

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ALCOHOL MONITORING SYSTEMS, INC.,
Petitioner,

v.

SOBERLINK, INC.,
Patent Owner.

Case IPR2015-00556
Patent 8,381,573 B2

Before KALYAN K. DESHPANDE, DAVID C. McKONE, and
MIRIAM L. QUINN, *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 2, “Pet.”) to institute *inter partes* review of claims 1–22 of U.S. Patent No. 8,381,573 B2 (Ex. 1102, “the ’573 patent”). Soberlink, Inc. (“Patent Owner”) filed a Waiver of Preliminary Response (Paper 6). Pursuant to 35 U.S.C. § 314, in our Decision to Institute (Paper 7, “Dec.”), we instituted this proceeding as to claims 6–8, 12–14, and 18–20.

Patent Owner did not file a Patent Owner Response. Rather, Patent Owner filed a Motion to Amend (Paper 13, “Mot.”), requesting that we cancel claims 6–8, 12–14, and 18–20 and replace them with substitute claims 23–28. Petitioner filed an Opposition to Patent Owner’s Motion to Amend (Paper 14, “Opp.”), and Patent Owner filed a Reply to Petitioner’s Opposition to Patent Owner’s Motion to Amend (Paper 18, “Reply”). An oral hearing was held on February 25, 2016 (Paper 27, “Tr.”).

We have jurisdiction under 35 U.S.C. § 6(c). This decision is a final written decision under 35 U.S.C. § 318(a) as to the patentability of claims 6–8, 12–14, 18–20, and new claims 23–28 added under 35 U.S.C. § 316(d). We grant Patent Owner’s request to cancel claims 6–8, 12–14, and 18–20. Based on the record before us, Patent Owner has not demonstrated that it is entitled to an amendment adding substitute claims 23–28.

B. Related Matters

The ’573 patent was the subject of *Alcohol Monitoring Systems, Inc. v. Soberlink, Inc.*, IPR2013-00577 (“IPR-577”).

In IPR-577, in a Final Written Decision (“IPR-577 FWD”) issued under 35 U.S.C. § 318(a), the panel held that claims 1–5, 9–11, 15–17, 21, and 22 are unpatentable. IPR-577 FWD, 35. In the Decision, at 7, we determined that, under 35 U.S.C. § 315(e)(1), Petitioner was estopped from maintaining this proceeding as to claims 1–5, 9–11, 15–17, 21, and 22.

C. References Relied Upon

In the Petition, Motion, and Opposition, the parties discuss the following references:

Ex. 1103	Ku	US 2006/0009257 A1	Jan. 12, 2006
Ex. 1105	Williams	WO 2008/076310 A1	June 26, 2008
Ex. 1106	Freund	US 2009/0293589 A1	Dec. 3, 2009
Ex. 1122	Hyde	US 2009/0060287 A1	Mar. 5, 2009
Ex. 1125	Walter	US 7,934,577 B2	May 3, 2011
Ex. 1132	LG Breathalyzer	Mike Hanlon, <i>The LG Breathalyzer Phone</i> (July 7, 2006), http://www.gizmag.com/go/5841/ (last visited Nov. 15, 2014)	
Ex. 1133	iBreath	CNET Staff, <i>iBreath: the iPhone Breathalyzer</i> (Dec. 15, 2008), http://www.cnet.com/news/ibreath-the-iphone-breathalyzer/ (last visited June 2, 2014)	
Ex. 1141	MEMS	<i>MEMS 2000 HomeStation, Diamond Series VBR</i> (archived Mar. 9, 2002), https://web.archive.org/web/20020309100655/http://tsc.trackingsystems.com/mem4.htm	
Ex. 1168	Zimmermann	US 2010/0314190 A1	Dec. 16, 2010

Patent Owner also relies on the testimony of Adi Jaffe, Ph.D (Ex. 2000, “Jaffe Decl.”; Ex. 2002, “Jaffe Reply Decl.”). Petitioner relies on the testimony of Mark Wojcik (Ex. 1124, “Wojcik Decl.”; Ex. 1169, “Wojcik 2nd Decl.”).

II. ANALYSIS

Patent Owner’s proposed amendment is not entered automatically, but only upon Patent Owner’s having demonstrated the patentability of the substitute claims. As the moving party, Patent Owner bears the burden of proof to establish that it is entitled to the relief requested. *See* 37 C.F.R. § 42.20(c).

The amendment must respond to a ground of unpatentability involved in the trial and must not seek to enlarge the scope of the claims or introduce new subject matter. *See* 37 C.F.R. § 42.121(a)(2). As we have stated, “[f]or a patent owner’s motion to amend, 37 C.F.R. § 42.20(c) places the burden on the patent owner to show a patentable distinction of each proposed substitute claim over the prior art.” *Idle Free Sys., Inc. v. Bergstrom, Inc.*, Case IPR2012-00027, slip op. at 7 (PTAB June 11, 2013) (Paper 26). Such prior art may include:

- a. any material art in the prosecution history of the patent;
- b. any material art of record in the current proceeding, including art asserted in grounds on which the Board did not institute review; and
- c. any material art of record in any other proceeding before the Office involving the patent.

MasterImage 3D, Inc. v. RealD Inc., Case IPR2015-00040, slip op. at 2 (PTAB July 15, 2015) (Paper 42).

A. The '573 Patent

The '573 patent generally relates to remote sobriety monitoring using a breath testing and identification device. Ex. 1102, 1:15–24. 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 4:43–50. Figure 3 of the '573 patent is reproduced below:

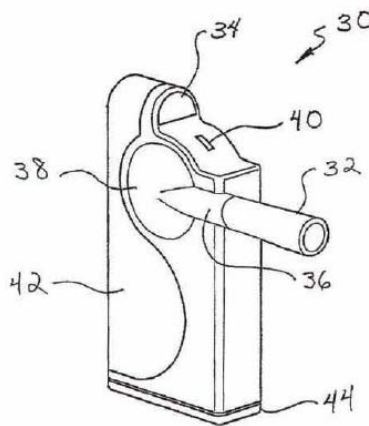


FIG. 3

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 6:39–47. 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 6:47–53. 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 7:50–67. The wireless transmitter can be a

hardware component internal to the breath testing device. *Id.* at 5:1–6. 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 8:1–6. 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 8:34–38.

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

B. Cancellation of claims 6–8, 12–14, and 18–20

During an *inter partes* review, Patent Owner may file a motion to amend the patent to “[c]ancel any challenged patent claim.” 35 U.S.C. § 316(d)(1)(A). Patent Owner’s Motion requests that we cancel claims 6–8, 12–14, and 18–20. Mot. 1. Patent Owner did not file a Patent Owner Response to the Petition. We grant Patent Owner’s request to cancel claims 6–8, 12–14, and 18–20.

C. The Substitute Claims

Patent Owner proposes the following claim substitutions:

claim 23 for claims 1 and 6;

claim 24 for claim 7;

claim 25 for claim 8; and

claim 27 for claims 15 and 19;

Mot. Appx. A. Additionally, Patent Owner proposes adding claims 26 and 28, but indicates that these proposed substitutions do not correspond to any original claim. *Id.*

Petitioner argued that the claims submitted with the Motion impermissibly broadened the claims in some respects. Opp. 11–16. For example, in amending “breath alcohol content” to “breath alcohol content information,” Petitioner argued, claims 23 and 27 are broader in that “information” regarding breath alcohol content could include more than simply the numerical value of the breath alcohol content. *Id.* at 14–15.

Patent Owner disagreed that such amendments were broadening, but provided no substantive argument or evidence other than its statement of disagreement. Reply 6. Given the lack of argument and evidence and that Patent Owner bears the burden in its Motion, we find Patent Owner’s simple disagreement insufficient to show that the original Motion to Amend does not broaden the claims. Thus, the original Motion to amend does not show this requirement of a proper amendment. *See* 35 U.S.C. § 316(d)(3).

Patent Owner, however, filed, along with its Reply, a revised set of proposed substitute claims purporting to address Petitioner’s arguments. Reply, Appendix A. By way of example, the following is a list of some of the changes to claim 6 in the Motion and subsequent changes to claim 23 in the Reply, although Petitioner cites to additional examples in claim 23 and other claims:

The language of claim 6, “positioned to capture an image of the user,” was changed to “*configured* to capture image *information* of the user,” and then changed back;

The language of claim 6, “cause the camera to capture the image of the user,” was changed to “cause the digital camera to image *information* of the first user,” and subsequently changed to “cause the digital camera to capture the image of the first user”;

The language of claim 6, “electronically receive the breath alcohol content and the image of the user,” was changed to “receive and then transmit the image *information*, alcohol content *information* and location information generated during a breath test,” and subsequently changed to “receive and then transmit the *image of the user*, the alcohol content, and the location information generated during a breath test”; and

Claim 23 added the language, “having the wireless transceiver receive, via the controller, the image *information*, alcohol content *information*, and location information generated during the breath test,” which subsequently was changed to “having the wireless transceiver receive, via the controller, the *image of the first user*, the alcohol content, and the location information generated during the breath test.”

