

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*.

JUDGMENT
Final Written Decision
Determining All Challenged Claims Unpatentable
35 U.S.C. § 318(a)

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”). Nike, Inc. (“Patent Owner”) timely filed a Preliminary Response to the Petition. Paper 10 (“Prelim. Resp.”); *see* Paper 8, 2. We instituted an *inter partes* review of claims 1–5, 7, 11, and 13 of the ’615 patent on all grounds of unpatentability alleged in the Petition. Paper 11 (“Institution Decision” or “Dec.”).

After institution, Patent Owner filed a Response. Paper 17 (“PO Resp.”). Petitioner filed a Reply. Paper 22 (“Pet. Reply”). Patent Owner filed a Sur-reply. Paper 24 (“PO Sur-reply”). We held an oral hearing in this case on April 4, 2024, and a transcript of the hearing is included in the record. Paper 34 (“Tr.”).

We have jurisdiction under 35 U.S.C. § 6 (2018). Under the applicable evidentiary standard, Petitioner has the burden to prove unpatentability by a preponderance of the evidence. *See* 35 U.S.C. § 316(e); 37 C.F.R. § 42.1(d) (2022). “Preponderance of the evidence means 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); Paper 10, 1 (“[T]here is no other indication in the Petition that claims 6, 8, or 12 are being challenged.”). We regard the inclusion of claims 6, 8, and 12 in the statements noted above on pages 2 and 19 of the Petition to be inadvertent. Thus, we need not and do not address herein claims 6, 8, and 12.

greater weight of evidence, evidence which is more convincing than the evidence which is offered in opposition to it.” *United States v. C.H. Robinson Co.*, 760 F.3d 1376, 1383 (Fed. Cir. 2014) (internal quotations omitted). This Final Written Decision is issued pursuant to 35 U.S.C. § 318(a) and 37 C.F.R. § 42.73.

For the reasons discussed below, we determine Petitioner has established by a preponderance of the evidence that claims 1–5, 7, 11, and 13 of the ’615 patent are unpatentable.

II. BACKGROUND

A. Related Matters

The parties indicate 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; Paper 8, 2.

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 (Paper 37, Final Written Decision, entered May 13, 2024, determining that claims 1–4, 7, 8, and 11–16 (but not claims 5, 6, 9, 10, and 17–20) of the ’256 patent are unpatentable)); 10,188,930 (IPR2023-00348); 10,232,220 (IPR2023-00180 (Paper 36, Final Written Decision, entered May 13, 2024, determining that all challenged claims (i.e., claims 11–14, 19, and 20) of the ’220 patent are unpatentable)); 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.



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, published August 11, 2011	1002
Stivoric	US 2004/0152957 A1, published August 5, 2004	1003
Sirmans	US 2006/0111944 A1, published May 25, 2006	1004

Kobayashi	JP 2003-141260 ² , published May 16, 2003	1005
Brady	US 7,431,696 B1, issued October 7, 2008	1021

Pet. 20.

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

Patent Owner relies upon the Declaration of Dr. Robert Stone (Ex. 2002).

E. Asserted Challenges to Patentability

We instituted *inter partes* review of claims 1–5, 7, 11, and 13 of the '615 patent on the following grounds asserted by Petitioner. Dec. 3, 37; Pet. 20.

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

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.

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

III. PATENTABILITY

A. Applicable Law

Petitioner challenges the patentability of claims 1–5, 7, 11, and 13 of the '615 patent on grounds that various 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, Stivoric, 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 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).

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*

March 16, 2013. Neither party argues that the outcome of this case would differ based on applying the pre-AIA or post-AIA versions of these laws.

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). Secondary considerations 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)).

The Supreme Court has made clear that we apply “an expansive and flexible approach” to the question of obviousness. *Id.* at 415. Whether a patent claiming a combination of prior art elements would have been

⁴ Patent Owner does not present objective evidence of non-obviousness.

obvious is determined by whether the improvement is more than the predictable use of prior art elements according to their established functions. *Id.* at 417. To reach this conclusion, however, requires more than a mere showing that the prior art includes separate references covering each separate limitation in a claim under examination. *Unigene Lab'ys, Inc. v. Apotex, Inc.*, 655 F.3d 1352, 1360 (Fed. Cir. 2011). Rather, obviousness requires the additional showing that a person of ordinary skill at the time of the invention would have selected and combined those prior art elements in the normal course of research and development to yield the claimed invention. *Id.* “To satisfy its burden of proving obviousness, a petitioner cannot employ mere conclusory statements. The petitioner must instead articulate specific reasoning, based on evidence of record, to support the legal conclusion of obviousness.” *In re Magnum Oil Tools Int’l, Ltd.*, 829 F.3d 1364, 1380 (Fed. Cir. 2016).

