Trials@uspto.gov
571-272-7822

Paper 17
Entered: September 11, 2014

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MEDTRONIC, INC.,
Petitioner,

v.

ROBERT BOSCH HEALTHCARE SYSTEMS, INC.,
Patent Owner.

Case IPR2014-00488
Patent 7,769,605 B2

Before STEPHEN C. SIU, JUSTIN T. ARBES, and MIRIAM L. QUINN, *Administrative Patent Judges.*

ARBES, *Administrative Patent Judge.*

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

Petitioner Medtronic, Inc. filed a Petition (Paper 1, "Pet.") to institute an *inter partes* review of claims 1–9 of U.S. Patent No. 7,769,605 B2 (Ex. 1001, "the '605 patent") pursuant to 35 U.S.C. §§ 311–19.[1] Patent Owner Robert Bosch Healthcare Systems, Inc. filed a Preliminary Response (Paper 7, "Prelim. Resp."). We have jurisdiction under 35 U.S.C. § 314. For the reasons that follow, we have determined to institute an *inter partes* review.

I. BACKGROUND

The standard for instituting an *inter partes* review is set forth in 35 U.S.C. § 314(a):

> THRESHOLD—The Director may not authorize an inter partes review to be instituted unless the Director determines that the information presented in the petition filed under section 311 and any response filed under section 313 shows that there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.

Petitioner challenges claims 1–9 as unpatentable under 35 U.S.C. § 103(a). Pet. 14–60. We institute an *inter partes* review as to claims 1–9 on certain grounds of unpatentability as discussed below.

A. The '605 Patent

The '605 patent describes a system for "monitoring a group of patients having a chronic disease or ongoing health condition" by monitoring certain parameters of the condition, such as blood glucose level

[1] Cardiocom, LLC ("Cardiocom"), a wholly-owned subsidiary of Petitioner, previously filed a petition seeking *inter partes* review of the '605 patent in Case IPR2013-00439. The petition was denied on January 16, 2014. Ex. 1010 ("-439 Dec.").

for diabetes and blood pressure for hypertension. Ex. 1001, Abstract; col. 1, ll. 25–37. According to the '605 patent, in prior art outpatient treatment programs, a clinician often learned about a patient's status through "patient initiated events," such as a visit to the emergency room. *Id*. at col. 1, ll. 48–67. As a result, medical needs of unmotivated patients could be overlooked. *Id*. In addition, prior art computer systems displayed medical data only on an "individual patient basis," making it difficult to determine "which patients are having the greatest difficulty in controlling their health condition so that the clinician may focus attention on these patients." *Id*. at col. 2, ll. 1–8. Consequently, according to the '605 patent, a need existed in the art to "view medical data for an entire group of patients simultaneously." *Id*. at col. 2, ll. 6–8.

Figure 1 of the '605 patent is reproduced below.

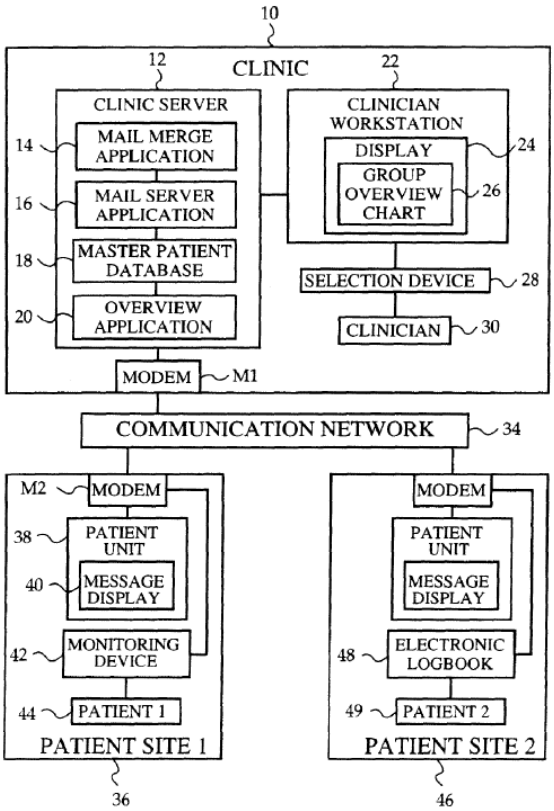

FIG. 1

Figure 1 above depicts healthcare clinic 10 in communication with patient sites 36 and 46 via communication network 34. *Id*. at col. 4, ll. 39–65. Patient site 36 includes monitoring device 42 for measuring periodically a particular health parameter of the patient, such as the patient's blood glucose level, and transmitting the measurements to healthcare clinic 10. *Id*. at col. 5, ll. 11–23. Patient site 36 also includes patient unit 38 (e.g., a personal computer) with message display 40 for displaying messages received from the clinic (e.g., emails). *Id*. at col. 4, l. 66–col. 5, l. 10.

