

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

FITBIT, INC.,
Petitioner,

v.

BODYMEDIA, INC.,
Patent Owner.

Case IPR2016-00707
Patent 8,398,546 B2

Before TREVOR M. JEFFERSON, MICHAEL J. FITZPATRICK, and
FRANCES L. IPPOLITO, *Administrative Patent Judges*.

JEFFERSON, *Administrative Patent Judge*.

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

I. INTRODUCTION

Fitbit, Inc. (“Petitioner”) filed a Petition (Paper 2, “Pet.”) to institute an *inter partes* review of claims 1–29 of U.S. Patent No. 8,398,546 B2 (Ex. 1001, “the ’546 patent”) pursuant to 35 U.S.C. §§ 311–319. Patent Owner, BodyMedia, Inc., filed a Preliminary Response to the Petition. (Paper 7, “Prelim. Resp.”). We have jurisdiction under 35 U.S.C. § 314(a) and 37 C.F.R. 42.4(a). Section 314(a) provides that an *inter partes* review may not be instituted “unless . . . there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.” After considering the Petition, the Preliminary Response, and associated evidence, we conclude that Petitioner has not demonstrated a reasonable likelihood that it would prevail in showing unpatentability of claims 1–29 of the ’546 patent.

A. Related Proceedings

The parties state that the ’546 patent has been asserted in *AliphCom d/b/a Jawbone and BodyMedia, Inc. v. Fitbit, Inc.*, No 3:15-cv-02579 (N.D. Cal.), and *Certain Activity Tracking Devices, Systems, and Components Thereof*, Inv. No. 337-TA-963 (ITC). Pet. 3; Paper 5, 2. Petitioner has also filed a petition for *inter partes* review of related patents in IPR2016-00543 and IPR2016-00545. Pet. 3; Paper 5, 3.

B. The ’546 Patent

The ’546 patent generally describes “[a] nutrition and activity management system . . . that monitors energy expenditure of an individual through the use of a body-mounted sensing apparatus.” Ex. 1001, 1:25–27,

[57]. An embodiment relates to “weight management . . . directed to achieving an optimum or preselected energy balance between calories consumed and energy expended by the user.” *Id.*

The ’546 patent discloses a “nutrition and activity management system,” a management system that relies on an apparatus on the body that monitors the user for accurate estimation of total energy expenditure of a user. *Id.* at 4:15–17, 4:22–39. The apparatus may be at least one sensor or a combination of sensors to provide user data. *Id.* at 5:22–27. The management system also allows entry and tracking of caloric consumption. *Id.* at 4:56–58. The combination of information collected from the apparatus and user is used to provide feedback regarding the user’s progress toward goals. *Id.* at 5:7–10.

With respect to the weight management embodiment, “Weight Manager” software, which may be web-based or accessed through central monitoring unit 30, is provided user-specific information, such as height, weight, gender, and estimated physical activity level. *Id.* at 22:47–23:2. The Weight Manager prompts the individual to establish weight-loss goals, and establish a “diet and exercise plan,” which may include “appropriate exercises” and “daily meal plans to help the [individual] attain their . . . goals.” *Id.* at 23:9–14, 23:27–51.

The system uses the energy expenditure information collected from the wearable apparatus or sensors and the caloric intake information entered by the individual to provide feedback regarding the individual’s progress toward weight-loss goals and recommendations for reaching those goals. *Id.* at 5:7–10. This feedback may include suggestions of a new meal plan or

new exercise plan. *Id.* at 35:23–38. These “suggestions may include simple hints,” such as to “visit the gym more, park farther from the office, or log food items more regularly,” or targeted messages. *Id.* at 35:50–55, 38:15–17.

C. Illustrative Claim

Independent claim 1 is representative and reproduced below (Ex. 1001, 60:15–38):

1. A system to provide feedback for an individual's weight-loss goal, said system comprising:
 - a. a wearable sensor device for detecting data; and
 - b. a processing unit in electronic communication with said sensor device, said processing unit configured to accomplish the following steps, thus providing said feedback:
 - (i) derive physiological and contextual data of the individual from data detected by said sensor device;
 - (ii) prompt said individual to establish a weight-loss goal;
 - (iii) generate a first suggestion to engage in an activity to assist said individual to achieve said weight-loss goal;
 - (iv) determine weight-loss;
 - (v) generate a second suggestion to engage in an activity to assist said individual to achieve said weight-loss goal if said weight-loss goal is not progressing toward the goal;
- wherein said second suggestion is based upon a determination of whether or not the individual complied with said first suggestion; and
- wherein said determination of whether or not the individual complied with said first suggestion is based on

said derived physiological and contextual data of the individual.