Under 35 U.S.C. § 316(d)(1)(B), “the patent owner may file 1 motion to amend the patent” Thus, Patent Owner was authorized to file the amendments accompanying its Motion, but not those filed with its Reply.

At the oral hearing, Petitioner argued that the amendment accompanying the Reply is improper and that we should consider only the amendment submitted with Patent Owner's original Motion to Amend. Tr. 30:3–32:12. Petitioner admitted that the amendment accompanying Patent Owner's Reply simply removed areas of alleged broadening without introducing new instances of broadening. Tr. 30:17–23.¹ Nevertheless, Petitioner argues that it would have analyzed the claims further and introduced additional instances of broadening if given the chance to respond to Patent Owner's submission of an additional or second amendment. Tr. 30:24–31:8, 32:6–9. Petitioner, however, does not point to any such additional instance of broadening and, thus, does not articulate any specific prejudice that would occur if we consider the additional amendment in the Reply.

“Additional motions to amend may be permitted upon the joint request of the petitioner and the patent owner to materially advance the settlement of a proceeding under section 317, or as permitted by regulations prescribed by the Director.” 35 U.S.C. § 316(d)(2). To that end, 37 C.F.R. § 42.121(c) provides:

In addition to the requirements set forth in paragraphs (a) and (b) of this section, any additional motion to amend may not be filed without Board authorization. An additional motion to amend may be authorized when there is a good cause showing or a joint request of the petitioner and the patent owner to materially advance a settlement. In determining whether to authorize such an additional motion to amend, the Board will consider whether

¹ We acknowledge Petitioner's argument that the Reply amendment did not eliminate every alleged instance of broadening. Tr. 30:21–23.

a petitioner has submitted supplemental information after the time period set for filing a motion to amend in paragraph (a)(1) of this section.

Under our rules, Patent Owner should have requested authorization to submit an additional or second amendment with its Reply and should have shown good cause. Although Patent Owner did not comply with Rule 42.121(c) in pursuing the second amendment, that amendment does nothing more than eliminate one of the disputes between the parties—the alleged claim scope broadening—by restoring, in at least some respects, the claim language to its original scope. Petitioner is unable to articulate any meaningful prejudice in its inability to file an opposition to the second amendment. In contrast, if we refuse to consider the second amendment, Patent Owner would be left with a broadening amendment in contravention of 35 U.S.C. § 316(d)(3). Accordingly, we exercise our discretion to consider the second amendment accompanying the Reply. *See* 37 C.F.R. § 42.5.

Proposed claim 23 of the Reply, reproduced below, is illustrative of Patent Owner’s proposed substitutions:

23 (proposed). An electronic method that enables a first user to discreetly, proactively and periodically self-report alcohol usage to a second user with a handheld portable, cordless breath alcohol content testing device, the method comprising the following steps:

providing the portable, cordless, hand-held breath alcohol content testing device, the breath test device comprising:

a portable, cordless hand-held case having an inside, an outside, and one or more walls, wherein the case is a size that can be discreetly concealed;

- a breath alcohol content sensor housed within the case for sensing breath alcohol content of a user during a breath test;
- a removable 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 location sensor housed within the case and configured to sense the location of the breath testing device;
- a controller housed within the case and electronically coupled to the digital camera, the breath alcohol content sensor, and the location sensor, wherein the controller is configured to:
 - cause the digital camera to capture the image of the first user during a breath test, and
 - receive and then transmit the image of the user, the alcohol content, and the location information generated during a breath test; and
- a wireless transceiver housed within the case and electronically coupled to the controller,
 - sending an electronic message to the first user that requests the first user to self-administer a breath test performed in accordance with a predetermined schedule;
 - having the wireless transceiver receive, via the controller, the image of the first user, the alcohol content, and the location information generated during the breath test, and
 - transmitting to a mobile phone, via the wireless transceiver, electronic image-related data derived from the image of the user, the alcohol content, and data indicating whether a

self-administered breath test was taken in accordance with the schedule.

D. Claim Construction

We interpret claims of an unexpired patent using the broadest reasonable construction in light of the specification of the patent in which they appear. *See* 37 C.F.R. § 42.100(b); *In re Cuozzo Speed Techs., LLC*, 793 F.3d 1268, 1278 (Fed. Cir. 2015), *cert. granted sub nom. Cuozzo Speed Techs. LLC v. Lee*, 136 S. Ct. 890 (mem.) (U.S. Jan. 15, 2016) (No. 15-446). In applying a broadest reasonable construction, 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 IPR-577 FWD, a panel construed terms of the '573 patent claims as reproduced below. IPR-577 FWD, 6.

Claim Phrase	Claim Construction in the IPR-577 FWD
“wireless transceiver”	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”	a website comprising information, at least part of which information is screened manually by personnel and/or automatically by software

We applied these constructions in the Institution Decision. Dec. 7. These constructions are applicable to the proposed substitute claims. Neither party contests these constructions and we maintain them on the full record.

1. “*wherein the case is a size that can be discreetly concealed*” (claim 23, 27)

Claim 23 recites a “portable, cordless, hand-held breath alcohol content testing device” that comprises a “portable, cordless hand-held case having an inside, an outside, and one or more walls, *wherein the case is a size that can be discreetly concealed.*” Similarly, claim 27 recites “a handheld portable, cordless breath alcohol content testing device comprising: a portable, cordless hand-held case that has one or more walls, *wherein the case is a size that can be discreetly concealed.*”

Quoting the Specification, Patent Owner contends that a device with a case of “a size that can be discreetly concealed” is “a device having ‘physical dimensions . . . such that it is readily able to be carried by hand, or inserted in to a handbag, purse, pocket or the like.’” Reply 5 (quoting Ex. 1102, 5:47–54). The Specification gives example dimensions, “not more than 27 cubic inches in volume, and has, for example, a major axis length of approximately 9 inches, a first minor axis length of approximately 3 inches, and a second minor axis length of approximately 1 inch.” Ex. 1102, 5:51–54. Nevertheless, Patent Owner argues that a case of “a size that can be discreetly concealed” is not limited to this example. Tr. 13:5–7. Patent Owner also relies on the testimony of Dr. Jaffe, who states that, based on this disclosure in the Specification, a skilled artisan would have agreed with Patent Owner’s construction. Ex. 2002 ¶ 11.

Petitioner argues that the Specification, in the phrase “system of providing supervisory monitoring of sobriety that is *discrete*, portable, tamper-proof, and effective,” uses the term “discrete,” as in “consisting of distinct or unconnected elements,” rather than its homophone “discreet,” as

in “unnoticeable.” Opp. 7 (quoting Ex. 1102, 2:47–49; Ex. 1161 (<http://www.merriam-webster.com/dictionary/discrete>, last visited Dec. 2, 2015); Ex. 1162 (<http://www.merriam-webster.com/dictionary/discreet>, last visited Dec. 2, 2015)). Petitioner argues that the use of “discreet” in the claims, where the Specification only describes “discrete,” is an introduction of new matter. *Id.* at 6–7.

We read the Specification’s use of “discrete” rather than “discreet” to be an obvious typographical error. We note that the Specification includes other instances in which it erroneously uses “discrete” where context calls for “discreet.” For example, in describing concerns with remote monitoring of blood alcohol levels using ankle bracelets, the Specification explains that “users are often stigmatized by their *indiscrete* presence and therefore find healthy societal interaction while wearing such bracelets difficult.” Ex. 1102, 2:14–17 (emphasis added); *see also id.* at 1:66–2:5 (“Thus, the *discrete* remote monitoring of a person under such a program by the court, or other authority, without requiring the monitored person to excuse themselves from society for more than a brief period of time would be useful in reintegrating the monitored person into society without the awkward and embarrassing effects of traditional monitoring procedures.”). Thus, the use of “discreet” in the proposed substitute claims is not new matter.

Petitioner further contends that this claim phrase “wherein the case is a size that can be discreetly concealed” is indefinite. Specifically, Petitioner argues that the Specification provides “no reasonable certainty as to how big a manufacturer needs to make the breath testing device case such that the skilled artisan would consider the case to not be discreetly concealable.”

Opp. 9. We are not persuaded that this limitation is indefinite. Rather, the Specification provides a standard for measuring whether a device can be discreetly concealed, namely “it is readily able to be carried by hand, or inserted in to a handbag, purse, pocket or the like.” Ex. 1102, 5:47–50. This is consistent with the dictionary provided by Petitioner, defining “discreet” to mean “unobtrusive, unnoticeable.” Ex. 1162. Thus, “wherein the case is a size that can be discreetly concealed” means that the size is unobtrusive such that it can be carried by hand, or concealed in a handbag, purse, pocket, or the like.

Nevertheless, a device of “a size that can be discreetly concealed” is not distinguishable from “[a] portable, cordless, hand-held” device, as recited in original claims 1 and 15. That language is supported by the same description in the Specification. Tellingly, Patent Owner also provides constructions for “hand-held” and “portable,” namely “designed to be operated while being held in the hand” and “easy to carry or move around,” respectively. Reply 4. At the oral argument, Patent Owner was unable to provide a meaningful distinction between a device that can be discreetly concealed and one that is portable and handheld. Tr. 11:19–13:4. We see no evidence that sufficiently supports a distinction between these two phrases.

