

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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MEDTRONIC, INC.  
Petitioner

v.

ROBERT BOSCH HEALTHCARE SYSTEMS, INC.  
Patent Owner

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Case IPR2014-00436  
Patent 7,587,469 B2

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

QUINN, *Administrative Patent Judge.*

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

Medtronic, Inc. (“Petitioner”) filed a Petition to institute an *inter partes* review of claims 1-22 of U.S. Patent No. 7,587,469 B2 (“the ’469 patent”) pursuant to 35 U.S.C. §§ 311-319. Paper 5. Concurrently with its Petition, Petitioner filed a Motion for Joinder seeking to join this case with the ongoing *inter partes* review of the ’469 patent in *Cardiacom LLC v. Robert Bosch Healthcare Systems, Inc.*, Case IPR2013-00451 (“the 451 case”). Paper 4. Robert Bosch Healthcare Systems, Inc. (“Patent Owner”) filed a Preliminary Response (Paper 13) and an Opposition to the Motion for Joinder (Paper 10). We have jurisdiction under 35 U.S.C. § 314.

## I. BACKGROUND

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

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

Petitioner asserts unpatentability under 35 U.S.C. § 103 of (1) claims 1-22 over the combination of Cohen,<sup>1</sup> Kaufman,<sup>2</sup> and Wahlquist,<sup>3</sup> and (2) claims 1-6, 10-12, 16-18, and 22 over the combination of Cohen and Kaufman.

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<sup>1</sup> U.S. Patent No. 6,014,626 (Ex. 1002) (“Cohen”).

<sup>2</sup> European Patent Application Publication No. EP0342859A2 (Ex. 1003) (“Kaufman”).

<sup>3</sup> U.S. Patent No. 5,367,667 (Ex. 1004) (“Wahlquist”).

We deny the Petition because the information presented in the Petition fails to demonstrate a reasonable likelihood that Petitioner would prevail with respect to unpatentability of claims 3, 4, and 11-22 based on all asserted grounds. Further, we reject the Petition as to claims 1, 2, and 5-10 based on our exercise of discretion under 35 U.S.C. § 325(d) because the “same or substantially the same prior art or arguments previously were presented to the Office” in the 451 case.

#### RELATED MATTERS AND PETITIONER

The '469 patent is the subject of an *ex parte* reexamination (Control No. 90/013,175),<sup>4</sup> and of a co-pending district court case, *Robert Bosch Healthcare Systems v. Cardiocom, LLC and Abbott Diabetes Care*, Case No. 2:13-cv-349 (E.D. Tex.). Pet. 1; Prelim. Resp. 10. Furthermore, at the time the Petition was filed, patents related to the '469 patent were subject to other district court proceedings, *ex parte* reexamination, and *inter partes* review. Pet. 1-2.

The '469 patent is also the subject of an *inter partes* review. Specifically, on January 16, 2014, we instituted an *inter partes* review in the 451 case on two grounds of unpatentability: (1) claims 1, 2, and 5-10 as unpatentable over Cohen and Wahlquist under 35 U.S.C. § 103(a); and (2) claims 1, 2, and 5-10 as unpatentable over Cohen, Wahlquist, and two other

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<sup>4</sup> Petitioner filed the request for *ex parte* reexamination on March 7, 2014, after filing the Petition in the instant proceeding on February 14, 2014. The parties are reminded of their obligation to update their mandatory notice information, including identification of any related matters, within 21 days of any change. *See* 37 C.F.R. § 42.8(a)(3).

prior art references under 35 U.S.C. § 103(a). *Cardiocom LLC v. Robert Bosch Healthcare Systems, Inc.*, Case IPR2013-00451, Paper 23 at 29.

Petitioner has asserted that it is a real party-in-interest in the 451 case. *Cardiocom*, IPR 2013-00451, Paper 26. Petitioner, Medtronic, Inc. acquired Cardiocom LLC (“Cardiocom”) after that entity filed the petition in the 451 case. Pet. 3.