Healthcare clinic 10 comprises clinic server 12 and clinician workstation 22. Ex. 1001, col. 4, ll. 39–65. Clinic server 12 includes master patient database 18 for storing patient data and overview application 20 for "performing various calculations using the patient data" and "generating a group overview chart with the patient data." *Id*. at col. 4, ll. 49–54. Overview application 20 calculates a "control value" for a patient indicating the patient's "control over the health condition" (e.g., the mean value of a parameter over a given period of time). *Id*. at col. 6, ll. 16–28. The control values for a group of patients then are displayed in group overview chart 26 on clinician workstation 22. *Id*. at col. 4, ll. 58–62.

Figure 3 of the ’605 patent depicts an exemplary group overview chart for a group of ten diabetes patients, and is reproduced below.

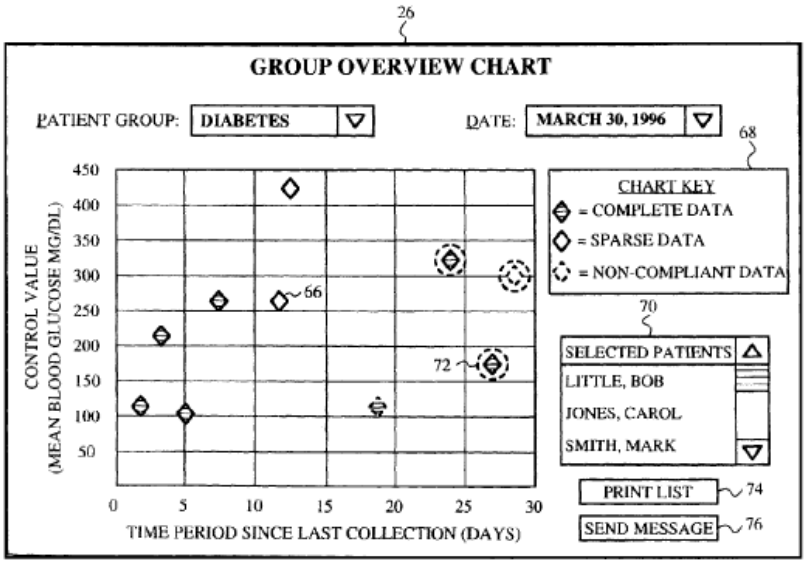

FIG. 3

As shown in Figure 3 above, group overview chart 26 has “ten data points, each data point representing one corresponding patient and indicating the control value calculated for the patient and the time period elapsed since the patient’s most recent collection date,” with each data point represented by an icon (e.g., icon 66). Ex. 1001, col. 7, ll. 20–25. According to the ’605 patent, viewing such a chart allows a clinician to determine which patients are having difficulty with their condition and require greater attention. *Id*. at col. 8, ll. 34–43.

B. Illustrative Claim

Claim 1 of the ’605 patent recites:

> 1. A system for monitoring a plurality of patients regarding a health condition, comprising:
>
> a reception unit for receiving a corresponding set of measurements regarding said health condition from each patient included in the plurality of patients;

a processing unit in communication with said reception unit for processing said corresponding set of measurements and identifying at least one patient included in the plurality of patients based upon said processing of said corresponding set of measurements;

a database, the database being in communication with said processing unit, the database being configured for storing medical health history information for each patient included in the plurality of patients, wherein processing of said corresponding set of measurements by the processing unit includes evaluating said corresponding set of measurements against said stored medical health history information;

a transfer unit in communication with said processing unit, wherein said transfer unit communicates with said at least one identified patient, said transfer unit being configured for transmitting a message for communicating with said at least one identified patient, the message being based upon said medical health history information and said processing of said corresponding set of measurements, the message being one of: a telephone message and an electronic mail message; and

a display unit in communication with said processing unit, the display unit being configured for displaying a group overview chart, said group overview chart being generated by the processing unit based upon said processing and being provided to said display unit, said group overview chart including a plurality of data points, wherein each of the data points represents one corresponding patient included in the plurality of patients and indicates at least one control value for the one corresponding patient, the control value being indicative of the one corresponding patient's control over said health condition, the control value being based upon said corresponding set of measurements, each data point including an icon.

C. The Prior Art

Petitioner relies on the following prior art:

1. U.S. Patent No. 5,331,549, issued July 19, 1994 ("Crawford") (Ex. 1006);

2. U.S. Patent No. 5,471,382, issued November 28, 1995 ("Tallman") (Ex. 1008);

3. U.S. Patent No. 5,827,180, issued October 27, 1998, continuation of an application filed August 24, 1995 ("Goodman") (Ex. 1002);

4. U.S. Patent No. 5,942,986, issued August 24, 1999, filed August 9, 1995 ("Shabot") (Ex. 1003);

5. G.F. Groner *et al.*, *An Introduction to the CLINFO Prototype Data Management and Analysis System*, National Institutes of Health, R-1541-NIH, 1–57 (Dec. 1977) ("Groner") (Ex. 1007);

6. M. Michael Shabot & Reed M. Gardner, ed., DECISION SUPPORT SYSTEMS IN CRITICAL CARE (1994) ("Shabot Book") (Ex. 1004);[2] and

7. E. Chris Vincent *et al.*, *The Effects of a Computer-Assisted Reminder System on Patient Compliance With Recommended Health Maintenance Procedures*, AMIA, Inc., 656–60 (1995) ("Vincent") (Ex. 1005).

