

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent of: Hicks, *et al.*

Attorney Docket No.: 10030008-000022

U.S. Patent No.: 8,719,052 B2

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Title: INTERNET SYSTEM FOR CONNECTING HEALTHCARE PROVIDERS
AND PATIENTS

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**PETITION FOR *INTER PARTES* REVIEW OF UNITED STATES PATENT
NO. 8,719,052 PURSUANT TO 35 U.S.C. §§ 311–319, 37 C.F.R. § 42**

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EXHIBITS

MDX-1001	U.S. Patent No. 8,719,052 to Hicks, et al. (“‘052 Patent”)
MDX-1002	Relevant Portions of the Prosecution History of the ‘052 Patent (“Prosecution History”)
MDX-1003	Priority Provisional Application No. 60/771,757 (“Provisional Application”)
MDX-1004	Declaration of Jeff LaPointe
MDX-1005	Health Grades’ Infringement Contention Claim Chart on Accused Website (District of Colorado, Case No. 11-cv-520, Dkt. Nos. 612, 612-1, 612-2, 612-3)
MDX-1006	Prior Art Reference U.S. Patent No. 7,167,855 (“Koenig”)
MDX-1007	Prior Art Reference (“Shelton Reference”)
MDX-1008	Prior Art Reference (“HG Physician Quality Comparison Report”)
MDX-1009	Prior Art Reference (“HG Physician Quality Report”)
MDX-1010	Prior Art Reference (“Drucker Report”)
MDX-1011	Prior Art Reference U.S. Patent Application Publication No. US2002/0010616 (“Itzhaki”)
MDX-1012	Prior Art Reference U.S. Patent Application Publication No. US20060015369 (“Bachus”)
MDX-1013	Prior Art Reference U.S. Patent Application Publication No. US20060294138 (“Stolba”)
MDX-1014	Prior Art Reference U.S. Patent Application Publication No. US20020038233 (“Shubov”)
MDX-1015	Declaration of Dr. Richard G. Cooper

MDX-1016	Curriculum Vitae of Dr. Richard G. Cooper
MDX-1017	Order Regarding Claim Construction (District of Colorado, Case No. 11-cv-520, Dkt. No. 138)

MDx Medical, Inc. (“Petitioner” or “MDx”) petitions for *Inter Partes*

Review (“IPR”) under 35 U.S.C. §§ 311–319 and 37 C.F.R. § 42 of claims 1-4, and 6-33 of U.S. Patent No. 8,719,052 (“‘052 Patent”).

I. MANDATORY NOTICES UNDER 37 C.F.R § 42.8(a)(1)

A. Real Party-In-Interest Under 37 C.F.R. § 42.8(b)(1)

Petitioner, MDx Medical, Inc. is the only real party-in-interest.

B. Related Matters Under 37 C.F.R. § 42.8(b)(2)

The ‘052 Patent is the subject of a patent infringement lawsuit brought by Health Grades, Inc. in the District of Colorado: *Health Grades, Inc. v. MDx Medical, Inc.*, Case No. 1:14-cv-01268-MEH (“the Litigation”).

The ‘052 Patent claims priority to an application that led to U.S. Patent No. 7,752,060, which is the subject of a patent infringement lawsuit also brought by Health Grades, Inc. in the District of Colorado: *Health Grades Inc. v. MDx Medical, Inc.*, Case No. 1:11-cv-00520-RM-BNB. This case is listed here for completeness.

C. Lead And Back-Up Counsel Under 37 C.F.R. § 42.8(b)(3)

MDx provides the following designation of counsel.

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D. Service of Information Under 37 C.F.R. § 42.8(b)(4)

MDx respectfully requests that all correspondence/service be addressed to counsel at the address provided in Section I(C). MDx also consents to electronic service by email at sstimpson@sillscummis.com, dlee@sillscummis.com and vferraro@sillscummis.com.

II. PAYMENT OF FEES – 37 C.F.R. § 42.103

MDx authorizes the Patent and Trademark Office to charge Deposit Account No. 03-1250 for the fee set in 37 C.F.R. § 42.15(a) for this Petition and further authorizes payment for any additional fees to be charged to this Deposit Account.

III. SUMMARY OF THE ‘052 PATENT

A. Brief Description

The ‘052 Patent “generally relates to an Internet-based system and method that connects patients with potential healthcare providers, e.g., physicians and hospitals.” MDX-1, at 1:19-21. “More particularly, the present invention relates to providing on-line ratings and reports comprised of detailed healthcare provider information with verified information sections, including physician verified and/or independent third-party-verified portions, and patient-provided information sections, to assist patients in differentiating among healthcare providers.” *Id.*, at 1:21-27.

The ‘052 Patent identifies what it claims to be a “well-recognized problem” that it intends to cure. *Id.*, at 1:38-41 (BACKGROUND section). Notably, the problem that the ‘052 Patent allegedly addresses is that people often cannot assess the veracity of the information they obtain on the Internet regarding physicians, hospitals and the like. *Id.* The ‘052 Patent also indicates that it is difficult to obtain healthcare provider information because there are few, if any, resources available for patients to discover any information, must less verified information about physicians or hospitals. *Id.*, at 1:42-45. It also indicates that any information about physicians or hospitals on the Internet is provided by the physicians or hospitals themselves. *Id.*, at 1:45-48. Such information, the ‘052

Patent claims, may not be updated on a regular basis or may contain inaccurate or incomplete information. *Id.*, at 1:48-50. And further, according to the ‘052 Patent, even if such information is available, it is usually not organized in a manner that would allow a patient to compare physicians or hospitals, search for a particular physician or hospital by geographic area or other criteria, or verify a physician’s or hospital’s certification and licensures. *Id.*, at 1:50-54.

The ‘052 Patent includes 33 claims, with claims 1 and 18 being independent. The ‘052 Patent’s claims all recite various requirements of the specific information accessed for creating either a results list of healthcare professional information or a healthcare professional report in response to a request, where that information must be obtained, and what should be in either the results lists or report. *Id.*, at 20:23-61 and 22:1-45.

B. Summary of the Prosecution History of the ‘052 Patent

U.S. Patent No. 8,719,052 issued on May 6, 2014 from U.S. Patent Application No. 13/551,471 (“the ‘471 application”), which was filed on July 17, 2012. MDX-1001, at Cover Page. On the same day the ‘471 application was filed (July 17, 2012), Health Grades submitted a preliminary amendment cancelling original claims 1-20 and adding new claims 21-53. MDX-1002, at 1-14.

The Patent Examiner (“Examiner”) issued a first non-final Office action on April 5, 2013 (“Office action”). *Id.*, at 102-149. In the Examiner’s April 5, 2013

Office Action, she rejected all the pending claims, 21-53, in light of the cited prior art. Id., at 102-127. In particular, the Examiner rejected claims 21-53 as being unpatentable over various combinations of U.S. Pat. Pub. No. 2003/0195838 to Henley, U.S. Pat. Pub. No. 2006/0161456 to Baker et al., U.S. Pat. Pub. No. 2004/0024618 to Martin et al, U.S. Patent No. 6,014,629 to DeBruin-Ashton, U.S. Pat. Pub. No. 2003/0195838 to Sameh and U.S. Patent Pub. No. 2006/0080146 to Cook. Id.

Regarding independent claim 21 (the results list claim), the Examiner relied on Henley for the disclosure of the receiving the request for healthcare professional information step, the creating the results list step, the patient-provided information element, the comparison rating element, and the providing access to the results lists step. Id., at 105-108. The Examiner relied on Baker for the disclosure of the healthcare professional-provided information and comparison rating elements. Id. Finally, the Examiner relied on Martin for the disclosure of the third party-verified information element. Id.

Regarding independent claim 38, the Examiner relied on Henley for the disclosure of the receiving a request for information regarding a first healthcare professional step, the compiling patient-provided information step, and the providing access to the report step. Id., at 117-120. The Examiner once again relied on Baker for the disclosure of the three or more healthcare professional-

verified information element. Id. The Examiner also again relied on Martin for the disclosure of the three or more information verified by an independent third-party source element. Id. Finally, the Examiner relied on Cook for the disclosure of the creating a report on the first healthcare professional using all the different types of data step. Id.

Prior to filing a response to the Office action, Health Grades' representatives attended an Examiner Interview with Examiners Nguyen and O'Connor on August 27, 2013. Id., at 210-212. Based on the Examiner's Interview Summary, the parties discussed the '060 patent and the Henley, Baker, Martin and Cook references as well as possible amendments to the claims to overcome the outstanding rejections. Id.

In response to the Office action, Health Grades amended independent claim 21 to clarify that the request was for "a results list of" of healthcare professional information and not just a "request for healthcare professional information." Id., at 214. Independent claim 38 was not amended. Id., at 218-219. In the response, Health Grades argued that Henley merely relates to reducing transactional costs associated with providing professional services by enabling prospective clients/patients and professional service providers to competitively negotiate fees for proffered services through an interactive on-line professional services auction transaction system implemented over a public network such as the Internet. Id., at

225-227. In other words, Health Grades argued that Henley simply disclosed an on-line auctioning website. Id. Health Grades continued by stating that Henley fails to teach all of the recited features of claim 21 and then simply reiterated every element of claim 21 except for the first one. Id.

