

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

AMERICAN WELL CORPORATION,
Petitioner,

v.

TELADOC HEALTH, INC.,
Patent Owner.

IPR2021-00933
Patent 7,761,185 B2

Before LYNNE H. BROWNE, JOHN P. PINKERTON, and
KARA L. SZPONDOWSKI, *Administrative Patent Judges*.

PINKERTON, *Administrative Patent Judge*.

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

I. INTRODUCTION

A. Background and Summary

American Well Corporation (“Petitioner”) filed a Petition (Paper 2, “Pet.”) requesting *inter partes* review of claims 1–13 of U.S. Patent No. 7,761,185 B2 (Ex. 1001, “the ’185 patent”). Teladoc Health, Inc. (“Patent Owner”) filed a Preliminary Response (Paper 6, “Prelim. Resp.”).

We are authorized to institute an *inter partes* review where a petition demonstrates a reasonable likelihood that the petitioner would prevail with respect to at least one challenged patent claim. 35 U.S.C. § 314(a). We are never compelled, however, to institute a review. *Harmonic Inc. v. Avid Tech., Inc.*, 815 F.3d 1356, 1367 (Fed. Cir. 2016). We may exercise our discretion to deny review, for example, where a petition fails to identify “with particularity” the challenges or evidence supporting them. *Id.* at 1363; 35 U.S.C. § 312(a)(3). “Even when a petitioner demonstrates a reasonable likelihood” of prevailing with respect to at least one patent claim, institution of review “remains discretionary.” *Adaptics Limited v. Perfect Co.*, IPR2018-01596, Paper 20 at 17 (PTAB Mar. 6, 2019) (informative).

For the reasons explained below, we do not institute an *inter partes* review.¹

¹ Because we determine not to institute an *inter partes* review based on the merits of the four grounds asserted by Petitioner, we do not address the parties’ arguments regarding discretionary denial. *See* Pet. 63–70; Prelim. Resp. 53–66.

B. Real Parties-in-Interest

Petitioner identifies itself as the real party-in-interest. Pet. 70. Patent Owner identifies Teladoc Health, Inc. and InTouch Technologies, Inc. as the real parties-in-interest. Paper 4, 1.

C. Related Matters

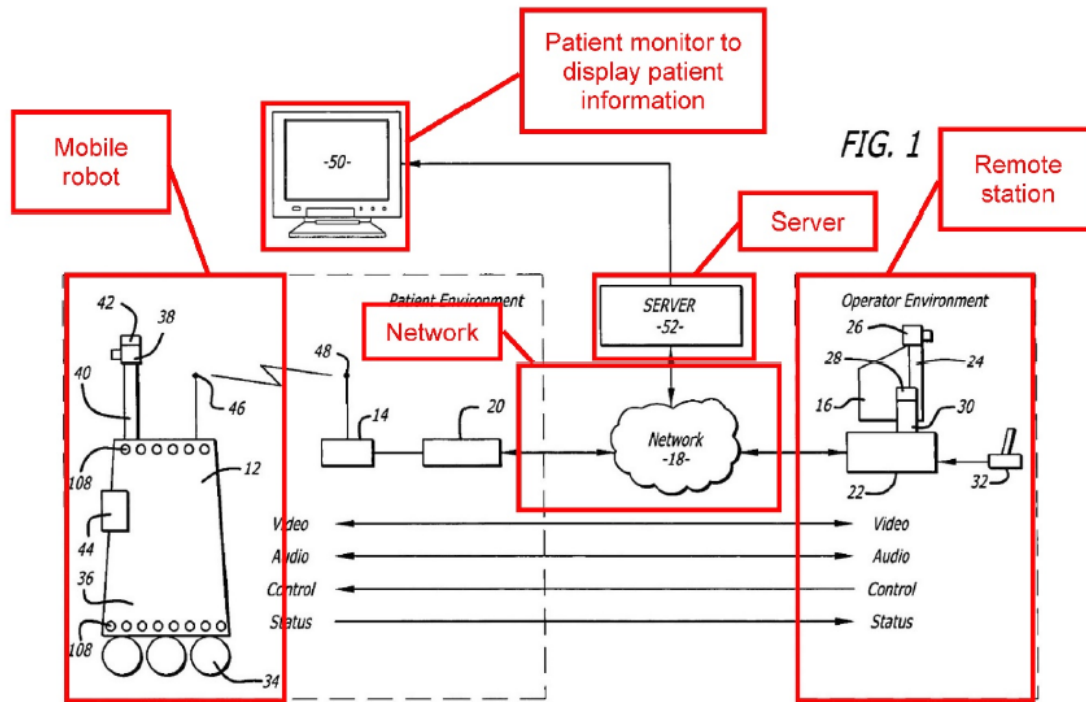
The parties inform us that the '185 patent is the subject of *Teladoc Health, Inc. v. Am. Well Corp.*, No. 1:20-cv-01377-MN (D. Del.). Pet. 70; Paper 4, 1.

D. Summary of the '185 Patent

The '185 patent, titled “Remote Presence Display Through Remotely Controlled Robot,” issued July 20, 2010, from Application No. 11/542,912, filed October 3, 2006. Ex. 1001, codes (21), (22), (45), (54).

The '185 patent describes a system and method for providing patient consultation by a physician that includes a remote station coupled to a mobile robot. *Id.* at 1:7–8, 1:45–46. The robot and remote station contain monitors, cameras, speakers, and microphones that allow for two-way video conferencing between a physician at the remote station and a patient in the vicinity of the robot. *Id.* at 2:13–16.

The system also includes a patient monitor that displays patient information. *Id.* at 1:49–51. The patient monitor can be seen by the patient and by the physician through the robot camera. *Id.* at 2:18–19. Figure 1 of the '185 patent, as annotated by Patent Owner, illustrates the robot system and is reproduced below.

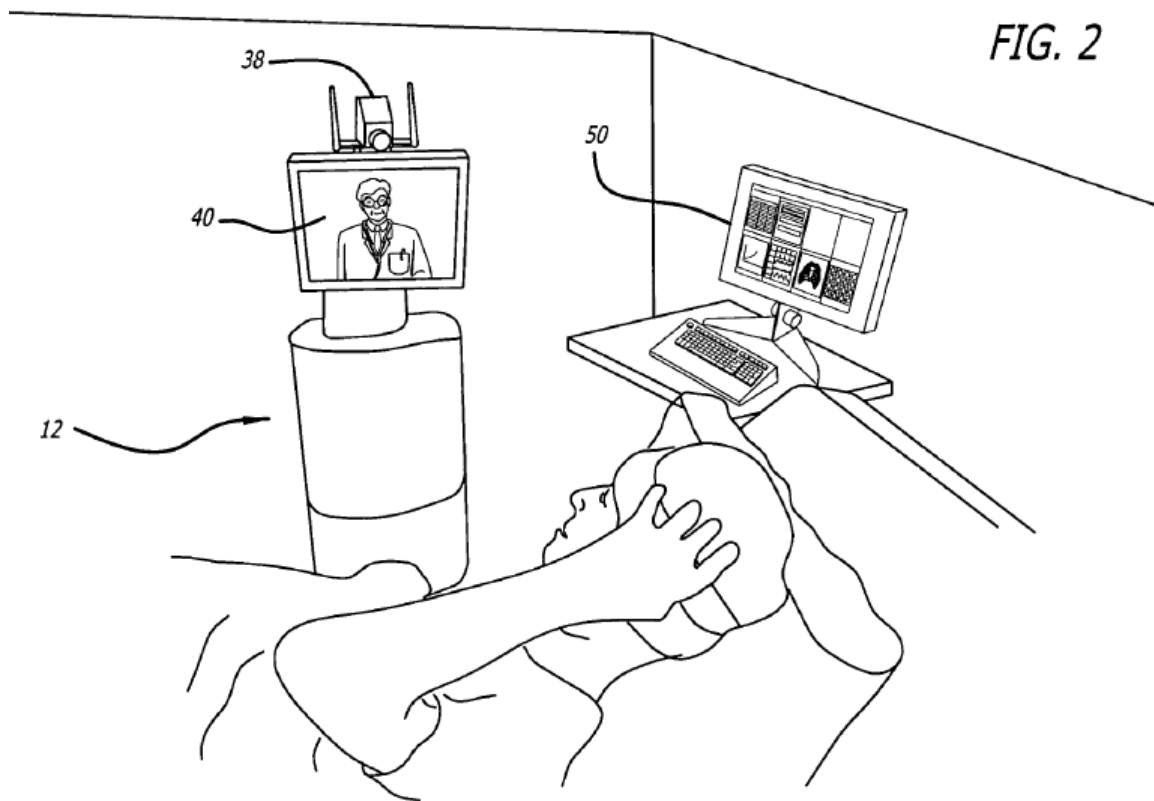


See Prelim. Resp. 4 (citing Ex. 1001, Fig. 1). As shown in annotated Figure 1, the '185 patent system includes mobile robot 12 (located at the far left) and remote station 16 (located at the far right), which are coupled via network 18, such as a broadband network. *Id.* at 2:23–31. Remote station 16 includes monitor 24, camera 26, microphone 28, and speaker 30. *Id.* at 2:36–39. Remote station 16 also includes input device 32 that allows the healthcare practitioner to control the movement of robot 12. *Id.* at 2:54–56, 4:30–36. Robot 12 includes camera 38, monitor 40, microphone 42, and speaker(s) 44. *Id.* at 2:49–51. Robot camera 38 is coupled to remote monitor 24 (at the remote station), so that a user at remote station 16 can view a patient. *Id.* at 2:56–58. Likewise, robot monitor 40 is coupled to remote camera 26 so that the patient may view the user. *Id.* at 2:58–59.

