

IN THE UNITED STATES DISTRICT COURT
FOR THE EASTERN DISTRICT OF TEXAS
SHERMAN DIVISION

DUKE W. ZINSER,

Plaintiff,

v.

VIVINT, LLC AND VIVINT, INC.,

Defendant,

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Case No. 4:25-cv-1030-ALM

JURY TRIAL DEMANDED

DEFENDANTS' PRELIMINARY INVALIDITY CONTENTIONS

Defendants Vivint, LLC and Vivint, Inc. (collectively “Vivint” or “Defendants”) hereby submit their Preliminary Invalidity Contentions regarding claims asserted by Duke W. Zinser (“Plaintiff,” “Zinser,” or “Mr. Zinser”), pursuant to the Local Patent Rules and Scheduling Order (Dkt. No. 21).

In his Preliminary Infringement Contentions, served April 16, 2026 (“PIC”), Mr. Zinser asserted claims 2-7, 15-18, 20-35, and 37-47 (collectively the “Asserted Claims”) of U.S. Patent No. 7,583,191 (“the ’191 Patent” or the “Asserted Patent”) as found in the originally issued ’191 Patent and the ’191 Patent’s *Ex-Parte* Reexamination Certificate.¹ Defendants contend that each of the Asserted Claims is invalid, at least for the reasons set forth herein.

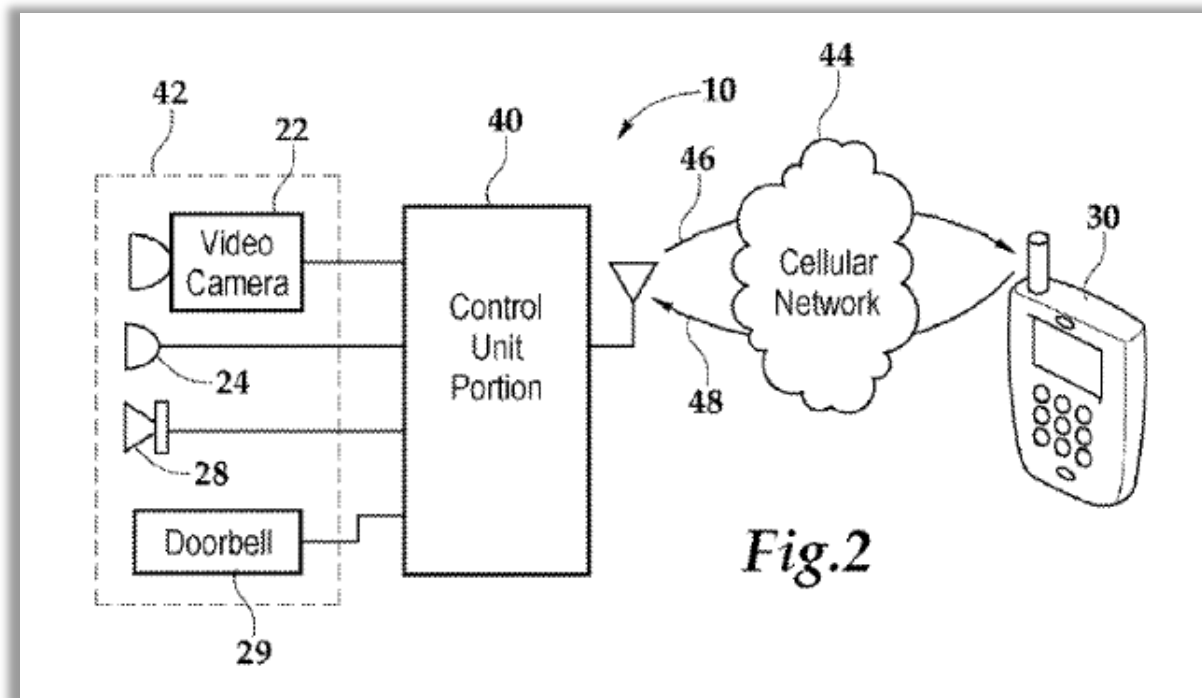
¹ In a letter sent by Mr. Zinser’s counsel on May 8, 2026—the last business day before these Invalidity Contentions are due—Mr. Zinser agreed to drop his infringement assertion of claims 2, 3, 4, 6 and 20.

I. INVALIDITY CONTENTIONS

A. Overview of the '191 Patent

The '191 Patent is directed to a conventional security system that streams audio and video from a property's entry point to a remote user's cellular telephone. '191 Patent, Abstract. The '191 Patent explains that previous systems are merely "reactive" and typically only provide alarm monitors to predetermined third parties. '191 Patent, 1:13-14, 1:23-26. The '191 Patent explains that there exists a need for a "proactive" system that relays audio and visual information from the property to the remote user (*i.e.*, the property owner) during an alarm thereby deterring unwanted individuals. *Id.*, 1:23-44.

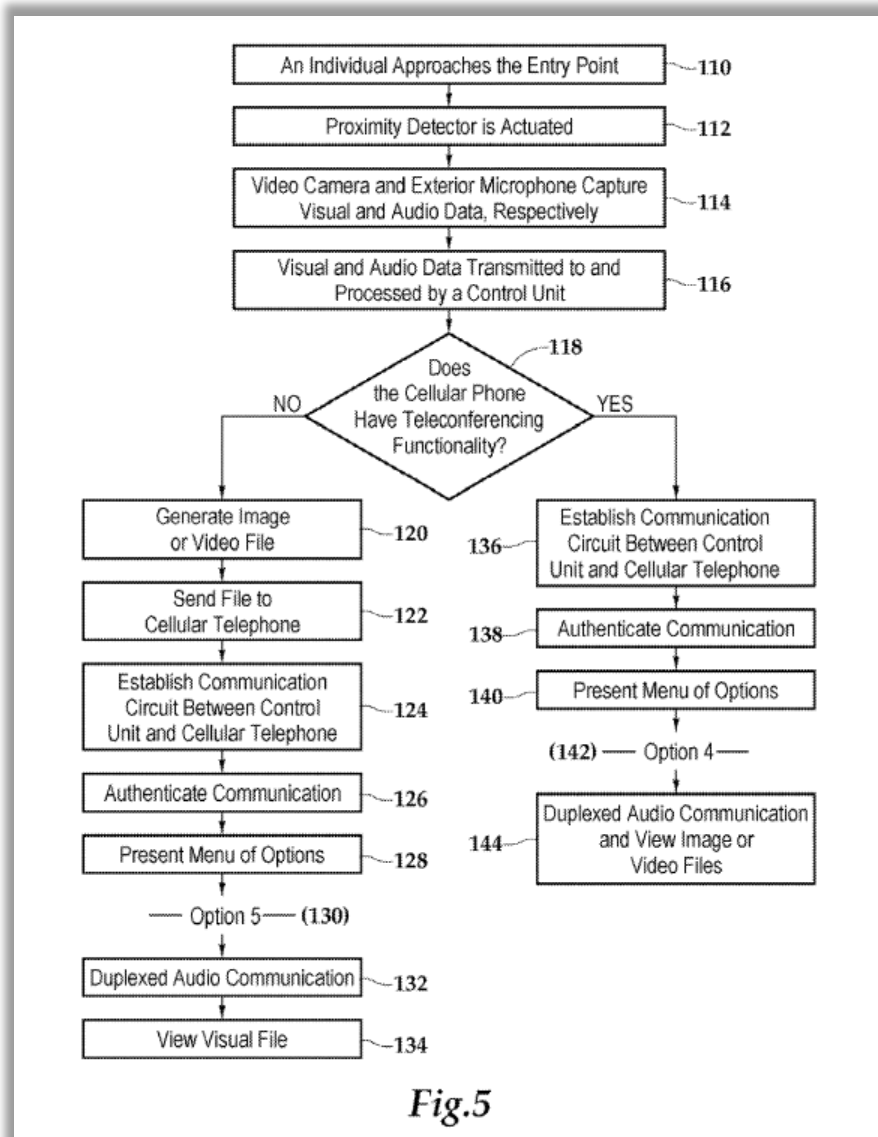
Figure 2 illustrates the doorbell monitoring security system and connection to the remote user's cellular telephone:



Id., Fig. 2.

As illustrated, the doorbell monitoring system utilizes a control unit 40 to relay data from a communication portion 42 to the cellular network 44 and the remote user's telephone 30. *Id.*, 3:10-13. The communication portion 42 includes a video camera 22 and an exterior microphone 24 for capturing audio and visual information at the doorway. *Id.*, 2:36-37, 3:13-17. The communication portion 42 also includes doorbell 29 where a triggering event, such as the ringing of a doorbell, initiates the contact of the control unit to the homeowner. *Id.*, 2:38-47, 3:4-8. The control unit controls the communication portion 42 and relays data and communications between the communication portion 42 and the cellular telephone 30 via a cellular network 44. *Id.*, 3:10-17.

The '191 Patent explains that the system operates as follows: (1) An individual approaches the doorway; (2) The proximity detector is activated; (3) The video camera 22 and exterior microphone 24 capture the visual and audio data; (4) The control unit 40 processes the received audio-visual data from the video camera and microphone; (5) The control unit 40 notifies the remote user's cellular phone; (6) The control unit 40 interfaces with the remote user's telephone 30 allowing the remote user to receive additional information (*i.e.*, an image or a video file), and establish a real-time teleconferencing stream between the individual at the doorway and the remote user. *Id.*, Figure 5, 4:46-59, 6:13-67, 7:66-8:8. The general operation of the system is illustrated by Figure 5 below:



Id., Figure 5.

