

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ALCOHOL MONITORING SYSTEMS, INC.,
Petitioner,

v.

SOBERLINK, INC.,
Patent Owner.

Case IPR2013-00577
Patent 8,381,573 B2

Before KALYAN K. DESHPANDE, SCOTT E. KAMHOLZ,
and DAVID C. MCKONE, *Administrative Patent Judges*.

MCKONE, *Administrative Patent Judge*.

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

I. INTRODUCTION

A. Background

Alcohol Monitoring Systems, Inc. (“Petitioner”) filed a Petition (Paper 5, “Pet.”) to institute an *inter partes* review of claims 1–5, 9–11, 15–17, 21, and 22 of U.S. Patent 8,381,573 B2 (Ex. 1002, “the ’573 patent”). Soberlink, Inc. (“Patent Owner”) filed a Preliminary Response (Paper 11, “Prelim. Resp.”). Pursuant to 35 U.S.C. § 314, in our Decision to Institute (Paper 12, “Dec.”), we instituted this proceeding as to all of the challenged claims of the ’573 patent.

After the Decision to Institute, Patent Owner filed a Patent Owner Response (Paper 22, “PO Resp.”), and Petitioner filed a Reply to the Patent Owner Response (Paper 26, “Reply”). An oral hearing (Paper 39, “Tr.”) was held on September 10, 2014.

B. References Relied Upon

Petitioner relies upon the following prior art references:

Ex. 1003	Walter	US 7,934,577 B2	May 3, 2011 (filed July 17, 2009)
Ex. 1006	Hawthorne	US 2004/0236199 A1	Nov. 25, 2004
Ex. 1011	Williams	WO 2008/076310 A1	June 26, 2008

C. The Asserted Grounds

We instituted this proceeding based on the grounds of unpatentability set forth in the table below. Dec. 18–19.

References	Basis	Claims challenged
Walter	§ 103(a)	1–3 and 9
Walter and Hawthorne	§ 103(a)	4, 5, 10, and 11
Walter and Williams	§ 103(a)	15–17 and 21
Walter, Williams, and Hawthorne	§ 103(a)	22

D. The '573 Patent

The '573 patent generally relates to remote sobriety monitoring using a breath testing and identification device. Ex. 1002, col. 1, ll. 15–24. The '573 patent describes a handheld device that includes a breath alcohol test device for analyzing the breath alcohol content (“BAC”) of a user. *Id.* at col. 4, ll. 43–50. Figure 3 of the '573 patent is reproduced below:

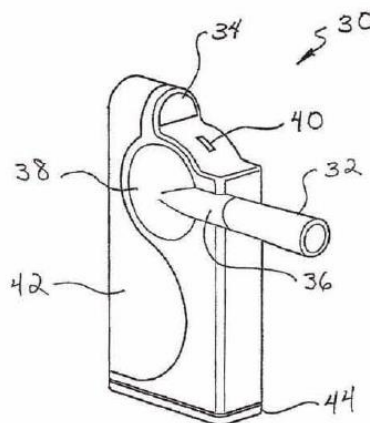


FIG. 3

Figure 3 depicts a handheld breath testing device. A user blows into removable breath tester tip 32 that is connected to breath analysis and processing portion 38 of the device. *Id.* at col. 6, ll. 39–47. The device also includes digital camera 34 that takes a picture of the user, synchronized to when the user is blowing into the tip, to verify the identity of the user. *Id.* at col. 6, ll. 47–53. The device also includes a wireless transmitter for transmitting the BAC information and photo over a wireless or cellular network to a receiver at a monitoring station. *Id.* at col. 7, ll. 50–67. The wireless transmitter can be a hardware component internal to the breath testing device. *Id.* at col. 5, ll. 1–6. If the breath testing device detects a BAC above a threshold, it can transmit an alarm condition to a supervisory monitor at the monitoring station. *Id.* at col. 8, ll. 1–6. The supervisory monitor can, for example, alert a supervisory care professional (e.g., a “sober buddy”) who can respond to the alarm and take corrective action. *Id.* at col. 8, ll. 34–38.

The breath testing device also can include other components such as a battery and a global positioning system (“GPS”) tracking module internal to the device. *Id.* at col. 6, ll. 57–65.

E. Illustrative Claim

Claim 1, reproduced below, is illustrative of the claimed subject matter:

1. A portable, cordless, hand-held breath alcohol content testing device, comprising:
 - a portable, cordless hand-held case having an inside, an outside, and one or more walls;

- a breath alcohol content sensor housed within the case for sensing a breath alcohol content of a user;
- a breath interface component operatively coupled to the breath alcohol content sensor and exposed within the one or more walls of the case;
- a digital camera housed within the case with a lens exposed within the one or more walls and positioned to capture an image of the user during a breath test;
- a controller housed within the case and electronically coupled to the digital camera and the sensor, the controller configured to cause the camera to capture the image of the user during the breath test and to electronically receive the breath alcohol content and the image of the user; and
- a wireless transceiver housed within the case and electronically coupled to the controller for receiving and wirelessly transmitting the breath alcohol content of the user and electronic image-related data, derived from the image of the user, to a receiving station.

II. ANALYSIS

A. Claim Construction

The Board interprets claims of an unexpired patent using the broadest reasonable construction. *See* 37 C.F.R. § 42.100(b). Claim terms generally are given their ordinary and customary meaning, as would be understood by one of ordinary skill in the art in the context of the entire disclosure. *See In re Translogic Tech., Inc.*, 504 F.3d 1249, 1257 (Fed. Cir. 2007).

In the Petition, Petitioner proposed construing “wireless transceiver,” recited in independent claims 1 and 15, and “monitored internet website,” recited in dependent claims 5, 11, and 22. Pet. 4–5. Patent Owner contested Petitioner’s proposed construction of “wireless transceiver.” Prelim. Resp. 6 & n.2. In the Decision to Institute (Dec. 9–16, 21), we agreed with Petitioner’s proposals and construed the claim terms as reproduced in the table below:

Claim Phrase	Claim Construction in the Decision to Institute
“wireless transceiver” (claims 1, 15)	a device that is capable of receiving communications from a source and transmitting communications to a destination without a wired connection between it and the source or destination
“monitored internet website” (claims 4, 11, 22)	a website comprising information, at least part of which information is screened manually by personnel and/or automatically by software

Petitioner and Patent Owner do not dispute these constructions. We see no reason to change these constructions based on the complete record developed during this trial and maintain them for purposes of this Decision. Neither Petitioner nor Patent Owner identifies any additional terms requiring construction. No other terms require express construction for purposes of this Decision.