D. The Asserted Grounds

Petitioner challenges claims 1–9 of the '605 patent under 35 U.S.C. § 103(a) on the following grounds:

References	Claim(s) Challenged
Goodman and Shabot	1 and 3–9

[2] As explained herein, Petitioner argues that the Shabot Book is incorporated by reference in Shabot. *See infra* Section II.C.3.

References	Claim(s) Challenged
Goodman, Shabot, and Vincent	2
Goodman, Shabot, and Crawford	1 and 3–9
Goodman, Shabot, Crawford, and Vincent	2
Goodman, Shabot, and Groner	1 and 3–9
Goodman, Shabot, Groner, and Vincent	2
Goodman, Shabot, Crawford, and Tallman	1 and 3–9
Goodman, Shabot, Crawford, Tallman, and Vincent	2

E. Claim Interpretation

Consistent with the statute and legislative history of the Leahy-Smith America Invents Act, Pub. L. No. 112-29, 125 Stat. 284 (2011) ("AIA"), the Board interprets claims using the "broadest reasonable construction in light of the specification of the patent in which [they] appear[]." 37 C.F.R. § 42.100(b); *see also* Office Patent Trial Practice Guide, 77 Fed. Reg. 48,756, 48,766 (Aug. 14, 2012) ("Trial Practice Guide"). In our decision denying institution in Case IPR2013-00439, we interpreted the term "chart" in claim 1 of the '605 patent to mean "information arranged in the form of one or more tables, graphs, or diagrams," and interpreted the term "icon" in claim 1 to mean "a graphical representation of an underlying function or data." -439 Dec. 8–12. Petitioner argues that the terms should be interpreted in the same manner in this proceeding, and Patent Owner applies our previous interpretations in its Preliminary Response. *See* Pet. 7; Prelim.

Resp. 12. We incorporate our previous analysis for purposes of this decision and determine that the broadest reasonable interpretations of the terms "chart" and "icon" are the same interpretations that were articulated in the decision denying institution in Case IPR2013-00439. *See* -439 Dec. 8–12.

II. DISCUSSION

We turn now to Petitioner's asserted grounds of unpatentability and Patent Owner's arguments in its Preliminary Response to determine whether Petitioner has met the threshold standard of 35 U.S.C. § 314(a).

A. Section 312(a)(2)

As an initial matter, Patent Owner argues that the Petition should be denied for failure to "identif[y] all real parties in interest" under 35 U.S.C. § 312(a)(2). Prelim. Resp. 7–9. Petitioner states in its Petition that it is the sole real party-in-interest. Pet. 1. Patent Owner argues that Cardiocom also is a real party-in-interest, relying on the following facts: (1) Cardiocom previously filed a petition in Case IPR2013-00439 seeking *inter partes* review of the '605 patent; (2) Cardiocom and Petitioner both are listed as real parties-in-interest in Case IPR2013-00439;[3] (3) Cardiocom and Petitioner both are defendants in the related district court case where the '605 patent is being asserted; (4) Petitioner has the same counsel and declarant, Robert T. Stone, Ph.D., in this proceeding as Cardiocom had in Case IPR2013-00439; and (5) Petitioner relies on many of the same prior art

[3] Cardiocom listed itself as the sole real party-in-interest when it filed its petition, but later added Petitioner after Petitioner acquired Cardiocom. *See* IPR2013-00439, Paper 3 at 1, Paper 25.

references as Cardiocom did in Case IPR2013-00439. Prelim. Resp. 7–9. Based on these facts, Patent Owner contends that Cardiocom "desires review" of the '605 patent and was "involved" in the filing of the Petition. *Id*. at 7–8. Patent Owner also argues that even if Petitioner was permitted to correct its Petition to identify Cardiocom, doing so would be futile because Cardiocom was served with a complaint alleging infringement of the '605 patent more than one year ago under 35 U.S.C. § 315(b). *Id*. at 8–9.

Whether a non-party is a "real party-in-interest" for purposes of an *inter partes* review proceeding is a "highly fact-dependent question" that takes into account how courts generally have used the term to "describe relationships and considerations sufficient to justify applying conventional principles of estoppel and preclusion." Trial Practice Guide, 77 Fed. Reg. at 48,759. In general, a "real party-in-interest" is "the party that desires review of the patent," and "may be the petitioner itself, and/or it may be the party or parties at whose behest the petition has been filed." *Id*. Depending on the circumstances, various factors may be considered, including whether the non-party exercises, or could exercise, control over the petitioner's participation in the proceeding, and whether the non-party is funding or directing the proceeding. *Id*. at 48,759–60.