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 dispute [Petitioner’s] proposed level of skill in the art” in this case. PO Resp. 11.

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 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 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); *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; see *CCS Fitness, Inc. v. Brunswick Corp.*, 288 F.3d 1359, 1366 (Fed. Cir. 2002) (explaining that 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))).

The parties dispute the meaning of limitation 1[b], “receiving an activity time period.” PO Resp. 11–13; Pet. Reply 2–6; PO Sur-reply 2–8. The parties otherwise do not contend that claim construction is necessary to resolve the controversy in this case. See PO Resp. 11 (“[Patent Owner] contends that all terms and phrases in the ’615 patent, including limitations 1[B]/11[B], should be given their ordinary and customary meaning.”); Pet. 18. To the extent necessary to resolve the controversy before us, we address claim interpretation in our patentability analysis below.

D. 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 would have been 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; Pet. Reply 2–11. Patent Owner opposes Petitioner’s contentions. PO Resp. 11–13, 30–33; PO Sur-reply 2–8, 20–23. For the reasons expressed below, and based on the complete record before us, we determine that Petitioner has demonstrated by a preponderance of the evidence that claims 1–5, 7, 11, and 13 would have been unpatentable as obvious over the combination of Sirmans and Kobayashi. 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.

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.

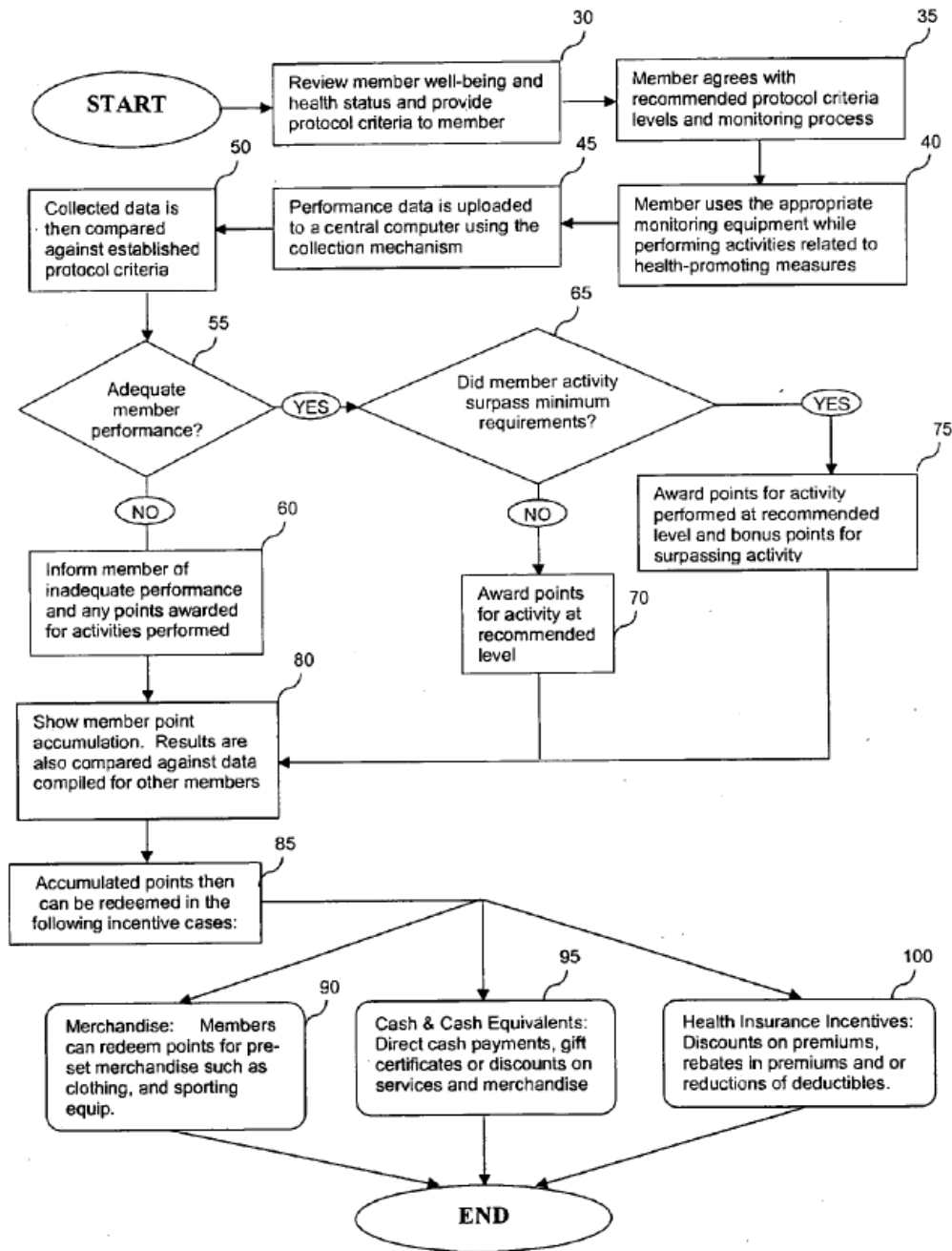


FIG. 2

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 by redeeming points (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, 56–65; Pet. Reply 2–11. Patent Owner opposes. PO Resp. 11–13, 30; PO Sur-reply 2–8, 20–22. As discussed below, Petitioner contends each limitation in claim 1 would have been taught or fairly suggested by this combination.

(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, code (57)).

Neither Petitioner nor Patent Owner takes a position as to whether the preamble is limiting, nor does Patent Owner dispute that Sirmans discloses such a “method,” generally. *See* Pet. 56–57; *see generally* PO Resp.; PO Sur-reply. Because we find that Petitioner’s cited disclosures from Sirmans and Kobayashi teach or fairly suggest a “method” with limitations 1[a] through 1[e] (*see infra*), we need not determine whether the preamble is limiting. *See Nidec*, 868 F.3d at 1017.

(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 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).

Based on the foregoing evidence and the reasons stated in the Petition at pages 57–58, we find Petitioner sufficiently establishes that Sirmans teaches or fairly suggests limitation 1[a]. Patent Owner does not contest that this limitation is present in Sirmans. *See generally* PO Resp.