Finally, we note that neither party argues, nor does the evidence support, a narrower construction under the approach in *Phillips v. AWH Corp.*, 415 F.3d 1303 (Fed. Cir. 2005) (en banc).

2. “*proactively and periodically self-report*” (claims 23, 27)

The preamble of claim 23 recites a method “that enables a first user to discreetly, *proactively and periodically self-report* alcohol usage.” The preamble of claim 27 recites a system with similar language.

The Motion does not propose a construction for “proactively and periodically self-report.” Nevertheless, in reliance on Dr. Jaffe’s testimony, Patent Owner contends that “[a] key innovation of the claimed invention (and key reason driving the success of the Soberlink monitoring system) is that the system promotes and encourages voluntary and proactive use to test and self-report sobriety.” Mot. 10 (citing Ex. 2000 ¶ 23). Patent Owner distinguishes the invention from devices used “because that person is ordered by a court or some other authority to do so.” *Id.* (citing Ex. 2000 ¶ 25). Dr. Jaffe does not identify evidence (or provide citations to the Specification) supporting his testimony. Ex. 2000 ¶¶ 23–25.

In its Opposition, Petitioner surmises that Patent Owner finds this distinction in the language “proactively and periodically self-report.” Opp. 9–10. In the Reply, Patent Owner appears to agree, contending that “proactive” means “‘anticipatory’ and/or ‘voluntary.’” Reply 5. Thus, we evaluate whether “proactively and periodically self-report” means voluntarily self-report, as opposed to reporting due to law enforcement compulsion.

Citing online dictionaries, Petitioner argues that “proactive” means “anticipatory,” but does not mean “voluntary.” Opp. 10; Ex. 1163 (“serving to prepare for, intervene in, or control an expected occurrence or situation,

especially a negative or difficult one; anticipatory”); Ex. 1164 (“acting in anticipation of future problems, needs, or changes”).

Patent Owner argues that Mr. Wojcik admitted that “proactive” also means “voluntary.” Reply 5. We disagree. Consistent with Petitioner’s dictionary definitions, Mr. Wojcik testifies that “[t]he word ‘proactive’ means anticipatory” and that “the skilled artisan would not have understood ‘proactive’ to mean uncompelled or voluntary.” Ex. 1169 ¶ 20 (citing Ex. 1163). Patent Owner’s Reply also cites to Dr. Jaffe, who mischaracterizes Mr. Wojcik’s testimony and purports to agree with it. Reply 5; Ex. 2002 ¶ 12–13. This testimony does not cite to any other evidence that “proactive” means “voluntary.” We give Dr. Jaffe’s testimony on this point no weight. *See* 37 C.F.R. § 42.65(a).

As to the term “periodic,” its plain meaning, as evidenced by dictionary definitions, is “1. Having or marked by repeated cycles. 2. Happening or appearing at regular intervals. 3. Recurring or reappearing from time to time.” THE AMERICAN HERITAGE COLLEGE DICTIONARY 1035 (4th ed. 2002) (Ex. 3001).

Based on the plain meaning of “proactive” and “periodic,” as evidenced by dictionary definitions, we construe “proactively and periodically self-report” to mean self-report at regular intervals in anticipation of a need for a measurement. Patent Owner points to no evidence in the Specification to the contrary. Specifically, Patent Owner points to no evidence in the Specification distinguishing between self-reporting voluntarily and self-reporting due to law enforcement compulsion. Rather, Patent Owner admitted at the oral argument that its substitute claims

would cover law enforcement use. Tr. 16:14–18:5. Indeed, the ’573 patent explicitly states that “[t]he present invention is also useful for remotely monitoring sobriety in situations in which sobriety has been required as a condition of probation or by courts.” Ex. 1102, 3:32–34.

We note that use of the claim construction approach in *Phillips* would not result in Patent Owner’s more narrow construction. The ordinary meanings of “proactive” and “periodic,” in light of the Specification, are clear. Patent Owner points to nothing in the intrinsic evidence suggesting that “proactive” also means voluntary and without compulsion.

Finally, Petitioner contends that this claim limitation also is indefinite. Petitioner appears to argue that, under Patent Owner’s theory that this term carries with it a distinction between compelled versus voluntary testing, a skilled artisan would not be reasonably certain what this term means. Opp. 9–10. Because we do not construe this claim language to include a distinction between compelled and voluntary self-reporting, we do not find persuasive Petitioner’s argument that the claim language is indefinite.

E. Written Description Support for Substitute Claims

A claim amendment must not introduce new subject matter. See 35 U.S.C. § 316(d)(3); 37 C.F.R. § 42.121(a)(2)(ii). To that end, a motion to amend must include a claim listing, which must set forth “[t]he support in the original disclosure of the patent for each claim that is added or amended.” 37 C.F.R. § 42.121(b)(1). Attached to its Motion, Patent Owner included Appendix B, which purported to show, in chart form, the written

description support in the '573 patent's Specification for each limitation of proposed substitute claims 23–28.

Petitioner points to numerous errors in Appendix B, including:

- (1) several instances in which a purported quotation from the Specification is unaccompanied by any citation to the Specification or accompanied simply by the word “[cite].” Petitioner contends that there are 47 such instances. Opp. 4. While we have not verified this number, it is plausible;
- (2) several instances of quotations from material clearly not part of the specification (such as material that describes “intermediate device 500” and “PAN module 520,” structure that is not part of the Specification). Petitioner alleges that there are 56 such instances. Opp. 5 & n.7. Again, although we have not verified this count, it is plausible.

For many of the limitations of the proposed substitute claims, we are unable to discern, from Appendix B to the Motion, what Patent Owner contends provides written description support. For example, in its support for the claim limitation “sending an electronic message to the first user that requests the first user to self-administer a breath test performed in accordance with a predetermined schedule,” most of the purported quotations discuss intermediary device 500, which is not discussed in the '573 patent Specification. Two passages reference a supervisory monitor 16 and a cellular receiver monitoring station 56 receiving breath test signal 11

indicating that an alcohol content level exceeds a predetermined threshold. These passages, however, do not match any from the Specification. Indeed, breath test signal 11 is discussed only with respect to Figure 1, although cellular receiver monitoring station 56 is discussed only with respect to Figure 5. Moreover, to the extent that these passages constitute summaries of various disclosures in the Specification, we are unable to discern from these passages what Patent Owner contends discloses “*sending an electronic message to the first user that requests the first user to self-administer a breath test performed in accordance with a predetermined schedule.*” As best we can discern, Patent Owner relies on disclosure of electronic reminders sent via SMS or email, discussed in connection with intermediary device 500, disclosure clearly not in the Specification.

We similarly are unable to discern, from original Appendix B, what Patent Owner contends supports “receive the predetermined schedule for the first user to self-administer a periodically-performed breath test,” as recited in substitute claim 27. The Motion itself includes no argument explaining how the proposed substitute claims are supported; it simply points to Appendix B. Mot. 3. In short, what evidence we are able to discern from the original Appendix B filed along with the Motion is insufficient to show written description support in the original disclosure of the ’573 patent for the proposed substitute claims.

In the Reply, Patent Owner argued that its Motion “mistakenly attached the wrong version of Appendix B, which included several errors, most notably in multiple places omitting page/line citations to the ’573 patent specification, including a ‘[cite]’ reference rather than the actual cite.”

Reply 2. The Reply attached an amended Appendix B, which Patent Owner contends is proper Reply evidence, as it responds to Petitioner's challenge to the clerical errors in the original Appendix B. *Id.* at 2–3.

Patent Owner's amended Appendix B was not submitted in accordance with our rules. "All arguments for the relief requested in a motion must be made in the motion. A reply may only respond to arguments raised in the corresponding opposition or patent owner response." 37 C.F.R. § 42.23(b). The Patent Office has given the following guidance regarding distinguishing proper replies from improper new arguments:

A reply may only respond to arguments raised in the corresponding opposition. § 42.23. While replies can help crystalize issues for decision, a reply that raises a new issue or belatedly presents evidence will not be considered and may be returned. The Board will not attempt to sort proper from improper portions of the reply. Examples of indications that a new issue has been raised in a reply include new evidence necessary to make out a *prima facie* case for the patentability or unpatentability of an original or proposed substitute claim, and new evidence that could have been presented in a prior filing.

Office Patent Trial Practice Guide, 77 Fed. Reg. 48,756, 48,767 (Aug. 14, 2012).

At the hearing, Petitioner argued that Patent Owner's amended Appendix B added evidence that was not in the Motion or original Appendix B. Tr. 38:24–39:6. As an example raised by Petitioner, in amended Appendix B, as support for the claim language "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, wherein the case is a size that can be discreetly concealed," as recited in

claim 23, Patent Owner included a cite to column 5, lines 47–54, which discusses specific dimensions for a breath testing device. Tr. 39:10–13. Neither this citation, nor a summary that could be associated with the citation, appears in original Appendix B.