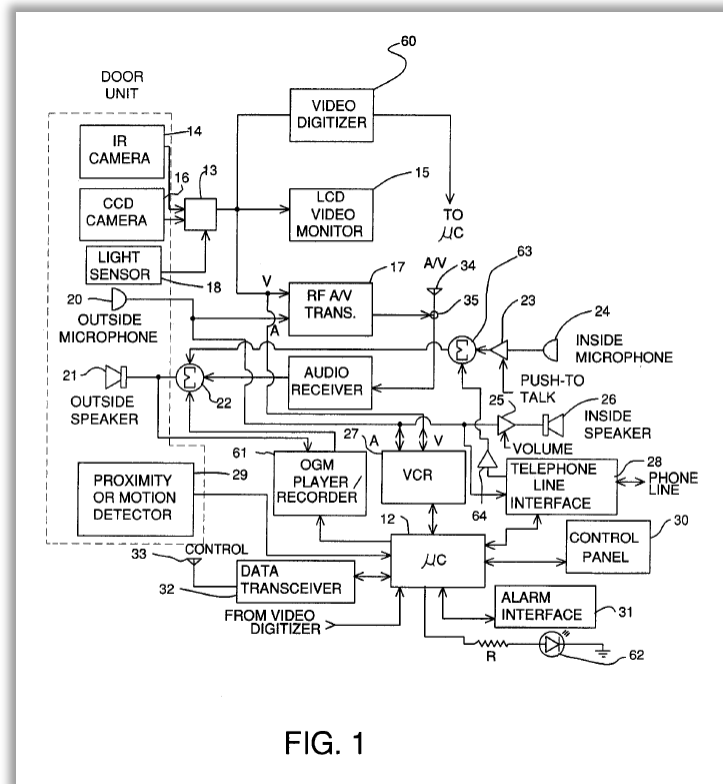
The '191 Patent issued with twenty claims, including independent Claims 1, 8, 14 and 19. However, the '191 patent was subject to a reexamination proceeding which resulted in a Reexamination Certificate that cancelled Claims 1, 8, 14 and 19, and found new Claims 21-47 patentable.

B. Prior Art to the Asserted Claims

1. State of the Art for Audio and Video Camera Enabled Security Systems

The prior art references, and the discussions of what was known to a Person of Ordinary Skill in the Art (POSITA) in the art of audio and video enabled security systems as of May 2006, the alleged date of invention set forth in Plaintiff's infringement contentions, provide exemplary factual support for the general description of the state of the art at the time of the invention, and provide additional motivation to modify or combine the prior art references cited in these Preliminary Invalidity Contentions.

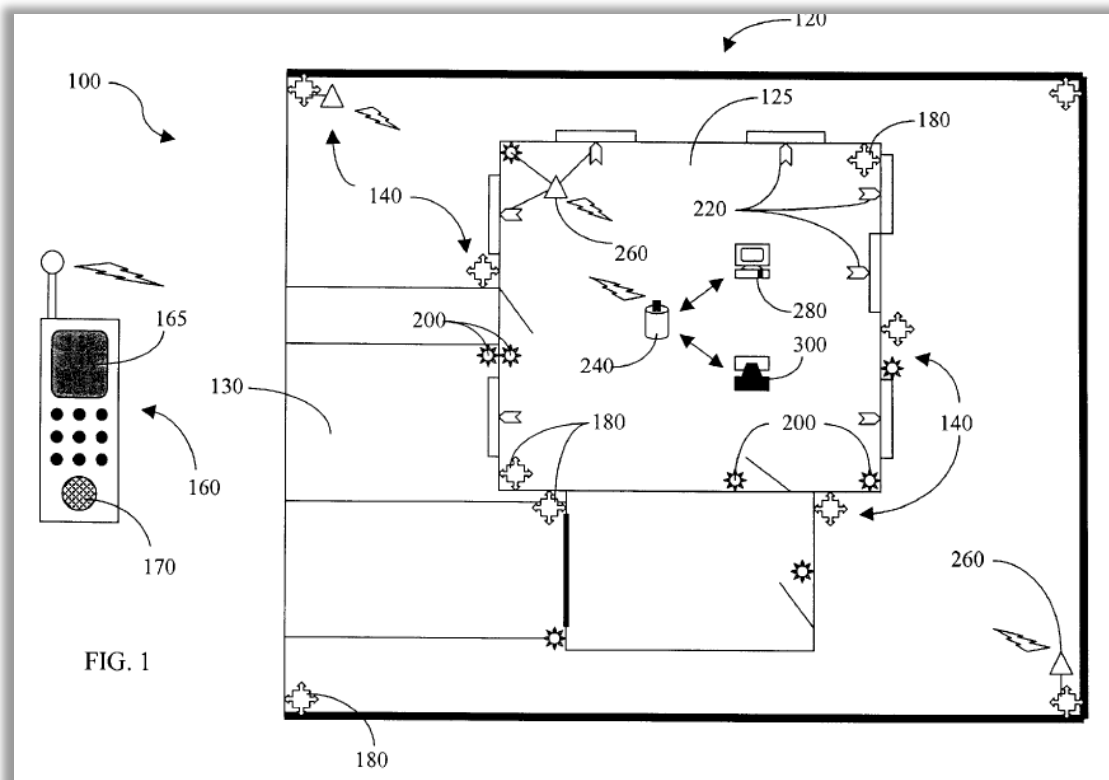
Prior art security systems were generally used to monitor entrances to a building in order to prevent unauthorized access to the building. These systems used various sensors to detect unauthorized persons. For example, U.S. Patent No. 6,429,893 to Xin ("Xin") disclosed such a system as shown below in FIG. 1:



Xin, Figure 1.

The security system includes a door unit with several different types of sensors for generating signals, including a video camera 16 for generating a video signal, an outside microphone 20 for generating an audio signal, an outside speaker 21 for playing an audio signal, and a proximity or motion detector 29 for detecting motion in the vicinity of the door. *Id.*, 4:10-5:8, FIG. 1. A remote unit allows a person to remotely monitor the activity at the door, play video and audio captured at the door unit, and control the security system. *Id.*, 1:37-50. The remote unit also allows the remote user to communicate orally with a person at the door. *Id.*, 6:6-8.

U.S. Patent No. 6,778,084 to Chang et al. ("Chang") disclosed another prior art security system as shown in FIG. 1 below:

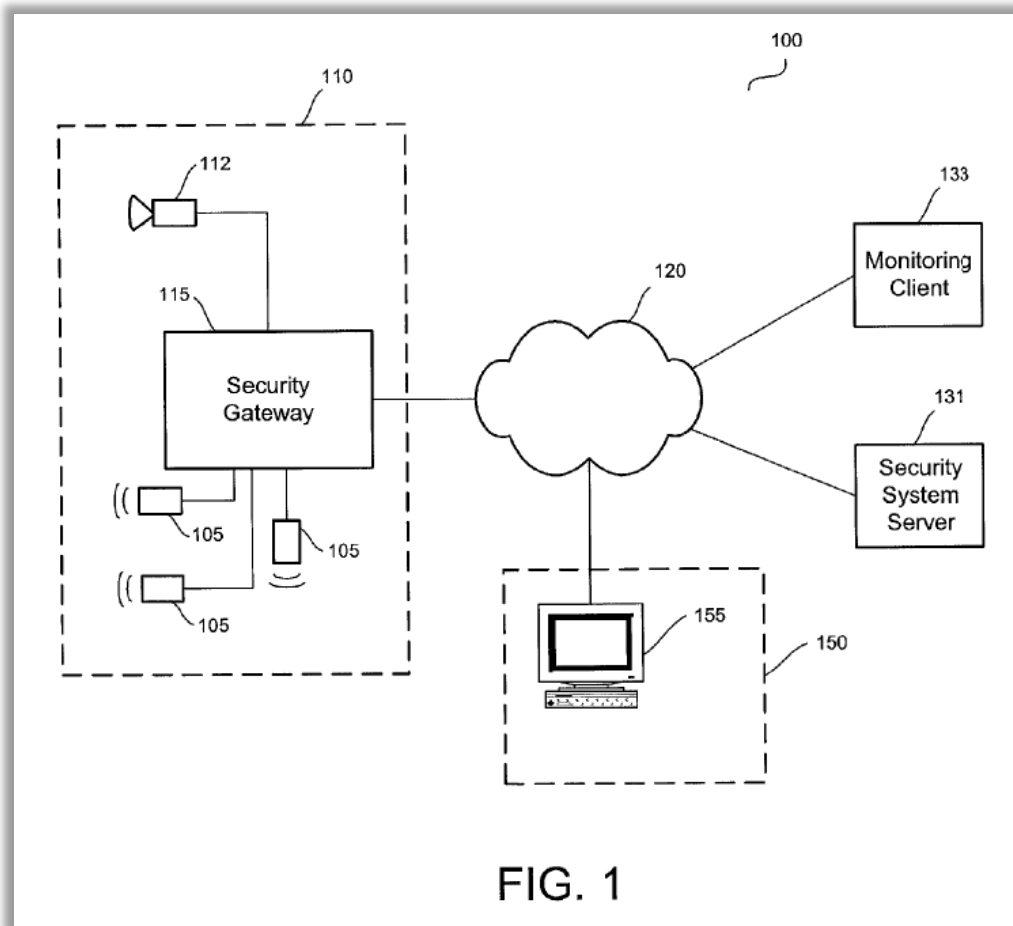


Chang, FIG. 1.

Chang's system included one or more cameras 180 capable of capturing video and audio data, one or more audio devices 200 capable of capturing and broadcasting audio data, and one or more intrusion devices 220 capable of detecting any intrusion onto the premises, such as glass breakage sensors, motion detectors, contact switches, proximity or alignment sensors. *Id.*, 3:56-4:4. According to Chang, one skilled in the art would have appreciated that such system components were placed and installed about the premises to provide optimum surveillance and security capabilities while being inconspicuous or resistant to disablement. *Id.*, 4:4-8.