B. Patent Owner’s Motion to Exclude

Petitioner submitted a Declaration of Mr. Mark Wojcik, Petitioner’s Chief Technology Officer, along with its Reply. Patent Owner filed a

Motion to Exclude paragraphs 11–16, 23–27, 33, 36–53, 56, and 58 of this Declaration as well as several Petitioner exhibits (Exs. 1022, 1023, 1028–34, 1037–49) referred to in the Declaration. Paper 27 (“Mot. to Exclude”). In response, Petitioner withdrew Exhibits 1023, 1038, 1045, and 1049; submitted a substitute Wojcik Declaration (Ex. 1035); submitted substitute exhibits 1039, 1041, 1043, 1044, 1046, and 1047; and submitted new Exhibits 1053, 1054, and 1055. See Petitioner’s Opposition to Patent Owner’s Motion to Exclude Evidence (Paper 33, “Opp. to Mot. to Exclude”).

Paragraphs 11–16 and 33 of the substitute Wojcik Declaration discuss the MEMS 2000/3000, VI CAP, iBreath, In Hom, LifeSafer, and Streetime alcohol monitoring products purportedly available around the time of the invention of the ’573 patent. Exhibits 1022, 1037, 1039–44, 1046, and 1047 support paragraphs 11–16 and 33 of the substitute Wojcik Declaration. Patent Owner argues that this testimony and the associated exhibits are being offered to show the state of the art, an issue that Petitioner should have discussed in its Petition. Mot. to Exclude 3–4. Exhibit 1048 is a published patent application that Petitioner contends independently renders the challenged claims unpatentable, but which Petitioner did not discover until after the Petition was filed. Reply 7 n.7. Patent Owner argues that it would be more misleading than relevant. Mot. to Exclude 16. We do not rely on paragraphs 11–16 and 33 of Exhibit 1035 or Exhibits 1022, 1037, 1039–44, and 1046–48. Therefore, Patent Owner’s objections to these paragraphs and exhibits are overruled as moot.

Paragraphs 23–27 of the substitute Wojcik Declaration discuss the circumstances around a marketing presentation from Petitioner (Ex. 2003).

Patent Owner contends Exhibit 2003 shows that Petitioner itself taught away from the prior art combinations Petitioner now proposes. PO Resp. 21–22. Patent Owner argues that Mr. Wojcik lacked personal knowledge to give the testimony of paragraphs 23–27 and that, to the extent he is testifying to the contents of documents, the testimony is hearsay and violates the best evidence rule. Mot. to Exclude 15–16. In paragraph 21, Mr. Wojcik testifies that he has used Exhibit 2003 in presentations on several occasions as part of his job. We are persuaded that he has personal knowledge to testify about Exhibit 2003. Moreover, Patent Owner’s general reference to hearsay, without identifying any such instances, does not persuade us that we should exclude paragraphs 23–37.

Paragraphs 36–53 of the substitute Wojcik Declaration discuss Petitioner’s development of its own hand-held remote breath alcohol monitoring device. Patent Owner contends that this device is a copy of its own patented device. PO Resp. 26–28. Petitioner cites paragraphs 36–53 of the substitute Wojcik Declaration to rebut Patent Owner’s contention. Reply 8–11. Patent Owner contends that Mr. Wojcik lacked personal knowledge to give the testimony of paragraphs 36–53. Mot. to Exclude 17–18. We are persuaded that at least paragraphs 1–5, 39, 44, and 46 show that Mr. Wojcik has sufficient personal knowledge to give the testimony of paragraphs 36–53. Patent Owner further argues that this testimony is hearsay “[t]o the extent Wojcik is regurgitating statements he heard from others.” Mot. to Exclude 18. This general reference to hearsay, without identifying any such instances, does not persuade us that we should exclude paragraphs 36–53.

Exhibits 1028–34 are photographs comparing Petitioner’s device with products of Patent Owner. Petitioner, through the substitute Wojcik Declaration, cites these exhibits to rebut Patent Owner’s contention that Petitioner copied Patent Owner’s product. Reply 9; Ex. 1035 ¶ 55. Patent Owner argues that these exhibits are not authenticated properly. Mot. to Exclude 18. Mr. Wojcik, however, testifies that these photographs accurately represent the products of Patent Owner and Petitioner. Ex. 1035 ¶ 55. Patent Owner has not provided a persuasive reason to doubt their authenticity. Patent Owner further argues that these exhibits are misleading because they depict ornamental features of the devices rather than the claimed features and functionality. Mot. to Exclude 18. We disagree. The photographs depict both the exterior and interior of the devices, including the circuit components that implement the functionality Patent Owner contends embodies the claims. Accordingly, we are not persuaded that we should exclude Exhibits 1028–34.

Paragraph 56 of the substitute Wojcik Declaration sets forth Mr. Wojcik’s opinion of the level of ordinary skill in the art, while paragraph 58 disagrees with Patent Owner’s proposed level of ordinary skill. Patent Owner argues that this testimony is improper reply evidence. Mot. to Exclude 18–19. We do not rely on ¶¶ 56 and 58 of Exhibit 1035. Therefore, we overrule Patent Owner’s objections to these paragraphs as moot.

C. Asserted Grounds of Unpatentability

1. Obviousness over Walter

Petitioner contends that Walter renders obvious claims 1–3 and 9. Pet. 10–14. Walter is directed to a breath alcohol test device in a handheld

unit. Ex. 1003, Abstract. Walter describes a breath alcohol test ignition interlock device that includes a handheld breath alcohol test device and a relay box. *Id.* at col. 5, ll. 24–27. The relay box includes a vehicle systems interface that, for example, can disable a vehicle if the breath alcohol test device detects that the user of the vehicle has consumed too much alcohol or that the user is attempting to tamper with the device. *Id.* at col. 5, ll. 31–51.