#### THE '469 PATENT (EX. 1001)

The '469 patent, titled “Audio Instructions for Appliances,” issued on September 8, 2009. The '469 patent relates to a networked system for remotely monitoring individuals, and for communicating information to the individuals through the use of script programs. Ex. 1001, col. 1, ll. 39-41.

The patent describes the need for remote monitoring of patients in out-patient or home healthcare programs. *Id.* at col. 1, ll. 45-50; col. 2, ll. 33-37. According to the patent, the use of personal computers, medical monitoring devices, and interactive telephone or video response systems for remote monitoring have proved inadequate because of their expense, limited multimedia capability, and the complexity of managing non-compliant patients. *Id.* at col. 1, l. 65 – col. 2, l. 32.

One embodiment of the '469 patent, shown in Figure 1, reproduced below, is networked system 16 with server 18 connected to the Internet (communication network 24), where server 18 sends script programs to each remotely programmable apparatus 26. *Id.* at col. 4, ll. 18-35.

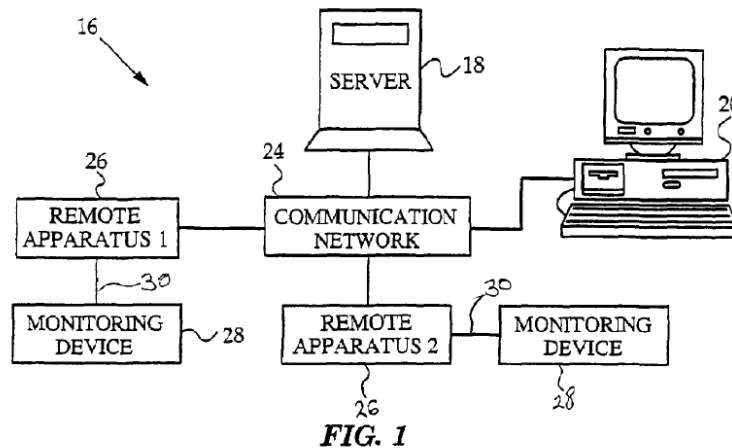


Figure 1 illustrates that system 16 may include any number of remotely programmable apparatuses 26 (two are shown, above) for monitoring any number of patients. *Id.* at col. 4, ll. 42-44. In one preferred embodiment, each patient is provided with monitoring device 28 (such as a blood glucose meter). *Id.* at col. 4, ll. 45-61. That device produces measurements of a physiological condition of the patient (such as blood glucose concentrations in the blood of the patient), and transmits those measurements to the patient's remote apparatus 26 via standard cable 30. *Id.* at col. 4, ll. 45-61. Remotely programmable apparatus 26 executes a script program received from server 18. *Id.* at col. 5, ll. 7-9. That script program includes "queries, reminder messages, informational statements, useful quotations, or other information of benefit to the patient." *Id.* at col. 5, ll. 9-11.

The '469 patent further describes an embodiment where remotely programmable apparatus 26 includes speech recognition and speech synthesis functionality. *Id.* at col. 11, ll. 50-54. Audible queries, prompts, and response choices are communicated to the user through a speaker in

apparatus 26, and a microphone receives the responses from the user. *Id.* at col. 12, ll. 40-48.

In further embodiments, remotely programmable apparatus 26 is an interactive television system. *Id.* at col. 16, ll. 19-26. Furthermore, the '469 patent describes collecting data from smart appliances, such as a “refrigerator, telephone, stove, clock radio, VCR, or any other electrical or non-electrical device including the monitoring device 28.” *Id.* at col. 20, ll. 32-40.

#### ILLUSTRATIVE CLAIM

Challenged claims 1, 11, and 17 are independent. Claim 1 is illustrative of the claims-at-issue and is reproduced below:

1. A communications network comprising:
  - a communications channel;
  - a server;
  - a primary device in communication with said server through said communications channel, wherein (A) said primary device comprises a component adapted to (i) receive one or more computer programs including one or more queries, instructions or messages as a first digital file from said server, (ii) convert the first digital file into synthesized audio transmissions, (iii) present said synthesized audio transmissions to an individual through a speaker and (iv) receive audible responses from said individual and (B) said primary device comprises a processor adapted to collect data relating to said primary device, and execute said computer programs to provide a diagnosis of a performance of said primary device; and
  - a secondary device operatively connected to said primary device, wherein said secondary device (i) is adapted to be operated by said individual in response to said synthesized audio transmissions and (ii) comprises a user interface adapted to receive input responses from

said individual and convert said input responses to a second digital file through speech recognition.

