

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

LULULEMON ATHLETICA CANADA INC.
AND LULULEMON USA INC.,
Petitioner,

v.

NIKE, INC.,
Patent Owner.

IPR2023-00349
Patent 9,259,615 B2

Before JOSIAH C. COCKS, GEORGE R. HOSKINS, and
STEPHEN E. BELISLE, *Administrative Patent Judges*.

BELISLE, *Administrative Patent Judge*.

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

I. INTRODUCTION

lululemon athletica canada inc. and lululemon usa inc. (“Petitioner”) filed a Petition (Paper 2, “Pet.”) requesting an *inter partes* review of claims 1–5, 7, 11, and 13¹ (“Challenged Claims”) of U.S. Patent No. 9,259,615 B2 (Ex. 1001, “the ’615 patent”). Petitioner identifies itself along with lululemon athletica inc. and Curiouser Products, Inc. as real parties in interest. Pet. 78. Nike, Inc. (“Patent Owner”) identifies itself as a real party in interest (Paper 8, 2), and timely filed a Preliminary Response to the Petition (Paper 10, “Prelim. Resp.”).

We have authority to determine whether to institute an *inter partes* review. 35 U.S.C. § 314(b) (2018); 37 C.F.R. § 42.4(a) (2022). We may not institute an *inter partes* review “unless . . . there is 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). The “reasonable likelihood” standard is “a higher standard than mere notice pleading” but “lower than the ‘preponderance’ standard to prevail in a final written decision.” *Hulu, LLC v. Sound View Innovations, LLC*, IPR2018-01039, Paper 29 at 13 (PTAB Dec. 20, 2019) (precedential). When instituting *inter partes* review, the Board will authorize the review to proceed on all of the

¹ We note that the Petition also states Petitioner “requests cancelation of claims 1–7 and 11–13 of the ’615 patent” (Pet. 2), and “requests cancellation of claims 1–8 and 11–13 of the ’615 patent” (Pet. 19). The Petition, however, substantively addresses only claims 1–5, 7, 11, and 13, and does not challenge with particularity any of claims 6, 8, or 12. *See* 35 U.S.C. § 312(a)(3); Prelim. Resp. 1 (“[T]here is no other indication in the Petition that claims 6, 8, or 12 are being challenged.”). Thus, we need not and do not address herein claims 6, 8, and 12.

challenged claims and on all grounds of unpatentability asserted for each claim. 37 C.F.R. § 42.108(a).

Applying those standards, and upon consideration of the information presented in the Petition and Preliminary Response, we determine that Petitioner has demonstrated a reasonable likelihood of success in proving that at least one claim of the '615 patent is unpatentable. *See* 35 U.S.C. § 314; 37 C.F.R. § 42.4(a). Accordingly, we institute an *inter partes* review as to all Challenged Claims of the '615 patent on all grounds raised in the Petition.

We base our factual findings and conclusions at this stage of the proceeding on the evidentiary record developed so far. This is not a final decision as to the construction of any claim term or the patentability of any claim. Any final decision shall be based on the full trial record, including any response timely filed by Patent Owner. Any arguments not raised by Patent Owner in a timely filed response may be deemed waived, even if they were presented in the Preliminary Response.

II. BACKGROUND

A. Related Matters

Petitioner indicates that Patent Owner asserted the '615 patent against Petitioner in a U.S. district court action, namely, *Nike, Inc. v. lululemon athletica inc. et al.*, Case No. 1:22-cv-00082-RA-OTW (S.D.N.Y.) (“District Court Action”), which is presently stayed. Pet. 79.

Although not identified by the parties, we note that the District Court Action also involves the following U.S. Patents against which Petitioner filed the noted requests for *inter partes* review: 8,620,413 (IPR2023-00438);

9,278,256 (IPR2023-00189); 10,188,930 (IPR2023-00348); 10,232,220 (IPR2023-00180); and 10,923,225 (IPR2023-00424).

B. The '615 Patent

The '615 patent is titled “Wearable Device Assembly Having Athletic Functionality and Streak Tracking,” and issued February 16, 2016, from U.S. Patent Application No. 14/194,191, filed February 28, 2014. Ex. 1001, codes (10), (21), (22), (45), (54). The '615 patent states that it claims priority through a series of continuation and continuation-in-part applications to U.S. Patent Application No. 13/068,870, filed November 1, 2010. *Id.* at 1:8–17.

The '615 patent relates to a “wearable athletic information device having illuminating features indicating a level of activity,” such as wearable device assembly 10 shown in Figure 1, reproduced below. Ex. 1001, 1:23–26, 8:24–27, Fig. 1.

FIG. 1



Figure 1 depicts a person utilizing an athletic performance monitoring and feedback system.

Id. at 2:56–59, Fig. 1. Wearable device assembly 10 “has a sensor associated therewith such as a three-axis accelerometer wherein the device 10 is capable of monitoring athletic activity or overall activity of the user.” *Id.* at 8:28–31. As shown above in Figure 1, athletic performance monitoring and feedback system 1 also may include a further module or sensor 2, such as one carried by or embedded in a shoe, as well as mobile device 3. *Id.* at 8:31–35. According to the ’615 patent, system 1 also may include “an activity tracking application that may execute on a mobile device or stationary device different from a wearable activity tracking device,” and “may be used to record activity data, track goals, track

milestones and other achievements and provide competition and team modes.” *Id.* at 2:42–47.

According to the ’615 patent, the activity tracking application may further provide feedback and review information relating to *multiple goal time periods*, including the tracking and monitoring of activity *streaks*:

In one example, the activity tracking application may track and monitor activity streaks. Streaks may include the completion of multiple goals corresponding to multiple consecutive goal time periods. Streaks might only be recognized when the user has completed goals for X number of consecutive goal time periods, where X may be any number greater than 1 (e.g., greater than or equal to 2). The tracking and recognition of streaks may provide a further motivating factor for the user to maintaining and/or elevating his or her activity level and to meet all goals. Streaks also encourage consistency which may lead to the adoption of a healthier or more active lifestyle. The user may be awarded with rewards or types of recognition including coupons, free products, virtual items including virtual apparel, icons, images etc., services, event tickets and the like.

Ex. 1001, 56:65–57:23.

C. Illustrative Claim

The ’615 patent includes fourteen claims, of which Petitioner challenges claims 1–5, 7, 11, and 13. Claims 1 and 11 are the only independent claims, and claim 1 is reproduced below with bracketing added to mirror the parties’ usage thereof.

1. [pre] A method, comprising:
 - [a] receiving athletic activity data from a device configured to be worn by a user;
 - [b] receiving an activity time period;
 - [c] receiving a first activity goal for the activity time period;

[d] determining, at a processor, whether the received athletic activity data exceeds the first activity goal for a predetermined number of consecutive activity time periods; and

[e] presenting a streak reward to the user when the received athletic activity data exceeds the first activity goal for the predetermined number of consecutive activity time periods.

Ex. 1001, 80:25–37.

D. Evidence of Record

Petitioner relies on the following patent and published patent application evidence.