Patient monitor 50 is typically located within a patient's room at a healthcare facility. *Id.* at 3:4–5. Patient monitor 50 is depicted in annotated Figure 1 as a standard computer display screen, and is described as “any

type of device that can display graphics, video images and text.” *Id.* at 3:5–9. Remote control station 16 and patient monitor 50 are coupled through network 18 to server 52 that contains electronic medical records of the patient. *Id.* at 3:10–15. Medical records can be retrieved from server 52 and displayed by patient monitor 50. *Id.* at 3:16–19.

The system of the ’185 patent allows a physician to review patient information with the patient, as shown in Figure 2, which is reproduced below. *Id.* at 3:28–29.



Ex. 1001, Fig. 2. Figure 2 depicts a patient lying down with his head raised slightly (in the foreground) and an image of the physician (located at remote station 16) displayed on robot monitor 40 (in the background), with patient monitor 50 on the right side of Figure 2. *Id.* at 3:28–31, Fig. 2. Robot 12 “displays an image of the physician [on monitor 40] so that the physician’s

presence is projected into [the] patient's room," and patient monitor 50 "displays medical information that can be reviewed by the patient." *Id.* at 3:29–32. Robot camera 38 "allows the physician to see the patient and to view the medical information displayed by the patient monitor." *Id.* at 3:33–35.

E. Illustrative Claims

Petitioner challenges claims 1–13. Claims 1 and 7 are independent and are reproduced below (with subparagraph notations inserted as in the Petition):

1. [1.P] A medical system for a patient, comprising:
 - [1.1] a patient monitor that displays patient information;
 - [1.2] a mobile robot that has a robot monitor, and a robot camera that captures an image, said robot camera being capable of viewing the patient and said patient monitor; and
 - [1.3] a remote station that is coupled to said mobile robot, said remote station includes a remote station monitor that displays the image captured by said robot camera and a remote station camera that captures an image that is displayed by said robot monitor.
7. [1.P] A method for interacting with a patient, comprising:
 - [7.1] moving a mobile robot that has a camera to view a patient and a patient monitor;
 - [7.2] displaying patient information on the patient monitor; and
 - [7.3] conducting a two-way video conference between the patient and a medical personnel at a remote station that controls movement of the robot.

Ex. 1001, 4:4–13, 4:27–33.

F. Asserted Grounds

Petitioner contends that the challenged claims would have been unpatentable based on the following grounds:

Claim(s) Challenged	35 U.S.C. § ²	References/Basis
1–5	102	Wang438 ³
1, 3–6	102	Wang128 ⁴
1–5, 7–13 ⁵	103(a)	Wang438, David ⁶
1–13	103(a)	Wang421, David, Reeder ⁷

Pet. 2–3. In support of its proposed grounds, Petitioner relies on the Declaration of Gregory S. Fischer, Ph.D. *See* Ex. 1003. Patent Owner relies on the Declaration of Michael Rosen, Ph.D. *See* Ex. 2001.

II. ANALYSIS

A. Applicable Law

“In an [inter partes review], the petitioner has the burden from the onset to show with particularity why the patent it challenges is unpatentable.” *Harmonic*, 815 F.3d at 1363 (citing 35 U.S.C. § 312(a)(3)).

² The relevant sections of the Leahy-Smith America Invents Act (“AIA”), Pub. L. No. 112–29, took effect on March 16, 2013. The application that issued as the ’185 patent was filed prior to March 16, 2013. *See* Ex. 1001, code (22). Thus, we apply the pre-AIA version of these statutes. *See* 35 U.S.C. § 100(i).

³ US 2005/0204438 A1, published September 15, 2005 (Ex. 1005). Petitioner contends that Wang438 qualifies as prior art to the ’185 patent under § 102(b). Pet. 3.

⁴ US 2007/0291128 A1, published December 20, 2007 (Ex. 1006). Petitioner contends that Wang128 qualifies as prior art to the ’185 patent under § 102(e). Pet. 3.

⁵ *See infra* at 24, n.11.

⁶ US Patent 5,544,649, issued August 13, 1996 (Ex. 1009). Petitioner contends that David qualifies as prior art to the ’185 patent under § 102(b). Pet. 3.

⁷ US 2002/0044059 A1, published April 18, 2002 (Ex. 1008). Petitioner contends that Reeder qualifies as prior art to the ’185 patent under § 102(b). Pet. 3.

Under 35 U.S.C. § 312(a)(3), a petition for *inter partes* review “may be considered only if . . . the petition identifies, in writing and with particularity, each claim challenged, the grounds on which the challenge to each claim is based, and *the evidence that supports the grounds for the challenge to each claim*” (emphases added). Additional Board regulations further address the showing required in a petition. In particular, 37 C.F.R. § 42.104(b)(4) requires that “[t]he petition must specify where each element of the claim is found in the prior art . . . relied upon,” and 37 C.F.R. § 42.104(b)(5) adds that a petition must “identify[] specific portions of the evidence that support the challenge.” “The Board may exclude or give no weight to the evidence where a party has failed to state its relevance or to identify specific portions of the evidence that support the challenge.” 37 C.F.R. § 42.104(b)(5). Similarly, 37 C.F.R. § 42.22(a)(2) requires that a petition “must include . . . [a] full statement of the reasons for the relief requested, including a *detailed explanation of the significance of the evidence*” (emphasis added).

The Board has denied petitions that lack particularity or present deficient or conclusory analysis. *See Adaptics*, Paper 20 at 17–18. Our reviewing court describes this particularity requirement as “of the utmost importance.” *Intelligent Bio-Sys., Inc. v. Illumina Cambridge Ltd.*, 821 F.3d 1359, 1369 (Fed. Cir. 2016) (quoting Section 312(a)(3)).

The requirement for particularity “takes on heightened importance when considered in conjunction with” the “‘all-or-nothing’ approach” that applies to decisions on institution. *Adaptics*, Paper 20 at 17. Under that approach, we must execute “a binary choice” to institute on all grounds asserted in a petition or none. *SAS Inst., Inc. v. Iancu*, 138 S. Ct. 1348, 1354, 1359–60 (2018); 35 U.S.C. § 314(a); Patent Trial and Appeal Board Consolidated Trial Practice Guide, 64 (Nov. 2019)⁸ (“The Board will not institute on fewer than all claims or all challenges in a petition.”).

Petitioner’s asserted grounds of unpatentability are based on anticipation under 35 U.S.C. § 102 and obviousness under 35 U.S.C. § 103(a). Pet. 2.

A claim is anticipated, and therefore unpatentable under 35 U.S.C. § 102, if all its limitations are disclosed either explicitly or inherently in a single prior art reference. *In re Schreiber*, 128 F.3d 1473, 1477 (Fed. Cir. 1997). That single prior art reference must disclose all the limitations of the claim “arranged or combined in the same way as in the claim.” *Net MoneyIN, Inc. v. VeriSign, Inc.*, 545 F.3d 1359, 1371 (Fed. Cir. 2008).

A claim is unpatentable under 35 U.S.C. § 103(a) if “the differences between the subject matter sought to be patented 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.” *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 406 (2007). The question of obviousness is resolved 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;

⁸ Available at <https://www.uspto.gov/TrialPracticeGuideConsolidated>.

(3) the level of skill in the art; and (4) when in evidence, objective evidence of obviousness or nonobviousness, that is, secondary considerations.⁹ *See Graham v. John Deere Co.*, 383 U.S. 1, 17–18 (1966).

Additionally, the obviousness inquiry typically requires an analysis of “whether there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue.” *KSR*, 550 U.S. at 418 (citing *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006) (requiring “articulated reasoning with some rational underpinning to support the legal conclusion of obviousness”)); *see In re Warsaw Orthopedic, Inc.*, 832 F.3d 1327, 1333 (Fed. Cir. 2016). Petitioner has the burden to demonstrate both “that a skilled artisan would have been motivated to combine the teachings of the prior art references to achieve the claimed invention, and that the skilled artisan would have had a reasonable expectation of success in doing so.” *Intelligent Bio-Systems, Inc. v. Illumina Cambridge Ltd.*, 821 F.3d 1359, 1367–68 (Fed. Cir. 2016).

B. Level of Ordinary Skill in the Art

The level of skill in the art is “a prism or lens” through which we view the prior art and the claimed invention. *Okajima v. Bourdeau*, 261 F.3d 1350, 1355 (Fed. Cir. 2001). Petitioner contends that a person having ordinary skill in the art at the time of the filing date

would have had at least a Bachelor’s of Science Degree (or equivalent) in an academic area emphasizing electrical engineering, computer engineering, computer science, biomedical engineering, or a related technical field, and at least 2–3 years of experience in the field of robotics, telepresence

⁹ On this record, the parties do not address objective indicia of nonobviousness, which accordingly do not form part of our analysis.

systems, or both (*e.g.*, familiarity with wireless communication technology, biomedical robotic systems, etc.).

Pet. 8 (citing Ex. 1003 ¶¶ 23–24).

