

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

FIRST ALERT, INC. and BRK BRANDS INC.,

Petitioners

v.

WALTER KIDDE PORTABLE EQUIPMENT, INC.,

Patent Owner

IPR2023-00896
Patent 7,123,158 B2

Before MEREDITH C. PETRAVICK, GREGG I. ANDERSON, and
ROBERT J. WEINSCHENK, *Administrative Patent Judges*.

ANDERSON, *Administrative Patent Judge*.

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

I. INTRODUCTION

First Alert, Inc. and BRK Brands Inc., (collectively “Petitioner”) filed a Petition requesting *inter partes* review of claims 1–7 and 12–15 of U.S. Patent No. 7,123,158 B2 (Ex. 1001, “the ’158 patent”). Paper 1, 6 (“Pet.”). Walter Kidde Portable Equipment, Inc., (“Patent Owner”) filed a Preliminary Response. Paper 9 (“Prelim. Resp.”).

We have authority under 35 U.S.C. § 314 to determine whether to institute *inter partes* review. Upon considering the record developed thus far, for reasons discussed below, **we do not institute *inter partes* review.**

II. BACKGROUND

A. *Real Parties in Interest*

Petitioner states it is a real party in interest and identifies Resideo Technologies, Inc. and Ademco Inc. “as additional parties that may be relevant to the determinations.” Pet. vii. Patent Owner asserts it is the real party in interest. Paper 5, 2 (Patent Owner’s Mandatory Notices).

B. *Related Matters*

Both parties list one pending lawsuit filed by Patent Owner asserting the ’158 patent against Petitioner in the Western District of Texas captioned *Walter Kidde Portable Equipment Inc. v. First Alert Inc. et al.*, No. 6:22-cv-566 (W.D. Tex.) (“Texas Litigation”). Pet. viii; Paper 5 (Patent Owner’s Mandatory Notices), 2.

In addition, we note *First Alert, Inc. and BRDK Brands Inc. v. Walter Kidde Portable Equipment, Inc.*, IPR2023-00898, an *inter partes* review proceeding between these same parties.

C. *The ’158 Patent*

The application for the ’158 patent was filed on August 12, 2004, issued on October 17, 2006, and claims priority to U.S. Provisional Patent

1. Background Technology

The '158 patent relates to “[e]lectronic devices that are powered by one or more batteries,” including for example “a battery powered life safety alarm.” Ex. 1001, 1:19–28. “The batteries in many battery powered life safety alarm are often replaceable so that when the battery power is sufficiently depleted, the user can remove the depleted batteries and install fresh batteries.” *Id.* at 1:35–37. Battery replacement can cause problems, including batteries that have insufficient power for proper alarm operation and improper installation or no installation. *Id.* at 1:44–48. If problems arise, the alarm will not function causing a potentially a dangerous situation. *Id.* at 1:48–50.

“Some battery operated alarms are designed so that the batteries are not replaceable.” Ex. 1001, 1:51–52. It is also known to have alarms that require subsequent reactivation, which may be repeated over time. *Id.* at 1:51–54. Other known alarm systems require manual activation before attachment to a mounting bracket. *Id.* at 1:56–58.

2. The Safety Alarm of the '158 patent

The '158 patent describes smoke alarm devices with batteries “sealed inside the alarm portion.” Ex. 1001, 2:2–3, 3:59–65. The '158 patent avoids any “user interaction, other than attaching the alarm portion to the mounting bracket” to “activate the alarm,” which prevents users from forgetting to activate the alarm. *Id.* at 2:25–28. The alarm can also “prevent reattachment of the alarm portion to the mounting bracket” upon permanent deactivation of the alarm portion. *Id.* at 2:31–36.

Figure 1 is reproduced below.

FIG. 1

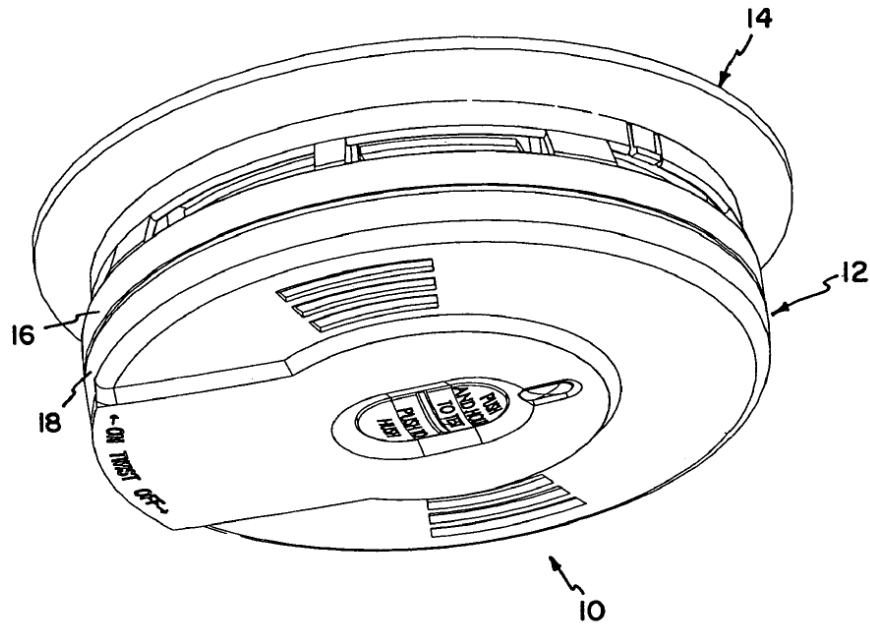


Figure 1 is a view of a perspective view of a smoke alarm.

Ex. 1001, 2:59–60. An alarm portion 12 is designed to be detachably connected to a mounting bracket 14. *Id.* at 4:14–15, 3:51–4:6, 4:13–14.

The alarm's activation and deactivation is controlled by an activate/deactivate system 33. Ex. 1001, 4:54–59. Figure 5 of the '158 patent is reproduced below.

FIG. 5

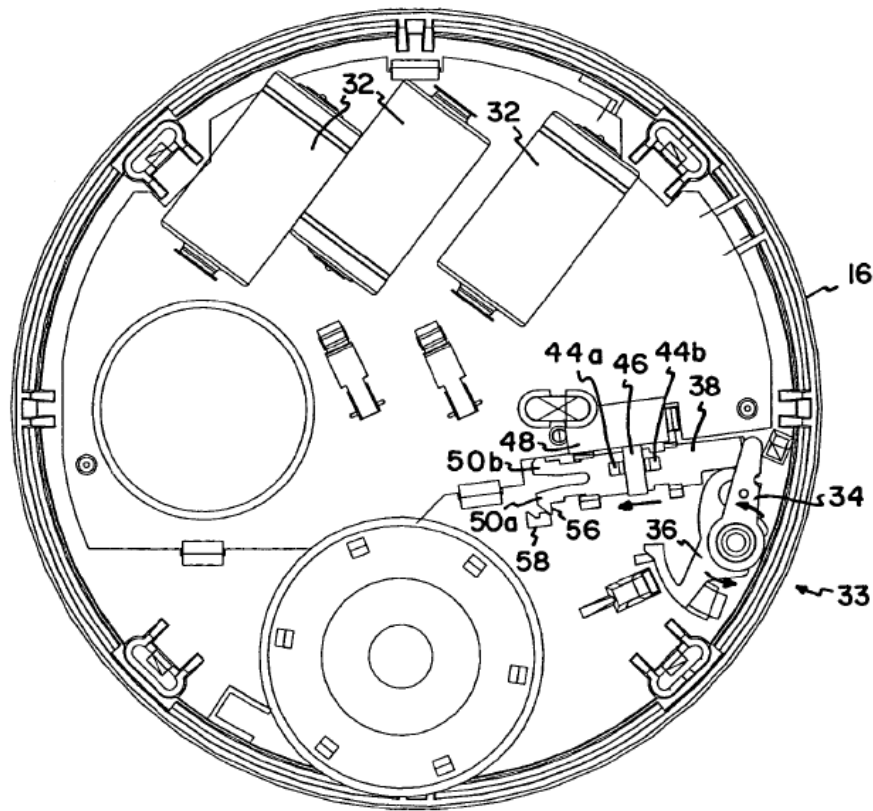


Figure 5 is a view of the interior of the alarm portion with the bottom enclosure removed and looking upward toward the alarm portion as it would be mounted on the mounting bracket.