Health Grades attacked Baker by arguing that it only teaches a ranking system for presenting information to patients and attacked Martin by arguing that it only relates to linking credentialing information with a medical malpractice insurance application to generate a medical malpractice insurance policy. Id., at 227-228. Health Grades concluded by simply arguing that neither reference teach all the elements of claim 21, which were then repeated. Id.

Finally, with respect to claim 38, Health Grades first argued that Henley, Baker and Martin fail to teach all of the features for similar reasons discussed with respect to claim 21. Id., 228-230. Health Grades then stated that Cook relates to identifying health information systems based on compatibility and capability of improving quality, safety and cost effectiveness of health care, to identify healthcare providers who are using such technology and to assist patients to find these healthcare providers. Id. Once again, Health Grades simply concluded that Cook fails to teach all of the elements of claim 38 and just reiterated all the elements of the claim. Id.

On November 22, 2013, the Examiner issued a Notice of Allowance allowing all the pending claims, 21-53. Id., at 291-324. In the Notice of Allowance, the Examiner amended claims 21, 38 and 42, though the amendments were minor and appear to have been made to clarify the claimed subject matter. Id., at 298-302.

In the Reasons for Allowance section of the Notice of Allowance, the Examiner simply indicated that the prior art of record neither anticipate nor fairly and reasonably teach the claims subject matter and then simply set forth claim 21 in its entirety. Id., at 302-304. The Examiner then indicated that the reasons for allowance of claim 38 are similar to that of claim 21. Id. The Examiner also stated that the “most remarkable prior art” of record were the Henley, Cook, Baker and Martin references. Id. Finally, in the last paragraph, the Examiner indicated that the cited prior art references of record specifically fail to expressly teach (1) providing healthcare provider information to potential patients where the healthcare professional-verified information is received from the healthcare professional and comprises at least three or more from the enumerated group; and (2) wherein the information verified by the independent third-party source comprises three or more from the enumerated group. Id.

C. The Effective Priority Date of the Claims of the '052 Patent

The '052 patent claims priority to prior applications filed July 2, 2010; August 29, 2006; and February 8, 2006. Specifically, the earlier filed applications are as follows: (1) provisional application serial no. 60/771,757, filed February 8, 2006 (the “757 Provisional”); (2) nonprovisional application serial no. 11/512,529, filed August 29, 2006 (“529 Application”); and (3) nonprovisional application serial no. 12/830,255, filed July 2, 2010 (“255 Application”). For the following reasons, Petitioner submits that the earliest potential priority date for claims 1-17 of the '052 Patent is July 12, 2012 (the actual filing date of the '052 Patent) and the earliest potential priority date for claims 18-33 of the '052 Patent is August 29, 2006, the actual filing date of the '529 Application. See Cooper Report, at ¶¶ 14-19.

Federal Circuit law is clear, for a claim of an issued patent to “be afforded the priority date of the provisional application, the two applications must share at least one common inventor and the written description of the provisional must adequately support the claims of the non-provisional application.” *New Railhead Mfg., L.L.C. v. Vermeer Mfg. Co.*, 298 F.3d 1290, 1294 (Fed. Cir. 2002). “In other words, the specification of the provisional must ‘contain a written description of the invention and the manner and process of making and using it, in such full,

clear, concise, and exact terms,’ 35 U.S.C. § 112 ¶ 1, to enable an ordinarily skilled artisan to practice the invention claimed in the non-provisional application.” *Id.*

None of the ‘757 Provisional, the ‘529 Application, or the ‘255 Application support the following claim element of independent claim 1: “creating ... the results list of healthcare professional information using ... three or more of [professional-provided information] ... patient provided information ... [and] three or more of [third-party verified information]”). Therefore, claim 1 of the ‘052 Patent, and each of its dependent claims 2-17, are not entitled to the earlier filing dates of any of the prior applications. They should be afforded an effective filing date of July 17, 2012 -- the actual filing date of the ‘052 Patent. See Cooper Report, at ¶¶ 14-19.

Additionally, the ‘757 Provisional does not support the following claim element of independent claim 1: “comparison rating for the one or more healthcare professionals”. Nor does it support the following claim element of independent claim 18: “comparison rating of the first healthcare professional”. Thus, even if claim 1 of the ‘052 Patent (and its dependent claims) were entitled to a priority date of an earlier application (it is not), the earliest potential priority date would be August 29, 2006, the actual filing date of the ‘529 Application and not the provisional application (the ‘757 Provisional). Moreover, claim 18 of the ‘052 Patent (and each of its dependent claims) is not entitled to the earlier filing date of

the ‘757 Provisional, and instead has an earliest potential priority date of August 29, 2006, the actual filing date of the ‘529 Application. See Cooper Report, at ¶¶ 14-19.

IV. REQUIREMENTS FOR IPR UNDER 37 C.F.R. § 42.104

A. Grounds for Standing Under 37 C.F.R. § 42.104(a)

MDx certifies that the ‘052 Patent is available for IPR. The present petition is being filed within one year of service of a complaint against MDx in the Litigation. MDx is not barred or estopped from requesting this review. Moreover, MDx certifies that under the AIA Technical Corrections Act, which took effect on January 14, 2013 (and applies to proceedings commenced on or after that date), the ‘052 Patent is available for IPR because it is “a patent that is not described in section 3(n)(1) of the Leahy-Smith American Invents Act,” (i.e., has an effective filing date prior to March 16, 2013) (*see* 37 C.F.R. § 42.102(a)(2)) and, therefore, may be instituted as of the date of the grant of the patent.

B. Challenge Under 37 C.F.R. §42.104(b) and Relief Requested

The challenges in this Petition are separated into Group 1 and Group 2. Group 1 (labeled with the designation below “Ground 1_”) addresses claims 1-4 and 6-17; and Group 2 (labeled with the designation below “Ground 2_”) addresses claims 18-33.

Ground	'052 Patent Claims	Basis for Rejection
Ground 1A	Claims 1, 2, 4, 6-10 and 15-17	Anticipated And Obvious In View Of Shelton
Ground 1B	Claims 1, 2, 4, 6-10 and 15-17	Obvious Over Shelton In View Of PQCR
Ground 1C	Claims 2 and 3	Ground 1A or 1B in View Of Bachus and Itzhaki
Ground 1D	Claim 11	Ground 1A or 1B In View Of Stolba
Ground 1E	Claims 12-14	Ground 1A or 1B In View Of Shubov
Ground 2A	Claims 18-29 and 33	Obvious Over Shelton In View of The PQR
Ground 2B	Claim 18-29 and 33	Obvious Over Shelton In View of Drucker
Ground 2C	Claims 18-29 and 33	Obvious Over Ground 2A In View of Koenig And Obvious Over Ground 2B In View Of Koenig
Ground 2D	Claims 19-22 and 27- 29	Obvious Over Ground 2A In View of Itzhaki and Obvious Over Ground 2B In View of Itzhaki and Obvious Over Ground 2C In View of Itzhaki
Ground 2E	Claims 30 and 32	Obvious Over Ground 2A In View of Stolba

		and Obvious Over Ground 2B In View of Stolba and Obvious Over Ground 2C In View of Stolba and Obvious Over Ground 2D In View of Stolba
Ground 2F	Claim 31	Obvious Over Ground 2E In View of Bachus

Brief Discussion of the Prior Art:

Shelton Reference (MDX-1007): The Shelton Reference is a printed publication that was published in August of 2004 by the National Committee for Quality Assurance (“NCQA”), and, therefore, qualifies as prior art under 35 U.S.C. § 102(b), as it was published more than one year prior to even the earliest potential priority date for the ‘052 patent (i.e., before February 8, 2005). The Shelton Reference discloses, among other things, online patient directories that provide results lists and physician reports, and that contain data from various sources.

Health Grades’ Physician Quality Comparison Report (“PQCR”) (MDX-1008): The PQCR is a printed publication that was published on December 28, 2004 by Health Grades, Inc., and, therefore, qualifies as prior art under 35 U.S.C. § 102(b), as it was published more than one year prior to even the earliest potential priority date for the ‘052 patent (i.e., before February 8, 2005). *See also* LaPointe Declaration, MDX-1004. The PQCR discloses, among other things, a results list

of physicians generated from a user conducting a search based on the user's preferences, with the results list including various data elements.

Health Grades' Physician Quality Report ("PQR") (MDX-1009): The PQR is a printed publication that was published on September 15, 2004 by Health Grades, Inc., and, therefore, qualifies as prior art under 35 U.S.C. § 102(b), as it was published more than one year prior to even the earliest potential priority date for the '052 patent (i.e., before February 8, 2005). *See also* LaPointe Declaration, MDX-1004. The PQR discloses, among other things, a report on a physician generated from a user conducting a search based on the user's preferences, with the report including various data elements.

The Drucker Report (MDX-1010): The Drucker Report is a printed publication that was published on June 4, 2005 by Health Grades, Inc., and, therefore, qualifies as prior art under 35 U.S.C. § 102(b), as it was published more than one year prior to the August 29, 2006 priority date for the '052 patent (i.e., before August 29, 2005). The Drucker Report is also prior art under 35 U.S.C. § 102(a) as a publication of another. *In re Katz*, 69 F.3d 1303 (Fed. Cir. 2011); *see also* MPEP § 2132. The Drucker Report discloses, among other things, a report on a physician including various data elements.