Chang's system components communicated with an on-premises master terminal box 240, and the master terminal box 240 communicated wirelessly with a remote command unit 160. *Id.*, 4:9-25. The master terminal box 240 was capable of two-way wireless audio and video communication with the command unit 160. *Id.*, 4:25-29. The remote command unit 160 included an LCD screen, speaker, video camera, and microphone to allow two-way wireless audio and video communication between the user of the remote command unit 160 and the security components connected to the master terminal box 240. *Id.*, 4:56-5:2.

U.S. Patent Application Publication No. 2002/0147982 to Naidoo et al. ("Naidoo") disclosed another prior art security system as shown in FIG. 1 below:



Naidoo, FIG. 1.

Naidoo's security system 100 provided real-time monitoring with remote access through use of broadband features, including audio and video capabilities, web access and wireless capabilities. *Id.*, ¶30. The security system 100 included any type of sensor 105 to detect alarm conditions including magnetic contact switches, audio sensors, infrared sensors, motion detectors, fire alarms, and carbon monoxide sensors. *Id.*, ¶36. The security system also included one or more video cameras 112 that captured video of the monitored premises. *Id.*, ¶37.

The video cameras could include "smart" cameras to perform video capture, compression and storage and to communicate with the security system using a wireless network. *Id.*, ¶84. The smart camera could perform many functions, including, but not limited to, analyzing data from the

video camera 112 to determine if an alarm condition existed, accessing stored data in memory, generating alarm video to transmit to the security system based on a detected alarm condition, and communicating with the security system and a remote user. *Id.*, ¶81. The video camera 112 could capture and record video continuously in memory, and then based on predefined criteria, could discard older video. *Id.* The remote user could adjust the predetermined criteria by adjusting the recording times, recording duration, and total length of recordings. *Id.*

In one prior art example, the video sent to the security system began at least just prior to the beginning of the alarm condition and ended after the conclusion of the alarm condition, which helped identify false alarms. *Id.*, ¶38. In Naidoo's system, the remote user had the ability to control the functionality of the security system. *Id.*, ¶43. Once authenticated, the remote user could control the functionality of the system, such as by arming the security system, disarming the security system, adjusting sensor sensitivity, adjusting alarm condition detection sensitivity, remote surveillance (also referred to as "lifestyle video"), adjusting camera settings, and reviewing alarms and recordings. *Id.* The security system was capable of streaming live audio and video from the residence during alarm conditions and for general for lifestyle viewing over the world wide web. *Id.*, ¶82.

Before the earliest possible priority date for the '191 Patent, the concepts claimed in the Asserted Claims of the '191 Patent were well-known, as shown in numerous prior art references, as described below and the art cited in these Preliminary Invalidity Contentions. For these reasons and those shown in the remainder of these Preliminary Invalidity Contentions, each of the Asserted Claims of the '191 Patent is unpatentable over the prior art cited in these Preliminary Invalidity Contentions.

2. Mr. Zinser's Admissions

On June 19, 2024, Mr. Zinser filed a Request for *Ex Parte* Reexamination Request (the “Request”) in reexamination application No. 90/019,542. In this Request, Mr. Zinser explicitly represented and admitted to the PTO and the public that “Claims 1-7 and 19-20 are obvious over *Von Bauer* [U.S. Patent No. 5,428,388] in combination with *Menard* [WO 01/93220].” Request at 2. He further represented and admitted that “Claims 8-18 are obvious from *Von Bauer* in combination with *Menard* and *Klein* [U.S. Patent Application Publication No. 2004/0080615].” *Id.* Further, he attached to the Request “a chart showing where each limitation of independent claims 1 and 19 may be found in the combination of *Von Bauer* and *Menard*,” and he explicitly asserted that because “[c]laims 2-7 and 20 depend directly or indirectly from independent claims 1 and 19 and inherit all features and limitations of the base claim from which they depend . . . , **claims 2-7 and 20 are invalid** for at least the reasons as set forth with respect to claims 1 and 19.” Request at 4 (emphasis added). Similarly, he attached to the Request “a chart showing where each limitation of independent claims 8 and 14 may be found in *Von Bauer* in view of *Menard* and *Klein*,” and he explicitly asserted that because “[c]laims 9-13 and 15-18 depend directly or indirectly from independent claims 8 and 14 and inherit all features and limitations of the base claim from which they depend . . . , **claims 9-13 and 15-18 are invalid** for at least the reasons as set forth with respect to claims 8 and 14.” Request at 4-5 (emphasis added).

In summary, Mr. Zinser expressly admitted and represented that the subject matter of independent claims 1, 8, 14 and 19 is not patentable. And Mr. Zinser further admitted that each dependent claim 2-7, 9-13, 15-19 and 20 failed to recite an inventive feature vis-à-vis the independent claims and was invalid for at least the reasons set forth in connection with the independent claims. Features that Mr. Zinser has admitted are known in the prior art individually

and in combination, and are not inventive, are set forth below along with their corresponding features as set forth in reexamined claims 21-47:

Claim 1	Corresponding Feature: Reexamined Claims
[PRE] A doorbell monitoring system comprising:	[21PRE], [34PRE]
[1.1] a doorway having an environment;	[21.1], [34.1]
[1.2] a doorbell located in the doorway, the ringing of the doorbell being a triggering event;	[21.2], [34.2]
[1.3] a video camera and an external microphone disposed in the entry point, the video camera and external microphone, responsive to the triggering event, for capturing entry point visual and audio communications at the entry point and transmitting the captured entry point visual and audio communications;	[21.3], [21.14], [34.3]
[1.4] an external speaker disposed in the entry point, the external speaker for rendering received cellular audio communications;	[21.4], [34.4]
[1.5] a control unit disposed in communication with the video camera, the doorbell, and the external microphone, the control unit for communicating at least one portion of the entry point visual and audio communications received from the video camera and external microphone, and for communicating the received cellular audio communications to the external speaker; and	[21.5], [34.5]
[1.6] a cellular telephone disposed remotely to the doorway and the control unit, the cellular telephone for capturing cellular audio communications at the cellular telephone, transmitting the cellular audio communications to the control unit, and rendering the at least one portion of entry point communications received from the control unit.	[21.6], [34.6]
Claim 2	Corresponding Feature: Reexamined Claims

The system as recited in claim 1, wherein the video camera and the external microphone are integrated.	[21.7], [34.7]
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Claim 3	Corresponding Feature: Reexamined Claims
The system as recited in claim 1, wherein the external microphone and speaker are integrated.	[21.7], [34.7]

Claim 4	Corresponding Feature: Reexamined Claims
The system as recited in claim 1, wherein the control unit is disposed in communication with the video camera and the external microphone by a communication link selected from the group consisting of wireless links and physical links.	[21.8], [34.8]

Claim 5	Corresponding Feature: Reexamined Claims
The system as recited in claim 1, wherein the at least one portion of the entry point visual and audio communications comprises data selected from the group consisting of audio data, at least one image and audio data, and streaming visual and audio data.	[21.8], [34.8] Claims 22, 27, 35, 41

Claim 6	Corresponding Feature: Reexamined Claims
The system as recited in claim 1, wherein the cellular telephone comprises teleconferencing capability.	Claims 29, 43

Claim 7	Corresponding Feature: Reexamined Claims
The system as recited in claim 1, wherein the connection between the control unit and cellular telephone comprises a network connection over a cellular network.	[21.6], [34.6]

Claim 14	Corresponding Feature: Reexamined Claims
[PRE] A doorbell monitoring system comprising:	[21PRE], [34PRE]

[14.1] a doorbell located at an entry point;	[21.2], [34.2]
[14.2] means, responsive to the ringing of the doorbell, for capturing visual and audio communications at the entry point;	[21.3], [21.14], [34.3]
[14.3] means for relaying at least a portion of the captured visual and audio communications to a cellular phone;	[21.5], [34.5]
[14.4] means for rendering the least a portion of the captured visual and audio communications at the cellular phone;	[21.6], [34.6]
[14.5] means for capturing audio communications at the cellular phone;	[21.6], [34.6]
[14.6] means for relaying the audio communications from the cellular phone to the entry point; and	[21.6], [34.6]
[14.7] means for rendering the audio communications at the entry point.	[21.4], [34.4]

Claim 15	Corresponding Feature: Reexamined Claims
The system as recited in claim 14, wherein the means for relaying at least a portion of the captured visual and audio communications and means for relaying the audio communications for the cellular phone operate substantially simultaneously.	Claims 29, 43

Claim 16	Corresponding Feature: Reexamined Claims
The system as recited in claim 14, wherein the means for relaying at least a portion of the captured visual and audio communications and the means for relaying the audio communications for the cellular phone operate to provide duplexed audio communication.	Claims 29, 43

Claim 17	Corresponding Feature: Reexamined Claims
The system as recited in claim 14, further comprising means for forwarding the captured visual and audio communications to means for data storage located onsite to the entry point.	[21.9] Claims 30, 32, 33, 40, 44, 45, 46, 47

Claim 18	Corresponding Feature: Reexamined Claims
The system as recited in claim 14, further comprising means for forwarding the captured visual and audio communications to a video monitor located onsite to the entry point.	Claims 24, 25, 26, 37, 38, [39PRE]

Claim 19	Corresponding Feature: Reexamined Claims
[PRE] A system for providing doorbell monitoring, the system comprising:	[21PRE], [34PRE]
[19.1] a doorway to a home having an environment;	[21.1], [34.1]
[19.2] a doorway located in the doorway, the ringing of the doorbell being a triggering event;	[21.2], [34.2]
[19.3] a video camera and an external microphone disposed in the doorway, the video camera and external microphone for, when actuated, by the triggering event, capturing doorway visual and audio communications at the doorway and transmitting the captured doorway visual and audio communications;	[21.3], [21.14], [34.3]
[19.4] a proximity detector disposed in the doorway, the proximity detector for actuating the video camera and the external microphone in response to an individual approaching the doorway;	[21.7], [34.7]
[19.5] an external speaker disposed in the doorway, the external speaker for rendering received cellular audio communications;	[21.4], [34.4]
[19.6] a control unit disposed in communication with the video camera, the doorbell, and the external microphone, the control unit for communicating at least one portion of the doorway visual and audio communications received from the video camera and external microphone, and for communicating the received cellular audio communications to the external speaker; and	[21.5], [34.5]
[19.7] a cellular telephone disposed in the possession of the homeowner and remotely to the doorway and the control unit, the cellular telephone for capturing cellular audio communications at the cellular telephone,	[21.6], [34.6]

transmitting the cellular audio communications to the control unit, and rendering the at least one portion of doorway communications received from the control unit,	
[19.8] thereby permitting the homeowner to monitor the home while away and the homeowner and individual to communicate as if the homeowner was at home.	[21.6], [34.6]