Patent Owner has not provided a sufficient factual basis upon which to conclude, based on the current record, that Cardiocom is a real party-in-interest in this proceeding. Petitioner is the party seeking *inter partes* review, and represents that it is the sole real party-in-interest. *See* Pet. 1. The fact that Cardiocom previously filed a petition in another proceeding, without more, does not establish anything about which entity, or entities, are responsible for controlling, funding, or directing Petitioner's

activities in *this* proceeding. Nor does the fact that both Cardiocom and Petitioner are defendants in the district court case—also a different proceeding—indicate, without more, that both entities must be involved in this proceeding. We also note that Cardiocom is a wholly-owned subsidiary of Petitioner, indicating that Petitioner has the ability to exercise some measure of control over its subsidiary, and not necessarily the reverse. Patent Owner has not pointed to sufficient facts to show, at this stage of the proceeding, that Petitioner failed to name all real parties-in-interest, and we do not deny the Petition on that basis.

B. Section 325(d)

In Case IPR2013-00439, Cardiocom asserted similar grounds to those asserted by Petitioner in this proceeding, relying on five of the same prior art references: Goodman, Crawford, Groner, Tallman, and Vincent. *Compare* IPR2013-00439, Paper 3 at 20–56 *with* Pet. 14–60. We determined that Cardiocom had not shown sufficiently that either Crawford or Goodman teaches a processing unit for "evaluating said corresponding set of measurements against said stored medical health history information," as recited in claim 1. -439 Dec. 13–19. Petitioner now relies on a new reference, Shabot, which was not considered during prosecution of the '605 patent, as allegedly teaching the "evaluating" limitation. Pet. 47–48. Petitioner also relies on Goodman as teaching the majority of limitations of the claims, unlike in Case IPR2013-00439 where Cardiocom relied primarily on Crawford. *Compare* IPR2013-00439, Paper 3 at 20–35 *with* Pet. 25–41.

Patent Owner argues that the Petition should be denied under 35 U.S.C. § 325(d) because it relies on five of the same prior art references

as the petition in Case IPR2013-00439 and Shabot is "cumulative" to the prior art and arguments in the earlier case. Prelim. Resp. 4–5. Patent Owner also contends that Petitioner and Cardiocom have filed numerous other petitions for *inter partes* review and requests for *ex parte* reexamination of patents asserted in the district court case, causing unnecessary delay and expense for Patent Owner. *Id*. at 5–6 (citing, for example, Reexamination Control No. 90/013,167, a pending *ex parte* reexamination of the '605 patent).

In determining whether to institute an *inter partes* review, "the Director may take into account whether, and reject the petition or request because, the same or substantially the same prior art or arguments previously were presented to the Office." 35 U.S.C. § 325(d). The statutory language gives the Director the authority not to institute review on the basis that the same or substantially the same prior art or arguments were presented previously to the Office, but does not require that result. Shabot, and the specific combinations of Shabot and other prior art asserted by Petitioner in this proceeding, were not considered during prosecution of the '605 patent or during Case IPR2013-00439. Although we are mindful of the burden on Patent Owner and the Office in analyzing the other, previously considered five references, we conclude that Petitioner's arguments regarding Shabot and the "evaluating" limitation are persuasive, as explained herein, and thus, we do not exercise our discretion to deny the Petition under 35 U.S.C. § 325(d).

C. Asserted Ground Based on Goodman and Shabot

Petitioner contends that claims 1 and 3–9 are unpatentable over Goodman and Shabot under 35 U.S.C. § 103(a), and relies on the declaration of Dr. Stone (Ex. 1018) in support. Pet. 25–32, 41–60. For the reasons explained below, we are not persuaded that Petitioner has established a reasonable likelihood of prevailing on the asserted ground.

1. Goodman

Goodman discloses a system for monitoring the health of a patient in which a third party host computer is in communication with a health care provider's computer and a patient's computer. Ex. 1002, Abstract; col. 2, ll. 44–51; Fig. 1. In one embodiment, the host computer receives a treatment plan for a patient from the health care provider and generates an algorithm based on the treatment plan. *Id*. at col. 2, ll. 54–57. The algorithm is programmed into a message device in possession of the patient. *Id*. at col. 2, ll. 49–58. The message device prompts the patient to measure and enter physiological data as dictated by the treatment plan. *Id*. at col. 2, ll. 58–61. The host computer receives the data and "functions as a central station for collecting, analyzing, and routing data" received from patients. *Id*. at col. 2, l. 51–col. 3, l. 2.

2. Shabot

Shabot discloses a "critical event notification system [that] continuously monitors patient statistics and lab data to detect critical events, and automatically pages a responsible physician." Ex. 1003, Abstract. The system receives real-time data regarding patients, stores the data in "patient

chart databases" and "databases corresponding to patient history," periodically analyzes the data to determine whether a "critical event" or "exception condition" has occurred, and, if so, sends an alphanumeric message with information about the event to the responsible physician. *Id*., Abstract; col. 2, ll. 28–65; col. 10, l. 46–col. 11, l. 23.

