

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

RESPIRONICS, INC.,
Petitioner,

v.

ZOLL MEDICAL CORPORATION,
Patent Owner.

Case IPR2013-00322
Patent 6,681,003 B2

Before BRYAN F. MOORE, BRIAN J. MCNAMARA, and
SCOTT E. KAMHOLZ, *Administrative Patent Judges*.

KAMHOLZ, *Administrative Patent Judge*.

DECISION
Petitioner's Request for Rehearing
37 C.F.R. § 42.71

I. INTRODUCTION

Petitioner Respiroics, Inc. (“Respiroics”) filed a Request for Rehearing (Paper 47, “Req.”) of our determination in the Final Written Decision (Paper 46, “Dec.”) that Respiroics had not proven the unpatentability claims 2, 4, 5, 8, 9, 16, 19, and 20 of U.S. Patent No. 6,681,003 by a preponderance of the evidence. Req. 1; Dec. 28. We have considered the Request for Rehearing but decline to modify the Decision.

II. STANDARD OF REVIEW

A party challenging a final written decision by way of a request for rehearing must identify specifically all matters the party believes the Board misapprehended or overlooked. 37 C.F.R. § 42.71(d). The challenging party bears the burden of showing that the decision should be modified. *Id.*

III. DISCUSSION

Respiroics challenges the Final Written Decision with respect to our determination that Owen fails to disclose “patient compliance data.” Req. 1–12. Respiroics also challenges the Final Written Decision with respect to the disposition of the means-plus-function claims. *Id.* at 12–14.

A. *Wear-time statement*

Respiroics argues that Owen’s “statements indicating that the patient has been wearing electrode harness 4 for greater than a recommended period of time” (Ex. 1003, 31:31–32) is patient compliance data because it indicates whether the patient has followed his physician’s instructions to wear the device for a recommended period of time. Req. 4–5 (citing Paper 20, 10–11;

Ex. 1011 ¶ 65). Respiroics argues that the expert witness of Patent Owner ZOLL Medical Corporation (“Zoll”) acknowledged that wear time data is a measure of patient compliance. *Id.* at 5 (citing Paper 20, 10–11; Ex. 2006 ¶ 32). Respiroics argues that the word “recommended” indicates that it was the patient to whom the recommendation regarding wear time was given. *Id.* at 6.

These arguments do not apprise us of error in the Final Written Decision. As we explained, Owen does not disclose that it is *the patient* who is told what the recommended wear time is. Dec. 17. Respiroics acknowledged as much. *Id.* (citing Paper 45, 22:18–23). Respiroics does not identify where in its Petition or elsewhere in the record it identifies any disclosure in Owen to the contrary. A patient cannot be said to have failed to comply with a recommendation absent evidence that the patient received the recommendation. *Id.* Respiroics did not show that Owen discloses making the recommendation to the patient. *Id.* It follows that Owen’s statement that the patient exceeded this time cannot be deemed to indicate noncompliance. *Id.*

Respiroics’s argument that the word “recommended” in Owen means “recommended to the patient” is improper because it is presented for the first time on Rehearing. But the argument would be unpersuasive on the merits because it is unsupported by evidence of record. Respiroics identifies no credible evidence that Owen used, or that one of ordinary skill would have understood, the term “recommended” to mean “recommended to the patient.”

B. Response Button

Respironics argues that Owen's data indicating that the response button was pushed is "patient compliance data," because in some circumstances the patient will have pushed the button after receiving an instruction to do so. Req. 8–9. Respironics argues that Owen thus anticipates in this mode of operation, even though in other circumstances button push data might not indicate compliance. *Id.* at 9–11.*

These arguments do not apprise us of error in the Final Written Decision. As we explained, Respironics did not show how the data Owen records provides sufficient context for one to be able to determine whether a prompt preceded a particular button push. Dec. 16. Respironics did not identify any credible disclosure in Owen indicating that its data record of a button push reflects whether the push was prompted. *Id.* Because Owen does not disclose recording, e.g., the time at which the user was prompted, the information that it does record about button pushes is insufficient to distinguish prompted pushes from unprompted or accidental ones. *Id.*

Respironics's reliance on cases concerning anticipation by disclosures with optional features is inapposite. Although Owen does disclose alternative embodiments with various button configurations, Respironics has

* Respironics also argues that Zoll's arguments on the "button push" issue should be disregarded because they were presented for the first time at oral argument. Req. 7–8 n.3. We disagree. Zoll presented this argument adequately in its Response. Dec. 15 (citing Resp. 15–17). Zoll's clarification of its position at oral argument was permissible.

not identified any Owen embodiment in which the data Owen records is sufficient to indicate that a button push was prompted. *Id.*

C. Means-plus-function claims

According to Respironics, Zoll does not dispute that Owen discloses the structures disclosed by the '003 patent as corresponding to the functions recited in means-plus-function limitations of claims 4 and 19. Req. 12–14.

This argument does not apprise us of error in the Final Written Decision. As we explained, a showing that a reference discloses a means-plus-function element requires showing that the reference discloses the corresponding structure in the context of performing the recited function. Dec. 20 (citing *Fresenius USA, Inc. v. Baxter Int'l, Inc.*, 582 F.3d 1288, 1300 (Fed. Cir. 2009)). We determined that Owen does not disclose the corresponding structure in the context of the claimed function because it does not disclose operating the corresponding structure to perform the claimed functions on “patent compliance data” as that term is properly construed. *Id.* at 19–20.

IV. CONCLUSION

For the reasons given, we determine that Respironics has not carried its burden of demonstrating that the Board misapprehended or overlooked any matters in rendering the Final Written Decision. We decline to modify the Final Written Decision.

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V. ORDER

Accordingly, it is

ORDERED that the Request for Rehearing is *denied*.

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FOR PETITIONER:

Denise W. DeFranco
J. Michael Jakes
Finnegan, Henderson, Farabow,
Garrett & Dunner, L.L.P.

FOR PATENT OWNER:

John C. Phillips
Dorothy P. Whelan
John A. Dragseth
Fish & Richardson P.C.