Figure 2 of Walter is reproduced below:

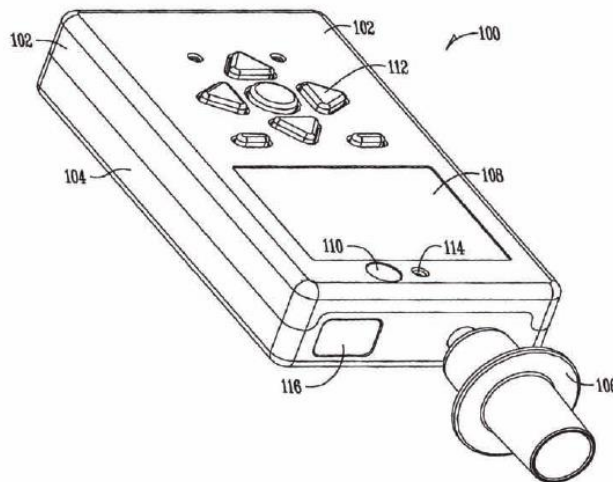


Fig. 2

Figure 2 depicts a handheld breath alcohol test device. As shown in Figure 2, a user blows into blow tube 106 at one end of the handheld unit. *Id.* at col. 6, ll. 9–10. The handheld unit includes an outer case formed by top shell 102 and bottom shell 104. *Id.* at col. 5, ll. 65–67. A breath alcohol tester assembly, with a fuel cell, is provided inside the handheld unit for measuring BAC. *Id.* at col. 8, ll. 45–61. The handheld unit also includes a camera for photographing a user as the user blows into the tube. *Id.* at

col. 6, ll. 49–54, col. 7, l. 55–col. 8, l. 15, col. 14, ll. 33–35. Figure 2 further illustrates camera cover 116 adjacent to blow tube 106. *Id.* at col. 6, ll. 49–54.

Walter describes multiple wireless transceivers. For example, the handheld device can include a Bluetooth transceiver for transmitting BAC data and camera images to the relay box. *Id.* at col. 6, ll. 45–46, col. 12, ll. 1–6. The handheld device also can include a cellular phone for transmitting audio information. *Id.* at col. 6, ll. 40–45. As we explained in the Decision to Institute (Dec. 11), Walter does not describe this cellular phone as being used to transmit BAC data or camera images. Walter’s relay device includes a cellular phone for communicating with an outside service provider. *Id.* at col. 5, ll. 31–33, col. 5, ll. 51–55, col. 11, ll. 48–67. The outside service provider can be a third party commercial organization that monitors and maintains the breath alcohol test ignition interlock device, a government agency, or a private company managing a fleet of vehicles and drivers. *Id.* at col. 5, ll. 55–61.

In the Decision to Institute, we preliminarily determined that Petitioner had shown that Walter discloses each limitation of claims 1–3 and 9 except for a wireless transceiver “housed within the case,” as recited in claim 1. Dec. 10–12. Rather, it is the cellular phone in Walter’s relay box that transmits the BAC of the user and image data to a receiving station. *Id.* Patent Owner’s Opposition does not contest these findings.

At the oral hearing, Patent Owner argued that Walter does not teach “transmitting the breath alcohol content of the user and electronic image-

related data” to a receiving station, as recited in claim 1.¹ Tr. 26:6–18. We are not persuaded by this argument. According to Walter, the handheld device acquires BAC and image-related data together as part of a test. Ex. 1003, col. 14, ll. 33–35. Both the BAC and image data are transmitted to the relay box. *Id.* at col. 12, ll. 1–6 (“Data from breath tests will be transmitted to the relay box for storage, along with images captured by the handheld unit cameras as part of the breath test.”). In the case of a failed test, both the BAC and image data are transmitted from the relay box to the service provider. *Id.* at col. 15, ll. 18–21 (“The failed test will be recorded and logged in the memory of the relay computer, and the results will be communicated to the service provider 40 by the cellular phone.”). Because the image data is part of the breath test, it is part of the results transmitted. Walter makes this clear when it explains that “[t]he identity of the person providing the unacceptable test may be determined by review of the associated digital image that was captured while the sample was being provided.” *Id.* at col. 15, ll. 21–24. Moreover, Patent Owner acknowledged at the hearing that the purpose of Walter’s camera image is to authenticate the person blowing into the breath alcohol test device before the car starts and, thus, the image must be sent to the service provider. Tr. 31:3–24. Accordingly, we find that Walter teaches transmitting both BAC and image data to a receiving station.

As to whether Walter discloses a wireless transceiver “housed within the case,” Petitioner identified Walter’s service provider 40 as the claimed

¹ Although this argument is belated, *see* Office Patent Trial Practice Guide, 77 Fed. Reg. at 48,768, we exercise our discretion and consider it.

receiving station to which the transceiver sends data, identified the functionality of the relay box's cellular phone as the claimed "wirelessly transmitting," and argued that this functionality could be performed by the other cellular phone Walter describes as present in the handheld device.

Pet. 12. We determined that transmitting BAC and image data by the handheld device's cellular phone is not disclosed in Walter and, thus, Walter does not anticipate the challenged claims. Dec. 11; *see also Net MoneyIN, Inc. v. Verisign, Inc.*, 545 F.3d 1359, 1370 (Fed. Cir. 2008) (To anticipate, a reference must "show all of the limitations of the claims arranged or combined in the same way as recited in the claims."); *In re Bond*, 910 F.2d 831, 832 (Fed. Cir. 1990).

Nevertheless, we preliminarily determined that using the handheld device's cellular phone in place of the relay box's would have been no more than a predictable, and obvious, rearrangement of old elements. *Id.* at 11–12; *see also KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 417 (2007). Patent Owner challenges this determination.

a. Walter is not "fundamentally different" from the claimed invention

Patent Owner contends that Walter, a vehicle interlock system, is "fundamentally different" from the claimed invention, which Patent Owner characterizes as a device for monitoring abstinence. PO Resp. 9–10, 13. The '573 patent "relates generally to a method and system for remote sobriety monitoring." Ex. 1002, col. 1, ll. 15–16. One of the goals of the invention is "to help ensure abstinence of the user from the use of alcohol or another substance." *Id.* at col. 1, ll. 23–24. The claims, however, do not

recite promoting abstinence. Nor has Patent Owner shown persuasively that the specification limits the claims to devices that monitor abstinence. Indeed, the '573 patent describes and claims an embodiment in which “a mobile breath-testing module 210 and user identification device 220 may also be included in a vehicle ignition interlock signal generating system 200.” *Id.* at col. 9, ll. 16–18; Fig. 9; *see also* claim 20 (“further comprising: a vehicle interlock device”). Thus, we are not persuaded that the claims are limited to devices that promote or monitor abstinence or that the claims are fundamentally different from the vehicle interlock system described in Walter.

