

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

TELADOC, INC.,
Petitioner,

v.

AMERICAN WELL CORP.,
Patent Owner.

Case IPR2015-00924
Patent 7,590,550 B2

Before BRIAN J. McNAMARA, MICHAEL J. FITZPATRICK, and
DANIEL J. GALLIGAN, *Administrative Patent Judges*.

GALLIGAN, *Administrative Patent Judge*.

FINAL WRITTEN DECISION
35 U.S.C. § 318

I. INTRODUCTION

Teladoc, Inc. (“Petitioner”) filed a Petition (“Pet.”) requesting *inter partes* review of claims 10, 11, 23, and 30 of U.S. Patent No. 7,590,550 B2 (“the ’550 patent,” Ex. 1001). Paper 1. American Well Corporation (“Patent Owner”) did not file a Preliminary Response. We instituted trial on one of Petitioner’s six asserted grounds, namely, whether claims 10, 11, 23, and 30 are unpatentable as anticipated by Haq.¹ Paper 7 (“Dec. to Inst.”).

During the trial, Patent Owner filed a Response (Paper 10, “PO Resp.”), and Petitioner filed a Reply (Paper 19, “Reply”). In addition, Patent Owner filed a Motion to Exclude evidence. Paper 32. Patent Owner also filed Observations regarding certain cross-examination testimony of Petitioner’s declarant Mr. Scott Silverman (Paper 33), and Petitioner filed a Response to Patent Owner’s Observations (Paper 35).

An oral hearing was held on May 12, 2016, a transcript of which appears in the record. Paper 41 (“Tr.”).

We have jurisdiction under 35 U.S.C. § 6(c). This Final Written Decision is entered pursuant to 35 U.S.C. § 318(a). We conclude Petitioner has demonstrated by a preponderance of the evidence that claims 10, 11, 23, and 30 are unpatentable. *See* 35 U.S.C. § 316(e) (“In an *inter partes* review instituted under this chapter, the petitioner shall have the burden of proving a proposition of unpatentability by a preponderance of the evidence.”).

A. *Related Matters*

The parties indicate that the ’550 patent was at issue in *American Well Corp. v. Teladoc, Inc.*, No. 1:15-cv-12274-IT (D. Mass). Paper 6, 1;

¹ US Patent No. 7,412,396; Aug. 12, 2008 (filed July 30, 2001) (“Haq,” Ex. 1002).

Paper 9, 2. According to Petitioner, the district court dismissed this case because it determined claims 10, 11, 23, and 30 are directed to patent-ineligible subject matter. Paper 42, 1.

Petitioner has filed two other petitions for *inter partes* review challenging various claims of the '550 patent. Paper 42, 1–2; IPR2016-00100; IPR2016-01167. Petitioner has also filed a petition for *inter partes* review challenging all claims of related Patent 7,835,928 B2. Paper 42, 1–2; IPR2016-00101. The Board instituted trial on certain grounds in IPR2016-00100 and IPR2016-00101.

B. The '550 Patent (Ex. 1001)

The '550 patent generally relates to a system and method for receiving requests from consumers to consult with service providers and establishing a connection between consumers and service providers. Ex. 1001, Abst. The challenged claims are directed specifically to medical service providers.

Challenged claims 10, 23, and 30 are independent. Claim 11 depends from independent claim 10. Claims 10 and 11 are reproduced below:

10. A computer-implemented method comprises:
 - accessing a data repository that stores information pertaining to medical service providers, including present availability of the medical service providers for participating in a consultation;
 - receiving in a computer, indications that members of a pool of medical service providers have become presently available;
 - receiving in the computer, a request from a consumer of services to consult with a medical service provider;
 - identifying in the computer, an available member of the pool; and
 - establishing a real-time communication channel between the consumer of services and the identified member of the pool.

11. The method of claim 10 wherein:
the request includes an identification of a time in the
future; and
identifying the member of the pool and establishing the
communication channel take place at the identified time.

Ex. 1001, 27:25–44.

II. ANALYSIS

A. Claim Construction

In an *inter partes* review, “[a] claim in an unexpired patent shall be given its broadest reasonable construction in light of the specification of the patent in which it appears.” 37 C.F.R. § 42.100(b); *Cuozzo Speed Techs., LLC v. Lee*, 136 S. Ct. 2131 (2016). In determining the broadest reasonable construction, we presume that claim terms carry their ordinary and customary meaning. *See In re Translogic Tech., Inc.*, 504 F.3d 1249, 1257 (Fed. Cir. 2007). This presumption may be rebutted when a patentee, acting as a lexicographer, sets forth an alternate definition of a term in the specification with reasonable clarity, deliberateness, and precision. *In re Paulsen*, 30 F.3d 1475, 1480 (Fed. Cir. 1994).

Petitioner proposed constructions for three phrases of the ’550 patent: “information pertaining to medical service providers,” “a real-time communication channel,” and “a time in the future.” *See* Pet. 13–17. Patent Owner did not file a Preliminary Response and, therefore, did not propose constructions prior to institution. In our Decision to Institute, we determined that these phrases, as well as the remaining terms in the challenged claims, did not require express constructions. *See* Dec. to Inst. 4–6.

