

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GARMIN INTERNATIONAL, INC., GARMIN USA, INC.,
AND GARMIN LTD.,
Petitioner,

v.

PHILIPS NORTH AMERICA LLC,
Patent Owner.

IPR2020-00909
Patent 6,976,958 B2

Before PATRICK R. SCANLON, FRANCES L. IPPOLITO, and
CHRISTOPHER G. PAULRAJ, *Administrative Patent Judges*.

IPPOLITO, *Administrative Patent Judge*.

DECISION
Denying Institution of *Inter Partes* Review
35 U.S.C. § 314

Denying Motion for Joinder
35 U.S.C. § 315(c); 37 C.F.R. § 42.122

I. INTRODUCTION

Petitioner filed a Petition (“Pet.”) requesting *inter partes* review of claims 15–17 (the “Challenged Claims”) of U.S. Patent No. 6,976,958 B2 (Ex. 1001, “the ’958 patent”). Pet. 1. Petitioner filed a Motion for Joinder under 35 U.S.C. § 315(c), seeking to join IPR2020-00782. Paper 3 (“Mot.”). Patent Owner Philips North America LLC filed a Preliminary Response to the Petition (Paper 8, “Prelim. Resp.”) and a statutory disclaimer disclaiming the challenged claims 15–17 (Exhibit 2001).

We have jurisdiction under 35 U.S.C. § 314. *See also* 37 C.F.R. § 42.4(a) (permitting the Board to render institution decisions on behalf of the Director).

To institute an *inter partes* review, we must determine whether the information presented in the Petition shows “a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.” 35 U.S.C. § 314(a). For the reasons set forth below, we do not institute an *inter partes* review.

A. Related Matters

Petitioner identifies the ’958 patent, related U.S. Patent 8,277,377 (“the ’377 patent”), U.S. Patent No. 7,088,233 (“the ’233 patent”), and U.S. Patent No. 6,013,007 (“the ’007 patent”) as being currently asserted in *Philips North America LLC v. Fitbit, Inc.*, No. 1:19-cv-11586-IT (D. Mass., July 22, 2019). Pet. 1; Paper 6, 1. Patent Owner adds that the ’958, ’377, ’233, and ’007 patents, as well as U.S. Patent Nos. 9,314,192 and 9,801,542, are at issue in *Philips North America LLC v. Garmin International, Inc. et al.*, Case No. 2:19-cv-06301-AB-KS (C.D. Cal., June 8, 2020). Paper 6, 1.

Petitioner has filed a petition for *inter partes* review challenging claims of the '233 patent (IPR2020-00910). Pet. 1; Paper 6, 2

Separately, Fitbit, Inc. has filed petitions for *inter partes* review challenging claims of the '233 patent (IPR2020-00783), the '958 patent (IPR2020-00782), and the '377 patent (IPR2020-00828). See Pet. 2; Paper 6, 1–2; Mot. 1.

B. The '958 Patent

The '958 patent, titled “Method and Apparatus for Health and Disease Management Combining Patient Data Monitoring with Wireless Internet Connectivity,” issued Dec. 20, 2005, with 17 claims. Ex. 1001, code (54), (45), 15:23–18:31. Figure 1 is reproduced below.

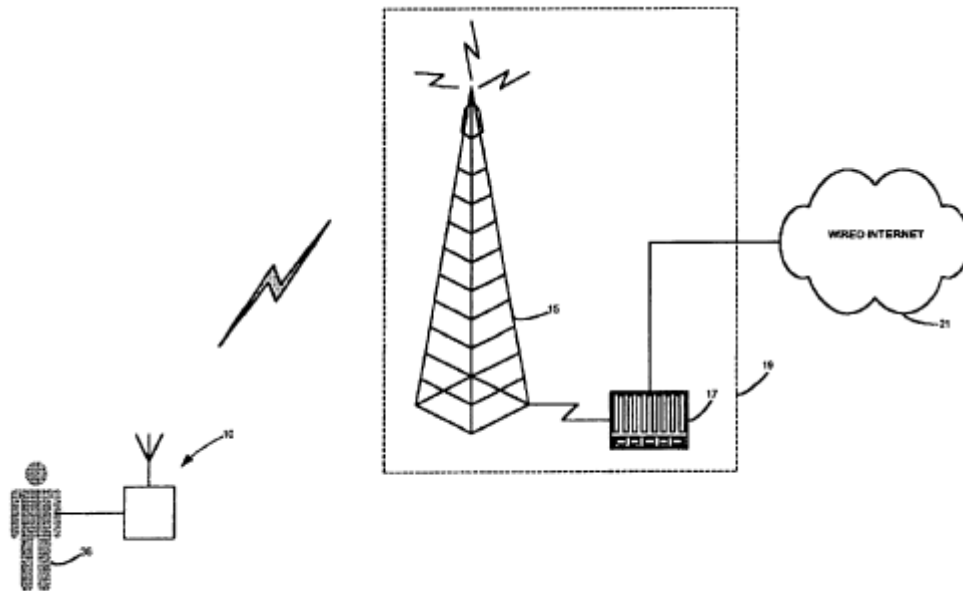


FIG. 1

Figure 1 depicts general wireless health-monitoring system 10 (“WHMA”) as described in the '958 patent. Ex. 1001, 5:9–11. Referring to Figure 1, the '958 teaches WHMA 10 is a system for monitoring health data from a

patient or subject 38. *Id.* at 6:36–38. WHMA 10 is wirelessly linked to wireless connection point of presence (“POP”) 19. *Id.* at 6:38–41. POP 19 includes base station antenna 15 that is coupled to server 17, which in turn is connected to Internet 21. *Id.* at 6:40–42. The ’958 patent further teaches that WHMA 10 includes health monitoring device (“HMD”) 11, which may contain physiologic sensor 24 or manual system 36 for input of physiologic data via a connection 34. *Id.* at 6:47–55.