Patent Owner agrees with Petitioner’s definition of a person of ordinary skill in the art. Prelim. Resp. 11 (citing Ex. 2001 ¶ 36).

Based on our review of the limited record, we determine that Petitioner’s definition is consistent with the technology and skill reflected in the prior art of record and the specification of the ’185 patent. Thus, for purposes of this decision, we apply Petitioner’s definition of the level of ordinary skill in the art.

C. Claim Construction

“In an *inter partes* review proceeding, a claim of a patent . . . shall be construed using the same claim construction standard that would be used to construe the claim in a civil action under 35 U.S.C. 282(b).” 37 C.F.R. § 42.100(b) (2019). Under this standard, we construe the claim “in accordance with the ordinary and customary meaning of such claim as understood by one of ordinary skill in the art and the prosecution history pertaining to the patent.” *Id.*; *see also Phillips v. AWH Corp.*, 415 F.3d 1303, 1312–13 (Fed. Cir. 2005) (*en banc*).

Petitioner does not propose a specific construction for any claim term in this proceeding. Pet. 3. Instead, Petitioner asserts that “[a]ll [claim] terms should be given their ordinary and customary meaning,” and “Petitioner also reserves the right to identify terms for construction as may become necessary in the related District Court case.” *Id.* Patent Owner agrees with Petitioner that no formal claim constructions are necessary at this point. Prelim. Resp. 11.

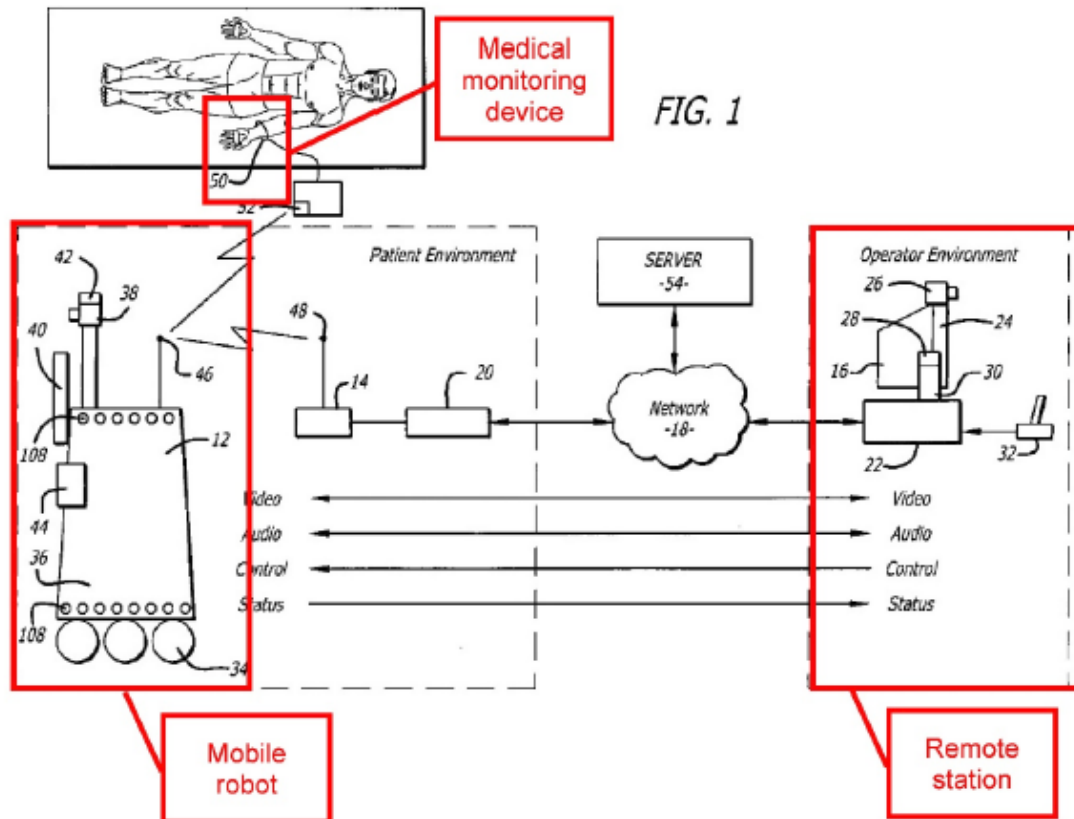
We determine that we need not expressly construe any claim terms to resolve the parties' disputes on the current record. *See, e.g., Nidec Motor Corp. v. Zhongshan Broad Ocean Motor Co.*, 868 F.3d 1013, 1017 (Fed. Cir. 2017) (“[W]e need only construe terms ‘that are in controversy, and only to the extent necessary to resolve the controversy.’” (quoting *Vivid Techs., Inc. v. Am. Sci. & Eng’g, Inc.*, 200 F.3d 795, 803 (Fed. Cir. 1999))).

D. Ground 1: Claims 1–5 as Anticipated by Wang438

Petitioner contends that claims 1–5 are anticipated by Wang438. Pet. 21–36.

1. Summary of Wang438 (Ex. 1005)

Wang438 is titled “Graphical Interface for a Remote Presence System” and is directed to “[a] robot system that includes a remote station and a robot.” Ex. 1005, code (54), ¶ 10, Fig. 1. Figure 1 of Wang438, as annotated by Patent Owner, is reproduced below.



Prelim. Resp. 12. Annotated Figure 1 of Wang438 depicts robot 12 (at the far left) wirelessly coupled to remote station 16 (at the far right) through network 18 (between robot 12 and remote station 16). Ex. 1005 ¶¶ 18–19. Remote station 16 includes computer 22 having monitor 24, camera 26, microphone 28, speaker 30, and input device 32, such as a joy stick or mouse, which permits a user at remote station 16 to move robot 12. *Id.* Robot 12 includes movement platform 34 attached to robot housing 36. *Id.* at ¶ 19. Attached to robot housing 36 are camera 38, monitor 40, microphone(s) 42, speaker(s) 44, and antenna 46, which is wirelessly coupled to antenna 48 of base station 14. *Id.*

Robot 12 is also coupled to medical monitoring device 50. *Id.* at ¶ 21. Medical monitoring device 50 “can take medical data from a patient,”

and may be “a stethoscope, a pulse oximeter and/or an EKG¹⁰ monitor.” *Id.* Medical monitoring device 50 contains wireless transmitter 52 that transmits the patient data to robot 12, and robot 12 “can then transmit the data to the remote station 16.” *Id.*

2. Claim 1

In its Preliminary Response, Patent Owner argues that Wang438 does not anticipate claim 1 because it does not disclose “a patient monitor that displays patient information,” as recited in limitation 1.1. Prelim. Resp. 22–26. Patent Owner also argues Wang438 does not anticipate claim 1 because it does not disclose “a robot camera capable of viewing the patient and the patient monitor,” as recited in limitation 1.2. *Id.* at 26–27. Because we agree with Patent Owner that Wang438 does not disclose limitation 1.1, we focus our discussion below on that limitation.

a) Petitioner’s Arguments

Petitioner argues that Wang438 discloses “a patient monitor (medical monitoring device 50 . . .) that displays patient information (*e.g.*, an EKG waveform; the patient’s name; the patient’s heart rate as a numeric value; and/or the patient’s SpO₂ oxygen saturation as a numeric percentage).” Pet. 22 (citing Ex. 1005 ¶ 21; Ex. 1019 (Ex. Q, 1–3, identifying third party diagnostic equipment as claimed patient monitor); Ex. 1017 (GE CARESCAPE V100 Brochure); Ex. 1018 (GE CARESCAPE V100 Operators Manual)). Petitioner notes that paragraph 21 of Wang438 states that “medical monitoring device 50 can take medical data from a patient.

¹⁰ “EKG” is an acronym for the German procedure “elektrokardiogramm.” In English, this procedure is known as an “electrocardiogram,” which has the acronym “ECG.” See <https://en.wikipedia.org/wiki/Electrocardiography>.

[By way of] example, the medical monitoring device 50 may be a stethoscope, a pulse oximeter and/or an EKG monitor.” *Id.* at 22–23 (citing Ex. 1005 ¶ 21). Petitioner then states that an exemplary prior art pulse oximeter is the Nellcor N-200 that “displays patient information (oxygen saturation and pulse rate).” *Id.* at 23–24 (citing Ex. 1011, 16; Ex. 1003 ¶¶ 58–59). Petitioner also asserts that an EKG monitor displays at least the patient’s EKG as a waveform and other information such as the patient’s name and heart rate. *Id.* at 24 (citing Ex. 1003 ¶¶ 60–68; Ex. 1012 (GE-MAC 1200); Ex. 1013 (Phillips-PageWriter)). According to Petitioner, the GE-MAC-1200 and Phillips-PageWriter are prior art monitors that display this patient information. *Id.* at 24–28 (citing Ex. 1012, 9, 27, 36, 55; Ex. 1013, 14, 45–47).