1. *Presently Available and Present Availability*

During the trial, Patent Owner proposed constructions for the following phrases in the challenged claims: “have become presently available” and “present availability.” PO Resp. 15–23. Patent Owner contends that “[t]he term[s] presently and currently are used interchangeably in the ’550 patent and the file history” and that they are synonyms and mean “right now.” *Id.* at 16. Therefore, according to Patent Owner, these phrases should be construed to mean, respectively, “have become *currently* available” and “*current* availability.” *Id.* at 16, 23 (emphases added). In its Reply, Petitioner disputes Patent Owner’s proposed constructions and argues that the plain and ordinary meaning of “presently available” should apply, which Petitioner construes as “being available at the present.” Reply 8.

Patent Owner argues that the prosecution history confirms its proposed interpretations because the term “presently” was added to overcome prior art patent publication 2004/0019579 (“Herz”) that allegedly disclosed availability in terms of willingness to accept referrals rather than present availability for participating in a consultation. PO Resp. 17–18 (citing Ex. 1005 at 166–67). In particular, during prosecution, the applicant stated:

Herz fails to disclose “determining in the computer, which of the service providers are *presently available*”

Herz’s “availability list” is merely indicative of the candidate’s willingness to accept client referrals. For this reason, *Herz*’s “availability list” fails to disclose a “candidate[’s]” “*present availability*” for “participating in a consultation.” That is, in *Herz*, a “candidate” who is “looking for clients” would be listed on the “availability list” even though the “candidate” is “offline” or otherwise not “currently available” to engage with a client.

Ex. 1005, 166–67 (brackets and emphases in original).

Patent Owner argues the specification of the '550 patent confirms that “presently” available means “currently” available. PO Resp. 19–21. In particular, Patent Owner argues the following passage from the '550 patent describes six different availability states, only the first being one in which a provider is “presently available”:

Providers participating in the brokerage network can have several states of availability over time. States in which the provider may be available may include [1] on-line, in which the provider is logged-in and can accept new engagements in any mode, [2] on-line (busy), in which the provider is logged-in but is currently occupied in a video or telephonic engagement, and [3] scheduled, in which the provider is offline but is scheduled to be online at a designated time-point and can pre-schedule engagements for it. While not online, the provider can take messages as in offline state. Other states may include [4] off-line, in which the provider is not logged in but can take message based engagements (i.e., asynchronous engagements), [5] out of-office, in which the provider is not accepting engagements or messages, and [6] standby, in which the provider is offline and can be paged to Online status by the brokerage network if traffic load demands it (in some examples, consumers see this state as offline).

PO Resp. 19–20 (quoting Ex. 1001, 6:59–7:8 (numbering added by Patent Owner)). Patent Owner contends that a provider is available, but not “presently available,” in states 2, 3, 4, and 6, and is not available at all in state 5. PO Resp. 19–20.

The phrase “presently available” does not appear in the specification of the '550 patent. Further, the cited passage from the '550 patent does not limit the possible states of availability to only certain states. Rather, the cited passage discloses that “[s]tates in which the provider may be available *may include*” various states. Ex. 1001, 6:59–61 (emphasis added). The '550

patent, therefore, uses open-ended language rather than describing these states as the only possible availability states. Although a provider who is on-line, logged-in, and able to accept new engagements in any mode may be one example of a “presently available” provider, the specification does not limit the meaning of “presently available” as such.

To the extent “presently” and “currently” are synonyms, as Patent Owner contends (PO Resp. 16), there is no need to substitute “currently” for “presently.” On the other hand, if “currently” has a narrower meaning than “presently,” the intrinsic record does not demonstrate that such a narrowing limitation should be imported into the challenged claims. Indeed, dictionaries cited by Patent Owner to support its position that “presently” and “currently” are synonyms and mean “right now” provide several other definitions that undermine Patent Owner’s position. *See* Exs. 2004–06. Addressing this, Patent Owner states: “‘Presently’ also has a second contradictory meaning, ‘in a short time; soon,’ Ex. 2004, or ‘in a little while,’ Ex. 2006; however the intrinsic evidence is consistent only with this first definition, ‘have become currently available.’” PO Resp. 17 n.4. We do not agree that the intrinsic record compels the narrower interpretation. As noted above, the ’550 patent specification does not even use the term “presently available,” let alone provide a definition for it. The cited portions of the prosecution history demonstrate that certain claims were amended to recite “presently available” or “present availability” to distinguish from prior art disclosing availability in terms of “willingness to accept client referrals.” Ex. 1005, 166. Thus, the prosecution history informs an ordinarily skilled artisan that a general willingness to accept referrals is not encompassed within “presently available.” The prosecution history does not compel the

conclusion that “presently available” means only “currently available” in the sense of available “right now.”

Patent Owner further argues a person of ordinary skill in the art “would recognize that part of the novelty of [the ’550 patent] was a system for giving a patient ‘an on-demand, real-time consultation with a physician’ who could give ‘immediate attention’ and an ‘immediate response’ to patients.” PO Resp. 21 (citing Ex. 1001, 2:63–64, *et seq.*; Ex. 2001 at ¶¶ 15, 23). Patent Owner also argues:

To permit the “on-demand” “immediate” system described in the specification, as described above, the [person of ordinary skill in the art] would recognize that the challenged claims rely on identifying which medical providers are currently available; this is what is meant by “receiv[ing] indications that members of a pool of medical service providers have become presently available.”

PO Resp. 21.

Contrary to Patent Owner’s assertions, however, the challenged claims do not “rely on identifying which medical providers are currently available.” Rather, independent claim 10 recites “identifying in the computer, an *available* member of the pool.”² (Emphasis added).