Patent Owner further argues that incorporating the function of transmitting BAC and image data to a service provider into Walter's handheld device fundamentally would transform Walter's system by “untethering” the handheld device from the relay box. PO Resp. 20–21. According to Patent Owner, such a modification “would convert the Walter interlock to a . . . breathalyzer-based remote sobriety monitoring system to help ensure abstinence.” PO Resp. 34. We disagree. Walter describes its handheld device as including a cellular phone. Ex. 1003, col. 6, ll. 41–45. The issue is whether it would have been obvious to use that cellular phone, rather than the phone in the relay box, to transmit the BAC and image data collected by the handheld device to a service provider. Using the handheld device's cellular phone to transmit test data to a receiving station does not mean that the handheld device also would have ceased transmitting the test data to the relay box for the purpose of operating the vehicle interlock.

b. Petitioner does not teach away from the claimed invention

Patent Owner introduces press releases and marketing presentations made by Petitioner that Patent Owner contends shows Petitioner's skepticism and criticism of using breath testing for alcohol monitoring. PO Resp. 4, 15–16 (citing Exs. 2003, 2009, 2010, 2011). Petitioner's marketing materials describe a transdermal monitoring product, such as an ankle bracelet, that tests, at 30 minute intervals, for alcohol evaporating through the skin. Ex. 2003, slide 17. The marketing materials also state that, because alcohol metabolizes quickly, using breath alcohol test devices to test offenders randomly could fail to detect many drinking events. *Id.* at slide 12. Patent Owner argues that Petitioner's statements repeatedly criticized and discouraged the use of breath alcohol test devices such as those claimed in the '573 patent. PO Resp. 21–22. According to Patent Owner, Petitioner taught away from modifications to Walter that would have converted Walter's system into a breath alcohol test device-based remote sobriety monitoring system to help ensure abstinence. *Id.* at 34.

Petitioner replies that its marketing materials were presented in a high-risk criminal justice setting, in which people with motivation to avoid detection are monitored involuntarily. Reply 2. According to Petitioner, its statements do not reflect upon the efficacy of monitoring using breath alcohol test devices in other contexts. *Id.* at 2.

As the United States Court of Appeals for the Federal Circuit has counseled:

[a] reference may be said to teach away when a person of ordinary skill, upon reading the reference, would be discouraged from following the path set out in the reference, or

would be led in a direction divergent from the path that was taken by the applicant [I]n general, a reference will teach away if it suggests that the line of development flowing from the reference's disclosure is unlikely to be productive of the result sought by the applicant.

In re Gurley, 27 F.3d 551, 553 (Fed. Cir. 1994). Likewise, the prior art may teach away when it indicates “that the invention would not have worked for its intended purpose.” *DuPuy Spine, Inc. v. Medtronic Sofamor Danek, Inc.*, 567 F.3d 1314, 1326 (Fed. Cir. 2009).

Patent Owner has not explained persuasively how Petitioner's marketing materials would have discouraged a skilled artisan from modifying Walter or would have suggested that such a modification would not have worked. As explained above, Walter describes cellular phones in both the relay box and the handheld device, with the relay box's cellular phone performing the claimed functionality. Given that the remaining limitations of claim 1 are taught by Walter, the only issue is whether it would have been obvious to use the handheld device's cellular phone, rather than the phone in the relay box, to transmit BAC and image data to a receiving station. Whether transdermal monitoring is more effective than breath alcohol monitoring is inapposite to this question. We also are persuaded that Walter's handheld device would have worked for transmitting BAC and image data to a receiving station and Petitioner's marketing materials, in light of Patent Owner's arguments, do not suggest otherwise. Thus, we are not persuaded that Petitioner's marketing materials would have taught away from the claimed invention.

c. The Level of Ordinary Skill in the Art

“[T]o establish a *prima facie* case of obviousness based on a combination of elements disclosed in the prior art, the Board must articulate the basis on which it concludes that it would have been obvious to make the claimed invention. . . . This entails consideration of both the ‘scope and content of the prior art’ and ‘level of ordinary skill in the pertinent art’ aspects of the [*Graham v. John Deere Co.*, 383 U.S. 1, 17–18 (1966)] test.” *In re Kahn*, 441 F.3d 977, 986 (Fed. Cir. 2006) (internal citations omitted). “Factors that may be considered in determining level of skill include: type of problems encountered in art; prior art solutions to those problems; rapidity with which innovations are made; sophistication of the technology; and educational level of active workers in the field.” *Mintz v. Dietz & Watson, Inc.*, 679 F.3d 1372, 1376 (Fed. Cir. 2012) (quoting *Custom Accessories, Inc. v. Jeffrey-Allan Indus., Inc.*, 807 F.2d 955, 962 (Fed. Cir. 1986)) (internal quotation marks omitted).

Patent Owner argues that Petitioner offered no evidence of the level of ordinary skill in the Petition and that this failure, by itself, warrants denial of the Petition. PO Resp. 29, 35. Patent Owner further contends that the pertinent art is “sobriety monitoring for the purpose of promoting and ensuring alcohol abstinence.” PO Resp. 28–29 (emphasis omitted). According to Patent Owner, a person of ordinary skill in the art would have had two to five years of experience in blood, breath, and transdermal alcohol monitoring, including a working understanding of related devices and methodologies, and would have had an understanding of behavior patterns of individuals suffering from alcohol addiction. PO Resp. 29–30. Patent Owner relies on the testimony of its declarant, Dr. Gregory Skipper, M.D.,

to establish the level of ordinary skill. *Id.* (citing Ex. 2200 ¶ 14).

Dr. Skipper, however, does not explain the bases for his opinion or what he considered in reaching his conclusions. Ex. 2200 ¶¶ 13–16.

At oral hearing, Petitioner acknowledged that the Petition did not state the level of ordinary skill in the art. Tr. 10:17–11:7. Nevertheless, Petitioner argues that it was not required to propose a specific finding because the prior art itself reflected the level of skill in the art. *Id.* (citing *Litton Indus. Products, Inc. v. Solid State Sys. Corp.*, 755 F.2d 158, 163–64 (Fed. Cir. 1985) (“A specific finding on the level of skill in the art is not, however, required where the prior art itself reflects an appropriate level and a need for testimony is not shown.”)). In particular, Petitioner argues that Walter teaches that a skilled artisan would have known to put a cellular phone, a blood alcohol monitor, and a camera in a single housing. Tr. 11:8–11.