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

In our Institution Decision, we noted that “[n]either party provides an express construction of any limitation in claim 1,” including concerning “receiving an activity time period.” Dec. 35–36; *see id.* at 19. Subsequently, the parties submitted competing constructions for limitation 1[b]. We turn below first to construing this limitation 1[b] and

then to whether the combination of Sirmans and Kobayashi would have taught or fairly suggested the limitation.

(a) *Claim Construction: “receiving an activity time period”*

Patent Owner proposes that limitation 1[b], “receiving an activity time period,” “should be given [its] ordinary and customary meaning,” which according to Patent Owner, is “receiving an activity time period *from a user during a goal setting operation.*” PO Resp. 11–12 (emphasis added); *see id.* at 11–13; PO Sur-reply 2–8. Petitioner proposes that limitation 1[b] also should be given its ordinary and customary meaning, but contends the meaning is simply what it recites, “receiving an activity time period,” which does not require the “activity time period” to be received “from a user during a goal setting operation.” Pet. Reply 2–6; Pet. 18. We agree with Petitioner, and determine that limitation 1[b] *does not require* the “activity time period” to be received “from a user during a goal setting operation,” as discussed below.

Claims: We turn first to the claim language itself. We are mindful of Judge Rich’s guidance from over thirty years ago: in all aspects of claim construction, “the name of the game is the claim.” *In re Hiniker Co.*, 150 F.3d 1362, 1369 (Fed. Cir. 1998) (quoting Giles Sutherland Rich, *Extent of Protection and Interpretation of Claims—American Perspectives*, 21 Int’l Rev. Indus. Prop. & Copyright L. 497, 499 (1990)).

Claim 1 recites “receiving an activity time period,” without more, as part of a method claim. Ex. 1001, 80:28. The simple claim language itself strongly suggests that the “activity time period” may be “receiv[ed]” without concern as to source (e.g., from a user, third-party, database, etc.).

Similarly, claim 1 specifies nothing 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. In contrast, certain other method steps *in claim 1* do explicitly implicate the “user”:

(1) limitation 1[a], “receiving athletic activity data from a device configured to be worn by a user,” recites that the data comes “from” the device configured to be worn “by a user” (*id.* at 80:26–27); and (2) limitation 1[e], “presenting a streak reward to the user . . . ,” recites that the reward is presented “to the user” (*id.* at 80:34). Contrary to Patent Owner’s position,⁵ and as argued by Petitioner,⁶ we find the detailing of “user” in limitations 1[a] and 1[e] but not 1[b], although not dispositive, *supports* our interpretation of limitation 1[b]—the inventor chose to implicate the user in certain steps (such as 1[a] and 1[e]), but not others (such as 1[b] (and 1[c])).