Claim 20	Corresponding Feature: Reexamined Claims
The system as recited in claim 19, wherein the home comprises a structure selected from the group consisting of a house, an apartment, a loft, a condominium, and a townhouse.	[21.1], [21.2], [34.1], [34.2]

C. P.R. 3-3(a) – Identification of Prior Art

Pursuant to P.R. 3-3(a), and subject to Defendants’ reservation of rights as stated herein, Defendants identify the following items of prior art that anticipate or render obvious the Asserted Claims. The identification of prior art below is not exhaustive, and the Parties’ respective document productions may contain additional references that render the Asserted Claims invalid. Defendants reserve the right to rely upon both the listed and unlisted references, as well as other art that may become known and/or relevant during the course of this litigation.

Defendants also identify as prior art any system, method, or apparatus accused of infringement by plaintiff to the extent such system, method, or apparatus currently exists or operates in the same or substantially the same way as prior to the critical date and further reserve the right to rely on any such system art and any evidence thereof of as part of its defenses in these cases, including their invalidity cases.

Plaintiff has asserted that the date of invention for the claimed inventions was “at least as early as May 2, 2006.” PIC at 7. Defendants reserve the right to rely on any other version of the

patents and published patent applications identified below, domestic or foreign, in particular if Plaintiff alleges that it can antedate any of the versions identified below.

Defendants reserve their rights to rely on information not reasonably available to it at this time, including information subsequently obtained during discovery. Subject to the foregoing, Defendants identify the following patents and patent applications and non-patent references as prior art to the Asserted Patents:

<u>Patent/Publication No. (First Inventor)</u>	<u>Priority Date</u>	<u>Date of Issue / Publication</u>
U.S. Patent Application Publication No. 2004/0086093 (“Schranz”)	Oct. 29, 2002	May 6, 2004
U.S. Patent Application Publication No. 2005/0285724 (“Sheynman”)	Jun. 29, 2004	Dec. 29, 2005
U.S. Patent Application Publication No. 2004/0132489 (“Ryley”)	Jan. 6, 2003	Jul. 8, 2004
U.S. Patent No. 5,428,388 (“von Bauer”)	Jun. 15, 1992	Jun. 27, 1995
U.S. Patent Application Publication No. 2002/0147982 (“Naidoo”)	Jul. 20, 1999	Oct. 10, 2002
U.S. Patent Application Publication No. 2004/0080615 (“Klein”)	Aug. 21, 2002	Apr. 29, 2004
Korean Patent No. 10-0491708 (“Kim”)	Sep. 12, 2002	May 18, 2005
International Patent Application Publication No. WO 01/93220 (“Menard”)	May 26, 2000	Dec. 6, 2001
U.S. Patent No. 6,429,893 (“Xin”)	Jun. 4, 1998	Aug. 6, 2002
U.S. Patent No. 6,778,084 (“Chang”)	Jan. 9, 2002	Aug. 17, 2004

<u>First Author/Publisher/Creator</u>	<u>Reference Title / Description</u>	<u>Date</u>
Bing-Fei Wu / 5th WSEAS International Conference on Telecommunications and Informatics, Istanbul, Turkey, May 27-29, 2006	A Practical Home Security System via Mobile Phones (“Wu”)	At least as early as May 27, 2006

<u>Prior Art Products/Systems</u>	<u>Date of Conception/Reduction to Practice</u>
TLC Interview 3 Video Door Entry Products (“Interview 3”)	<i>See Exhibit A-3</i>

D. P.R. 3-3(b) – Anticipation and Obviousness

Pursuant to P.R. 3-3(b), and subject to Defendants’ reservation of rights, Defendants attach claim charts hereto that are directed to the prior art references that anticipate each of the Asserted Claims of the Asserted Patent under 35 U.S.C. § 102, either expressly or inherently, and/or the prior art references that, in the alternative, would have rendered the Asserted Claims obvious under 35 U.S.C. § 103. *See Exhibits A-01 to A-10* (collectively “Exhibit A”).

To the extent the prior art references do not anticipate each of the Asserted Claims of the ’191 Patent, it would have been obvious to a POSITA to combine the prior art references identified in Defendants’ invalidity contentions, including in the manner listed in Exhibit A. These references are in the same technical field—i.e., audio and video enabled security systems. The reasons or motivation to combine the references include following the express teachings of the references themselves. Each combination of art would have produced no unexpected results, and at most would simply represent a known alternative within the knowledge of one of ordinary skill in the art. *See KSR Int’l Co. v. Teleflex, Inc.*, 550 U.S. 398, 415-17 (2007) (rejecting the Federal Circuit’s “rigid” application of the teaching, suggestion, or motivation to combine test, instead

espousing an “expansive and flexible” approach). Indeed, the Supreme Court has held that a person of ordinary skill in the art is “a person of ordinary creativity, not an automaton,” and “in many cases a person of ordinary skill in the art will be able to fit the teachings of multiple patents together like pieces of a puzzle.” *Id.* at 420-21.

Under *KSR*, a claimed invention can be obvious even if there is no explicit teaching, suggestion, or motivation for combining the prior art to produce that invention. “In determining whether the subject matter of a patent claim is obvious, neither the particular motivation nor the avowed purpose of the patentee controls. What matters is the objective reach of the claim.” *Id.* at 419. “Under the correct analysis, any need or problem known in the field of endeavor at the time of invention and addressed by the patent can provide a reason for combining the elements in the manner claimed.” *Id.* at 420. In particular, the Supreme Court has emphasized the principle that “[t]he combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.” *Id.* at 416. A key inquiry is whether the “improvement is more than the predictable use of prior art elements according to their established functions.” *Id.* at 401.

The rationale to combine or modify prior art references is significantly stronger when the references seek to solve the same problem, come from the same field, and correspond well to each other. *In re Inland Steel Co.*, 265 F.3d 1354, 1362 (Fed. Cir. 2001). The Federal Circuit has held that two references may be combined as invalidating art under similar circumstances, namely “[the prior art] focus[es] on the same problem that the . . . patent addresses. Moreover, both [prior art references] come from the same field Finally, the solutions to the identified problem found in the two references correspond well.” *Id.* (concerning patents and prior art relating to improving the magnetic and electrical properties of steel). Here, as already discussed, many of prior art

references of Defendants' invalidity contentions (including Exhibit A) recognize the same problems as the '191 Patent, and they propose or suggest similar solutions.

In view of the Supreme Court's *KSR* decision, the USPTO issued a set of Examination Guidelines to its Patent Examiners. *See* Examination Guidelines for Determining Obviousness Under 35 U.S.C. § 103 in View of the Supreme Court Decision in *KSR International Co. v. Teleflex, Inc.*, 72 Fed. Reg. 57526 (October 10, 2007). Those Guidelines summarized the *KSR* decision, and identified various rationales for finding a claim obvious, including those based on other precedents. Those rationales include:

- (A) Combining prior art elements according to known methods to yield predictable results;
- (B) Simple substitution of one known element for another to obtain predictable results;
- (C) Use of known technique to improve similar devices (methods, or products) in the same way;
- (D) Applying a known technique to a known device (method, or product) ready for improvement to yield predictable results;
- (E) "Obvious to try" – choosing from a finite number of identified, predictable solutions, with a reasonable expectation of success;
- (F) Known work in one field of endeavor may prompt variations of it for use in either the same field or a different one based on design incentives or other market forces if the variations would have been predictable to one of ordinary skill in the art; and
- (G) Some teaching, suggestion, or motivation in the prior art that would have led one of ordinary skill to modify the prior art reference or to combine prior art reference teachings to arrive at the claimed invention.

Id. at 57529. Defendants contend that the above rationales likewise apply in rendering obvious the Asserted Claims.

Thus, one of ordinary skill in the art implementing a device and/or system in the respective technical field would be motivated to investigate the various related existing publications, and/or patents identified in these contentions to address the particular needs. Indeed, the claimed subject

matter required nothing more than combining prior art elements according to their intended purpose using known methods to yield predictable results. Therefore, one of ordinary skill in the art would have been motivated to combine the prior art, in that it required only simple substitutions of one known element for another to obtain predictable results.

Further, to the extent any piece of prior art refers to or discusses other pieces of prior art, either expressly or inherently, it would have been obvious to combine those pieces of prior art for that reason. In addition, design incentives and other market forces would have prompted those combinations and modifications. The teachings of the individual prior art references, combined with the industry knowledge of a POSITA at the time of the alleged invention of the asserted patents, would have rendered obvious the Asserted Claims.

Still further, it would have been obvious to try combining the prior art references identified in Exhibit A because there were only a finite number of predictable solutions and/or because known work in one field of endeavor prompted variations based upon predictable design incentives and/or market forces either in the same field or a different one. In addition, the combinations of the prior art references identified in Exhibit A would have been obvious because the combinations represent the known potential options to known problems that would have been obvious to implement with a reasonable expectation of success in the field of audio and video enabled security systems.

