

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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CARDIOCOM, LLC,  
Petitioner,

v.

ROBERT BOSCH HEALTHCARE SYSTEMS, INC.,  
Patent Owner.

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Case IPR2013-00431  
Patent 7,921,186 B2

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

SIU, *Administrative Patent Judge.*

FINAL WRITTEN DECISION  
35 U.S.C. § 318(a) and 37 C.F.R. § 42.73

I. BACKGROUND

Cardiocom, LLC (“Petitioner”)<sup>1</sup> filed a Petition (Paper 2) (“Pet.”) seeking *inter partes* review of claims 1–16 of U.S. Patent No. 7,921,186 B2 (Ex. 1001, “the ’186 patent”) pursuant to 35 U.S.C. §§ 311–319. On

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<sup>1</sup> Petitioner indicates that Medtronic, Inc. also is a real party-in-interest in this proceeding. Paper 21.

January 16, 2014, the Board instituted an *inter partes* review of claims 1–16 (Paper 22) (“Dec. on Inst.”).

Subsequent to institution, Robert Bosch Healthcare Systems, Inc. (“Patent Owner”) filed a Patent Owner Response (Paper 37) (“PO Resp.”),<sup>2</sup> and Petitioner filed a Reply (Paper 44) (“Pet. Reply”). Patent Owner filed a Motion to Exclude Evidence (Paper 54), Petitioner filed an Opposition to Patent Owner’s Motion to Exclude (Paper 58), and Patent Owner filed a Reply (Paper 59). Petitioner filed a Motion to Exclude Evidence (Paper 52), Patent Owner filed an Opposition to Petitioner’s Motion to Exclude (Paper 56), and Petitioner filed a Reply (Paper 60). Patent Owner also filed a Motion for Observation (Paper 53) (“Obs.”) on certain cross-examination testimony of Petitioner’s declarant, Dr. Robert Stone, and Petitioner filed a Response (Paper 57) (“Obs. Resp.”).

The Board has jurisdiction under 35 U.S.C. § 6(c). This final written decision is issued pursuant to 35 U.S.C. § 318(a) and 37 C.F.R. § 42.73.

For the reasons that follow, we determine that Petitioner has shown by a preponderance of the evidence that claims 1–16 of the ’186 patent are unpatentable.

A. *The ’186 Patent (Ex. 1001)*

The ’186 patent describes methods for collecting data relating to the health status of patients and communicating information to patients.

Ex. 1001, 4:8–17.

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<sup>2</sup> We cite to the Corrected Patent Owner’s Response, filed April 25, 2014, Paper 37.

*B. Illustrative Claim*

Claim 1 of the '186 patent is reproduced below:

1. An apparatus for interactively communicating with an individual regarding health related information, the apparatus comprising:

a first communication interface to communicate with a monitoring device, wherein said monitoring device is configured to (i) produce physiological information regarding said individual, and (ii) transmit said physiological information to said apparatus;

a second communication interface to (i) receive programming information from a server via a communication network, and (ii) transmit said physiological information from said apparatus to said server via said communication network, wherein said programming information comprises at least one of (a) a query, (b) a message corresponding to said individual from a health care professional associated with said individual, (c) a computer program customized using personal data relating to said individual, and (d) information specific to said individual;

a display for presenting one or more of said query, said message, and said information to said individual; and

a user interface for said individual to provide responses to said query, said message, or said information presented on said display;

wherein (i) said responses are transmitted to said server through said communication network, (ii) said server assigns said programming information to said individual based upon input from said health care professional associated with said individual, and (iii) said programming information is related to a health condition of the individual, (iv) said apparatus is remotely situated from said server, (v) said programming information is presented to said individual by executing said computer program on said apparatus and (vi) said computer program comprises a custom script program (a) designed specifically for said individual, (b) associated with said individual by a unique identification code, and (c) configured to control said monitoring device.

*C. Cited Prior Art*

The pending grounds of unpatentability in this *inter partes* review are based on the following prior art:

Wahlquist	US 5,367,667	Nov. 22, 1994	(Ex. 1003)
Goodman	US 5,827,180	Oct. 27, 1998	(Ex. 1005)
Lyons	US 5,623,656	Apr. 22, 1997	(Ex. 1006)

*D. Instituted Grounds of Unpatentability*

This *inter partes* review involves the following asserted grounds of unpatentability:

<b>References</b>	<b>Basis</b>	<b>Claims Challenged</b>
Goodman and Wahlquist	§103	1–6 and 8–15
Goodman, Wahlquist, and Lyons	§103	7 and 16

*E. Claim Interpretation*

The parties appear to agree with the interpretation of various claim terms of the '186 patent as described in the Decision on Institution. Patent Owner explains that Petitioner “filed a new petition seeking *inter partes* review of related U.S. Patent No. 7,587,469” in which Petitioner “advances a very different construction” for the term “script program.” PO Resp. 2. However, Petitioner does not advance a different construction for the term “script program” in this proceeding.

We adopt our previous analysis for the non-disputed claim terms, and interpret certain claim terms as follows:

Term	Interpretation
“communication interface”	any component through which two or more devices or systems may communicate
“script program”	a program that contains a set of instructions capable of being executed and interpreted
“monitoring device”	a device that monitors

See Dec. on Inst. 5–8.

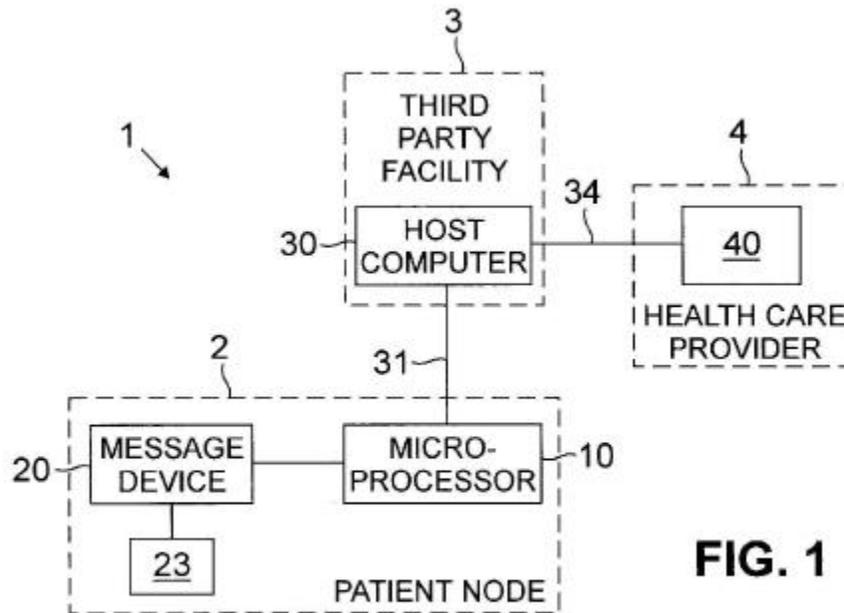
## II. ANALYSIS

### A. *Grounds Based at Least in Part on Goodman and Wahlquist*

For at least the foregoing reasons, we conclude that Petitioner has demonstrated that claims 1–6 and 8–15 are unpatentable over Goodman and Wahlquist, and that claims 7 and 16 are unpatentable over Goodman, Wahlquist, and Lyons, under 35 U.S.C. § 103(a).