Specification: We next turn to disclosures in the Specification relevant to the subject limitation. *See E-Pass Techs., Inc. v. 3Com Corp.*, 343 F.3d 1364, 1369 (Fed. Cir. 2003) (Claims must be interpreted “‘in view of the specification’ without unnecessarily importing limitations from the

⁵ Patent Owner argues that other limitations in claim 1 that explicitly implicate a “user” do not “mandate” or “require” that we construe limitation 1[b]’s “activity time period” as *not* necessarily coming “from a user during a goal setting operation.” PO Sur-reply 4–5. We agree such surrounding limitations do not *mandate* us to do so, but on the record before us, we find they at least *support* doing so.

⁶ Petitioner argues, “the claims make no secret when something must come ‘from’ a certain source.” Pet. Reply 2 (citing various claims with such limitations).

specification into the claims.” (citing *Texas Digital Sys., Inc. v. Telegenix, Inc.*, 308 F.3d 1193, 1203–04 (Fed. Cir. 2002))).

Patent Owner argues that the skilled artisan “reading the claims in light of the ’615 patent specification would have understood that the activity time period was received from a user as the user set his or her goal(s),” because the Specification describes, in several instances, activity time periods being received from users during goal setting operations. PO Resp. 12 (citing Ex. 2002 ¶ 33); *see id.* at 11–13; PO Sur-reply 2–8.

According to Petitioner:

[Patent Owner] argues that because [the Specification] sometimes describes a user setting an activity time period while setting a goal, that is the scope of the claims. (POR, 12–13.) [Patent Owner] is wrong as a matter of law. Narrowing claims from their ordinary and customary meaning requires “clear” lexicography or disclaimer, neither of which [Patent Owner] even mentions. *Thorner v. Sony Comp. Entm’t Amer., LLC*, 669 F.3d 1362, 1365–66 (Fed. Cir. 2012). Alternatively, even if the specification only had disclosed embodiments matching [Patent Owner’s] construction—and it discloses far more—the Federal Circuit “has expressly rejected [the] contention that if a patent describes only a single embodiment, the claims of the patent must be construed as being limited to that embodiment.” *Liebel-Flarsheim Co. v. Medrad, Inc.*, 358 F.3d 898, 906 (Fed. Cir. 2004). Thus, the specification provides [Patent Owner] no support.

Pet. Reply 4–5. We agree with Petitioner. Indeed, “[e]ven when the specification describes only a single embodiment, the claims of the patent will not be read restrictively *unless the patentee has demonstrated a clear intention to limit the claim scope using ‘words or expressions of manifest exclusion or restriction.’*” *Liebel-Flarsheim*, 358 F.3d at 906. Here, Patent Owner concedes that it is “not arguing lexicography or disclaimer or

anything like that.” Tr. 36:10–14. Thus, we find Patent Owner’s arguments unavailing.

Moreover, although not highlighted by the parties, we find it at least noteworthy that:

(1) limitation 1[e] requires “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, 80:34–37 (emphasis added)); and

(2) the Specification describes that such streak rewards include “coupons, *free products*, virtual items including virtual apparel, icons, images etc., services, *event tickets* and the like” (*id.* at 57:13–22 (emphases added)); that a user does not send, but rather *the user receives* “[an] alert message . . . indicat[ing] that a reward is possible *for activity performed at a particular time*” (*id.* at 67:55–63 (emphasis added)); and that a “first application interface [used in the method of claim 1] is further configured to communicate content *to the user* indicating that a streak reward is available *upon performing a specified athletic activity*” (*id.* at 81:1–4 (claim 9) (emphases added)).

Patent Owner, in arguing that limitation 1[b] requires “receiving an activity time period from a user during a goal setting operation,” does not explain how users setting their own activity time periods and overall goals allegedly works in the context of streak rewards. In particular, it would seem to flout common sense that an entity offering “event tickets” as a streak reward would not have input into or outright define the goal (activity time period) that must be achieved to win those tickets. For example, under Patent Owner’s construction where the “activity time period” may only be

received from the user,⁷ a user could set the activity time period to one week and the goal as one push-up, and once the user performs that one push-up per week for a predetermined number of consecutive time periods, declare victory and entitlement to a streak reward—that makes no sense. We find the presentation of streak rewards in claim 1 further supports our interpretation of limitation 1[b], and counsels against Patent Owner’s attempt to limit “receiving an activity time period” to be *only* from a user during a goal setting operation.