E. P.R. 3-3(c) – Claim Charts

Each of the Asserted Claims is anticipated and/or rendered obvious by at least the prior art references identified in Defendants' Invalidity Contentions. Many of these references recognize the same problem—i.e., security systems with audio only features were merely reactive—and they propose or suggest a similar solution—i.e., security systems with two-way audio and visual communication, including to both local and remote locations.

Pursuant to P.R. 3-3(c), detailed claim charts showing how the Asserted Claims read on various prior art references and/or combinations thereof are attached as Exhibit A. The prior art references identified in these charts anticipate and/or render obvious the Asserted Claims, alone or in combination, and/or with other prior art and the understanding of a POSITA:

Claim Chart Exhibit	Prior Art Reference
A-01	U.S. Patent Application Publication No. 2004/0086093 (“Schranz”)
A-02	A Practical Home Security System via Mobile Phones (“Wu”)
A-03	TLC Interview 3 Video Door Entry Products (“Interview 3”)
A-04	U.S. Patent Application Publication No. 2005/0285724 (“Sheynman”)
A-05	U.S. Patent Application Publication No. 2004/0132489 (“Ryley”)
A-06	U.S. Patent No. 5,428,388 (“von Bauer”)
A-07	U.S. Patent Application Publication No. 2002/0147982 (“Naidoo”)
A-08	U.S. Patent Application Publication No. 2004/0080615 (“Klein”)
A-09	Korean Patent No. 10-0491708 (“Kim”)
A-10	International Patent Application Publication No. WO 01/93220 (“Menard”)

In addition to the specific combinations of prior art asserted in Exhibit A, Defendants reserve the right to rely on any other combination of the prior art references disclosed herein, disclosed within the references cited herein, disclosed within the prosecution history of the ’191 Patent and its reexam, and/or identified during the course of discovery. Moreover, to the extent a finder of fact determines that a limitation of an asserted claim was not disclosed by one of the references or combinations identified in Exhibit A, Defendants assert that the Asserted Claims are nevertheless unpatentable as obvious because the Asserted Claims contain nothing that constitutes a patentable innovation over those references.

F. Exemplary Combinations of the References

The prior art references identified in Exhibits A-01 to A-10 are either directly related to or specifically address issues with reactive security systems.

Thus, reasons or motivations to combine the prior art include the explicit teachings of the references, that the references were produced by researchers working in the same or similar technical areas of security systems that the references are directed toward the same problem (*e.g.*, providing audio and video of an entry point to a remote user), the fact that the prior art is all in the field of security systems, and one of ordinary skill in the art would be motivated to investigate the various existing security systems, patents, and other publications identified herein to address their particular needs. The combinations and modifications of the prior art to invalidate the Asserted Claims would have arisen from ordinary innovation, ordinary skill, common sense, would have been obvious to try, or would have been otherwise predictable in the field of audio and video enabled security systems.

Defendants contend that where the Asserted Claims are anticipated by a particular reference they are also rendered obvious by that same reference alone, or in combination with the other references, as shown in the table below:

Primary Reference	In Combination with One or More of
Schranz	Wu
Schranz	Interview 3
Schranz	Sheynman
Schranz	Ryley
Schranz	von Bauer
Schranz	Naidoo
Schranz	Klein
Schranz	Kim
Schranz	Menard
Wu	Schranz
Wu	Interview 3
Wu	Sheynman
Wu	Ryley
Wu	von Bauer
Wu	Naidoo
Wu	Klein
Wu	Kim
Wu	Menard
Interview 3	Schranz

Interview 3	Wu
Interview 3	Sheynman
Interview 3	Ryley
Interview 3	von Bauer
Interview 3	Naidoo
Interview 3	Klein
Interview 3	Kim
Interview 3	Menard
Sheynman	Schranz
Sheynman	Wu
Sheynman	Interview 3
Sheynman	Ryley
Sheynman	von Bauer
Sheynman	Naidoo
Sheynman	Klein
Sheynman	Kim
Sheynman	Menard
Ryley	Schranz
Ryley	Wu
Ryley	Interview 3
Ryley	Sheynman
Ryley	von Bauer
Ryley	Naidoo
Ryley	Klein
Ryley	Kim
Ryley	Menard
von Bauer	Schranz
von Bauer	Wu
von Bauer	Interview 3
von Bauer	Sheynman
von Bauer	Ryley
von Bauer	Naidoo
von Bauer	Klein
von Bauer	Kim
von Bauer	Menard
Naidoo	Schranz
Naidoo	Wu
Naidoo	Interview 3
Naidoo	Sheynman
Naidoo	Ryley
Naidoo	von Bauer
Naidoo	Klein
Naidoo	Kim
Naidoo	Menard
Klein	Schranz

Klein	Wu
Klein	Interview 3
Klein	Sheynman
Klein	Ryley
Klein	von Bauer
Klein	Naidoo
Klein	Kim
Klein	Menard
Kim	Schranz
Kim	Wu
Kim	Interview 3
Kim	Sheynman
Kim	Ryley
Kim	von Bauer
Kim	Naidoo
Kim	Klein
Kim	Menard
Menard	Schranz
Menard	Wu
Menard	Interview 3
Menard	Sheynman
Menard	Ryley
Menard	von Bauer
Menard	Naidoo
Menard	Klein
Menard	Kim

Each reference in Exhibits A-01 to A-10 discloses audio and video enabled security systems. A person having ordinary skill in the art would have been motivated to combine the prior art based on the nature of the problem to be solved, the teachings of the prior art, and the knowledge of persons having ordinary skill in the art.

For example, to the extent Mr. Zinser asserts the references charted in Exhibits A-01 to A-10 do not disclose the limitations referencing “cellular audio communications” and/or “a cellular telephone” it would have been obvious to combine any of these charted references with (by way of example) at least A-01 (Schranz), A-02 (Wu), A-04 (Sheynman), A-09 (Kim), and A-10 (Menard), all of which disclose these limitations as shown in their respective charts. A person of skill in the art would be motivated to combine these references because they each disclose benefits

and improvements to security systems through the flexibility associated with the use of mobile phones and cellular communications in such systems. Moreover, such techniques have been common knowledge in the art since long before the alleged inventions claimed in the '191 Patent, as were the techniques of capturing cellular audio communications at the cellular telephone, transmitting cellular audio communications, and rendering cellular audio communications. *See, e.g.,* A-01 (Schranz) (*e.g.,* at Abstract “The SCM is connected to the Internet via ADSL or Cable modem, or by cellular phone with a Bluetooth interface. The peripheral devices detect an event and notify the SCM, the SCM establishes a VoIP call to a remote user in the Internet, PSTN or cellular networks.”), A-02 (Wu) (*e.g.,* at p. 1 “[o]nce PHSS was triggered, users receive a notification and browse the desired images captured from the CCD/CMOS cameras connected to the embedded surveillance server (ESS) of PHSS on the screen of their mobile phone.”), A-04 (Sheynman) (*e.g.,* at [0024] “data captured by the visitor monitor. . . is communicated over a GPRS data network to an image server 140 communicably coupled to the cellular communications network . . . [and] retrieved by the remote terminal 134”), A-09 (Kim) (*e.g.,* at [0039] “remotely access the video intercom through the Internet, mobile phone, or telephone to make video calls with people inside the site, or to control the entry and exit of visitors from a remote location, and to access the intruder response mode to enter, modify, and change the intruder response function”), A-10 (Menard) (*e.g.,* “module 200 is in wireless communication with other devices, or PDU 400B, shown in the figure as cellular telephone, via link 220A, and PDU 400A”).

To the extent Mr. Zinser asserts the references charted in Exhibits A-01 to A-10 do not disclose limitations referencing a “data storage” or a “storage device” it would have been obvious to combine any of these charted references with (by way of example) at least A-01 (Schranz), A-02 (Wu), A-06 (von Bauer), A-07 (Naidoo), A-08 (Klein) all of which disclose these limitations

as shown in their respective charts. A person of skill in the art would be motivated to combine these references because they each disclose benefits in security systems associated with providing improved access to visual and audio communications through storage of the same. Moreover, such techniques have been common knowledge in the art since long before the alleged inventions claimed in the '191 Patent, as were the techniques of accessing and displaying stored data on the storage device/data storage. *See, e.g.*, A-01 (Schranz) (*e.g.*, at [0032] “audio and video recording mechanism that uses a hard disk drive to store the data in real-time using standard audio and video formats), A-02 (Wu) (*e.g.*, at p. 2 “[t]hese images were compressed into JPEG format and stored in storage units”), A-06 (von Bauer) (*e.g.*, at 15:43-16:1 explaining a system controller has a “VCR pause” pushbutton), A-07 (Naidoo) (*e.g.*, at [0083] “video module 620 contains enough memory to store sixty seconds of pre-alarm video and audio from each camera 112 and microphone 634 in RAM and up to five minutes of audio/video content (per camera 112) on disk.”), A-08 (Klein) (*e.g.*, at [0023] “[t]he video management unit 45 provides a management system for recording the video feed received by the camera 60 to a local storage medium associated with the host computer 20”).