b) Patent Owner’s Arguments

Patent Owner argues that, contrary to Petitioner’s arguments, “nowhere does Wang438 disclose that the medical monitoring device 50 displays any patient information, much less the specific information of ‘an EKG waveform; the patient’s name; the patient’s heart rate as a numeric value; and/or the patient’s SpO2 oxygen saturation as a numeric percentage.’” Prelim. Resp. 22–23 (citing Ex. 2001 ¶ 59). Patent Owner also argues that Petitioner’s reliance on secondary references external to Wang438 cannot support an anticipation challenge based on Wang438, especially where they are not incorporated by reference into Wang438 and Petitioner does not assert that the medical equipment described in the secondary references is inherent to Wang438’s monitoring device. *Id.* at 24–25 (citing Ex. 2001 ¶ 60). Patent Owner further argues that by citing these secondary references, Petitioner is attempting to effectively turn

ground 1 into an obviousness ground and gain the benefit of these disclosures without fulfilling the obligation of demonstrating a motivation to combine. *Id.* at 25.

c) Analysis

We agree with Patent Owner that Petitioner has not sufficiently shown that Wang438 discloses limitation 1.1. Initially, we agree with Patent Owner that Wang438 does not disclose that monitoring device 50 displays any patient information. *Id.* at 23–24 (citing Ex. 2001 ¶ 59). Although Petitioner relies on paragraph 21 of Wang438, we agree with Patent Owner that paragraph 21 makes clear that the purpose of medical monitoring device 50, which may be a stethoscope, pulse oximeter, or EKG monitor, is to “take medical data from a patient.” *Id.* at 23 (citing Ex. 1005 ¶ 21). In other words, as Patent Owner states, “monitoring device 50 is a device that monitors data, not a ‘monitor’ that displays the data.” *Id.* (citing Ex. 1005 ¶ 21; Ex. 2001 ¶ 59) (emphasis omitted). Paragraph 21 does not disclose that monitoring device 50 displays any patient information. Instead, as Patent Owner argues, paragraph 21 of Wang438 discloses that monitoring device 50 may contain wireless transmitter 52 (as shown in Figure 1) that transmits the patient data to robot 12, which can then transmit the data to remote station 16. *Id.* at 23–24 (citing Ex. 1005 ¶ 21).

We also agree with Patent Owner that Petitioner’s secondary references external to Wang438 cannot support an anticipation challenge based on Wang438. In that regard, Petitioner cites to five secondary references: Nellcor N-200 pulse oximeter operator’s manual (Ex. 1011, 16); GE-MAC 1200 ECG monitor operator’s manual (Ex. 1012, 9, 27); Phillips-PageWriter ECG monitor instructions for use (Ex. 1013, 14, 45–47); GE

CARESCAPE V100 vital signs monitor brochure (Ex. 1017, 5); and, GE CARESCAPE V100 vital signs monitor operator's manual (Ex. 1018, 13). *See* Pet. 23–28. None of these references were identified in the grounds set forth in the Petition. *See* Pet. 2–3. For the reasons stated below, we determine we cannot consider these secondary references because doing so would violate the requirement of Section 312(a)(3) for an *inter partes* review petition to identify “with particularity . . . the grounds on which the challenge to each claim is based, and the evidence that supports the grounds for the challenge to each claim.” *See* 35 U.S.C. § 312(a)(3).

We also determine we cannot consider these secondary references because ground 1 challenges claim 1 for anticipation under 35 U.S.C. § 102 based on Wang438, which requires Petitioner to show that the single reference Wang438 discloses, either expressly or inherently, the limitations of claim 1. *See Schreiber*, 128 F.3d at 1477. Permitting Petitioner to argue Wang438 together with the secondary references would, as Patent Owner argues, convert the basis for ground 1 from anticipation to obviousness under 35 U.S.C. § 103(a). *See* Prelim. Resp. 25. Thus, we also determine we cannot consider Petitioner's secondary references because doing so would be contrary to the requirement for the petition to identify “with particularity . . . the grounds on which the challenge to each claim is based” (35 U.S.C. § 312(a)(3)) and the Board's rule requiring a petition for *inter partes* review to identify the statutory grounds on which the challenge to the claim is based (37 C.F.R. § 42.104(b)).

We further agree with Patent Owner's argument that the secondary references are not incorporated by reference into Wang438 and Petitioner does not assert that the medical equipment described in the secondary

references is inherent to Wang438's monitoring device.¹¹ Prelim. Resp. 24–25 (citing Ex. 2001 ¶ 60). In addition, we note Petitioner has not demonstrated that the secondary references qualify as prior art printed publications under § 102(b), which would be required for Petitioner to rely on these references because under 35 U.S.C. § 311(b), a petitioner in an *inter partes* review may only challenge the claims of a patent based on “prior art consisting of patents or printed publications.”

d) Summary

For the reasons discussed above, we determine that the information presented in the Petition does not demonstrate a reasonable likelihood that claim 1 is unpatentable for anticipation under 35 U.S.C. § 102 over Wang438.

3. Claims 2–5

Each of claims 2–5 depends directly from claim 1. *See* Ex. 1001, 6:14–24. Patent Owner argues, and we agree, that because claims 2–5 depend from claim 1, each of these claims is also not anticipated by Wang438 for at least the reasons claim 1 is not anticipated. Prelim. Resp. 28–30. Thus, for the reasons discussed above regarding claim 1, we also determine that Petitioner has not demonstrated a reasonable likelihood that

¹¹ Although an additional reference may be used to show that a characteristic not expressly discussed in the anticipating reference is an inherent characteristic, we see no indication that Petitioner is relying on an inherency theory. *See Cont'l Can Co. USA v. Monsanto Co.*, 948 F.2d 1264, 1268 (Fed. Cir. 1991) (“Such evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill.”) Rather, Petitioner merely relies on these references to show “exemplary” devices. *See* Pet. 23–28.

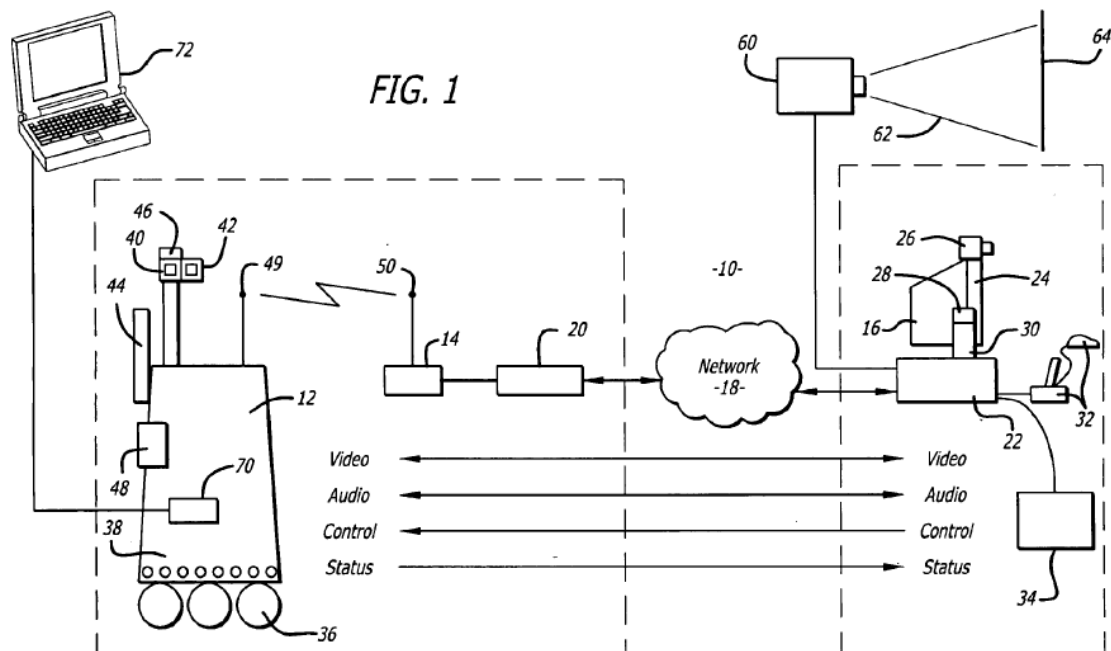
claims 2–5 are unpatentable for anticipation under 35 U.S.C. § 102 over Wang438.

E. Ground 2: Claims 1 and 3–6 as Anticipated by Wang128

Petitioner contends that Wang128 anticipates claims 1 and 3–6 of the '185 patent. Pet. 36–43.

1. Summary of Wang128 (Ex. 1006)

Wang128, titled “Mobile Teleconferencing System That Projects An Image Provided By A Mobile Robot,” relates generally to “[a] remote controlled robot system that includes a mobile robot and a remote control station.” Ex. 1006, code (54), ¶ 8. Figure 1 of Wang128 is reproduced below.



Ex. 1006, Fig. 1. Figure 1 of Wang128 depicts telepresence system 10 comprising robot 12 (located at the far left) and remote control station 16 (located at the far right), which are coupled via network 18. Ex. 1006 ¶ 17, Fig. 1. Robot 12 includes movable platform 36 that is attached to robot housing 38. *Id.* at ¶ 19. Also attached to robot housing 38 are cameras 40

and 42, monitor 44, microphone(s) 46 and speaker(s) 48. *Id.* Camera 40 may provide a wide angle view, and camera 42 may contain a zoom lens to provide a narrow angle view. *Id.* at ¶ 20. Robot 12 may include one or more I/O inputs 70, such as USB ports, and electronic device 72, such as a laptop computer or an electronic camera, can be connected to one or more of ports 70. *Id.* at ¶ 25. An image can be transmitted from electronic device 72 to remote station 16 through mobile robot 12, and the image provided by electronic device 72 can be projected by projector 60. *Id.*

Remote control station 16 includes computer 22 that has monitor 24, camera 26, microphone 28, and speaker 30. *Id.* at ¶ 18. Computer 22 also includes input device 32, such as a joystick and/or a mouse, and keyboard 34. *Id.* Projector 60 is connected to remote control station 16. *Id.* at ¶ 22. Remote control station 16 is typically located in a place that is remote from robot 12. *Id.* ¶ 18.