We agree with Petitioner that this citation represents part of Patent Owner’s *prima facie* case that the substitute claims are supported by the Specification. Indeed, at the oral hearing, Patent Owner stressed the importance of this disclosure in providing clarity as to the meaning of “discreetly concealed,” as distinguished from “portable” and “hand-held,” as recited in original claim 1, arguing that it gave “a very clear example with specific size and dimension of . . . the preferred embodiment.” Tr. 12:13–13:4; *see also* Mot. 9 (listing “compact, portable, and concealable” as a distinction over the prior art).

As another example, in support of the claim language “sending an electronic message to the first user that requests the first user to self-administer a breath test performed in accordance with a predetermined schedule,” as recited in claim 23, amended Appendix B cites to column 7, line 62, to column 8, line 6, and column 8, lines 34–43, neither of which appear, in any form, in original Appendix B. Moreover, Patent Owner’s evidence for claims 24 and 25 appears to have changed completely from original Appendix B to amended Appendix B. These are citations that should have been presented along with the Motion.

At the hearing, Patent Owner represented that the citations in the original Appendix B clearly are not from the ’573 patent (e.g., describing intermediary device 500) but, instead, referenced a continuation-in-part.

Tr. 64:3–7. Nevertheless, Patent Owner disputed that amended Appendix B included any evidence that Patent Owner did not present, in some form, in its Motion. According to Patent Owner, in amended Appendix B, “we simply just took out the support that did not belong from the original specification. So, you know, the record is there.” *Id.* at 65:22–66:2. Asked to clarify whether it had added any material to amended Appendix B not included in original Appendix B, counsel for Patent Owner argued the following:

JUDGE McKONE: So you’re certifying to us that you have put nothing new in the claim charts that accompany the reply. Because to be clear, Petitioner has argued that you did put additional information in, additional cites, additional text that was not in the charts that accompanied the motion. Are you certifying today that, indeed, everything that was in the reply, written description support chart was also in the chart that accompanied the motion to amend?

MR. LIU: Well, to be clear, it wasn’t necessarily just limited to the chart. There’s also citation support that we provided in Jaffe’s declaration as well. So I think what we did was we moved a few things around, but at the end of the day the citations and the support as a whole in our motion to amend, all of that was there. That’s our position. It’s my understanding.

Tr. 66:9–22. We find that the record does not support Patent Owner’s representation. We have examined both of Dr. Jaffe’s Declarations (Exs. 2000, 2002), and find no reference to written description support and, specifically, no reference to the material added to amended Appendix B. Nor is that material referenced, in any form, in the Motion. Thus, the additional material quoted in amended Appendix B is, indeed, newly cited evidence, necessary to make out Patent Owner’s *prima facie* case.

We exercise our discretion to decline to consider amended Appendix B in determining whether Patent Owner has shown that the proposed substitute claims are supported by the original disclosure of the '573 patent. It is worth noting that Patent Owner, upon discovering its purported clerical error, never sought the Board's guidance or asked for authorization to supplement its evidence with corrected claim charts. The Board could have considered relief that provided Petitioner an opportunity to respond to Patent Owner's new evidence. The rules do not provide for additional argument or evidence from Petitioner after Patent Owner's Reply. Thus, Petitioner did not have a fair opportunity to respond to the evidence in amended Appendix B. *Cf. Dell, Inc. v. Acceleron, LLC*, 2016 WL 1019075 2015-1513 (Fed. Cir. Mar. 15, 2016), slip op. at 13 (In an *inter partes* review, "the APA imposes particular requirements on the PTO. The agency must 'timely inform[]' the patent owner of 'the matters of fact and law asserted,' 5 U.S.C. § 554(b)(3), must provide 'all interested parties opportunity for the submission and consideration of facts [and] arguments . . . [and] hearing and decision on notice,' *id.* § 554(c), and must allow 'a party . . . to submit rebuttal evidence . . . as may be required for a full and true disclosure of the facts,' *id.* § 556(d).").

Moreover, even if we were to consider the evidence in amended Appendix B, it would not be sufficient to show support in the original disclosure. For example, claim 23 recites "sending an electronic message to the first user that requests the first user to self-administer a breath test performed in accordance with a predetermined schedule." Amended Appendix B cites column 3, lines 12–15 (a user can send breath test reports

to a family member on a predetermined schedule, or when randomly requested), column 7, line 62–column 8, line 6 (an alarm condition or alert is sent to a supervisory monitor if a breath test signal is not received within a desired timeframe or schedule), and column 8, lines 34–43 (a monitoring station can provide a variety of reports of a user’s testing history, allowing analysis). None of these citations discloses sending an electronic message to the user of an alcohol content testing device, let alone sending a message requesting the user to self-administer a breath test. The Reply itself (to which amended Appendix B was attached) does not provide argument explaining Patent Owner’s citations. Reply 2–3. Neither the Reply nor amended Appendix B cites to any testimony explaining the applicability of Patent Owner’s citations. For similar reasons, Patent Owner’s evidence fails to show written description support for a “controller [] configured to . . . receive the predetermined schedule for the first user to self-administer a periodically-performed breath test,” as recited in substitute claim 27.

Substitute claims 24–26 depend from claim 23 and claim 28 depends from claim 27. Patent Owner does not allege that the evidence in amended Appendix B for claims 24–26 and 28 remedy the above-noted deficiencies for claims 23 and 27. Accordingly, Patent Owner has not shown support in the original disclosure of the ’573 patent for substitute claims 23–28. For this reason, Patent Owner has not established that it is entitled to the relief it seeks in its Motion, namely entry of proposed substitute claims 23–28.

F. Patent Owner has not Shown that the Substitute Claims would have been Nonobvious

A claim is unpatentable under 35 U.S.C. § 103(a) if the differences between the claimed subject matter and the prior art are “such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.” We resolve the question of obviousness on the basis of underlying factual determinations, including: (1) the scope and content of the prior art; (2) any differences between the claimed subject matter and the prior art; (3) the level of skill in the art; and (4) objective evidence of nonobviousness, i.e., secondary considerations. *See Graham v. John Deere Co.*, 383 U.S. 1, 17–18 (1966).

In an obviousness analysis, some reason must be shown as to why a person of ordinary skill would have combined or modified the prior art to achieve the patented invention. *See Innogenetics, N.V. v. Abbott Labs.*, 512 F.3d 1363, 1374 (Fed. Cir. 2008). A reason to combine or modify the prior art may be found explicitly or implicitly in market forces; design incentives; the “interrelated teachings of multiple patents”; “any need or problem known in the field of endeavor at the time of invention and addressed by the patent”; and the background knowledge, creativity, and common sense of the person of ordinary skill. *Perfect Web Techs., Inc. v. InfoUSA, Inc.*, 587 F.3d 1324, 1328–29 (Fed. Cir. 2009) (quoting *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 418–21 (2007)).

1. Level of Skill in the Art

In the Petition, Petitioner contends that a skilled artisan would have had a BS degree in engineering, knowledge of cellular telephone technology, and two to four years of experience designing, optimizing, and/or testing portable, battery-operated products. Pet. 18. Petitioner supports its argument with Mr. Wojcik's testimony (Ex. 1124 ¶¶ 57–60), which does not itself cite evidence.

In its Motion, Patent Owner argues that a skilled artisan would have had at least two to five years of experience working in the field of sobriety monitoring, developing sobriety monitoring and treatment programs. Mot. 4. Patent Owner also argues that a skilled artisan would have had a practical understanding of methodologies used to monitor sobriety and an understanding of human behavioral patterns as they relate to alcohol addiction. *Id.* at 4–5. Patent Owner cites to Dr. Jaffe (Ex. 2000 ¶ 13), whose testimony is as conclusory and devoid of evidence as Mr. Wojcik's.

In IPR-577, we found that the level of ordinary skill in the art is reflected in the prior art itself, reflects solutions to engineering problems, and does not require a physician's knowledge of the behavior of alcoholics. IPR-577 FWD, 17–19. On the record of the current proceeding, considering similar testimony and substantially the same prior art, we maintain the finding that the level of ordinary skill in the art is reflected by the prior art of record. *See Okajima v. Bourdeau*, 261 F.3d 1350, 1355 (Fed. Cir. 2001); *In re GPAC Inc.*, 57 F.3d 1573, 1579 (Fed. Cir. 1995); *In re Oelrich*, 579 F.2d 86, 91 (CCPA 1978).

2. *Scope and Content of the Prior Art*

“A motion to amend may be denied where . . . [t]he amendment does not respond to a ground of unpatentability involved in the trial.” 37 C.F.R. § 42.121(a)(2)(i). We instituted trial on two grounds: (1) claims 6, 12, and 18 for obviousness based on Ku, MEMS, and Williams and (2) claims 7, 8, 13, 14, 19, and 20 for obviousness based on Ku, MEMS, Williams, and Freund. Dec. 22. We evaluate whether Patent Owner’s proposed amendment responds to these grounds.

Additionally, as explained above, Patent Owner must show that the proposed substitute claims include patentable distinctions over the prior art, including the material prior art raised in this proceeding and IPR-577. *MasterImage*, Case IPR2015-00040, slip op. at 2 (Paper 42).² In its Opposition, Petitioner specifically argues that proposed claim 23 would have been obvious over Ku, Williams, MEMS, Hyde, LG Breathalyzer, and iBreath. Opp. 24–25. Patent Owner additionally addresses Freund and Walter.³ Mot. 6–7, 12–14.