To the extent that Mr. Zinser asserts the references charted in Exhibits A-01 to A-10 do not disclose “collect[ing] the entry point visual communications captured by the single communications unit before the triggering event” it would have been obvious to combine any of these charted references with (by way of example) at least A-04 (Sheynman), A-06 (von Bauer), A-07 (Naidoo), A-09 (Kim), and A-10 (Menard) all of which disclose these limitations as shown in their respective charts. A person of skill in the art would be motivated to combine any of the charted references with these references because they each disclose expanding security and monitoring coverage through the collection of entry point visual communications before the

triggering event. Moreover, such techniques have been common knowledge in the art since long before the alleged inventions claimed in the '191 Patent. *See, e.g.*, A-04 (Sheynman) (*e.g.*, at [0029] “upon . . . detection of the visitor, the visitor monitor captures an image of the visitor or subject at block 312, and at block 314 the captured image is communicated to the gateway”), A-06 (von Bauer) (*e.g.*, at 13:13-19 “Video Doorbell Station 31 desirably incorporates alternate means of being switched from a standby mode to an operating mode. Thus, as shown in FIG. 13, Video Doorbell Station 31 includes a ‘human presence sensor’ (preferably an infrared proximity detector) 38 having a field of view encompassing a desired region”), A-07 (Naidoo) (*e.g.*, at [0038] “[t]he alarm video sent to the security system server 131 preferably begins at least just prior to the occurrence of the alarm condition and may end upon after the conclusion of the alarm condition”), A-09 (Kim) (*e.g.*, at [0029] “[t]he operation is operated by the intruder response mode, wherein the moment the intruder response program recognizes the presence of an object captured by the camera through the sensor, the intruder response program automatically records the detected image on the video intercom inside the site, and transmits the video data to the base of the remote location specified by the user in advance.”), A-10 (Menard) (*e.g.*, at p. 22, ll. 11-28 “[i]n one embodiment, arrival of the caller is detected by video camera 370.”).

To the extent that Mr. Zinser asserts the references charted in Exhibits A-01 to A-10 do not disclose “collect[ing] additional visual communications after the triggering event” it would have been obvious to combine any of these charted references with (by way of example) at least A-01 (Schranz), A-02 (Wu), A-05 (Ryley), A-06 (von Bauer), A-07 (Naidoo), A-08 (Klein), A-09 (Kim), and A-10 (Menard) all of which disclose this limitation as shown in their respective charts. A person of skill in the art would be motivated to combine any of the charted references with these references because they each disclose the benefits associated with continued security and

monitoring coverage through the collection of entry point visual communications after the triggering event. Moreover, such techniques have been common knowledge in the art since long before the alleged inventions claimed in the '191 Patent. *See, e.g.*, A-01 (Schranz) (*e.g.*, at Abstract “[t]he peripheral devices detect an event and notify the SCM, the SCM establishes a VoIP call to a remote user in the Internet, PSTN or cellular networks. The remote user using a multimedia device will hear ambient audio and see video images from the peripheral device in the location of the alarm.”), A-02 (Wu) (*e.g.*, at p. 5 “mobile phone shows the real-time continuous QCIF images on the screen”), A-05 (Riley) “[t]he CDB 110 wakes up upon sensing the press of the button and initiates a voice/data link to the speakerphone base unit (SB) 101.”), A-06 (von Bauer) (*e.g.*, at 7:26-31 “[t]he function of second transmitter 46 is to transmit an RF signal 47 modulated by a composite video signal 48 produced by CCD camera 45. Video RF signal 47 is transmitted from antenna 49 to an antenna 51 coupled to a video receiver 50 located in Video Receiver Station 32.”), A-07 (Naidoo) (*e.g.*, at [0038] “[t]he alarm video sent to the security system server 131 preferably begins at least just prior to the occurrence of the alarm condition and may end upon after the conclusion of the alarm condition”), A-08 (Klein) (*e.g.*, at [0036] “[t]he event generation module 22 through the action handler 66, upon detection of an alarm event, may further instruct the video management unit 45 to commence recording of the video feed for future references”), A-09 (Kim) (*e.g.*, at [0029] “[t]he operation is operated by the intruder response mode, wherein the moment the intruder response program recognizes the presence of an object captured by the camera through the sensor, the intruder response program automatically records the detected image on the video intercom inside the site, and transmits the video data to the base of the remote location specified by the user in advance.”), A-10 (Menard) (*e.g.*, at p. 21, ll. 23-26 “[e]ntry of an appropriate command causes exterior module 200D to capture an image using exterior video camera 370 and

transmit said image to 25 PDU 400. The graphical image may include a still image or real-time video images.”).

To the extent Mr. Zinser asserts the references charted in Exhibits A-01 to A-10 do not disclose “authenticate a user of the doorbell monitoring system” it would have been obvious to combine any of these charted references with (by way of example) at least A-07 (Naidoo), A-08 (Ryley), A-09 (Kim), A-10 (Menard) all of which disclose these limitations as shown in their respective charts. A person of skill in the art would be motivated to combine any of the charted references with these references because they each disclose improved system security through user authentication. Moreover, such techniques have been common knowledge in the art since long before the alleged inventions claimed in the ’191 Patent. *See, e.g.*, A-07 (Naidoo) (*e.g.*, at [0043] “[r]emote user 155 must first be authenticated by security system server 131.”), A-08 (Ryley) (*e.g.*, at [0022] “[t]he access control requires the entry of a username and password in order to gain access to the features of the security surveillance system.”), A-09 (Kim) (*e.g.*, at [0037] “if it is a preregistered visitor, the entry and exit is automatically controlled by the pre-authenticated authentication key function”), A-10 (Menard) (*e.g.*, at p. 23, ll. 11-24 “the image captured by camera 370 corresponds to an authorized user or caller, then transceiver 150D (Figure 9) sends a signal, on a wireless link, to other modular security system components (such as base 250A, Figure 7), causing perimeter security system components to be armed and interior security system components to be disarmed.”).

To the extent that Mr. Zinser asserts the references charted in Exhibits A-01 to A-10 do not disclose limitations requiring “an additional device” or a “video monitor” it would have been obvious to combine any of these charted references with (by way of example) at least A-01 (Schranz), A-06 (von Bauer), A-07 (Naidoo), A-08 (Klein), and A-09 (Kim) all of which disclose

these limitations as shown in their respective charts. A person of skill in the art would be motivated to combine any of the charted references with these references because they each disclose improving security systems to provide enhanced monitoring access through a video monitor or additional devices. Moreover, such techniques have been common knowledge in the art since long before the alleged inventions claimed in the '191 Patent. *See, e.g.*, A-01 (Schranz) (*e.g.*, at [0056] “[o]nce the system is configured the user may access this secure portal remotely via any Internet enabled device equipped with a web browser.”), A-06 (von Bauer) (*e.g.*, at 7:28-33 “[v]ideo RF signal 47 is transmitted from antenna 49 to an antenna 51 coupled to a video receiver 50 located in Video Receiver Station 32. A composite video signal representing a scene viewed by CCD camera 45 may then be coupled to a television monitor C”), A-07 (Naidoo) (*e.g.*, at [0073] “In some embodiments, due to privacy concerns, monitoring client 133 may be configured to only allow display audio and video content associated with an open alarm conditions.”), A-08 (Klein) (*e.g.*, at [0021] “[t]he rendering unit 44 receives a feed from the video camera 60 via the video interface 40, and renders the feed to a monitor 48 associated with the host computer 20.”), *see also* A-08 (Klein) (*e.g.*, at [0043] “The user may connect remotely to the host computer 20 to view the video feed, or adjust scheduling parameters in the event scheduler 22.”), A-09 (Kim) (*e.g.*, at [0079] “[u]sers can access the video intercom through the Internet, mobile phones or telephones, etc., to make video calls with people inside the site, or control the entry and exit of visitors from remote places, and access the intruder response mode to enter, modify, and change the intruder response function.”).

To the extent Mr. Zinser asserts the references charted in Exhibits A-01 to A-10 do not disclose a “proximity detector” it would have been obvious to combine any of these charted references with (by way of example) at least A-01(Schranz), A-02 (Wu), A-04 (Sheynman), A-05

(Ryley), A-06 (von Bauer), A-07 (Naidoo), A-09 (Kim), and A-10 (Menard) all of which disclose these limitations as shown in their respective charts. A person of skill in the art would be motivated to combine any of the charted references with these references because they each disclose improving security systems to provide diverse monitoring capabilities with proximity sensors. *See, e.g.*, A-01 (Schranz) (*e.g.*, at [0048] “[t]he sensor 35 may be different types, such as a motion detector, infrared radiation sensor or doorbell signal, and may be located external to the peripheral device.”), A-02 (Wu) (*e.g.*, at p. 2 “ESS is also triggered by an infrared sensor or other motion sensors, when someone moves within its sensing scope.”), A-04 (Sheynman) (*e.g.*, at [0020] “the actuator detects the presence of visitors without requiring the performance of any act. Various sensors may be used including, for example, magnetic or capacitive proximity sensors, infrared and optical sensors among many others.”), A-05 (Ryley) (*e.g.*, at [0031] “module 110 preferably also . . . includes infrared illumination capabilities and motion detection capabilities.”), A-06 (von Bauer) (*e.g.*, at 5:6-10 “[c]ircuitry included in the sensing station responds to . . . triggering of an optional infrared sensor by the presence of a person near the sensor, to send via radio waves an annunciator signal to a monitoring station within the building.”), A-07 (Naidoo) (*e.g.*, at [0036] “[e]xamples [of sensor 105] include, without limitation, magnetic contact switches, audio sensors, infrared sensors, motion detectors, fire alarms, and carbon monoxide sensors.”), A-09 (Kim) (*e.g.*, at [0025] “[w]hen a visitor approaches, the video intercom captures the object through the infrared sensor of the external device attached to the camera, and the infrared sensor and the thermal sensor are operated in conjunction to read whether the detected object is a person or not.”), A-10 (Menard) (*e.g.*, at pp. 5-6, ll. 25-17 “[t]he first module may include . . . a proximity detector coupled to the controller, the proximity detector for signaling the presence of a caller near the exterior module”).