Prosecution History: Neither party has directed us to any evidence in the prosecution history of the ’615 patent relevant to interpreting the subject limitation. *See generally* Exs. 1007–1012 (excerpted prosecution file history of the ’615 patent).

Based on the record before us, we determine that limitation 1[b] *does not require* the “activity time period” to be received “from a user during a goal setting operation.”

(b) Sirmans’ Disclosures

Petitioner contends Sirmans discloses 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

⁷ *See* Tr. 37:1–4 (“[Judge:] Is it your position that that phrase, receiving an activity time period, in claim 1 excludes receiving it from anything or anybody other than the user? [Patent Owner’s counsel’s response:] Yes.”)

(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.”)). We find Petitioner’s argument persuasive.

Under our construction of limitation 1[b] (and Petitioner’s), Patent Owner concedes that Sirmans teaches or fairly suggests the limitation. *See* Tr. 44:13–22 (Patent Owner’s counsel stating, “[w]e agree with what [Petitioner] said earlier that if you don’t agree with our construction [of ‘receiving an activity time period’] then Sirmans would cover that limitation.”). Based on the foregoing evidence and the reasons stated in the Petition at pages 58–59, we find Petitioner sufficiently establishes that Sirmans teaches or fairly suggests 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.

Based on the foregoing evidence and the reasons stated in the Petition at pages 59–60, we find Petitioner sufficiently establishes that Sirmans teaches or fairly suggests limitation 1[c]. Except as discussed above concerning limitation 1[b] (activity time period), Patent Owner does not contest that this limitation is present in Sirmans. *See generally* PO Resp.

(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 or fairly suggests 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]

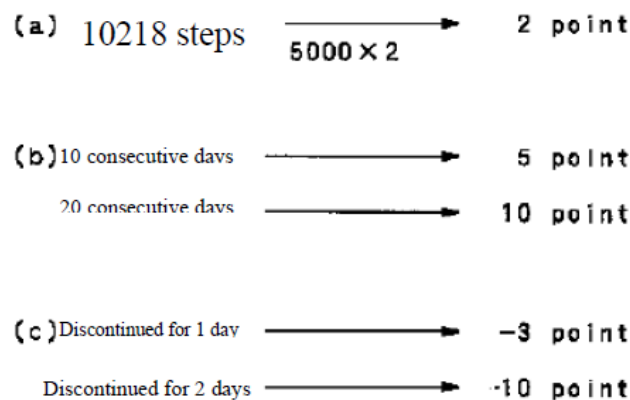


Figure 12 depicts operations involved in step-point conversion processing, particularly for reaching goals over consecutive days.

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). In sum, 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.

Based on the foregoing evidence and the reasons stated in the Petition at pages 60–63, we find Petitioner sufficiently establishes that the combination of Sirmans and Kobayashi teaches or fairly suggests limitation 1[d]. Except as discussed above concerning limitation 1[b] (activity time period), Patent Owner does not contest that this limitation is present in the combination. *See generally* PO Resp.

- (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 presenting a reward to the user when the user exceeds an activity goal per 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. We note that 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 then 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 evidence and the reasons stated in the Petition at pages 63–65, we find Petitioner sufficiently establishes that the combination of Sirmans and Kobayashi teaches or fairly suggests limitation 1[e]. Except as discussed above concerning limitation 1[b] (activity time period), Patent Owner does not contest that this limitation is present in the combination. *See generally* PO Resp.

(7) *Conclusion for Independent Claim 1*

For the foregoing reasons, and the reasons stated in the Petition (Pet. 14–17, 56–65), we conclude that Petitioner has demonstrated by a preponderance of the evidence that independent claim 1 would have been unpatentable as obvious over the combination of Sirmans and Kobayashi. *See* Tr. 12:1–6 (Petitioner’s counsel: “[I]f the Board declines to adopt Patent Owner’s additions to the claim language, then there is no dispute that the two Sirmans grounds, that’s ground 3, and ground 5, collectively render

unpatentable, all the challenge claims.”); Tr. 44:13–22 (Patent Owner’s counsel: “We agree with what [Petitioner] said earlier that if you don’t agree with our construction [of ‘receiving an activity time period’] then Sirmans would cover that limitation.”).

b. Dependent Claim 3

Petitioner contends claim 3, which depends directly from independent claim 1, would have been unpatentable as obvious over the combination of Sirmans and Kobayashi. Pet. 66–67; Pet. Reply 8–10. Patent Owner opposes. PO Resp. 32–33; *see* PO Sur-reply 20–24.