² Because we conclude that Patent Owner has not shown a patentable distinction over the prior art raised in this proceeding, we need not address Petitioner’s argument (Opp. 16–19) that Patent Owner failed to address additional prior art in the ’573 patent’s prosecution history.

³ In the IPR-577 FWD, we found that several claims of the ’573 patent would have been obvious over Walter, alone or in combination with other references. Because we conclude that Patent Owner has not shown that the substitute claims are patentable over the prior art cited by Petitioner in the Petition and the Opposition, we do not address Walter further.

a. Overview of Ku

Ku describes a multifunctional portable digital image capturing device. Ex. 1103 ¶ 1. Ku's device can capture a digital image and measure a physical quantity of a source (such as alcohol concentration or water quality). *Id.* ¶ 21. Figure 3a, reproduced below, illustrates an example:

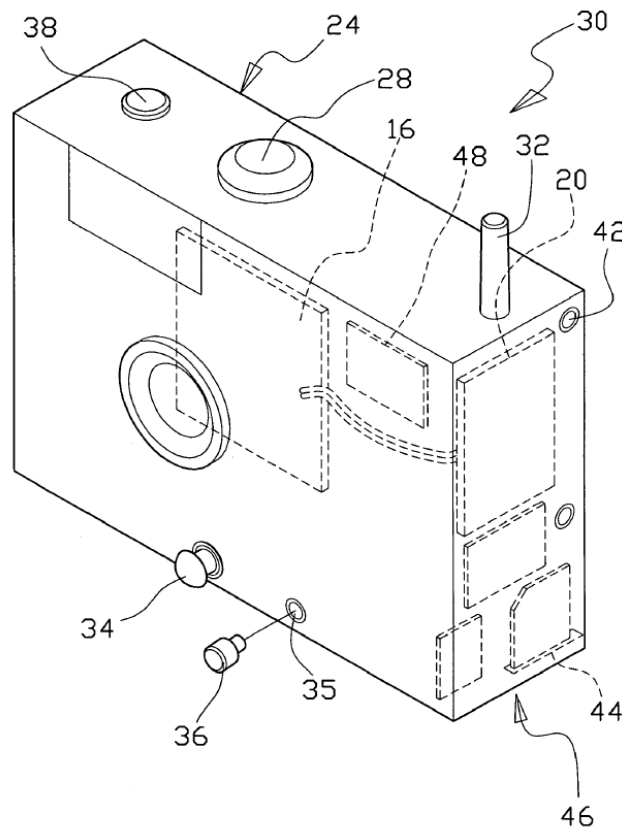


Fig. 3a

Figure 3a is a diagram of personal portable digital image capturing device. *Id.* ¶ 15.

Digital video camera 30 includes built-in sensor 34 and external sensor 36, both of which can detect contact-type or non-contact-type items. *Id.* ¶ 22. Built-in sensor 34 can be a retractable sensing rod. *Id.* In one example, external sensor 36 is used to measure breath alcohol content.

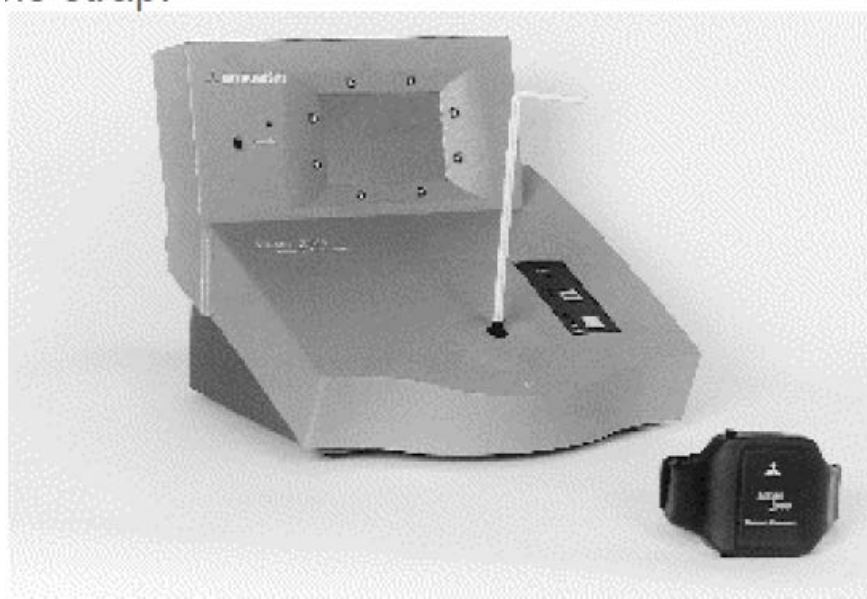
Id. ¶ 23. A sensor “can also be hidden in or externally connected on the personal portable digital image capturing device.” *Id.* ¶ 27. Digital video camera 30 also includes data processor 48, which performs analysis, calculation, and plotting of data and also can use a satellite positioner to calculate the longitude and latitude of a picture-taking site. *Id.* ¶ 22. Digital video camera 30 also includes network card 20 and communications transmission device 46 for transmitting and receiving communications signals. *Id.* ¶¶ 22, 25. Data transmission can be over wired or wireless means (e.g., GPRS, CDMA, or transmission line). *Id.* ¶ 25.

In one example, when a user presses starting button 38, digital video camera 30 takes a picture and sensor 36 measures blood alcohol content. *Id.* ¶ 24. The satellite positioner records the longitude and latitude values of the picture-taking site. *Id.* The BAC value, image data, and position data are transmitted simultaneously (e.g., by Bluetooth, wireless network, infrared transmission, or transmission line) to an external computer (e.g., a hospital or police business server). *Id.* “Because the taken picture and the measured alcohol concentration value and location are immediately transmitted to the external equipment 22 via the transmitter to keep in the archives via, they can’t be changed and become credible data.” *Id.*

b. Overview of MEMS

MEMS is a web page that describes a MEMS 2000 HomeStation product from ElmoTech Ltd. The MEMS 2000 is an integrated tabletop BAC testing and video identity verification unit that is installed in a home

and connects to a monitoring center via a telephone line. Ex. 1141, 1. The MEMS 2000 HomeStation is pictured on the second page of the exhibit:



The picture on page two of MEMS depicts a MEMS 2000 HomeStation. As shown in the picture, the MEMS 2000 HomeStation includes a straw into which a user can blow, allowing the device to test BAC. *Id.* at 2; *see also* Ex. 1124, 56.

c. Overview of Williams

Williams describes a self-service breath alcohol test kiosk system for collecting BAC information and reporting it over a communication network. Ex. 1105, Abstract. Figure 1, reproduced below, illustrates an example:

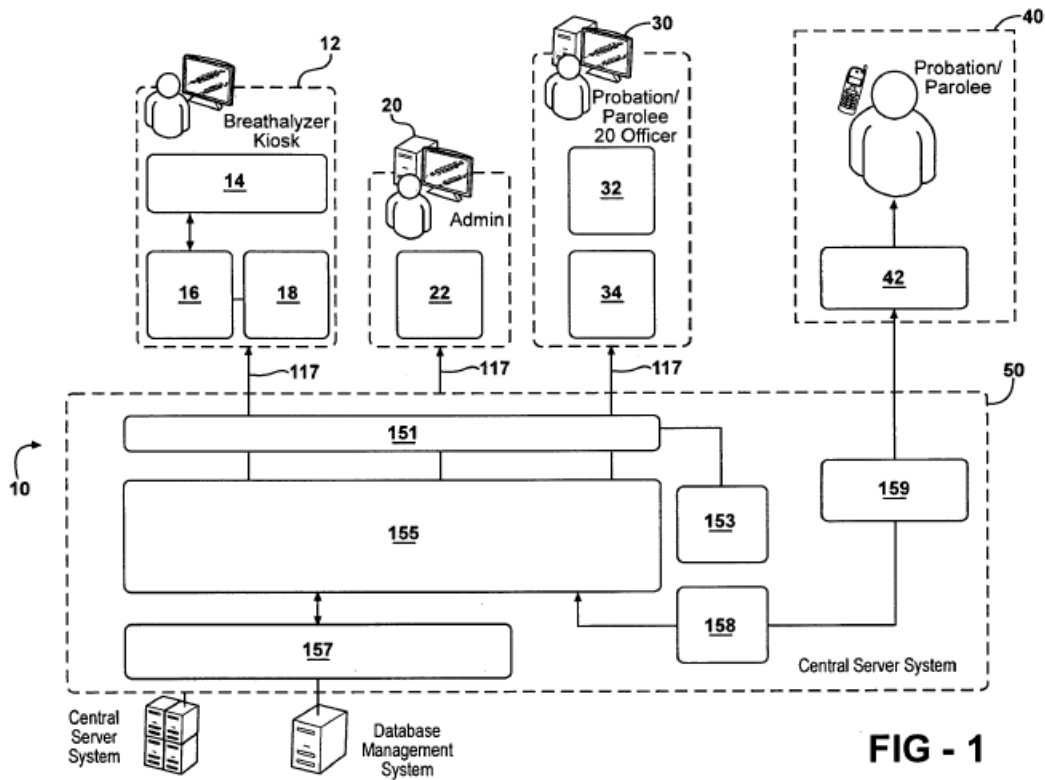


Figure 1 is a block diagram of a breath alcohol testing kiosk system with network connections. *Id.* ¶ 7.