#### 1. *Server*

Claim 1, for example, recites a “server.” Wahlquist discloses a help desk representative selecting diagnostic tests based on a user’s request. Ex. 1003, 2:8–10, 11; 2:17–18, 22–23. Goodman discloses a host computer in communication with a health care provider’s computer and a patient’s computer. Ex. 1005, 1:11–13, 2:45–49. Fig. 1 of Goodman is reproduced below.



**FIG. 1**

Fig. 1 of Goodman illustrates a personal health network in which a host computer is in communication with a patient computer and a health care provider computer.

Petitioner argues that Goodman discloses “server 30” (i.e., “host computer 30”). Pet. 42 (citing Ex. 1005, 5:5–8, 13–24); *see also* Ex. 1005, Fig. 1. Patent Owner argues that Goodman fails to disclose or suggest a “server” because Petitioner’s declarant “conceded that Goodman’s ‘communications port’ was not a server.” PO Resp. 39. However, Patent Owner does not refute sufficiently Petitioner’s contention that Goodman discloses or suggests host computer 30 or “server 30.” Nor does Patent Owner point out any differences believed to exist between host computer 30 disclosed by Goodman and the claimed “server.”

2. *First communication interface*

Claim 1, for example, recites a “first communication interface.” Petitioner argues that “Goodman discloses a first communication interface 71 to communicate with a monitoring device 70.” Pet. 41. Patent Owner relies on testimony of Dr. Yadin David<sup>3</sup> and argues that Goodman fails to disclose or suggest a “first communication interface” because “element 71 . . . is an ‘information input,’ . . . not a system component” and “fails to satisfy the Board’s construction for communication interface, which requires a ‘component.’” PO Resp. 40 (citing Ex. 2006 ¶ 146). However, neither Patent Owner nor Patent Owner’s declarant (Dr. Yadin David) demonstrates sufficiently how “element 71” of Goodman differs from a “component” through which devices communicate information, particular in view of the disclosure of Goodman that data is accepted at data processor 10 from device 70 via “information input 71” and that such signals are communicated “through the use of a custom interface” (or a “communication interface”). *See, e.g.*, Ex. 1005, 7:22–23, 34–35.

Patent Owner acknowledges that Goodman discloses a “custom interface” but argues that the custom interface of Goodman “is incorporated into the monitoring device 70.” PO Resp. 40 (citing Ex. 1005, 7:34–38, 42–44). Thus, Patent Owner argues that the “custom interface” of Goodman is not the same or suggestive of a “first communication interface,” as recited in claim 1, for example, because the “custom interface” of Goodman supposedly is “incorporated into the monitoring device 70.” Claim 1, for example, recites a first communication interface “to communicate with a monitoring device.” Goodman discloses that “the data processor 10 is

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<sup>3</sup> Declaration of Dr. Yadin David, Ed.D., dated April 1, 2014 (Ex. 2006).

adapted to accept information input . . . from a medical device 70” and that “a custom interface . . . translate[s] a signal of the medical device . . . into a . . . form acceptable to processor 10.” Ex. 1005, 7:22–23, 34–37. In other words, Goodman discloses an interface (i.e., a “first communication interface”) that receives signals from a device (i.e., communicates with a monitoring device), as recited in claim 1.

### 3. User interface

Claim 1, for example, recites a “user interface for said individual to provide responses to said query, said message, or said information”; that “programming information comprises at least one of” the query, the message, and the information specific to said individual; and a second communication interface for receiving the “programming information from a server via a communication network.” Petitioner argues that Goodman discloses these features. Pet. 42 (citing Ex. 1005, 4:46–52). Goodman discloses, for example, that a patient receives a “medication alarm” in which “the name of the medication and dose may be displayed,” and the “patient turns off the alert by activating a switch 22.” Ex. 1005, 4:46–52. Petitioner argues also that Goodman discloses “adding one or more switches 24” so that “patients *can respond to query-type messages.*” Pet. Reply 8 (citing Ex. 1005, 5:29–34).

Patent Owner argues that “activating the switch 22 [or, presumably, switch 24] is not a response to any query, message or information received over the second communication interface” and that “the alarm is not communicated over the second communication interface, as required by claim 1.” PO Resp. 41.

As Petitioner explains, however, Goodman discloses that patients respond “to query-type messages,” which Patent Owner does not demonstrate to differ from an individual providing responses to a query, as recited in claim 1, for example. Goodman also discloses that the “medication alarm” (i.e., “query”) is provided to the patient based on “[a] patient’s entire medication regimen, including dosing intervals [that] can be downloaded from the host computer 30 to the data processor 10 via communication line 31.” Ex. 1005, 4:39–43. Hence, Goodman discloses that information (e.g., query, medication regimen and dosing intervals, or the name of medication and dose) specific to the individual (e.g. the patient), at least, is received from a server (i.e., host computer 30), presented to the patient, and the patient responds to the information via a “user interface” (i.e., a switch). We do not observe, and Patent Owner does not point out, any substantial differences between the patient in Goodman responding to a medication alert, for example, by activating a switch in response to query-type messages and the claim feature of an individual providing a response to a query, message, or information.

*4. Said responses are transmitted to said server*

Claim 1, for example, recites “said responses are transmitted to said server.” Claim 9 recites a similar feature. Petitioner argues that Goodman discloses this feature. Pet. 42 (citing Ex. 1005, 4:46–52). Goodman discloses that a patient receives a “medication alarm” in which “the name of the medication and dose may be displayed,” and the “patient turns off the alert by activating a switch 22.” Ex. 1005, 4:46–52. Petitioner also argues that Goodman discloses “activation of the switch is stored as compliance

data and communicated to the host computer.” Pet. Reply 9 (citing Ex. 1005, 4:49–53, 63–65). Hence, Goodman discloses that responses (i.e., “compliance data”) are transmitted to the server (or host computer).

Patent Owner argues that Goodman fails to disclose or suggest “responses or other messages generated by the individual and sent to the host computer 30” or that “alarm de-activations are transmitted to the server through said communication network.” PO Resp. 41–42. As discussed above, claim 1 recites that “said responses are transmitted to said server.” Also as discussed above, Goodman discloses a patient’s response (e.g., “compliance data”) being transmitted to the server (e.g., “uploaded to the host computer,” Ex. 1005, 4:64–65) and that the compliance data result from the patient’s response (i.e., activating a switch). Patent Owner does not explain sufficiently a difference between transmitting a patient’s response (or compliance data) to a host computer of Goodman and the claim limitation of said responses being transmitted to the server.

Regarding claim 9, Patent Owner also argues that Petitioner “improperly relies on a combination with the pager embodiment of Goodman,” and that the pager embodiment “cannot be combined with the embodiment of Fig. 5 [of Goodman], which contains the ‘generating physiological information’ step of parent claim 9.” PO Resp. 57. Goodman discloses a “personal health network” (PHN) that contains a “patient node 2,” which may contain a “data processor 10” and a “message device 20.” Ex. 1005, 3:13–14, 51–52, 60–61; Fig. 1. Goodman also discloses that the “patient node 2” may further contain “a medical device 70.” Ex. 1005, 7:22–24; Fig. 5 (the so-called “embodiment of Fig. 5,” as referred to by Patent Owner). In the “pager embodiment” (as referred to by Patent

Owner), a “wireless carrier 60 functions as the data processor 10 and the paging device 61 performs the message functions of the message device 20.” Ex. 1005, 6:13–15. In other words, Goodman explicitly discloses combining the so-called “pager embodiment” with the so-called “embodiment of Fig. 5” in which the “wireless carrier 60” and “paging device 61” (of the so-called “pager embodiment”) function as “the data processor 10” and “the message device 20,” respectively, of the so-called “embodiment of Fig. 5.”