CLAIM INTERPRETATION

Based on the record presented and for purposes of rendering our decision to institute in the 451 case, we construed two claim terms of the '469 patent as stated in the table below:

| <b>Term</b>  | <b>Construction in IPR2013-00451</b>  |
|--|---|
| household appliance  | electronic equipment devised for home use   |
| execute said computer programs to provide a diagnosis of a performance of said [primary device or household appliance] | execute said computer programs to provide data or information of a performed operation by the [primary device or household appliance] |

Petitioner does not propose a different construction for the above-referenced terms, and contends that we should construe an additional term, “script program.” Specifically, Patent Owner urges us to adopt the construction for “script program” determined in another *inter partes* review proceeding, which concerns a patent related to the '469 patent, *Cardiocom LLC v. Robert Bosch Healthcare Systems Inc.*, Case IPR2013-00431. Prelim. Resp. 17-21. We conclude that construing the term “script program,” however, is not necessary for our determination of whether to institute a second *inter partes* review of the '469 patent. Accordingly, for purposes of this decision, we adopt the constructions set forth in the table above, and no other terms are expressly construed.

## II. DISCUSSION

We now turn to Petitioner's asserted grounds of unpatentability and Patent Owner's arguments in the preliminary response.

### A. PRIOR ART REFERENCES

Each prior art reference asserted in the Petition is summarized below.

#### 1. Overview of Cohen (Exhibit 1002)

Cohen is directed to a patient monitoring system and, in particular, to using a telephone to monitor the health status of outpatients. Ex. 1002, Abstract; col. 1, ll. 14-16. The Cohen central monitoring system generates questions concerning a health condition of a patient, questions which the patient answers using the keys of a telephone, by speaking the response, or in electronic form, such as by a computer-to-computer communication. *Id.* at Abstract; col. 16, ll. 7-12. One embodiment of Cohen's system is depicted in Figure 5, reproduced below.

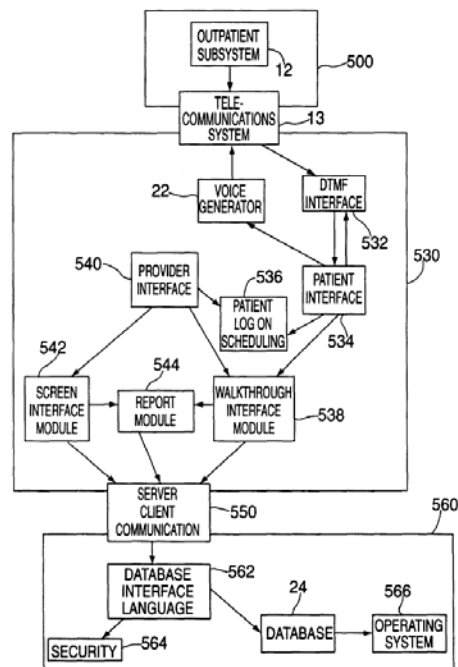


FIG. 5



Figure 5 illustrates that the Cohen system may be divided into three parts: patient system 500; interface server 530; and database server 560. *Id.* at col. 11, ll. 31-33. Patient system 500 incorporates outpatient subsystem 12. *See id.* at col. 11, ll. 33-37. Interface server 530 handles the process of getting answers from patients, *id.*, and it allows health care providers access to database 24. *Id.* at col. 11, ll. 37-39. Cohen describes interface server 530 and database server 560 as comprising central monitoring subsystem 11, depicted in Figure 2A (not shown). *Id.* at col. 11, ll. 40-42.