3. Analysis

Claim 1 recites a display unit configured to display a "group overview chart" with a plurality of data points, where each data point (1) represents a patient, (2) indicates a "control value" for the patient indicative of the patient's control over a health condition, and (3) includes an "icon." Petitioner relies on Shabot as allegedly teaching these limitations, citing general statements in Shabot that the disclosed system monitors multiple patients, analyzes the received data, and displays "lab results, charts, or other data" on a workstation display screen. Pet. 18–19, 51–52 (emphasis omitted). Petitioner, however, does not explain specifically how these general statements teach a chart having data points for particular patients or data points indicating control values. Thus, we are not persuaded that the disclosure of Shabot itself teaches a "group overview chart" as recited in claim 1.

Petitioner also relies on portions of the Shabot Book describing a display screen in the "APACHE III" medical computer system, and asserts that they are incorporated by reference in Shabot. *Id*. at 19–20, 52–54 (citing Ex. 1004). The Shabot Book states that the APACHE III system displays a screen having intensive care unit ("ICU") patients each represented by a "stylized bed symbol," and showing each "patient's risk of

both ICU and hospital death through the coordinated use of color-coded information." Ex. 1004 at 250–51. Petitioner argues that the Shabot Book is incorporated by reference in the following passage from Shabot:

> Those desiring additional detail as to the interface between these computer systems 71 or 73 and the clinical information system 61, and how new data from these computer systems is processed, are referred to the following references: . . . *Decision Support Systems In Critical Care*, Ed. M. Michael Shabot and Reed Gardner (Springer-Verlag 1994). These references are hereby incorporated by reference into this disclosure, as though fully set forth herein.

Ex. 1003, col. 12, ll. 7–22; *see* Pet. 19–20. Patent Owner responds that the portions of the Shabot Book relied upon by Petitioner are not incorporated by reference in Shabot. Prelim. Resp. 35–38. We agree with Patent Owner.

"To incorporate material by reference, the host document must identify with detailed particularity what specific material it incorporates and clearly indicate where that material is found in the various documents." *Advanced Display Sys., Inc. v. Kent State Univ.*, 212 F.3d 1272, 1282–83 (Fed. Cir. 2000). Whether a patent describes material to be incorporated by reference with sufficient particularity is assessed from the perspective of a person of ordinary skill in the art. *Id*. at 1283.

The Shabot Book is a 420-page publication comprising 25 different chapters on different subjects. *See* Ex. 1004 at xi. Shabot does not identify clearly any particular portion or material from the Shabot Book as being incorporated by reference, instead referring only to the publication as a whole. Also, in introducing the Shabot Book, Shabot explicitly refers the reader to the reference for "additional detail" regarding the "interface" between computer systems 71/73 and clinical information system 61 and "how new data from these computer systems is processed." Ex. 1003, col.

12, ll. 7–22. To the extent this statement could be considered a reference to specific material in the Shabot Book, the Shabot Book's description of the APACHE III system *display screen* does not pertain to an interface between computer systems or how data from different computer systems is processed. Thus, we are not persuaded that the cited portions of the Shabot Book are incorporated by reference in Shabot. Further, even if the cited portions of the Shabot Book pertaining to the APACHE III system were incorporated by reference in Shabot, Petitioner has not shown sufficiently that a person of ordinary skill in the art would have had reason to combine those specific disclosures with the other teachings of Shabot and Goodman. *See* Prelim. Resp. 37. Thus, Petitioner has not established a reasonable likelihood of prevailing on its assertion that independent claim 1, as well as dependent claims 3–9, are unpatentable over Goodman and Shabot under 35 U.S.C. § 103(a).

D. Asserted Ground Based on Goodman, Shabot, and Vincent

Petitioner contends that claim 2 is unpatentable over Goodman, Shabot, and Vincent under 35 U.S.C. § 103(a). Pet. 40–41, 56–57. As explained above, Petitioner has not shown that Goodman and Shabot teach the "group overview chart" limitations of claim 1. Petitioner does not rely on Vincent for the limitations and, therefore, has not established a reasonable likelihood of prevailing as to claim 2 for the same reasons.

E. Asserted Ground Based on Goodman, Shabot, and Crawford

Petitioner contends that claims 1 and 3–9 are unpatentable over Goodman, Shabot, and Crawford under 35 U.S.C. § 103(a), again relying on

the testimony of Dr. Stone in support. Pet. 33–36, 41–60. We are persuaded that Petitioner has established a reasonable likelihood of prevailing on the asserted ground for the reasons explained below.

