

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MDx MEDICAL, INC.,
Petitioner,

v.

HEALTH GRADES, INC.,
Patent Owner.

Case IPR2014-01090
Patent 8,719,052 B2

Before MICHAEL W. KIM, PATRICK R. SCANLON, and
DAVID C. McKONE, *Administrative Patent Judges*.

SCANLON, *Administrative Patent Judge*.

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

I. INTRODUCTION

Petitioner, MDx Medical, Inc., filed a corrected Petition (Paper 4, “Pet.”)¹ to institute an *inter partes* review of claims 1–4 and 6–33 of U.S. Patent No. 8,719,052 B2 (Ex. 1001, “the ’052 patent”) pursuant to 35 U.S.C. §§ 311–319. Patent Owner, Health Grades, Inc., filed a Preliminary Response (Paper 7, “Prelim. Resp.”). We have jurisdiction under 35 U.S.C. § 314, which provides that *inter partes* review may not be instituted unless “the information presented in the petition . . . and any [preliminary] response . . . 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.” 35 U.S.C. § 314(a).

Petitioner challenges claims 1–4 and 6–33 on various asserted grounds of unpatentability. We institute an *inter partes* review as to claims 1–4, 6–11, 15–29, and 33 on certain grounds as discussed below.

II. BACKGROUND

A. Related Matters

The parties state that the ’052 patent is at issue in *Health Grades, Inc. v. MDx Medical, Inc.*, No. 1:14-cv-01268-RM (D. Colo.). Pet. 1; Paper 6, 2. In addition, Petitioner indicates that U.S. Patent No. 7,752,060, to which the ’052 patent claims priority, is at issue in *Health Grades, Inc. v. MDx Medical, Inc.*, No. 1:11-cv-00520-RM-BNB (D. Colo.). Pet. 1.

¹ Paper 4 is a corrected Petition for *inter partes* review, filed July 23, 2014, and subsequently accepted by the Board. See Paper 5. The original Petition for *inter partes* review (Paper 1) has been accorded the filing date of July 1, 2014. Paper 3.

B. The '052 Patent (Ex. 1001)

The '052 patent, titled “Internet System for Connecting Healthcare Providers and Patients,” issued on May 6, 2014. The '052 patent describes “[a]n Internet-based system [having] a database and search capabilities for connecting patients with healthcare providers.” Ex. 1001, Abstract. The invention allows users to perform “searches for healthcare providers based on geographic area, specialty, and/or other criteria,” and “compiles and produces a results list of providers meeting such criteria.” *Id.* at 2:2–7. Reports can include various types of information, including physician-verified information, information verified by an independent third party, and patient-provided information. *Id.* at 7:59–8:42.

C. Illustrative Claim

Claim 1 of the '052 patent is illustrative of the claims at issue:

1. A computer-implemented method of providing healthcare professional information to potential patients, said method comprising:

(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;

(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 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;

(ii) patient-provided information comprising patient ratings from one or more patients of the one or more healthcare professionals;

(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

(iv) a comparison rating for the one or more healthcare professionals; and

(c) providing access to the results list over a computer network.

D. The Prior Art

Petitioner relies on the following prior art:

1. U.S. Patent No. 7,167,855 B1, issued Jan. 23, 2007 (“Koenig”) (Ex. 1006);
2. Linda Shelton, *Recommendations for Improving the Quality of Physician Directory Information on the Internet*, NCQA (Aug. 2004) (“Shelton”) (Ex. 1007);
3. Health Grades Physician Quality Comparison Report (Dec. 28, 2004) (“PQCR”) (Ex. 1008);
4. Health Grades Physician Quality Report (Sept. 15, 2004) (“PQR”) (Ex. 1009);
5. Health Grades Report-David A. Drucker, MD (June 4, 2005) (“Drucker”)² (Ex. 1010);

² Exhibits 1008, 1009, and 1010 are purported to be printed publications published by Patent Owner. Pet. 13–14.