Name	Patent Document	Exhibit
Hoffman	US 2011/0197157 A1	1002
Stivoric	US 2004/0152957 A1	1003
Sirmans	US 2006/0111944 A1	1004
Kobayashi	JP 2003-141260 ²	1005
Brady	US 7,431,696 B1	1021

Pet. 20.

Petitioner also relies upon the Declaration of Dr. Gregory S. Fischer (Ex. 1006).

At this stage of the proceeding, Patent Owner does not rely upon a declarant of its own.

² Petitioner submitted a certified English translation of JP 2003-141260 in Ex. 1005 (i.e., this exhibit includes both original and translated versions), and citations herein to Kobayashi are to the translated version, namely, exhibit pages 26–50.

E. Asserted Challenges to Patentability

Petitioner challenges the patentability of claims 1–5, 7, 11, and 13 of the '615 patent on the following bases.

Claims Challenged	35 U.S.C. §	Reference(s)/Basis
1–5, 7, 11, 13	102 ³	Hoffman
1–5, 7, 11, 13	103	Stivorice, Kobayashi
1–5, 7, 11, 13	103	Sirmans, Kobayashi
3–5	103	Stivorice, Kobayashi, Brady
3–5	103	Sirmans, Kobayashi, Brady

Pet. 20.

III. ANALYSIS

A. Applicable Law

Petitioner challenges the patentability of claims 1–5, 7, 11, and 13 of the '615 patent on grounds that the claims are anticipated under 35 U.S.C. § 102 or would have been obvious under 35 U.S.C. § 103 in light of various references, namely Hoffman, Stivorice, Sirmans, Kobayashi, and Brady.

“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 Inc. v. Avid Tech., Inc., 815 F.3d 1356, 1363 (Fed. Cir. 2016)

(citing 35 U.S.C. § 312(a)(3) (requiring *inter partes* review petitions to identify “with particularity . . . the evidence that supports the grounds for the

³ The Leahy-Smith America Invents Act (“AIA”), Pub. L. No. 112-29, 125 Stat. 284, 287–88 (2011), amended 35 U.S.C. §§ 102 and 103 effective on March 16, 2013. Neither party argues, at least at this stage of the proceeding, that the outcome of this case would differ based on applying the pre-AIA or post-AIA versions of these laws.

challenge to each claim”)) (emphasis added). This burden never shifts to Patent Owner. *See Dynamic Drinkware, LLC v. Nat’l Graphics, Inc.*, 800 F.3d 1375, 1378 (Fed. Cir. 2015) (citing *Tech. Licensing Corp. v. Videotek, Inc.*, 545 F.3d 1316, 1326–27 (Fed. Cir. 2008)) (discussing the burden of proof in *inter partes* review).

To serve as an anticipatory reference under 35 U.S.C. § 102, “the reference must disclose each and every element of the claimed invention, whether it does so explicitly or inherently.” *In re Gleave*, 560 F.3d 1331, 1334 (Fed. Cir. 2009). “The identical invention must be shown in as complete detail *as is contained in the . . . claim.*” *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236 (Fed. Cir. 1989) (emphasis added). The elements must be arranged as required by the claim, “but this is not an ‘*ipsissimis verbis*’ test,” i.e., identity of terminology is not required. *In re Bond*, 910 F.2d 831, 832–33 (Fed. Cir. 1990) (citing *Akzo N.V. v. United States Int’l Trade Comm’n*, 808 F.2d 1471, 1479 & n.11 (Fed. Cir. 1986)).

A claim is unpatentable under 35 U.S.C. § 103 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; (3) the level of skill in the art; and (4) when of record, objective evidence of obviousness or non-obviousness, i.e., secondary considerations. *Graham v. John Deere Co.*, 383 U.S. 1, 17–18 (1966). Objective indicia of non-

obviousness may include the following: “commercial success, long felt but unsolved needs, failure of others, etc.”⁴ *Id.* The totality of the evidence submitted may show that the challenged claims would not have been obvious to one of ordinary skill in the art. *In re Piasecki*, 745 F.2d 1468, 1471–72 (Fed. Cir. 1984). When evaluating a combination of teachings, we must also “determine 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)).

We analyze the challenges presented in the Petition in accordance with the above-stated principles.

B. Level of Ordinary Skill in the Art

Petitioner contends that a person of ordinary skill in the art, at the time of the invention of the ’615 patent,

would have had (1) a bachelor’s degree in engineering, computer science, industrial design, biomechanics, or a related field, and (2) at least two years of experience researching, developing, designing, and/or testing fitness or physiological sensors, wearable devices, physiological or biomechanical devices, remotely controlled systems or interfaces, network-based applications and/or equipment, or the equivalent experience or education.

Pet. 18 (citing Ex. 1006 ¶ 42).

Patent Owner does not present an alternative definition at this stage of the proceeding. *See* Prelim. Resp. 11–12 (“For the purposes of this

⁴ At this stage of the proceeding, Patent Owner has not presented objective evidence of non-obviousness.

Preliminary Response only, [Patent Owner] applies [Petitioner's] proposed level of skill in the art.”).

In determining the level of ordinary skill in the art, various factors may be considered, including the “type of problems encountered in the art; prior art solutions to those problems; rapidity with which innovations are made; sophistication of the technology; and educational level of active workers in the field.” *In re GPAC Inc.*, 57 F.3d 1573, 1579 (Fed. Cir. 1995) (citation omitted). The level of ordinary skill in the art also is reflected by the prior art of record. *See Okajima v. Bourdeau*, 261 F.3d 1350, 1355 (Fed. Cir. 2001).

Neither party argues, at least at this stage of the proceeding, that the outcome of this case would differ based on our adoption of any particular definition of the level of ordinary skill in the art. Considering the subject matter of the '615 patent, the background technical field, the prior art, and Petitioner's proposed and unopposed definition of the skilled artisan, we apply the level of skill set forth above, which is consistent with the testimony of Dr. Fischer (Ex. 1006 ¶ 42).

C. Claim Construction

We construe claims “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), including construing 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.” 37 C.F.R. § 42.100(b) (2020); *see also Phillips v. AWH Corp.*, 415 F.3d 1303 (Fed. Cir. 2005) (en banc).

In this context, claim terms “are generally given their ordinary and customary meaning” as understood by a person of ordinary skill in the art in question at the time of the invention. *Phillips*, 415 F.3d at 1312–13; *accord CCS Fitness, Inc. v. Brunswick Corp.*, 288 F.3d 1359, 1366 (Fed. Cir. 2002) (There is “a ‘heavy presumption’ that a claim term carries its ordinary and customary meaning.”). “In determining the meaning of the disputed claim limitation, we look principally to the intrinsic evidence of record, examining the claim language itself, the written description, and the prosecution history, if in evidence.” *DePuy Spine, Inc. v. Medtronic Sofamor Danek, Inc.*, 469 F.3d 1005, 1014 (Fed. Cir. 2006) (citing *Phillips*, 415 F.3d at 1312–17). Extrinsic evidence is “less significant than the intrinsic record in determining ‘the legally operative meaning of claim language.’” *Phillips*, 415 F.3d at 1317.

Only those claim terms that are in controversy need to be construed, and only to the extent necessary to resolve the controversy. *See Nidec Motor Corp. v. Zhongshan Broad Ocean Motor Co.*, 868 F.3d 1013, 1017 (Fed. Cir. 2017) (stating that “we 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))).