Petitioner further argues, in the Reply, that nothing in the claims of the ’573 patent or the prior art supports limiting the pertinent art to promoting abstinence. Reply 3 n.2. Further, the parties each accuse the other’s declarant of lacking ordinary skill in the relevant art, with Patent Owner contending that Petitioner’s declarant, an engineer, lacks an understanding of the behavioral aspect of alcohol monitoring (PO Resp. 30–33) and Petitioner contending that Patent Owner’s declarant, a physician, lacks an understanding of the technical aspects of alcohol monitoring devices (Reply 14).

We agree with Petitioner that Walter itself reflects an appropriate level of skill in the art of electronics design. As explained above, neither the claims nor the description of the ’573 patent are limited to monitoring for or

promoting abstinence. Rather, the claims are directed to specific devices for monitoring and transmitting BAC. Walter teaches a specific vehicle interlock device for alcohol monitoring. As we have explained, Walter teaches each of the components of claims 1–3 and 9, just not arranged as in those claims. We are not persuaded that a physician’s knowledge of the behavior of alcoholics would have been required to evaluate whether the phone in Walter’s handheld device could have been used to transmit BAC and image data. Rather, given what already is disclosed in Walter, the issue is whether an engineer designing a specific alcohol monitoring device would have known to use the phone in the handheld device. We also agree with Petitioner that this level of skill would have been evident from Walter itself. Thus, we are not persuaded that Petitioner’s failure to state explicitly a level of skill in the Petition warrants denial of the Petition.

d. Objective Indicia Do Not Evidence Non-Obviousness

Patent Owner contends that several objective indicia show non-obviousness. In evaluating whether an invention would have been obvious, “[s]uch secondary considerations as commercial success, long felt but unsolved needs, failure of others, etc., might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented.” *Graham*, 381 U.S. at 17–18. It is Patent Owner’s burden to introduce evidence supporting such objective indicia. *See In re Huang*, 100 F.3d 135, 139 (Fed. Cir. 1996); *In re Applied Materials, Inc.*, 692 F.3d 1289, 1299 (Fed. Cir. 2012). To be clear, the ultimate burden of persuasion never shifts to Patent Owner. *See* 35 U.S.C. 316(e). Moreover, objective indicia should be considered along with all of the other evidence in making an

obviousness determination. *In re Cyclobenzaprine Hydrochloride Extended-Release Capsule Patent Litigation*, 676 F.3d 1063, 1076–77 (Fed. Cir. 2012) (“It is to be considered as part of all the evidence, not just when the decision maker remains in doubt after reviewing the art.”) (citing *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 1538–39 (Fed. Cir. 1983)).

“For objective evidence to be accorded substantial weight, its proponent must establish a nexus between the evidence and the merits of the claimed invention.” *In re GPAC Inc.*, 57 F.3d 1573, 1580 (Fed. Cir. 1995). In particular, the objective indicia “must be tied to the novel elements of the claim at issue” and must “be reasonably commensurate with the scope of the claims.” *Institut Pasteur & Universite Pierre Et Marie Curie v. Focarino*, 738 F.3d 1337, 1347 (Fed. Cir. 2013) (quoting *Rambus Inc. v. Rea*, 731 F.3d 1248, 1257 (Fed. Cir. 2013)).

(1) Copying

Patent Owner alleges that in 2011, around the time the application for the '573 patent was published, Petitioner and Patent Owner engaged in discussions to collaborate on a “pilot program.” PO Resp. 27. According to Patent Owner, it shared a sample of its commercial product with Petitioner. *Id.* Patent Owner argues that the collaboration never materialized and that, in 2013, Petitioner came out with its own competing product that included the same features as the claims of the '573 patent. *Id.* Patent Owner relies on the declaration of Brad Keays, the named inventor on the '573 patent, to show copying. See Ex. 2100 ¶¶ 4–5. According to Mr. Keays, at the time Petitioner released its competing product, Petitioner demanded that Patent

Owner license the '573 patent for \$1,000 and agree not to reference the patent in advertisements. *Id.* at 5.

Petitioner replies that a showing of copying requires a showing of replication, and that Patent Owner has not shown that Petitioner replicated any of Patent Owner's products. Reply 11. Petitioner further contends that none of the components of its product are the same as those of any Patent Owner product. *Id.* at 9.

According to the Federal Circuit,

copying requires evidence of efforts to replicate a specific product, which may be demonstrated through internal company documents, direct evidence such as disassembling a patented prototype, photographing its features, and using the photograph as a blueprint to build a replica, or access to the patented product combined with substantial similarity to the patented product.

Wyers v. Master Lock Co., 616 F.3d 1231, 1246 (Fed. Cir. 2010). While Patent Owner alleges that Petitioner had access to its product, Patent Owner has not introduced credible evidence to show that its product was replicated or that Petitioner's competing product was substantially similar to the patented product. Patent Owner simply alleges that "the newly released AMS breathalyzer based remote monitoring system has all the same features as found in the '573 patent." PO Resp. 27 (citing Ex. 2004, Petitioner's marketing brochure). Simply alleging that a competing product has the same general features as a patented product, however, is insufficient to show replication of or substantial similarity to the patented product.

Petitioner also argues that there were two versions of Patent Owner's product, the product it actually inspected in 2011 was not covered by the claims of the '573 patent and, thus, there is no nexus between any alleged

copying of the patented invention. Reply 8–11. In any case, the evidence of record is insufficient to show that any particular version of Patent Owner’s device practices the invention of the ’573 patent. Patent Owner (PO Resp. 26–27) cites only to the Keays Declaration (Ex. 2100 ¶ 3), which refers to an exhibit containing a single image and minimal textual description of a Patent Owner product. Patent Owner’s declarant, Dr. Skipper, testifies regarding the “Soberlink monitoring system claimed in the ’573 patent . . . ,” but does not state whether this testimony is applicable to any particular version of Patent Owner’s device. Ex. 2200 ¶¶ 26–28. None of the evidence introduced by Patent Owner shows the details of its commercial products or their relationship to the claims of the ’573 patent. Accordingly, Patent Owner has not shown a nexus between its objective indicia of copying and the claims of the ’573 patent.