According to Patent Owner’s characterization of the states of availability in the ’550 patent, such an “available” provider can include one who is “currently occupied” or even “offline” so long as he is scheduled to be online later, for example. *See* PO Resp. 20; *see also* Ex. 1001, 6:60–7:8

² Counsel for Patent Owner confirmed this during the oral hearing. *See* Tr. 73:1–4 (“So the database is collecting information from the pool. But as I said earlier, the identification step that we talk about there, we’re saying an available member of the pool does not mean that it’s necessarily choosing a presently available member.”).

(providing open-ended list of states of availability). Therefore, Patent Owner's arguments that the challenged claims require identifying providers who are "presently available" are not commensurate with the scope of the claims and do not support Patent Owner's proposed claim constructions.

Patent Owner also relies on the Declaration of Dr. Ronald S. Weinstein (Ex. 2001, "Weinstein Declaration") in support of its proposed constructions. Dr. Weinstein testifies: "A medical doctor familiar with telehealth at the time of the creation of the ['550] patent, such as myself, would have understood 'presently available' as that term is used in the ['550] patent as meaning that the medical service provider is prepared to pay immediate attention to the case." Ex. 2001 ¶ 15. Dr. Weinstein further opines that "'[p]resently available' means currently available—set to go, in the context of this type of medical service." *Id.* ¶ 19. As noted above, the phrase "presently available" does not appear in the specification of the '550 patent, and Dr. Weinstein does not cite any disclosure from the '550 patent supporting his opinion as to the meaning of "presently available" in the challenged claims. Therefore, Dr. Weinstein's testimony as to the meaning of "presently available" "at the time of the creation" of the '550 patent provides us little, if any, meaningful insight as to the broadest reasonable interpretation of "presently available." See 37 C.F.R. § 42.65(a) ("Expert testimony that does not disclose the underlying facts or data on which the opinion is based is entitled to little or no weight.").

We reject Patent Owner's constructions for "have become presently available" and "present availability" as unreasonably narrow and determine that those limitations do not require express constructions. All remaining

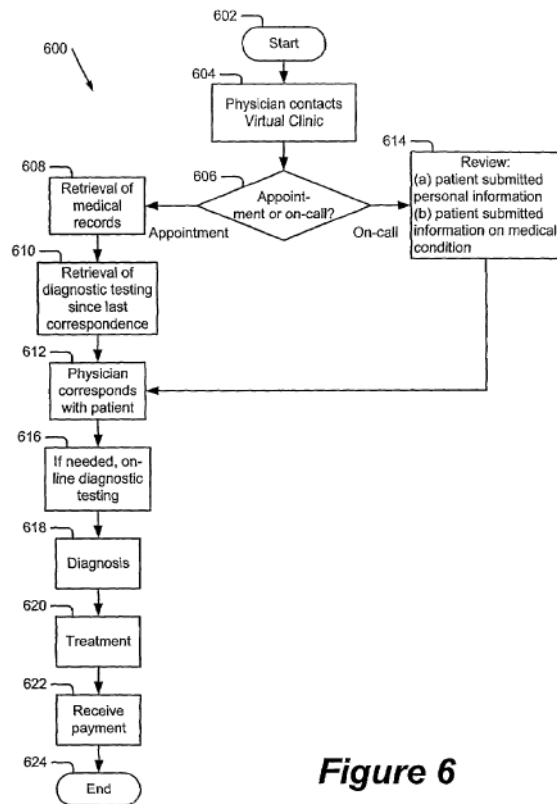
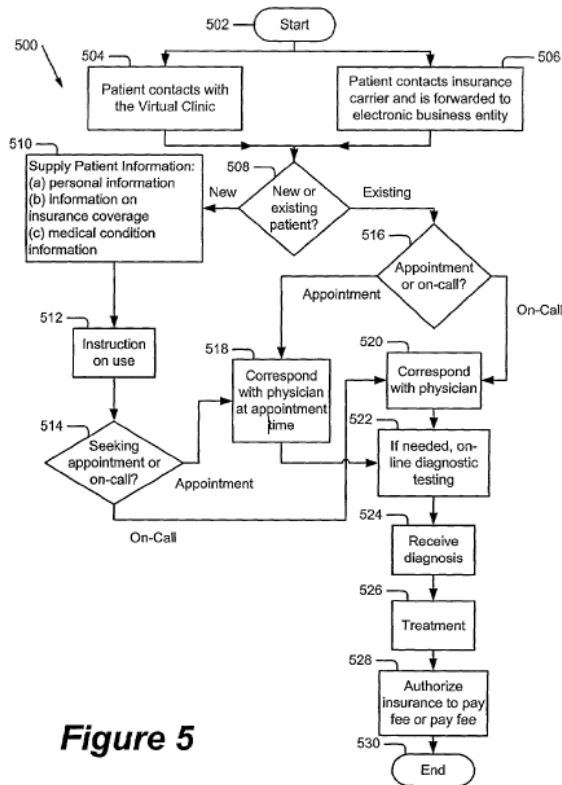
claim terms or phrases recited in claims 10, 11, 23, and 30 need not be construed expressly.

B. Anticipation by Haq

Petitioner contends that Haq anticipated claims 10, 11, 23, and 30. Pet. 18–25.

1. Haq Disclosure

Haq describes a “virtual clinic” that “enables a patient to request consultation with a medical professional.” Ex. 1002, 4:61–65. Figures 5 and 6 of Haq are reproduced below:



Figures 5 and 6 are flow charts illustrating the use of the “virtual clinic” from the perspectives of a patient and a physician, respectively. Ex. 1002, 4:8–11, 9:38–10:40.