U.S. Patent Application Publication Number 2002/0010616 ("Itzhaki") (MDX-1011): Itzhaki is a published patent application that published January 24,

2002 by the United States Patent and Trademark Office, and, therefore, qualifies as prior art under at least 35 U.S.C. § 102(b), as it was published more than one year prior to even the earliest potential priority date for the ‘052 patent (i.e., before February 8, 2005). Itzhaki discloses a system and method for connecting a client to a counselor over a communications network.

U.S. Patent Application Publication Number 2006/0015369 (“Bachus”)

(MDX-1012): Bachus is a published patent application that published January 19, 2006 by the United States Patent and Trademark Office and, therefore, qualifies as prior art under at least 35 U.S.C. § 102(a), as it was published prior to even the earliest potential priority date for the ‘052 patent (i.e., before February 8, 2006). Bachus also qualifies as prior art under 35 U.S.C. § 102(e), as it was granted on an application of another filed prior to even the earliest potential priority date for the ‘052 patent (i.e., before February 8, 2006). Bachus discloses an online database of healthcare provider recommendations to assist patients in choosing a physician.

U.S. Patent Application Publication Number 2006/0294138 (“Stolba”)

(MDX-1013): Stolba is a published patent application that published December 28, 2006 and qualifies as prior art under 35 U.S.C. § 102(e), as it was granted on an application of another filed prior to even the earliest potential priority date for the ‘052 patent (i.e., before February 8, 2006). Stolba discloses a system for providing ratings of professionals as well as advertisements for the professionals.

U.S. Patent Application Publication Number 2002/0038233 (“Shubov”)

(MDX-1014): Shubov is a published patent application that published March 28, 2002 by the United States Patent and Trademark Office, and, therefore, qualifies as prior art under at least 35 U.S.C. § 102(b), as it was published more than one year prior to even the earliest potential priority date for the ‘052 patent (i.e., before February 8, 2005). Shubov discloses a system for matching consumers with service providers via a matching system that uses computers connected to a server through a network.

U.S. Patent Number 7,167,855 (“Koenig”) (MDX-1006): Koenig is a U.S. Patent that was filed on August 11, 2000 with the United States Patent and Trademark Office, and, therefore, qualifies as prior art under at least 35 U.S.C. § 102(e), as it was filed before even the earliest potential priority date for the ‘052 patent (i.e., before February 8, 2006). Koenig discloses an Internet-based matching service for expert consultants and customers with matching of qualifications and times of availability.

C. Claim Construction under 37 C.F.R. §§ 42.104(b)(3)

A claim subject to IPR is given its “broadest reasonable construction in light of the specification of the patent in which it appears.” 37 C.F.R. § 42.100(b).

Accordingly, for purposes of this proceeding only, MDx submits constructions for the following terms. All remaining terms should be given their plain meaning.¹

1. Comparison Rating

“a comparison rating for the one or more healthcare professionals” (claim 1)

Based on Health Grades’ comments, we expect in the Litigation that it will assert that this “comparison rating” element can be met by a single patient rating – the same as claimed in the ‘052 Patent at 20:48-50. If Health Grades will take that position, we expect Health Grades to make the same allegation here, as that would be the “broadest” interpretation.

As Dr. Cooper opines (MDX-1015), both the claims and specification of the ‘052 Patent treat “patient ratings” and “comparison ratings” differently. *See, e.g.*, MDX-1001 at 20:48-50 (claiming patient ratings) and 20:58-59 (claiming comparison rating); *see also* 9:8-32 (patient ratings) and 2:2-12 (comparison rating). Therefore, Petitioner submits that the construction for this claim term is “a

¹ Because the standards of claim interpretation applied in litigation differ from PTO proceedings, any interpretation of claim terms in this IPR is not binding upon Petitioner in any litigation related to the ‘052 Patent, the ‘060 Patent, or any related patent or patent application. *See In re Zletz*, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989).

rating, separate from a patient rating for a healthcare professional, for comparing the healthcare professional”. Cooper Report, at ¶23.

“a comparison rating of the first healthcare professional” (claim 18)

We expect Health Grades to take the same position with regard to the “comparison rating” of claim 18. The “comparison rating” element in claim 18 is very similar. *See* MDX-1001 at 22:22-24 and at 22:39-40. Therefore, Petitioner submits that the construction for this claim term is “a rating, separate from a patient rating for the first healthcare professional, for comparing the first healthcare professional”.

2. Using The Information

“creating a results list using the healthcare professional information” (claim 1)

Claim 1 recites “creating a results list using the healthcare professional information”, but goes on to further define “the healthcare professional information” as comprising several pieces of information:

- healthcare professional-provided information received from the one or more healthcare professionals, wherein the healthcare professional-provided information comprises three or more from the group consisting of [health professional-provided data];
- patient-provided information comprising patient ratings from one or more patients of the one or more healthcare professionals;

- third party-verified information verified by an independent third-party, the third-party information comprises three or more from the group consisting of [third party-verified data];
- a comparison rating for the one or more healthcare professionals.

This claim element is not described elsewhere in the specification.

Therefore, the broadest reasonable construction for this claim term is “creating a results list using at least: three or more from the group consisting of [claimed health professional-provided data], patient ratings, three or more from the group consisting of [claimed third party-verified data], and a comparison rating for the one or more healthcare professionals”. See Cooper Report, at ¶25.

“creating a healthcare professional report on the first healthcare professional using the healthcare professional-verified information, the patient-provided information, and the information verified by an independent third-party source” (claim 18)

This claim element is addressed in the specification at 22:8-32. From the plain language of the claim, which includes similar language to claim 1 defining the three types of data, this element means “creating a report on the first healthcare professional using at least: three or more from the group consisting of [claimed health professional-provided data], patient ratings, and three or more from the group consisting of [claimed third party-verified data]. See Cooper Report, at ¶26.

3. Healthcare Professional-Verified

“healthcare professional-verified information” (claim 18)

In the Litigation, Health Grades has consistently argued that receiving information from a healthcare professional automatically makes the information “verified” by the healthcare professional. In fact Health Grades asserts that the Court has already interpreted this element in connection with the related ‘060 Patent to require only receipt from the healthcare professional or its agent, and nothing more is required. *See* Health Grades Infringement Charts, MDX-1005; see also MDX-1017, page 15, n.8 (Markman order: “the confirmation described appears to not extend beyond receipt of such information from the first healthcare provider”).

Petitioner disagrees that mere receipt is sufficient to also meet the verification requirement. *See, e.g.,* MDX-1, Figure 16 and accompanying text (separately addressing receipt and verification); *but see also* claim 17 (dependent claim reciting verification by receipt). However, if the Health Grades position is a reasonable broad position, then it must apply to the prior art for this proceeding. 37 C.F.R. § 42.100(b).

V. MANNER OF APPLYING CITED PRIOR ART TO EVERY CLAIM FOR WHICH IPR IS REQUESTED, THUS ESTABLISHING A REASONABLE LIKELIHOOD THAT AT LEAST ONE CLAIM OF THE '052 PATENT IS UNPATENTABLE

During prosecution of the '052 Patent, the Examiner stated that the specific sources of data were not found in the prior art, and allowed the claims to issue. *See* MDX-2, Notice of Allowance. To this point, Petitioner submits here the Shelton prior art, which unequivocally discloses the sources of data as found in the '052 Patent claims. Shelton was not part of the prosecution, and its disclosure renders these claims invalid.

Below, the invalidity analyses are broken into Group 1 and Group 2. The Group 1 analyses apply to claims 1-4, and 6-17; and the Group 2 analyses apply to claims 18-33.

GROUP 1 ANALYSES: CLAIMS 1-4, 6-17

1A. Claims 1, 2, 4, 6-10 and 15-17 Are Anticipated And Obvious In View Of Shelton

As shown in the claim chart below, Shelton teaches every element of claims 1, 2, 4, 6-10, and 15-17 of the '052 Patent. The claim chart thus addresses anticipation, and is supplemented with discussion in Section 1A(i), *supra*. In the event that the PTAB believes not all elements are found in Shelton, obviousness is addressed in Section 1A(ii), *supra*.

Shelton recommends more than ten data elements, including patient-ratings, be searchable to generate a results list. Shelton also discloses the identical sources for the various data elements as in claim 1 of the '052 Patent. The analyses are also supported by the Declaration of Dr. Richard Cooper, MDX-1015.