Breathalyzer kiosk 12, administration system 20, and officer interface system 30 each are coupled to central server system 50 over communications link 117. *Id.* ¶¶ 16, 23. Kiosk 12 includes a digital camera for taking pictures while a user is providing a breath sample. *Id.* ¶¶ 30, 53. The breathalyzer test results are transmitted from kiosk 12 to central server 50 through communication link 117. *Id.* ¶¶ 32, 41, 53. Data also is exchanged between administration system 20 and central server 50 or kiosk 12 over communications link 117. *Id.* ¶ 42. Officer interface system 30 also accesses central server system 50 or kiosk 12 over communications link 117. *Id.* ¶ 44.

Officer interface system 30 includes a computer (e.g., personal computer 34) with an Internet browser for connecting to central server system 50 or kiosk 12 through communications link 117. *Id.* ¶ 44. Personal computer 34 can be a mobile device. *Id.* ¶¶ 42, 44.

In one example, an officer, using officer interface system 30, enters information about a user to be tested, including fingerprint samples and digital photographs of the user. *Id.* ¶ 45. “The officer further inputs a breathalyzer testing schedule for the user 110.” *Id.*

In one use scenario of the user notification system 40, the test schedule as discussed above set up by the officer through the officer interface system 30 initiates an automated call to the registered user 110 notifying the user 110 of a pending breathalyzer test date and time, and further notifying the user 110 of the location of the kiosk 12 or kiosks 12 that the user 110 is authorized to use.

Id. ¶ 48. The test schedule also initiates automated email messages to the officer, notifying the officer of test results ready for review and “the number of users 110, if any, that failed to appear for scheduled testing.” *Id.* ¶ 49.

d. Overview of Freund

Freund describes a sobriety interlock system for a vehicle that allows the vehicle to be started only when the driver is sober. Ex. 1106 ¶ 1.

Figure 1, reproduced below, illustrates an example:

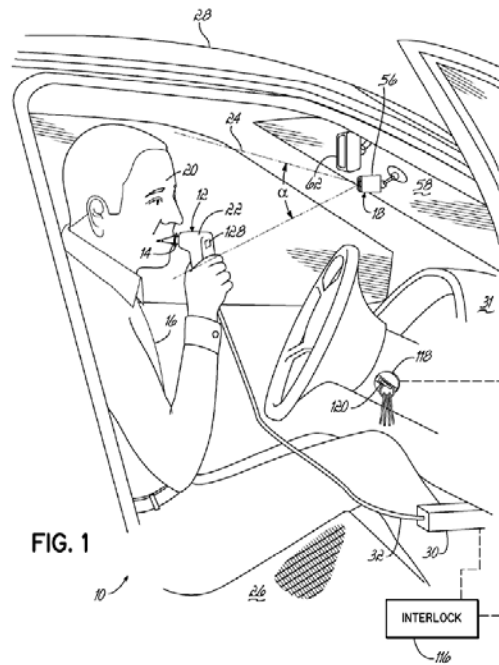


Figure 1 is a perspective view of a chemical impairment detection system in vehicle 28. *Id.* ¶ 16.

As shown in Figure 1, chemical impairment detection sampling device (handset) 12 samples user 16's breath through mouthpiece 14. *Id.* ¶ 27.

Handset 12 is connected to control/relay module (CRM) 30. *Id.* ¶ 30.

Figure 1 shows handset 12 connected to CRM 30 via corded coil 32. *Id.*

Handset 12 and CRM 30 also can be connected wirelessly. *Id.* ¶ 36. Relay 30 is connected to vehicle ignition interlock 116, which, in turn, is connected to vehicle ignition switch 118. *Id.* ¶¶ 39–40.

The system also includes video surveillance system 18 that is mounted separately to windshield 58. *Id.* ¶¶ 29, 33. Video surveillance system 18 ensures that handset 12 is within its field of view during a test, and, thus, that the person blowing into the handset and attempting to start the car is the person sitting in the driver's seat (and not a sober friend sitting elsewhere).

Id. ¶¶ 42–43, 53. Video surveillance system 18 also can capture an image of the user during a test. *Id.* ¶ 56. The image and the test results can be stored. *Id.*

Freund’s system also includes a communication module (e.g., a cellular phone) that can transfer test results and the facial image of the tester to an external receiver, such as a monitoring facility, or to law enforcement. *Id.* ¶¶ 38–39. Freund also describes another mode of operation, an abstinence monitoring “driveway test,” in which a user uses handset 12 to test sobriety periodically (e.g., three times per day) without driving the vehicle. *Id.* ¶¶ 60–61.

e. Overview of Hyde

Hyde describes a portable electronic device, such as a cellular telephone, a personal digital assistant (“PDA”), or an iPod, that can include a breath analyzer for measuring the presence of alcohol on a user’s breath. Ex. 1122 ¶¶ 23, 45. Data from the device can be uploaded to a central authority. *Id.* ¶ 52.

f. Overview of LG Breathalyzer

LG Breathalyzer is a web page stating that manufacturer LG has introduced a cellular phone equipped with a built-in breathalyzer and a digital camera. Ex. 1132, 1–2.

g. Overview of iBreath

iBreath is a web page describing a breathalyzer that connects to an iPod or iPhone. Ex. 1133, 1. According to iBreath:

You simply grab your iPod with the attached iBreath and fold out the “blow wand” and exhale into it for a minimum of five seconds. Within two seconds after the test, the device will display the results of your breath test. Accordingly you’ll know your blood alcohol content (BAC) level within the range of 0.0000–0.100% and whether or not you are at the legal limit restricting your ability to drive.

Id. The device also includes “[a] built in timer [that] can be used to remind you to test yourself again within one minute to up to eight hours.” *Id.*

h. Petitioner’s Contentions as to the Original Claims and Substitute Claim 23

In the Petition, regarding original claim 1, Petitioner contends that Ku’s digital video camera 30 is a portable, cordless, hand-held device with a case, and that Ku discloses a breath alcohol content sensor (built-in sensor 34 and external sensor 36) for sensing a BAC of a user, a digital camera (24) for taking a picture of the user during a breath test, and a transmitter (40) for sending the BAC and picture data to a receiving station (22). Pet. 19–20, 23–24, 27–29. Petitioner also contends that Ku teaches a controller (circuit component 16) housed within the case that causes the camera to capture the image of the user during the breath test. *Id.* at 26–27. Petitioner continues to cite to Ku for these aspects of substitute claim 23. Opp. 24–25.

Petitioner cites MEMS for a disclosure of a “breath interface component operatively coupled to the breath alcohol content sensor,” as recited in claim 1. Pet. 22–23. Specifically, Petitioner argues that it would

have been obvious to use a straw, such as shown in the picture of the MEMS device, as a way to interface with Ku's internal sensor. *Id.* Petitioner argues that MEMS's straw would have been a predictable way to deliver undiluted breath to Ku's sensor and would properly position the user's face for a picture. *Id.* at 23. Petitioner also cites MEMS as a more specific example of a camera lens "positioned to capture an image of the user during a breath test," as recited in claim 1, in the event that we find Ku's disclosure of camera positioning to be insufficient on this point. *Id.* at 24–26. Petitioner argues that this positioning would have been a matter of common sense. *Id.* at 26.

Claim 9 adds a GPS unit for identifying the user location during a breath test and transmitting that user location. Petitioner cites Ku's disclosure of a satellite positioner for this limitation. Pet. 30 (citing Ex. 1103 ¶ 22). We note that this aspect has been incorporated into substitute claims 23 and 27, for example in claim 23's recitation of "a location sensor housed within the case and configured to sense the location of the breath testing device." Petitioner continues to cite to Ku's disclosure for claim 23's location sensor. Opp. 25.

Claim 15 is similar to claim 1, and adds "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." Petitioner cites Williams for a disclosure of this aspect of claim 15. Pet. 33–35. Specifically, Petitioner cites to Williams's disclosure of monitoring personnel such as parole or probation officers accessing information transmitted to central server system 50 by breathalyzer kiosk 12 over

communications link 117. *Id.* In reliance on the testimony of Mr. Wojcik, Petitioner argues that the data delivery in Williams is an example of the type of data delivery expected by consumers, and that Williams's server system would have performed the same function receiving data transmitted by Ku's camera as it would receiving the same type of data from a kiosk. *Id.* (citing Ex. 1124 ¶ 67). Petitioner continues to cite Williams for similar aspects incorporated into substitute claim 23. Opp. 24–25.