Petitioner submits “no constructions are necessary to resolve any disputes identified in this Petition” (Pet. 18), and “[Patent Owner] agrees,” contending that “[a]ll terms and phrases in the ’615 patent have their ordinary and customary meanings, which are readily apparent, and no further construction is required” (Prelim. Resp. 12). In determining whether Petitioner has demonstrated a reasonable likelihood of establishing

unpatentability of at least one challenged claim in this case, we need not and do not construe expressly any claim terms. *See Nidec*, 868 F.3d at 1017.

D. Alleged Obviousness of Claims 1–5, 7, 11, and 13 over the Combination of Sirmans and Kobayashi

Petitioner contends claims 1–5, 7, 11, and 13 are unpatentable under 35 U.S.C. § 103 as obvious over the combination of Sirmans (Ex. 1004) and Kobayashi (Ex. 1005). Pet. 14–17, 56–74. Patent Owner opposes Petitioner’s contentions. Prelim. Resp. 26–33. Based on our review of the record before us, we determine that Petitioner has established a reasonable likelihood that it would prevail in showing that claims 1–5, 7, 11, and 13 are unpatentable as obvious over the combination of Sirmans and Kobayashi, as discussed below. We turn first to overviews of Sirmans and Kobayashi.

1. Overview of Sirmans (Ex. 1004)

Sirmans relates to “a system and method for evaluating and monitoring member compliance with health-promoting measures and, depending on the level of member compliance, providing tangible and/or intangible incentive products.” Ex. 1004 ¶ 2. More specifically, Sirmans relates to “an individual performance processing system that monitors individual performance of health-promoting measures and, based on individual performance, issues appropriate incentives/rewards.” *Id.* ¶ 29; *see* Pet. 14–16; Prelim. Resp. 10.

In an exemplary embodiment, Sirmans describes its system and method as follows:

[A] member will pay a monthly fee to an organization to receive a personal body monitor and access to a website portal. Wearing the body monitor, the member will be asked to perform the Center for Disease Control recommended levels of exercise (i.e.,

moderate intensity for 30 minutes a day 5 days a week and/or vigorous intensity for 20 minutes a day 3 days a week). Members can then upload their compliance data from their monitors over the Internet to the organization (which includes a computer system and member profile database). In certain instances, data from the personal body monitoring system is automatically relayed to the organization. In certain embodiments, the transferred data regarding member performance can be displayed to the member on a website.

Ex. 1004 ¶ 84. Sirmans discloses that “a point system is assigned to performance data.” *Id.* ¶ 85. With that, an organization can calculate “how many points a member has earned for each day of exercise.” *Id.* Sirmans explains that, “if a member was 100% compliant for the day, the member would receive 100 points,” and “the more active a member is, the more points a member can in turn accumulate.” *Id.* According to Sirmans, “[t]here are also bonus points that can be assigned for various activities (such as bonus points for vigorous exercise; or *if a member is compliant in performing health-promoting measures for the week, points are doubled*).” *Id.* (emphasis added).

Sirmans’ Figure 2, reproduced below, depicts an exemplary set of steps for evaluating an incentive to be provided based on member performance of health-promoting measures. Ex. 1004 ¶ 28, Fig. 2.

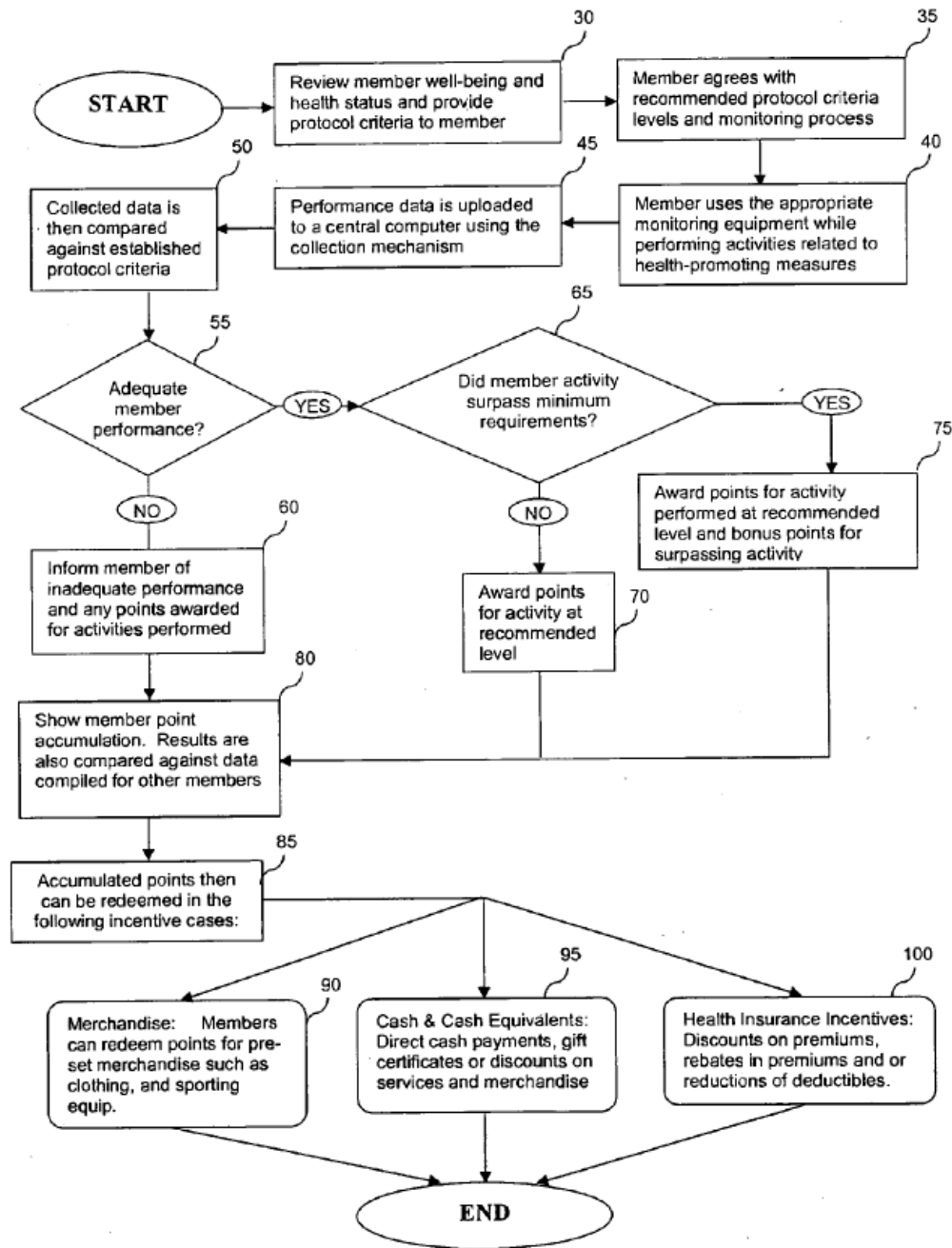


FIG. 2

Figure 2 depicts exemplary steps in evaluating member well-being and health-activity performance, awarding points, and awarding member incentives.