2. Overview of Wahlquist (Exhibit 1004)

Wahlquist is directed to remote diagnostics on a personal computer system, where the user calls a help desk representative who selects specific diagnostic tests, resident on the user's diagnostic disk, to be run on the user's computer. Ex. 1004, Abstract. The user's computer is instructed to run the selected diagnostic tests. *Id.* Upon completion of the tests, the user's computer reconnects with the help desk computer and reports the result of the tests. *Id.* A script file also may instruct the user's computer to send copies of various computer system files, such as network or configuration system files, to a link manager computer. *Id.* at col. 6, ll. 33-36. In one embodiment of a remote diagnostic method, Wahlquist describes that the link manager computer interrogates the user's computer to determine and provide its corresponding computer identification code. *Id.* at col. 5, ll. 52-56.

3. Overview of Kaufman (Exhibit 1003)

Kaufman discloses a patient assistance system that can communicate

with a remote medical computer via modem 40 and a telephone system. Ex. 1003, 5, ll. 15-16. The modem can be used for transferring patient information to the remote computer or for receiving programmed instructions or information from the remote computer. *Id.* at 3, ll. 27-29. One embodiment of the Kaufman system is depicted in Figure 4, reproduced below.

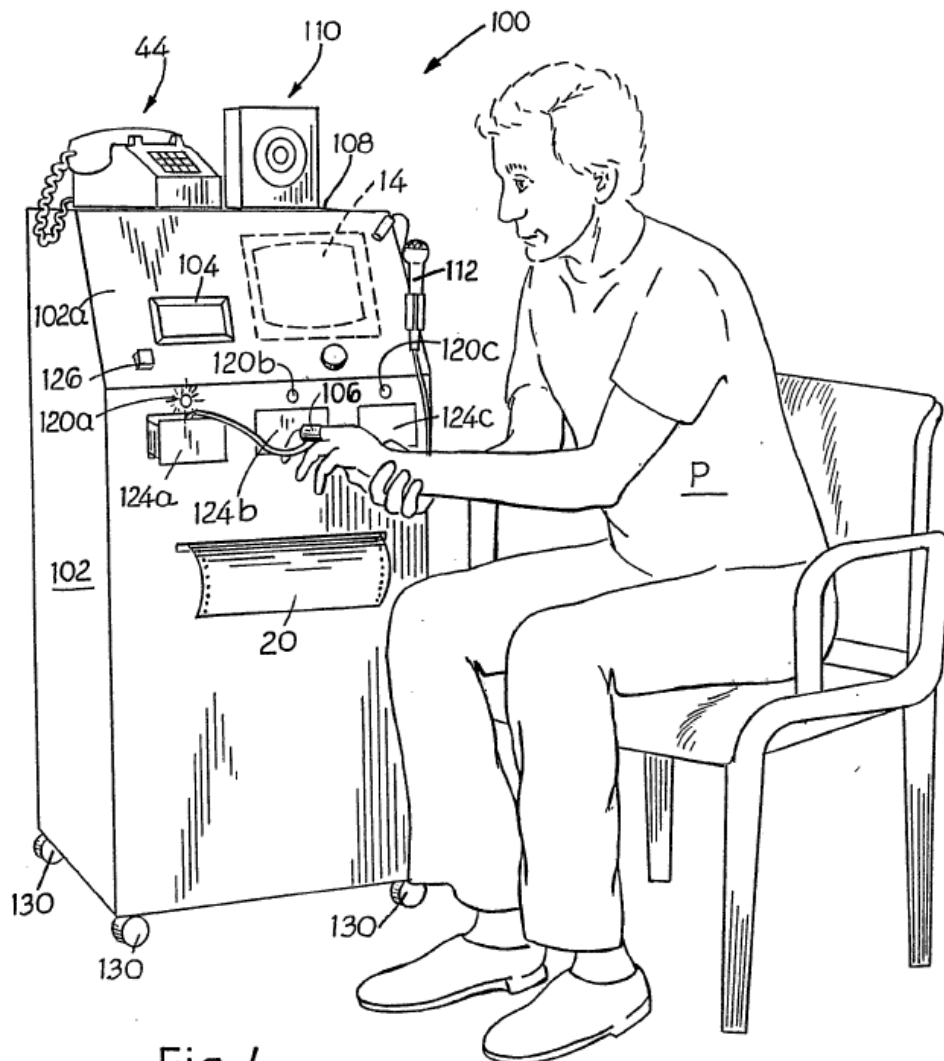


Fig. 4

Figure 4 illustrates system 100 with the patient P using finger type blood pressure and pulse rate cuff 106 that detects the blood pressure and