6. U.S. Patent Application Publication No. 2002/0010616 A1, published Jan. 24, 2002 (“Itzhaki”) (Ex. 1011);

7. U.S. Patent Application Publication No. 2006/0015369 A1, published Jan. 19, 2006 (“Bachus”) (Ex. 1012);

8. U.S. Patent Application Publication No. 2006/0294138 A1, published Dec. 28, 2006 (“Stolba”) (Ex. 1013); and

9. U.S. Patent Application Publication No. 2002/0038233 A1, published Mar. 28, 2002 (“Shubov”) (Ex. 1014).

E. The Asserted Grounds

Petitioner challenges claims 1–4 and 6–33 of the ’052 patent on the following grounds:

Reference(s)	Basis	Claim(s) Challenged
Shelton	§ 102(b) or § 103	1, 2, 4, 6–10, and 15–17
Shelton and PQCR	§ 103	1, 2, 4, 6–10, and 15–17
Shelton, Bachus, and Itzhaki or Shelton, PQCR, Bachus, and Itzhaki	§ 103	2 and 3
Shelton and Stolba or Shelton, PQCR, and Stolba	§ 103	11
Shelton and Shubov or Shelton, PQCR, and Shubov	§ 103	12–14
Shelton and PQR	§ 103	18–29 and 33
Shelton and Drucker	§ 103	18–29 and 33
Shelton, PQR and Koenig or Shelton, Drucker and Koenig	§ 103	18–29 and 33
Shelton, PQR and Itzhaki or Shelton, Drucker and Itzhaki or Shelton, PQR, Koenig, and Itzhaki or Shelton, Drucker, Koenig and Itzhaki	§ 103	19–22 and 27–29

Reference(s)	Basis	Claim(s) Challenged
Any of the combinations listed in the four previous rows and Shubov ³	§ 103	30 and 32
Any of the combinations listed in the previous row and Bachus	§ 103	31

F. Claim Interpretation

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); *accord* Office Patent Trial Practice Guide, 77 Fed. Reg. 48,756, 48,766 (Aug. 14, 2012). Under the broadest reasonable interpretation standard, claim terms are given their ordinary and customary meaning in view of the specification, as would be understood by one of ordinary skill in the art at the time of the invention. *In re Translogic Tech., Inc.*, 504 F.3d 1249, 1257 (Fed. Cir. 2007). “In determining the meaning of the disputed claim limitation, we look principally to the intrinsic evidence of record, examining the claim language itself, the written description, and the prosecution history, if in evidence.” *DePuy Spine, Inc. v. Medtronic Sofamor Danek, Inc.*, 469 F.3d 1005, 1014 (Fed. Cir. 2006) (citing *Phillips v. AWH Corp.*, 415 F.3d 1303, 1312–17 (Fed. Cir. 2005) (en banc)).

For purposes of this Decision, we find it necessary to construe only the term “comparison rating,” as recited in claims 1 and 18. Petitioner proposes

³ Although Petitioner identifies Stolba as a reference in this combination in the chart on page 12 of the Petition and the heading on page 53 of the Petition, the text of the Petition describes Shubov as disclosing the elements of claims 30 and 32. Pet. 54. We thus treat this asserted ground of unpatentability as including Shubov rather than Stolba.

that “comparison rating” should be construed as “a rating, separate from a patient rating for a healthcare professional, for comparing the healthcare professional.” Pet. 17–18. As support for its proposed interpretation, Petitioner asserts that “both the claims and specification of the ’052 Patent treat ‘patient ratings’ and ‘comparison ratings’ differently.” *Id.* at 17 (citing Ex. 1001, 20:48–50, 20:58–59, 9:8–32, 2:2–12). Patent Owner proposes that “the term ‘comparison rating’ should be construed to mean: ‘a rating that allows a healthcare professional to be compared to other healthcare professionals.’” Prelim. Resp. 15. Patent Owner asserts that although “the comparison rating element is a separate claim element from the patient rating element of the claim,” the ’052 patent does not prevent “the recited comparison rating from being based upon, at least in part, patient ratings.” *Id.* at 15–16.