Claim of the '052 Patent	Anticipated and Obvious by Shelton
1. A computer-implemented method of providing healthcare professional information to potential patients, said method comprising:	<u>The Shelton Reference</u> : <i>See, e.g.</i> , Figures 1-3 and page 1 text. <i>See also, e.g.</i> , page 9: "An online physician directory provides users with easy access to descriptive and quality-related information about physicians."
(a) receiving, at one or more server computers operated by a service provider who provides a service for connecting healthcare professionals with the potential patients, a request for a results list of healthcare professional information, wherein the one or more server computers comprise at least one computer processor and memory;	<u>The Shelton Reference</u> : Shelton teaches extensive searching options for users, and the generation of results lists. <i>See, e.g.</i> , Figures 1-3 and accompanying text (results lists generated by user searching, <i>e.g.</i> , Figure 3). <i>See also</i> page vii: "Most members strongly advise that as many elements as possible be searchable, so that consumers have the maximum flexibility in finding the providers they want." The Shelton Reference inherently discloses the use of server computers, wherein the one or more server computers comprise at least one computer processor and memory. Cooper Report, at ¶49.
(b) in response to the request for the results list of healthcare professional information, creating, by at least one of the one or more server computers, the results list of healthcare professional information using the healthcare professional	<u>The Shelton Reference</u> : <i>See</i> discussion in Element 1(a).

Claim of the '052 Patent	Anticipated and Obvious by Shelton
information for one or more healthcare professionals, and wherein the healthcare professional information comprises:	
(i) healthcare professional-provided information received from the one or more healthcare professionals, wherein the healthcare professional-provided information comprises three or more from the group consisting of: specialty information, medical philosophy, gender, age, years in profession, years in practice, awards, honors, professional appointments, professional memberships, publications, languages, and hobbies;	<u>The Shelton Reference</u> : <i>See e.g.</i> , pages 11-13 where gender, specialty information, years in practice, professional appointments and languages are shown to be provided by the physician. <i>See also</i> Pages vii and 9 of the Shelton Reference, which states that it is advisable that <i>as many elements as possible</i> be searchable and that the online directories should provide as much information to consumers as can be kept current and accurate. This information is thus taught by Shelton as being used to generate the results list. Cooper Report, at ¶51.
(ii) patient-provided information comprising patient ratings from one or more patients of the one or more healthcare professionals;	<u>The Shelton Reference</u> : Shelton discloses “patient survey data” (page 19), which are ratings and not open-ended comments. <i>See also, e.g.</i> , pages 10 and 19 (page 10 recommending “as useful for consumer choice . . . performance measures”; and at page 19 describing the “performance measures” survey results measuring such things as a doctor’s communication, wait times, and courteousness and helpfulness of staff, and “similar information”). <i>Contrast</i> “Patient open-ended comments” at page 19. <i>See also</i> Section 1A(i), <i>supra</i> (addressing why these Shelton surveys are

Claim of the '052 Patent	Anticipated and Obvious by Shelton
	<p>inherently “ratings”).</p> <p><i>See also</i> Pages vii and 9 of the Shelton Reference, which states that it is advisable that <u><i>as many elements as possible</i></u> be searchable. Cooper Report, at ¶51.</p>
<p>(iii) third party-verified information verified by an independent third-party, the third-party information comprises three or more from the group consisting of: board certification, licensure, disciplinary action information, medical school, medical internship, medical residency, and medical fellowship information; and</p>	<p><u>The Shelton Reference</u>: The Shelton Reference teaches the use of numerous of these third-party verified data elements. <i>See e.g.</i>, pages 11-13 where internships, residencies, fellowships, medical school, licensure, board certification, and disciplinary action information are shown to be verified by an independent third-party.</p> <p><i>See also</i> Pages vii and 9 of the Shelton Reference, which states that it is advisable that <u><i>as many elements as possible</i></u> be searchable. Cooper Report, at ¶51.</p>
<p>(iv) a comparison rating for the one or more healthcare professionals; and</p>	<p><u>The Shelton Reference</u>: <i>See</i> Element (b)(ii). Searching by patient ratings would mean that the patient ratings of multiple physicians would be used to create the resulting list. Cooper Report, ¶51.</p>
<p>(c) providing access to the results list over a computer network.</p>	<p><u>The Shelton Reference</u>: <i>See, e.g.</i>, Figures 1-3 and accompanying text: “most health plans now make their physician directories available online to consumers.” (Cover Page, ABSTRACT). “A large proportion of the population now relies on Web sites for health information, and most health plans have put their directories online.” (Page v). <i>See also</i> Page 9, and pages 2-4 (showing results of NCQA searches “on various Web sites”).</p>
<p>2. The method as defined in claim 1, wherein the patient ratings are</p>	<p><u>The Shelton Reference</u>: Shelton teaches that the surveys are performed on a Web site operated by the service provider. <i>See, e.g.</i>, page 10 (“Following are</p>

Claim of the '052 Patent	Anticipated and Obvious by Shelton
received from an on-line patient experience survey completed by the one or more patients of the one or more healthcare professionals and wherein the on-line patient experience survey is completed on a Web site operated by the service provider.	the specific elements that the consensus panel <u><i>recommends as . . . feasible for directory sponsors to obtain. . .</i></u> ” (emphasis added); page 19 (“Patient Survey Data”, “ <u><i>Data Source Patient survey . . .</i></u> ” (emphasis added). <i>Compare and contrast</i> pages 11-18 generally (recommending that directory sponsor obtain data from physician, health plan, hospital, state, etc.).
4. The method as defined in claim 1, wherein the one or more patients of the one or more healthcare professionals are past or current patients.	<u>The Shelton Reference</u> : The Shelton Reference discloses the use of patient survey data. <i>See, e.g.</i> , Page 19, and analysis of Element 1(b)(ii), <i>supra</i> .
6. The method as defined in claim 1, wherein the access to the results list is obtained through a predetermined Web page that provides search capabilities for a database comprised of the healthcare professional information of the one or more healthcare professionals.	<u>The Shelton Reference</u> : Shelton teaches searching and obtaining the results lists over predetermined web pages. <i>See, e.g.</i> , Figure 3 and accompanying text. <i>See also</i> “most health plans now make their physician directories available online to consumers.” (Cover Page, ABSTRACT). “A large proportion of the population now relies on Web sites for health information, and most health plans have put their directories online.” (Page v). <i>See also</i> Elements 1(a) and (b), <i>supra</i> .
7. The method as defined in claim 6, wherein the search capabilities permit a search based on one or more from the group consisting of: name, medical specialty, gender, state, city, procedure,	<u>The Shelton Reference</u> : <i>See, e.g.</i> , Figure 3 and accompanying text. “The panel also considered the navigability of online directories. Most members strongly advise that as many elements as possible be searchable, so that consumers have the maximum flexibility in finding the providers they want.” (Page vii). <i>See also, e.g.</i> , Figure 3: “You Have Chosen: Find Physician by Name – Maryland Smith.”

Claim of the '052 Patent	Anticipated and Obvious by Shelton
diagnosis, procedure, and location criteria.	
8. The method as defined in claim 1, wherein the results list displays all of the healthcare professional information relating to the one or more healthcare professionals.	<u>The Shelton Reference</u> : <i>See, e.g.</i> , Figures 1-3 and Pages vii (searching with “as many elements as possible”) and page 9 (“an online directory should: provide as much information as can be kept current accurate.”). <i>See also</i> Section 1B(ii), <i>infra</i> .
9. The method as defined in claim 1, further including displaying in the results list two or more of the healthcare professional-provided information.	<u>The Shelton Reference</u> : The Shelton Reference discloses this claim language. <i>See, e.g.</i> , Figures 1-3 and Pages vii (searching with “as many elements as possible”) and page 9 (“an online directory should: provide as much information as can be kept current accurate.”). <i>See also</i> Section 1B(ii), <i>infra</i> .
10. The method as defined in claim 9, further comprising sending the results list to a second device for displaying in the results list two or more third party-verified information.	<u>The Shelton Reference</u> : The Shelton Reference discloses this claim language. <i>See, e.g.</i> , Figures 1-3, the Abstract, and pages 1 and 9. It is inherent that the results list of the Shelton Reference is sent from a first device (e.g., the online directory’s system) to a second device (e.g., a user’s computer). <i>See, also</i> , 1(c); and Figures 1-3 and Pages vii (searching with “as many elements as possible”) and page 9 (“an online directory should: provide as much information as can be kept current accurate.”). <i>See also</i> Section 1B(ii), <i>infra</i> .
15. The method as defined in claim 1, wherein the one or more healthcare professionals are physicians.	<u>The Shelton Reference</u> : <i>See, e.g.</i> , Figure 3: “You have Chosen: Find Physician by Name – Maryland Smith.” <i>See also, e.g.</i> , entire Shelton reference addressing “physicians” throughout.
16. The method as defined in claim 1, wherein the	<u>The Shelton Reference</u> : Shelton teaches the service provider itself ensuring data accuracy, and generally

Claim of the '052 Patent	Anticipated and Obvious by Shelton
independent third party is the information service provider.	validating data. <i>See, e.g.</i> pages9-10, “2. An online physician directory should provide context for the detailed data reported. Such contextual information can be a general part of the Web site, or where needed can be included with individual elements. The recommendations on specific elements, which follow, provide guidelines. At minimum, the directory should provide: “Data validation: <i>Did the site ensure</i> that the data are accurate? Using what sources? The specific recommendations indicate which elements should be validated. In most cases the consensus panel recommends using validation sources approved by accrediting agencies.” <i>See also</i> pages 11-19 (discussing the various data needing verification); <i>see also</i> claim 17 (confirming such verification can be by receiving information from sources other than the healthcare professional).
17. The method as defined in claim 16, wherein the information service provider verifies the third-party verified information by receiving it from an entity other than the one or more healthcare professionals.	<u>The Shelton Reference:</u> <i>See, e.g.</i> , page 12 (medical school data received from the school issuing the degree), page 14 (licensure data validated by receiving it from the state(s) issuing the license, and board certification validated by specialty boards or other sources, disciplinary action validated by sanctioning organizations). <i>See also</i> analysis of claim 16.