To the extent Mr. Zinser asserts the references charted in Exhibits A-01 to A-10 do not disclose “wirelessly streaming at least a portion of the captured visual and audio communications to the control unit” it would have been obvious to combine any of these charted references with (by way of example) at least A-01 (Schranz), A-04 (Sheynman), A-05 (Ryley), A-06 (von Bauer), A-07 (Naidoo), A-08 (Klein), and A-10 (Menard) all of which disclose these limitations as shown in their respective charts. A person of skill in the art would be motivated to combine any of the charted references with these references because they each disclose improving security systems to provide wireless streaming of video and audio communications, providing greater flexibility in connecting to the camera, microphone and speaker as compared to wired connections. *See, e.g.*, A-01 (Schranz) (*e.g.*, at [0048] “[t]he peripheral device 40 connects to the SCM 43 via . . . wireless interface 39”), A-04 (Sheynman) (*e.g.*, at [0024] “[t]he exemplary network gateway 120 also includes a visitor monitor short-range radio transceiver 123 that communicates wirelessly with the gateway SRR (e.g. Bluetooth) transceiver 116 of the visitor monitor 110.”), A-05 (Ryley) (*e.g.*, at [0042] “[t]he base unit 101 acts as the master in the voice telephony system and the handsets/camera units 105, 110, 115, 120 are considered slaves. All voice connections are preferably made using the TDMA system including those that accompany a video link.”), A-06 (von Bauer) (*e.g.*, at 5:10-12 “[b]oth visual images of, and voice transmissions from, the visitor may be sent via the RF link.”), A-07 (Naidoo) (*e.g.*, at [0084] “these smart cameras may be operable to perform video capture, compression and storage and to communicate with the security gateway using a home area network, e.g., wireless or powerline.”), A-08 (Klein) (*e.g.*, at [0017] “[t]he video camera 60 communicates via wire or wireless means with a video interface 40, which in turn is connected to a host computer 20.”), A-10 (Menard) (*e.g.*, at p. 21, ll. 14-15 “In response

to actuation of the button, or detection by camera 370, exterior module 200D transmits a wireless signal.”).

As such, these combinations would have been a combination of prior art elements according to known methods and would have been the result of applying known techniques to a known method—that was ready for improvement—to yield predictable results. Moreover, these combinations would have also been obvious to try given that there were a finite number of identified, predictable solutions in the prior art, and there would have been a reasonable expectation of success to simply implement one prior art solution with concepts from prior art in the same field.

G. P.R. 3-3(d) – Invalidity Under Pre-AIA 35 U.S.C. § 112

Defendants’ aforementioned identification of prior art that anticipates and/or renders obvious particular claim elements, including the attached claim charts, should not be deemed as an admission that any claim element satisfies the requirements of Pre-AIA 35 U.S.C. § 112. Indeed, Defendants contend that the Asserted Claims are invalid for failure to meet one or more of the requirements of Pre-AIA 35 U.S.C. § 112.

Conversely, while Defendants assert below that one or more Asserted Claims is invalid under Pre-AIA 35 U.S.C. § 112 (such as because of a failure to particularly point out and distinctly claim the alleged invention, failure to provide written description support in the specification, and/or failure to enable one of ordinary skill in the art to make and use the claimed invention), Defendants have nonetheless provided prior art disclosures that anticipate or render obvious the claim on the assumption that Plaintiff will contend those claims are definite, are supported by an adequate written description, and are adequately enabled.

1. Lack of Written Description and Enablement under Pre-AIA 35 U.S.C. § 112, ¶ 1

Certain claims in the Asserted Patents are invalid for lack of written description. Section 112 requires that a patent specification “contain a written description . . . of the manner and process of making and using [the invention] in such full, clear, concise and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same.” Pre-AIA 35 U.S.C. § 112, first paragraph. A patent’s written description “must ‘clearly allow persons of ordinary skill in the art to recognize that [the inventor] invented what is claimed.’” *Ariad Pharm., Inc. v. Eli Lilly & Co.*, 598 F.3d 1336, 1351 (Fed. Cir. 2010) (en banc) (quoting *Vas-Cath Inc. v. Mahurkar*, 935 F.2d 1555, 1562–63 (Fed.Cir.1991)). The disclosure must “convey[] to those skilled in the art that the inventor had possession of the claimed subject matter as of the filing date.” *Ariad*, 598 F.3d at 1351. The level of detail required to satisfy the written description requirement varies depending on the nature and scope of the claims and on the complexity and predictability of the relevant technology, but a “mere wish or plan” for obtaining the claimed invention does not satisfy the written description requirement. *Novozymes A/S v. DuPont Nutrition Biosciences APS*, 723 F.3d 1336, 1344 (Fed. Cir. 2013). Put another way, “a description that merely renders the invention obvious does not satisfy the requirement.” *Ariad*, 598 F.3d at 1352 (citing *Lockwood v. Am. Airlines*, 107 F.3d 1565, 1571–72 (Fed. Cir. 1997)). Defendants contend that, at least under Plaintiff’s actual and/or apparent application of the claims, the Asserted Patents do not include a sufficient written description supporting the claims.

Section 112 likewise requires that the specification “enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the” claimed invention. 35 U.S.C. § 112, ¶ 1. A claim is not enabled if, “at the effective filing date of the patent, one of ordinary skill in the art could not practice their full scope without undue experimentation.”

Wyeth and Cordis Corp. v. Abbott Labs., Inc., 720 F.3d 1380, 1384 (Fed. Cir. 2013) (citing *MagSil Corp. v. Hitachi Global Storage Techs., Inc.*, 687 F.3d 1377, 1380–81 (Fed. Cir. 2012)). “This important doctrine prevents both inadequate disclosure of an invention and overbroad claiming that might otherwise attempt to cover more than was actually invented.” *MagSil Corp. v. Hitachi Global Storage Techs., Inc.*, 687 F.3d 1377, 1381 (Fed. Cir. 2012). Defendants contend that, at least under Plaintiff’s actual and/or apparent application of the claims, the Asserted Patents do not enable any person skilled in the relevant art to make and use the claimed invention of the Asserted Claims without undue experimentation.

At least under Plaintiff’s actual and/or apparent application of the claims, the Asserted Claims are invalid under Pre-AIA 35 U.S.C. § 112, first paragraph because the specification lacks an adequate written description of the alleged invention and fails to enable the full scope of the invention.

2. Doorbell ringing/activation as “triggering event” for capturing video and audio and transmitting captured video and audio

The ’191 Patent disclosure does not convey to those skilled in the art that the inventor had possession of the claimed subject matter, including subject matter where triggering or activation of a doorbell is a triggering event responsive to which a video camera and an external microphone capture video and audio and transmit captured video and audio. The specification also does not enable a person of ordinary skill in the art to make and use such an invention. The specification only discloses proximity detection as a trigger for capturing video/audio, and the doorbell ring as a trigger for the control unit communicating with the homeowner’s cellular phone based on the doorbell ring. There is no disclosure of capturing video/audio and then transmitting captured video/audio based on the doorbell being actuated. *See* 2:35-38 (proximity detection as actuating event for capturing video and audio), 3:1-9 (video cameras are motion activated; triggering event

such as ringing of doorbell “initiates the contact of the control unit to the homeowner 16; however, the plurality of video cameras 22 collect video for the homeowner’s review *irrespective of the occurrence of the triggering event.*”); 4:49-51 (“actuation of the doorbell establishes communication from the control unit portion 40 to the cellular telephone 30”); 6:15-18 (video and audio captured as a result of proximity detection).

Moreover, to the extent Defendants understand Plaintiff’s deficient infringement contentions, Plaintiff’s apparent interpretation of the Asserted Claims of the ’191 Patent is that they encompass a camera positioned with its video capturing zone covering the doorbell and capturing and interpreting the specific movement of a guest moving to press the doorbell as a triggering event. Under this overly broad and unsupported interpretation, those skilled in the art would not understand the inventor to have possession of the claimed subject matter. Such subject matter—where a specific motion towards ringing a doorbell is a triggering event—is also not enabled.

Defendants assert all asserted claims are invalid (all independent claims and their asserted dependent claims) based on this ground. Specific elements that are implicated and lack written description and enablement include:

- [1.2] a doorbell located in the doorway, the ringing of the doorbell being a triggering event;
- [1.3] a video camera and an external microphone disposed in the entry point, the video camera and external microphone, responsive to the triggering event, for capturing entry point visual and audio communications at the entry point and transmitting the captured entry point visual and audio communications;

- [14.2] means, responsive to the ringing of the doorbell, for capturing visual and audio communications at the entry point;
- [19.2] a doorway located in the doorway, the ringing of the doorbell being a triggering event;
- [19.3] a video camera and an external microphone disposed in the doorway, the video camera and external microphone for, when actuated, by the triggering event, capturing doorway visual and audio communications at the doorway and transmitting the captured doorway visual and audio communications;
- [21.2] a doorbell located in an entry point, activation of the doorbell being a triggering event;
- [21.3] a video camera and an external microphone disposed in the entry point, the video camera and the external microphone, responsive to the triggering event, for capturing visual and audio communications at the entry point and transmitting the captured visual and audio communications;
- [21.12] wherein the video camera is configured to collect the entry point visual communications captured by the single communications unit before the triggering event;
- [21.13] wherein the video camera is configured to collect additional visual communications after the triggering event;
- [23] The doorbell monitoring system of claim 21, wherein the single communications unit is configured to capture additional video from the video camera after the triggering event.

- [34.2] a doorbell located in an entry point, activation of the doorbell being a triggering event;
- [34.3] a video camera and an external microphone disposed in the entry point, the video camera and the external microphone, responsive to the triggering event, for capturing visual and audio communications at the entry point and transmitting the captured visual and audio communications;
- [34.9] wherein the video camera is configured to collect the entry point visual communications before the triggering event; and
- [34.10] wherein the video camera is configured to collect additional visual communications after the triggering event.

3. Additional written description and enablement grounds

The '191 Patent disclosure does not convey to those skilled in the art that the inventor had possession of the claimed subject matter, including subject matter where the video camera and the external microphone are integrated. The specification also does not enable a person of ordinary skill in the art to make and use such an invention. Therefore, claim 2 (“wherein the video camera and the external microphone are integrated”) is invalid for lack of written description and enablement.