The essential dispute between the parties is whether the recitation of “patient ratings” in the claims should impact the interpretation of “comparison rating.” Consideration of the context in which a term is used in a claim is a bedrock principle of claim construction. *See, e.g., Phillips*, 415 F.3d at 1314 (“To begin with, the context in which a term is used in the asserted claim can be highly instructive.”). Here, the claims clearly recite “patient ratings” and “comparison rating” as two separate and distinct elements, which suggests the two terms have different meanings. *See CAE Screenplates, Inc. v. Heinrich Fiedler GmbH & Co. KG*, 224 F.3d 1308, 1317 (Fed. Cir. 2000) (“In the absence of any evidence to the contrary, we must presume that the use of these different terms in the claims connotes different meanings.”). In addition, although not expressly defining “patient ratings” or “comparison rating,” the Specification of the ’052 patent refers to “patient survey 366” and

“comparisons 368” of Figure 3B as separate elements. Also, we agree with Patent Owner that the ’052 patent discloses comparison ratings that compare healthcare professionals to one another. Accordingly, we adopt aspects of both Petitioner’s and Patent Owner’s proposed constructions and interpret “comparison rating” as “a rating, separate from a patient rating for a healthcare professional, for comparing the healthcare professional to other healthcare professionals.”

III. ANALYSIS

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

A. Asserted Grounds Based on Shelton

Petitioner challenges claims 1, 2, 4, 6–10, and 15–17 as either anticipated under 35 U.S.C. § 102(b) by Shelton or obvious under 35 U.S.C. § 103(a) over Shelton. Pet. 12, 21–31. To support this assertion, Petitioner relies on the Declaration of Richard G. Cooper, D.Sc. (Ex. 1015).

Shelton discloses the recommendations made by an “expert consensus panel” regarding “the elements that constitute quality in electronic physician directories for consumers.” Ex. 1007, v. The recommendations involve “the kinds of information that would best help consumers choose doctors and health plans.” *Id.* Pages 11–19 of Shelton present a table that sets forth the panel’s recommendations of specific elements that would be useful for consumer choice. These elements include patient survey data. *Id.* at 19.

Petitioner presents a claim chart identifying where the individual features of the challenged claims are alleged to be found in Shelton. Pet. 22–27. Independent claim 1 of the ’052 patent recites creating a results list of

healthcare professional information, wherein the healthcare professional information comprises, *inter alia*, “patient-provided information comprising patient ratings” and “a comparison rating for the one or more healthcare professionals.” Ex. 1001, 20:33–59. Petitioner asserts that Shelton discloses the “patient-provided information comprising patient ratings” because “Shelton discloses ‘patient survey data’ (page 19), which are ratings.” Pet. 23; *see also id.* at 28 (“While Shelton does not use the word ‘ratings’ in its disclosure, the Shelton ‘patient survey data’ at page 19 are inherently ratings.”). Regarding the claimed “comparison rating,” Petitioner argues that this element is also disclosed by Shelton’s patient survey data. *Id.* at 24, 28–29.

Alternatively, Petitioner argues that if the Board “does not accept that the ‘ratings’ element (element 1(b)(ii))⁴ is inherently met by the Shelton ‘patient survey data’, then that element is obvious in view of the Shelton teaching.” *Id.* at 30 (footnote added). Petitioner asserts that patient ratings would have been obvious in view of Shelton because collecting Shelton’s “patient survey data in the form of ratings is the . . . most sensible way to provide searchability while not using open-ended comments.” *Id.* Petitioner further asserts:

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).

⁴ Petitioner refers to the claimed “patient-provided information comprising patient ratings” as element 1(b)(ii).