Ex. 1001, 3:1–4. As shown in Figure 5, system 33 includes a rotate activate component 34, a rotate deactivate component 36, and an activate/deactivate slider 38. *Id.* at 4:61–67. The portion 12 is connected to the bracket 14 via a “twist on/twist off connection system of a type that is well known in smoke alarms.” Ex. 1001, 4:16–18. Attaching alarm portion 12 to bracket 14 automatically activates the alarm 10. *Id.* at 4:54–56.

When the alarm portion 12 is attached to bracket 14 a boss 41 “is engaged by a portion of one of bracket 14’s flanges . . . which actuates the boss 41.” Ex. 1001, 5:26–33. This actuation “causes rotation of the activate

component 34,” which causes slider 38’s movement to the ON position.” *Id.* Slider 38’s movement in turn causes a tab to activate a switch actuating switch 48 that activates the alarm. *Id.* at 5:34–44. When slider 38 is moved to the DEACTIVATED position, rotate deactivate component 36 “rotate[s] counterclockwise to a locked position. *Id.* at 6:31–49.

D. Illustrative Claim

Claims 1–7 and 12–15 of the ’158 patent are challenged. Pet. 5–6. Claims 1 and 12 are independent claims. Claims 2–7 depend from claim 1, and claims 13–15 depend from claim 12. Claim 1 is illustrative and is reproduced below.

[1Pre]¹ An electronic device, comprising:

[1a] a first portion;

[1b] a second portion configured for attachment to the first portion, the second portion including electronics to operate the device and at least one battery for powering the electronics; and

[1c] cooperating features on the first portion and the second portion that automatically activate the second portion upon initial attachment of the second portion to the first portion;

[1d] wherein the cooperating features comprise an activate/deactivate system, the activate/deactivate system being configured to automatically activate the second portion upon initial attachment of the second portion to the first portion;

¹ Petitioner uses the bracketed designations for the limitations of the claims. *See* Pet. 11 (limitations [1Pre] and [1a]). Patent Owner adopts this convention. *See* PO Prelim. Resp. 12 (limitations [1c] and [1d]). We adopt this convention for purposes of this Decision.

[1e] wherein the activate/deactivate system is configured to enable the user to manually deactivate the second portion; and

[1f] wherein, when deactivated, the second portion cannot be reactivated and the second portion cannot be reattached to the first portion.

Ex. 1001, 7:20–40.

E. Evidence of Record

This proceeding relies on the following prior art references and expert testimony:

DeLuca '487, US Patent No. 6,160,'487, issued December 12, 2000 (Ex. 1006, “DeLuca '487”).

Malewski, US Patent No. 6,433,700 B1, issued August 13, 2002 (Ex. 1007, “Malewski”).

Report of the Meeting of the Standards Technical Panel of UL for Smoke Detectors, March 7, 2003 (Ex. 1008, “STP2003”).

Byrne, EP 1,045,354 A2, published October 18, 2000 (Ex. 1009, (“Byrne '354”).

Byrne, UK 2,312,311 B, patent published April 19, 2000 (Ex. 1010, (“Byrne '311”).

Petitioner relies on the Declaration of John D. Pratt, Ph.D., P.E. in Support of Petition for *Inter Partes* Review (Ex. 1002, “Pratt Declaration”).

F. Asserted Grounds

Petitioner asserts the following grounds. Pet. 5–6.

Claim(s) Challenged	35 U.S.C. §	Reference(s)/Basis
1–7, 12–15	103 ²	STP2003
1–7, 12–15	103	Malewski
1–7, 12–15	103	Malewski and DeLuca ’487
1–7, 12–15	103	Malewski and STP2003
1–7, 12–15	103	Byrne ’354 and Byrne ’311
12–15	103	Byrne ’311 and DeLuca ’487

III. PATENTABILITY ANALYSIS

A. Level of Ordinary Skill in the Art

Relying on the Pratt Declaration, Petitioner contends a person of ordinary skill in the art as of “August 2003 had a Bachelor’s Degree in mechanical engineering or similar discipline.” Pet. 5 (citing Ex. 1002 ¶ 31). In addition, the person of ordinary skill “would have had knowledge of design considerations in the industry and would have been familiar with then-existing electro-mechanical products and solutions.” *Id.* (citing Ex. 1002 ¶ 31). Patent Owner “does not dispute” Petitioner’s proposal and does not propose a different level of ordinary skill. Prelim. Resp. 8.

² The Leahy-Smith America Invents Act (“AIA”), Pub. L. No. 112-129, 125 Stat. 284, 285–288 (2011), revised 35 U.S.C. § 103 effective March 16, 2013. Because the challenged patent was filed prior to March 16, 2013, we refer to the pre-AIA version of the statute. The findings and analysis in this Decision would be the same under the AIA version.

Petitioner’s proposal is consistent with the level of ordinary skill in the art reflected by the asserted prior art. *See Okajima v. Bourdeau*, 261 F.3d 1350, 1355 (Fed. Cir. 2001); *In re GPAC Inc.*, 57 F.3d 1573, 1579 (Fed. Cir. 1995). On this record, the level of ordinary skill is neither in dispute nor dispositive of any challenge. For purposes of this Decision, we apply Petitioner’s articulation.

B. Claim Construction

In an *inter partes* review, a claim shall be construed using the same claim construction standard that would be used to construe the claim in a civil action under 35 U.S.C. § 282(b), including construing the claim in accordance with the ordinary and customary meaning of such claim 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 (Fed. Cir. 2005) (en banc).

The District Court in the Texas Litigation issued a “Claim Construction Order” (“*Markman* Order”) on February 15, 2023. Ex. 1019. With some qualifiers not relevant here, the *Markman* Order applied the plain and ordinary meaning to all claim terms. *Id.* Petitioner cites the *Markman* Order and, “[f]or purposes of this proceeding,” applies the plain and ordinary meaning for all claim terms. Pet. 5 (citing Ex. 1019; Ex. 1020³). Patent Owner also cites to the *Markman* Order and agrees with application of the plain and ordinary meaning to all claim terms. Prelim. Resp. 8 (citing Ex. 1019; Ex. 2004⁴).

³ Texas Litigation “Joint Claim Construction Statement.”

⁴ Texas Litigation “Plaintiff’s Responsive Claim Construction Brief.”

We need not decide whether the “cooperating features” comprising “an activating/deactivating system” and “activate/deactivate system” terms are means plus function limitations because, regardless of their construction, Petitioner fails to show that any reference discloses the same or an equivalent structure.