Haq discloses that “[i]nitially, the physician contacts the virtual clinic, step 604, informing the virtual clinic whether he is going on-line to conduct an appointment or is available for on-call conferences, step 606.” Ex. 1002, 10:23–26, Fig. 6. A patient can request an appointment or request to speak with an on-call physician. *Id.* at 10:1–8. If a patient requests an on-call physician, “then the patient’s information on his/her medical condition is used to determine a suitable physician and the virtual clinic determines whether that physician is on-call at that time.” *Id.* at 10:8–12. “If the physician is on-call, the patient may correspond directly with the physician, step 520.” *Id.* at 10:12–14. Haq further discloses that, once a medical professional is selected, “the virtual clinic establishes communications with the medical professional (typically a physician) and then either coordinates the communications link between the physicians and patient or simply tells the patient or physician how to contact the other party directly.” *Id.* at 5:19–24.

2. *Claim 10*

Petitioner presents an analysis of Haq accompanied by a claim chart to explain how Haq discloses the steps recited in claim 10. Pet. 19–22.

Patent Owner does not dispute Haq discloses the following steps of claim 10: “receiving in the computer, a request from a consumer of services to consult with a medical service provider”; “identifying in the computer, an available member of the pool”; and “establishing a real-time communication channel between the consumer of services and the identified member of the

pool.” *See generally* PO Resp. 30–45. Consistent with the evidence presented in this proceeding, we find Haq discloses these limitations. *See* Pet. 19–22.

Claim 10 also recites “accessing a data repository that stores information pertaining to medical service providers, including present availability of the medical service providers for participating in a consultation” and “receiving in a computer, indications that members of a pool of medical service providers have become presently available.” Petitioner contends, *inter alia*, Haq’s disclosure regarding physician availability for on-call conferences discloses these limitations. *See* Pet. 21–22; *see also* Reply 10–21 (addressing Patent Owner’s arguments to the contrary). In particular, Haq discloses:

FIG. 6 shows a flow chart 600 of an embodiment of a method of the present invention from a physician’s perspective. The method starts out generally at step 602. Initially, the physician contacts the virtual clinic, step 604, informing the virtual clinic whether he is going on-line to conduct an appointment or is available for on-call conferences, step 606.

Ex. 1002, 10:21–26 (cited at Pet. 21).

We find Haq’s disclosure of physicians’ initially contacting the virtual clinic to inform it that they are “available for on-call conferences” discloses the virtual clinic’s receiving indications that members of a pool of medical service providers (i.e., “physicians”) “have become presently available,” as recited in claim 10, so that patients can be connected to those physicians. *See* Ex. 1002, 10:21–26. Indeed, this on-call availability information is used by the virtual clinic of Haq to connect patients seeking on-call care, rather than seeking an appointment, with physicians who are available to be contacted in such cases. Ex. 1002, 9:63–10:14. Haq discloses that the

virtual clinic “determine[s] a suitable physician” and “determines whether that physician is on-call at that time.” *Id.* at 10:11–12. Therefore, we find Haq also discloses “accessing a data repository that stores information pertaining to medical service providers, including present availability of the medical service providers for participating in a consultation.” In particular, the virtual clinic accesses data pertaining to its physicians, including their “availab[ility] for on-call conferences,” which is within the scope of “present availability . . . for participating in a consultation.” *See id.* at 10:1–26.

In its Response, Patent Owner argues Haq’s disclosure regarding on-call availability does not disclose the limitations of claim 10 reciting “presently available” and “present availability.” PO Resp. 30–45.

We address Patent Owner’s arguments below.

a. Presently Available and Present Availability

Patent Owner’s arguments are largely based on the premise that “present availability,” as recited in claim 10, does not encompass “on-call” availability, as disclosed in Haq. *See* PO Resp. 30–45. Patent Owner argues the ’550 patent’s “specification and file history distinguish the state of being available [sic] for on-call conferences from ‘have become presently available.’” *Id.* at 22. The specification of the ’550 patent does not use either the term “on-call” or the phrase “presently available” to describe a state of availability, and, therefore, it does not distinguish between “on-call” and “presently available.” Nor do the cited portions of the prosecution history use the term “on-call.” *See* Ex. 1005, 165–70. Rather, the portions of the prosecution history relied on by Patent Owner show an attempt to distinguish the amended claims from prior art that allegedly discloses an

“‘availability list’ [that] is merely indicative of the candidate’s willingness to accept client referrals.” Ex. 1005, 166.

During prosecution, the applicant stated:

Herz’s “availability list” is merely indicative of the candidate’s willingness to accept client referrals. For this reason, Herz’s “availability list” fails to disclose a “candidate[’s]” “present availability” for “participating in a consultation.” That is, in Herz, a “candidate” who is “looking for clients” would be listed on the “availability list” even though the “candidate” is “offline” or otherwise not “currently available” to engage with a client. This is illustrated by the fact that “once the candidate has indicated his availability, his interaction with the system is over.” (Herz, ¶0018.)

Ex. 1005, 166–67 (brackets and emphases in original). Haq’s disclosure relating to on-call availability is not merely disclosing a provider’s willingness to accept client referrals. Rather, Haq discloses being “available for on-call conferences.” Ex. 1002, 10:26. As Patent Owner acknowledges, Haq’s virtual clinic “provides on-call doctors for urgent problems.” PO Resp. 1. Haq’s “on-call” physicians are presently available for the specific purpose of conversing with patients seeking urgent care, and, therefore, Haq provides the disclosure of “present availability” applicant alleged was lacking in the prior art during prosecution.