pulse rate of patient P. *Id.* at 6, ll. 13-15.

B. ASSERTED OBVIOUSNESS OF CLAIMS 1, 2, AND 5-10

Petitioner asserts two grounds of obviousness for independent claim 1 and dependent claims 2 and 5-10. Pet. 6. Both grounds rely, at least in part, on Cohen, and one of the grounds relies, at least in part, on Wahlquist. *Id.* The arguments presented with regard to Cohen are the same arguments presented in connection with the Petition filed in the 451 case. In particular, the instant Petition presents Cohen as disclosing the same claim limitations with substantially the same support and arguments as presented in the Petition in the 451 case. For example, for claim 1, both petitions rely on Cohen as disclosing the preamble, the communications channel, the server, the primary device in communication with the server, receiving computer programs, converting to synthesized audio transmissions, receiving audible responses from individuals, and the secondary device. *Compare* Pet. 23-30 *with* Petition in *Cardiocom* at IPR2013-00451, Paper 1 at 20-25. Both petitions also point out the same deficiency in Cohen, namely the lack of execution of computer programs to provide a diagnosis of a performance of said primary device. *Compare* Pet. 27 (relying solely on Kaufman as teaching the limitation) *with* Petition in *Cardiocom* at IPR2013-00451, Paper 1, at 23-24 (relying solely on Wahlquist as teaching the limitation). With regard to Wahlquist, the instant Petition asserts the same arguments presented in the 451 case. *Compare* Pet. 25-26 (relying on Wahlquist in “Ground 2” as disclosing a diagnostic program running on the user’s computer) *with* Petition in *Cardiocom* at IPR2013-00451, Paper 1, at 23-24 (relying on Wahlquist in “Grounds 1 and 2” as disclosing the diagnostic program running on the user’s computer).

We, therefore, exercise our discretion and determine that the arguments presented in the instant Petition involve the same, or substantially the same, prior art (e.g., Cohen and Wahlquist) and the same, or substantially the same, arguments previously presented in the 451 case. 35 U.S.C. § 325(d). We have taken into account that Petitioner here is a real party-in-interest in the ongoing *inter partes* review of the '469 patent. *See Cardiacom*, IPR2013-00451, Paper 26. We also have considered that Petitioner already is involved in a trial involving the '469 patent and concerning substantially similar grounds. Furthermore, as explained above, for the claims already involved in the 451 case trial, the overlap between the arguments and evidence in that trial and the grounds asserted in the Petition in this proceeding is substantial. Nothing in the Petition accounts for this substantial overlap or persuades us that we should not exercise our discretion under section 325(d). Accordingly, we reject the Petition as to claims 1, 2, and 5-10.

#### C. ASSERTED OBVIOUSNESS OF CLAIMS 3-4 AND 11-22

In the 451 case, we denied institution of trial based on the determination that the petitioner in that case had not shown sufficiently that Cohen teaches the “single housing” limitation recited in claim 3 and the “household appliance” limitation recited in claims 4 and 11-22. Decision, IPR2013-00451, Paper 23, at 18, 24-25 (Jan. 16, 2014). In the instant Petition, Kaufman is proffered as disclosing both the “single housing” and the “household appliance” limitations. *See* Pet. 19.