On the record before us, we construe all claim terms to have their plain and ordinary meaning to a person of ordinary skill in the art.

C. Legal Standard for Obviousness

A patent claim is invalid as obvious 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.” 35 U.S.C. § 103(a).

The ultimate determination of obviousness is a question of law, but that determination is based on underlying factual findings. . . . The underlying factual findings include (1) “the scope and content of the prior art,” (2) “differences between the prior art and the claims at issue,” (3) “the level of ordinary skill in the pertinent art,” and (4) the presence of secondary considerations of nonobviousness such “as commercial success, long felt but unsolved needs, failure of others,” and unexpected results.

In re Nuvasive, Inc., 842 F.3d 1376, 1381 (Fed. Cir. 2016) (citing *inter alia* *Graham v. John Deere Co. of Kan. City*, 383 U.S. 1, 17–18 (1966)).

“To satisfy its burden of proving obviousness, a petitioner cannot employ mere conclusory statements. The petitioner must instead articulate specific reasoning, based on evidence of record, to support the legal conclusion of obviousness.” *In re Magnum Oil Tools Int’l, Ltd.*, 829 F.3d 1364, 1380 (Fed. Cir. 2016). Furthermore, in assessing the prior art, the

IPR2023-00896

Patent 7,123,158 B2

Board must consider whether a person of ordinary skill would have been motivated to combine the prior art to achieve the claimed invention.

Nuvasive, 842 F.3d at 1381.

As the Federal Circuit found, in quoting from the Supreme Court’s decision in *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 418–419 (2007),

“because inventions in most, if not all, instances rely upon building blocks long since uncovered, and claimed discoveries almost of necessity will be combinations of what, in some sense, is already known,” “it can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does.”

Personal Web Techs., LLC v. Apple, Inc., 848 F.3d 987, 991–92 (Fed. Cir. 2017).

D. Claims 1–7 and 12–15 as Obvious over STP2003

Petitioner alleges claims 1–7 and 12–15 would have been obvious over STP2003. Pet. 11–21. Petitioner also relies on the Pratt Declaration. Ex. 1002 ¶¶ 130–175.

1. STP2003 (Ex. 1008)

STP2003 is a report of a meeting of the Standards Technical Panel (STP) for Smoke Detectors and Alarms. Ex. 1008, 1. STP2003 discloses that “smoke alarms employing a non-replaceable primary battery be provided with both a means to activate the power and a means to deactivate the power when the batteries had reached the end of their useful life.” *Id.* at 6. STP2003 further discloses deactivation of such alarms “shall require the use of a tool, or equivalent, and shall render the unit incapable of being reinstalled.” *Id.* at 5–6.

2. *Claim 1*

Limitations [1c] and [1d] are at issue. Prelim. Resp. 9–13. The limitations recite respectively:

[1c] cooperating features on the first portion and the second portion that automatically activate the second portion upon initial attachment of the second portion to the first portion.

[1d] wherein the cooperating features comprise an *activate/deactivate system*, the activate/deactivate system being configured to *automatically activate* the second portion *upon initial attachment of the second portion to the first portion*.

See Section II.D above (emphasis added).

With respect to Limitation [1c], Petitioner cites to STP2003’s teaching of a “means to activate the power” of “non-replaceable battery smoke alarms.” Pet. 13 (citing Ex. 1008, 6). Petitioner says a person of ordinary skill in the art would understand STP2003’s “means to activate the power” would “include cooperating features on the first and second portions.” *Id.* (citing Ex. 1002 ¶¶ 137–139; Ex. 1001, 1:51–58; 1005, 2:51–53, 4:66–5:10, Fig. 7).

For Limitation [1d], Petitioner cites to STP2003’s teaching of “a means to activate the power and a means to deactivate the power when the batteries had reached the end of their useful life.” Pet. 13 (citing Ex. 1008, 6). Based on that teaching, Petitioner alleges a person of ordinary skill in the art would understand that “the first and second portions [would] automatically activate the second portion upon attachment.” *Id.* (citing

Ex. 1002 ¶¶ 140–142; Ex. 1013,⁵ 65:24–67:6; *see also* Ex. 1005,⁶ 2:51–53, 4:66–5:10, Fig. 7; Ex. 1001, 1:51–58).

As to STP2003, Patent Owner argues STP2003’s proposal of a “means to activate the power” does not teach the claimed “cooperating features.” Prelim. Resp. 9 (citing Pet. 13). Patent Owner disputes that Limitation [1c] would have been obvious over any of the evidence relied on by Petitioner. *Id.* at 9–11. Patent Owner specifically disputes that STP2003’s “means to activate power” upon attachment of the two portions, or Petitioner’s citations to the background of the ’158 patent, Watson or the Reinholtz Deposition, would have made obvious the cooperating features. Prelim. Resp. 10–11; *see also* Pet. 13–14 (citing Ex. 1001, 1:51–58; 1005, 2:51–53, 2:51–53, 4:66–5:18; Ex. 1013, 65:24–67:6, 106:10–107:13, 77:24–78:9, 79:12–17, 105:4–6). Patent Owner argues that Watson is not part of the asserted ground. Prelim. Resp. 10. Further, Patent Owner claims there is no showing of how Watson “would be implemented in a device contemplated by STP2003.” *Id.* Patent Owner argues the Reinholtz Deposition discusses a device that is not shown to be prior art. *Id.* Prelim. Resp. 11.

For similar reasons, Patent Owner also disputes the showing for Limitation [1d] as it relates to the “activate/deactivate system” or the “automatically activate the second portion” limitations of claim 1. Prelim. Resp. 12–13 (citing Prelim. Resp. 9–11 (argument that Limitation [1c] is not shown)). For example, Patent Owner notes that the Pratt Declaration acknowledges that “STP2003 does not disclose or suggest the structure

⁵ Texas Litigation, Deposition of Charles Frederick Reinholtz (Ex. 1013, “Reinholtz Deposition”).

⁶ Watson, US Patent No. 5,578,996, issued Nov. 26, 1996).

corresponding to its proposed ‘means to activate the power.’” *Id.* at 12 (citing Ex. 1002 ¶ 165 (“means” is a nonce/non-structural term)).

We agree with Patent Owner. As to both Limitations [1c] and [1d], Petitioner’s argument and evidence is too general to establish obviousness. *See* 37 C.F.R. §42.22(a)(2) (Petitioner must include “a detailed explanation of the significance of the evidence including material facts”). Petitioner cites to forty-four paragraphs of the Pratt Declaration, but does not explain how any of those paragraphs support its statement in the Petition. Pet. 14 (citing Ex. 1002 ¶¶ 103–112, 140–144, 35–40, 63–85); 37 C.F.R. § 42.104(b)(5) (“The Board may exclude or give no weight to evidence where a party has failed to state its relevance or to identify specific portions of the evidence that support the challenge.”).

STP2003 is directed to an alarm with non-replaceable batteries that can be activated and deactivated. *See, e.g.,* Ex. 1008, 6. However, there is no disclosure of how the function is accomplished. Specifically, Petitioner does not identify any portion of STP2003 that teaches cooperating features on the first portion and the second portion configured to automatically activate the second portion upon initial attachment of the second portion to the first portion. *See* Pet. 13–14. None of the evidence cited by Petitioner, including the background of the ’158 patent, Watson, nor the Reinholtz Deposition, remedy this deficiency. In particular, Petitioner does not explain why a person of ordinary skill in the art would have understood STP2003’s activation means to include the recited cooperating features. *See id.*

Petitioner has not sufficiently shown all limitations of claim 1 would have been obvious over STP2003.