Dependent claim 3 recites, “wherein the device is a wrist-worn monitoring device.” Ex. 1001, 80:41–42.

Petitioner contends Sirmans teaches or fairly suggests the limitation added by claim 3 by describing, *inter alia*, a “personal monitoring device” “equipped with a means for continuous monitoring of member physiological status,” where physiological data monitored using the monitoring device include “body core temperature, galvanic skin response, pulse, blood pressure, respiration, activity, heat flow, and certain electrical currents associated with electrocardiogram and electroencephalograph measurements.” Pet. 66 (citing Ex. 1004 ¶ 16).

Petitioner alternatively contends the combination of Sirmans and Kobayashi teaches or fairly suggests the limitation added by claim 3. Pet. 66–67 (citing Ex. 1006 ¶¶ 86–87). In particular, Petitioner contends Kobayashi teaches “a pedometer that ‘can be worn on any position of the human body.’” Pet. 67 (quoting Ex. 1005 ¶ 95). Petitioner submits that “sensors in wrist watches were well known at the time of the earliest priority date of the ’615 patent.” Pet. 67 (citing Ex. 1006 ¶¶ 86–87). Petitioner

argues that the skilled artisan, “looking to implement Sirmans and Kobayashi would have been motivated to use an existing sensor to be worn on the wrist (e.g., a watch-like device) with a high likelihood of success as an obvious choice, thereby allowing a user to easily monitor their performance and check their progress while exercising.” Pet. 67. We find persuasive Petitioner’s argument that *the combination* of Sirmans and Kobayashi teaches the limitation added by claim 3.

Patent Owner argues that “Sirmans simply does not teach or suggest that a monitor[ing] [device] is worn on the wrist,” and that Petitioner’s expert, Dr. Fischer, “was unable to point to any disclosure in the Sirmans reference showing a wrist-worn device.” PO Resp. 32 (citing Ex. 2003, 81:3–19). Notably, Patent Owner attacks only Sirmans, and does not contest the combination of Sirmans and Kobayashi as presented by Petitioner. *See* Pet. Reply 8 (“[Patent Owner] does not dispute that it would have been obvious to combine Kobayashi’s sensor ‘worn on any position’ with Sirmans’s system.”).⁸ Patent Owner cannot show nonobviousness by attacking references individually where unpatentability is based on a *combination* of references. *See In re Keller*, 642 F.2d 413, 425–26 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 1097 (Fed. Cir. 1986). Further, 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 (PO Resp. 32–33), but whether the claimed subject matter would have been obvious to those of ordinary skill in the art *in light of the combined*

⁸ Patent Owner also does not meaningfully address in its Sur-reply the combination of Sirmans and Kobayashi as presented by Petitioner. *See generally* PO Sur-reply 20–24.

teachings of those references. See In re Keller, 642 F.2d at 425; *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 agree with Petitioner and find Patent Owner’s arguments unavailing.⁹

Based on the foregoing and the reasons provided above for independent claim 1, we conclude that Petitioner has demonstrated by a preponderance of the evidence that dependent claim 3 would have been unpatentable as obvious over the combination of Sirmans and Kobayashi.

c. Dependent Claim 7

Petitioner contends claim 7, which depends directly from independent claim 1, would have been unpatentable as obvious over the combination of Sirmans and Kobayashi. Pet. 40–41; Pet. Reply 10–11. Patent Owner opposes. PO Resp. 33; *see* PO Sur-reply 22–23.

⁹ In its Ground 5, Petitioner argues dependent claim 3 also would have been unpatentable as obvious over the combination of Sirmans, Kobayashi, *and* Brady. Pet. 20, 74–75. Petitioner argues that Brady explicitly describes “‘monitoring device 20 preferably includes an article 25 and an attachment band 26’ that attaches the monitoring device to a user’s wrist,” where “[t]he device includes a sensor that is used to detect the user’s heart rate and other physiological parameters.” Pet. 74–75 (citing Ex. 1021, 4:32–33, 5:8–9, 5:16–41, 6:1–13). Patent Owner does not contest that the limitation added by claim 3 is present in the combination of Sirmans, Kobayashi, and Brady. *See* PO Resp. 34 (relying on arguments against claim 1); PO Sur-reply 23–24 (same).

Dependent claim 7 recites:

receiving a second activity goal for the activity time period; and
determining, at a processor, whether the received athletic activity
data exceeds the second activity goal for a predetermined
number of consecutive activity time periods.

Ex. 1001, 80:59–63.