Upon review of the evidence and arguments presented in the Petition, we determine that Petitioner fails to show a reasonable likelihood that it will prevail in showing the unpatentability of claims 3, 4, and 11-22, because the

Petition does not show sufficient evidence of a reasonable rationale for the combination of Cohen and Kaufman with regard to these claims. In particular, we find persuasive Patent Owner's argument that Petitioner's proffered rationale for the combination of Cohen and Kaufman does not explain sufficiently how Cohen may be modified to include Kaufman's cabinet. Prelim. Resp. 34. Petitioner's contention is that the modification of Cohen to include a device that runs programs and allows for user interaction would have been obvious because Kaufman discloses such a system, "packaged in a single household appliance." Pet. 20. This statement by Petitioner does not demonstrate sufficiently a reason why a person of ordinary skill in the art would have modified Cohen to include a Kaufman home-use-designed cabinet to house the Cohen servers alleged to be the primary and secondary devices to achieve the "household appliance" and "single housing" limitations. In other words, Petitioner's proffered motivation to combine Kaufman and Cohen leaves unexplained why a person of ordinary skill in the art would select the "household appliance" and "single housing" of Kaufman to modify Cohen's system. *See Unigene Labs., Inc. v. Apotex, Inc.*, 655 F.3d 1352, 1360 (Fed. Cir. 2011) ("Obviousness requires more than a mere showing that the prior art includes separate references covering each separate limitation in a claim under examination. Rather, obviousness requires the additional showing that a person of ordinary skill at the time of the invention would have selected and combined those prior art elements in the normal course of research and development to yield the claimed invention.") (internal citations omitted).

Furthermore, Petitioner's reliance on the testimony of Dr. Stone also fails to show sufficient evidence of a rationale to combine Kaufman and

Cohen. *See* Pet. 20 (citing Ex. 1007 ¶¶ 38, 43, 47, and 68). First, the Petition merely states that “[a]dditional reasons to combine the art are described in the attached Declaration,” but does not offer any explanation of the additional alleged “reasons to combine” that may be found in Dr. Stone’s declaration. *See id.*; 37 C.F.R. § 42.104(b)(4) (a petition for *inter partes* review must explain “[h]ow the construed claim is unpatentable”). Second, even considering the cited portions of the declaration, we are not persuaded that these paragraphs offer a sufficient reason to modify Cohen to achieve the “household appliance” or “single-housing” limitation, as taught by Kaufman—this is the rationale missing from the cited portions of the declaration. Stating that the references deal with similar features or devices, and alluding to the allegation that the combination ensures “proper[] functioning” with a patient, are unpersuasive. *See* Ex. 1007 ¶¶ 38, 43, 47, 68. We find no evidence presented in the cited testimony of Dr. Stone to explain how a motivation to make the device function properly when interacting with a patient also motivates one of ordinary skill in the art to include the primary and secondary servers of Cohen into a home-use-designed cabinet, such as that taught in Kaufman.

As for the ground pertaining to the combination of Cohen, Kaufman, and Wahlquist, Petitioner also fails to demonstrate a sufficient rationale for why a person of ordinary skill in the art would find it obvious to modify Cohen with Kaufman’s disclosure of the “household appliance” and “single housing.” *See* Pet 21-22 (focusing on the combination of the references with regard to the sending of computer programs over a network and speech recognition and synthesis limitations). Accordingly, we determine, for purposes of this decision, that the record does not show sufficient evidence

that there is a reasonable likelihood Petitioner will prevail as to its contention that claims 3, 4, and 11-22 would have been obvious over the combination of Cohen and Kaufman or over the combination of Cohen, Kaufman, and Wahlquist.

### III. CONCLUSION

For the foregoing reasons, we reject the request for institution of *inter partes* review of claims 1-2 and 5-10, and deny institution of *inter partes* review of claims 3-4 and 11-22 of the '469 patent based on all the grounds asserted in the Petition. Accordingly, the pending Motion for Joinder is rendered moot.

### IV. ORDER

After due consideration of the record before us, it is ORDERED that the petition is denied and no trial is instituted; and FURTHER ORDERED that Petitioner's Motion for Joinder is *denied*.

Case IPR2014-00436  
Patent 7,587,469 B2

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