

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

AMERICAN WELL CORPORATION,
Petitioner,

v.

TELADOC HEALTH, INC.,
Patent Owner.

IPR2022-00039
Patent 10,471,588 B2

Before LYNNE H. BROWNE, KARA L. SZPONDOWSKI, and
STEVEN M. AMUNDSON, *Administrative Patent Judges*.

AMUNDSON, *Administrative Patent Judge*.

DECISION
Dismissal Prior to Institution of Trial
35 U.S.C. § 314

American Well Corporation (“Petitioner”) filed a Petition requesting an *inter partes* review of claim 4 in U.S. Patent No. 10,471,588 B2 (Ex. 1001, “the ’588 patent”) under 35 U.S.C. §§ 311–319. Paper 2 (“Pet.”). Teladoc Health, Inc. (“Patent Owner”) filed a Preliminary Response. Paper 6 (“Prelim. Resp.”).

After receiving Board authorization, Petitioner filed an Unopposed Motion to Dismiss this proceeding. Paper 8; *see* Ex. 1023 (Mar. 2, 2022, email from Patent Owner’s counsel stating, “We do not oppose.”). In its motion, Petitioner states that in April 2021 it filed a petition in IPR2021-00749 (“the -749 proceeding”) challenging claims in the ’588 patent and that in September 2021 the Board instituted an *inter partes* review in the -749 proceeding. Paper 8, 1; *see Am. Well Corp. v. Teladoc Health, Inc.*, IPR2021-00749, Paper 2 (challenging claims 1–7 in the ’588 patent). According to Petitioner, the petition in the -749 proceeding “included inadvertent misstatements related to claim 4.” Paper 8, 1.

Petitioner states that it sought to address the inadvertent misstatements related to claim 4 in two alternative ways. Paper 8, 1. First, Petitioner filed “a motion to submit supplemental information, including a supplemental expert declaration,” in the -749 proceeding. *Id.* (citing IPR2021-00749, Paper 13). Second, Petitioner filed “the instant Petition.” *Id.*; *see* Pet. 58 (stating that “[t]he present IPR petition is being filed to correct inadvertent misstatements made in the first petition relating to claim 4”). Petitioner states that in February 2022 “the Board granted Petitioner’s motion to submit supplemental information” in the -749 proceeding. Paper 8, 1.

Petitioner asserts that “the instant Petition is now moot in view of the successful submission of supplemental information” in the -749 proceeding.

Paper 8, 1. Petitioner also asserts that “good cause exists to dismiss the instant Petition” because (1) this proceeding “is in its preliminary stage and the Board has not rendered a decision on institution” and (2) “[d]ismissal would preserve the Board’s and parties’ resources and promote a speedy and inexpensive resolution to this dispute.” *Id.* at 2.

We agree that good cause exists to dismiss the Petition. This proceeding has not progressed very far. Petitioner filed the Petition on October 12, 2021. Patent Owner filed the Preliminary Response on January 24, 2022. The Board has not yet decided whether to institute an *inter partes* review. Terminating this proceeding will save the Board administrative and judicial resources, e.g., in conducting an oral argument and issuing a final written decision to decide the patentability issues raised in the Petition.

Under these circumstances, we determine that it is appropriate to terminate this proceeding.

ORDER

Accordingly, it is

ORDERED that Petitioner’s Unopposed Motion to Dismiss (Paper 8) is granted; and

FURTHER ORDERED that this proceeding is terminated as to all parties.

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