System 10 allows a user at remote control station 16 to move robot 12 through operation of input device 32. *Id.* at ¶ 19. Robot cameras 40 and 42 are coupled to remote monitor 24, so that a user at remote station 16 can view a patient. *Id.* Robot monitor 44 is coupled to remote camera 26, so that the patient can view the user. *Id.* Microphones 28 and 46, and speakers 30 and 48, allow for audible communication between the patient and the user. *Id.*

2. Claim 1

Patent Owner argues that Wang128 fails to disclose limitation 1.1, “a patient monitor that displays patient information,” and limitation 1.2, “a robot camera capable of viewing the patient and the patient monitor.” Prelim. Resp. 30–33. Because we agree with Patent Owner that Wang128

does not disclose limitation 1.1, we focus our discussion below on that limitation.

a) Petitioner's Arguments

Petitioner contends that Wang128 discloses limitation 1.1. Pet. 37–38 (citing Ex. 1003 ¶¶ 83–87). In particular, Petitioner argues that “Wang128 discloses a patient monitor (electronic device 72) that displays patient information (*e.g.*, video and/or graphical images used during a teleconference with a patient and/or a healthcare practitioner with the patient).” *Id.* at 37 (citing Ex. 1006 ¶¶ 25, 28; *see also* Ex. 1019 (Complaint, Ex. Q at 1–2 (identifying a “Horus Scope,” which is a type of digital camera, as the claimed patient monitor))). Petitioner asserts Wang128 explains an image, that “may be video and/or graphical in nature,” can be transmitted from electronic device 72 to remote station 16 through robot 12. *Id.* at 38 (citing Ex. 1006 ¶ 25; *see also* ¶ 28 (confirming that the “screen of the computer 72 (*see* Fig. 1) can be projected by projector 60”), claims 4–6; Ex. 1003 ¶¶ 84–86))). Petitioner also asserts that “[t]he image transmitted from electronic device 72 to remote station 16 for display by projector 60 is also displayed on the screen of electronic device 72 (*e.g.*, on the screen of the laptop or the screen of the digital camera).” *Id.* (citing Ex. 1003 ¶¶ 84–86).

b) Patent Owner's Arguments

Patent Owner contends that claim 1 is not anticipated by Wang128 because Wang128 fails to disclose “a patient monitor that displays patient information,” as recited in limitation 1.1. Prelim. Resp. 30–31. Patent Owner argues that, contrary to the assertion in the Petition, “nowhere does Wang128 disclose that the electronic device 72 displays any patient

information, much less the specific information of ‘video and/or graphical images used during a teleconference with a patient.’” *Id.* at 31 (citing Pet. 37; Ex. 2001 ¶ 76). Patent Owner states that although Wang128 discloses that an image can be transmitted from electronic device 72 to remote station 16 through robot 12, where the image “may be video and/or graphical in nature,” “Wang128 is silent regarding such an image being patient information.” *Id.* at 31–32 (citing Ex. 1006 ¶ 25; Ex. 2001 ¶ 76).

c) *Analysis*

We agree with Patent Owner that Petitioner has not sufficiently shown that Wang128 discloses limitation 1.1. In particular, we agree with Patent Owner that, contrary to Petitioner’s argument, Wang128 does not disclose that “electronic device 72 displays any patient information, much less the specific information of ‘video and/or graphical images used during a teleconference with a patient and/or a healthcare practitioner.’” Prelim. Resp. 31 (citing Ex. 2001 ¶ 76). Petitioner cites paragraphs 25 and 28 of Wang128 to support its argument that electronic device 72 displays patient information (*e.g.*, video and/or graphical images used during a teleconference with a patient and/or a healthcare practitioner with the patient). Pet. 37 (citing Ex. 1006 ¶¶ 25, 28). However, neither of these paragraphs discloses that electronic device 72 displays patient information or video and/or graphical images used during a teleconference. Instead, as Patent Owner argues, and we agree, Wang128 discloses that an image can be transmitted from device 72 to remote station 16 through robot 12, where the image “may be video and/or graphical in nature.” Prelim. Resp. 31 (citing Ex. 1006 ¶ 25, Fig. 1). Patent Owner also argues, and we agree, that

“Wang128 is silent regarding such an image being patient information.” *Id.* at 32 (citing Ex. 1006 ¶ 25; Ex. 2001 ¶ 76).

Moreover, we are not persuaded by Petitioner’s assertion that “[t]he image transmitted from electronic device 72 to remote station 16 for display by projector 60 is also displayed on the screen of electronic device 72 (e.g., on the screen of the laptop or the screen of the digital camera).” Pet. 38 (citing Ex. 1003 ¶¶ 84–86) (emphasis added). Petitioner’s assertion is conclusory and unsupported by any citation to Wang128.

Petitioner relies on Dr. Fischer’s testimony to bridge the gap in Wang128’s teachings. Dr. Fischer states that a person of ordinary skill in the art “would have understood that the image transmitted from electronic device 72 to remote station 16 for display by projector 60 is also displayed on the screen of electronic device 72” because Wang128 discloses remote station computer 22 may use Microsoft OS, WINDOWS XP or LINUX operating systems, which a person of ordinary skill would have understood could also be run on computer 72 and which “would allow one to easily share a screen of the computer 72 on projector 60 and/or a remote station monitor.” *See* Ex. 1003 ¶ 86.

Like ground 1, ground 2 is also based on anticipation. Like ground 1, Petitioner relies on extrinsic evidence to teach the missing limitation in Wang128, namely, Dr. Fischer’s testimony.¹² However, Dr. Fischer does

¹² As with ground 1, we see no indication that Petitioner is relying on an inherency theory in ground 2. *See Cont’l Can Co.*, 948 F.2d at 1268 (“To serve as an anticipation when the reference is silent about the asserted inherent characteristic, such gap in the reference may be filled with recourse to extrinsic evidence. Such evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference.”).

not provide sufficient support or explanation for his conclusions. Moreover, Dr. Fischer's testimony about the capabilities of these operating systems cannot be considered because neither of these operating systems nor any prior art printed publication concerning either of them is identified in the Petition as the basis for the challenge in ground 2. *See* 35 U.S.C. § 312(a)(3) (petition must identify "with particularity . . . the grounds on which the challenge to each claim is based, and the evidence that supports the grounds for the challenge to each claim."); *see also* 37 C.F.R. § 42.104(b); 35 U.S.C. § 311(b) (petitioner in an *inter partes* review may only challenge the claims of a patent based on "prior art consisting of patents or printed publications.").

Thus, we conclude Petitioner does not demonstrate a reasonable likelihood of prevailing on its challenge to claim 1 as anticipated by Wang128.

3. *Claims 3–6*

Each of claims 3–6 depends directly from claim 1. *See* Ex. 1001, 6:17–26. Patent Owner argues, and we agree, that because claims 3–6 depend from claim 1, each of these claims is also not anticipated by Wang128 for at least the reasons claim 1 is not anticipated. Prelim. Resp. 33–35. Thus, for the reasons discussed above regarding claim 1, we also determine Petitioner does not demonstrate a reasonable likelihood of prevailing on its challenge to claims 3–6 as anticipated by Wang128.

F. Ground 3: Claims 1–5 and 7–13 as Obvious Over Wang438 and David

Petitioner contends that claims 1–5 and 7–13¹³ would have been obvious over Wang438 and David. Pet. 43–49.

1. Summary of David (Ex. 1009)

David is titled “Ambulatory Patient Health Monitoring Techniques Utilizing Interactive Visual Communication.” Ex. 1009, code (54), 2:8–11. David describes “[a]n ambulatory (in the home) patient health monitoring system” wherein patient 16 is monitored by health care worker or practitioner 112 at central station 20, while the patient is at remote location 10. *Id.*, code (57), 8:59–67, 9:1–3. Cameras are provided at remote site 10 and at central station 20 so patient 16 and health practitioner 112 can have a videoconference. *Id.*, code (57), 14:34–40. Figure 6 of David is reproduced below.

¹³ We note Petitioner does not identify claim 13 in its grounds chart or heading for ground 3. *See* 2, 43. However, because Petitioner argues claim 13 in the Petition, we consider ground 3 as including claim 13. *See id.* at 49.