Patent Owner also relies on the ’550 patent’s disclosure pertaining to availability tracking to distinguish the disclosure of Haq from the limitations of the claims. See PO Resp. 8–9, 26, 33, 37–38. According to Patent Owner, “Haq discloses no mechanism for the virtual clinic to receive indications that the on-call physician has become presently available,” whereas the ’550 patent “has detailed disclosures of active and passive

tracking of a medical service provider's present availability.” PO Resp. 33 (citing Ex. 1001, 6:31–58, 7:22–29).

As an initial matter, the cited passages do not mention tracking *present* availability, as asserted by Patent Owner. Rather, these passages concern tracking mere availability. See Ex. 1001 at 6:31–58, 7:22–29; see also Ex. 1001 at 3:55–4:8. For example, these passages describe tracking availability in terms of being “available to be contacted by consumers” and “available to interact with consumers.” *Id.* at 3:60–61, 6:36–37.

The '550 patent explains that availability can be tracked actively or passively:

The computerized system 110 includes an availability or presence tracking module 112 for tracking the availability of the service providers 130. Availability or presence is tracked actively or passively. In an active system, one or more of the service providers 130 provides *an indication to the computerized system 110 that the one or more service providers are available to be contacted by consumers 120* and an indication of the mode by which the provider may be contacted. In some examples of an active system, the provider's computer, phone, or other terminal device periodically provides an indication of the provider's availability (e.g., available, online, idle, busy) to the system 110 and a mode (e.g., text, voice, video, etc.) by which he can be engaged. In a passive system, the computerized system 110 presumes that the service provider 130 is available by the service provider's actions, including connecting to the computerized system 110 or registering the provider's local phone number with the system. In some examples of a passive system, the system 110 indicates the provider 130 to be available at all times until the provider logs off, except when the provider is actively engaged with a consumer 120.

Ex. 1001 at 3:55–4:8 (emphasis added).

The '550 patent further discloses:

Referring now to FIG. 3, the computerized system 110 tracks 142 the availability of providers 130 and consumers 120. When a provider 130 logs 144 into the system 100, the provider 130 indicates 146 (such as by setting a check box or selecting a menu entry or by responding to a voice prompt) to the tracking module 112 that he or she is *available to interact with consumers* 120. . . . The tracking module 112 can also infer 152 a provider's availability and modes of engagement by the provider's previously provided profile information and the terminal device through which the provider connects to the system.

Id. at 6:31–58 (emphasis added).

To the extent these passages inform a person of ordinary skill in the art as to the meaning of “indications that members of a pool of medical service providers have become presently available,” they show that such indications include an indication that a provider has become available to interact with consumers or to be contacted by consumers. Haq discloses such indications by disclosing that “[i]nitially, the physician contacts the virtual clinic, step 604, informing the virtual clinic whether he is going on-line to conduct an appointment or *is available for on-call conferences*, step 606.” Ex. 1002, 10:23–26 (emphasis added). Haq discloses providing patients the option of requesting an appointment or urgent care. *See id.* at 5:42–44, 6:10–15, 10:1–8. Haq discloses that “if a patient wishes to correspond with [a] physician pursuant to an appointment, an appointment is set up through the virtual clinic.” *Id.* at 10:4–6. However, if “the patient wishes to converse with a physician on-call, then the patient’s information on his/her medical condition is used to determine a suitable physician and the virtual clinic determines whether that physician is on-call at that time.” *Id.* at 10:9–12. Haq also discloses that, “[i]f the physician is on-call, the patient may correspond directly with the physician.” *Id.* at 10:12–14. Patent

Owner acknowledges Haq's virtual clinic "provides on-call doctors for urgent problems." PO Resp. 1; *see also* PO Resp. 38–39 (Haq discloses "for urgent care passing the patient to the on-call physician."). Therefore, the physician-provided indications of availability for on-call conferences disclosed in Haq are consistent with indications that a provider has become available to interact with consumers or to be contacted by consumers, as described with respect to availability tracking in the '550 patent. *See* Ex. 1001, 3:55–4:8, 6:31–58, 7:22–29.

Patent Owner argues that being "available for on-call conferences" in Haq

is most analogous to what [the '550 patent] calls its "standby" mode wherein a provider can be off-line after having notified the system that he or she is "available for on-call conferences," and where the provider "can be paged to Online status by the brokerage network if traffic load demands it."

PO Resp. 33 (citing Ex. 1001, 7:5–8). Patent Owner further argues that "[d]uring prosecution, the inventor confirmed that such off-line providers in this standby mode are not presently available." PO Resp. 33.

First, as noted above, the specification of the '550 patent and the cited portions of the file history do not use the term "on-call," much less equate the "standby" state of availability with on-call availability. Second, Haq does not disclose that a physician who "is available for on-call conferences" is "off-line." Rather, Haq states that "the physician contacts the virtual clinic, step 604, informing the virtual clinic whether he is going on-line to conduct an appointment or is available for on-call conferences, step 606." Ex. 1002, 10:23–26. This is similar to the availability tracking of the '550 patent, discussed above, in which providers indicate to the system that they

are “available to be contacted by consumers” or are “available to interact with consumers.” Ex. 1001, 3:60–61, 6:36–37.