1. Crawford

Crawford discloses a "medical monitoring system in which a plurality of vital signs monitors for a plurality of patients provide data on a continuing basis to a central server." Ex. 1006, Abstract. The system provides an overview display (e.g., a computer touchscreen) showing, for example, a hospital floor plan with room icons. *Id*. at col. 5, ll. 19–23; col. 6, ll. 34–38. Alarms and warnings are displayed whenever a patient's monitored vital signs fall outside a range pre-selected by the health care provider. *Id*. at col. 5, ll. 23–37; col. 8, ll. 22–44. Figure 3 of Crawford is reproduced below.

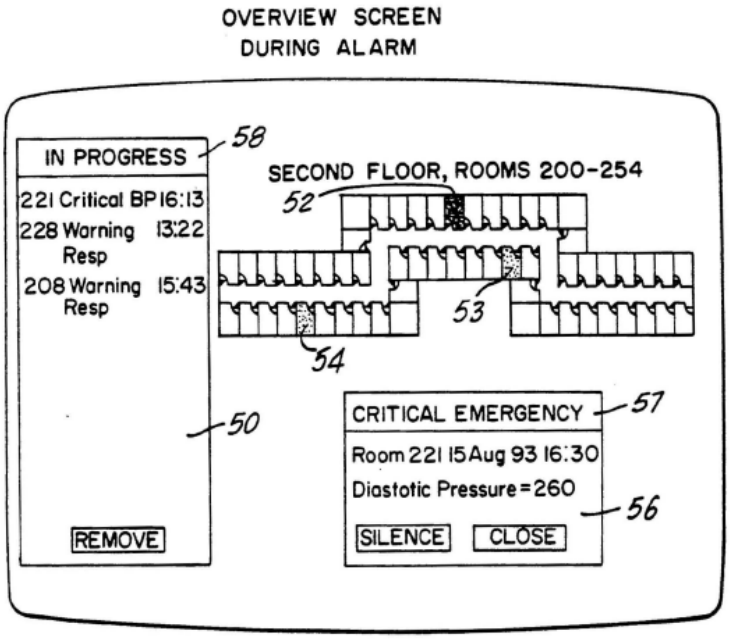

FIG. 3

Figure 3 above depicts Room 221with a critical emergency and Rooms 208 and 228 with warnings. *Id*. at col. 5, ll. 23–58. A user can touch the screen on a particular room to call up information for the particular patient. *Id*. at col. 6, ll. 34–38. The system also can display past vital sign measurements for a patient. *Id*. at col. 2, ll. 34–37; col. 8, ll. 52–62; Fig. 7.

2. Analysis

Petitioner contends that Goodman, Shabot, and Crawford teach all of the limitations of claim 1. Pet. 33–36, 41–56. For example, Petitioner cites Shabot for the "evaluating" limitation and Crawford's overview display for the "group overview chart" limitations. *Id*. at 47–48, 54–56. Upon review of Petitioner's analysis and supporting declaration, we are persuaded that Petitioner has shown a reasonable likelihood of prevailing on its asserted ground of unpatentability of claim 1 based on the combination of Goodman, Shabot, and Crawford.

Patent Owner makes five arguments. First, Patent Owner argues that Shabot does not teach a "processing unit" for "processing said corresponding set of measurements," wherein the processing includes "evaluating said corresponding set of measurements against said stored medical health history information," as recited in claim 1. Prelim. Resp. 27–30. Patent Owner contends that the limit values in Shabot are "default values set by a lab technician," not based on any "medical health history information" or set by a "processing unit." *Id*. Patent Owner's arguments are not persuasive. The server workstation in Shabot accesses real-time patient data and periodically updated hospital databases, including "databases corresponding to patient history." Ex. 1003, Abstract; Figs. 2–3;

col. 8, ll. 14–22; col. 11, l. 53–col. 12, l. 37. The server workstation can detect a singular critical event, such as "a drop in a patient's calcium level (as determined from periodic analysis of the patient's blood) below a predetermined critical level." *Id*. at col. 2, l. 66–col. 3, l. 4; col. 6, ll. 29–36. Importantly, though, it also can detect an exception condition based on patient data collected over time. For instance, an exception condition may be when "the patient . . . required levels of oxygen ventilation of greater than 60% oxygen composition for over four hours duration," determined by reviewing "several, time-spanned data entries" for the patient. *Id*. at col. 10, ll. 51–59; col. 6, ll. 36–47 ("[t]his type of analysis cannot be performed upon instantaneous measurements"). Based on the current record, we are persuaded that the latter type of processing constitutes evaluating a set of measurements against stored medical health history information, as required by claim 1. *See* Pet. 47–48; Ex. 1018 ¶¶ 44–47.