As shown in Figure 2 above, Sirmans describes, *inter alia*, a member using monitoring equipment while performing activities related to health-promoting measures (step 40); uploading performance data to a central computer using a collection mechanism (step 45); comparing collected data against established protocol criteria (step 50); determining whether adequate member performance exists (step 55), and if so, determining whether “member activity *surpass[es]* minimum requirements” (step 65); awarding points for certain activity (step 75); and awarding incentives (steps 85, 90, 95, 100). Ex. 1004 ¶¶ 66–75 (emphasis added).

We further discuss below the disclosure of Sirmans in connection with the parties’ arguments.

2. Overview of Kobayashi (Ex. 1005)

Kobayashi relates to a “health points bank system” that a user may use “to select and obtain predetermined products and services according to points accrued.” Ex. 1005 ¶ 1. The system measures biological information on a health device, such as exercise equipment, converts that information into points, and determines whether a predetermined number of points is reached. *Id.*

In particular, Kobayashi explains:

[A]dditional points may be given for *consecutive days of reaching the goal*: for example, 5 points on the 10th consecutive day or 10 points on the 20th consecutive day and penalties such as -3 points for a day off or -10 points for two consecutive days off. Another example may be adding 3 points when the total steps per day *surpasses* 10,000 steps.

Ex. 1005 ¶ 142, Fig. 12.

We further discuss below the disclosure of Kobayashi in connection with the parties' arguments.

3. *Analysis*

a. *Independent Claim 1*

Petitioner provides an element-by-element analysis of independent claim 1 in relation to the combined teachings of Sirmans and Kobayashi. Pet. 14–17, 56–74. Petitioner's analysis relies on testimony from its declarant, Dr. Fischer. Ex. 1006 ¶¶ 71–82, 95–103, 123–128. Patent Owner opposes. Prelim. Resp. 26–33.

(1) [1[pre]] A method, comprising:

Petitioner contends Sirmans meets the preamble by disclosing “methods for monitoring and promoting behavioral modification with regard to an individual's health.” Pet. 56–57 (quoting Ex. 1004, Abs.). Patent Owner does not contend otherwise at this stage of the proceeding. Nonetheless, the burden remains on Petitioner to demonstrate unpatentability. *See Dynamic Drinkware*, 800 F.3d at 1378. For the reasons stated in the Petition at pages 56–57, Petitioner sufficiently establishes that Sirmans teaches this limitation.⁵

(2) [1[a]] receiving athletic activity data from a device configured to be worn by a user;

Petitioner contends Sirmans teaches limitation 1[a] by describing, *inter alia*, “monitoring ‘health-promoting measures,’ such as various exercise regimens, which involves tracking ‘the intensity and duration of the exercise activity, as well as physiological conditions such as heart rate or

⁵ Neither party at this stage of the proceeding argues that the preamble of claim 1 is limiting. We likewise express no view herein.

blood pressure, caloric energy expended, or number of steps taken.” Pet. 57 (citing Ex. 1004 ¶¶ 31, 46). Petitioner contends Sirmans also describes that ““a monitoring device (such as a personal monitoring device or monitoring system at a health-promoting location) is provided that observes and records the individual’s (hereinafter also referred to as a “member”) efforts to perform health-promoting measures”; ““the data from the monitoring device is received via a data communication channel and automatically mapped and incorporated’ into a user’s profile stored in a database”; and “an ‘individual wears a member monitoring device which uniquely identifies the individual, then gathers and relays data on member compliance and performance with regard to the chosen health promoting regimens (i.e., exercise regimens).” Pet. 57–58 (citing Ex. 1004 ¶¶ 13, 20). Petitioner contends Sirmans also describes that “data from a personal monitoring device is ‘transmitted to [i.e., received by] a central computer of the invention.’” Pet. 58 (citing Ex. 1004 ¶ 36).

For the reasons stated in the Petition at pages 57–58, Petitioner sufficiently establishes that Sirmans teaches limitation 1[a]. Patent Owner does not contend otherwise at this stage of the proceeding.

(3) [1[b]] receiving an activity time period;

Petitioner contends Sirmans teaches limitation 1[b] by describing, *inter alia*, that a user “will be asked to perform the Center for Disease Control recommended levels of exercise (i.e., moderate intensity for 30 minutes *a day* 5 days a week and/or vigorous intensify [sic ‘intensity’] for 20 minutes *a day* 3 days a week).” Pet. 58–59 (quoting Ex. 1004 ¶ 84). Petitioner argues “Sirmans thus teaches a daily activity time period that is received by a computer system tracking a user’s performance.” Pet. 59

(citing Ex. 1006 ¶¶ 77–78 (Dr. Fischer testifying that “This regimen (including a time period and goal) is necessarily ‘received’ because they are used in the assessment of the user with respect to the goals.”)). Based on the present record, we find Petitioner’s argument persuasive.

Patent Owner argues Sirmans does not teach this limitation because “Sirmans’ *personal monitor* does not receive any activity time period.” Prelim. Resp. 27 (emphasis added). But Patent Owner does not direct us, and we do not find at this stage of the proceeding, any limitation in claim 1 that requires the “activity time period” to be received by the personal monitor. Indeed, claim 1 recites, in relevant part, “[a] method, comprising . . . receiving an activity time period,” and specifies nothing more about “what” *receives* that activity time period, although at some point “a processor” makes a “determin[ation]” using that activity time period. *See* Ex. 1001, 80:25–37. Thus, we find Patent Owner’s argument unavailing.

Patent Owner argues that Petitioner’s above-cited disclosure in Sirmans (Ex. 1004 ¶ 84) “*differs* from the ’615 patent that is directed to customizable goal setting in which the system receives an activity goal and an activity time period over which a user’s activity is measured.” Prelim. Resp. 28 (emphasis added). But Patent Owner does not explain “why” or “how” it *differs*, and cites no support for this conclusory statement. Patent Owner also does not dispute, at least at this stage of the proceeding, Petitioner’s expert’s testimony that Sirmans’ “regimen (*including a time period and goal*) is *necessarily* ‘received’ because they are used in the assessment of the user with respect to the goals.” Ex. 1006 ¶ 78; *see* Prelim. Resp. 27–29. Moreover, even if Sirmans *differed* from the ’615 patent, Petitioner’s challenge here is based on the teachings and suggestions of

Sirmans (i.e., obviousness), and at this stage of the proceeding, Patent Owner does not meaningfully address why Sirmans does not teach or at least fairly suggest *to the skilled artisan* the limitation at issue. Thus, we find Patent Owner’s argument unavailing.

Based on the foregoing reasons, and for the reasons stated in the Petition at pages 58–59, Petitioner sufficiently establishes that Sirmans teaches limitation 1[b].