Patent Owner also relies on the testimony of Dr. Weinstein, who opines that

[a] medical service provider could be on-call, and available within a previously agreed upon time interval, without being “presently available.” A doctor could be “available for on-call conferences” per Haq but not “presently available” because the on-call doctor is treating another patient, attending to other business, or even on the golf course.

Ex. 2001 ¶ 21. Dr. Weinstein further testifies that “[a]t the time of the invention of the [’550] patent, no telemedicine system to that date would have equated ‘available for on-call conference’ as actually being synonymous with ‘presently available.’” *Id.* ¶ 23.

Dr. Weinstein does not cite any disclosure from the ’550 patent supporting his opinion that “presently available,” a phrase that is not used, much less defined, in the specification of the ’550 patent excludes on-call availability as disclosed in Haq. Nor does Dr. Weinstein cite supporting evidence demonstrating that “presently available” was a phrase that would have been readily understood to a person of ordinary skill in the relevant art at the time of the invention of the ’550 patent to exclude on-call availability as described in Haq. *See* 37 C.F.R. 42.65(a) (“Expert testimony that does not disclose the underlying facts or data on which the opinion is based is entitled to little or no weight.”). We have considered Dr. Weinstein’s testimony, but we do not find it probative of a distinction between being “on-call,” as described in Haq, and being “presently available,” as recited in the challenged claims.

In sum, we find Haq’s disclosure of physician “availab[ility] for on-call conferences” (Ex. 1002, 10:26) to be within the broadest reasonable interpretation of “present availability of the medical service providers for participating in a consultation,” as recited in claim 10. *See* Pet. 21–22. Likewise, we find the physician-provided indications of availability for on-call conferences disclose indications that “medical service providers have become presently available,” consistent with the broadest reasonable interpretation of “presently available.” *See id.*

b. “Pool of Medical Service Providers”

Patent Owner argues:

The petition does not address the claim limitation requiring that indications of present availability be received for members of a pool of medical providers. The words “indications,” “members,” and “providers” are plural. The [’550 patent] system relies on tracking the present availability of a **pool** of medical service providers because that is the only way to ensure that some provider is available right now. Haq is focused on scheduling an appointment between an identified physician and the patient (and for urgent care passing the patient to the on-call physician); so, Haq has no need to track the present availability of a pool of providers.

PO Resp. 38–39. We disagree.

We find Petitioner has proven Haq discloses “receiving in a computer, indications that members of a pool of medical service providers have become presently available,” as recited in claim 10. The multiple physicians in Haq’s virtual clinic disclose “a pool of medical service providers,” as recited in claim 10. The virtual clinic tracks the “pool” of providers through each provider’s interaction with the system, such as described with reference to Figure 6, illustrating “an embodiment of a method of the present invention from a physician’s perspective.” Ex. 1002, 10:21–23.

To the extent it is Patent Owner’s contention that the virtual clinic in Haq interacts with only one physician, this is not a reasonable reading of Haq, which explicitly defines “virtual clinic” as “a professional association such as a corporation or partnership . . . that hires or otherwise contracts with physicians.” *Id.* at 4:34–39. Haq further discloses that, “[o]nce the virtual clinic establishes sufficient working relationships with physicians and/or insurance carriers and/or employers, it creates a presence on the network by, for example, creating a Web page that enables a patient to request consultation with a medical professional.” *Id.* at 4:61–65. Haq still further discloses that “[t]he virtual clinic maintains a list of the physicians with their specialities [sic], their qualifications and relevant information (board certification, school and year of graduation, experience and expertise, etc.).” *Id.* at 6:6–9. Therefore, Haq is explicit that the virtual clinic deals with multiple providers, i.e., a “pool.”

c. Multiple Embodiments

Patent Owner argues Petitioner improperly relies on multiple embodiments and has not shown that there is a single embodiment containing all claim elements, and, therefore, Petitioner has not shown Haq anticipated the challenged claims. PO Resp. 23–30; *see Net MoneyIN, Inc. v. VeriSign, Inc.*, 545 F.3d 1359, 1371 (Fed. Cir. 2008) (“[U]nless a reference discloses within the four corners of the document not only all of the limitations claimed but also all of the limitations arranged or combined in the same way as recited in the claim, it cannot be said to prove prior invention of the thing claimed and, thus, cannot anticipate under 35 U.S.C. § 102.”). We disagree.

Patent Owner acknowledges that a particular passage in Haq (9:38–10:40) “describes *an embodiment* contained in two figures, Fig. 5 & 6 that are, respectively, ‘from a patient’s perspective’ and ‘from a doctor’s perspective.’” PO Resp. 29 n.6. We find that this “embodiment” alone discloses all limitations of the challenged claims. *See* Pet. 21–22. For example, the virtual clinic receives “indications that members of a pool of medical service providers have become presently available” when physicians contact the virtual clinic to inform it that the physician “is available for on-call conferences,” as discussed above. Ex. 1002, 10:21–26. The virtual clinic of Haq discloses receiving “a request from a consumer of services to consult with a medical service provider” when a patient requests “an appointment or an on-call contact with a physician.” *Id.* at 10:1–8. Haq discloses “the patient’s information on his/her medical condition is used to determine a suitable physician and the virtual clinic determines whether that physician is on-call at that time.” *Id.* at 10:9–12. Thus, Haq discloses a “pool of medical service providers,” as recited in claim 10, from which “a suitable physician” is identified. In addition, Haq discloses determining if the chosen “physician is on-call at that time” (*id.* at 10:11–12), thereby disclosing accessing stored information, including “present availability of the medical service providers for participating in a consultation.” Haq further discloses that, “[i]f the physician is on-call, the patient may correspond directly with the physician, step 520.” *Id.* at 10:12–14. Thus, Haq discloses “identifying in the computer, an available member of the pool,” and “establishing a real-time communication channel between the consumer of services and the identified member of the pool.”