Given that Goodman explicitly discloses one embodiment that includes a combination of the alleged components of both the so-called “pager embodiment” and the so-called “embodiment of Fig. 5,” we are not persuaded by Patent Owner’s argument that the two alleged embodiments “cannot be combined.”

5. Said server assigns said programming information to said individual

Claim 1, for example, recites “said server assigns said programming information to said individual.” Claim 9 recites a similar feature. Petitioner argues that Goodman discloses this feature. Pet. 43 (citing Ex. 1005, 5:13–24). Goodman discloses “the PHN 1” or “host computer 30” (i.e., a server) receiving a patient’s “medication regimen and other information from each primary health care provider” and “information from other health care facilities” and downloading the information “to the data processor . . . and the message device.” Ex. 1005, 5:13–24. Petitioner also argues that one of ordinary skill in the art would have understood that a “customized message appearing on the remote apparatus [of Goodman] is enough to show that the server assigned the programming information,” citing the testimony of Dr.

David. Pet. Reply 10 (citing Ex. 1041, 112:14–19; 483:16–25; 485:20–486:2).

Patent Owner argues that Goodman “says nothing about how those messages are assigned to the individual” and that the information received by the host computer of Goodman is “already specific to the patient.” PO Resp. 43; *see also* PO Resp. 55. However, Patent Owner’s argument is undermined by Patent Owner’s declarant’s (Dr. Yadin David) testimony that one of ordinary skill in the art would have understood that the host computer necessarily assigns programming information to an individual when a remote apparatus provides a customized message to the individual.

Q. How did -- how did that information indicate that to you?

A. When the apparatus is coming up with a message that is customized to the patient and says, “Mrs. Jones, did you take your blood pressure today,” and she’s responding by pushing a button, yes.

Q. So when you see that happening at the remote Health Buddy device, does that necessarily mean that a server assigns said programming information to said individual, as described there in part 2 of the wherein clause?

A. Yes.

Ex. 1041, 112:7–19.

Goodman discloses, for example, a “medication alarm” and “the name of the medication and dose” of a patient displayed on a remote device and based on a “patient’s entire medication regimen, including dosing intervals” that is “downloaded from the host computer 30” to the remote device. Ex. 1005, 4:39–45. In other words, Goodman discloses a remote device

displaying a message to a patient, the message being customized to the patient (i.e., displaying medication and dosages specific to the patient). Hence, as Petitioner demonstrates, and as Patent Owner's declarant avers, one of ordinary skill in the art would have understood that the host computer of Goodman (i.e., a "server") necessarily would have assigned programming information to the individual (or patient).

6. Said programming information is presented to said individual

Claim 1, for example, recites "said programming information is presented to said individual by executing said computer program on said apparatus." Claim 9 recites a similar feature. Petitioner argues that Goodman discloses this feature. Pet. 43 (citing Ex. 1005, 6:28–35); Pet. Reply 10–11 (citing Ex. 1005, 2:54–61, 8:38–46, 8:65–9:28; Figs. 10a–10b). Patent Owner argues that Petitioner fails to demonstrate "that any computer program is received over the second communication interface from a server, as required by claim 1" or that "the computer program which presents messages to the individual is received from a server." PO Resp. 44–45. We are not persuaded by Patent Owner's arguments.

Goodman discloses a server (or host computer) that develops "algorithms" based on the treatment plan that the server receives and programs the algorithms into a (remote) message device associated with a specific patient and that "[t]he patient is prompted by the message device to measure and enter relevant physiological data." See e.g., Ex. 1005, 2:56–61. In other words, Goodman discloses that "algorithms" (or a computer program) are received from a server (i.e., host computer programs the algorithms into a message device) and executed on the message device (i.e.,

executing a computer program on the apparatus) with the resultant display of programming information (e.g., message for prompting to measure data) to an individual (e.g., a patient) at the remote device (i.e., apparatus).

With respect to claim 9, Patent Owner also argues that Petitioner relies on “the ‘pager’ embodiment [that] cannot be combined with the embodiment of Fig. 5, which allegedly contains the required ‘generating physiological information’ step of parent claim 9.” PO Resp. 58. We are not persuaded by Patent Owner’s arguments for at least the reasons previously discussed.

*7. Said computer program comprises a custom script program*

Claim 1, for example, recites “said computer program comprises a custom script program.” Claim 9 recites a similar feature. Petitioner argues that Goodman and Wahlquist disclose this feature. Pet. 43 (citing Ex. 1005, 8:38–46; Ex. 1003, 2:10–15, 17–31, 42–49); Pet. Reply 11–12.

Patent Owner argues that Wahlquist fails to disclose or suggest a script program because, according to Patent Owner, Wahlquist fails to disclose that its “script file” “is ‘executed and interpreted’ as required by the Board’s construction.” PO Resp. 47 (citing Ex. 2006 ¶¶ 163–164, 168). However, a “script file” is construed broadly but reasonably to include a program that contains a set of instructions capable of being executed and interpreted. Dec. on Inst. 7. Wahlquist discloses that the “various diagnostic tests” are “to be run on the user’s computer.” Ex. 1003, 2:18–19. Patent Owner does not explain adequately how a program that is “to be run” on a computer is incapable of being “executed,” for example, on the computer. We are persuaded by Petitioner’s arguments, supported by the

testimony of Dr. Stone (Ex. 1007), that one of ordinary skill in the art would have understood that a program that is capable of being “run” on a computer would be executed and interpreted on the computer, as Wahlquist explicitly discloses.

Likewise, Goodman discloses that the “algorithm” processes input and delivers results from the processing to the patient as a message. *See e.g.*, Ex. 1005, 8:49–51. One of ordinary skill in the art would have understood the “algorithm” of Goodman to be capable of being executed and interpreted because Goodman explicitly discloses the processing of data with the “algorithm.” One of ordinary skill in the art would have understood that if the “algorithm” of Goodman was incapable of being executed and interpreted, the “algorithm” would be unable to process data (not being able to execute in the first place). This is in contrast to Goodman’s explicit disclosure of processing data with the algorithm.

Also, Patent Owner argues that Wahlquist fails to disclose “custom script files” because the scripts of Wahlquist “are not even directed at human patients, so the diagnostic tests contain no personal data.” PO Resp. 47–48. In particular, Patent Owner acknowledges that Wahlquist discloses that “personal data . . . is placed in a ‘case file’” but argues that the “case file” of Wahlquist “is separate from the ‘script file’ mentioned in Wahlquist.” *Id.* at 48 (citing Ex. 1003, 2:10–15). In other words, Patent Owner argues that Wahlquist fails to disclose or suggest a custom “script file” that contains “personal data.” We note that claim 1 does not require that the custom script program *contains* “personal data.” Rather, claim 1 recites “said computer program comprises a custom script program” and that the computer program is “customized *using* personal data relating to said individual.”

Also, Patent Owner does not appear to contest that Goodman discloses or suggests a computer program that contains “data relating to said individual.” We note that Goodman discloses “algorithms . . . are developed based on a treatment plan or guidelines for a specific patient” and a “customized patient management program” that contains data relating to a patient (or an individual). Ex. 1005, 8:38–41; 9:1–3, 21–22. Patent Owner does not explain sufficiently how Goodman differs from the claim recitation of “said computer program comprises a custom script program” or that the computer program is “customized using personal data relating to said individual.”