1A(i): Anticipation by Shelton

In order to anticipate, a reference must disclose each and every element of the claimed invention, whether it does so explicitly or inherently. *Eli Lilly & Co. v. Zenith Goldline Pharms., Inc.*, 471 F.3d 1369, 1375 (Fed. Cir. 2006). The

reference need not satisfy an *ipsissimis verbis* test, however. *In re Bond*, 910 F.2d 831, 832-33 (Fed. Cir. 1990).

As shown in the claim chart, Shelton teaches every element of numerous claims of the '052 Patent. Petitioner submits that the Shelton teaching is plain and clear, but adds the following commentary, to clarify and further explain the anticipation.

Element 1(a)(ii) – patient “ratings”: While Shelton does not use the word “ratings” in its disclosure, the Shelton “patient survey data” at page 19 are inherently ratings. That is, while Shelton recommends the use of patient survey data as useful for consumer choices, it expressly distinguishes these surveys (under the heading “Performance Measures”) from “Patient open-ended comments” which are addressed separately at the bottom of page 19. Answers in the patient survey data are not open-ended comments and thus must be ratings. For example, the question “how well Doctors Communicate” when not answered by open-ended comments must be answered by ratings (e.g., excellent, good, fair, poor). Cooper Report, at ¶¶45-46; *see also Continental Can Co. USA v. Monsanto Co.*, 948 F.2d 1264, 1268 (Fed. Cir. 1991) (describing the law on inherency).

Element 1(a)(iv) – “comparison rating”: Shelton plainly discloses searching physicians and results lists of physicians matching search criteria (*see, e.g.*, Figure 3 and accompanying text), and inherently teaches searching physicians using

patient survey data, *i.e.*, patient ratings (see Element 1(a)(ii), *supra*). *See Continental Can Co. USA v. Monsanto Co.*, 948 F.2d 1264, 1268 (Fed. Cir. 1991) (describing the law on inherency). Because searches of physicians matching patient survey data (patient ratings) criteria would necessarily consider the patient ratings of multiple physicians in generating the results list, Shelton inherently teaches creating a results list using multiple patient ratings of physicians, *i.e.*, using patient ratings and comparison ratings. Cooper Report, at ¶51.

Element 1(b): Creating a Results List Using: Shelton teaches that “as many elements as possible be searchable, so that consumers have the maximum flexibility in finding the providers they want” (page vii). This maximum flexibility naturally would result in using all of the Shelton claim elements in generating the results lists, including all of the claimed elements. Cooper Report, at ¶51; *see also* Element 1(a)(iv), *supra*. *See W.M. Wrigley Jr. Co., v. Cadbury Adams USA LLC*, 683 F.3d 1356, 1360-63 (Fed. Cir. 2012) (prior art that teaches different possible combinations anticipates if one combination meets the claims language).

1A(ii). Obviousness under Shelton

If the PTAB does not accept that the “ratings” element (element 1(b)(ii)) is inherently met by the Shelton “patient survey data”, then that element is obvious in view of the Shelton teaching. Shelton recommends that patient survey data be searchable, and distinguishes them as a separate element altogether from patient

open-ended comments, at the bottom of page 19. *Id.* Because collecting this patient survey data in the form of ratings is the the most sensible way to provide searchability while not using open-ended comments, patient ratings would have been obvious under Shelton’s own teachings. Cooper Report, at ¶¶45-46.

Creating a results list using patient ratings (element 1(b)(ii)) and comparison ratings (element 1(b)(iv)), even if that disclosure was not inherent from Shelton, also would be obvious. That is, patient ratings are inherently taught by or are obvious under Shelton (above), and Shelton expressly teaches (page vii) that “*as many elements as possible*” should be available in the search criteria (and thus used in creating the results list) (emphasis added). Use of patient ratings from the Shelton surveys in creating the results list, therefore, even if it was not the plain and inherent teaching of Shelton, is an obvious design option under this directive. Cooper Report, at ¶51.

As *KSR* dictates, options such as these are obvious as predictable variations, based on nothing more than common sense. *See KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 417 (U.S. 2007) (“If a person of ordinary skill can implement a predictable variation, § 103 likely bars its patentability.”); *id.* (“[A] court must ask whether the improvement is more than the predictable use of prior art elements according to their established functions.”); *id.* at 418 (“As our precedents make clear, however, the analysis need not seek out precise teachings directed to the

specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ.”); *id.*, at 420 (“Common sense teaches, however, that familiar items may have obvious uses beyond their primary purposes, and in many cases a person of ordinary skill will be able to fit the teachings of multiple patents together like pieces of a puzzle.”).

1B. Claims 1, 2, 4, 6-10 and 15-17 Are Obvious Over Shelton In View Of PQCR

All of the elements of claims 1, 2, 4, 6-10, and 15-17 are expressly disclosed in, or at least obvious from, Shelton, as addressed in section 1A, *supra*. As a secondary, additional ground for invalidity, the elements of creating a results list, patient ratings, and comparison ratings are all obvious under Shelton in view of the PQCR (MDX-1008) as explained below.

There is motivation to combine Shelton and the PQCR, as there is motivation in each reference to be combined with the other. See Cooper, ¶¶ 57-59.

1B(i). Patient Ratings and Comparison Ratings: The PQCR is a results list from a search for doctors done on the Health Grades website in 2004. It teaches ratings for physicians’ hospitals based on patient data (*e.g.*, page 14: “based on Medicare patient data”); and it discloses a results list having ratings of multiple hospitals. See, *e.g.*, pages 11-14. The PQCR shows all local hospitals and expressly instructs the reader to use the multiple hospital ratings to evaluate

physicians to see the range of quality available in an area. *Id.* at page 12. Thus, the concept of using ratings to compare physician quality is already disclosed in PQCR, and these are comparison ratings. (The claim language does not require that the comparison ratings be patient ratings, or ratings of the physicians.)

Furthermore, patient ratings would be obvious in view of these disclosures in the PQCR. The PQCR already discloses using ratings of all local hospitals that are based on patient data to evaluate physician quality. Thus, the only question is whether having patients rate physicians would be obvious in view of the express disclosure in PQCR of using ratings based on patient data to evaluate physicians, and in view of Shelton patient survey questions about “How well Doctors Communicate”, etc. According to *KSR*, this would be an obvious variation based on nothing more than common sense. *See* case law in Section 1A(ii), *supra*; Cooper Report, at ¶ 60.²

² In the ‘060 litigation, Health Grades has argued that service providers did not use patient ratings of physicians in the prior art because of fear of upsetting the physicians. If anything, this indicates obviousness – they knew how to do it, but chose not to do so. *See, e.g., Friskit, Inc. v. RealNetworks, Inc.*, 306 Fed. Appx. 610, 617-18 (Fed. Cir. 2009) (failure to combine due to market forces is not relevant to the obviousness issue as they present no evidence of technological

1B(ii). Creating a results list using claimed elements (element 1(b)): The idea of creating a results list using the various claim elements is also obvious in view of the PQCR. The data that is displayed in the PQCR results list includes specialty, gender and years since medical school. *See, e.g.*, page 1 (specialty of psychiatry), page 14 (gender), page 6 (years since medical school). There are also comparison ratings, in the PQCR results list. *See* pages 11-14, and 1B(i), *supra*. And it also shows medical school, internship, residency, fellowship, licensure, and disciplinary action. *See, e.g.*, pages 2-7 (medical school, internship, residency, fellowship, licensure, and disciplinary action). As discussed above, patient ratings are obvious in view of the Shelton Reference and the PQCR. *See* 1B(i), *supra*. Thus, the combination of Shelton and the PQCR make it obvious to provide a results list that uses and displays all of the claimed data elements. *See* case law in Section 1A, *supra*; Cooper Report, at ¶ 55.