3. *Claims 2–7*

Because Petitioner has not sufficiently shown all limitations of claim 1 over STP2003, there is also an insufficient showing that claims 2–7, all of which depend from claim 1, would have been obvious over STP2003.

4. *Claim 12*

Limitations [12c] and [12d], both of which recite an “activation mechanism,” are at issue. As it did for claim 1, Petitioner relies on STP2003’s disclosure of a “means to activate the power” as showing the “activation mechanism” recited in both limitations at issue. Pet. 19–20. Petitioner reaches the conclusion of obviousness based in part on the Pratt Declaration. *Id.* (citing Ex. 1002 ¶¶ 165–169).

As to Limitation [12d], Dr. Pratt testifies a person of ordinary skill in the art “would understand that single-use activation and deactivation means would have the effect of permanently deactivating the alarm.” Ex. 1002 ¶ 166. Further, the Pratt Declaration asserts that “[t]he deactivation means shall also serve to completely discharge the battery(ies),” meeting the “permanent deactivation mechanism” required by Limitation [12d]. *Id.* ¶ 167 (quoting Ex. 1008, 6). Last, the Pratt Declaration, relying on STP2003’s disclosure that “deactivation means shall require the use of a tool, or equivalent,” opines that “tool or equivalent suggests the deactivation means described in STP2003 are accessible when the first and second portions are detached.” *Id.* ¶ 169 (citing Ex. 1008, 6).

Patent Owner disputes Petitioner’s showing of an “activation mechanism,” arguing a mechanical device is required for “activating the alleged second portion.” Prelim. Resp. 14. As it did for claim 1, Patent Owner argues that STP2003 lacks any description of how the function disclosed is performed. *Id.* at 14. Patent Owner cites to the Specification of

the '158 patent describing the “activate component” as including a tab to activate a switch to activate the alarm. *Id.* (citing Ex. 1001, 5:36–42); *see also* Ex. 1001, 5:16–25 (“activate component” further described).

We are not persuaded that the teaching of functionality in STP2003 is sufficient to show the mechanism recited in Limitations [12c] or [12d]. Relevant to Limitation [12c], the Pratt Declaration includes testimony that a person of ordinary skill in the art would understand “‘means to activate the power’ of a smoke alarm would include an activation mechanism.” Ex. 1002 ¶ 165 (citing Ex. 1018⁷ § 2181 (“mechanism” is often a nonce word substitute for the word “means.”)).

The Pratt Declaration is conclusory in that it includes no more than an ultimate opinion on obviousness in the form of what a person of ordinary skill would have understood is required for an “activation mechanism.” That STP2003 discloses “use of a tool, or equivalent” does not add to the showing because there is no description of the “tool” or what or how it would be used in conjunction with the undescribed “mechanism.”

Further, Petitioner’s reliance on MPEP § 2181 is not persuasive. MPEP § 2181 indicates that the term “mechanism” in some circumstances “may invoke 35 U.S.C. 112(f).” Ex. 1018, 2. But MPEP § 2181 does not indicate that the terms “means” and “mechanism” are synonymous. *See id.* Nor does it demonstrate that a person of ordinary skill in the art would have understood the term “means” in the context of STP2003 to refer to a mechanism. *See id.*

Petitioner has not sufficiently shown all limitations of claim 12 would have been obvious over STP2003.

⁷ Manual of Patent Examining Procedure (“MPEP”).

5. *Claims 13–15*

Because Petitioner has not sufficiently shown all limitations of claim 12 over STP2003, there is also an insufficient showing that claims 13–15, all of which depend from claim 12, would have been obvious over STP2003.

6. *Conclusion*

Petitioner has not shown a reasonable likelihood that claims 1–7 and 12–15 would have been obvious over STP2003.

E. Claims 1–7 and 12–15 as Obvious over Malewski

Petitioner alleges claims 1–7 and 12–15 would have been obvious over Malewski. Pet. 22–37. Petitioner also relies on the Pratt Declaration. Ex. 1002 ¶¶ 176–289.

1. *Malewski*⁸ (Ex. 1007)

Malewski provides a device with “a repetitively useable on/off switch which is engaged or disengaged whenever the device/detector is installed or uninstalled.” Ex. 1007, 1:5–10. The necessary circuitry is “disposed in a circuit board 20, which also is adapted to secure batteries 22 thereto.” *Id.* at 5:1–4.

A major portion of the detector “is designed for contact and mating with . . . a surface-mountable bracket” which retains the major portion.” Ex. 1007, 3:32–35. “The mating, which is achieved by both contact and rotation (two steps) of the device's two mentioned portions” attaches securely the two and “effects simultaneous switch activation.” *Id.* at 3:35–40.

Malewski provides four embodiments of its hazard device. *See* Ex. 1007, 3:65–2:53 (Figures 1, 5, 8, and 11 each describing separate

⁸ Malewski incorporates Watson (US Pat. No. 5,578,996, issued November 26, 1996 (Ex. 1005, “Watson”) by reference. Ex. 1007, 2:35–36.

embodiments). Figures 1 through 10 depict the first three embodiments. *Id.* at 5:34–38 (“FIG. 2, like FIG. 1, depicts structure that is common to three disclosed embodiments of the invention; it is presented to illustrate the mated condition of two portions of a detector that features the instant invention; it is presented to illustrate the mated condition of two portions of a detector that features the instant invention.”). “[W]hen base 14 is aligned with and guided into bracket 12, and mated so as to interleave tab pairs 36,37, the two portions (EPS-base and its bracket) complete the operative unit.” *Id.* at 5:29–33. Figure 4 of the first embodiment shows how once mating has been accomplished “continuity is restored to the circuit and the device is active electrically.” *Id.* at 5:55–61.

In its fourth embodiment, shown in Figures 11–20, Malewski enables activation and deactivation of the device via an “activation key 60.” *Id.* at 7:51–53 (activation key 60), 7:66–8:9. Figure 17 of the fourth embodiment is reproduced below.

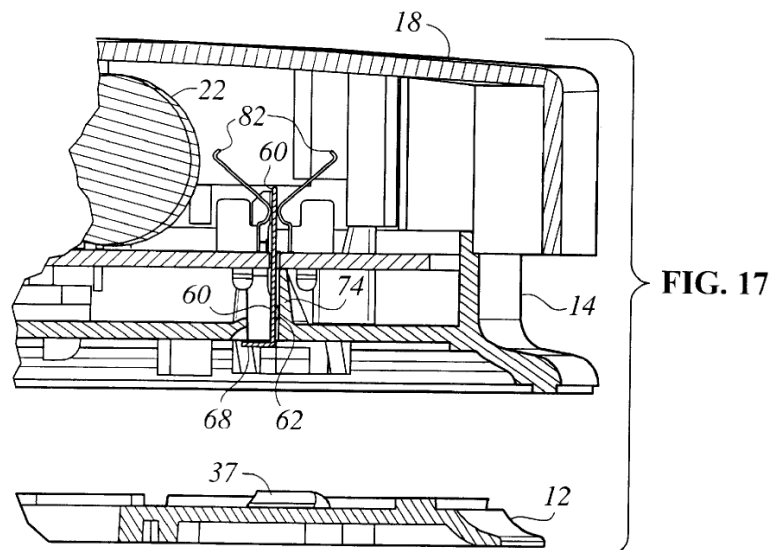


Figure 17 is an expanded sectional elevation showing the activation key of fourth embodiment in the on (activated)

position mounting bracket.