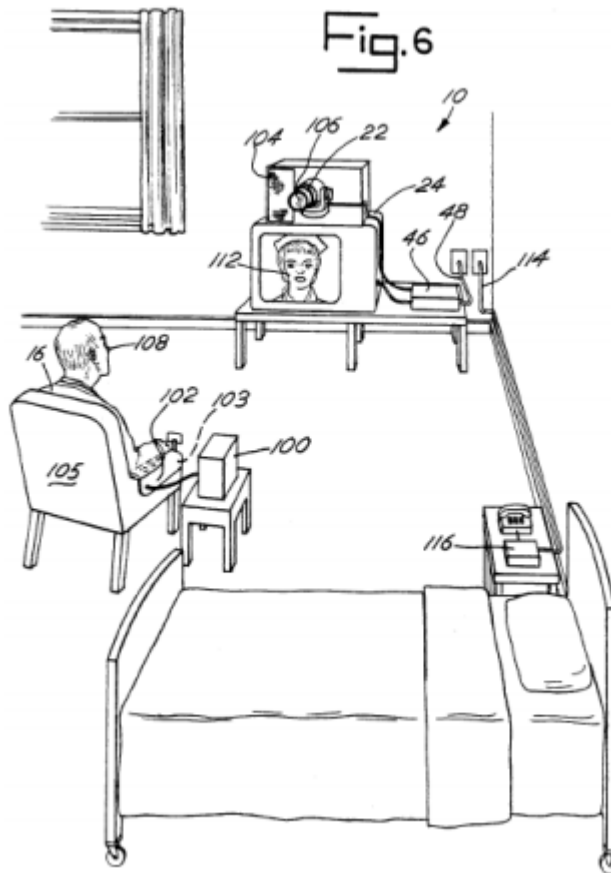


Figure 6 is an “illustration of one possible arrangement of the medical condition measuring, sensing and telecommunications equipment in a patient’s home environment.” Ex. 1009, 7:11–13. In this example, David’s patient monitoring system includes “Criticare monitor unit 100 to which patient 16 is hooked up” and which “measures the pulse rate, blood pressure, oximetry, and temperature of the patient and displays the information on the screen of the monitor unit 100.” *Id.*, 14:4–9.

As shown in Figure 6, patient 16 is seated in chair 105 (with the back of the chair facing the reader) and video camera 22 is mounted in cabinet 104 a short distance away from patient 16 so that the field of view of camera 22 includes the entire patient’s body, as well as the screen of monitor 100. *Id.* at 14:14–22. Video camera 22 then films patient 16 or the screen of the

patient monitoring equipment and transmits the audio-visual signal via modulator 46 through cable TV line 48 from home 10 to cable television station 60. *Id.* at 14:22–26. Suitable servomotors (not shown) are provided within cabinet 104 such that the camera focus and orientation can be controlled by the monitoring health practitioner at the central station. *Id.* at 14:26–30. Camera 22 may also include start up controls which can be remotely operated by the health practitioner to enable the health practitioner to initiate patient monitoring via camera 22. *Id.* at 14:30–33.

In David’s system, the audio-visual signal captured by camera 22 is transmitted over communications network 12 to central station 20. *Id.*, 8:64–67, 9:1–3. Similarly, patient 16 receives an audio-visual signal from health practitioner 112 at central station 20 via communications network 12. *Id.* at 9:6–10. If the medical data is being transmitted simultaneously via telephone line 114 or digitally through cable line 48, then health practitioner 112 can have the information displayed at the central station, in which case the display of monitor 100 is redundant. *Id.* at 14:46–51. However, the display of monitor 100 serves as a “useful backup if the digital transmission is interrupted or fails.” *Id.* at 14:51–52.

2. *Claims 1–5*

Petitioner asserts that Wang438 discloses each element of claim 1. Pet. 43. However, for the reasons discussed above regarding ground 1, we determine that Wang438 does not disclose limitation 1.1, “a patient monitor that displays patient information.” *See supra* § II.D.2(c).

Petitioner contends that Wang438 in view of David also discloses each element of claim 1. Pet. 43 (citing Ex. 1003 ¶¶ 98–106). Petitioner argues that “[l]ike Wang438’s robot 12, David’s patient monitoring system

includes servomotors that allow the camera focus and orientation to be remotely controlled by the healthcare practitioner from central station 20.” *Id.* at 45 (citing Ex. 1009, 14:26–30). Petitioner further argues David’s camera 22 is oriented in the direction of patient 16 and “the field of view” includes the patient’s body, as well as the screen of monitor 100. *Id.* (citing Ex. 1009, 14:18–30). Petitioner asserts that although claim 1 does not require the mobile robot to view the patient and the patient monitor (but only the capability to do so), Wang438 discloses moving robot 12 to view the patient. *Id.* at 45 (citing Ex. 1005 ¶ 19; Ex. 1003 ¶ 102). Petitioner then asserts it would have been obvious in view of David to move Wang438’s robot 12 to view the patient monitor (medical monitoring device 50) as well. *Id.* at 45–46 (citing Ex. 1003 ¶¶ 102–106).

According to Petitioner, a person of ordinary skill would have been motivated to move Wang438’s robot 12 to view the patient monitor for the reason disclosed in David—*i.e.*, to “serve as a useful backup[] if the digital transmission” of patient information from Wang438’s medical monitoring device 50 to Wang438’s remote control station 16 “is interrupted or fails.” *Id.* at 45 (citing Ex. 1009, 14:51–52; *see also* 14:40–45). Petitioner also asserts a person of ordinary skill would have been motivated to move robot 12 to view patient monitors that were incapable of communicating with Wang438’s robot 12 (*e.g.*, patient monitors that lacked a wired or wireless output and patient monitors that lacked digital communication protocols for communicating with Wang438’s robot 12). *Id.* at 45–46 (citing Ex. 1003 ¶ 104). Otherwise, Petitioner states that the “user at Wang438’s remote control station 16 would not be able to obtain patient information from the patient monitor.” *Id.* at 46. Petitioner further asserts that the

proposed combination would have been merely “the application of a known technique (viewing a patient and patient monitor during a tele-conference) with a known system (Wang438’s robotic system) in a common field of endeavor (telepresence systems for remotely monitoring patients).” *Id.* (citing Ex. 1003 ¶ 106). Accordingly, Petitioner argues that in the “Wang438-David combination, Wang438’s robot 12 and medical monitoring device 50 each continue to work as they always have.” *Id.*

In response, Patent Owner argues that a person of ordinary skill would not have been motivated to combine Wang438 and David. Prelim. Resp. 35–38. In particular, Patent Owner argues that David criticizes robotic systems such as Wang438 for several reasons and, therefore, a person of ordinary skill would not have been motivated to combine aspects of David with Wang438 “in view of David’s warning not to do so.” *Id.* 36 (citing Ex. 1009, 3:61–4:12; Ex. 2001 ¶ 90). Patent Owner also argues that a person of ordinary skill would not have been motivated to use Wang438’s robot 12 to view monitoring device 50 to serve as a useful backup because if the transmission from device 50 to Wang438’s remote station 16 was interrupted or failed, then the transmission of images from robot camera 38 to remote station 16 would also fail because both transmissions “travel through almost entirely the same path.” *Id.* at 36–37 (citing Ex. 1005 ¶¶ 18–19, 21–22, Fig. 1; Ex. 2001 ¶ 91).

Patent Owner further argues a person of ordinary skill would not have been motivated to move Wang438’s robot 12 to view monitoring device 50 that was incapable of communicating with Wang438’s robot because in the proposed combination, “monitoring device 50 *is* capable of communicating with Wang438’s robot” and, therefore, “the offered motivation merely cures

a problem with Wang438 that doesn't actually exist in the proposed combination.” *Id.* at 37–38 (citing Ex. 2001 ¶ 92). Lastly, Patent Owner argues a person of ordinary skill would not have been motivated to move Wang438's robot 12 to view monitoring device 50 for the simple reasons that a person of ordinary skill would have understood that “the medical monitoring device 50 does not display any patient information, as discussed above, and therefore there would be no reason to point the camera at it.” *Id.* at 38.

Patent Owner also asserts that Petitioner's proposed combination of Wang438 and David “retains the Wang438 system completely intact but relies on David to supply a motivation ‘to move Wang438's robot 12 to view the [medical monitoring device 50] as well.’” *Id.* at 38–39. However, Patent Owner further asserts that the proposed combination of Wang438 and David still does not disclose or teach either “a patient monitor that displays patient information” or “a robot camera capable of viewing the patient and the patient monitor,” as required by limitations 1.1 and 1.2 of claim 1.

Even assuming Petitioner has shown a person of ordinary skill in the art would have been motivated by David to move Wang438's robot 12 to view medical monitoring device 50, Patent Owner argues, and we agree, that Petitioner's combination of Wang438 and David “retains the Wang438 system completely intact” and relies on David to supply a motivation “to move Wang438's robot 12 to view the [medical monitoring device 50] as well.” Prelim. Resp. 38–39 (citing Pet. 45–46). However, as Patent Owner also argues, the proposed combination of Wang438 and David still does not disclose “a patient monitor that displays patient information” because, as we determine above in regard to limitation 1.1 in ground 1, Wang438 does not

disclose that medical monitoring device 50 displays any patient information. *Id.* at 39 (citing Ex. 1005 ¶21; Ex. 2001 ¶ 95; *see supra* § II.D.2(c)). Thus, as Patent Owner further argues, because the proposed combination in ground 3 for claim 1 “does not provide any further teaching of a patient monitor that displays patient information,” the proposed combination also does not disclose a patient monitor that displays patient information. *Id.* (citing Pet. 45–56; Ex. 2001 ¶ 96).

Accordingly, we conclude Petitioner does not demonstrate a reasonable likelihood of prevailing on its challenge to claim 1 as obvious over the combination of Wang438 and David. Each of claims 2–5 depends directly from claim 1. Ex. 1001, 6:14–24. Thus, for the reasons discussed above regarding claim 1, we also determine Petitioner does not demonstrate a reasonable likelihood of prevailing on its challenge to claims 2–5 as obvious over the combination of Wang438 and David.