(4) [1[c]] receiving a first activity goal for the activity time period;

Petitioner contends Sirmans teaches limitation 1[c] by describing, *inter alia*, that a user “can agree to both the recommended/minimal level of exercise to be performed as well as appropriate use of the monitoring equipment” (Pet. 59 (quoting Ex. 1004 ¶ 68)), where “[t]he activity goal that is received by a computer system is a baseline against which a user’s athletic performance is measured” (Pet. 59 (citing Ex. 1006 ¶¶ 77–78)). As discussed above for limitation 1[b], Sirmans describes that, “wearing the body monitor, the member will be asked to perform the Center for Disease Control recommended levels of exercise (i.e., moderate intensity for 30 minutes a day 5 days a week and/or vigorous intensity for 20 minutes a day 3 days a week).” Ex. 1004 ¶ 84. Petitioner argues this “recommended level[] of exercise” (e.g., 30 minutes a day for five days per week) constitutes a first activity goal.

For the reasons stated in the Petition at pages 59–60, Petitioner sufficiently establishes that Sirmans teaches limitation 1[c]. Patent Owner does not contend otherwise at this stage of the proceeding, except as discussed above concerning limitation 1[b] (activity time period).

(5) [1[d]] determining, at a processor, whether the received athletic activity data exceeds the first activity goal for a predetermined number of consecutive activity time periods; and

Petitioner contends Sirmans teaches limitation 1[d] by describing, *inter alia*, that “a central computer ‘records and processes data provided by the monitoring device and/or exercise machine worn by the user,’” and “contains a database that ‘profiles, tracks, and stratifies the recorded data into a performance model based on previously established protocol criteria regarding health-related measures.’” Pet. 60 (citing Ex. 1004 ¶ 36). Petitioner, relying in part on Sirmans’ Figure 2 (reproduced above), contends that “[c]ollected data is then compared against established protocol criteria” (step 50), and next is “specifically assessed to identify whether the established recommended/minimum level of performance was accomplished” (step 65). Pet. 60–61 (citing Ex. 1004 ¶ 71, Fig. 2). We note step 65 of Figure 2 queries, “Did member activity *surpass* minimum requirements?” Ex. 1004, Fig. 2 (step 65 (emphasis added)) (cited at Pet. 60–61 (drawing red box around step 65)); *see* Pet. 61–62 (quoting Ex. 1004 ¶ 72 (“[S]hould the member’s performance meet the established recommended/minimum level of performance, a further assessment on whether member’s performance exceeds minimum requirements is then performed 65.”)). Petitioner argues this step 65 “requires comparing whether the user exceeded an activity goal (*e.g.*, moderate intensity exercise for 30 minutes) for predetermined consecutive activity periods (*e.g.*, daily workouts occurring 5 days per week[.]”). Pet. 61–62 (citing Ex. 1006 ¶¶ 79–81).

Petitioner alternatively contends the combination of Sirmans and Kobayashi teaches limitation 1[d]. Pet. 62–63. In particular, Petitioner contends “Kobayashi teaches recognizing and rewarding ‘consecutive days of reaching the goal.’” Pet. 62 (citing Ex. 1005 ¶ 142). Petitioner, relying in part on Kobayashi’s Figure 12 (reproduced below), contends “Kobayashi determines when a user has completed an activity goal for 10 or 20 consecutive days.” Pet. 62 (citing Ex. 1005, Fig. 12); *see* Ex. 1005 ¶ 142.

[Figure 12]

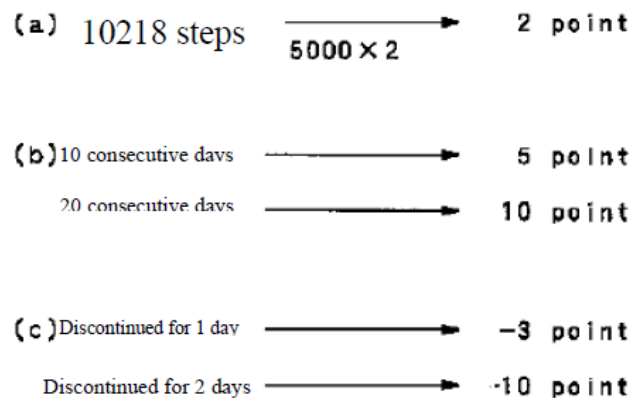


Figure 12 depicts operations involved in step-point conversion processing, particularly for reaching goals over consecutive days.

Ex. 1005 ¶ 142, Fig. 12. Petitioner argues the skilled artisan would have had “a strong motivation” to combine the teachings of Sirmans and Kobayashi, which are “in the same field of personal fitness monitoring,” because doing so would have “further incentivize[d] regular exercise,” and that the skilled artisan would have done so “with a high likelihood of success.” Pet. 62–63 (citing Ex. 1006 ¶¶ 124–128). Petitioner argues “it would [have been] a simple modification to include Kobayashi’s recognition of consecutive

activity time periods into Sirmans’ protocol criteria,” and “[i]n view of the combined teachings of Sirmans and Kobayashi, it would [have been] easy to implement determining whether the received athletic activity data exceeds the first activity goal for a predetermined number of consecutive activity time periods.” Pet. 62–63 (citing Ex. 1006 ¶¶ 124–128). Based on the present record, we find Petitioner’s arguments persuasive.

Patent Owner argues “[Petitioner] has not shown that Kobayashi discloses a determination of whether received activity data exceeds an activity goal.” Prelim. Resp. 30 (referring also to Prelim. Resp. Section V.B.2.). But as we understand Petitioner’s argument, Petitioner contends *Sirmans teaches* determining whether received athletic activity data exceeds a first activity goal for a predetermined number of activity time periods, and turns to *Kobayashi* for teaching recognizing and rewarding users for achieving goals for *consecutive* activity time periods. See Pet. 60–63. Patent Owner does not appear to address Petitioner’s actual obviousness challenge concerning limitation 1[d]. The test for obviousness is not whether the claimed invention is expressly suggested in any one or all of the references, as argued by Patent Owner, but whether the claimed subject matter would have been obvious to those of ordinary skill in the art *in light of the combined teachings of those references*. See *In re Keller*, 642 F.2d 413, 425 (CCPA 1981); *In re Burckel*, 592 F.2d 1175, 1179 (CCPA 1979) (“[A] reference must be considered not only for what it expressly teaches, but also for what it fairly suggests.”). Thus, we find Patent Owner’s argument unavailing.

Patent Owner argues, “[a]ssuming *arguendo*, that Sirmans’ activity time period is one day, Sirmans does not track whether users exercise on

consecutive days,” and to the contrary, “Sirmans *suggests* that the user follow CDC exercise guidelines, which recommend working out 3 or 5 days per week, which *may* or may not *be on consecutive days*.” Prelim. Resp. 30 (emphases added). We find Patent Owner’s recognition here that the skilled artisan would have understood Sirmans to teach or at least fairly suggest that the “5 days” “may” be “consecutive” favors Petitioner more so than Patent Owner. Indeed, in tracking data at “5 days” per week, at least two such days would necessarily have to be consecutive, given only 7 days in a week. Patent Owner also attacks Sirmans individually concerning this “consecutive” feature (Prelim. Resp. 29–30), even though Petitioner alternatively relies on Kobayashi to teach this feature and on *the combination of* Sirmans and Kobayashi to teach limitation 1[d]. Thus, we find Patent Owner’s argument unavailing. *See In re Keller*, 642 F.2d at 425.