Because the evidence of record is insufficient to show that Petitioner’s product is a replication of, or substantially similar to Patent Owner’s products, or that Patent Owner’s products are commercial embodiments of the ’573 patent claims, we are not persuaded that objective indicia of copying shows non-obviousness of the challenged claims.

(2) Long-felt yet unresolved need

“Evidence that an invention satisfied a long-felt and unmet need that existed on the patent’s filing date is a secondary consideration of nonobviousness.” *Perfect Web Techs., Inc. v. InfoUSA, Inc.*, 587 F.3d 1324, 1332 (Fed. Cir. 2009). To show a long-felt need, Patent Owner must introduce evidence to show when such a need first arose and how long this

need was felt, and must introduce evidence to show that this need was met by the patented invention. *Id.*

Patent Owner contends that prior art alcohol monitoring techniques such as ankle bracelets (e.g., described in Hawthorne) were invasive, uncomfortable, and costly; that vehicle interlock systems (e.g., described in Walter) only addressed drunk driving and not abstinence; and that non-portable breath alcohol test devices (e.g., the kiosk described in Williams) also did not monitor abstinence. PO Resp. 24 (citing Ex. 2200 ¶¶ 17–25, 31). Patent Owner argues that Mr. Keays recognized that the portable breath alcohol test device he invented could eliminate these purported deficiencies. PO Resp. 25 (citing Ex. 2200 ¶¶ 26–28). Against this backdrop, Patent Owner’s declarant, Dr. Skipper, testifies that “[t]here was an entire segment of the population whose needs were not met—e.g., those voluntarily recovering from alcohol abuse and dependence.” Ex. 2200 ¶ 24. Dr. Skipper also states that “[d]espite the availability of inexpensive handheld breathalyzer units that were not set up with remote monitoring functionality, prior to the invention, no one had come out with a product that crossed the boundaries between handheld breathalyzers and transdermal remote monitoring.” *Id.* ¶ 25.

We are not persuaded that the evidence of record supports a finding that there was a recognized need for the invention, or that it shows when such a need arose, or what, if anything, skilled artisans were doing to address that need. Merely stating that the prior art had deficiencies is not enough to show a long-felt need. Rather, “long-felt need is analyzed as of the date of an articulated identified problem and evidence of efforts to solve that problem.” *Tex. Instruments v. Int’l Trade Comm’n*, 988 F.2d 1165,

1178 (Fed. Cir. 1993). Accordingly, we are not persuaded that objective indicia of a long-felt need shows non-obviousness.

(3) Commercial success

“When a patentee can demonstrate commercial success, usually shown by significant sales in a relevant market, and that the successful product is the invention disclosed and claimed in the patent, it is presumed that the commercial success is due to the patented invention.” *J.T. Eaton & Co. v. Atl. Paste & Glue Co.*, 106 F.3d 1563, 1571 (Fed. Cir. 1997).

Patent Owner argues that its products have been “accepted by more than 200 courts in all 50 states,” are in use in over 50 treatment facilities, promote sobriety in 15 state run professional health programs, and have monitored over 15,000 subjects and conducted over 10 million remote alcohol monitoring tests. PO Resp. 25 (citing Ex. 2100 ¶ 7). Patent Owner contends that this evidences commercial success of the claimed invention. PO Resp. 26.

Petitioner argues that Patent Owner has failed to establish that its evidence shows significant sales in the market. Reply 11 n.11. We agree with Petitioner. According to the Federal Circuit, “the more probative evidence of commercial success relates to whether the sales represent ‘a substantial quantity in th[e] market.’” *In re Applied Materials, Inc.*, 692 F.3d 1289, 1300 (Fed. Cir. 2012) (quoting *In re Huang*, 100 F.3d 135, 140 (Fed. Cir. 1996)). The Federal Circuit has noted “that evidence related solely to the number of units sold provides a very weak showing of commercial success, if any.” *Huang*, 100 F.3d at 140. Patent Owner offers no evidence of the size of the market to which to compare its purported

sales. Patent Owner, citing its declarants Dr. Skipper and Mr. Keays, contends that its invention “created a new market.” PO Resp. 14 (citing Ex. 2200 ¶¶ 27–30; Ex. 2100 ¶¶ 6–7). Aside from listing the benefits of the invention, however, neither Patent Owner nor its declarants give any details regarding this purported new market. *Id.* Moreover, beyond the testimony of Mr. Keays, which largely repeats the arguments in the Patent Owner Response, Patent Owner offers no credible evidence to support its statements regarding its sales. Tr. 45:11–18. Thus, the evidence of record does not support a finding of commercial success.

Petitioner further argues that Patent Owner has not shown a nexus between its purported commercial success and the claimed invention. Reply 10–11. We agree. As we explain above, the evidence of record does not show whether any particular version of its device practices the claims of the ’573 patent. The most Patent Owner points to is a statement by Mr. Keays that “[t]he commercial success of the Soberlink system is a direct result of the patented features which permit users freedom and flexibility—as well as immediate accountability—while being monitored for alcohol consumption in accordance with a sober plan.” Ex. 2100 ¶ 10. Mr. Keays, however, provides no details from which we could find that any patent owner product practices the patented invention. Accordingly, we are not persuaded that objective indicia of commercial success shows non-obviousness.

(4) Praise

Industry praise also may evidence non-obviousness, so long as it is linked to the patented invention. *See Geo. M. Martin Co. v. Alliance Mach. Sys. Int'l LLC*, 618 F.3d 1294, 1305 (Fed. Cir. 2010).

Patent Owner contends that it has “been the subject of extensive community praise.” PO Resp. 25. Patent Owner, citing the testimony of Mr. Keys, reproduces “two examples of the types of laudatory feedback” it receives from users. *Id.* (citing Ex. 2100 ¶ 9). Neither example provides any details as to which Patent Owner products, nor which features of such products, were the subject of the praise. Patent Owner acknowledged at the hearing that the record does not show the particular product to which the praise was referring. Tr. 47:5–12. Moreover, as we explain above, the evidence of record does not show that any Patent Owner product practices the claims of the ’573 patent. Thus, Patent Owner has not shown a nexus between the industry praise and the claimed invention. Accordingly, we are not persuaded that objective indicia of industry praise shows non-obviousness.

e. Conclusion

As explained above, Walter describes cellular phones in both the relay box and the handheld device, with the cellular phone in the relay box being used to transmit BAC and image data to a receiving station. Petitioner has persuaded us that it would have been simple and predictable for a person of ordinary skill in the art to use the cellular phone in Walter’s handheld device, rather than the relay box, to transmit the BAC and image data to a receiving station. We have weighed Petitioner’s evidence against the

objective evidence presented by Patent Owner. We consider that objective evidence unpersuasive for the reasons given above. In sum, upon consideration of all the evidence, including the evidence in the Petition and Patent Owner's objective indicia of non-obviousness, we conclude that Petitioner has proved by a preponderance of the evidence that claims 1–3 and 9 would have been obvious over Walter.