D. Asserted Ground of Unpatentability

The information presented in the Petition sets forth a proposed ground of unpatentability for claims 1–29 of the ’546 patent as follows (Pet. 14–15):

References	Basis
Mault 470 ¹ and Mault 089 ²	35 U.S.C. § 103(a)

II. ANALYSIS

A. Claim Interpretation

In an *inter partes* review, claim terms in an unexpired patent are given their broadest reasonable construction in light of the specification of the patent in which they appear. 37 C.F.R. § 42.100(b); *Cuozzo Speed Techs., LLC v. Lee*, 136 S. Ct. 2131, 2144–46 (2016) (upholding the use of the broadest reasonable interpretation standard as the claim interpretation standard to be applied in inter partes reviews). Under this standard, we interpret claim terms using “the broadest reasonable meaning of the words in their ordinary usage as they would be understood by one of ordinary skill in the art, taking into account whatever enlightenment by way of definitions or otherwise that may be afforded by the written description contained in the applicant’s specification.” *In re Morris*, 127 F.3d 1048, 1054 (Fed. Cir.

¹ U.S. Patent Application Pub. No. 2001/0049470, published Dec. 6, 2001, to Mault et al. (“Mault 470”) (Ex. 1004).

² International Application Publication No. WO 01/39089 to Mault published May 31, 2001 (“Mault 089”) (Ex. 1005).

1997). We presume that claim terms have their ordinary and customary meaning. *See Trivascular, Inc. v. Samuels*, 812 F.3d 1056, 1062 (Fed. Cir. 2016) (“Under a broadest reasonable interpretation, words of the claim must be given their plain meaning, unless such meaning is inconsistent with the specification and prosecution history.”); *In re Translogic Tech., Inc.*, 504 F.3d 1249, 1257 (Fed. Cir. 2007) (“The ordinary and customary meaning is the meaning that the term would have to a person of ordinary skill in the art in question.” (internal quotation marks omitted)). A patentee, however, may rebut this presumption by acting as his or her own lexicographer, providing a definition of the term in the specification with “reasonable clarity, deliberateness, and precision.” *In re Paulsen*, 30 F.3d 1475, 1480 (Fed. Cir. 1994).

Petitioner asserts that the broadest reasonable construction of “contextual data of the individual” as recited in the claim limitation 1(b)(i) is “data relating to an individual’s activity state environment, surrounding, or location.” Pet. 17. Petitioner asserts that this construction was applied in the related ITC proceeding. *Id.* (citing Ex. 1015, 17–22, 33). Patent Owner does not contest this proposed construction.

For purposes of this Decision, we adopt Petitioner’s proposed construction for “contextual data of the individual.”

B. Effective Priority Date of the Claims of the '546 Patent

A claim in a patent that arise from an application in a chain of continuation or continuation-in-part parent applications may benefit from the filing date of the earlier applications in the chain, if the disclosure of the earlier applications meets the requirements of 35 U.S.C. § 112 ¶ 1, including

the written description requirement, with respect to that claim. *Tech. Licensing Corp. v. Videotek, Inc.*, 545 F.3d 1316, 1326 (Fed. Cir. 2008) (applying 35 U.S.C. § 120). Thus, in a chain of continuation applications, a claim in a patent receives the benefit of the filing date of an earlier application in the chain, if the claim is supported by the written description of the earlier application. 35 U.S.C. §§ 112, 120. To meet the requirements of § 112 ¶ 1, the disclosure of the earlier application must convey with reasonable clarity to those skilled in the art that the inventor was in possession of the invention, as of the filing date of the earlier application. *Vas-Cath Inc. v. Mahurkar*, 935 F.2d 1555, 1563–64 (Fed. Cir. 1991). “[E]ntitlement to priority is decided on a claim-by-claim basis, and various claims may be entitled to different priority dates.” *X2Y Attenuators, LLC v. Int’l Trade Comm’n*, 757 F.3d 1358, 1366 (Fed. Cir. 2014). Absent a claim of priority, parent applications may be used as prior art to claims in a later-filed child application, but only for claims that incorporate new matter. *See Santarus, Inc. v. Par Pharm., Inc.*, 694 F.3d 1344, 1352 (Fed. Cir. 2012).