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.

Id.

Patent Owner argues that Shelton does not anticipate the challenged claims because the reference “does not disclose many of the claim elements, including patient ratings and comparison ratings.” Prelim. Resp. 21. Patent Owner asserts “Petitioner does not cite any specific part of Shelton that discloses a comparison rating. Rather, Petitioner’s claim chart states: ‘See Element 1(b)(ii). See also Cooper Report, ¶ 51.’ Element 1(b)(ii) is the ‘patient ratings’ element from claim 1 itself.” Prelim. Resp. 22. Patent Owner argues further that “Petitioner’s anticipation argument is blatantly inconsistent with its own proposed claim construction,” and “paragraph 51 of Dr. Cooper’s report makes no mention of ‘comparison ratings.’” *Id.*

Regarding Petitioner’s assertion that the claims are obvious over Shelton, Patent Owner argues:

The entirety of Petitioner’s obviousness argument regarding “comparison ratings” is one sentence. (Pet., 30.) Petitioner states “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.” (Pet., 30.) Petitioner provides no further description of comparison ratings. Rather, Petitioner discusses only patient ratings. To the extent Petitioner is asserting that a patient rating is the same as a comparison rating, that assertion is directly contrary to Petitioner’s proposed claim construction of comparison rating.

Prelim. Resp. 36.

We find Patent Owner's arguments persuasive. As discussed above, Petitioner's anticipation argument is based on Shelton's patient survey data meeting both the "patient ratings" and "comparison rating" elements of claim 1.⁵ The same disclosure of Shelton, however, cannot be used to meet separate elements of the same claim. *See Becton Dickinson and Co. v. Tyco Healthcare Group, LP*, 616 F.3d 1249, 1254 (Fed. Cir. 2010) (noting where a claim lists elements separately, "the clear implication of the claim language" is that those elements are "distinct components" of the patented invention). In addition, for the reasons asserted by Patent Owner (*see* Prelim. Resp. 36), Petitioner does not establish sufficiently that a comparison rating would have been obvious in view of the teachings of Shelton.

Accordingly, based on the record before us, we determine that Petitioner has not demonstrated a reasonable likelihood that it would prevail in showing that claims 1, 2, 4, 6–10, and 15–17 are anticipated by Shelton or in showing that claims 1, 2, 4, 6–10, and 15–17 would have been obvious over Shelton.

B. Asserted Ground Based on Shelton and PQCR

Petitioner challenges claims 1, 2, 4, 6–10, and 15–17 as unpatentable over Shelton and PQCR under 35 U.S.C. § 103(a). Pet. 12, 31–34. Petitioner asserts that the claim "elements of creating a results list, patient ratings, and comparison ratings are all obvious under Shelton in view of the PQCR," and relies on Shelton as disclosing or rendering obvious all other claim elements. Pet. 31.

⁵ We agree that this position appears inconsistent with Petitioner's proposed claim construction, which we adopt in pertinent part (*see supra* Section II.F.), that a "comparison rating" is "separate from a patient rating."

PQCR is a “Physician Quality Comparison Report” that provides “a written guide for physician comparison and selection” of 20 physicians in the Lexington, Kentucky area. Ex. 1008, 1. The report includes ratings of several hospitals in the area. *Id.* at 11–14. The report indicates that the hospital ratings are provided to give the user “yet another gauge for evaluating a physician” because most physicians admit patients only to hospitals with which the physician is affiliated. *Id.* at 11–12. The hospital ratings are based on “Medicare patient data.” *Id.* at 14.