Second, Patent Owner argues that Goodman and Shabot do not teach a "transfer unit" that transmits a telephone message or electronic mail message to a patient, as recited in claim 1. Prelim. Resp. 30–32. Goodman discloses host computer 30 in communication with wireless carrier 60, which "'telephones' the patient's pager 61" and delivers a message to the patient, such as a reminder for the patient to take his or her medication. Ex. 1002, col. 5, l. 64–col. 6, l. 7. Goodman further discloses the transmission of information to a patient "via telephone, facsimile transmission, electronic mail, or other communication means." *Id*. at col. 7, l. 66–col. 8, l. 5. Dr. Stone testifies that "the pager and modem messages specifically disclosed by Goodman for transmitting health-related messages to patients [are] examples," and "[o]ne of ordinary skill would understand that the other

means of communication disclosed by Goodman, telephone, and electronic mail, were also viable methods to transfer messages to patients." Ex. 1018 ¶ 52. Petitioner has made a sufficient showing regarding the "transfer unit" limitations of claim 1. *See* Pet. 29, 48–49; Ex. 1018 ¶¶ 49, 51–52.

Third, Patent Owner contends that Crawford does not teach a "group overview chart" with separate "data points" and "icons," as recited in claim 1. Prelim. Resp. 38–39. As explained above, we interpret "chart" to mean "information arranged in the form of one or more tables, graphs, or diagrams," and interpret "icon" to mean "a graphical representation of an underlying function or data." *See supra* Section I.E. Based on the current record, Petitioner has shown sufficiently that Crawford's overview display is a chart having data points, each representing one patient and indicating a value for the patient (e.g., a warning situation) based on measurements for the patient, with each data point having an icon (image of a room), as recited in claim 1. *See* Pet. 54–56.

Fourth, Patent Owner argues that a person of ordinary skill in the art would not have had reason to combine the teachings of Goodman, Shabot, and Crawford. Prelim. Resp. 42–45. In its Petition, Petitioner contends that Goodman and Shabot both describe "remote monitoring systems that monitor patients over time (e.g., based on health history)," and a person of ordinary skill in the art would have been motivated to incorporate Shabot's evaluation against medical health history information into Goodman's monitoring system "to provide periodic reports to a primary provider, allowing that provider to determine if the patient is following a particular treatment." Pet. 27–28; *see* Ex. 1018 ¶¶ 31–34, 40–41. Further, according to Petitioner, a skilled artisan would have been motivated to expand

Goodman's monitoring system to include alerts based on data collected over time, as taught by Shabot, to improve "automation and efficiency in detecting health conditions of concern" and help health care professionals detect "critical situation[s]." Pet. 31; *see* Ex. 1018 ¶¶ 45, 47–48. As to Crawford, Petitioner contends that the reference is directed to "monitoring of patient populations," just like Goodman and Shabot, and a person of ordinary skill in the art would have been motivated to incorporate Crawford's overview display into the other monitoring systems to "enhance the remote monitoring capabilities available" by using a display where "multiple patients can be quickly monitored at once." Pet. 33–36; *see* Ex. 1018 ¶ 90. Dr. Stone testifies regarding these and other reasons why a person of ordinary skill in the art would have had reason to combine the teachings of the references to arrive at the claimed system. *See, e.g.*, Ex. 1018 ¶¶ 31–92.

Patent Owner argues that the system of Goodman is so different from the systems of Shabot and Crawford that a skilled artisan would not have thought to combine them. Prelim. Resp. 42–45. Specifically, Shabot and Crawford continuously monitor a group of patients in real-time, whereas Goodman collects information from patients, not in real-time, and presents information to health care professionals. *Id*. Goodman's system, therefore, is "incompatible" with those of Shabot and Crawford according to Patent Owner. *Id*. Based on the current record, we do not view the systems disclosed in the three references as so different that a person of ordinary skill in the art would not have combined their teachings. In particular, we note that Goodman describes monitoring more than one patient, just like Shabot

and Crawford. *See* Ex. 1002, col. 8, l. 65–col. 10, l. 28; Ex. 1003, col. 5, ll. 42–52; Ex. 1006, col. 2, ll. 60–63.

Patent Owner further contends that incorporating Crawford's display into the system of Shabot would "make no sense" and "improperly alter the functionality of Shabot" because Crawford uses a computer display and Shabot uses alphanumeric pager messages. Prelim. Resp. 45. Petitioner, however, has explained sufficiently how the teachings of Crawford could be combined with those of Goodman and Shabot. *See* Pet. 33–36. At this stage of the proceeding, we are persuaded that Petitioner's analysis, supported by the testimony of Dr. Stone, is sufficient to show "'some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.'" *See KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 417–18 (2007) (citation omitted).