Patent Owner argues Petitioner’s challenge based on the combination of Sirmans and Kobayashi is “rife with hindsight reasoning.” Prelim. Resp. 31–33. “Any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning, but so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made and does not include knowledge gleaned only from applicant’s disclosure, such a reconstruction is proper.” *In re McLaughlin*, 443 F.2d 1392, 1313–14 (CCPA 1971). Here, Patent Owner does not direct us to any knowledge *gleaned only from applicant’s disclosure* that Petitioner allegedly relies upon to support its obviousness rationale. *See* Prelim. Resp. 31–33.

Instead, Patent Owner argues the combination of Sirmans and Kobayashi is “redundant.” Prelim. Resp. 31–32 (“[Petitioner] combines Sirmans’ protocol criteria with Kobayashi’s rewards system but Sirmans already discloses whether the user has met predetermined goals, i.e., by issuing appropriate incentives/rewards for compliance with health-promoting measures.”). Patent Owner’s argument appears to be premised on a misunderstanding of Petitioner’s challenge here. As we noted above, and as we understand Petitioner’s challenge, Petitioner contends *Sirmans teaches* determining whether received athletic activity data exceeds a first activity goal for a predetermined number of activity time periods, and turns to *Kobayashi* for teaching recognizing and rewarding users for achieving goals for *consecutive* activity time periods. *See* Pet. 60–63. We do not presently see any “redundancy” in turning to Kobayashi for the “consecutive” feature, particularly where Patent Owner itself argues Sirmans does not teach such a feature.

Patent Owner also argues the teachings of Sirmans and Kobayashi are “incompatible,” and thus, according to Patent Owner, there can be no “reasonable expectation of success.” Prelim. Resp. 32–33. Patent Owner notes that Kobayashi teaches “rewarding additional points when the user performs an activity for 10 or 20 consecutive days,” and that Sirmans teaches use of “CDC guidelines that recommend 3 to 5 workouts per week based on varying levels of intensity,” which according to Patent Owner “encourages and rewards a non-consecutive day workout regimen.” *Id.* Patent Owner then argues “incompatibility” apparently because if users were to exercise for 10 or 20 consecutive days (Kobayashi) then they could not also exercise for only 3 or 5 days per week (Sirmans). *Id.*

In proving obviousness here, it is not necessary to show that the skilled artisan somehow would have incorporated Kobayashi's entire method and structure within Sirmans' methods and structure. "The test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference. . . . Rather, the test is what the combined teachings of those references would have suggested to those of ordinary skill in the art." *Keller*, 642 F.2d at 425; *see In re Mouttet*, 686 F.3d 1322, 1332 (Fed. Cir. 2012) ("It is well-established that a determination of obviousness based on teachings from multiple references does not require an actual, physical substitution of elements."); *In re Sneed*, 710 F.2d 1544, 1550 (Fed. Cir. 1983) ("[I]t is not necessary that the inventions of the references be physically combinable to render obvious the invention under review."). Patent Owner does not explain why, in a method combining *the teachings* of Sirmans and Kobayashi as proposed by Petitioner (*see* Pet. 56–74), Kobayashi's teaching of recognizing and rewarding users for achieving goals for *consecutive* activity time periods would not have been implemented by the skilled artisan in Sirmans' method of rewards for a predetermined number of activity time periods (e.g., 3 *consecutive* days instead of any 3 days) to "further incentivize regular exercise," as proffered by Petitioner (Pet. 62–63).

Based on the foregoing reasons, and for the reasons stated in the Petition at pages 60–63, Petitioner sufficiently establishes that the combination of Sirmans and Kobayashi teaches limitation 1[d].

(6) [1[e]] *presenting a streak reward to the user when the received athletic activity data exceeds the first activity goal for the predetermined number of consecutive activity time periods.*

Petitioner contends Sirmans teaches limitation 1[e] by describing, *inter alia*, (1) “should the member’s performance *exceed* minimum requirements, the points established in the protocol criteria as well as bonus points are awarded to the member” (Pet. 63–64 (quoting Ex. 1004 ¶ 72) (emphasis added)); and (2) “bonus points” “can be assigned for various activities (such as bonus points for vigorous exercise; or if a member is compliant in performing health promoting measures *for the week*, points are doubled)” (Pet. 64 (quoting Ex. 1004 ¶ 85) (emphasis added)). Petitioner submits that “for the week” here refers at least to Sirmans’ description of exercising “at moderate intensity for 30 minutes a day 5 days a week.” Pet. 64. As we noted above, in exercising 5 days in a week, at least two such days would necessarily be consecutive, given only 7 days in a week. Petitioner argues “[t]his is consistent with the ’615 patent, which explains that a streak begins with completing an activity goal for at least two consecutive workouts.” Pet. 64. Petitioner concludes, “[u]ltimately, a computer system presents respective incentives to the user based on the number of accumulated points, including a reward associated with a streak according to the ’615 patent.” Pet. 64 (citing Ex. 1004 ¶ 17).

Petitioner alternatively contends the combination of Sirmans and Kobayashi teaches limitation 1[e]. Pet. 65. In particular, Petitioner contends Kobayashi teaches that “if continuity is considered important” “additional points may be given for consecutive days of reaching the goal: for example, 5 points on the 10th consecutive day or 10 points on the 20th consecutive

day.” Pet. 65 (quoting Ex. 1005 ¶¶ 141–142). Petitioner argues that, “[i]n view of Kobayashi’s teachings, Sirmans’ reward structure could readily be configured to provide a reward for meeting an activity goal over a predetermined consecutive set of daily activity periods (i.e., a streak reward)”; “it would be simple to add Kobayashi’s exemplary bonus points for completing an activity goal over consecutive activity time period into Sirmans’ predetermined protocol criteria”; and “[t]his would yield a predictable result of *providing an additional incentive to maintain a daily exercise regimen and rewarding a user for doing so.*” Pet. 65 (citing Ex. 1006 ¶¶ 124–128).

Based on the foregoing reasons, and for the reasons stated in the Petition at pages 63–65, Petitioner sufficiently establishes that the combination of Sirmans and Kobayashi teaches limitation 1[e]. Patent Owner does not contend otherwise at this stage of the proceeding, except as discussed above concerning limitations 1[b] (activity time period) and 1[d] (*consecutive* activity time periods).

b. Independent Claim 11 and Dependent Claims 2–5, 7, and 13

Petitioner contends independent claim 11, which recites substantially the same limitations as independent claim 1 but in the context of a computer readable medium, and dependent claims 2–5, 7, and 13, are unpatentable as obvious over the combination of Sirmans and Kobayashi. Pet. 65–74. The Petition provides a detailed assessment of these claims, with references to the Petition’s analysis of claim 1 and teachings in Sirmans and Kobayashi. *Id.* At this stage of the proceeding, Patent Owner does not present any separate arguments that are distinct to any of these claims. Rather, Patent

Owner generally states the view that the alleged deficiencies in the Petition with respect to claim 1 also are applicable to claims 2–5, 7, 11, and 13. *See* Prelim. Resp. 15 n.5 (“Claim 11 is substantially identical to claim 1.”), 29–30, 33. As discussed above, we are persuaded that the cited evidence sufficiently supports Petitioner’s contention that independent claim 1 is unpatentable as obvious over the combination of Sirmans and Kobayashi. For the reasons set forth in the Petition (Pet. 65–74), we also are persuaded that the current record sufficiently supports Petitioner’s challenges to claims 2–5, 7, 11, and 13 for purposes of institution.