8. Individual’s response to the query (claim 2)

Claim 2 recites that the query is related to the health condition of the individual and the response comprises an answer to the query provided by the individual. Petitioner argues that Goodman discloses this feature. Pet. 44 (citing Ex. 1005, 6:1–13). Patent Owner argues that Goodman discloses “an acknowledgement of delivery of a message” but does not disclose or suggest “an answer to a query.” PO Resp. 49. As Petitioner explains, Goodman discloses “messaging capabilities” where a “[w]ireless carrier 60 . . . receives instructions . . . to deliver . . . messages to specific patients . . . at predetermined times” by telephoning “the patient’s pager 61” where the wireless carrier 60 “functions as the data processor 10” and the “paging device 61 performs the messaging functions of the message device 20.” Ex. 1005, 5:67; 6:1–4, 13–15.

Goodman further discloses that “data processor 10” (with “message device 20,” which functions with paging device 61 ) incorporates “two-way

message capability” in which “patients can respond to query-type messages.” *Id.* at 5:29–56. One of ordinary skill in the art would have understood that wireless carrier 60 of Goodman performs the functions of data processor 10 because, at least, Goodman explicitly discloses that the wireless carrier 60 “functions as the data processor 10.” *Id.* at 6:13–15. We agree with Petitioner that Goodman discloses both a query and that an individual’s response contains an answer to the query because Goodman explicitly discloses that patients (or individuals) can respond (i.e., provide a response) to query-type messages (i.e., the response to the “query-type message” contains an “answer”). Patent Owner does not provide an adequate showing of a difference between Goodman’s disclosure and the claim limitations of claim 2.

Patent Owner also argues that Goodman discloses a “‘pager’ alternate embodiment [the so-called ‘pager embodiment’]” that involves a response to a query but that “the ‘medical device’ alternate embodiment of Goodman [i.e., the so-called “embodiment of Fig. 5]” fails to disclose or suggest this limitation. PO Resp. 49–50. Patent Owner also argues that Petitioner “provides no explanation of how these two different embodiments [of Goodman] could or would have been combined.” *Id.* at 50. In other words, Patent Owner argues that the so-called “pager embodiment” cannot be combined with the “embodiment of Fig. 5.” We are not persuaded by Patent Owner’s arguments for at least the reasons previously discussed.

9. *Patient’s response comprises an acknowledgement (claims 3–4, 11–12)*

Claim 3 recites that the response comprises an acknowledgement provided by the individual. Claims 4, 11, and 12 recite similar features.

Petitioner argues that Goodman discloses these features. Pet. 44 (citing Ex. 1005, 15:8–12). Patent Owner argues that Petitioner “improperly relies on a combination with the ‘pager’ alternate embodiment of Goodman” and that “this embodiment cannot be combined with the embodiment of Fig. 5, which allegedly contains the required monitoring device of parent claim 1.” PO Resp. 50–51. We are not persuaded by Patent Owner’s arguments for at least the reasons previously discussed.

*10. Communication network (claim 5)*

Claim 5 recites that the communication network comprises a wired network, cable network, wireless network, cellular network, telephone network, satellite network, or television network. Petitioner argues that Goodman discloses this feature. Pet. 44 (citing Ex. 1005, Fig. 4a, 6:1–7). Patent Owner argues that Petitioner “relies on the ‘pager’ alternate embodiment” and that “this embodiment cannot be combined with the embodiment of Fig. 5.” PO Resp. 51. We are not persuaded by Patent Owner’s arguments for at least the reasons previously discussed.

*11. Programming information provided by healthcare professional (claims 6, 14)*

Claim 6 recites that programming information is from the server and provided by the health care professional via a computer in communication with the server. Claim 14 recites a similar feature. Petitioner argues that Goodman discloses this feature. Pet. 49 (citing Ex. 1005, Figs. 3, 6, 4:63–67, 5:1–4). Patent Owner argues that “the communications port 50 cannot be ‘said server’ as required by claim 6.” PO Resp. 52. As previously discussed, Petitioner asserts that “host computer 30” is the claimed “server.”

Therefore, we are not persuaded by Patent Owner's arguments with respect to "communications port 50."

Patent Owner also argues that Petitioner "improperly relies on a combination with the 'pager' alternate embodiment of Goodman" that "cannot be combined with the 'medical device' alternate embodiment of Fig. 5 [i.e., the so-called "embodiment of Fig. 5"]." PO Resp. 52–53. We are not persuaded by Patent Owner's arguments for at least the reasons previously discussed.

*12. Apparatus comprises a handheld device (claim 8)*

Claim 8 recites that the apparatus comprises a handheld device. Petitioner argues that Goodman discloses this feature. Pet. 45 (citing Ex. 1005, 4:23–25). Patent Owner argues that Goodman fails to disclose or suggest that "the entire 'apparatus' [as opposed to the message device alone] . . . is portable, let alone handheld." PO Resp. 53.

We credit Petitioner's declarant's (Dr. Robert Stone) testimony that "Goodman discloses a portable device sufficiently compact to comprise a handheld device." Ex. 1007 ¶ 108 (citing Ex. 1005, 4:23–25). Goodman discloses that the "message device . . . is a portable device, of suitable shape and size to be carried in the pocket, purse or briefcase of a patient." Ex. 1005, 4:23–25. Hence, Goodman explicitly discloses that the device is intended to be carried in the pocket, purse, or briefcase, and that the message device is portable. We are persuaded that it would have been obvious to one of ordinary skill in the art that the components associated with the message device (e.g., communication interfaces) would also be portable. If other components were not portable, then the device would not be able to be

“carried in the pocket, purse or briefcase of a patient.” Rather, if only the message device was portable and other components necessary for operation were not portable, then the device would either be non-functional (as missing other components necessary for operation) or the patient would be unable to carry the device in a pocket, purse, or briefcase (as the apparatus would not be portable). This would be contrary to the explicit disclosure of Goodman.

In any event, a known, non-portable, device or apparatus is not patentable merely by making the known, non-portable device portable in the absence of an unexpected result. *In re Lindberg*, 194 F.2d 732, 872 (C.C.P.A. 1952) (“it is not regarded as inventive to merely make an old device portable . . . without producing any new and unexpected result”). Patent Owner does not point out any unexpected results in making the Goodman device portable, even if the communication interfaces of the Goodman device were, in fact, non-portable.

*13. Generating programming information on the server (claim 9)*

Claim 9 recites generating programming information on the server. Petitioner argues that Goodman discloses this feature. Pet. 46 (citing Ex. 1005, 5:5–8, 13–14). Patent Owner argues that Goodman discloses generating programming information “at the health care provider 4 or the healthcare facility 5, which are not servers.” *See, e.g.*, PO Resp. 54–55.

As previously discussed in the Decision on Institution, Goodman discloses that the message device “is adapted . . . to receive data from . . . the data processor,” and the host computer develops algorithms (based on treatment plans) which are programmed into “an appropriately configured

message device.” Dec. on Inst. 12–13 (citing Ex. 1005, 2:49–50, 54–58). In other words, Goodman discloses that programming information (e.g., algorithms) is generated (or developed) at the host computer (i.e., the “server”). We are not persuaded by Patent Owner that Goodman fails to disclose or suggest this feature.

*14. Storing responses in a database in communication with the server*  
*(claim 9)*

Claim 9 recites storing the responses in a database where the database is in communication with the server. Petitioner argues that Goodman discloses this feature and that a “database” is an “electronically-stored collection of data.” Pet. 47 (citing Ex. 1005, 5:13–24, 11:58–61); Pet. Reply 9 (citing Ex. 1005, 4:49–55; Ex. 1041, 607:2–19). In particular, Petitioner argues that Goodman discloses that “message unit 20 stores a record of the so-called compliance data.” Pet. Reply 9. Patent Owner argues that Goodman fails to disclose or suggest “a database at all, much less anything about responses from the individual or that these responses are stored in a database.” PO Resp. 55. Patent Owner also acknowledges that Goodman discloses a database but that the “database [of Goodman] does not store ‘said responses,’ as required by claim 9.” PO Resp. 56 (citing Ex. 1005, 11:58–61).

