

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

DIGITAL ALLY, INC.,
Petitioner,

v.

UTILITY ASSOCIATES, INC.,
Patent Owner.

Case IPR2015-01389
Patent 6,831,556 B1

Before KALYAN K. DESHPANDE, JAMES B. ARPIN, and
ROBERT J. WEINSCHENK, *Administrative Patent Judges*.

WEINSCHENK, *Administrative Patent Judge*.

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

I. INTRODUCTION

Digital Ally, Inc. (“Petitioner”) filed a Petition (Paper 1, “Pet.”) requesting *inter partes* review of claim 8 of U.S. Patent No. 6,831,556 B1 (Ex. 1001, “the ’556 patent”). Utility Associates, Inc. (“Patent Owner”) filed a Preliminary Response (Paper 6, “Prelim. Resp.”) to the Petition. 35 U.S.C. § 314(a) provides that an *inter partes* review may not be instituted “unless . . . 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 set forth below, the Petition is *denied*, and no trial is instituted.

A. *Related Proceedings*

The parties indicate that the ’556 patent is the subject of the following co-pending district court case: *Utility Associates, Inc. v. Digital Ally, Inc.*, No. 1:14-cv-01847 (N.D. Ga.). Pet. 33; Paper 5, 2. Petitioner indicates that the ’556 patent is the subject of IPR2014-00725. Pet. 33.

B. *The ’556 Patent*

The ’556 patent relates to a surveillance system for capturing video, audio, and data information. Ex. 1001, col. 1, ll. 54–56. In particular, the ’556 patent sought to improve existing surveillance systems by replacing the videocassette recorder (“VCR”) with digital capture and storage technology. *Id.* at col. 1, ll. 13–43. The ’556 patent describes a surveillance system that captures information using, *inter alia*, video cameras, microphones, and sensors. *Id.* at col. 2, ll. 49–56, col. 3, ll. 44–49, col. 3, l. 56–col. 4, l. 11. The captured video, audio, and data information can be converted to digital format and then combined into one data stream using a multiplexer. *Id.* at col. 3, ll. 34–37, col. 3, ll. 41–44, col. 4, ll. 28–38. The data stream is stored in the surveillance system (*id.* at col. 4, ll. 36–38) and also can be

transmitted to another location (*id.* at col. 1, ll. 56–60, col. 5, ll. 45–53). For example, the surveillance system may transmit the data stream from a vehicle to a building. *Id.* The ’556 patent explains that the described surveillance system can be used for police, fire, and rescue vehicles, transportation vehicles, railroads, and airlines. *Id.* at col. 2, ll. 15–19.

C. *Illustrative Claim*

Claim 8 is the challenged claim and is reproduced below.

8. The surveillance system according to claim 7, wherein said computer processing unit includes a camera control device, for controlling at least one camera that supplies video information for the video capturing device, said camera control device being controlled by one of said computer processing unit and a computer processing unit of the second location via said wireless device.

Ex. 1001, col. 9, ll. 30–36.

D. *Evidence of Record*

Petitioner relies on the following references and declaration (*see* Pet. 16):

Reference or Declaration	Exhibit No.
Declaration of Schuyler Quackenbush, Ph.D.	Ex. 1003
US 6,246,320 B1 (“Monroe ’320”)	Ex. 1004
US 6,389,340 B1 (“Rayner”)	Ex. 1005

E. *Asserted Grounds of Unpatentability*

Petitioner asserts that claim 8 is unpatentable on the following ground (*see* Pet. 16):

Claim(s) Challenged	Basis	References(s)
8	35 U.S.C. § 103(a)	Monroe '320, Rayner, and the knowledge of one of ordinary skill in the art

II. ANALYSIS

Petitioner argues that claim 8 would have been obvious over Monroe '320, Rayner, and the knowledge of one of ordinary skill in the art. Pet. 16. Petitioner previously argued in IPR2014-00725 that claim 8 would have been obvious over Monroe '320 and Rayner. IPR2014-00725, Paper 2, 12. Petitioner contends that the prior art and arguments in the Petition are not the same or substantially the same as those in IPR2014-00725, because “the addition of the knowledge of one of ordinary skill in the art presents new arguments and art/evidence for claim 8 not raised or considered in the '725 IPR.” Pet. 4–5. Patent Owner argues that the Petition presents substantially the same prior art and arguments as those in IPR2014-00725, and thus should be denied. Prelim. Resp. 1. Patent Owner also argues that “[i]nstituting a trial on claim 8 in the present proceeding will require an examination of the grounds of unpatentability raised by Petitioner against claims 1, 2, 5, and 7.” *Id.* at 2.

“In determining whether to institute or order a proceeding . . . , the Director may take into account whether, and reject the petition or request because, the same or substantially the same prior art or arguments previously were presented to the Office.” 35 U.S.C. § 325(d). The only difference between the prior art and arguments presented in this Petition and those presented in IPR2014-00725 is that this Petition adds “the knowledge of one of ordinary skill in the art” to Monroe '320 and Rayner as the asserted ground of unpatentability for claim 8. Pet. 4–5. This same ground was

presented for dependent claim 7 in IPR2014-00725. IPR2014-00725, Paper 2, 13. Therefore, the Petition presents substantially the same prior art and arguments as those presented previously in IPR2014-00725.

Petitioner does not provide a reason why it could not have included “the knowledge of one of ordinary skill in the art” in the asserted ground of unpatentability for claim 8 in IPR2014-00725. Pet. 1–8. Further, we denied institution of an *inter partes* review of claim 8 in IPR2014-00725 on October 1, 2014. *Digital Ally, Inc. v. Utility Associates, Inc.*, Case IPR2014-00725, slip op. at 19–20 (Paper 7) (PTAB Oct. 1, 2014). Petitioner waited over eight months, until the proceeding in IPR2014-00725 was almost complete, before filing this Petition that requests another review based on substantially the same prior art and arguments. For the foregoing reasons, we exercise our discretion to deny the Petition under 35 U.S.C. §§ 314(a), 325(d).

III. CONCLUSION

For the foregoing reasons, we exercise our discretion to deny the Petition under 35 U.S.C. §§ 314(a), 325(d).

IV. ORDER

In consideration of the foregoing, it is hereby:

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

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Patent 6,831,556 B1

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