3. Claims 7–12

Similar to limitation 1.1, limitation 7.2 of independent claim 7 recites “displaying patient information on the patient monitor.” Ex. 1001, 6:30. In regard to limitation 7.2, Petitioner merely states, “*See* Ground 1, element [1.1].” Pet. 47. However, Petitioner’s statement is unavailing. For the reasons discussed above regarding limitation 1.1 in ground 1, we determine Wang438 does not disclose “a patient monitor that displays patient information,” and therefore, we also determine Wang438 does not disclose or teach the substantially similar limitation 7.2, which recites “displaying patient information on the patient monitor.” *See supra* § II.D.2(c).

Accordingly, we conclude Petitioner does not demonstrate a reasonable likelihood of prevailing on its challenge to claim 7 as obvious

over the combination of Wang438 and David. Each of claims 8–12 depends directly from claim 7. Ex. 1001, 6:34–45. Thus, for the reasons discussed above regarding claim 7, we also determine Petitioner does not demonstrate a reasonable likelihood of prevailing on its challenge to claims 8–12 as obvious over the combination of Wang438 and David.

G. Ground 4: Claims 1–13 as Obvious Over Wang438, David, and Reeder

Petitioner contends that the combination of Wang438, David, and Reeder render claims 1–13 obvious. Pet. 49–63.

1. Summary of Reeder (Ex. 1008)

Reeder is titled “Patient Point of Care Computer System” and describes computer system 10 that includes computer 12 for use by the

caregiver at a patient point of care in a hospital or other medical facility.
Ex. 1008, code (54), ¶¶ 2, 85. Figure 1 of Reeder is reproduced below.

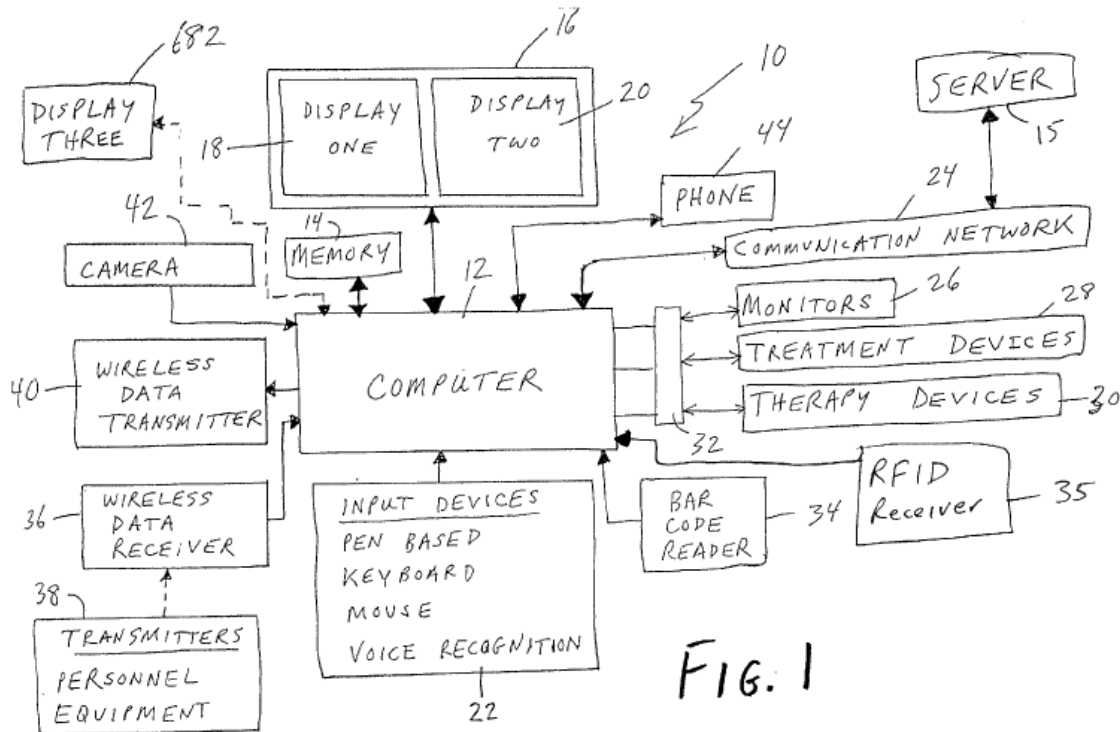


Figure 1 is a block diagram illustrating components of Reeder's patient point of care computer system 10. *Id.* at ¶ 27. "Computer system 10 is designed to provide improved access to data at the point of care," and "organizes numerous monitors, treatment devices, and therapy devices and facilitates record keeping by providing a real time electronic chart for the patient." *Id.* at ¶ 84. Computer system 10 includes computer 12 that is coupled to display 16, which includes first and second displays 18 and 20, input device 22 (such as a pen or stylus based input, keyboard, mouse, joystick or other suitable input device), data monitors 26, treatment devices 28, therapy devices 30, among many other devices. *Id.* at ¶ 85. Computer 12 processes signals from monitors 26, treatment devices 28, and therapy devices 30 on a real time basis, which information is used to provide an

electronic chart of patient conditions on display screens 18 and 20. *Id.* at ¶ 87. Monitors 26, treatment devices 28, and therapy devices 30 include heart rate monitors, temperature sensors, blood pressure monitors (invasive and noninvasive), EKG monitors, blood oxygen sensors, capnographs, ventilators, IV pumps, scales, chest drainage monitors, and the like. *Id.*

Reeder discloses different embodiments of computer system 10, including the embodiment illustrated in Figure 2, which is reproduced below.

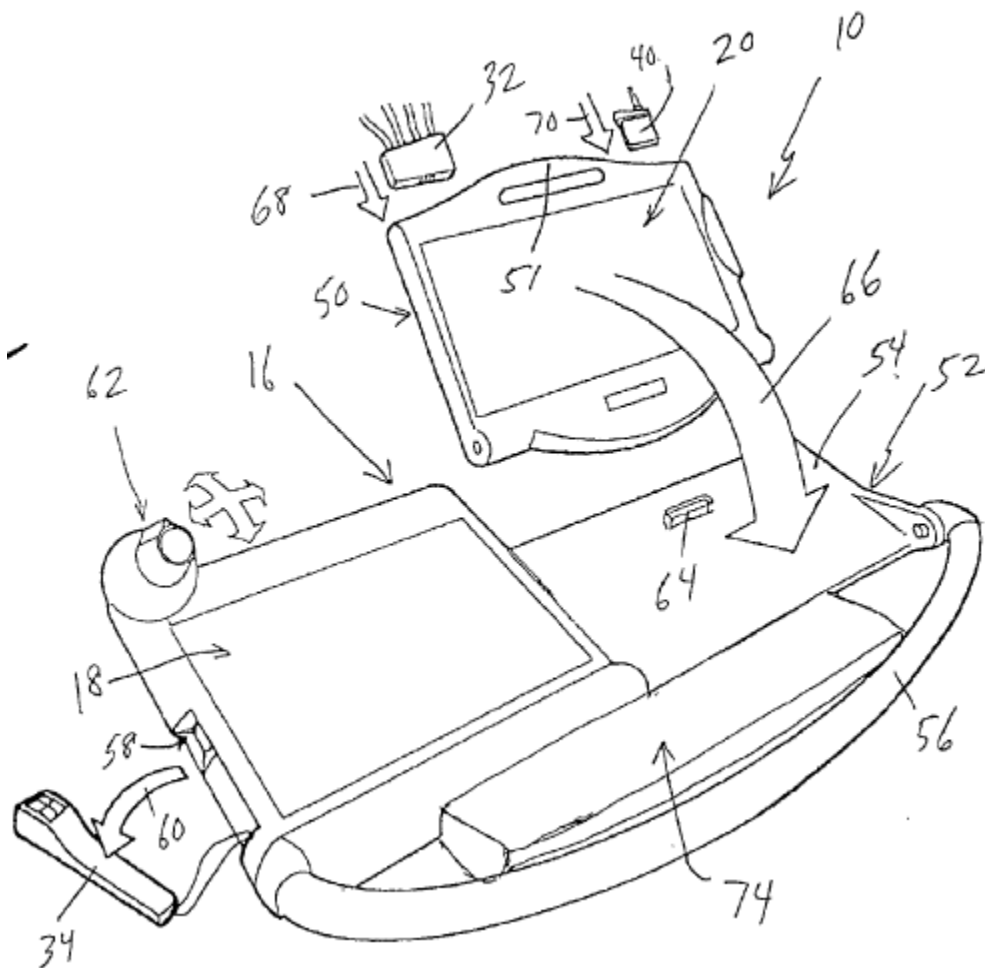


Figure 2 illustrates display screen 18 affixed to support 52 and display screen 20 located in removable module 50, which may be detached from

support 52. *Id.* at ¶ 93. Input device 62 is coupled to support 52, and connector 32 connects to a port on module 50 to receive signals from monitors 26, treatment devices 28, and therapy devices 30. *Id.* at ¶ 94.