Ex. 1007, 4:42–44. The fourth embodiment includes “mounting bracket 12, base 14, EPS section 16, protective cover 18 and a switch that is used to activate the device (i.e. make a connection with electrical power).” *Id.* at 4:64–65 (EPS (electronics/power/sensor)), 6:61–65. The activation key 60 and four spring contacts 82 are mounted on printed circuit board 20. *Id.* at 6:66–7:2. When the key 60 is pushed in to the on position, the alarm base can be mounted to the mounting bracket. *Id.* at 8:7–9.

Figure 16 of the fourth embodiment is reproduced below.

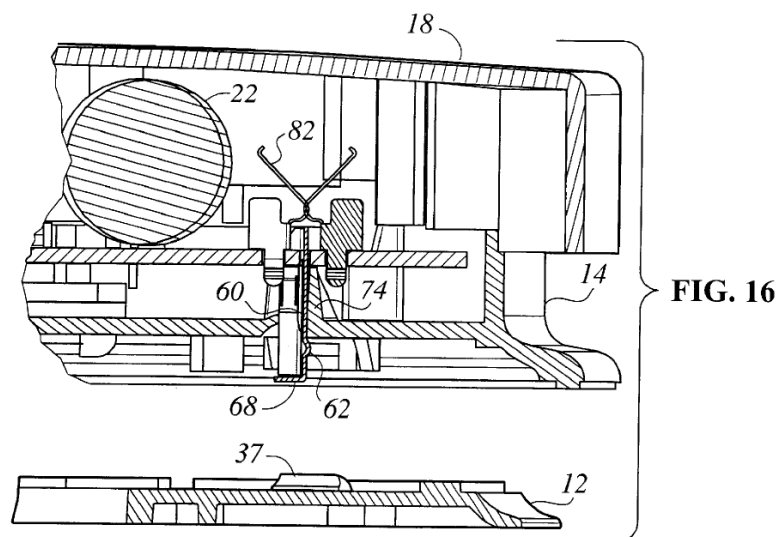


Figure 16 is an expanded sectional elevation showing the activation key of fourth embodiment in the off (deactivated) position.

Ex. 1007, 4:39–41. When the key 60 is in the off position, “bottom ledge 68 protrudes from base 14, where it interferes with making a bayonet-type connection between base 14 and mounting bracket 12.” *Id.* at 8:4–7.

2. *Claim 1*

Limitations [1c], [1d], and [1f] are at issue. Prelim. Resp. 24–32.

Limitations [1c] and [1d]

For Limitation [1c] reciting, in pertinent part, “automatically activate the second portion,” Petitioner cites the mating between the “major portion” and the “surface mountable bracket.” Pet. 24 (citing Ex. 1007, 3:24–42; Ex. 1002 ¶ 190). Petitioner argues that the mating “effects simultaneous switch activation.” *Id.* (citing Ex. 1007, 3:24–42; Ex. 1002 ¶¶ 190–193, 35–40, 63–85).

For Limitation [1d] reciting, in pertinent part, “an activate/deactivate system,” Petitioner argues “Malewski teaches a deactivation mechanism that deactivates the device ‘merely by applying a single counter rotation motion to its protective cover.’” Pet. 25 (citing Ex. 1007, 3:49–50; Ex. 1002 ¶ 196). Malewski is also cited by Petitioner for its teaching of an activation key to activate and deactivate the circuit. *Id.* (citing Ex. 1007, 7:6–11, 7:29–30, 7:51–8:2, 8:11–15; Ex. 1002 ¶ 196).

Patent Owner first argues Petitioner improperly

combines Malewski’s different embodiments without explaining how these embodiments would disclose (or be combined to disclose) a single device (1) that is configured to “automatically activate the second portion” (limitations [1c]/[1d]) and (2) where the “second portion cannot be reattached to the first portion” upon permanent deactivation (limitation [1f]).

Prelim. Resp. 22–24. Stated slightly differently, Patent Owner argues as to Limitations [1c] and [1d] that activation is based on the first three embodiments of Malewski’s Figures 1 through 10. Deactivation and inability to reattach is based on the fourth embodiment of Figures 11–20.

Patent Owner argues

Petitioner fails to explain why Malewski's mating-based activation embodiments would be combined with the activation key-based embodiment and how such a combination would satisfy both limitations of the same device. *See Abiomed, Inc. v. Maquet Cardiovascular, LLC*, IPR2017-01204, Paper 9 at 8–12 (PTAB Oct. 23, 2017) (denying institution where no explanation provided for how different embodiments of a reference were interchangeable or why a [person of ordinary skill in the art] would have found it obvious to combine their respective teachings).

Prelim. Resp. 23.

We agree with Patent Owner that the record fails to support sufficient reasoning as to why the various embodiments of Malewski would have been combined to meet the Limitations [1c] and [1d].

We have reviewed paragraphs 190 through 200, which is the testimony of Dr. Pratt regarding the two limitations. None of it provides any reasoning as to why Malewski's separate embodiments would have been combined to show either limitation.

Limitation [1f]

Limitation [1f] recites, in pertinent part, “when deactivated, the second portion cannot be reactivated and the second portion cannot be reattached.” Petitioner cites Malewski's teaching that “describes permanent deactivation through a ‘single-use, frangible, and rotatable switch mechanism.’” Pet. 27 (citing Ex. 1007, 1:35–58; Ex. 1002 ¶¶ 206–207). Petitioner alleges such a “single-use” would mean “it is not possible to activate the electronic device a second time (i.e. it cannot be reactivated).” *Id.* (citing Ex. 1002 ¶¶ 207–212; Ex. 1005, 2:35–43, 4:9–11, 4:44–56).

As to the “cannot be reattached” recitation in Limitation [1f], Petitioner argues Watson teaches discarding parts of the switch after the end of its useful life, “mean[ing] it is not possible to activate the electronic device a second time (i.e. it cannot be reactivated).” Pet. at 27 (citing Ex. 1005, 2:35–43, 4:9–11, 4:44–56; Ex. 1002 ¶¶ 207–212). Petitioner argues Malewski’s second portion cannot be reattached to the first portion because withdrawing the activation key 60 to the “‘off position,’ interferes ‘with making the bayonet-type connection between the base 14 and mounting bracket 12,’ and therefore renders the device incapable of remounting.” *Id.* at. 27–28 (citing Ex. 1007, 7:51–8:9; Ex. 1002 ¶ 213). In further support of its argument, Petitioner provides annotations of Figures 16 and 17 of Malewski. *Id.* at 28 (citing Ex. 1007, Figs. 16 and 17 (annotations reproduced at Pet. 28)).

Patent Owner argues Malewski does not prevent reactivation. Prelim. Resp. 24. As to Watson, Patent Owner argues “incorporation does not demonstrate that Malewski’s device would necessarily implement the features of Watson’s device.” *Id.* at 25 (citing *Modine Mfg. Co. v. United States ITC*, 75 F.3d 1545, 1553 (Fed. Cir. 1996) (“incorporation by reference does not convert the invention of the incorporated patent into the invention of the host patent”)).

Patent Owner further argues Malewski and Watson are “incompatible and would not be combined.” Prelim. Resp. 26–27. According to Patent Owner, this is because Watson is a single use device whereas Malewski may be used repeatedly. *Id.* at 26 (citing Ex. 1005, 1:5–10, 4:45–56; Ex. 1007, 1:50–58, 3:13–17).