The ’546 patent, which issued from U.S. Patent App. No. 10/940,214 (“the ’214 application”) (Ex. 1003) filed on September 13, 2004, claims priority to several applications, stating the following:

This application is a continuation in part of U.S. application Ser. No. 10/638,588, filed Aug. 11, 2003, now U.S. Pat. No. 6,605,038 which is a continuation of U.S. application Ser. No. 09/602,537 [“the ’537 application”], filed Jun. 23, 2000, now U.S. Pat. No. 7,689,437 which is a continuation-in-part of U.S. application Ser. No. 09/595,660 [“the ’660 application”], filed Jun. 16, 2000. This application also claims the benefit of U.S. Provisional Application No. 60/502,764 filed on Sep. 13, 2003

and U.S. Provisional Application No. 50/555,280 filed on Mar. 22, 2004.

Ex. 1001, 1:11–19.

As a threshold matter, Petitioner asserts that the sole independent claim of the '546 patent, claim 1, is not supported by the priority date of the earliest filed applications, the '537 application or the '660 application, both of which were filed in June 2000. Pet. 7. Petitioner argues that the '546 patent contains new matter regarding a weight loss or management application (Ex. 1001, 19:61–62) and additional text in the specification and figures that are not part of the '537 application or '660 application. Pet. 8 (citing Ex. 1011 at 33–62 (highlighting the alleged new matter in the '546 disclosure)). Based on this inadequate support, Petitioner argues that the earliest effective priority date of claims 1–29 of the '546 patent is September 12, 2003, which is more than one year after the publication date of Mault 470 and Mault 089. Pet. 7, n.1 (asserting that Mault 470 and Mault 089 are prior art under 35 U.S.C. § 102(b)).

Petitioner argues that the June 2000 applications (the '537 and '660 applications) “do not contain an equivalent description of limitations in claim 1 reciting that the processing unit is configured to ‘(ii) prompt [the] individual to establish a weight-loss goal’ or ‘(iv) determine weight-loss.’” Pet. 9 (citing Ex. 1002 ¶¶ 30–38). Petitioner further argues that the June applications do not

disclose[] a processing unit configured to provide feedback for an individual's weight-loss goal by generating a first suggestion to engage in an activity to assist the individual to achieve the goal (claim 1.b.iii), generating a second such suggestion if weight loss is not progressing towards that goal (claim 1.b.v), or basing the

second suggestion on a determination of whether the individual complied with the first suggestion (claim 1, first “wherein” statement)

(Pet. 11) such that a skilled artisan would conclude the inventor was in possession of the invention, as of the filing dates of the June 2000 applications. *See* Pet. 10–11 (citing Ex. 1002 ¶ 34). To support its contentions, Petitioner cites to and compares the disclosures in the ’546 patent to issued U.S. Patent No. 7,689,437 (which issued from the ’660 application (see Ex. 1006 at [21])) and issued U.S. Patent No. 6,605,038 (which issued from the ’537 application (see Ex. 1007 at [21])). *See* Pet. 8–14 (relying on issued patents rather than application as filed and citing Ex. 1002 ¶¶ 26–38, which provides similar analysis).

Patent Owner asserts that Petitioner improperly relies on the disclosure from the patents that issued from the June 2000 applications, the ’537 and ’660 applications, without any showing that the issued patents and claims are equivalent to the contents of the ’537 and ’660 applications. PO Prelim. Resp. 5. We agree with Patent Owner that the proper inquiry looks to the earlier, parent application (including its claims) as originally filed to determine if a claim of the child patent may benefit from the filing date of the parent application. *See Tech. Licensing Corp.*, 545 F.3d at 1326; 35 U.S.C. § 120. Patent Owner points out that, in the present case, the as-filed claims of the June 2000 applications differ from the claims of the patents that issued from them and the as-filed claims constitute disclosure ignored in Petitioner’s comparison of the challenged claims of the ’546 patent to the patents that issued from the June 2000 applications. PO Prelim. Resp. 6;

compare Ex. 2001 at 45–65 *with* Ex. 1007, 25:30–30:44; *compare* Ex. 2002 at 36–54 *with* Ex. 1006, 20:65–28:12.

In addition, Patent Owner contends that Petitioner’s argument and evidence misapply the test by requiring that the earlier parent application contain an “equivalent description” of the recited limitation such that it is literally described, rather than determining whether the disclosure of the earlier application conveyed with reasonable clarity to those skilled in the art that the inventor was in possession of the invention. PO Prelim. Resp. 8–9. Patent Owner contends under a proper analysis that does not require literal support for each limitation of claim 1, sufficient support exists in the parent applications for the limitations of claim 1 challenged by Petitioner. PO Prelim. Resp. 9–17.