Petitioner contends Sirmans teaches or fairly suggests the limitations added by claim 7 by describing, *inter alia*, 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)” (Pet. 71 (citing Ex. 1004 ¶ 84)), and “should the member’s performance meet the established recommended/minimum level of performance, a further assessment on whether [the] member’s performance exceeds minimum requirements is then performed” (*id.* (citing Ex. 1004 ¶ 72)). Petitioner argues the skilled artisan “would understand that this exercise regimen sets two activity goals for a user to follow: (1) moderate intensity for 30 minutes a day 5 days a week, and (2) vigorous intensity for 20 minutes a day 3 days a week.” Pet. 71–72 (citing Ex. 1006 ¶ 130).

Petitioner alternatively contends the combination of Sirmans and Kobayashi teaches or fairly suggests the limitations of claim 7. Pet. 72–73 (citing, *inter alia*, Ex. 1006 ¶¶ 95–103, 130). In particular, Petitioner contends Kobayashi teaches “recognizing and rewarding ‘consecutive days of reaching the goal,’” and combines with Sirmans to teach or fairly suggest the limitations of claim 7 for the same reasons discussed above in Section III.D.3.a.5 (discussing limitation 1[d]). Pet. 72 (citing Ex. 1005 ¶ 142); *see id.* at 72–73 (citing Ex. 1006 ¶¶ 95–103, 130). Petitioner further

argues that “it would be a simple modification to include Kobayashi’s recognition of consecutive activity time periods for a second activity goal into Sirmans’ protocol criteria,” and that “[i]n view of the combined teachings of Sirmans and Kobayashi, it would be easy to implement determining whether the received athletic activity data exceeds the second activity goal for a predetermined number of consecutive activity time periods.” Pet. 72 (citing Ex. 1006 ¶ 130). We find persuasive Petitioner’s argument that *the combination* of Sirmans and Kobayashi teaches the limitations of claim 7.

Patent Owner argues that the combination of Sirmans and Kobayashi does not teach the additional limitations of claim 7 because, according to Patent Owner, “Sirmans does not disclose ‘receiving an activity time period’” as recited in underlying limitation 1[b]. PO Resp. 33; *see* PO Sur-reply 22–23. But Patent Owner’s argument here relies on its construction of limitation 1[b] (“receiving an activity time period”), which we found unpersuasive and rejected as discussed above in Section III.D.3.a.3. *See* Pet. Reply 11 (“[Patent Owner’s] lone argument for claim 7 is, instead, that Sirmans does not disclose receiving the time period ‘from a user during a goal setting operation’ under its construction. That argument fails for the same reasons as before.” (citation omitted)). Thus, we find Patent Owner’s arguments unavailing.

Based on the foregoing and the reasons provided above for independent claim 1, we conclude that Petitioner has demonstrated by a preponderance of the evidence that dependent claim 7 would have been unpatentable as obvious over the combination of Sirmans and Kobayashi.

d. Independent Claim 11 and Dependent Claims 2, 4, 5, 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, 4, 5, and 13, would have been unpatentable as obvious over the combination of Sirmans and Kobayashi. Pet. 65–71, 73–74. The Petition provides a detailed assessment of these claims, with references to the Petition’s analysis of claim 1, teachings in Sirmans and Kobayashi, and the declaration testimony of Dr. Fischer. *Id.*

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, 4, 5, 11, and 13. *See generally* PO Resp.; PO Sur-reply.

As discussed above, we are persuaded that the cited evidence sufficiently supports Petitioner’s contention that independent claim 1 would have been unpatentable as obvious over the combination of Sirmans and Kobayashi. For the same reasons provided above for independent claim 1, and the reasons set forth in the Petition (Pet. 65–71, 73–74), we conclude that Petitioner has demonstrated by a preponderance of the evidence that independent claim 11 and dependent claims 2, 4, 5, and 13 would have been unpatentable as obvious over the combination of Sirmans and Kobayashi.

4. Conclusion

For the foregoing reasons, we conclude that Petitioner has demonstrated by a preponderance of the evidence that claims 1–5, 7, 11,

and 13 would have been unpatentable as obvious over the combination of Sirmans and Kobayashi.