Malewski does not teach that the alarm cannot be reactivated after it is deactivated, as Limitation[1f] requires. Malewski enables activation and

deactivation of the device via the “activation key 60.” Ex. 1007, 7:51–53 (activation key 60), 7:66–8:9, Fig. 17. The switch 60 of Malewski may be moved to an “ON” position. Malewski therefore does not prevent reactivation when the key allows reattachment. *See* Prelim. Resp. 31 (citing Ex. 1007, 7:66–8:9).

Concerning the prevention of reattachment recited in Limitation [1f], Patent Owner repeats its multiple embodiment argument made in connection with Limitations [1c] and [1d]. Prelim. Resp. 27. Moreover, as already discussed, Patent Owner argues Malewski does not prevent reactivation and thus does not prevent reattachment. *Id.* at 28–32 (citing Prelim. Resp. 24). Patent Owner also argues that Petitioner improperly incorporates testimony from the Pratt Declaration into the Petitioner. *Id.* at 33–34 (citing Prelim. Resp. 63–67 (regarding improper and “expansive” incorporation by reference)).

We agree with Patent Owner that the portions of Malewski cited by Petitioner do not indicate that the key prevents a user from installing a detector that is permanently deactivated. *See* Pet. 27–29 (citing Ex. 1007, 1:35–58, 7:51–8:9). In fact, Petitioner does not explain what prevents a user from simply pushing the key in a permanently-deactivated detector to the on position and then reattaching it to the bracket. *Id.*

Although Malewski incorporates Watson by reference for its “showing of [the] current state-of-the-art.” (Ex. 1007, 2:35–38), Malewski and Watson describe different devices. Watson describes a detector with a single-use switch that permanently drains the detector’s battery. *Id.* at 1:35–43, 1:50–54. In contrast, Malewski sought to improve upon Watson by providing a detector with “an on/off switching mechanism” that “can be used, repeatedly, to activate/deactivate” the detector. *Id.* at 1:54–58, 3:13–

17. Petitioner does not explain why a person of ordinary skill in the art would have combined Malewski’s detector that includes a multiple-use on/off switch with Watson’s single-use deactivation switch. *See* Pet. 27–29; *In re Stepan Co.*, 868 F.3d 1342, 1346 n.1 (Fed. Cir. 2017) (“Whether a rejection is based on combining disclosures from multiple references [or] combining multiple embodiments from a single reference, . . . there must be a motivation to make the combination.”).

While discarding the device, as Watson teaches, prevents reinstallation, we are not persuaded that a person of ordinary skill in the art would understand that the two would have been combined in the manner Petitioner proposes. Indeed, Malewski’s description of how Watson accomplishes permanent deactivation, discarding the unit altogether, explains that Watson is “silent” as to “whether the switch is capable of . . . allow[ing] the unit’s deactivation for removal, storage, and later movement to alternate locations.” Ex. 1007, 1:55–58.

Petitioner has not sufficiently shown all limitations of claim 1 would have been obvious over Malewski.

3. *Claims 2–7*

Because Petitioner has not sufficiently shown all limitations of claim 1 over Malewski, there is also an insufficient showing that claims 2–7, all of which depend from claim 1, would have been obvious over Malewski.

4. *Claim 12*

Limitations [12d] and [12e] are at issue. Prelim. Resp. 34–36.

Limitation [12d] recites in pertinent part “a permanent deactivation mechanism to permit permanent deactivation of the second portion after the second portion has been activated.” Petitioner’s argument is all but the same as the argument made in connection with Limitation [1f] above. *Compare*

Pet. 27–29 (Limitation [1f]) *with* Pet. 35 (Limitation 12d)). Patent Owner’s arguments are also similar. *See* Prelim. Resp. 15–16.

Limitation [12e] recites in pertinent part “a reattachment prevention mechanism to prevent reattachment of the first and second portions once the second portion is permanently deactivated.” Petitioner’s argument is all but the same as the argument made in connection with Limitation [1f] above.

Compare Pet. 27–29 (Limitation [1f]) *with* Pet. 35–36 (Limitation [12e]).

Patent Owner’s arguments are also similar. *See* Prelim. Resp. 15–16.

For the reasons discussed in connection with Limitation [1f], we find that Petitioner has not sufficiently shown all limitations of claim 12 would have been obvious over Malewski.

5. Claims 13–15

Because Petitioner has not sufficiently shown all limitations of claim 12 over Malewski, there is also an insufficient showing that claims 13–15, all of which depend from claim 12, would have been obvious over Malewski.

6. Conclusion

Petitioner has not shown a reasonable likelihood that claims 1–7 and 12–15 would have been obvious over Malewski.

F. Obviousness of Claims 1–7 and 12–15 over Malewski and DeLuca ’487

Petitioner alleges claims 1–7 and 12–15 would have been obvious over Malewski and DeLuca ’487. Pet. 37–46. Petitioner also relies on the Pratt Declaration. Ex. 1002 ¶¶ 290–335.

1. Malewski (Ex. 1007)

Malewski was described in Section III.E.1 above.

2. DeLuca '487 (Ex. 1006)

DeLuca '487 relates to a smoke detector with replaceable batteries that includes a base and mounting bracket. Ex. 1006, 1:64–2:44. The base includes a battery compartment with a “single battery lockout mechanism” that “actuates from an obstructing to a non-obstructing position” when batteries are inserted into the compartment. *Id.* at 2:9–31. Because a spring biases the lockout actuator to the obstructing position, the insertion of the correct number of batteries in the battery compartment causes “the action of the spring” that allows “the lockout actuator” to move to “the non-obstructing position,” which allows mounting the base to the mounting bracket. *Id.* at 2:16–31.

3. Claim 1

Limitations [1c], [1d], and [1f] are at issue. Prelim. Resp. 42–44.

Petitioner repeats its arguments based on Malewski for Limitations [1c] and [1d] for this ground. Pet. 40–41. Patent Owner cites to its arguments in response. Prelim. Resp. 42.

For the reasons discussed in Section III.E.2 above, we find that Petitioner has not sufficiently shown all limitations of claim 1 would have been obvious over Malewski and DeLuca '487.

4. Claims 2–7

Because Petitioner has not sufficiently shown all limitations of claim 1 over Malewski and DeLuca '487, there is also an insufficient showing that claims 2–7, all of which depend from claim 1, would have been obvious over Malewski and DeLuca '487.

5. Claim 12

Limitations [12d] and [12e] are at issue. Prelim. Resp. 45–46.

Petitioner repeats its arguments based on Malewski for Limitation [12d]. Pet. 44; *see* Section III.E.4 above. Patent Owner cites to its prior arguments in response. Prelim. Resp. 45.

For the reasons discussed in Section III.E.4 above, we find that Petitioner has not sufficiently shown all limitations of claim 12 would have been obvious over Malewski and DeLuca '487.

6. Claims 13–15

Because Petitioner has not sufficiently shown all limitations of claim 12 over Malewski and DeLuca '487, there is also an insufficient showing that claims 13–15, all of which depend from claim 12, would have been obvious over Malewski and DeLuca '487.

7. Conclusion

Petitioner has not shown a reasonable likelihood that claims 1–7 and 12–15 would have been obvious over Malewski and DeLuca '487.

