romine and the ’120 patent are not in the same field of endeavor, Romine may still properly be combined with Fitzgibbon if it is reasonably pertinent to the problem the ’120 patent attempts to solve. “A reference is reasonably pertinent if, even though it may be in a different field from that of the inventor's endeavor, it is one which, because of the matter

with which it deals, logically would have commended itself to an inventor's attention in considering his problem.” *In re Clay*, 966 F.2d 656, 659 (Fed. Cir. 1992).

Regarding this second test for defining the scope of analogous prior art, Patent Owner argues that Romine would not logically have commended itself to an inventor’s attention in considering a problem of pairing a wireless transmitter to a receiver because

Romine addresses problems associated only with manufacturing wireless devices in isolation, e.g., how to manufacture a cell phone. Romine explains in its background sections that when manufacturing “[w]ireless computing device[s],” such as cell phones, there are “physical connection or data interface needed to test, program, and/or transfer data to/from the device(s)—these physical connections allow the device to communicate with a tester, controller, programmer, etc.”

*Id.* at 30 (quoting Ex. 1012, 1:23–33).

Patent Owner explains that said “physical connections” “contribute to the overall cost of manufacturing the devices,’ and that the human handling and wear and tear associated with these physical connections increase manufacturing time and cost.” *Id.* at 30–31 (citing Ex. 1012, 1:35-55).

According to Patent Owner, “Romine suggests using the ‘embedded wireless technology already supported by a device being tested to transfer data to and from factory test controllers without use of physical data connections’ in order to reduce the number of physical connections with the wireless devices.” *Id.* at 31 (quoting Ex. 1012, 2:1-4). “In other words, [according to Patent Owner,] the purpose of Romine is to take steps of the manufacturing process requiring “physical data connections” and make those steps wireless.” *Id.* at 24–25.

Patent Owner accurately characterizes Romine’s objective; that is, it seeks to overcome the disadvantages of having to make a physical connection with a wireless device in order to test said device during the manufacturing process. *Cf. e.g., Ex. 1012, 1:33–36* (“[t]he hardware (e.g., cabling, connectors) utilized in wired data transfer solutions to physically connect the data interfaces [that] contribute to the overall cost of manufacturing the devices.”); Prelim. Resp. 31.

By contrast, the ’120 patent discusses how to improve users’ experience when pairing wireless transmitters as they try to operate a barrier system. *See supra* Section I.C.1. (citing, *inter alia*, Ex. 1001, 2:26–29 (“without user inconvenience or confusion”)). *Cf. Ethicon LLC v. Intuitive Surgical, Inc.*, 2022 WL 1576779, at \*3 (Fed. Cir. 2022) (“the Board considered the problems facing the inventors of the ’287 patent as part of the ‘reasonably pertinent’ inquiry.”)

We do not see how the matter with which Romine deals, that is, how to test a wireless device without having to physically connect to it, logically would have commended itself to the attention of a person of ordinary skill, having “at least one to two years of related work experience in the fields of access control or automated door control systems” (Pet. 4) in considering the problem of pairing a transmitter with a receiver without having to involve the user of an automated barrier control system. The evidence on the record supports Patent Owner in that “[a] POSA would understand that such ‘physical connections’ were not traditionally used to pair transmitters to a receiver in a barrier operator.” Prelim. Resp. 31 (citing, *inter alia*, ’120 patent, Abstract and Sommer ¶ 2). A person having ordinary skill in the art of automated door control systems would not reasonably have been expected

to consult a reference (i.e., Romine) that deals with factory testing of wireless devices without physical connections in order to solve a problem of pairing without having to involve a user (i.e., the '120 patent).

Given the evidence and that Petitioner does not address whether Romine is analogous prior art, Petitioner does not sufficiently show that Romine would logically have commended itself to an inventor's attention in considering a problem of pairing a wireless transmitter to a receiver.

For that reason, we agree with Patent Owner that Romine is non-analogous art.

Because Romine is non-analogous art, Petitioner has not established that a person of ordinary skill in the art would have had sufficient reason to combine the teachings of Fitzgibbon and Romine to reach the claimed subject matter. *See Clay*.

Given that Romine is non-analogous art, we need not address the various motivations Petitioner has presented in contending that one of ordinary skill in the art would have been led to the claimed subject matter by combining Fitzgibbon and Romine. Pet. 59–62.

*c. Conclusion as to Claim 1*

On this record, Petitioner has not demonstrated a reasonable likelihood of prevailing in demonstrating that claim 1 of the '120 patent would have been obvious over Fitzgibbon and Romine.

*2. Independent Claim 10*

Independent claim 10 parallels claim 1.

Petitioner's position is essentially the same as the one taken with respect to claim 1. Pet. 55–58.

As discussed with respect to the challenge of claim 1, Romine is nonanalogous art. Accordingly, the record insufficiently shows claim 10 of the '120 patent would have been obvious over Fitzgibbon and Romine.

*a. Conclusion as to Claim 10*

On this record, Petitioner has not demonstrated a reasonable likelihood of prevailing in demonstrating that claim 10 of the '120 patent would have been obvious over Fitzgibbon and Romine.

*3. Claims 4, 11, and 13*

Petitioner addresses the subject matter of claims 4, 11 and 13. *See* Pet. 55 and 58–59. But otherwise relies on its reasoning with respect to its challenge of the independent claims from which they depend.

By virtue of their dependency, claims 4, 11 and 13 include the same limitations as the independent claims from which they depend. Therefore, for the same reasons discussed above with respect to independent claims 1 and 10, Petitioner also has not demonstrated a reasonable likelihood that it would prevail in showing that dependent claims 4, 11, and 13 would have been obvious over Fitzgibbon and Romine.

*H. Ground 2B – Alleged Obviousness of Claims 5, 6, 8, 14, 15, and 17 over Sommer and Marchetto*

Petitioner challenges claims 5, 6, 8, 14, 15, and 17 as unpatentable under 35 U.S.C. § 103 over the combination of Fitzgibbon, Romine, and Thomas. Pet. 59–66.

By virtue of their dependency, claims 5, 6, 8, 14, 15, and 17 include the same limitations as the independent claims from which they depend. Petitioner addresses the subject matter of claims 5, 6, 8, 14, 15, and 17. *See*

Pet. 62-66. But Petitioner otherwise relies on its reasoning with respect to its challenge of the independent claims from which these claims depend.

For the same reasons discussed above with respect to independent claims 1 and 10, Petitioner also has not demonstrated a reasonable likelihood that it would prevail in showing that dependent claims 5, 6, 8, 14, 15, and 17 would have been obvious over Fitzgibbon, Romine, and Thomas.

### III. CONCLUSION

For the foregoing reasons, we determine that Petitioner has not demonstrated a reasonable likelihood that it would prevail in showing the unpatentability claims 1-6, 8, 10, 11, 13-15, and 17 of the '120 patent. Accordingly, we do not institute an *inter partes* review of the '120 patent.

### IV. ORDER

It is:

ORDERED that the Petition is *denied*; and

FURTHER ORDERED that no *inter partes* review is instituted.

IPR2022-00842  
Patent 9,869,120 B2

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