4. Conclusion

At this stage of the proceeding and based on the record before us, we are persuaded that Petitioner’s cited evidence provides sufficient rational reasons for purposes of institution to combine the teachings of Sirmans and Kobayashi with a reasonable expectation of success, and sufficiently supports Petitioner’s contentions that claims 1–5, 7, 11, and 13 are unpatentable as obvious over the combination of Sirmans and Kobayashi. Accordingly, we determine that Petitioner has established a reasonable likelihood that it would prevail in showing that claims 1–5, 7, 11, and 13 are unpatentable as obvious over the combination of Sirmans and Kobayashi.

E. Alleged Anticipation of Claims 1–5, 7, 11, and 13 by Hoffman

Petitioner contends claims 1–5, 7, 11, and 13 are unpatentable under 35 U.S.C. § 102 as anticipated by Hoffman (Ex. 1002). Pet. 9–12, 21–42. Patent Owner opposes Petitioner’s contentions. Prelim. Resp. 15–21. Because we determine that Petitioner demonstrates a reasonable likelihood of success in establishing the unpatentability of claims 1–5, 7, 11, and 13 as

obvious over the combination of Sirmans and Kobayashi such that we institute this proceeding (*see supra* Section III.D), and because we must therefore institute *inter partes* review on all claims and all challenges in the Petition (*see* 37 C.F.R. § 42.108(a)), for purposes of institution, we need not and do not herein address in detail Petitioner's assertions of anticipation of claims 1–5, 7, 11, and 13 by Hoffman. However, we do provide below certain guidance on this challenge to assist the parties in the upcoming trial.

As with the combination of Sirmans and Kobayashi discussed above in Section III.D, the parties similarly dispute whether Hoffman discloses limitation 1[d] of independent claim 1, and more particularly, the feature in this limitation of determining whether the received athletic activity data exceeds a first activity goal for a predetermined number of “consecutive” activity time periods. The entirety of Petitioner's argument concerning the “consecutive” requirement in limitation 1[d] consists of two sentences:

Hoffman discloses that its computing unit recognizes when a user has completed “3 goals in 3 consecutive days.” ([Ex. 1002] at [0198].) In this example, completing three goals exceeds a first activity goal, and three consecutive days constitute the predetermined number of consecutive active time periods.

Pet. 28 (citing Ex. 1002 ¶ 198).

Patent Owner notes that Hoffman's paragraph 198 cited by Petitioner states: “[A] badge may be awarded for a user completing 3 goals in 3 consecutive days, completing 2 goals in a single day, being the first to complete a particular goal and the like.” Prelim. Resp. 18 (quoting Ex. 1002 ¶ 198) (emphasis added). Patent Owner argues:

That disclosure does not describe determining whether a user “exceeds the activity goal for a predetermined number of consecutive time periods.” *The disclosure simply describes a*

user completing three goals over a single period of time: three consecutive days. [Ex. 1002 ¶ 198.] A user could accomplish that feat by completing zero goals on the first day, zero goals on the second day, and then three goals on the third day. [Petitioner] has not shown that paragraph 198—or any other aspect of Hoffman—discloses determining whether a user “exceeds the activity goal for a predetermined number of consecutive time periods.”

Prelim. Resp. 18. *In the context of anticipation*, we currently find Patent Owner’s argument persuasive on the record before us.

In particular, Petitioner cites merely a few words from Hoffman (i.e., “3 goals in 3 consecutive days”) that on their face do not appear to explicitly or inherently disclose the features of the subject limitation, and we discern no explanation as to how or why the cited disclosure in Hoffman allegedly discloses such limitation (or whether Petitioner is relying on a particular claim construction to give effect to its argument). Likewise, Petitioner does not cite to any expert testimony or other evidence showing how or why the cited statements in Hoffman allegedly disclose such limitation. Indeed, Petitioner appears to place the onus on Patent Owner—and the Board—to ascertain how or why the cited statements (i.e., paragraph 198) allegedly discloses limitation 1[d].

The burden of proof here lies with Petitioner, not Patent Owner, and we do not ourselves create and adopt unpatentability arguments on behalf of Petitioner as to whether or how Hoffman might disclose the subject limitation. *See Wasica Fin. GmbH v. Cont’l Auto. Sys., Inc.*, 853 F.3d 1272, 1286 (Fed. Cir. 2017) (“It is of the utmost importance that petitioners in the IPR proceedings adhere to the requirement that the initial petition identify with particularity the evidence that supports the grounds for the challenge to

each claim.” (quoting *Intelligent Bio-Sys., Inc. v. Illumina Cambridge Ltd.*, 821 F.3d 1359, 1369 (Fed. Cir. 2016)); *In re Magnum Oil Tools Int’l, Ltd.*, 829 F.3d 1364, 1381 (Fed. Cir. 2016) (“[W]e find no support for the PTO’s position that the Board is free to adopt arguments on behalf of petitioners that could have been, but were not, raised by the petitioner during an IPR.”); *DeSilva v. DiLeonardi*, 181 F.3d 865, 866–67 (7th Cir. 1999) (“A brief must make all arguments accessible to the judges, rather than ask them to play archeologist with the record.”).

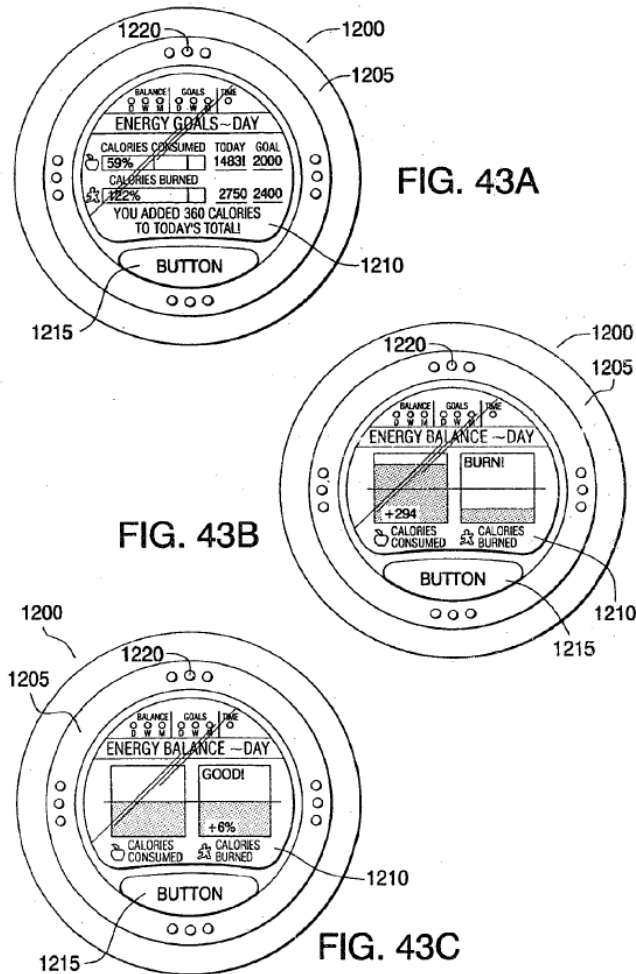
At this stage of the proceeding and constrained by the record before us, we preliminarily find that Petitioner has not established a reasonable likelihood that it would prevail in showing that claims 1–5, 7, 11, and 13 are anticipated by Hoffman.