Goodman discloses that the “message unit . . . stores a record of the so-called compliance data” and that “the compliance data can be uploaded to the host computer 30.” Ex. 1005, 4:52–53, 64–65. We agree with Petitioner’s construction of the term “database” to mean “an electronically-stored collection of data.” See Ex. 1042, 123 (textbook definition of the ordinary meaning of “database”). The message unit of Goodman “stores”

compliance data (and the compliance data is stored in electronic form), as Goodman discloses. Therefore, we agree with Petitioner that Goodman's disclosure of storing responses (i.e., "compliance data") in electronic form would result in "an electronically-stored collection of data" or a "database." Also, the "database" would be in communication with a server (i.e., compliance data can be uploaded to the host computer, or "server," and therefore the electronically-stored collection of data is "in communication" with the server).

*15. Claims 10–16*

Patent Owner does not provide further arguments regarding claims 10–16. PO Resp. 58–59. Petitioner has provided a sufficient showing of unpatentability of claims 10–16. Pet. 40–41, 48–50; *see also* Pet. 34–36.

*16. Claim 11*

Petitioner has demonstrated persuasively that claim 11 is unpatentable over Goodman and Wahlquist. *See, e.g.*, Pet. 40, 48–49. Patent Owner argues that Petitioner "improperly relies on a combination with the alternate pager embodiment of Goodman" and that "this embodiment cannot be combined with the medical device embodiment of Fig. 5 [i.e., the so-called "embodiment of Fig. 5"], which allegedly contains the required 'generating physiological information' step of parent claim 9." PO Resp. 59. We are not persuaded by Patent Owner's arguments for at least the reasons previously discussed.

*B. Analogous Art – Wahlquist*

Patent Owner argues that “Wahlquist is not analogous to the invention of the ’186 patent.” PO Resp. 33. A reference is analogous art to the claimed invention if: (1) the reference is from the same field of endeavor as the claimed invention (even if it addresses a different problem); or (2) the reference is reasonably pertinent to the problem faced by the inventor (even if it is not in the same field of endeavor as the claimed invention). *In re Bigio*, 381 F.3d 1320, 1325 (Fed. Cir. 2004). “A reference is reasonably pertinent if . . . it is one which, because of the matter with which it deals, logically would have commended itself to an inventor’s attention in considering his problem.” *Innovation Toys, LLC v. MGA Entm’t, Inc.*, 637 F.3d 1314, 1321 (Fed. Cir. 2011).

Patent Owner argues that the field of endeavor of the claimed invention “must be identified with reference to ‘the claimed invention’” and argues that the “field of endeavor” is “using customized script programs to facilitate communications with individual patients regarding health issues” and “communicating with an individual using an apparatus, by executing a customized script program received at the apparatus” that “monitors, communicates with, and gathers information *about a patient*.” PO Resp. 26–28.

“When a work is available in one field [of endeavor], design incentives and other market forces can prompt variations of it, either in the same field or” a different one. *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 402 (2007). Hence, although we do not agree with Patent Owner’s contention that a reference is only analogous to a “claimed invention” (for claim obviousness purposes) if the reference discloses specific recited claim

terms, we need not consider the propriety of Patent Owner's suggested "field of endeavor" because Wahlquist is reasonably pertinent to the problem faced by the inventor of the '186 patent. Claim 1 recites a script program that is "designed specifically for said individual," and "associated with said individual by a unique identification code." In other words, a problem faced by the inventor was how to associate a script program with a specific entity, such that the appropriate program would be executed for a corresponding user.

Wahlquist discloses a system in which a user "calls the help desk" for the creation of "a computerized case file" associated with "a unique case identification number [and] the user's identification." Ex. 1003, 4:36, 42, 45–46. Based on this information, the selection of "specific diagnostic tests" is performed. *Id.* at 4:58–60. In other words, Wahlquist discloses a solution to the problem faced by the inventor of how to associate a program with a specific entity by disclosing associating a program with a specific entity by associating "a unique case identification number" or a "user's identification" with the specific entity, then executing the program so identified (e.g., via reference to a "user's identification") at the user's device. Wahlquist, thus, deals with the matter of associating a program with a particular entity, and logically would have commended itself to an inventor considering the problem of how to associate a program with a particular entity. As such, Wahlquist is reasonably pertinent to the claimed invention.

Patent Owner argues that Wahlquist "is not pertinent to any problem addressed by the '186 patent, which have nothing to do with computer diagnostics" and that Wahlquist "has nothing to do with the patient monitoring problems that Stephen Brown was trying to solve in the '186

Patent.” PO Resp. 30, 32 (citing Ex. 2006 ¶ 111). We disagree with Patent Owner’s contention that Wahlquist is not pertinent to *any* problem addressed by the ’186 patent. As discussed above, Wahlquist discloses a solution to the problem faced by the inventor of how to associate a program with a specific entity and, therefore, logically would have commended itself to the attention of an inventor faced with that problem.

Patent Owner argues that “[a] person of ordinary skill in the art . . . trying to solve the problem of designing an interactive patient monitoring device would not look to the remote computer diagnostics system of Wahlquist.” PO Resp. 31. Patent Owner does not explain sufficiently why a person of ordinary skill in the art trying to solve the problem of how to associate a program with a specific entity would find that Wahlquist is not pertinent to the problem when Wahlquist, in fact, offers a solution to the problem (e.g., use an identifier).

Patent Owner argues that Wahlquist “is in the field of computer diagnostics, a different field of endeavor from the patient monitoring field of the claimed invention.” PO Resp. 32. First, claim 1 recites an apparatus that receives “programming information” that includes “a computer program.” Claim 1 therefore recites a computer. Hence, both Wahlquist and the claimed invention use computer programs, and are not as different as Patent Owner suggests. Second, whether Wahlquist is in the same (or different) field of endeavor as the ’186 patent is immaterial to the question of whether Wahlquist is pertinent to a problem faced by the inventor.

Patent Owner further argues that one of ordinary skill in the art “would not be motivated to incorporate [Wahlquist] into a remote patient monitoring system.” PO Resp. 32–33 (citing Ex. 1041, 115). Even

assuming that the '186 patent is directed to “a remote patient monitoring system,” as Patent Owner implies, as previously discussed, Wahlquist is reasonably pertinent to the problem faced by the inventor. Also, for purposes of determining whether Wahlquist is analogous art, we do not see the relevance of whether one of ordinary skill in the art would have been motivated (or not) to combine Wahlquist with the '186 patent, as opposed to the other prior art references at issue.

*C. Combinability – Goodman and Wahlquist*

Patent Owner argues that it would not have been obvious to one of ordinary skill in the art to have combined the teachings of Goodman and Wahlquist. *See, e.g.*, PO Resp. 33–38. Patent Owner argues that it would not have been obvious to one of ordinary skill in the art to have combined “Wahlquist’s script file, which eliminates communication with the user, with Goodman’s patient health network, which seeks to increase communications with the patients” because, according to Patent Owner, such a combination would result in a system that “communicate[s] directly with a patient’s messaging device, without communication . . . by the user that Goodman’s system is intended to serve.” *Id.* at 35. Patent Owner also argues that “Wahlquist teaches directly away from increasing communications with a person.” *Id.* at 36.