Petitioner asserts that because PQCR discloses using hospital ratings to evaluate physicians, “the concept of using ratings to compare physician quality is already disclosed in PQCR, *and these are comparison ratings.*” Pet. 32 (emphasis added). Regarding patient ratings, Petitioner argues that because PQCR discloses using ratings based on patient data to evaluate physicians, and Shelton discloses collecting patient survey data regarding physicians, it would have been “an obvious variation based on nothing more than common sense” to have patients rate physicians. *Id.* at 32–33 (citing *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398 (2007)). In other words, according to Petitioner, it would have been obvious to modify Shelton to include comparison ratings in the form of the hospital ratings taught by PQCR and to further modify Shelton by reporting the patient survey data in the form of patient ratings. Even after considering Patent Owner’s arguments, as set forth below, we determine that, on this record, Petitioner’s position is more persuasive.

Patent Owner argues that “PQCR does not include any patient provided information, and therefore cannot include patient ratings.” Prelim. Resp. 37. This argument is not persuasive because it addresses PQCR individually and

does not address Petitioner's proposed combination of Shelton and PQCR. *See In re Keller*, 642 F.2d 413, 426 (CCPA 1981). As discussed above, Petitioner asserts that patient ratings are obvious over the combination of Shelton and PQCR.

Patent Owner also argues that the hospital ratings in PQCR are not ratings of healthcare professionals (Prelim. Resp. 37), and PQCR “does not disclose a comparison rating for the healthcare professional, who is a human being” (*id.* at 38). We do not find these arguments persuasive because PQCR discloses that the hospital ratings are provided specifically to evaluate physicians. Ex. 1008, 11–12. In other words, it is possible for users to compare physicians to one another taking into account the quality of the hospitals with which they are affiliated. Therefore, it is reasonable to conclude that these ratings are comparison ratings for healthcare professionals.

Patent Owner also challenges Petitioner's reasons for combining Shelton and PQCR, arguing that “Petitioner states *only* ‘there is motivation in each reference to be combined with one another’ (Pet. 31), citing Dr. Cooper's report.” Prelim. Resp. 54 (emphasis added). Petitioner, however, does not rely on the Cooper Declaration as the sole basis for combining the references. Rather, relying on *KSR*, Petitioner also argues that it would have been obvious to combine Shelton and PQCR based on common sense. Pet. 32–33. *KSR* indicates that common sense may provide a reason to combine references in an obviousness analysis. *See KSR*, 550 U.S. at 420 (“Rigid preventative rules that deny factfinders recourse to common sense, however, are neither necessary under our case law nor consistent with it.”); *see also Perfect Web Techs., Inc. v. InfoUSA, Inc.*, 587 F.3d 1324, 1328–29 (Fed. Cir. 2009). Based

on the current record, we are persuaded that there is sufficient rationale for combining Shelton and PQCR in the manner proposed by Petitioner.

Patent Owner lastly argues that “[t]he objective indicia of non-obviousness demonstrate that the Petition is unlikely to prevail in proving that that the ’052 Patent claims are obvious.” Prelim. Resp. 56. Patent Owner asserts that “Health Grades’ website is protected, in part, by the ’052 Patent and has been wildly successful *based on features claimed in the ’052 Patent.*” *Id.* at 58 (emphasis added). In particular, Patent Owner asserts: “the Health Grades website was selected as one of the 50 Best Websites by TIME Magazine” (*id.* (citing Ex. 2002)); “over 200 million people have visited [the] Health Grades website to find a doctor or hospital” (*id.* (citing Ex. 2001)); and “Health Grades remains a leader in the industry, ranking as one the top 600 websites visited in the United States, and continues to see thousands of page visits every month” (*id.* (citing Exs. 2005, 2010, 2011)).

Patent Owner has not established on the present record, however, a sufficient nexus between the asserted success of the Health Grades website and the claims at issue in this proceeding. *See In re GPAC Inc.*, 57 F.3d. 1573, 1580 (Fed. Cir. 1995) (holding that there must be a nexus between the merits of the claimed invention and the evidence of secondary considerations). Patent Owner’s statement that “Time Magazine specifically calls out features of the claims of the ’052 Patent” (Prelim. Resp. 58) is inadequate to establish the required nexus. The *Time* Magazine article discusses the Health Grades website in generalities and, contrary to Patent Owner’s assertion, does not discuss specific claim features. Ex. 2002.