In the context of its anticipation arguments, we do not find improper Petitioner's citations to other relevant passages in Haq describing the "virtual clinic," such as information maintained by the virtual clinic or the communication channels by which patients and doctors may correspond through the virtual clinic. *See, e.g.*, Pet. 18–22 (citing, *inter alia*, Ex. 1002, 6:6–9 (describing that the "virtual clinic maintains a list of the physicians" with associated information about the physicians), 2:35–38, 10:59–62 (describing exemplary communication channels between patient and physician)).

As an example of allegedly incompatible embodiments, Patent Owner points to two passages in Haq it contends are describing different ways to select a doctor. PO Resp. 27–29. In one passage, Haq discloses:

The virtual clinic maintains a list of the physicians with their specialties [sic], their qualifications and relevant information (board certification, school and year of graduation, experience and expertise, etc.).

When a patient accesses the virtual clinic, he/she is asked to choose a physician from among those on their panel, or if the patient does not have a preference or needs urgent care and his/her personal choice is not available for providing urgent care, the virtual clinic connects him/her to an appropriate physician in the specialty which the patient is seeking.

Ex. 1002, 6:6–15. In another passage, Haq discloses:

Referring back to step 508, likewise, if the patient is an existing patient, he is questioned whether he seeks an appointment or an on-call contact with a physician. From step 514 and step 516, if a patient wishes to correspond with physician pursuant to an appointment, an appointment is set up through the virtual clinic with both the patient and physician, such that the patient may correspond with the physician at the appointment time, step 518. If from step 514 or step 516 the patient wishes to converse with a physician on-call, then the

patient's information on his/her medical condition is used to determine a suitable physician and the virtual clinic determines whether that physician is on-call at that time.

Id. at 10:1–12.

Patent Owner argues that the first passage discloses selecting a physician based on patient preferences (“the specialty which the patient is seeking”) whereas the second passage discloses using information about the patient's medical condition, not patient preferences, to select a physician. PO Resp. 28–29. Patent Owner contends Petitioner relies on these “alternate embodiment[s]” to disclose “accessing a data repository that stores information pertaining to medical service providers, including present availability of the medical service providers for participating in a consultation,” as recited in claim 10.

We do not find one passage to be exclusive of the other, as suggested by Patent Owner. The first cited passage is from a portion of the “Detailed Description” providing general information about the “virtual clinic” before the figures are discussed in detail. *See* Ex. 1002, 4:26–6:15. The second cited passage describes exemplary interactions with the virtual clinic from a patient's perspective and from a physician's perspective. *See id.* at 9:38–10:40, Figs. 5 and 6. Both passages disclose selecting an “appropriate” or “suitable” physician based on information supplied by the consumer, such as a particular specialty or a medical condition. Elsewhere, Haq discloses the correlation between condition of the patient and specialty of the physician, explaining that a medical professional is selected “based on an appropriate set of criteria that can include, but is not limited to, the patient's current location (for legal licensure constraints), *condition (for specialization)*, and

time (availability of the medical professional within a time zone having those working hours).” Ex. 1002, 5:11–19 (emphasis added).

As discussed above, we find Petitioner has shown that the embodiment in Figures 5 and 6 of Haq, disclosing the operation of the virtual clinic, anticipated the challenged claims. See Pet. 21–22. Moreover, Petitioner’s reliance on additional teachings in Haq to further support its challenge is not improper as we find these teachings would further inform a person of ordinary skill in the art as to the operation of the virtual clinic.

d. Claim 10 Conclusion

Petitioner has demonstrated by a preponderance of the evidence that claim 10 is unpatentable as anticipated by Haq.

3. Claim 11

Patent Owner contends Haq does not disclose that “the request includes an identification of a time in the future,” as recited in claim 11. PO Resp. 45. Patent Owner argues Haq merely discloses that a consumer requests an appointment, following which an appointment is set up, but “does not disclose how a ‘time in the future’ is identified.” *Id.* (citing Ex. 1002, 10:1–6). We disagree.

As an initial matter, we note that Patent Owner appears to concede that Haq discloses a request from a patient identifying a particular time for a desired appointment when it argues that “Haq, in contrast, assumes a classical model of an appointment with a particular provider, who may not be available *at the time the patient wants to meet*, and whose identity is determined at the time the patient requests the appointment.” PO Resp. 46 (emphasis added). A request from a patient seeking an appointment identifying “the time the patient wants to meet” discloses a request to

consult with a medical service provider that “includes an identification of a time in the future.”

Haq discloses that “if a patient wishes to correspond with [a] physician pursuant to an appointment, an appointment is set up through the virtual clinic with both the patient and physician, such that the patient may correspond with the physician *at the appointment time*.” Ex. 1002, 10:4–8 (emphasis added). We find Haq’s disclosure regarding setting up an appointment discloses a request from a consumer that “includes an identification of a time in the future.”