Also, and as Patent Owner argues, Petitioner does not address a person of ordinary skill in the art, and

thus does not address disclosures [in the June 2000 applications] involving various mechanisms for repeatedly determining the user’s weight, continuous tracking of other parameters from which weight loss can be calculated, or adjusting health suggestions based on factors such as a user’s new weight. A person of ordinary skill, or even a layperson, would have understood that these disclosures of tracking weight and weight-related parameters, as well as adjusting suggested exercises based on the user’s progressing weight, would have reasonably conveyed to one of ordinary skill that the inventor was in possession of a processor configured to “determine weight loss” as recited in claim 1.

PO Prelim. Resp. 17.

Patent Owner has provided citations to the June 2000 applications that demonstrate written description support of the claim 1 limitations that

Petitioner argues is lacking in them, i.e., that the processing unit is configured to “prompt said individual to establish a weight-loss goal” (limitation b(ii)) and that the processing unit is configured to “determine weight-loss” (limitation b(iv)). PO Prelim. Resp. 10–12. In addition, Patent Owner has provided citations to written description support in the June 2000 applications for the remaining limitations of claim 1 of the ’546 patent. PO Prelim. Resp. 10–17, 18–20 (discussing written description support for claim 1 limitations).

With respect to priority, Petitioner would bear the ultimate burden of persuasion in an *inter partes* review. 35 U.S.C. § 316(e); *Dynamic Drinkware, LLC v. Nat’l Graphics, Inc.*, 800 F.3d 1375, 1378 (Fed. Cir. 2015). Based on the record before us, Petitioner has failed to provide sufficient evidence and argument that it would have a reasonable likelihood of prevailing.

We agree with Patent Owner (*see* PO Prelim. Resp. 9) that Petitioner’s analysis of support from the written description of the parent application requires that the Specification provide “equivalent description”³

³ Petitioner relies on *Lockwood v. Am. Airlines, Inc.*, 107 F.3d 1565, 1572 (Fed.Cir.1997) to support the requirement that the specification must contain an “equivalent description of the claimed subject matter.” Pet. 9. *Lockwood* states, however, that “the exact terms need not be used *in haec verba*” in the supporting specification to contain an equivalent description. *Lockwood*, 107 F.3d at 1572 (citing *Eiselstein v. Frank*, 52 F.3d 1035, 1038 (Fed. Cir. 1995)). It is also instructive that in *Lockwood*, there was no dispute that an intervening parent application failed to disclose the claimed feature. *Lockwood*, 107 F.3d at 1572. The Federal Circuit in *Lockwood* rejected as inadequate support from the plaintiff’s expert who averred only that the

of the claimed subject matter without explaining what the parent application conveys to those skilled in the art. *See* Pet. 9–10 (discussing whether June 2000 applications contain “equivalent description” of claim 1 limitations); Ex. 1003 ¶ 32 (addressing whether “equivalent description” exists in the parent applications). Contrary to Petitioner’s application of the “equivalent description,” the test for sufficiency of support in a parent application is not “the presence or absence of literal support in the [parent application] for the claim language,” *In re Kaslow*, 707 F.2d 1366, 1375 (Fed. Cir. 1983), but instead is whether the disclosure of the application relied upon reasonably conveys to the artisan that the inventor had possession at that time of the later claimed subject matter, *Vas-Cath Inc.*, 935 F.2d at 1563–64; *see Yorkey v. Diab*, 605 F.3d 1297, 1303 (Fed. Cir. 2010) (quoting *In re Kaslow*, 707 F.2d at 1375).

In the present case, Petitioner relies on conclusory statements that [t]he June 2000 applications do not contain an *equivalent description* of a processing unit configured to provide feedback for an individual’s weight-loss goal by performing each of the steps recited in subparts b.(i)–(v) of claim 1 in sufficient detail such that one of skill in the art can clearly conclude the applicant invented the claimed invention.

Pet. 9 (citing Ex. 1002 ¶¶ 30–38) (emphasis added). Petitioner further argues that the June 2000 applications “do not contain an equivalent description of limitations in claim 1 reciting that the processing unit is configured to ‘(ii) prompt [the] individual to establish a weight-loss goal’ or

original disclosure, when combined with the knowledge of one of ordinary skill in the art, would lead one to modifications the inventor might have envisioned. *Id.*

‘(iv) determine weight-loss’ as recited in claim 1.” Pet. 9 (citing only to the patents issued from the June 2000 applications).