1C. Claims 2 and 3 Are Obvious Over Ground 1A in Further View Of Bachus and Itzhaki and Obvious Over Ground 1B in Further View of Bachus and Itzhaki

Claim 2: As an additional ground of invalidity for claim 2, either Bachus or Itzhaki can be combined with either or both of Grounds 1A and 1B, to further disclose that surveys, such as those taught in Shelton, can be conducted on the challenges); *Dystar Textilfarben GmbH v. C.H. Patrick Co.*, 464 F.3d 1356, 1371-72 (Fed. Cir. 2006) (“business judgment” not relevant to obviousness issue).

same website as that which allows searching for the information. *See, e.g.*, Bachus (MDX-1012) FIGs. 1, 2, 3, and 7, and accompanying text, including page 2, ¶ [0018] (consumers enabled to respond to survey over the website and submit doctor recommendations and to query the database from the same website.); *see also* ¶¶ [0020] – [0025]. Itzhaki also teaches that surveys, such as those in Shelton, can be conducted on the same website as that which allows searching for the information. *See, e.g.*, Itzhaki (MDX-1011) pages 2, 4 ¶¶ [0027, 0045]) (“The counseling service (“service”) of the invention includes a nationwide network of counselors. The service maintains a web site that provides clients, counselors, system administrators, and customer service representatives access to the system.” “In addition, the client can be presented with one or more survey questions regarding the session. . . . If the session was an Internet session, the questions can be presented in a succession of one or more web pages.”). These references teach the use of surveys, and they can easily be combined to yield the predictable benefits disclosed in Bachus or Itzhaki. *DyStar Textilfarben GmbH & Co. Deutschland KG v. C. H. Patrick Co.*, 464 F.3d 1356, 1367 (Fed. Cir. 2006) (“Our suggestion test is in actuality quite flexible and not only permits, but requires, consideration of common knowledge and common sense”); and *Alza Corp. v. Mylan Labs., Inc.*, 464 F.3d 1286, 1291 (2006) (“There is flexibility in our obviousness jurisprudence because a motivation may be found implicitly in the

prior art. We do not have a rigid test that requires an actual teaching to combine”); *see also* Cooper Report, at ¶ 62; *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 417 (U.S. 2007) (obvious where alleged improvement is nothing more than “use of prior art elements according to their established functions.”).

Claim 3: As for claim 3, it requires receiving a response to a question from the on-line patient experience survey from the one or more patients (disclosed as addressed in the above paragraph); and it requires receiving an email address from the one or more patients. Bachus teaches that patients may also submit their emails: “A Share Your Story field may also be provided so that the user may include a narration of the patient’s positive experience, and also may allow the registrant the option to leave their email address” (page 2, ¶ [0023]). This too, then, was a known and obvious option to obtain the benefit of the teaching of Bachus. *See KSR Int’l*, 550 U.S. at 417; Cooper Report, at ¶ 62.

1D. Claim 11 Is Obvious Over Ground 1A in Further View Of Stolba and Obvious Over Ground 1B in Further View of Stolba

Claim 11 recites: “The method as defined in claim 9, further comprising sending the results list to a second device for displaying an advertisement for a healthcare professional adjacent to the results list.” Stolba teaches the display of advertisements during searching. According to Stolba: “At the end of each month the highest bidder will ‘win’ the auction, and the user’s advertisements will be displayed during searches and on the web site.” (page 5, ¶

[0047]); *see also* page 2, ¶ [0024] (“Examples of professionals include such traditional professions as doctors.”); Cooper Report, at ¶ 63. As for the combining of these references and obviousness of the resulting combination, see the same law recited in Section 1C.

To the extent that Stolba does not expressly disclose the advertisements adjacent to the results list, the location of the advertisement is nothing more than an obvious design choice. *See KSR*, 550 U.S. at 417 (“If a person of ordinary skill can implement a predictable variation, § 103 likely bars its patentability.”).

1E. Claims 12, 13 and 14 Are Obvious Over Ground 1A in Further View Of Shubov and Obvious Over Ground 1B in Further View of Shubov

Claim 12 recites: “The method as defined in claim 9, further including: determining whether each of the one or more healthcare professionals is a member of the on-line information service; and providing one or more enhanced services for each of the members of the on-line information service.” Claim 13 depends on claim 12, and further recites: “The method as defined in claim 12, wherein the enhanced services comprise favorable positioning within the results list.” Claim 14, which also depends on claim 12, recites that the enhanced services of claim 12 “comprise providing a hyperlink to an online appointment booking service.”

Shubov discloses the elements of claims 12 and 13, in disclosing a prior art system whereby professionals register with the website (page 7, ¶ [0140]), and are then allowed priority in a list ahead of others: “In an embodiment, the matching system can control the order and posting of responses by service providers on the consumer home page. This allows the matching system to give priority to select service providers which can result in obtaining more cases.” (Page 2, ¶ [0013]). While Shubov discusses primarily lawyers, it teaches that it is applicable to other professionals. (Page 4, ¶ [0034]); *see also* the ‘052 Patent, column 20, lines 1-5 (the technology field is applicable to any type of professional). Thus, modifying Shelton to include the prioritizing arrangement of Shubov for registered providers would be an obvious design choice. *See KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 417 (U.S. 2007) (obvious where alleged improvement is nothing more than “use of prior art elements according to their established functions.”); *see* Cooper Report, at ¶ 64.

As for claim 14, the enhanced service of providign a hyperlink to an online appointment booking service is obvious is view of Shelton itself. That is, Shelton teaches use of email for the purpose of making appointments. Use of email in a website in the form of an email hyperlink (also known as MAILTO hyperlink) would have been an obvious design choice well known to those or ordinary skill in the art. Cooper Report, at ¶ 52. *See also KSR*, 550 U.S. at 417 (obvious where

alleged improvement is nothing more than “use of prior art elements according to their established functions.”)

GROUP 2 ANALYSES: CLAIMS 18-33

2A. Claims 18-29 and 33 Are Obvious Over Shelton In View of The PQR

As shown in the chart below, all elements of claims 18-29 and 33 are obvious in view of the combination of Shelton and the PQR. Discussions of obviousness combinations and “common sense” analyses under *KSR* are provided after the claim chart.

Claim of the ‘052 Patent	Obviousness By Shelton and PQR
18. A computer-implemented method of providing healthcare professional information to potential patients, said method comprising:	<u>The Shelton Reference:</u> See the support set forth in the preamble for claim 1.
(a) receiving, at one or more server computers, a request for information regarding a first healthcare professional, wherein the one or more server computers comprise at least one computer processor and memory;	<p><u>The Shelton Reference:</u> Shelton teaches extensive searching options, and the generation of healthcare professional reports. See, e.g., Figures 1-2 and accompanying text (various healthcare professional reports generated by user searching).</p> <p>The Shelton Reference inherently discloses at least one computer processor and memory. Cooper Report, at ¶ 49.</p>
(b) accessing, by at least one of the one or more server computers, healthcare	<u>The Shelton Reference:</u> The Shelton Reference teaches the compiling of numerous of these healthcare professional-verified

Claim of the '052 Patent	Obviousness By Shelton and PQR
<p>professional-verified information about the first healthcare professional, wherein the healthcare professional-verified information is received from the first healthcare professional and comprises three or more from the group consisting of: specialty information, medical philosophy, gender, age, years in profession, years in practice, awards, honors, professional appointments, professional memberships, publications, languages, and hobbies;</p>	<p>information data elements. <i>See e.g.</i>, pages 11-13 where gender, specialty information, years in practice, professional appointments and languages are shown to be received from the physician (and also thereby verified by the physician, per Section IV(C)(3), <i>supra</i>) and available to be accessed for inclusion in a healthcare professional report such as those shown in Figures 1 and 2.</p>
<p>(c) compiling, by the at least one of the one or more server computers, patient-provided information regarding the first healthcare professional, wherein the patient-provided information comprises patient ratings from one or more past or current patients of the first healthcare professional;</p>	<p><u>The Shelton Reference</u>: Shelton discloses “patient survey data” (page 19), which are ratings and not open-ended comments. <i>See also, e.g.</i>, pages 10 and 19 (page 10 recommending “as useful for consumer choice . . . performance measures”; and at page 19 describing the “performance measures” survey results measuring such things as a doctor’s communication, wait times, and courteousness and helpfulness of staff, and “similar information”). <i>Contrast</i> “Patient open-ended comments” at page 19. <i>See also</i> Section 1A(i), <i>supra</i> (addressing why these Shelton surveys are inherently “ratings”).</p>
<p>(d) compiling, by the at least one of the one or more server computers, information regarding the first healthcare professional verified by an</p>	<p><u>The Shelton Reference</u>: The Shelton Reference teaches the compiling of numerous of these third-party verified data elements. <i>See e.g.</i>, Pages 11-14 where medical internship, medical residency, medical</p>

Claim of the '052 Patent	Obviousness By Shelton and PQR
independent third-party source, wherein the information verified by the independent third-party source comprises three or more from the group consisting of: board certification, licensure, disciplinary action information, medical school, medical internship, medical residency, and medical fellowship information;	fellowship information, medical school, licensure, board certification, and disciplinary action information are shown to be verified by an independent third-party source and compiled by the system.
(e) creating, by the at least one of the one or more server computers, a healthcare professional report on the first healthcare professional using the healthcare professional-verified information, the patient-provided information, and the information verified by the independent third-party source, wherein the healthcare professional report on the first healthcare professional includes a comparison rating of the first healthcare professional; and	<p><u>The Shelton Reference:</u> The Shelton Reference teaches creating a healthcare professional report using various data elements. <i>See e.g.</i>, Figures 1 and 2 and accompanying text. <i>See also</i> Cooper Report at ¶ 71. <i>See also</i> page 9: “an online directory should: provide as much information as can be kept current and accurate.”</p> <p><u>Shelton and the PQR Reference:</u> To the extent that Shelton does not inherently disclose the use of all these claimed data elements in the report, that possibility is taught in PQR. <i>See, e.g.</i>, provider data: page 2 (specialty), page 8 (languages, gender); and third party data: page 2-6 (medical school, internship, residency, fellowship, board certification, and licensure).</p> <p>As for patient ratings and comparison ratings in the physician report, these too were disclosed and obvious to anyone of ordinary skill in the art. <i>See</i> Cooper Report, at ¶ 73-74; <i>see also</i> Section 2A(i), <i>infra</i>.</p>

Claim of the '052 Patent	Obviousness By Shelton and PQR
(f) providing, by the at least one of the one or more server computers, access to the healthcare professional report on the first healthcare professional over a computer network.	<u>The Shelton Reference:</u> See, e.g., support from Element 1(c).
19. The method as defined in claim 18, wherein the healthcare professional report on the first healthcare professional comprises multiple pages connected via hyperlinks.	<u>The Shelton Reference:</u> See Section 2A(ii), <i>infra</i> .
20. The method as defined in claim 19, wherein a portion of the healthcare-professional verified information is displayed on a first page of the multiple pages of the healthcare professional report on the first healthcare professional.	<u>The Shelton Reference:</u> See Section 2A(ii), <i>infra</i> .
21. The method as defined in claim 19, wherein a portion of the third-party verified information is provided in the healthcare professional report such that the portion of the third-party verified information is displayed on a first page of the multiple pages of the healthcare professional report on the first healthcare professional.	<u>The Shelton Reference:</u> See Section 2A(ii), <i>infra</i> .