In conclusion, Petitioner has demonstrated, on this record, a reasonable likelihood that it would prevail in showing that claims 1, 2, 4, 6–10, and 15–17 are unpatentable over Shelton and PQCR.

*C. Asserted Grounds Based on Shelton, PQCR
Bachus, and Itzhaki*

Petitioner challenges claim 2 as unpatentable over Shelton and either Bachus or Itzhaki, or over Shelton and PQCR and either Bachus or Itzhaki. Pet. 34–35. As we have decided to institute *inter partes* review of challenged claim 2 based on the combination of Shelton and PQCR (*see supra* Section III.B.), we exercise our discretion and decline to institute a review of claim 2 based on any of these alternative asserted grounds. *See* 37 C.F.R. § 42.108(a); *Liberty Mutual Ins. Co. v. Progressive Casualty Ins. Co.*, CBM2012-00003 (PTAB Oct. 25, 2012) (Paper 7).

Claim 3 recites “receiving a response to a question from the on-line patient experience survey from the one or more patients; and receiving an e-mail address from the one or more patients.” Petitioner asserts that Bachus discloses the use of a patient survey in which patients may leave an email address.⁶ Pet. 35 (citing Ex. 1012 ¶ 23). Patent Owner argues that Bachus discloses providing patient recommendations that are “narratives,” and does not disclose “any kind of ratings.” Prelim. Resp. 40. We are not persuaded by Patent Owner’s argument, because Petitioner asserts that claim 3 would

⁶ Petitioner includes Itzhaki in the combinations of references it asserts against claim 3, but it does not explain how Itzhaki contributes to rendering the claim obvious. *See* Pet. 35–36. Because we are otherwise persuaded, on this record, that Petitioner has shown a reasonable likelihood of prevailing in establishing obviousness based on Shelton, PQCR, and Bachus alone, we omit Itzhaki from the ground on which we institute trial for claim 3.

have been obvious over the combination of Shelton, PQCR, and Bachus, and does not rely on Bachus alone for disclosing ratings.

Based on the record before us, we determine that Petitioner has demonstrated a reasonable likelihood that it would prevail in showing that claim 3 would be rendered obvious by the combination of Shelton, PQCR, and Bachus, but not by any of the other combinations asserted by Petitioner with respect to claim 3.

D. Asserted Grounds Based on Shelton, PQCR, and Stolba

Petitioner challenges claim 11 as unpatentable over either Shelton and Stolba, or Shelton, PQCR and Stolba. Pet. 36. Claim 11 calls for “sending the results list to a second device for displaying an advertisement for a healthcare professional adjacent to the results list.” Petitioner asserts that Stolba discloses displaying advertisements during searching on a web site. *Id.* Patent Owner argues “Stolba describes including only basic information within the system, and does not discuss or even relate to any type of comparison ratings for a healthcare professional.” Prelim. Resp. 41.

Stolba discloses a system for rating professionals in which users are able to search a database via a web site. Ex. 1013, Abstract. In addition, Stolba discloses “the user’s advertisements will be displayed during searches and on the web site” and “it is possible to provide advertisements based on search terms, for example so that a law firm’s advertisements will be displayed when a user is searching for a law firm.” *Id.* ¶ 47. Moreover, we are not persuaded by Patent Owner’s argument, because other references, and not Stolba, are relied on for the recited ratings.

Accordingly, we conclude, on this record, Petitioner has demonstrated a reasonable likelihood of prevailing on its assertion that claim 11 is

unpatentable over the combination of Shelton, PQCR, and Stolba. As we have decided to institute *inter partes* review of claim 11 based on the combination of Shelton, PQCR, and Stolba, we exercise our discretion and decline to institute a review of claim 11 based on the combination of Shelton and Stolba. *See* 37 C.F.R. § 42.108(a); *Liberty Mutual Ins. Co.*, CBM2012-00003 (PTAB), Paper 7.