Even if an appointment time is not originally proposed by the consumer/patient but, rather, is proposed based on a doctor’s schedule, as Patent Owner argues (*see* PO Resp. 45), we find Haq discloses a request from the consumer including an identification of a time in the future. In particular, Haq discloses “an appointment is set up through the virtual clinic *with both the patient and physician*.” Ex. 1002, 10:5–7. Therefore, at the very least, the patient in Haq informs the virtual clinic that an appointment at a particular time is acceptable, whether proposed by the patient, the virtual clinic, or the physician. Such a negotiation for an appointment between the consumer and the virtual clinic and the doctor, therefore, may include multiple “requests” from the consumer, at least one of which is within the broadest reasonable interpretation of a “request from a consumer of services to consult with a medical service provider” that includes “an identification of a time in the future.”

Patent Owner also argues “claim 11 requires two steps ‘take place *at the identified time*’: (1) ‘identifying the member of the pool,’ and (2) ‘establishing the communication channel.’” PO Resp. 46. Although we

agree with Patent Owner that claim 11 requires both the “identifying” step and the “establishing” step to “take place at the identified time,” we do not agree that an earlier, additional identification of “the member of the pool” is precluded by claim 11. Therefore, claim 11 is not limited to a situation in which the “identity [of the provider] is not known until a ‘future time’ based on who, at that ***future time*** is currently available,” as argued by Patent Owner. *See id.*

As explained above, Haq discloses setting up an appointment pursuant to a consumer request. *See* Ex. 1002, 10:1–8. Haq also discloses the limitation of claim 10 reciting “establishing a real-time communication channel between the consumer of services and the identified member of the pool.” For example, Haq states that “[t]he virtual clinic then provides the proper connectivity between the selected physician and the patient or otherwise enables them to communicate.” *Id.* at 6:64–66. Patent Owner does not dispute that Haq discloses this limitation of claim 10. As Patent Owner argues, claim 11 requires the establishing step to be performed “at the identified time.” PO Resp. 45–46. We find that, in the case of an appointment, Haq discloses that the “communication channel between the consumer of services and the identified member of the pool” is established at the appointment time. Ex. 1002, 10:5–8 (emphasis added) (“[A]n appointment is set up through the virtual clinic with both the patient and physician, *such that the patient may correspond with the physician at the appointment time . . .*”).³

³ During the oral hearing, counsel for Patent Owner confirmed Haq discloses making a connection at the time of the appointment. Tr. 37:7–17 (emphasis added) (“The point is this is all about the question of how you make the

Patent Owner argues that, in the case of an appointment, Haq discloses identifying the provider at the time of the request, not at the time of the appointment. PO Resp. 46–47. As we explain above, however, claim 11 requires “identifying the member of the pool . . . at the identified time,” but it does not preclude an earlier identification of that member. Even if Haq discloses that the appointment is arranged at the time the request is made and that the physician is identified at that time, as Patent Owner argues, we find Haq discloses identifying the physician at the appointment time because a connection could not be made between the patient and the physician absent such an identification. The identification in Haq at the time of the appointment may not be the *first* identification of the physician for that appointment, but it is still an identification that is necessary to establish a connection at the time of the appointment.

Because claim 11 recites certain steps that must be performed at a certain time, rather than precluding certain steps from being performed at an earlier time, we find Haq’s disclosure of arranging an appointment and connecting patient and physician at the appointment time discloses the limitations of claim 11.

Petitioner has demonstrated by a preponderance of the evidence that claim 11 is unpatentable as anticipated by Haq. *See* Pet. 20–22.

connection. *Haq is saying when we set up this virtual clinic, we envision that either the connection can be facilitated through the virtual clinic at the time of the appointment or otherwise, or they can correspond directly with each other without the virtual clinic being involved. That’s what this is getting at.”*

4. *Claims 23 and 30*

Independent claim 23 is directed to a “computer program product comprising instructions for causing a computer to” perform steps corresponding to the steps of claim 10. Similarly, independent claim 30 is directed to an apparatus having a processor and a “computer program product comprising instructions for causing the processor to” perform steps corresponding to the steps of claim 10. Petitioner contends, “[t]he virtual clinic includes a software program running on a computer system that is connected to the network, the software comprises instructions to implement the features of the virtual clinic.” Pet. 22 (citing Ex. 1002, 3:39–46, 4:39–50, 7:52–58, 8:16–39). For example, Haq discloses that “[t]he virtual clinic can be a hardware device that is connected to a suitable network, or a software program running on a computer system that is connected to the network, or any combination there between.” Ex. 1002, 4:39–42.

We find that Petitioner has shown that Haq discloses the additional subject matter recited in claims 23 and 30.

Petitioner has demonstrated by a preponderance of the evidence that claims 23 and 30 are unpatentable as anticipated by Haq.

III. MOTION TO EXCLUDE

Patent Owner filed a Motion to Exclude Exhibit 1012, which is a declaration by Scott Silverman, and portions of Exhibits 1013 and 1014, which are, respectively, excerpts from the transcript and the complete transcript, of the deposition of Patent Owner’s declarant Dr. Weinstein. Paper 32. Because we do not rely on Exhibits 1012, 1013, or 1014 in any manner, we dismiss Patent Owner’s Motion to Exclude as moot.

IV. CONCLUSION

For the foregoing reasons, we find that Petitioner has demonstrated by a preponderance of the evidence that claims 10, 11, 23, and 30 of the '550 patent are unpatentable under 35 U.S.C. § 102 as anticipated by Haq.

V. ORDER

Accordingly, it is:

ORDERED that claims 10, 11, 23, and 30 of Patent 7,590,550 B2 are unpatentable;

FURTHER ORDERED that Patent Owner's Motion to Exclude is dismissed as moot; and

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

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Patent 7,590,550 B2

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