F. Alleged Obviousness of Claims 1–5, 7, 11, and 13 over the Combination of Stivorice and Kobayashi

Petitioner contends claims 1–5, 7, 11, and 13 are unpatentable under 35 U.S.C. § 103 as obvious over the combination of Stivorice (Ex. 1003) and Kobayashi (Ex. 1005). Pet. 12–14, 17, 43–56. Patent Owner opposes Petitioner’s contentions. Prelim. Resp. 21–26. Because we determine that Petitioner demonstrates a reasonable likelihood of success in establishing the unpatentability of claims 1–5, 7, 11, and 13 as obvious over the combination of Sirmans and Kobayashi such that we institute this proceeding (*see supra* Section III.D), and because we must therefore institute *inter partes* review on all claims and all challenges in the Petition (*see* 37 C.F.R. § 42.108(a)), for purposes of institution, we need not and do not herein address in detail Petitioner’s assertions of obviousness of claims 1–5, 7, 11, and 13 over the

combination of Stivoric and Kobayashi. However, we do provide below certain guidance on this challenge to assist the parties in the upcoming trial.

The parties dispute, *inter alia*, whether Stivoric teaches limitation 1[b] of independent claim 1, namely, “receiving an activity time period.” Petitioner contends Stivoric teaches limitation 1[b] by describing, *inter alia*, an “I/O device” that “receive[s] activity time periods, such as ‘a day, a week or a month.’” Pet. 44 (citing Ex. 1003 ¶¶ 180, 185–187, 197). Petitioner contends these time periods “are received from a user via a selection made ‘by rotating dial 1220’ or ‘pressing button 1215,’” as shown, for example, in Figures 43A–C, reproduced below. Pet. 44 (citing Ex. 1003 ¶ 197, Fig. 43A–C).



Figures 43A–C depict a data input and output device.

Ex. 1003 ¶ 56.

Patent Owner responds, “[a]lthough the user in Stivorice may use a ‘rotating dial’ or ‘pressing’ button to view past progress towards a ‘goal’ over a pre-determined set of time periods—all of the time periods taught or suggested in Stivorice are pre-programmed in the system,” and “Stivorice never teaches or suggests a ‘received’ activity time period.” Prelim.

Resp. 22–23 (citing Ex. 1003 ¶¶ 197–198). Patent Owner argues:

[T]he Stivorice system never “receiv[es]” an activity time period, as recited in limitation 1B. Instead, all of the available time periods are pre-programmed in the system (i.e., a day, a week,

and month). For example, [Petitioner] cites to Stivoric's Figures 43A–C. Petition at 45. But Stivoric describes Figures 43A–C as allowing a user to “toggle” between “the various time periods within each [goal], by rotating dial 1220.” Ex. 1003 at [0197]. Therefore, a user of Stivoric's system is only able to *retroactively* view their caloric expenditure achievement for either the day, the week, or the month. *Id.* *A user is not able to, in a forward-looking manner, enter an activity time period for a particular goal. All time periods in the Stivoric system are preset and displayed regardless of the device receiving an activity time period, which is required by the claim.*

Prelim. Resp. 23 (second emphasis added). Patent Owner argues “nothing in Stivoric (or elsewhere) supports [Petitioner's] proposed link between the workout history data and received, forward-looking goals,” because “this data is only available for the user to review past performance.” *Id.* at 23–24 (citing Ex. 1003 ¶ 197).

We understand Patent Owner to argue, essentially, that Petitioner establishes that Stivoric teaches three predetermined options for presenting past workout data to a user, namely, over a day, a week, or a month period, but does not teach or suggest “receiving” from a user “an activity time period” for use in actively (i.e., in a forward-looking manner) measuring whether (and thus at what point) received activity data exceeds a first activity goal for that received activity time period, and ultimately, for a predetermined number of consecutive activity time periods. We note that claim 1 does not explicitly recite “what” *receives* the activity time period, although at some point “a processor” makes a “determin[ation]” using the activity time period, or “when” the activity time period is received or used relative to the received activity data and activity goal. *See* Ex. 1001, 80:25–37. Neither party provides an express construction of any limitation

in claim 1 that would include or exclude receiving and applying “activity time periods” after athletic activity data were already received and databased. Considering both parties’ arguments and evidence at this stage of the proceeding, and given the burden of proof here lies with Petitioner, not Patent Owner, we currently find Petitioner does not explain sufficiently how its cited disclosure in Stivoric satisfies limitation 1[b], both in the context of claim 1 *as a whole* and in view of Patent Owner’s counter arguments discussed above.

At this stage of the proceeding and constrained by the record before us, we preliminarily find that Petitioner has not established a reasonable likelihood that it would prevail in showing that claims 1–5, 7, 11, and 13 would have been obvious over the combination of Stivoric and Kobayashi.

G. Alleged Obviousness of Claims 3–5 over the Combinations of (1) Stivoric, Kobayashi, and Brady and (2) Sirmans, Kobayashi, and Brady

Petitioner contends dependent claims 3–5 are unpatentable under 35 U.S.C. § 103 as obvious over the combinations of (1) Stivoric (Ex. 1003), Kobayashi (Ex. 1005), and Brady (Ex. 1021), and (2) Sirmans (Ex. 1004), Kobayashi, and Brady. Pet. 74–78. At this stage of the proceeding, Patent Owner does not present any separate arguments that are distinct to these challenges and claims. Prelim. Resp. 33–34. Because we determine that Petitioner demonstrates a reasonable likelihood of success in establishing the unpatentability of claims 1–5, 7, 11, and 13 as obvious over the combination of Sirmans and Kobayashi such that we institute this proceeding (*see supra* Section III.D), and because we must therefore institute *inter partes* review on all claims and all challenges in the Petition (*see* 37 C.F.R. § 42.108(a)),

for purposes of institution, we need not and do not herein address in detail Petitioner's additional assertions of obviousness of claims 3–5 over these noted combinations. We do note that Petitioner does not appear to apply Brady in any manner that would cure any deficiencies in Petitioner's challenges preliminary identified herein in Sections III.E and III.F above.

IV. CONCLUSION

Based on the evidence before us, we determine that Petitioner has established a reasonable likelihood that at least one claim of the '615 patent is unpatentable. Accordingly, we institute trial on all the challenges in the Petition.

At this stage of the proceeding, the Board has not made a final determination on the construction of any claim term or the patentability of any challenged claim.

V. ORDER

Upon consideration of the record before us, it is

ORDERED that, pursuant to 35 U.S.C. § 314(a), an *inter partes* review of claims 1–5, 7, 11, and 13 of the '615 patent is instituted with respect to all grounds set forth in the Petition; and

FURTHER ORDERED that, pursuant to 35 U.S.C. § 314(c) and 37 C.F.R. § 42.4(b), *inter partes* review of the '615 patent shall commence on the entry date of this Order, and notice is hereby given of the institution of a trial.

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