Patent Owner does not demonstrate persuasively that “Wahlquist’s system is a computer diagnosis system in which a help desk representative seeks to eliminate communications with a user.” *Id.* at 34 (citing Ex. 1003, 3:14–20; Ex. 2006 ¶¶ 122–123). Rather, Wahlquist discloses a system and method in which “a user calls the customer service help desk” who “is then

asked to identify the general nature of the problem.” Ex. 1003, 2:7–16. The representative then “instructs the user” as to what actions to take. *Id.* at 2:6–7, 15–16, 26. One of ordinary skill in the art would have understood that a user calling a help desk and identifying a problem to the representative, as well as the representative instructing the user, would have constituted “communication” between the user and the representative. The system of Wahlquist depends on “communications with a user” because without such “communication,” the representative would not be apprised of the user’s issues and would be unable to instruct the user as to the proper action to take.

In addition, in Wahlquist, an application “created by the representative” “establishes communications with the user’s system” and “downloads the case and script files to the user’s computer.” Ex. 1003, 2:32, 36–40. One of ordinary skill in the art would have understood that establishing a “communication” with a user’s system and downloading script files to the user’s computer via the “communication” would have constituted a “communication” between devices. While Patent Owner argues that Wahlquist “eliminates communication with the user,” Patent Owner does not explain sufficiently how such a system that relies on “communication” actually “eliminates communication with the user.” PO Resp. 35.

Patent Owner also argues that it would not have been obvious to one of ordinary skill in the art to have combined the teachings of Goodman with Wahlquist because “the Goodman system is a complete system . . . [that does not need] to be modified or extended” and “Wahlquist contains no teachings that its system should be combined with other references.” PO Resp. 36. As previously discussed in the Decision on Institution,

the combination of the known system of Goodman and the known system of Wahlquist would have entailed [no] more than a combination of known systems to perform their known functions to achieve a predictable result. . . . “The combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.”

Dec. on Inst. 13 (quoting *KSR*, 550 U.S. at 416). Patent Owner does not demonstrate persuasively that the combination of Goodman and Wahlquist would have entailed any more than combining familiar elements to achieve a predictable result. Therefore, we are not persuaded by Patent Owner’s argument.

Patent Owner argues that it would not have been obvious to one of ordinary skill in the art to have combined “the supposed teachings from multiple different and distinct embodiments of Goodman.” PO Resp. 37. In particular, Patent Owner argues that “the ‘medical device’ alternate embodiment (of Fig. 5) [i.e., the so-called “embodiment of Fig. 5”] is incompatible with the ‘pager’ alternate embodiment (of Fig. 4) [of Goodman]”; “the medical device 70 cannot be coupled to the wireless provider 61 as would be required”; and the “pager embodiment” “was never intended to be combined with Goodman’s ‘medical device’ embodiment [i.e., the so-called “embodiment of Fig. 5”].” PO Resp. 37–38.

As previously discussed above, Goodman discloses an embodiment that encompasses both the so-called “embodiment of Fig. 5” and the so-called “pager embodiment” in which “patient node 2” contains “data processor 10,” “message device 20,” and “medical device 70” (the so-called “embodiment of Fig. 5”) where “wireless carrier 60 functions as the data processor 10 and the paging device 61 performs the message functions of the

message device 20.” Ex. 1005, 1:13–14, 51–52, 60–61; 6:13–15; Fig. 1. In view of Goodman’s explicit disclosure of such a combination, we are not persuaded by Patent Owner that the combination “was never intended” or that the combination includes “incompatible” components.

Finally, Patent Owner argues that Petitioner’s declarant (Dr. Robert Stone) performed an obviousness analysis improperly by “us[ing] the claims of the Bosch patents as a template to try and fit combinations of references into the claims” and “improperly used the teachings of the Bosch specifications to identify the goals and motivations for combining the prior art.” PO Resp. 18 (citing Ex. 2061, 314:5–20; 256:25–257:11; 313:1–20). Hence, Patent Owner argues that Dr. Stone’s analysis is based improperly on hindsight reasoning. However, “[a]ny judgment on obviousness is in a sense necessarily a reconstruction based on hindsight reasoning, but so long as it takes into account only knowledge which was within the level of ordinary skill in the art at the time the claimed invention was made and does not include knowledge gleaned only from applicant’s disclosure, such a reconstruction is proper.” *In re McLaughlin*, 443 F.2d 1392, 1395 (CCPA 1971).

Patent Owner does not indicate how Dr. Stone’s analysis relies on knowledge that was beyond the level of ordinary skill in the art at the time the claimed invention was made. For example, Dr. Stone relies on Goodman’s disclosure of “a personal health network comprising a host computer which is in communication with one or more patient nodes over a communication link” and on Wahlquist’s disclosure of “an application on the help desk computer that is used to select” tests for a user’s computer. Ex. 1007 ¶ 121. We do not see, and Patent Owner does not assert or

demonstrate persuasively, how either of these disclosures (neither of which was gleaned only from the '186 patent specification) would have been beyond the level of ordinary skill in the art.

In conclusion, we are persuaded that Goodman and Wahlquist teach all of the limitations of claims 1–6 and 8–15, and that a person of ordinary skill in the art would have had reason to combine the teachings of the references. Further, with respect to claims 7 and 16, we are persuaded by Petitioner's analysis regarding the combination of Goodman, Wahlquist, and Lyons, which Patent Owner does not challenge separately in its Patent Owner Response. *See* Pet. 30–31, 36; PO Resp. 8 n.1.

#### *D. Secondary Considerations*

As part of our obviousness analysis, we consider the evidence and arguments submitted by Patent Owner regarding secondary considerations of nonobviousness. *See Graham v. John Deere Co.*, 383 U.S. 1, 17–18 (1966). In particular, Patent Owner argues that commercial success, long-felt need, industry praise, teaching away by others, and copying demonstrate that the challenged claims would not have been obvious to a person of ordinary skill in the art.<sup>4</sup> PO Resp. 19–23. In support of its assertions, Patent Owner cites the testimony of Dr. David. *Id.* (citing Ex. 2006 ¶¶ 63–96).

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<sup>4</sup> The parties refer to the challenged claims collectively in their arguments regarding secondary considerations, and we do the same. *See* PO Resp. 19–23; Reply 4–6.

*1. Commercial Success*

Patent Owner argues that the “Health Buddy” remote health monitoring system, released in 1999 by Health Hero (Patent Owner’s predecessor company), was commercially successful. PO Resp. 20–21. According to Patent Owner, the device was used in a successful pilot program with the U.S. Department of Veterans Affairs (“VA”), and afterwards Health Hero “sold many tens of thousands of Health Buddy devices.” *Id.*

Evidence of commercial success, however, “is only significant if there is a nexus between the claimed invention and the commercial success.” *Ormco Corp. v. Align Tech., Inc.*, 463 F.3d 1299, 1311–12 (Fed. Cir. 2006). To establish a proper nexus between a claimed invention and the commercial success of a product, a patent owner must offer “proof that the sales [of the allegedly successful product] were a direct result of the unique characteristics of the claimed invention—as opposed to other economic and commercial factors unrelated to the quality of the patented subject matter.” *In re Huang*, 100 F.3d 135, 140 (Fed. Cir. 1996). In addition, “if the commercial success is due to an unclaimed feature of the device,” or “if the feature that creates the commercial success was known in the prior art, the success is not pertinent.” *Ormco*, 463 F.3d at 1312; *see also In re Kao*, 639 F.3d 1057, 1070 (Fed. Cir. 2011) (requiring a determination of “whether the commercial success of the embodying product resulted from the merits of the claimed invention as opposed to the prior art or other extrinsic factors”). If a patent owner is able to show a sufficient nexus, “the burden shifts to the challenger to prove that the commercial success is instead due to other factors extraneous to the patented invention, such as advertising or superior

workmanship.” *J.T. Eaton & Co., Inc. v. Atlantic Paste & Glue Co.*, 106 F.3d 1563, 1571 (Fed. Cir. 1997).