2. Obviousness over Walter and Hawthorne

Claim 4 depends from claim 1 and adds “wherein the transceiver wirelessly transmits the breath alcohol content of the user and the image-related data to a server supported website.” Claim 10 depends from claim 9 and similarly adds “wherein the transceiver wirelessly transmits the breath alcohol content of the user, the image-related data, and the user location to a server supported website.” Petitioner contends that Hawthorne teaches an alcohol monitoring device that wirelessly transmits alcohol readings to a web-hosted database server at a monitor network, and that combining Hawthorne's teaching with Walter's would have been nothing more than combining prior art elements according to known methods to yield predictable results. Pet. 15–16, 19–20 (citing Ex. 1006 ¶¶ 33, 34, 36).

Hawthorne is directed to a transdermal alcohol concentration (“TAC”) monitoring device that uploads alcohol content information to a central monitoring station. Ex. 1006, Abstract. The TAC monitoring device measures blood alcohol concentration in perspiration, Ex. 1006 ¶ 05, and uploads the blood alcohol data to a modem, *id.* ¶ 33, which transmits the data to a web-hosted database server at a monitor network, *id.* ¶ 34. Hawthorne's monitor network analyzes and groups the data. *Id.* The data

then can be accessed by monitoring personnel using websites through the Internet. *Id.* Supervisory agency personnel can include law enforcement, for example, if the person wearing the TAC monitoring device is on parole or probation. *Id.* ¶ 36. Thus, Hawthorne teaches that alcohol consumption information can be transmitted to a server supported website to make it available to interested parties, such as law enforcement.

Claim 5 depends from claim 4; claim 11 depends from claim 10. Each of claims 5 and 11 recite “wherein the website is a monitored internet website.” Petitioner cites to Hawthorne’s description of monitoring personnel accessing alcohol content information through websites as teaching this limitation. Pet. 17–18, 20–21.

Patent Owner confirmed at the hearing that it does not contest that Hawthorne teaches a server-supported website and, more particularly, a monitored internet website. Tr. 37:8–10. Rather, Patent Owner contends that a skilled artisan would not have combined Walter and Hawthorne. PO Resp. 35–36. Specifically, Patent Owner reiterates its argument that a skilled artisan would not have converted Walter’s vehicle interlock system into a breath alcohol test device-based remote sobriety and abstinence monitoring system. PO Resp. 35. For the reasons given in Section II.C.1.a, we are not persuaded by this argument.

Patent Owner also contends that Hawthorne teaches away from being combined with a breath alcohol test device. PO Resp. 35. As explained above, Hawthorne describes a transdermal alcohol monitoring system (e.g., an ankle bracelet). According to Hawthorne:

There are numerous advantages to transdermal monitoring, as opposed to breath alcohol testing, including, but not limited to,

the ability to take readings at any time without the knowledge of the subject, consistent and continuous testing (unlike breath alcohol testing where a subject breathing incorrectly into the testing device can cause inaccurate results), and the ability to convert such readings into electrical signals that can be transmitted to a central monitoring station.

Ex. 1006 ¶ 6. Patent Owner argues that this statement in Hawthorne amounts to a disparagement of using breath alcohol test devices to monitor sobriety remotely rather than merely a statement of the advantages of using a transdermal device. PO Resp. 35; Tr. 38:16–39:10.

We disagree with Patent Owner and view this statement in Hawthorne as a statement of the advantages of transdermal monitoring rather than a disparagement of monitoring using breath alcohol test devices. Thus, we are not persuaded that Hawthorne teaches away from a combination of its monitored internet website with Walter’s vehicle interlock system. *See In re Mouttet*, 686 F.3d 1322, 1334 (Fed. Cir. 2012) (“This court has further explained that just because better alternatives exist in the prior art does not mean that an inferior combination is inapt for obviousness purposes.”). In particular, we are not persuaded that Hawthorne discourages such a combination or suggests that it would be unlikely to work. *See id.*; *Gurley*, 27 F.3d at 553. *See also Medichem, S.A. v. Rolabo, S.L.*, 437 F.3d 1157, 1165 (Fed. Cir. 2006) (“[A] given course of action often has simultaneous advantages and disadvantages, and this does not necessarily obviate motivation to combine.”).

As we explained in the Decision to Institute, Walter teaches transmitting BAC data to a service provider, which contacts law enforcement when a driver fails a breath test. Dec. 13 (citing Ex. 1003,

col. 11, ll. 65–67, col. 15, ll. 43–54). However, Walter is not specific as to how the information is conveyed to law enforcement. Dec. 13. Hawthorne similarly describes transmitting BAC data from a service provider to a supervisory authority and is specific as to the use of a monitored Internet website. *Id.* Although Hawthorne and Walter describe different techniques for collecting BAC data, we nevertheless are persuaded that Hawthorne’s teaching of the distribution of data, once collected, could have been applied predictably to Walter’s BAC and image data and would have operated in the same manner on Walter’s data.

Patent Owner further reiterates its arguments that objective indicia show non-obviousness. PO Resp. 36. For the reasons given in Section II.C.1.c, we are not persuaded by this argument.

Patent Owner also reiterates its argument that the Petition should be denied for Petitioner’s failure to articulate the level of ordinary skill in the art. PO Resp. 36. For the reasons given in Section II.C.1.d, we are not persuaded by this argument. The references themselves show the level of ordinary skill in the art. We are not persuaded that a physician’s knowledge would have been necessary to recognize that Williams’s more detailed teaching of data distribution could have been applied predictably to the data distribution technique described in Walter.