Claim of the '052 Patent	Obviousness By Shelton and PQR
<p>22. The method as defined in claim 19, further comprising:</p> <p>accessing, by the at least one of the one or more server computers, healthcare professional-verified information about a second healthcare professional, wherein the healthcare professional-verified information is received from the second healthcare professional and comprises three or more from the group consisting of: specialty information, medical philosophy, gender, age, years in profession, years in practice, awards, honors, professional appointments, professional memberships, publications, languages, and hobbies;</p> <p>compiling, by the at least one of the one or more server computers, patient-provided information regarding the second healthcare professional, wherein the patient-provided information comprises patient ratings from one or more past or current patients of the second healthcare professional;</p> <p>compiling information regarding the second</p>	<p><u>The Shelton Reference:</u> See support for entire claim 18.</p>

Claim of the '052 Patent	Obviousness By Shelton and PQR
<p>healthcare professional verified by an independent third-party source, wherein the information verified by the independent third-party source comprises three or more from the group consisting of: board certification, licensure, disciplinary action information, medical school, medical internship, medical residency, and medical fellowship information;</p> <p>creating a healthcare professional report on the second healthcare professional using the healthcare professional-verified information on the second healthcare professional, the patient-provided information on the second healthcare professional, and the information verified by the independent third-party source on the second healthcare professional, wherein the healthcare professional report on the second healthcare professional includes a comparison rating of the second healthcare professional; and</p> <p>providing access to the</p>	

Claim of the '052 Patent	Obviousness By Shelton and PQR
healthcare professional report on the second healthcare professional over a computer network.	
<p>23. The method as defined in claim 22, further comprising:</p> <p>displaying at least a portion of the report on the first healthcare professional on a first Web page; and</p> <p>displaying at least a portion of the report on the second healthcare professional on the first Web page.</p>	<p><u>The Shelton Reference:</u> See Section 2A(ii), <i>infra</i>.</p>
<p>24. The method as defined in claim 23, wherein the access to the healthcare professional report on the first healthcare professional is obtained through a predetermined Web page that provides search capabilities for a database comprised of healthcare professional information of the first and second healthcare professionals.</p>	<p><u>The Shelton Reference:</u> Shelton teaches searching and obtaining the results lists over predetermined web pages. <i>See, e.g.</i>, Figure 3 and accompanying text. <i>See also</i> “most health plans now make their physician directories available online to consumers.” (Cover Page, ABSTRACT). “A large proportion of the population now relies on Web sites for health information, and most health plans have put their directories online.” (Page v).</p>
<p>25. The method as defined in claim 24, wherein the search capabilities permit a search based on one or more from the group consisting of: name, medical specialty, gender, state, city, procedure, diagnosis, procedure, and</p>	<p><u>The Shelton Reference:</u> <i>See, e.g.</i>, Figure 3 and accompanying text. “The panel also considered the navigability of online directories. Most members strongly advise that as many elements as possible be searchable, so that consumers have the maximum flexibility in finding the providers they want.” (Page vii). <i>See also</i>, <i>e.g.</i>, Figure 3: “You Have</p>

Claim of the '052 Patent	Obviousness By Shelton and PQR
location criteria.	Chosen: Find Physician by Name – Maryland Smith.”
26. The method as defined in claim 25, wherein the search of the database produces a results list of one or more healthcare professionals satisfying the search criteria, wherein the results list includes the first healthcare professional and the second healthcare professional.	<u>The Shelton Reference:</u> Shelton teaches extensive searching options for users, and the generation of results lists. <i>See, e.g.</i> , Figures 1-3 and accompanying text (results lists generated by user searching, <i>e.g.</i> , Figure 3). <i>See</i> also page vii: “Most members strongly advise that as many elements as possible be searchable, so that consumers have the maximum flexibility in finding the providers they want.”
27. The method as defined in claim 26, further comprising: displaying at least a portion of the report on the first healthcare professional on a first Web page; displaying at least a portion of the report on the second healthcare professional on the first Web page; and displaying at least a portion of the results list on the first Web page.	<u>The Shelton Reference:</u> See Section 2A(ii), <i>infra</i> .
28. The method as defined in claim 22, further comprising: displaying at least a portion of the report on the first healthcare professional on a second Web page.	<u>The Shelton Reference:</u> See Section 2A(ii), <i>infra</i> .
29. The method as defined in claim 28, further comprising: displaying at least a portion of	<u>The Shelton Reference:</u> See Section 2A(ii), <i>infra</i> .

Claim of the '052 Patent	Obviousness By Shelton and PQR
the report on the second healthcare professional on a third Web page.	
33. The method as defined in claim 19, wherein the first and second healthcare professionals are physicians.	The Shelton Reference: See, e.g., Figure 3: “You have Chosen: Find Physician by Name – Maryland Smith.” See also, e.g., entire Shelton reference adding “physicians” throughout.

**2A(i): Obviousness Of Patient Ratings And Comparison Ratings
In Physician Reports From Shelton and PQR**

As shown in the chart, Element 18(c), Shelton teaches ratings of physicians. Shelton also contemplates the use of ratings in physician reports. See page 9: “an online directory should: provide as much information as can be kept current and accurate.” Thus, Shelton alone teaches the use of patient ratings of physicians included in a physician report (and also thereby comparison ratings under Health Grades’ view, see Section IV(C)(1), *supra*).

Furthermore, even if Shelton did not teach patient ratings for use in a report, that element would be obvious in view of the disclosures in the PQR. The PQR is a physician report on a particular professional. It teaches ratings for physicians’ hospitals based on patient data (e.g., page 13: “based on Medicare patient data”); and it discloses a physician report having ratings of multiple hospitals. See, e.g., pages 11-13. The PQR shows all local hospitals and expressly instructs the reader

to use the hospital ratings to evaluate physicians. *Id.* at page 9. Thus, the only question is whether having patients rate physicians would be obvious in view of the express disclosure in PQR of using ratings based on patient data to evaluate physicians, and in view of Shelton patient survey questions about “How well Doctors Communicate”, etc. According to *KSR*, this would be an obvious variation based on nothing more than common sense. *See* case law in Section 1A(ii), *supra*; Cooper Report, at ¶ 73.

As for comparison ratings, the PQR teaches ratings for physicians’ hospitals based on patient data (*e.g.*, page 13: “based on Medicare patient data”); and it discloses a physician report having ratings of multiple hospitals. *See, e.g.*, pages 11-13. The PQR shows all local hospitals and expressly instructs the reader to use the multiple hospital ratings to evaluate physicians to see the range of quality available in an area. *Id.* at page 9. Thus, the concept of using ratings to compare physician quality is already disclosed in PQR, and these are comparison ratings.

2A(ii): Obviousness Of Multiple Web Pages

Shelton teaches online physician directory Web sites and web pages. *See, e.g.*, Figure 3 and accompanying text. *See also* “most health plans now make their physician directories available online to consumers.” (Cover Page, ABSTRACT). “A large proportion of the population now relies on Web sites for health information, and most health plans have put their directories online.” (Page v).

Shelton disclosed that “approaches to organizing and display content . . . will vary according to the design and purpose of different directories.” (Page 10).

Dependent claims 19-22 and 27-29 specify apportioning certain information over multiple web pages. Such decisions about how many web pages to provide, how to link them together, and what information to provide in each web page, are merely design choices typical in Web site creation and are the type of design choices that will vary according to the design and purpose of different directories, as disclosed by Shelton. Accordingly, the multiple-web page claims 19-22 and 27-29 would have been obvious. *See KSR*, 550 U.S. at 417 (“If a person of ordinary skill can implement a predictable variation, § 103 likely bars its patentability.”).

2B. Claims 18-29 and 33 Are Obvious Over Shelton In View of Drucker

All of the elements of claims 18-29 and 33 are expressly disclosed in, or at least obvious from, Shelton in view of Drucker, as shown in the chart below. For claims 19-29 and 33, see Section 2A above.