Patent Owner has not established a sufficient nexus between the claimed apparatus or method and the alleged commercial success of the Health Buddy. Patent Owner argues that the success of the Health Buddy was “directly attributable to the invention of the ’186 Patent.” PO Resp. 21 (citing Ex. 2006 ¶¶ 68, 70, 75–76, 86, 89, 93–94). Patent Owner and Dr. David, however, do not provide any analysis of how the Health Buddy allegedly embodied the challenged claims, or explain in any detail why it was the unique characteristics of the *claimed* apparatus or method that drove sales. Instead, Dr. David testifies that media coverage emphasized “the simplicity of the product and the fact that it provided a simple set of questions that could be changed by a health care provider to take into account the needs of a particular patient through the ‘Care Composer’ feature,” as well as “the ability of health care providers to quickly distinguish between patients that were within prescribed guidelines and patients that were not . . . through the Health Buddy’s ‘Care Director’ features.” Ex. 2006 ¶ 75. According to Dr. David, the latter ability is the “scriptable communication feature claimed by the ’186 Patent.” *Id.*

Claim 9 of the ’186 patent, for example, recites “generating physiological information . . . and transmitting said physiological information to an apparatus,” “transmitting said physiological information from said apparatus to a server,” “generating programming information on said server,” “transmitting said programming information from said server to said apparatus over a communication network,” “receiving responses to said query, said message, or said information,” and “storing said responses in a

database.” Patent Owner does not point to evidence in the record showing that the Health Buddy performed these steps. Dr. David simply states that he reviewed various materials and spoke with Patent Owner’s personnel, and “understand[s]” that the Health Buddy “practiced each of the challenged claims.” Ex. 2006 ¶ 60. Dr. David does not provide any analysis to support that conclusion, and acknowledged during his deposition that his conversations with Patent Owner’s personnel did not involve any discussion of the challenged claims. *See* Ex. 1041, 244:16–246:3.

Further, Dr. David testifies that “after using the Health Buddy [at the VA], inpatient admissions[,] . . . ER visits[,] . . . and hospital bed days for patients were reduced.” Ex. 2006 ¶ 68 (citing Ex. 2054). Neither Patent Owner nor Dr. David asserts or demonstrates sufficiently, however, that any reduced inpatient admissions, ER visits, or hospital bed days were the impetus for the alleged “commercial success” or sales. In addition, claim 1, for example, recites an apparatus that comprises a first and second communication interface, a display, and a user interface. Patent Owner does not demonstrate sufficiently that the apparatus of claim 1 results in reductions in any of inpatient admissions, ER visits, or hospital bed days for patients. Hence, even assuming that the alleged reduction of inpatient admissions, ER visits, and/or hospital bed days in some way caused the alleged “commercial success,” Patent Owner and Dr. David still do not demonstrate adequately a nexus between the *claimed* apparatus or method and the alleged commercial success.

Dr. David cites the “VA study” as allegedly indicating that the Health Buddy system “was capable of ‘targeted education around disease(s), providing positive reinforcement for appropriate understanding of the

disease(s), and compliance to recommended regimens.” Ex. 2006 ¶ 70 (citing Ex. 2054, 267). Dr. David merely testifies as to alleged capabilities of the Health Buddy system, but does not demonstrate sufficiently that any of the alleged capabilities resulted in (or had a nexus to) the alleged commercial success. In any event, Patent Owner does not demonstrate sufficiently that the apparatus of claim 1 results in any of “targeted education,” “positive reinforcement,” or “compliance to recommended regimens.”

To the extent Dr. David identifies a general “scriptable communication feature” allegedly recited in the claims, he does not identify particular claim language corresponding to that feature or explain how general discussions of patient monitoring equate with any particular limitation(s) of the claims. *See* Ex. 2006 ¶ 75 (citing Ex. 2020, which states that “Care Composer allows the service’s users to design or modify protocols and assists them in defining patient health status data and designing disease-specific messages” and “Care Director allows authorized medical staff to view . . . information on groups of patients through graphic reports and detailed data displays”); *see also* Ex. 2006 ¶ 76 (citing Exs. 2021–2024, which describe a tool for “providing an online infrastructure through which providers can communicate daily with senior patients,” a system “to help patients manage chronic illness more effectively,” an “item” that helps “to keep patient, and hospital aware of possible problems,” and a system that “will enable medical professionals to effectively track and support patients,” respectively).

Any commercial success of the Health Buddy is only relevant if the Health Buddy actually was the claimed apparatus, or actually was used to

practice the methods, recited in the challenged claims. Patent Owner has not provided sufficient evidence to show that was the case. *See In re DBC*, 545 F.3d 1373, 1384 (Fed. Cir. 2008) (finding no nexus absent evidence that “the driving force behind [the allegedly successful product’s sales] was the *claimed* combination”) (emphasis added); *Ormco*, 463 F.3d at 1311–12 (requiring a “nexus between the *claimed* invention and the commercial success”) (emphasis added); *Huang*, 100 F.3d at 140 (requiring proof that sales were a “direct result of the unique characteristics of the *claimed* invention”) (emphasis added). Patent Owner has not provided sufficient evidence to show that was the case. Accordingly, the alleged commercial success of the Health Buddy does not support a conclusion of nonobviousness of the claims.

## 2. Long-Felt Need

Patent Owner argues that there was a “long-felt need in the industry for remote patient monitoring systems such as the Health Buddy,” and that the Health Buddy improved on existing systems in various ways. PO Resp. 21–22. To support a conclusion of nonobviousness, an alleged long-felt need must have been a persistent one that was recognized by those of ordinary skill in the art, must not have been satisfied by another before the challenged patent, and must have been satisfied by the claimed invention. *See Perfect Web Techs., Inc. v. InfoUSA, Inc.*, 587 F.3d 1324, 1332–33 (Fed. Cir. 2009); *Newell Cos. v. Kenney Mfg. Co.*, 864 F.2d 757, 768 (Fed. Cir. 1988). Patent Owner does not explain sufficiently why there was a long-felt need to solve a particular problem that others recognized but were unable to meet. As Patent Owner acknowledges, other remote patient monitoring

systems existed prior to the Health Buddy. PO Resp. 21–22. Even assuming that the Health Buddy represented an improvement over those systems, that does not mean automatically that there was a recognized long-felt, but unmet, need in the art. Further, the evidence cited by Patent Owner and Dr. David pertains only to the Health Buddy itself and does not show recognition of a particular need *prior to* the Health Buddy. *See id.* (citing Exs. 2026, 2027, 2036); Ex. 2006 ¶¶ 78–80, 90–91 (citing Exs. 2026, 2027, 2036); *Perfect Web*, 587 F.3d at 1332–33 (“[L]ong-felt need is analyzed as of the date of an articulated identified problem and evidence of efforts to solve that problem.”) (citation and internal quotation marks omitted). Finally, Patent Owner recognizes that there still “is” a need in the industry for “remote patient monitoring systems,” and does not show sufficiently that the ’186 patent actually satisfied the alleged need. *See* PO Resp. 21. Thus, Patent Owner’s evidence of long-felt need is not persuasive.