C. Challenged Claims

As indicated above, Patent Owner disclaimed claims 15–17 of the ’958 patent, which correspond to all of the Challenged Claims. *See* Prelim. Resp. 1–2; Ex. 2001; Ex. 1001, 17:19–18:31; Pet. 1. For illustrative purposes, disclaimed claim 16 is provided below:

16. A internet-enabled wireless web device for monitoring health, the internet-enabled wireless web device connected in wireless communication with a server running an application, comprising:

an internet-enabled wireless web device with a removable memory device and running an application, the application functioning to accept inputs from a first communications port and a second communications port, the first communications port including a generic input/output port and the second communications port including a wireless link to a network, the generic input/output port for receipt of a health parameter from a health monitoring device or visual data from a digital camera, the health parameter or visual data corresponding to a patient’s disease state or condition;

wherein in the event of an interruption of the wireless connection between the internet-enabled wireless web device and the server, the internet-enabled wireless web device is configured to store the health parameter or visual data in a memory or on the removable memory device.

Ex. 1001, 18:3–24.

II. ANALYSIS

A. Statutory Disclaimer

Patent Owner has filed a statutory disclaimer of claims 15, 16, and 17 of the '958 patent. Ex. 2001; *see* Prelim. Resp. 1. Petitioner has not challenged the disclaimer in any manner.

Pursuant to 37 C.F.R. § 42.107(e), “[t]he patent owner may file a statutory disclaimer under 35 U.S.C. [§] 253(a) in compliance with § 1.321(a) of this chapter, disclaiming one or more claims in the patent. No *inter partes* review will be instituted based on disclaimed claims.” A disclaimer under 35 U.S.C. § 253(a) shall be recorded in the Office, and is “considered as part of the original patent.” *See* 35 U.S.C. § 253(a).

A disclaimer of one or more claims, to be recorded in the Patent Office, must:

- (1) Be signed by the patentee, or an attorney or agent of record;
- (2) Identify the patent and complete claim or claims, or term being disclaimed. A disclaimer which is not a disclaimer of a complete claim or claims, or term will be refused recordation;
- (3) State the present extent of patentee’s ownership interest in the patent; and
- (4) Be accompanied by the fee set forth in [37 C.F.R.] § 1.20(d).

37 C.F.R. § 1.321(a); *see also Vectra Fitness, Inc. v. TNWK Corp.*, 162 F.3d 1379, 1382 (Fed. Cir. 1998) (holding that a § 253 disclaimer is immediately “recorded” on the date that the Office receives a disclaimer meeting requirements of 37 C.F.R. § 1.321(a)).

Based on our review of Exhibit 2001 and Office records (that is, the USPTO Patent Application Information Retrieval (PAIR) database containing the image file wrapper and other information for the '958 patent),

we conclude that a disclaimer of claims 15–17 of the '958 patent has been recorded in the Office under 35 U.S.C. § 253(a) and 37 C.F.R. § 1.321(a). Exhibit 2001 includes the electronic signature of Elias Schilowitz, Senior IP Counsel of the Patentee, Philips North America LLC. *See* Ex. 2001; *see also* Paper 3, 1. Exhibit 2001 identifies the '958 patent, indicates that claims 15–17 are disclaimed, and states that Patentee Philips North America LLC has 100 percent ownership of the '958 patent. *See* Ex. 2001. The image file wrapper in PAIR includes a fee worksheet and receipt for the requisite fee filed with the statutory disclaimer on August 10, 2020. *See* Ex. 3001.

Because Patent Owner filed a statutory disclaimer in compliance with 35 U.S.C. § 253(a) and 37 C.F.R. § 1.321(a) disclaiming all the challenged claims of the '958 patent, no *inter partes* review is instituted in this proceeding. *See* 37 C.F.R. § 42.107(e); *Gen. Elec. Co. v. United Techs. Corp.*, IPR2017-00491, Paper 9 (PTAB July 6, 2017) (precedential).

B. Denial of Motion for Joinder

In the Motion for Joinder, Petitioner requests that we institute *inter partes* review and that we join Petitioner as a party to the *inter partes* review requested in IPR2020-00782. Mot. 1. The Petition and supportive filings are all substantively identical to those filed in IPR2020-00909, which challenge claims 15, 16, and 17 of the '958 patent.

As discussed above, because Patent Owner filed a statutory disclaimer in compliance with 35 U.S.C. § 253(a) and 37 C.F.R. § 1.321(a) disclaiming all the challenged claims of the '958 patent, no *inter partes* review is instituted in this proceeding. Moreover, for the same reason, the Board has denied institution in IPR2020-00782. Accordingly, there is no ongoing *inter*

partes review in IPR2020-00782 to which the instant Petitioner could be joined. Therefore, pursuant to § 315(c), we deny the Motion for Joinder.

III. CONCLUSION

For the reasons above, we do not institute an *inter partes* review and deny the motion for joinder.

IV. ORDER

After due consideration of the record before us, it is:

ORDERED that no *inter partes* review is instituted for any claim challenged by Petitioner; and

FURTHER ORDERED that Petitioner's Motion for Joinder is *denied*.

IPR2020-00909
Patent 6,976,958 B2

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