Petitioner has persuaded us that, in light of the noted similarities between Walter and Hawthorne, it would have been obvious to improve Walter’s system through the predictable use of Hawthorne’s server-supported website. We have weighed Petitioner’s evidence against the objective evidence presented by Patent Owner. We consider that objective evidence unpersuasive for the reasons given above. In sum, upon

consideration of all the evidence, including the evidence in the Petition and Patent Owner's objective indicia of non-obviousness, Petitioner has shown by a preponderance of the evidence that claims 4, 5, 10, and 11 would have been obvious over Walter and Hawthorne.

3. Obviousness over Walter and Williams

Petitioner contends that Walter and Williams render obvious claims 15–17 and 21. Pet. 21–28.

Independent claim 15 claims a system that comprises a portable, cordless handheld BAC testing device, similar to that recited in claim 1, and additionally recites “a server coupled to a public network, the server supporting a website configured to display an image of a user in connection with a breath alcohol content of the user.” For the limitations that overlap with claim 1, Petitioner cites the evidence cited for claim 1. Pet. 23–25. We agree that these limitations are taught in Walter for the reasons given in Section II.C.1.

Williams describes a self-service breath alcohol test kiosk system for collecting BAC information and reporting it over a communication network. Ex. 1011, Abstract. Williams's kiosk includes a digital camera for taking pictures while a user is providing a breath sample. *Id.* ¶¶ 30, 53. The image and BAC information are transmitted from the kiosk to a central server through a communication link. *Id.* ¶¶ 32, 41, 53. Williams also describes administrator and officer interfaces for accessing the central server using internet browsers. *Id.* ¶¶ 16, 42, 44. Petitioner contends that Williams teaches the server limitation of claim 15 and that combining Walter and

Williams would have been nothing more than combining prior art elements according to known methods to yield predictable results. Pet. 22–23.

Patent Owner argues that Williams, which describes a kiosk, is “fundamentally different” from hand-held breath alcohol test devices because the user of a kiosk is “tethered” to the kiosk locations and must adapt his or her life to those locations. PO Resp. 10–11. According to Patent Owner, Williams does not lend itself to a combination that would produce a portable, hand-held breath alcohol test system. *Id.* at 37.

Petitioner replies that Patent Owner improperly attacks the references individually rather than considering the teachings of the combination. Reply 13 (citing *In re Merck & Co.*, 800 F.2d 1091 (Fed. Cir. 1986)). We agree with Petitioner. Petitioner cites Williams for its distribution of BAC and image data after that data is captured. Pet. 23. We agree with Petitioner that Williams’ technique would have been equally applicable to Walter’s BAC and image data, once captured, and that Williams’s server and website would have operated in the same predictable manner regardless of how the BAC and image data were captured.

Patent Owner further reiterates its arguments that objective indicia show non-obviousness. PO Resp. 37. For the reasons given in Section II.C.1.c, we are not persuaded by this argument.

Patent Owner also reiterates its argument that the Petition should be denied for Petitioner’s failure to articulate the level of ordinary skill in the art. PO Resp. 38. For the reasons given in Section II.C.1.d, we are not persuaded by this argument. The references themselves show the level of ordinary skill in the art. We are not persuaded that a physician’s knowledge would have been necessary to recognize that Hawthorne’s more detailed

teaching of data distribution could have been applied predictably to the data distribution technique described in Walter.

We have weighed Petitioner's evidence against the objective evidence presented by Patent Owner. We consider that objective evidence unpersuasive for the reasons given above. In sum, upon consideration of all the evidence, including the evidence in the Petition and Patent Owner's objective indicia of non-obviousness, Petitioner has proved by a preponderance of the evidence that claim 15 would have been obvious over Walter and Williams. Claims 16, 17, and 21 depend from claim 15. Having reviewed Petitioner's evidence of unpatentability for these dependent claims, and weighed it against Patent Owner's objective evidence, we conclude that Petitioner also has proved by a preponderance of the evidence that claims 16, 17, and 21 would have been obvious over Walter and Williams.

4. Obviousness over Walter, Williams, and Hawthorne

Claim 22 depends from claim 15 and adds "wherein the website is a monitored internet website." Petitioner cites Hawthorne as teaching this limitation for the reasons given for claims 4 and 5. Pet. 29.

For the reasons given for claims 4 and 5, we are persuaded that Walter, Williams, and Hawthorne teach this limitation and that a person of ordinary skill in the art would have sought to combine Hawthorne's teaching with that of Walter and Williams.

Patent Owner reiterates its arguments regarding the combinations of Walter with Hawthorne and Walter with Williams, both discussed above. PO Resp. 38. Patent Owner also reiterates its arguments that objective indicia evidence non-obviousness and that the Petition should be denied

because of Petitioner's failure to articulate the level of ordinary skill in the art. PO Resp. 38–39. For the reasons given above, we are not persuaded by these arguments.

For the reasons given for claims 4, 5, and 15 above, we are persuaded that a combination of Walter, Hawthorne, and Williams, resulting in claim 22, would have been no more than the predictable use of known components for their intended purposes. We have weighed Petitioner's evidence against the objective evidence presented by Patent Owner. We consider that objective evidence unpersuasive for the reasons given above. In sum, upon consideration of all the evidence, including the evidence in the Petition and Patent Owner's objective indicia of non-obviousness, Petitioner has shown by a preponderance of the evidence that claim 22 would have been obvious over Walter, Hawthorne, and Williams.

III. CONCLUSION

Petitioner has demonstrated by a preponderance of the evidence that claims 1–5, 9–11, 15–17, 21, and 22 are unpatentable based on the following grounds of unpatentability:

- (1) Claims 1–3 and 9 under 35 U.S.C. § 103(a) as obvious over Walter;
- (2) Claims 4, 5, 10, and 11 under 35 U.S.C. § 103(a) as obvious over Walter and Hawthorne;
- (3) Claims 15–17 and 21 under 35 U.S.C. § 103(a) as obvious over Walter and Williams; and

(4) Claim 22 under 35 U.S.C. § 103(a) as obvious over Walter, Williams, and Hawthorne.

IV. ORDER

For the reasons given, it is

ORDERED that, based on a preponderance of the evidence, claims 1–5, 9–11, 15–17, 21, and 22 of U.S. Patent No. 8,381,573 B2 are held unpatentable;

FURTHER ORDERED that Patent Owner’s Motion to Exclude is denied; and

FURTHER ORDERED that, because this is a final written decision, parties to this proceeding seeking judicial review of our Decision must comply with the notice and service requirements of 37 C.F.R. § 90.2.

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