E. Asserted Grounds Based on Shelton, PQCR, and Shubov

Petitioner challenges claims 12–14 as unpatentable over either Shelton and Shubov, or over Shelton, PQCR and Shubov. Pet. 37–38. Claim 12 recites the steps of “determining whether each of the one or more healthcare professionals is a member of the on-line information service” and providing enhanced services for members. Claims 13 and 14 depend from claim 12.

Petitioner asserts that Shubov discloses the determining step of claim 12 “in disclosing a prior art system whereby professionals register with the website.” *Id.* at 37 (citing Ex. 1014 ¶ 140). Paragraph 140 of Shubov, however, discusses how “each attorney accesses the matching system through his or her own homepage.” Ex. 1014 ¶ 140. This paragraph does not discuss determining whether a professional is registered with the system. On the contrary, Shubov discloses that each professional must be registered to use the system. *See id.* ¶ 38 (“before an attorney can use the matching system, he or she must go through attorney registration section 215”). Because every professional must be registered (i.e., must be a “member” of the system), Shubov does not contemplate “non-members” participating in the system. As such, there is no reason in Shubov to distinguish between members and non-members, and there is no disclosure of providing enhanced services to members.

Accordingly, we are not persuaded that Shubov suggests determining whether a healthcare professional is a member of the on-line information service and providing enhanced services to members. For this reason, Petitioner has not demonstrated, on this record, a reasonable likelihood of prevailing on its assertion that claims 12–14 are unpatentable over either the combination of Shelton and Shubov, or the combination of Shelton, PQCR and Shubov.

F. Asserted Ground Based on Shelton and PQR

Petitioner challenges claims 18–29 and 33 as unpatentable over Shelton and PQR under 35 U.S.C. § 103(a). Pet. 12, 38–48. Independent claim 18 calls for a “computer-implemented method of providing healthcare professional information to potential patients” including, *inter alia*, the steps of compiling patient-provided information in the form of patient ratings and creating a healthcare professional report that includes the patient-provided information and a comparison rating.

PQR is a “Physician Quality Report” that is very similar in format to the report of PQCR with a key difference that it reports on single physician. Ex. 1009, 2. Like PQCR, PQR shows a report that includes ratings of several hospitals in the area. *Id.* at 9–14. The report indicates that the hospital ratings are provided to give the user “yet another gauge for evaluating a physician” because most physicians admit patients only to hospitals with which the physician is affiliated. *Id.* at 10. The hospital ratings are based on “Medicare patient data.” *Id.* at 14.

Regarding the patient ratings of claim 18, Petitioner argues that because PQR discloses using ratings based on patient data to evaluate physicians and Shelton discloses collecting patient survey data regarding physicians, it would

have been “an obvious variation based on nothing more than common sense” to have patients rate physicians. *Id.* at 46–47 (citing *KSR*). Regarding the claimed comparison rating, Petitioner argues that because PQR discloses using hospital ratings to evaluate physicians, “the concept of using ratings to compare physician quality is already disclosed in PQR, and these are comparison ratings.” Pet. 47. Thus, it would have been obvious to modify Shelton to include comparison ratings in the form of the hospital ratings taught by PQR and to further modify Shelton by reporting the patient survey data in the form of patient ratings.

Even after considering Patent Owner’s arguments, as set forth below, we determine that, on this record, Petitioner’s position is more persuasive. Patent Owner argues that a “hospital is not a ‘healthcare professional,’” and it is not an obvious transition from hospital comparisons to physician comparisons. Prelim. Resp. 44. We are not persuaded by this argument because PQR discloses that the hospital ratings are provided specifically to evaluate physicians. Ex. 1009, 10. That is, users can compare physicians based on the quality of the hospitals with which they are affiliated. Therefore, it is reasonable to conclude that these ratings are comparison ratings for healthcare professionals.