Petitioner and their Declarant focus on whether the parent application provides “equivalent description” as a search for literal terms without any discussion of what the disclosure conveys as a whole, or in part, to a person of skill in the art. *See* Pet. 9–10; Ex. 1003 ¶¶ 30–38. Petitioner’s analysis and argument ignores the claims as originally filed in the June 2000 applications, thus overlooking additional disclosure in the June 2000 applications. *See* PO Prelim. Resp. 19 (citing claim 45 of the ’537 patent application as originally filed as supporting a limitation 1(b)(v) (citing Ex. 2001, 52:21–53:15)). We also note that Petitioner has not set forth sufficient argument or evidence regarding the existing knowledge in the particular field of the patent claims, nor examined the scope and content of the parent application disclosures from the perspective of a person of ordinary skill in the art. *See Ariad Pharm., Inc. v. Eli Lilly & Co.*, 598 F.3d 1336, 1351 (Fed. Cir. 2010) (citing *Capon v. Eshhar*, 418 F.3d 1349, 1357–58 (Fed. Cir. 2005)) (discussing the factual inquiry into whether the written description of a parent application supports the later issued claims, and noting that whether a patent complies with the written description requirement varies depending on the context, nature and scope of the claims, and complexity and predictability of the relevant technology). On the present record, we are not persuaded by Petitioner’s argument and evidence that limitations of claim 1 of the ’546 patent are not supported adequately by the written description of the June 2000 applications.

We are also not persuaded by Petitioner's argument that any text and figures in the '546 patent not found in the patents that issued from the June 2000 applications must be "new matter." Pet. 8. The inquiry for "new matter" is whether an amendment to a specification finds "adequate support" in the parent application sufficient to meet the written description requirement. *See Kolmes v. World Fibers Corp.*, 107 F.3d 1534, 1539 (Fed. Cir. 1997). In the present case, Petitioner provides only conclusory statements that the text and figures of the '546 patent are "new matter," and fails to provide argument or evidence that the new text and figures identified lack adequate support in the original applications.

In addition, we are not persuaded by Petitioner's argument that the Patent Owner, during prosecution of the '546 patent, relied on citations to the alleged new matter to rebut the Examiner's rejections of then pending claims. Pet. 11–14. Petitioner's arguments and evidence do not adequately connect the Examiner's rejections of the pending claims during the prosecution of the '546 patent to the issued claims Petitioner now challenges. For example, Petitioner identifies the Examiner's rejection for then pending claims in the '214 application (that issued as the '546 patent) under 35 U.S.C. § 112 grounds, but fails to show that these rejected claim limitations are present in the challenged claims. Pet. 11 (citing Examiner rejection of pending claims because specification did not disclose "the use of a processor evaluating the effectiveness of feedback" (Ex. 1003 at 671) and describing these claims as substantively similar). Indeed, the record shows that the pending claims Petitioner identified as rejected were cancelled and

claim 1 of the '546 patent was added by subsequent amendment. Ex. 1003 at 823–826.

Petitioner also has failed to show that Patent Owner's response to the indefiniteness rejection under 35 U.S.C. § 112 ¶ 2, for the "determine weight loss" limitation of claim 1, critically relies on alleged new matter. We agree with Patent Owner (*see* PO Prelim. Resp. 23–24) that its response to the Examiner's indefiniteness rejection did not critically rely on alleged new matter. *See* Ex. 1003 at 1002–1003 (Patent Owner response to rejection); Ex. 2001, 22:11–23:6, 13:15–14:11 (citation to '537 application as filed); Ex. 2002, 22:22–23:17, 14:3–22 (citations to '660 application as filed).

Based on the foregoing, we find that Petitioner has not shown that Mault 470 and Mault 089 are prior art, and, thus, there is not a reasonable likelihood that Petitioner would prevail in showing that claims 1–29 would have been obvious under 35 U.S.C. § 103 over Mault 470 and Mault 089.

III. CONCLUSION

For the foregoing reasons, we determine that the Petition fails to establish a reasonable likelihood of prevailing on the asserted ground that claims 1–29 would have been unpatentable as obvious under 35 U.S.C. § 103 over Mault 470 and Mault 089.

IV. ORDER

Accordingly, it is

ORDERED that the petition is denied as to all challenged claims and no trial is instituted.

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