G. Obviousness of Claims 1–7 and 12–15 over Malewski and STP2003

Petitioner alleges claims 1–7 and 12–15 would have been obvious over Malewski and DeLuca '487. Pet. 37–46. Petitioner also relies on the Pratt Declaration. Ex. 1002 ¶¶ 336–366.

1. Malewski (Ex. 1007)

Malewski was described in Section III.E.1 above.

2. STP2003 (Ex. 1006)

STP2003 was described in Section III.D.1 above.

3. Claim 1

Limitations [1c], [1d], and [1f] are at issue. Prelim. Resp. 47.

Petitioner repeats its arguments based on Malewski for Limitation [1c] and [1d]. Pet. 48; *see* Section III.E.2 above. Patent Owner cites to its prior arguments in response. Prelim. Resp. 47.

For the reasons discussed in Section III.E.2 above, we find that Petitioner has not sufficiently shown all limitations of claim 1 would have been obvious over Malewski and STP2003.

4. *Claims 2–7*

Because Petitioner has not sufficiently shown all limitations of claim 1 over Malewski and STP2003, there is also an insufficient showing that claims 2–7, all of which depend from claim 1, would have been obvious over Malewski and STP2003.

5. *Claim 12*

Limitations [12d] and [12e] are at issue. Prelim. Resp. 45–46.

Petitioner repeats its arguments based on Malewski for Limitation [12d]. Pet. 44; *see* Section III.E.4 above. Patent Owner cites to its prior arguments in response. Prelim. Resp. 45.

For the reasons discussed in Section III.E.4 above, we find that Petitioner has not sufficiently shown all limitations of claim 12 would have been obvious over Malewski and DeLuca '487.

6. *Claims 13–15*

Because Petitioner has not sufficiently shown all limitations of claim 12 over Malewski and STP2003, there is also an insufficient showing that claims 13–15, all of which depend from claim 12, would have been obvious over Malewski and STP2003.

7. *Conclusion*

Petitioner has not shown a reasonable likelihood that claims 1–7 and 12–15 would have been obvious over Malewski and STP2003.

H. Obviousness of Claims 1–7 and 12–15 over Byrne ’354 and Byrne ’311

Petitioner alleges claims 1–7 and 12–15 would have been obvious over Byrne ’354 and Byrne ’311. Pet. 54–46. Petitioner also relies on the Pratt Declaration. Ex. 1002 ¶¶ 367–411.

1. Byrne ’354 (Ex. 1009)

Byrne ’354 discloses an alarm with replaceable batteries “which may be opened after installation in a simpler and more convenient manner” while “minimi[z]ing possible exposure to mains supply.” Ex. 1009 ¶ 4. To replace the battery, the user “disengages the fixtures” using “a screwdriver and pushes the alarm body” in the opposite direction until the lips “disengage from the sides of the apertures” and the “terminal spades” have “separated from the alarm body terminals in the base.” *Id.* ¶ 32.

2. Byrne ’311 (Ex. 1010)

Byrne ’311 discloses a single-piece alarm device with a sealed battery, noting that its device includes a battery chamber “within which the battery is located to prevent user access to the battery.” Ex. 1010, 2:12–14. When the battery has reached the end of its life, a user uses a sharp tool to “cut a piece of wire” to “prevent battery-low indications being emitted after” the detector “has been discarded.” *Id.* at 6:21–24, 1:25–29.

3. Claim 1

Limitation [1f] is at issue. Prelim. Resp. 54–56.

Limitation [1f] recites, in pertinent part, “when deactivated, the second portion cannot be reactivated and the second portion cannot be reattached.” Petitioner quotes Byrne ’311’s teaching that “[f]or deactivation of the control circuit, the user must simply cut a piece of wire which is clearly presented’ upon engagement of the one-way deactivation

switch.” Pet. 59 (citing Ex. 1010, 6:21–24, 5:4–9). Petitioner also cites to Byrne ’354 for an alarm having a base and a body where attaching the alarm body to the base “causes the terminal spades 39 to enter the mouths 32 and 35 of the alarm body terminals to create an electrical connection.” *Id.* (citing Ex. 1009 ¶ 31; Ex. 1002 ¶ 379).

Petitioner concludes that a person of ordinary skill in the art would understand that the combined teachings of Byrne ’354 and Byrne ’311 teach this limitation. Pet. 59 (citing Ex. 1002 ¶¶ 380–834). Petitioner argues Burns ’311 teaches deactivation by disabling the power source of the alarm which “could be applied to the alarm of Byrne ’354” and the alarm body could not be reattached. *Id.* at 59–60 (citing Ex. 1010, 5:4–9; Ex. 1009 ¶ 28; Ex. 1002 ¶¶ 378–384).

Patent Owner argues that “Petitioner provides no reason why a [person of ordinary skill in the art] would incorporate Byrne ’311’s wire-cutting into Byrne ’354’s alarm.” Prelim. Resp. 54. Patent Owner also points out that there is no reason to do so because Byrne ’311 involves “devices with sealed batteries (that cannot be removed), such that there is a perceived need to eliminate the emission of battery low indications by permanently disabling (via the described wire-cutting) the connection between the power source and the alarm’s control circuit of the alarm when the battery is low.” *Id.* Patent Owner contrasts Byrne ’354 as a device with “replaceable batteries and its base is intended to be reused, such that Byrne ’311’s wire-cutting would prevent the alarm from being operated after battery replacement.” *Id.* at 54–55.

Patent Owner also argues the wire cutting deactivation process does not prevent reattachment in the Byrne ’354 device. Prelim. Resp. 55 (citing Pet. 59 (citing Ex. 1010, 5:15–19)). Further, Patent Owner argues the wire

cutting may make the combination nonfunctional because the first and second portions cannot be reattached. *Id.* Last, Patent Owner argues that the Pratt Declaration at paragraphs 380 and 381 improperly incorporates various documents and, based on the documents, incorrectly concludes that “a smoke detector deactivated as disclosed in Byrne ’311 cannot be mounted while appearing operational.” *Id.* (citing Ex. 1002 ¶ 383).

Beyond its conclusory allegation, Petitioner has not shown that a person of ordinary skill in the art would combine Byrne ’311 and Byrne ’354 where one has sealed batteries and the other has replaceable batteries. Petitioner does not explain why a person of ordinary skill in the art would have combined a reference that has sealed batteries with one that has replaceable batteries. *See* Pet. 54–559; *In re Stepan Co.*, 868 F.3d 1342, 1346 n.1 (Fed. Cir. 2017) (“Whether a rejection is based on combining disclosures from multiple references [or] combining multiple embodiments from a single reference, . . . there must be a motivation to make the combination.”). Neither has Petitioner shown that reattachment of the Byrne ’354 device is prevented when wires are cut in Byrne ’311’s device. Specifically, Petitioner does not explain what prevents a user from reattaching the deactivated alarm body to the base using the connection apertures and fastener taught by Byrne ’354. *See* Pet. 57–60.