Claim 6 depends from claim 1 and adds “wherein the transceiver wirelessly transmits the breath alcohol content of the user and the electronic image-related data to a mobile device.” Claim 19 adds a similar limitation to claim 15. Petitioner cites to Williams for these limitations. Pet. 37–38, 49. Specifically, Williams states that its “breathalyzer kiosk in the breathalyzer kiosk system may also be coupled to other devices such as personal computers, personal digital assistants (PDAs), [and] mobile phones.” Ex. 1105 ¶ 14. Petitioner again cites to Mr. Wojcik in arguing that market expectations would have motivated this combination. Pet. 38 (citing Ex. 1124 ¶ 70). This aspect has been incorporated into substitute claims 23 and 27, for example in claim 23's recitation of “transmitting to a mobile phone, via the wireless transceiver, electronic image-related data derived from the image of the user, the alcohol content, and data indicating whether a self-administered breath test was taken in accordance with the schedule.” Petitioner continues to cite to this disclosure in Williams for claim 23's “transmitting to a mobile phone.” Opp. 25. Petitioner cites to Freund as an additional example of transmitting to a mobile device. Pet. 49.

Regarding original claim 5, which depends from claims 1 and 4, Petitioner contends that Williams teaches transmitting the BAC and image data to a “monitored internet website,” arguing that its website would have been useless if not monitored. Pet. 37. This claim limitation is included in substitute claims 24 and 25.

3. Alleged Differences Between the Prior Art and the Substitute Claims

Patent Owner contends that the prior art, as a whole, does not teach three aspects of substitute claims 23 and 27:

- (1) a ***compact, portable, and concealable*** breath test device that allows the first user to discretely, and conveniently test and self-report sobriety to a second user,
- (2) having the first user ***proactively self-report sobriety*** to a second user on a ***predetermined*** schedule, and
- (3) using a user’s ***mobile phone*** to wirelessly receive and display the data generated during a[n] alcohol breath test, including image-related data, alcohol content information, and data indicating whether a self-administered breath test was taken in accordance with the predetermined schedule.

Mot. 1, 9–10. The Motion does not state explicitly which limitations in the substitute claims correspond to each of these allegedly distinguishable aspects. Nevertheless, we are able to infer the most likely limitations and conclude that Patent Owner has not shown that these limitations distinguish from the prior art.

As to a “***compact, portable, and concealable*** breath test device,” Patent Owner appears to be referring to the language “a portable, cordless

hand-held case having an inside, an outside, and one or more walls, *wherein the case is a size that can be discreetly concealed*,” as recited in claim 23 (and similarly recited in claim 27). Patent Owner argues that this is a distinction over the kiosk of Williams. Mot. 6 (“Williams is clearly not portable, concealable, or hand-held like the claimed device.”), 10 (“Williams describes a non-portable, point-in-time breathalyzer-based kiosk network. . . . The system is large and bulky, non-portable, and cannot be used discretely or at any location save for a kiosk on which the user is authorized for use.”); *see also* Reply 11 (“[N]ot once does Mr. Wojcik discuss the anxiety and embarrassment that understandably exists with having to use dedicated public testing centers.”). Similarly, Patent Owner argues that the device described in MEMS “was large, bulky, and obtrusive.” Mot. 14; *see also* Reply 11 (“MEMS is a bulky device—far from concealable.”).

Williams’s kiosk undoubtedly will not fit in a pocket or purse, although the MEMS device might. Nevertheless, Ku describes a portable digital camera with breath testing functionality. Ex. 1103 ¶¶ 21–22. As explained in Section II.D.1 above, a device that is of “a size that can be discreetly concealed” is one in which the size is unobtrusive such that it can be carried by hand, or concealed in a handbag, purse, pocket, or the like. We also explained that we discern no difference between a device that is “portable” and “hand-held” and one that can be “discretely concealed.” In any case, Ku at least suggests that its digital camera is of a size that could be concealed in a handbag or purse. Ex. 1103 ¶¶ 2 (describing the background of the invention as including digital cameras and PDAs), 21 (describing the

preferred embodiment as “a personal *portable* digital image capturing device” (emphasis added)). Moreover, Petitioner cites to other examples of hand-held devices, such as the flip-style cellular phones of Hyde and LG Breathalyzer and the iPhone breathalyzer of iBreath, each of which is depicted as being of a size that could be concealed discreetly in a pocket or purse. Opp. 22, 24; Ex. 1132; Ex. 1133.

As to Patent Owner’s argument that the prior art does not teach reporting test results “to a second user on a ***predetermined*** schedule” (Opp. 9), Patent Owner appears to refer to the language “sending an electronic message to the first user that requests the first user to self-administer a breath test performed in accordance with a predetermined schedule,” recited in claim 23, “wherein the predetermined schedule is a schedule set by the second user,” recited in claim 26, and the similar language in claims 27 and 28. Patent Owner contends that Ku does not meet these limitations: “Ku . . . says nothing [about] testing pursuant to a predetermined schedule.” Mot. 14.

As Petitioner points out (Opp. 23), Williams describes testing pursuant to a schedule determined by an officer. Ex. 1105 ¶ 45 (“The officer further inputs a breathalyzer testing schedule for the user 110.”). Patent Owner admits that Williams teaches testing a user on a predetermined schedule, stating that Williams’s “testing is involuntary *pursuant to a testing schedule established, for example, by the user’s probation officer.*” Mot. 11 (emphasis added). As to “sending an electronic message to the first user that requests the first user to self-administer a breath test” according to that schedule, as recited in claim 23, Williams’s system “initiates an automated

call to the registered user 110 notifying the user 110 of a pending breathalyzer test date and time” Ex. 1105 ¶ 48. Thus, Williams teaches these limitations.

As to Patent Owner’s argument that the prior art does not teach “having the first user *proactively self-report sobriety*” (Mot. 9), Patent Owner appears to be referring to the language “to discreetly, proactively and periodically self-report alcohol usage,” in the preamble of claim 23 (and similar language in the preamble of claim 27). Here, Patent Owner draws a distinction between voluntary testing and testing that is compelled (e.g., at the behest of law enforcement). For example Patent Owner argues that “[t]he Williams reference does not describe any need or desire for a portable testing device that allows a user to conveniently and proactively report his/her sobriety. The described device is instead designed and intended to be a tool for compelled alcohol testing.” Mot. 6; *see also id.* at 11 (“Williams does not discuss or address proactive testing and reporting of sobriety by the user. Instead, the testing is involuntary pursuant to a testing schedule established, for example, by the user’s probation officer.”), 14 (“Ku says nothing about proactively testing or self-reporting sobriety.”), 14 (The MEMS device is “designed and intended to be a tool for compelled alcohol testing in the context of law enforcement / criminal proceedings.”); Reply 11 (“Ku says nothing about sobriety monitoring, addiction treatment, or proactively testing or self-reporting sobriety pursuant to a pre-determined schedule.”).

As explained in Section II.D.2 above, we do not construe “proactively and periodically self-report” to include a distinction between testing that is

voluntary and testing that is at the behest of law enforcement. Rather, this term means “self-report at regular intervals in anticipation of a need for a measurement.” As explained above, Williams teaches a user self-administering tests according to a schedule set by an officer. Ex. 1105 ¶ 45.

As to Patent Owner’s argument that the prior art does not teach “using a user’s **mobile phone** to wirelessly receive and display the data generated during a[n] alcohol breath test, including image-related data, alcohol content information, and data indicating whether a self-administered breath test was taken in accordance with the predetermined schedule” (Mot. 9–10), Patent Owner appears to be referring to the language “transmitting to a mobile phone, via the wireless transceiver, electronic image-related data derived from the image of the user, the alcohol content, and data indicating whether a self-administered breath test was taken in accordance with the schedule,” recited in claim 23 (and similarly recited in claim 27). Patent Owner argues that “Ku . . . does not describe using a user’s mobile phone to wirelessly receive and display the data generated during an alcohol breath test.” Mot. 14; *see also* Reply 11 (“Ku also does not describe using a user’s mobile phone to wirelessly receive and display the data generated during an alcohol breath test.”). Similarly, Patent Owner argues that MEMS does not “describe any use of cellular, wi-fi, or other wireless technologies.” Mot. 14.

Petitioner, however, points out (Opp. 23) that Ku describes transmitting test results to “external equipment” that can include “a personal computer, a printer, or a server like a hospital server, a police business server, and so on.” Ex. 1103 ¶ 24. Williams describes sending test results to

and viewing those results on a personal computer, which “may be substituted with a conventionally known mobile device.” Ex. 1105 ¶¶ 42, 49–40. Thus, the prior art teaches this feature as well.

Patent Owner also argues that “[w]hile Ku describes including a generic ‘sensor’ for detecting alcohol, it does not even describe how this is accomplished, including even whether it includes a breathalyzer device.” Mot. 14. Presumably, Patent Owner is arguing that Ku fails to teach “a breath alcohol content sensor housed within the case for sensing breath alcohol content of a user during a breath test,” as recited in claim 23 (and similarly in claim 27).