### *3. Industry Praise*

Patent Owner argues that the Health Buddy received “great praise,” citing two television news segments and various written publications. PO Resp. 22 (citing Ex. 2006 ¶¶ 85–89). Patent Owner contends that the industry praise “highlighted the ease of use of the device, made possible by the scripting invention of the ’186 Patent.” *Id.* As with commercial success, however, evidence of industry praise is only relevant when it is directed to the merits of the invention claimed. *See Ormco*, 463 F.3d at 1311. Patent Owner cites a general “scripting” feature, but does not tie the discussion in the cited materials to any particular limitation(s) of the challenged claims. Dr. David also cites numerous materials praising the Health Buddy in

general, rather than praise due to specific features that are present in the claims. *See* Ex. 2006 ¶¶ 85–89 (describing, for example, awards won by the Health Buddy). Thus, Patent Owner has not established a sufficient nexus with the claimed apparatus or method, and industry praise of the Health Buddy does not support a conclusion of nonobviousness of the claims.

#### *4. Teaching Away by Others*

Patent Owner argues that there were other systems available when the Health Buddy was released that used “personal computers, or prior art methods, such as hospital initiated phone calls or patient diaries.” PO Resp. 22 (citing Ex. 2006 ¶¶ 90–91). According to Patent Owner, the Health Buddy was different from those systems because it had a “very simplified four-button design” and “case manager interface” using “scripted question[s].” *Id.* at 23. We are not persuaded that the mere existence of alternatives in the marketplace is a secondary consideration of nonobviousness,<sup>5</sup> however, and Patent Owner does not explain sufficiently why the cited alternatives would have taught away from the claimed apparatus or method. *See In re Fulton*, 391 F.3d 1195, 1201 (Fed. Cir. 2004) (“[t]he prior art’s mere disclosure of more than one alternative does not constitute a teaching away . . . because such disclosure does not criticize, discredit, or otherwise discourage the solution claimed”). Moreover, any difference between the Health Buddy and other systems would be immaterial because the challenged claims do not require a four-button

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<sup>5</sup> Failure of others can be a secondary consideration of nonobviousness, but Patent Owner does not argue that any other system was a failure. *See Graham*, 383 U.S. at 17–18.

design, which Patent Owner cites as an allegedly distinguishing feature of the Health Buddy. Again, what matters when considering secondary considerations of nonobviousness is what is actually claimed. Patent Owner's arguments are not directed to the challenged claims and are not persuasive.

### 5. Copying

Patent Owner argues that, as a result of the Health Buddy's initial success, the VA "codified" in a request for proposal ("RFP") various features of the Health Buddy, including "the requirement that all future telehealth messaging devices be capable of customizing user scripts specifically." PO Resp. 23 (citing Ex. 2006 ¶¶ 92–94). Patent Owner infers that other companies, such as Viterion, Inc. and Advanced Telehealth, Inc., copied the Health Buddy because they sold systems to the VA that complied with the RFP. *Id.*

Patent Owner's arguments regarding copying are not persuasive. "[C]opying requires evidence of efforts to replicate a specific product." *Wyers v. Master Lock Co.*, 616 F.3d 1231, 1246 (Fed. Cir. 2010). Patent Owner and Dr. David do not provide any analysis or explanation of how other companies allegedly copied the Health Buddy system. Indeed, Dr. David admitted that he never analyzed what other companies provided to the VA. *See* Ex. 1041, 177:21–25. Dr. David only states that Patent Owner's personnel he spoke with "recalled" competing products, such as "the Viterion VT100 device," that complied with the RFP. Ex. 2006 ¶¶ 95–96. There is no evidence in the record, however, as to how "the Viterion VT100 device" worked. Dr. David also does not mention any product of the other

company cited in the Patent Owner Response, Advanced Telehealth, Inc. Thus, Patent Owner has not shown sufficiently that anyone copied the Health Buddy system. Further, even if it was proper to infer copying merely from compliance with the RFP, Dr. David admitted that the RFP could be satisfied by a system that does not practice the methods recited in the challenged claims. *See* Ex. 1041, 212:21–213:3. Patent Owner has not shown proof of copying that would support a conclusion of nonobviousness of the challenged claims.

Based on all of the evidence of record, including evidence of secondary considerations of nonobviousness submitted by Patent Owner, we determine that claims 1–6 and 8–15 would have been obvious based on Goodman and Wahlquist, and that claims 7 and 16 would have been obvious based on Goodman, Wahlquist, and Lyons, under 35 U.S.C. § 103(a).

#### *E. Motions to Exclude*

The party moving to exclude evidence bears the burden of proof to establish that it is entitled to the relief requested—namely, that the material sought to be excluded is inadmissible under the Federal Rules of Evidence. *See* 37 C.F.R. §§ 42.20(c), 42.62(a).

Petitioner seeks to exclude Exhibits 2011–2057 and paragraphs 57–96 of Exhibit 2006. Paper 52, 1. In particular, Petitioner argues that “Patent Owner failed to establish a nexus between the alleged evidence and the claimed features,” that “[t]he secondary evidence has other gaps so fundamental as to warrant exclusion,” and that, in certain paragraphs of Dr. David’s testimony, Dr. David “only regurgitates what some Bosch witness

told Dr. David, and reflects no independent analysis of the issue by Dr. David.” Paper 52, 2, 6, 9.

We need not reach the merits of Petitioner’s Motion to Exclude because, as explained above, even if the disputed evidence is considered, Patent Owner has not shown proof of secondary considerations that would support a conclusion of nonobviousness of the challenged claims. Accordingly, Petitioner’s motion to exclude is *dismissed as moot*.

Patent Owner seeks to exclude paragraphs 46–75 of Exhibit 1022 (testimony from Dr. Stone regarding secondary considerations of nonobviousness). Paper 54, 1. We do not rely on the disputed evidence in rendering our Decision. Therefore, Patent Owner’s motion to exclude is *dismissed as moot*.

#### *F. Motion for Observation*

Patent Owner’s observations are directed to the cross-examination testimony of Dr. Stone (Ex. 2069), who was cross-examined after Petitioner filed its Reply. We have considered Patent Owner’s observations and Petitioner’s responses in rendering our decision, and have accorded the testimony the appropriate weight as explained above. *See* Obs. 1–15. Petitioner’s responses are 23 pages, and exceed the 15-page limit specified by 37 C.F.R. § 42.24(b)(3). As such, only the first 15 pages of Petitioner’s responses have been considered. *See* Obs. Resp. 1–15.

#### ORDER

Petitioner has demonstrated, by a preponderance of the evidence, that claims 1–6 and 8–15 are unpatentable over Goodman and Wahlquist, and

IPR2013-00431  
Patent 7,921,186 B2

that claims 7 and 16 are unpatentable over Goodman, Wahlquist, and Lyons, under 35 U.S.C. § 103(a).

In consideration of the foregoing, it is hereby:

ORDERED that claims 1–16 of the '186 patent have been shown to be unpatentable;

FURTHER ORDERED that Petitioner's Motion to Exclude is *dismissed*; and

FURTHER ORDERED that Patent Owner's Motion to Exclude is *dismissed*.

This is a final decision. Parties to the proceeding seeking judicial review of the decision must comply with the notice and service requirements of 37 C.F.R. § 90.2.

IPR2013-00431  
Patent 7,921,186 B2

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