E. (1) Anticipation of Claims 1–5, 7, 11, and 13 by Hoffman; (2) Obviousness of Claims 1–5, 7, 11, and 13 over the Combination of Stivorice and Kobayashi; and (3) Obviousness of Claims 3–5 over the Combinations of (a) Stivorice, Kobayashi, and Brady and (b) Sirmans, Kobayashi, and Brady

Petitioner contends (1) claims 1–5, 7, 11, and 13 are unpatentable under 35 U.S.C. § 102 as anticipated by Hoffman (Pet. 9–12, 21–42); (2) claims 1–5, 7, 11, and 13 are unpatentable under 35 U.S.C. § 103 as obvious over the combination of Stivorice and Kobayashi (Pet. 12–14, 17, 43–56); and (3) dependent claims 3–5 are unpatentable under 35 U.S.C. § 103 as obvious over the combinations of (a) Stivorice, Kobayashi, and Brady, and (b) Sirmans, Kobayashi, and Brady (Pet. 74–78).

As discussed above in Section III.D, we conclude that Petitioner has demonstrated by a preponderance of the evidence that all of the Challenged Claims (i.e., claims 1–5, 7, 11, and 13) would have been unpatentable under 35 U.S.C. § 103 as obvious over the combination of Sirmans and Kobayashi. Therefore, resolution of this proceeding does not require assessment of the foregoing additional challenges (i.e., (1), (2), (3)(a), and (3)(b) above), and so for efficiency purposes, we need not and do not herein address these challenges. *See SAS Inst. Inc. v. Iancu*, 138 S. Ct. 1348, 1359 (2018) (holding a petitioner “is entitled to a final written decision addressing all of the claims it has challenged”); *Boston Sci. Scimed, Inc. v. Cook Grp. Inc.*, 809 F. App’x 984, 990 (Fed. Cir. 2020) (non-precedential) (recognizing that the “Board need not address issues that are not necessary to the resolution of the proceeding” and, thus, agreeing that the Board has “discretion to decline

to decide additional instituted grounds once the petitioner has prevailed on all its challenged claims”).

IV. CONCLUSION

Petitioner has met its burden to show, by a preponderance of the evidence, that all of the Challenged Claims (i.e., claims 1–5, 7, 11, and 13) would have been unpatentable under 35 U.S.C. § 103 as obvious over the combination of Sirmans and Kobayashi.¹⁰ Because of this determination accounting for all Challenged Claims, we exercise our discretion to decline to decide Petitioner’s additional challenges to the same claims.

V. ORDER

Upon consideration of the record, it is
ORDERED that claims 1–5, 7, 11, and 13 of U.S. Patent
No. 9,259,615 B2 are unpatentable; and

FURTHER ORDERED that, because this is a Final Written Decision, parties to this proceeding seeking judicial review of the Decision must comply with the notice and service requirements of 37 C.F.R. § 90.2.

¹⁰ Should Patent Owner wish to pursue amendment of the challenged claims in a reissue or reexamination proceeding subsequent to the issuance of this decision, we draw Patent Owner’s attention to the April 2019 Notice Regarding Options for Amendments by Patent Owner Through Reissue or Reexamination During a Pending AIA Trial Proceeding. *See* 84 Fed. Reg. 16,654 (Apr. 22, 2019). If Patent Owner chooses to file a reissue application or a request for reexamination of the challenged patent, we remind Patent Owner of its continuing obligation to notify the Board of any such related matters in updated mandatory notices. *See* 37 C.F.R. § 42.8(a)(3), (b)(2).

In summary:

Claim(s)	35 U.S.C. §	Reference(s)	Claims Shown Unpatentable	Claims Not Shown Unpatentable
1–5, 7, 11, 13	102	Hoffman ¹¹		
1–5, 7, 11, 13	103	Stivorc, Kobayashi ¹²		
1–5, 7, 11, 13	103	Sirmans, Kobayashi	1–5, 7, 11, 13	
3–5	103	Stivorc, Kobayashi, Brady ¹³		
3–5	103	Sirmans, Kobayashi, Brady ¹⁴		
Overall Outcome			1–5, 7, 11, 13	

¹¹ We do not reach the ground based on Hoffman as to claims 1–5, 7, 11, and 13 because we determined those claims would have been unpatentable as obvious over the combination of Sirmans and Kobayashi.

¹² We do not reach the ground based on Stivorc and Kobayashi as to claims 1–5, 7, 11, and 13 because we determined those claims would have been unpatentable as obvious over the combination of Sirmans and Kobayashi.

¹³ We do not reach the ground based on Stivorc, Kobayashi, and Brady as to claims 3–5 because we determined those claims would have been unpatentable as obvious over the combination of Sirmans and Kobayashi.

¹⁴ We do not reach the ground based on Sirmans, Kobayashi, and Brady as to claims 3–5 because we determined those claims would have been unpatentable as obvious over the combination of Sirmans and Kobayashi.

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