Claim of the ‘052 Patent	Obviousness By Shelton and Drucker
18. A computer-implemented method of providing healthcare professional information to potential patients, said method comprising:	<u>The Shelton Reference:</u> <i>See</i> Section 2A chart.
(a) receiving, at one or more server computers, a request for information regarding a	<u>The Shelton Reference:</u> <i>See</i> Section 2A chart.

Claim of the '052 Patent	Obviousness By Shelton and Drucker
first healthcare professional, wherein the one or more server computers comprise at least one computer processor and memory;	
(b) accessing, by at least one of the one or more server computers, healthcare professional-verified information about the first healthcare professional, wherein the healthcare professional-verified information is received from the first healthcare professional and comprises three or more from the group consisting of: specialty information, medical philosophy, gender, age, years in profession, years in practice, awards, honors, professional appointments, professional memberships, publications, languages, and hobbies;	<u>The Shelton Reference</u> : See Section 2A chart.
(c) compiling, by the at least one of the one or more server computers, patient-provided information regarding the first healthcare professional, wherein the patient-provided information comprises patient ratings from one or more past or current patients of the first healthcare professional;	<u>The Shelton Reference</u> : See Section 2A chart. Such ratings are also disclosed in Drucker. See pages 2-3, showing patient provided ratings of Dr. Drucker.

Claim of the '052 Patent	Obviousness By Shelton and Drucker
<p>(d) compiling, by the at least one of the one or more server computers, information regarding the first healthcare professional verified by an independent third-party source, wherein the information verified by the independent third-party source comprises three or more from the group consisting of: board certification, licensure, disciplinary action information, medical school, medical internship, medical residency, and medical fellowship information;</p>	<p><u>The Shelton Reference</u>: See Section 2A chart.</p>
<p>(e) creating, by the at least one of the one or more server computers, a healthcare professional report on the first healthcare professional using the healthcare professional-verified information, the patient-provided information, and the information verified by the independent third-party source, wherein the healthcare professional report on the first healthcare professional includes a comparison rating of the first healthcare professional; and</p>	<p><u>The Shelton Reference</u>: The Shelton Reference teaches creating a healthcare professional report using various data elements. <i>See e.g.</i>, Figures 1 and 2 and accompanying text. <i>See also</i> Cooper Report at ¶ 78. <i>See also</i> page 9: “an online directory should: provide as much information as can be kept current and accurate.”</p> <p><u>Shelton and the Drucker Reference</u>: To the extent that Shelton does not inherently disclose the use of all these claimed data elements in the report, that possibility is taught in Drucker. As for provider data, <i>see, e.g.</i>, page 1 (philosophy, gender, languages, awards, appointments, specialty); as for patient ratings, <i>see</i> pages 2-3; as for third party verified data, <i>see</i> page 1 (medical school, internship, residency, fellowship, board certification) and page 2 (disciplinary).</p>

Claim of the '052 Patent	Obviousness By Shelton and Drucker
	As for comparison ratings, see Section 2B(i), <i>infra</i> .
(f) providing, by the at least one of the one or more server computers, access to the healthcare professional report on the first healthcare professional over a computer network.	<u>The Shelton Reference</u> : See Section 2A chart.

2B(i). Obviousness of Comparison Ratings

As shown in the chart, Element 18(c), Shelton teaches ratings of physicians. Shelton also contemplates the use of ratings in physician reports. *See* page 9: “an online directory should: provide as much information as can be kept current and accurate.” Thus, Shelton alone teaches the use of patient ratings of physicians included in a physician report (and also thereby comparison ratings under Health Grades’ view, see Section IV(C)(1), *supra*).

Furthermore, even if Shelton did not teach patient ratings for use in a report, that element would be obvious in view of the disclosures in Drucker. Drucker is a physician report on a particular professional (Drucker). It shows patient ratings for the physician at page 2 (and also thereby comparison ratings under Health Grades’ view, see Section IV(C)(1), *supra*).

Even if the claim construction is such that Shelton and Drucker do not disclose comparison ratings, such a feature would be obvious from the Drucker disclosure at page 2 of comparisons to national averages of patient ratings of all doctors, to include ratings of other specific providers for comparison.

2C. Claims 18-29 and 33 Are Obvious Over Ground 2A In View of Koenig And Obvious Over Ground 2B In View Of Koenig

Health Grades has indicated that the “healthcare professional-verified information” element requires only receipt of the information from the healthcare professional. *See* Section IV(C)(3), *supra*. Should that be the broadest reasonable interpretation of this element, then the element is plainly met by Shelton as disclosed in the claim chart above of Section 2A.

Another interpretation – a narrower interpretation – of this element is that it requires some additional act of verification from the healthcare professional. Even with that interpretation, however, this claim element is obvious in view of Koenig (MDX- 1006), which expressly teaches healthcare professional verification. *See*, e.g., Koenig at column 4, lines 6-15: “The providers provide information on their qualifications to a database through a hierarchical menu system and also indicate the times during which they will be available. An employee of the company providing the matching calls the providers to verify the accuracy of the input data, which are then made available for searching.” Since the verification is nothing more than what is already taught in Koenig, it is obvious. *See KSR Int’l Co. v.*

Teleflex Inc., 550 U.S. 398, 417 (U.S. 2007) (predictable use of prior art elements according to their established functions should be obvious).

2D. Claims 19-22 and 27-29 Are Obvious Over Ground 2A In View of Itzhaki and Obvious Over Ground 2B In View of Itzhaki and Obvious Over Ground 2C In View of Itzhaki

Should Grounds 2A, 2B and 2C be insufficient to render claims 19-22 and 27-29 obvious, then such claims are obvious in view of Itzhaki (MDX-1011), which discloses that a “web site presents a plurality of pages to a prospective member requesting information about the counselor”, including information such as age, gender, specialty, languages, level of education, licensure, etc. *See, e.g.*, Itzhaki, p.2, para. [0030]. Web page creation and linking is a routine task, and providing the particular web pages of information in claims 19-22 and 27-29 would have been obvious over Itzhaki. Cooper Report, at ¶ 83-85.

2E: Claims 30 and 32 are Obvious Over Ground 2A In View of Stolba and Obvious Over Ground 2B In View of Stolba and Obvious Over Ground 2C and Stolba and Obvious Over Ground 2D In View of Stolba

Claim 30 recites: “The method as defined in claim 19, further comprising: determining whether the first healthcare professional is a member of the on-line information service; and if the first healthcare professional is a member of the on-line information service, providing enhanced services for the first healthcare professional.” Claim 32 depends on claim 30, and further recites: “The method as defined in claim 30, further comprising: providing a predetermined Web page that

permits a search of a database comprised of healthcare professional information, wherein the search of the database produces a results list of one or more healthcare professionals satisfying a search criteria; and wherein the enhanced services comprise favorable positioning in the results list.”

Shubov (MDX- 1014) discloses the elements of claims 30 and 32, in disclosing a prior art system whereby professionals register with the website (page 7, ¶ [0140]), and are then allowed priority in a list ahead of others: “In an embodiment, the matching system can control the order and posting of responses by service providers on the consumer home page. This allows the matching system to give priority to select service providers which can result in obtaining more cases.” (page 2, ¶ [0013]). While Shubov discusses primarily lawyers, it teaches that it is applicable to other professionals. Shubov, page 4, ¶ [0034]); see also the ‘052 Patent, column 20, lines 1-5 (the technology field is applicable to any type of professional). Thus, modifying Shelton to include the prioritizing arrangement of Shubov for registered providers would be an obvious design choice. *See KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 417 (U.S. 2007) (obvious where alleged improvement is nothing more than “use of prior art elements according to their established functions.”); see Cooper Report, at ¶ 64.

2F: Claim 31 is Obvious Over Ground 2E In View of Bachus

Claim 31 recites: “The method as defined in claim 30, wherein the enhanced services comprise making report information on the member healthcare professional available at no charge to the potential patients.”

Bachus is directed to a healthcare provider recommendation system and discloses: “There are several different sources of health care information available, including various programs providing free or fee-based information through the Internet.” (Page 3, ¶ [0038]). Modifying Shubov to so that membership also provides a benefit to potential customers in the form of free information would have been an obvious design choice. *See KSR.*, 550 U.S. at 417 (“[A] court must ask whether the improvement is more than the predictable use of prior art elements according to their established functions.”).

VI. CONCLUSION

The cited prior art references identified in this Petition provide new, non-cumulative technological teachings which indicate a reasonable likelihood of success as to Petitioner's assertion that the Challenged Claims of the '052 Patent are not patentable pursuant to the grounds presented in this Petition. Accordingly, Petitioner respectfully requests institution of Inter Partes Review for the Challenged Claims of the '052 Patent for each of the grounds presented herein.

Respectfully submitted,

Dated: July 1, 2014

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CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. §§ 42.6(e)(4)(i) et seq. and 42.105(b), the undersigned certifies that on July 1, 2014, a complete and entire copy of this Petition for Inter Partes Review, and all supporting exhibits, were provided via FedEx, to the Patent Owner by serving the correspondence address of record as follows:

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