Petitioner appears to assert, alternatively, that a person of ordinary skill in the art would have been “inspire[d]” to add “a mounting prevention function, such as those known in the art” to the Byrne ’354 and Byrne ’311 combination to “prevent[] deactivated and non-operational alarms from being mounted.” Pet. 55 (citing Ex. 1002 ¶¶ 370–384, 35–40, 63–85). Petitioner, however, does not provide sufficient reasoning to support that assertion. Namely, Petitioner does not identify any specific mounting

prevention function that is known in the art. *See id.* Nor does Petitioner explain how such a mounting prevention function would have been combined with the Byrne ’354 and Byrne ’311 combination. *See id.*; *Personal Web Techs., LLC v. Apple, Inc.*, 848 F.3d 987, 994 (Fed. Cir. 2017) (explanation of how the combination worked is required). Further, Petitioner cites to forty-four paragraphs of the Pratt Declaration, but does not explain how any of those paragraphs support its assertion in the Petition. *See id.* (citing Ex. 1002 ¶¶ 370–384, 35–40, 63–85); 37 C.F.R. § 42.104(b)(5).

For the reasons discussed above, we find that Petitioner has not sufficiently shown all limitations of claim 1 would have been obvious over Byrne ’354 and Byrne ’311.

4. Claims 2–7

Because Petitioner has not sufficiently shown all limitations of claim 1 over Byrne ’354 and Byrne ’311, there is also an insufficient showing that claims 2–7, all of which depend from claim 1, would have been obvious over Byrne ’354 and Byrne ’311.

5 Claim 12

Limitation [12e] is at issue. Prelim. Resp. 56–58.

Limitation [12e] recites in pertinent part “a reattachment prevention mechanism to prevent reattachment of the first and second portions once the second portion is permanently deactivated.” Petitioner cites to Byrne ’311’s and quotes the Pratt Declaration that “cutting of a wire is to the user clearly a destructive operation and is not reversible.” Pet. 65 (citing Ex. 1010, 5:4–9; quoting Ex. 1002 ¶ 402). Petitioner contends that “a user physically disabling the connection between the power source and the control circuit of

the alarm,” as taught by Byrne ’311 could be applied to the alarm of Byrne ’354. *Id.* (citing Ex. 1002

¶ 404). Petitioner concludes that “the combined teachings of Byrne ’354 and Byrne ’311 teach that this physical disabling of the connection between the power source may result in an alarm body (i.e. second portion) that is not capable of reattachment to the base (i.e. first portion) once deactivated.” *Id.* (citing Ex. 1002 ¶¶ 402–408).

Patent Owner argues that Byrne ’311 has only an “one-way OFF switch that exposes a wire that can be cut (which is identical to Petitioner’s mapping for [12d]).” Prelim. Resp. 56 (citing Pet. 65–66). Patent Owner argues that Limitation [12e] “recites separate mechanisms for permanent deactivation and reattachment prevention” the OFF switch cannot be both. *Id.*

In addition, Patent Owner argues Byrne ’311’s wire cutting does not prevent reattachment. Prelim. Resp. 56 (citing Ex. 1010, 1:25–29). Next Patent Owner argues Byrne ’354’s connection between the base and alarm body does not “each or suggest any reattachment prevention.” *Id.* at 57. As to the combination of Byrne ’354 and Byrne ’311, Patent Owner argues there is no reason articulated by Petitioner as to why a person of ordinary skill would do so. *Id.* (citing Patent Owners making similar argument regarding claim 1). As with claim 1, Patent Owner disputes the propriety of incorporating various documents by reference in the Pratt Declaration and its conclusory assertions that reattachment would be prevented. *Id.* at 57–58.

As with claim 1’s showing, Petitioner has not explained, beyond its conclusory allegation based on the Pratt Declaration, how or why a person of ordinary skill in the art would combine Byrne ’311 and Byrne ’354 to prevent reattachment of the Byrne ’354 device. Neither has Petitioner

shown that there would be any reason to do so. Also, as discussed above, Petitioner has not shown that reattachment of the Byrne '354 device is prevented when wires are cut in Byrne '311's device. Specifically, Petitioner does not explain what prevents a user from reattaching the deactivated alarm body to the base using the connection apertures and fastener taught by Byrne '354. *See* Pet. 57–60.

For the reasons discussed above, we find that Petitioner has not sufficiently shown all limitations of claim 12 would have been obvious over Byrne '354 and Byrne '311.

6. Claims 13–15

Because Petitioner has not sufficiently shown all limitations of claim 12 over Byrne '354 and Byrne '311, there is also an insufficient showing that claims 2–7, all of which depend from claim 1, would have been obvious over Byrne '354 and Byrne '311.

7. Conclusion

Petitioner has not shown a reasonable likelihood that claims 1–7 and 12–15 would have been obvious over Byrne '354 and Byrne '311.

I. Obviousness of Claims 12–15 over Byrne '311 and DeLuca '487

Petitioner alleges claims 1–7 and 12–15 would have been obvious over Byrne '354 and Byrne '311. Pet. 54–46. Petitioner also relies on the Pratt Declaration. Ex. 1002 ¶¶ 412–435.

1. Byrne '311 (Ex. 1010)

Byrne '311 was described in Section III.H.2 above.

2. DeLuca '487 (Ex. 1006)

DeLuca '487 was described in Section III.F.2 above.

3. Claim 12

Limitation [12e] is at issue. Prelim. Resp. 62–63.

Petitioner argues “Byrne ’311 does not describe how the alarm device is mounted to a wall or ceiling, leading a [person of ordinary skill in the art] to look to other alarm devices to find a mounting solution.” Pet. 70–71 (citing Ex. 1002 ¶¶ 428–429). DeLuca ’487 is cited by Petitioner for its lockout mechanism which would “prevent users from installing a non-operational alarm, such as the deactivated, destroyed alarm of Byrne ’311.” *Id.* at 71 (citing Ex. 1002 ¶¶ 428–431).

We agree with Patent Owner that “DeLuca ’487’s lockout actuator would allow reattachment of the first and second portions, even when the alleged second portion is permanently deactivated.” *See* Prelim. Resp. 63. The portions of DeLuca ’487 cited by Petitioner do not indicate that the lockout mechanism prevents reattachment of a base that is permanently deactivated. *See* Pet. 71 (citing Ex. 1006, 2:23–25, 4:45–47, 4:63–67, 5:2–9). Specifically, DeLuca’s lockout mechanism only prevents reattachment of the base to the bracket when a user has removed some (or all) of the batteries. Ex. 1006, 4:62–5:19. And Petitioner does not explain what prevents a user from inserting batteries into a permanently-deactivated base and then reattaching it to the bracket. *See* Pet. 71.

We find that Petitioner has not sufficiently shown all limitations of claim 12 would have been obvious over Byrne ’311 and DeLuca ’487.

4. Claims 13–15

Because Petitioner has not sufficiently shown all limitations of claim 12 over Byrne ’311 and DeLuca ’487, there is also an insufficient showing that claims 13–15, all of which depend from claim 12, would have been obvious over Byrne ’311 and DeLuca ’487.

5. *Conclusion*

Petitioner has not shown a reasonable likelihood that claims 12–15 would have been obvious over Byrne '311 and DeLuca '487.

6. *Conclusion*

Petitioner has not shown a reasonable likelihood that claims 12–15 would have been obvious over Malewski and STP2003.

IV. CONCLUSION

As explained above, we determine that Petitioner has not established a reasonable likelihood of prevailing in its challenge to at least one claim of the '158 patent. In doing so, we need not reach Patent Owner's arguments regarding incorporation by reference or Section 325(d). *See* Prelim. 63–67, (Incorporation by Reference), 67–72 (Section 325(d)).

Thus, we do not institute an *inter partes* review the '158 patent.

V. ORDER

In consideration of the foregoing, it is hereby:

ORDERED that *inter partes* review is *not instituted* with respect to all claims and all grounds of unpatentability raised in the Petition.

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