Fifth, Patent Owner argues that various secondary considerations of non-obviousness demonstrate that the challenged claims would not have been obvious to a person of ordinary skill in the art. Prelim. Resp. 53–57. Patent Owner argues that its "Health Buddy" remote health monitoring system was commercially successful, satisfied a long-felt need in the art, received praise from others, was different from other systems of the time, and was copied by others. *Id*. Patent Owner cites as support the declaration of Yadin David, Ed.D. (Ex. 2001) submitted in Case IPR2013-00449 involving U.S. Patent No. 7,840,420 B2 ("the '420 patent"). *Id*. (citing Ex. 2001 ¶¶ 74–106). Dr. David's testimony, however, pertains to the challenged claims of the '420 patent. Patent Owner does not explain how Dr. David's testimony regarding different claims is applicable to the claims being challenged in this proceeding. For example, commercial success

requires evidence of a nexus, i.e., "proof that the sales [of the allegedly successful product] were a direct result of the unique characteristics of *the claimed invention*." *In re Huang*, 100 F.3d 135, 140 (Fed. Cir. 1996) (emphasis added). The claimed invention in each of the challenged claims is different from that recited in the '420 patent claims. Further, to the extent Patent Owner relies on other materials describing its "Health Buddy" system, Patent Owner has not provided sufficient explanation, at this stage of the proceeding, to counter Petitioner's evidence of obviousness. *See* Prelim. Resp. 53–57 (citing Exs. 2008–11, 2023, 2024, 2033).

Petitioner has demonstrated, on this record, a reasonable likelihood of prevailing on its assertion that claim 1 is unpatentable over the combination of Goodman, Shabot, and Crawford. We also are persuaded that there is a reasonable likelihood that Petitioner would prevail on the same asserted ground as to dependent claims 3–9, which Patent Owner does not dispute separately in its Preliminary Response.

F. Asserted Ground Based on Goodman, Shabot, Crawford, and Vincent

Petitioner contends that claim 2 is unpatentable over Goodman, Shabot, Crawford, and Vincent under 35 U.S.C. § 103(a), relying on Vincent for the additional limitation in claim 2 of "determin[ing] compliance based upon a time of receipt of said set of corresponding set of measurements and a number of corresponding sets of measurements compared with a prescribed number." Pet. 40–41, 56–57 (citing Ex. 1005 at 656–58). According to Petitioner and Dr. Stone, Vincent "teaches that calculating compliance and basing patient reminders on such compliance has a dramatic, positive impact on patient action," and a person of ordinary skill in the art

would have been motivated to incorporate such a calculation in the systems of the other references. *Id*. at 40–41; *see* Ex. 1018 ¶¶ 74–79, 93–95. Patent Owner does not argue claim 2 specifically in its Preliminary Response. Upon review of Petitioner's analysis and supporting declaration, we are persuaded that Petitioner has established a reasonable likelihood of prevailing on the asserted ground.

G. Additional Asserted Grounds

As explained above, we are persuaded that Petitioner has demonstrated a reasonable likelihood that claims 1 and 3–9 are unpatentable over Goodman, Shabot, and Crawford, and that claim 2 is unpatentable over Goodman, Shabot, Crawford, and Vincent. Petitioner also contends that, under 35 U.S.C. § 103(a), (1) claims 1 and 3–9 are unpatentable over Goodman, Shabot, and Groner; (2) claim 2 is unpatentable over Goodman, Shabot, Groner, and Vincent; (3) claims 1 and 3–9 are unpatentable over Goodman, Shabot, Crawford, and Tallman; and (4) claim 2 is unpatentable over Goodman, Shabot, Crawford, Tallman, and Vincent. Pet. 36–60. We exercise our discretion and deny the additional grounds as redundant to the grounds of unpatentability on which we institute an *inter partes* review. *See* 37 C.F.R. § 42.108.

H. Conclusion

We conclude that Petitioner has demonstrated a reasonable likelihood of prevailing with respect to at least one claim of the '605 patent challenged in the Petition. The Board, however, has not made a final determination

under 35 U.S.C. § 318(a) with respect to the patentability of the challenged claims.

III. ORDER

In consideration of the foregoing, it is hereby:

ORDERED that an *inter partes* review is instituted as to claims 1–9 of the '605 patent;

FURTHER ORDERED that pursuant to 35 U.S.C. § 314(a), *inter partes* review of the '605 patent is hereby instituted commencing on the entry date of this Order, and pursuant to 35 U.S.C. § 314(c) and 37 C.F.R. § 42.4, notice is hereby given of the institution of a trial; and

FURTHER ORDERED that the trial is limited to the following grounds of unpatentability, and no other grounds set forth in the Petition as to claims 1–9 of the '605 patent are authorized:

Claims 1 and 3–9 under 35 U.S.C. § 103(a) as unpatentable over Goodman, Shabot, and Crawford; and

Claim 2 under 35 U.S.C. § 103(a) as unpatentable over Goodman, Shabot, Crawford, and Vincent.

PETITIONER:

Daniel W. McDonald
Andrew J. Lagatta
William D. Schultz
Thomas J. Leach
MERCHANT & GOULD, P.C.
dmcdonald@merchantgould.com
alagatta@merchantgould.com
wschultz@merchantgould.com
tleach@merchantgould.com

PATENT OWNER:

Don Daybell
Davin M. Stockwell
ORRICK, HERRINGTON & SUTCLIFFE LLP
D2DPTABDocket@orrick.com
D2SPTABDocket@orrick.com