2. Claims 1–6

In regard to claim 1, Petitioner asserts that Wang438 discloses limitation 1.1—“a patient monitor that displays patient information”—and Reeder does also. Pet. 50 (stating, “*See* Ground 1, element [1.1]”; citing Ex. 1003 ¶¶ 118–122; Ex. 1008 ¶¶ 85, 101, Figs. 11–18). Patent Owner does not specifically contest Petitioner’s argument regarding Reeder. *See generally* Prelim. Resp. 44–52. We agree with Petitioner that Reeder teaches limitation 1.1 because Reeder discloses that first and second display screens 18 and 20 are used to display patient information in the form of an electronic chart or flow sheet. Ex. 1008 ¶¶ 4, 87, 92, 120.

Regarding limitation 1.2, which recites “a mobile robot that has . . . a robot camera that captures an image, said robot camera being capable of viewing the patient and said patient monitor,” Petitioner states that in ground 4, “Reeder’s computer system 10 is the claimed patient monitor.” Pet. 58. Petitioner argues it would have been obvious to combine Wang438’s robot system with Reeder’s patient monitor (computer system 10) and that “[i]n the resulting system (‘the Wang438-Reeder system’), Reeder’s computer system 10 is Wang438’s medical monitoring device 50.” *Id.* at 53 (citing Ex. 1003 ¶¶ 123–133). Petitioner also argues that a person of ordinary skill in the art would have been motivated to combine Wang438 and Reeder for several reasons. *Id.* at 53–58.

In response, Patent Owner states that “[n]otably, this proposed combination does not rely on David, or provide any motivation to combine

David with Wang438 or Reeder.” Prelim. Resp. 45 (citing Pet. 53–58; Ex. 2001 ¶ 118). Patent Owner further asserts, “[h]owever, the proposed combination of Wang438 and Reeder does not disclose ‘a robot camera capable of viewing the patient and the patient monitor,’ as is required by claim 1 of the ’185 [p]atent.” *Id.* (citing Ex. 2001 ¶ 119). Patent Owner argues that the proposed combination does not explain how Reeder’s computer system would be substituted for Wang438’s monitoring device 50, and how as a result Wang438’s robot camera would be capable of viewing the patient and the substituted computer system. *Id.* (citing Ex. 2001 ¶¶ 119–120). Patent Owner also argues that a person of ordinary skill in the art would not have been motivated to combine Wang438 and Reeder for the reasons provided in the Petition. *Id.* at 47–52.

We agree with Patent Owner that Petitioner’s proposed Wang438-Reeder system does not teach or suggest “a robot camera being capable of viewing the patient and said patient monitor.” As Patent Owner states, in Wang438, medical monitoring device 50 is a small wrist-mounted data probe, while in Figure 15 of Reeder, cited in Ground 4, “the computer system 10 is a large ensemble system of supports, displays, input devices, treatment devices, therapy devices, etc.” *Id.* at 45–46 (citing Ex. 1005 ¶ 21, Fig. 1; Ex. 1008 ¶¶ 84–85, 87, Figs. 1–2; Ex. 2001 ¶ 120; Pet. 50). Patent Owner also states, and we agree, it is “unclear how such an ensemble system could simply take the place of a small wrist-mounted data probe,” and Petitioner does not propose how the computer system of Reeder would be accommodated in Wang438 in place of the wrist-mounted monitoring device. *Id.* at 46 (citing Ex. 2001, ¶ 120; Pet. 53–58). As Patent Owner further argues, “Petitioner makes no attempt to explain[] how the computer

system of Reeder could be reconciled with the mobile robot of Wang438 in, for example, a hospital room with limited space.” *Id.* (citing Ex. 1005 ¶ 19, Fig. 1; Ex. 1008 ¶¶ 84–85, 87; Figs. 1–2; Pet. 53–58; Ex. 2001 ¶ 121). According to Patent Owner, for example, due to the large sizes of both Wang438’s robot and Reeder’s ensemble computer system, each would need to be either placed a good distance from the other, or in an awkward spatial relationship with the other, and in either case, the arrangement would not result in Wang438’s robot camera being capable of viewing both the patient and the display of the Reeder computer system ensemble. *Id.* (citing Ex. 2001 ¶ 121–122). Thus, we determine Petitioner makes an inadequate showing that the proposed Wang438-Reeder system teaches or suggests limitation 1.2. *See* 35 U.S.C. § 312(a)(3); 37 C.F.R. §§ 42.22(a)(2), 42.104(b)(4), 42.104(b)(5).

We also agree with Patent Owner that a person of ordinary skill in the art would not have been motivated to substitute Reeder’s computer system for Wang438’s medical monitoring device 50. *See* Prelim. Resp. 47–52. For example, Patent Owner first argues that Wang438’s monitoring device 50 is a small wrist-mounted data probe or sensor, “whereas Reeder’s computer system is a large ensemble system including supports, displays, input devices, treatment devices, therapy devices, etc.” *Id.* 47–48 (citing Ex. 1005 ¶ 21, Fig. 1; Ex. 1008 ¶¶ 84–85, 87; Figs. 1–2; Ex. 2001 ¶ 125). Accordingly, Patent Owner argues, and we agree, “the proposed combination is a substitution of dissimilar items, without any proposal to accommodate the dissimilarity, and the results would be unknown and unpredictable.” *Id.* at 48 (citing Ex. 2001 ¶ 125). Second, although Petitioner argues that a person of ordinary skill in the art would have been

motivated to use Reeder's computer system 10 as Wang438's monitoring device 50 to obtain the benefits of Reeder's system, Patent Owner argues, and we agree, Wang438's monitoring device does not perform, and has no need to perform, the functions cited by Petitioner, such as

“organiz[ing] numerous monitors, treatment devices, and therapy devices and facilitates record keeping by providing a real time electronic chart for the patient;” “improv[ing] communications between various caregivers who are members of a care team for the particular patient;” “automat[ing] processes for ordering tests and communicating between various caregivers working with a patient;” being “used as a tool to educate the patient;” being “used to assist compliance with a doctor's instructions after release;” or being “used as a TV set when the caregiver is not in the room” of Reeder.

Id. at 48–49 (citing Ex. 1005 ¶ 21, Fig. 1; Ex. 1008 ¶¶ 84–85, 87, Figs. 1–2; Pet. 54; Ex. 2001 ¶ 127).

Third, Patent Owner argues that Petitioner's assertion that “mobile robots, like Wang438's robot 12, were used with conventional paper charts” and that a person of ordinary skill would have been motivated to use Reeder's computer system 10 wherein there is little delay in inputting information to the patient's chart, to reduce the delays that occur with convention paper charts, is unsupported. *Id.* at 49–50 (citing Pet. 55). As Patent Owner states, Petitioner supports the idea that Wang438's robot is used with paper charts “by citing to a different reference (*i.e.*, Wang421) that is not among the references that form the basis for this ground” and to the declaration of Petitioner's expert, “which does not actually provide any further explanation or support.” *Id.* at 50 (citing Pet. 55; Ex. 1003 ¶ 127; Ex. 2001 ¶ 131). Thus, we agree with Patent Owner's argument that “there is no evidence that the robot of Wang438 is used with paper charts or even electronic charts,” and thus a person of ordinary skill would not have been

motivated “to incorporate a large ensemble computer system to address a need that is not shown to exist.” *Id.* (citing Ex. 2001 ¶131).

For these reasons, we conclude Petitioner does not demonstrate a reasonable likelihood of prevailing on its challenge of claim 1 as unpatentable under 35 U.S.C. § 103(a) over Wang438, David, and Reeder. Because the challenges to dependent claims 2–6 share the same deficiency, we also conclude Petitioner does not demonstrate a reasonable likelihood of prevailing on its challenge of those claims as unpatentable under 35 U.S.C. § 103(a) over Wang438, David, and Reeder.

3. *Claims 7–13*

In regard to limitation 7.1, which recites “moving a mobile robot that has a camera to view a patient and a patient monitor,” Petitioner states, “*See* Ground 3, element [7.1]. In Ground 4, however, Reeder’s computer system 10 is the claimed patient monitor.” Pet. 60–61.

In response, Patent Owner argues that the combination of Wang438, David, and Reeder fails to disclose or teach limitation 7.1 for the same reasons discussed regarding limitation 1.1 in ground 4 that “Wang438, David, and Reeder do not teach ‘a robot camera capable of viewing the patient and the patient monitor.’” Prelim. Resp. 52–53 (citing Ex. 2001 ¶ 138). Patent Owner also argues that a person of ordinary skill in the art would not have been motivated to combine Wang438, David, and Reeder for the same reasons discussed for claim 1 of ground 4. *Id.* at 53.

For the same reasons discussed above regarding limitation 1.1 in ground 4, we determine Petitioner makes an inadequate showing that the proposed combination of Wang438, David, and Reeder teaches or suggests

limitation 7.1 in ground 4. *See* § II.G.2; *see also* 35 U.S.C. § 312(a)(3); 37 C.F.R. §§ 42.22(a)(2), 42.104(b)(4), 42.104(b)(5).

Accordingly, we conclude Petitioner does not demonstrate a reasonable likelihood of prevailing on its challenge to claim 7 as obvious over the combination of Wang438, David, and Reeder. Each of claims 8–13 depends directly from claim 7. Ex. 1001, 6:34–47. Thus, for the reasons discussed above regarding claim 7, we also determine Petitioner does not demonstrate a reasonable likelihood of prevailing on its challenge to claims 8–13 as obvious over the combination of Wang438, David, and Reeder.

III. ORDER

In consideration of the foregoing, it is hereby:

ORDERED that no *inter partes* review is instituted.

IPR2021-00933
Patent 7,761,185 B2

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