According to Ku, “the external sensor 36 is used to measure the alcohol content in the expired air from the mouth.” Ex. 1103 ¶ 23. Ku further describes “a sensor like an alcohol tester,” wherein the “sensor is installed on a personal portable digital image capturing device for convenient measurement of physical quantities like alcohol concentration.” *Id.* ¶ 31. Ku further explains that “[t]he sensor 12 can also be hidden in or externally connected on the personal portable digital image capturing device.” *Id.* ¶ 27. We find that Ku teaches “a breath alcohol content sensor housed within the case for sensing breath alcohol content of a user during a breath test.”

In sum, we find each limitation of claims 23 and 27 to be taught in one or more of the references, although no single reference includes every limitation. Patent Owner’s arguments amount to attacks on the references individually. “Non-obviousness cannot be established by attacking references individually where the rejection is based upon the teachings of a

combination of references.” *In re Merck & Co., Inc.*, 800 F.2d 1091, 1097 (Fed. Cir. 1986) (citing *In re Keller*, 642 F.2d 413, 425 (CCPA 1981)).

As to combining the references, Patent Owner argues that “**none** of the relevant art is directed to the problem being addressed by the ’573 patent, i.e., providing a portable, discreet system for proactively self-reporting sobriety pursuant to a predetermined schedule.” Mot. 15. Citing *Leo Pharmaceutical Products, Ltd. v. Rea*, 726 F.3d 1346 (Fed. Cir. 2013), Patent Owner argues that the invention of the substitute claims is the recognition of a problem itself. Mot. 15–16. Specifically, Patent Owner argues that “none of the cited art even recognizes the problem of allowing a user to discreetly, conveniently, and proactively self-report sobriety,” and, thus, the prior art “cannot suggest a solution to that unrecognized problem.” *Id.* at 16. Patent Owner cites to Dr. Jaffe’s testimony, which largely repeats Patent Owner’s arguments without citation to evidence. Ex. 2000 ¶ 48.

We are not persuaded. As explained above, Ku describes a discreet, hand-held device that can be used to report breath alcohol test results. Ku states that it can be used to report results to the police. Ex. 1103 ¶ 24. Williams teaches that law enforcement could set schedules on which users could proactively self-report. Ex. 1105 ¶¶ 45, 48, 49. Petitioner introduces evidence (testimony of Mr. Wojcik) that it was industry practice for law enforcement to process data in the manner described in Williams and that similar data received from Ku’s device would have been processed in the same way. Pet. 34–35; Ex. 1124 ¶ 67 (citing several examples of industry practice). We find that testimony persuasive. Dr. Jaffe’s testimony to the

contrary is unsupported by persuasive evidence and is entitled to little weight.

Patent Owner further argues:

MEMS, Williams, Walter, Ku, and Freund are all focused on a much different problem than that addressed by the Patent Owner, i.e., each reference is directed to “catching” violators in the act, e.g., *drinking while on probation, driving while impaired, recording the presence of alcohol at the time of a car accident*, etc. Ex. 2000, Jaffe Decl. at ¶48.a. The claimed invention, however, focuses on a much different issue: providing a discrete, compact, portable, and easily used single-user device for allowing a recovering alcoholic to self-report sobriety pursuant to a predetermined schedule.

Mot. 16 (emphasis added); *see also id.* at 11 (“Williams’ sole purpose is ‘catching’ alcohol use in the course of law enforcement monitoring. . . . Because it is a tool intended for law enforcement monitoring of parolee’s and other potential violators, Williams is unconcerned with allowing discretion for the user or ‘on the go’ testing.”). However, the ’573 patent lists law enforcement monitoring and prevention of impaired driving as two express uses for the invention. Ex. 1102, 3:32–34 (“The present invention is also useful for remotely monitoring sobriety in situations in which sobriety has been required as a condition of probation or by courts.”), 9:16–30 (use of the invention in a vehicle interlock system monitored by a supervisory monitor). Thus, Patent Owner has not persuasively distinguished law enforcement and vehicle interlock uses from the substitute claims.

As to Williams, Patent Owner argues that “the kiosk network of Williams was simply not intended to be used by a single user. Rather, the system actually **required** multiple users to even be feasible.” Mot. 15.

Patent Owner does not explain persuasively how this distinguishes from the proposed substitute claims (which, on their faces, do not preclude multi-user systems).

Moreover, Patent Owner has not addressed adequately the additional reasons to combine Ku, Williams, and MEMS detailed in the Petition.⁴ Specifically, as explained above, Petitioner introduced evidence that, to the extent a straw is not disclosed explicitly in Ku, adding a straw such as taught in MEMS would have been a combination of prior art elements according to known methods to yield predictable results. Pet. 22–23 (citing Ex. 1124 ¶ 62). Petitioner has also asserted, and we agree, that positioning the camera lens to capture a picture of a user during a breath test (using a straw), as taught in MEMS, would have been a matter of common sense. *Id.* at 25–26 (citing Ex. 1124 ¶ 62 (“The skilled artisan would be motivated to modify the lens of Ku and position it so as to capture an image of a user during a breath test because monitoring personnel wanted to know that the individual taking the test is the individual being monitored”)). We find this evidence persuasive.

In sum, Petitioner has introduced persuasive evidence that the prior art teaches each limitation of the substitute claims and that a skilled artisan would have had reason to combine the teachings of the prior art. Patent Owner has not persuasively rebutted that evidence.

⁴ In its Opposition, Petitioner attempts to raise additional reasons to combine the references by citing, without explanation, to several paragraphs in Mr. Wojcik’s 2nd Declaration. Opp. 23. This is an improper incorporation by reference of arguments from the declaration into the Opposition. See 37 C.F.R. § 42.6(a)(3). We decline to consider these additional reasons.

4. *Objective Indicia of Nonobviousness*

The Motion did not raise objective indicia of nonobviousness. Nevertheless, Dr. Jaffe provided testimony (not referenced in the Motion) that Patent Owner's commercial product enjoyed commercial success, fundamentally changed the field of sobriety monitoring, created a new market, and solved a long-felt but unsolved need, namely "the ability to reliably monitor alcohol consumption to help ensure abstinence without the obtrusiveness, lack of comfort, high cost, and negative social stigma attached to the state of the art before Soberlink's claimed invention." Ex. 2000 ¶¶ 26–29, 49. Patent Owner belatedly cited to this testimony, without meaningful elaboration, in the Reply. Reply 12.

Although Dr. Jaffe's testimony on these points was not cited in the Motion, Petitioner nevertheless responded that Patent Owner failed to prove any alleged commercial success and failed to show any nexus between the claimed invention and the objective indicia. Opp. 21 n.18.

We agree with Petitioner. "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) (citation omitted). 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) (citation omitted) (quoting *Rambus Inc. v. Rea*, 731 F.3d 1248, 1257 (Fed. Cir. 2013)). Dr. Jaffe's testimony is conclusory and does not cite to evidence. Nor does it identify novel elements of the

substitute claims to which the alleged objective indicia are tied.

Accordingly, we give Dr. Jaffe's testimony little weight on this point.

In the Reply, Patent Owner also argues that a weblog, Medgadget, stated that "a key problem with prior solutions was ***'the anxiety of random testing' and 'having to visit a testing center.'***" Reply 12 (quoting Ex. 2001, Exhibit B, at 3). Patent Owner similarly fails to show, or even argue, a nexus between this evidence and the alleged novel elements of the substitute claims.

At the hearing, Patent Owner attempted to raise additional arguments as to objective indicia based on the Medgadget weblog. Tr. 19:1–24:13. However, we will not consider such arguments raised for the first time at the hearing. *See Dell*, 2015-1513, slip op. at 13–14.

In sum, we find that Patent Owner has not shown a nexus between alleged objective indicia of nonobviousness and alleged novel elements of the substitute claims.

5. Patent Owner has not Shown that the Substitute Claims are Nonobvious

In sum, as explained above, the prior art teaches each limitation of the substitute claims. Petitioner has introduced evidence, with rational underpinning, to show that a skilled artisan would have combined these teachings to arrive at the substitute claims. Patent Owner, who bears the burden, has not persuasively shown the contrary. Patent Owner also has not shown any persuasive objective indicia of nonobviousness to overcome the evidence of obviousness in the record.

After weighing the evidence, we are not persuaded that Patent Owner has met its burden to demonstrate that any of the substitute claims are patentable over the prior art. For this additional reason, Patent Owner has not established that it is entitled to the relief it seeks in its Motion, namely entry of proposed substitute claims 23–28.

III. CONCLUSION

We grant Patent Owner’s request to cancel claims 6–8, 12–14, and 18–20.

Patent Owner has not shown support in the original disclosure of the ’573 patent for substitute claims 23–28. Patent Owner also has not shown that claims 23–28 are patentable over the prior art of record. Accordingly, we do not enter substitute claims 23–28.

IV. ORDER

For the reasons given, it is

ORDERED that Patent Owner’s motion to cancel claims 6–8, 12–14, and 18–20 of U.S. Patent No. 8,381,573 B2 is *granted*;

FURTHER ORDERED that Patent Owner’s Motion to Amend U.S. Patent No. 8,381,573 B2 to add claims 23–28 is *denied*; and

FURTHER ORDERED, because this is a final written decision, the 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.

IPR2015-00556
Patent 8,381,573 B2

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