The '191 Patent disclosure does not convey to those skilled in the art that the inventor had possession of the claimed subject matter, including subject matter where an alarm system interface of the control panel is configured to interface with the security system. The specification also does not enable a person of ordinary skill in the art to make and use such an invention. The alarm system interface of the '191 Patent is not disclosed as being part of the control panel. *See* FIG. 3. The only description of the interface is: “[t]he alarm system interface 68 interfaces the security

system 10 described herein with the homeowner's existing home security system. By way of example, this feature permits the homeowner to utilize the cellular telephone 30 to notify a home security company or the police department in the instance of a break-in or other crime." 5:42-48. Therefore, claim 21 ([21.11] "wherein an alarm system interface of the control panel is configured to interface with the security system;") and all asserted dependent claims are invalid for lack of written description and enablement.

The '191 Patent disclosure does not convey to those skilled in the art that the inventor had possession of the claimed subject matter, including subject matter where the doorbell monitoring system is configured to establish communication with the control unit upon activation of the doorbell. The specification also does not enable a person of ordinary skill in the art to make and use such an invention. The control unit (element [21.5]) is part of the claimed "doorbell monitoring system" and, as such, the system (as opposed to some specified component) does not establish communications with itself, i.e., the control unit. Therefore, claim 21 ([21.14] "wherein the doorbell monitoring system is configured to establish communication with the control unit upon activation of the doorbell;") and all asserted dependent claims are invalid for lack of written description and enablement.

The '191 Patent disclosure does not convey to those skilled in the art that the inventor had possession of the claimed subject matter, including subject matter where the system institutes two-way video communications between the user and the person at the entry point. The specification also does not enable a person of ordinary skill in the art to make and use such an invention. The disclosure of the '191 Patent only discloses two-way/duplexed audio communications and one-way video (to the phone). *See* FIG. 5 (steps 132, 144); 6:8-12 (duplexed audio and "one-way visual observation"); 7:1-13 (Table 2); 7:51-54 (duplexed audio only); 7:67-8:2 (same); 8:32-42

(no disclosure of two-way video); claims 10 and 16; Therefore, claim 29 (“The doorbell monitoring system of claim 28, wherein the two or more actions are at least one of (1) play a pre-recorded greeting, (2) request additional video and/or audio communications, (3) institute two-way video communications between the user and the person at the entry point, (4) notify an alarm company, or (5) selection of no action.”) and claim 43 (“The doorbell monitoring system of claim 42, wherein the two or more actions are at least one of (1) play a pre-recorded greeting, (2) request additional video and/or audio communications, (3) institute two-way video communications between the user and the person at the entry point, (4) notify an alarm company, or (5) selection of no action.”) are invalid for lack of written description and enablement.

The '191 Patent disclosure does not convey to those skilled in the art that the inventor had possession of the claimed subject matter, including subject matter where the stored video and audio communications are accessible by an additional device apart from the control unit. The specification also does not enable a person of ordinary skill in the art to make and use such an invention. The disclosure of the '191 Patent only discloses stored video and audio communications accessible to and through the control unit. Therefore, claim 31 (“The doorbell monitoring system of claim 30, wherein the stored video and audio communications are accessible by an additional device apart from the control unit.”), claim 32 (“The system of claim 30, wherein the onsite storage device is configured to provide the additional device with access to the stored video and audio communications in substantially realtime.”), claim 45 (“The doorbell monitoring system of claim 44, wherein the stored video and audio communications are accessible by an additional device apart from the control unit.”), and claim 46 (“The system of claim 44, wherein the onsite storage device is configured to provide the additional device with access to the stored video and audio

communications in substantially realtime.”) are invalid for lack of written description and enablement.

A more detailed basis for Defendants’ written description and enablement defenses will be set forth in Defendants’ expert reports on invalidity or in other papers, to be served in accordance with the Court’s Scheduling Order. Defendants have not yet taken any depositions related to these issues. Defendants specifically reserve the right to amend and/or supplement these Invalidity Contentions based on a failure to comply with the requirements of 35 U.S.C. § 112.

G. Production of Prior Art

Accompanying these Invalidity Contentions is a production containing copies of all prior art cited within these Invalidity Contentions.

II. RESERVATIONS

A. General Reservations

These Invalidity Contentions, along with the information and documents that Defendants have produced and/or are producing herewith, are provisional in nature and subject to revision. Consistent with the Scheduling Order, Local Patent Rules, and the Federal Rules of Civil Procedure, Defendants reserve the right to amend these contentions.

Defendants provide the information herein, as well as the accompanying production of documents, for the sole purpose of complying with the Scheduling Order and the Local Patent Rules. The information provided shall not be deemed an admission regarding the scope of any claims or the proper construction of those claims or any terms contained therein. Nothing contained herein should be understood or deemed to be an express or implied admission or contention with respect to the proper construction of any terms in any asserted claim, or with respect to the alleged infringement of that claim. Defendants in many instances are responding to Plaintiff’s overbroad interpretation of the patent claims implicit in Plaintiff’s infringement contentions.

Defendants reserve the right to revise their ultimate contentions concerning the invalidity of the Asserted Claims, which may change depending upon additional information obtained during the discovery period, any findings as to the priority date(s) of the Asserted Claims, and/or positions that Plaintiff or any expert witness(es) may take concerning infringement and/or invalidity issues.

B. Anticipated Discovery

Because discovery is ongoing, Defendants reserve the right to revise, amend, and/or supplement the information provided herein, including by identifying, charting, and relying on additional information, references, systems, and devices, should Defendants' further search and analysis yield additional such information, references, systems, or devices, consistent with the Scheduling Order, Local Patent Rules, and the Federal Rules of Civil Procedure.

C. Plaintiff's Infringement Contentions

Plaintiff's Infringement Contentions are deficient in numerous respects, including but not limited to the fact that the contentions do not clearly identify the allegedly infringing features of Defendants' products. Because such deficiencies may lead to further grounds for invalidity, Defendants specifically reserve the right to modify, amend, or supplement their contentions should Plaintiff modify, amend, or supplement its Infringement Contentions. Defendants expressly reserve their rights to amend these contentions to add or delete claims should Plaintiff subsequently be permitted to change its identification of Asserted Claims.

Further, Defendants' identification of a claim limitation in the prior art, based on Plaintiff's theory identified in its Infringement Contentions for the Accused Products, shall not operate as an admission that the Accused Products satisfy that claim limitation.

D. Claim Construction

These Invalidity Contentions necessarily are based in whole or in part on Defendants' present, limited understanding of Plaintiff's contentions concerning the scope and construction of

the Asserted Claims, or on Defendants' own understanding of the scope and construction of those claims. Defendants reserve the right to interpret these terms differently over the course of the litigation, and do not adopt any interpretations impliedly or expressly put forth in these contentions. Defendants also reserve the right to amend their invalidity contentions based on any further claim construction orders issued by the Court.

E. The Intrinsic Record

Defendant further reserve their right to rely upon prior art cited in the file histories of the '191 Patent and its associated ex-parte reexamination as invalidating references or to show the state of the art. Defendants also may rely on inventor admissions concerning the scope of the prior art relevant to the Asserted Claims found in, *inter alia*: the patent prosecution histories for the '191 Patent and its associated ex parte reexamination, and any related patents and/or patent applications; any deposition testimony of the named inventor(s) on the '191 Patent; and the papers filed or any evidence submitted by Plaintiff in connection with this litigation.

F. Rebuttal Evidence

Prior art not included in these Invalidity Contentions, whether known or not known to Defendants, may become relevant to rebut positions taken by Plaintiff. In particular, Defendants are currently unaware of the extent, if any, to which Plaintiff will contend that limitations of the Asserted Claims are not disclosed or suggested in the prior art identified herein, and the extent to which Plaintiff will contend that any elements not disclosed in the specifications of the '191 Patent would have been known to persons of skill in the art. To the extent that such an issue arises, Defendants reserve the right to identify other references that would illustrate the inherency of allegedly missing limitation(s), render the claims obvious, or illustrate the knowledge of those skilled in the art.

G. Contextual Evidence

Defendants' claim charts cite to particular teachings and disclosures of the prior art as applied to features of the Asserted Claims. The identified prior art, however, may contain additional descriptions of, or alternative support for, the claim limitations and inherent information. Moreover, persons having ordinary skill in the art generally may view an item of prior art in the context of other publications, literature, products, and understanding. As such, the cited portions are only exemplary, and Defendants reserve the right to rely on uncited portions of the prior art references, on disclosures inherent in the references, and on other publications and expert testimony as aids in understanding and interpreting the cited portions, as providing context thereto, and as additional evidence that the prior art discloses a claim limitation or any alleged invention as a whole.

Additionally, when Defendants cite to a particular figure in a reference, the citation should be understood to encompass the caption and description of the figure and any text relating to the figure even if such text appears elsewhere within the reference. Similarly, where Defendants cite to particular text referring to a figure, the citation should be understood to include the figure and caption as well, even if the figure and caption appear elsewhere within the reference.

H. Related References

Prior art patents or publications included in these contentions may be related (*e.g.*, as a divisional, continuation, continuation-in-part, parent, child, or other relation or claim of priority) to earlier- or later-filed patents or publications, may have counterparts filed in other jurisdictions, or may incorporate (or be incorporated by) other patents or publications by reference. The listed patents or publications are intended to be representative of these other patents or publications, to the extent they exist, as well as representative of corresponding prior art systems, products, demonstrations, techniques, services, knowledge, uses and the like. Accordingly, Defendants

reserve the right to modify, amend and/or supplement these contentions with these related patents or publications, as well as other prior art references, upon further investigation.

Date: May 11, 2026

Respectfully submitted,

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CERTIFICATE OF SERVICE

I certify that on May 11, 2026, I served via e-mail the cover document for Defendants' Invalidity Contentions to all opposing counsel of record. In addition, Exhibits A-01 to A-10 were made available to Plaintiff's counsel via file share utility.

/s/ Gilbert A. Greene
Gilbert A. Greene