Based on the record before us, we determine that Petitioner has demonstrated a reasonable likelihood that it would prevail in showing that claims 18–29 and 33 are unpatentable over Shelton and PQR.

G. Asserted Grounds Based Primarily on Shelton and Shubov

Petitioner challenges claims 30 and 32 as unpatentable over Shelton and Shubov together with one or more of various other references. Pet. 12–13, 53–54. Claim 30, from which claim 32 depends, recites the step of

“determining whether the first healthcare professional is a member of the on-line information service.” Petitioner asserts that Shubov discloses the determining step of claim 30 “in disclosing a prior art system whereby professionals register with the website.” *Id.* at 54 (citing Ex. 1014 ¶ 140). For the reasons discussed above (*see supra* Section III.E.), however, we are not persuaded that Shubov suggests determining whether a healthcare professional is a member of the on-line information service. Accordingly, Petitioner has not demonstrated, on this record, a reasonable likelihood of prevailing on its assertion that claims 30 and 32 are unpatentable over any of the combinations asserted against these claims.

*H. Asserted Grounds Based Primarily on Shelton,
Shubov, and Bachus*

Petitioner challenges claim 31, which depends from claim 30, as unpatentable over any of the combinations of references asserted against claim 30 together with Bachus. Pet. 13, 54–55. Each one of these asserted grounds depends on Petitioner’s assertion that Shubov discloses the step of “determining whether the first healthcare professional is a member of the on-line information service” recited in claim 30. For the reasons discussed above (*see supra* Section III.E.), however, we are not persuaded that Shubov discloses this determining step. Accordingly, Petitioner has not demonstrated, on this record, a reasonable likelihood of prevailing on its assertion that claim 31 is unpatentable over any of the combinations asserted against it.

I. Remaining Asserted Grounds

Petitioner challenges claims 18–29 and 33 as unpatentable over (1) Shelton and Drucker; (2) Shelton, PQR, and Koenig; or (3) Shelton, Drucker, and Koenig. Pet. 12, 48–52. Petitioner also challenges claims 19–22 and 27–

29 as unpatentable over (1) Shelton, PQR, and Itzhaki; (2) Shelton, Drucker, and Itzhaki; (3) Shelton, PQR, Koenig, and Itzhaki; or (4) Shelton, Drucker, Koenig, and Itzhaki. Pet. 12, 53. Because we have already instituted review of these claims on other grounds, we exercise our discretion and decline to institute a review based on these asserted grounds. *See* 37 C.F.R. § 42.108(a); *Liberty Mutual Ins. Co.*, CBM2012-00003 (PTAB), Paper 7.

J. Conclusion

We conclude that Petitioner has demonstrated a reasonable likelihood of prevailing with respect to its challenge of claims 1–4, 6–11, 15–29, and 33 of the '052 patent. We have not made, however, a final determination under 35 U.S.C. § 318(a) with respect to the patentability of the challenged claims.

IV. ORDER

In consideration of the foregoing, it is hereby:

ORDERED that *inter partes* review is authorized on the following grounds of unpatentability asserted in the Petition:

Claims 1, 2, 4, 6–10, and 15–17 under 35 U.S.C. § 103(a) as unpatentable over Shelton and PQCR;

Claim 3 under 35 U.S.C. § 103(a) as unpatentable over Shelton, PQCR, and Bachus;

Claim 11 under 35 U.S.C. § 103(a) as unpatentable over Shelton, PQCR, and Stolba; and

Claims 18–29 and 33 under 35 U.S.C. § 103(a) as unpatentable over Shelton and PQR;

FURTHER ORDERED that pursuant to 35 U.S.C. § 314(a), *inter partes* review of the '052 patent is hereby instituted commencing on the entry

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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 grounds identified above, and no other ground set forth in the Petition as to any challenged claim is authorized.

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