

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ALIVECOR, INC.,
Petitioner

v.

APPLE INC.,
Patent Owner

Case No. IPR2023-01434

U.S. Patent No. 10,270,898 B2

PETITIONER'S REQUEST FOR REHEARING BY THE DIRECTOR

Mail Stop PATENT BOARD
Patent Trial and Appeal Board
US Patent and Trademark Office
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Petitioner respectfully requests Director review of the Board’s denial of institution of *inter partes* review (Paper 8) (the “ID”).

I. INTRODUCTION

This proceeding presents the perfect opportunity to clarify that petitioners should be permitted to address new and unforeseeable claim construction arguments raised by a patent owner for the first time in a preliminary response. Here, Patent Owner argued a claim construction position for the first time in its preliminary response that contradicted not only the language of the claim in view of the intrinsic record, but also the Patent Owner’s own claim construction positions in Related Proceedings. Petitioner could not have foreseen Patent Owner would raise this claim construction argument and the Board should have permitted petitioner a short reply.

The United States Patent and Trademark Office adopted the *Phillips* standard in *inter partes* review proceedings to provide greater consistency and harmonization with the federal courts and the ITC and, as a result, greater certainty, and predictability in the patent system. Allowing petitioners to address new and unforeseeable claims constructions positions in replies furthers the goal of harmonizing *inter partes* review and district court proceedings and improves the predictability of the patent system.

In this case, Patent Owner took the position that the “graph representation of the sub-category of wellness data” and “selectable data sharing” option must be

located on the same user interface. Paper 6 at 2, 8, 9. Because Petitioner allegedly pointed to different user interfaces for these two elements, Patent Owner argued that Petitioner's grounds were deficient and that the Board should deny institution. Petitioner could not have foreseen, nor was there any indication in the Related Proceedings, that Patent Owner would argue that the claim was so narrow.

Patent Owner's proposed construction was unforeseeable for multiple reasons. First, the intrinsic record does not support the proposed construction. Second, Patent Owner's infringement contentions did not contend the detailed view must comprise both the "graph representation" and "selectable data sharing option." In fact, Patent Owner's contentions pointed to *different* user interfaces for those two elements. Third, despite being on notice of the same art at issue in the petition, Patent Owner did not contend that "a detailed view" required construction in the Related Proceeding. And fourth, Patent Owner's contentions appeared to take the position that selection of the "selectable data sharing option" only required that the one or more programs cause the user's data to be received from the plurality of sources and approved to be accessed by other destinations, rather than display the approved sources and destinations as required by Claim 1. *See, e.g.*, Ex. 1017, ¶¶ 156, 161.

Given Patent Owner's contradictory arguments, Petitioner requested authorization to submit a reply to address this new claim construction argument. Petitioner advanced that good cause exists to address "the unforeseeable new claim

construction” and to explain “how the claims are anticipated and/or rendered obvious under the prior art under [Patent Owner’s] proposed construction.” Paper 7 at 2; *see also* 37 C.F.R. § 42.108(c) (“A petitioner may seek leave to file a reply to the preliminary response in accordance with §§ 42.23 and 42.24(c). Any such request must make a showing of good cause.”). Petitioner demonstrated and was prepared to further explain how, under this new construction, the petition and the cited references rendered the claims unpatentable. Despite this, the Board denied Petitioner’s request. Paper 7. This constituted a clear abuse of discretion, particularly where the Board’s ID denying institution hinged on the construction raised in Patent Owner’s Preliminary Response. Paper 8. Petitioner should not have been expected to anticipate Patent Owner’s argument, and both parties should have been given the opportunity to brief the claim construction issue that formed the basis of the ID.

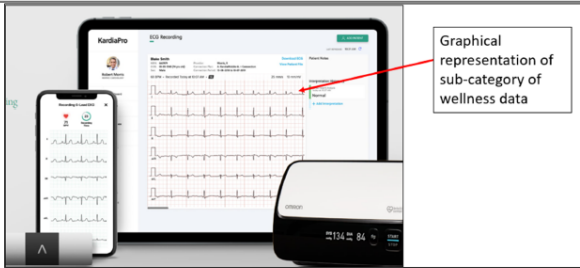
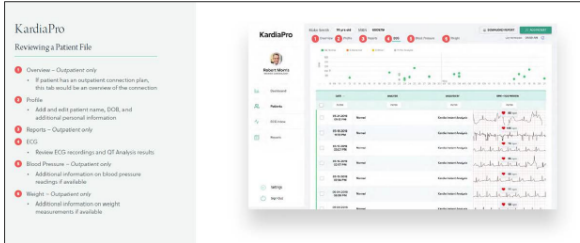
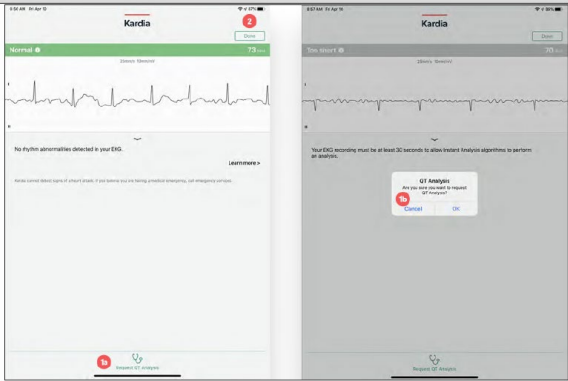
II. FACTUAL BACKGROUND

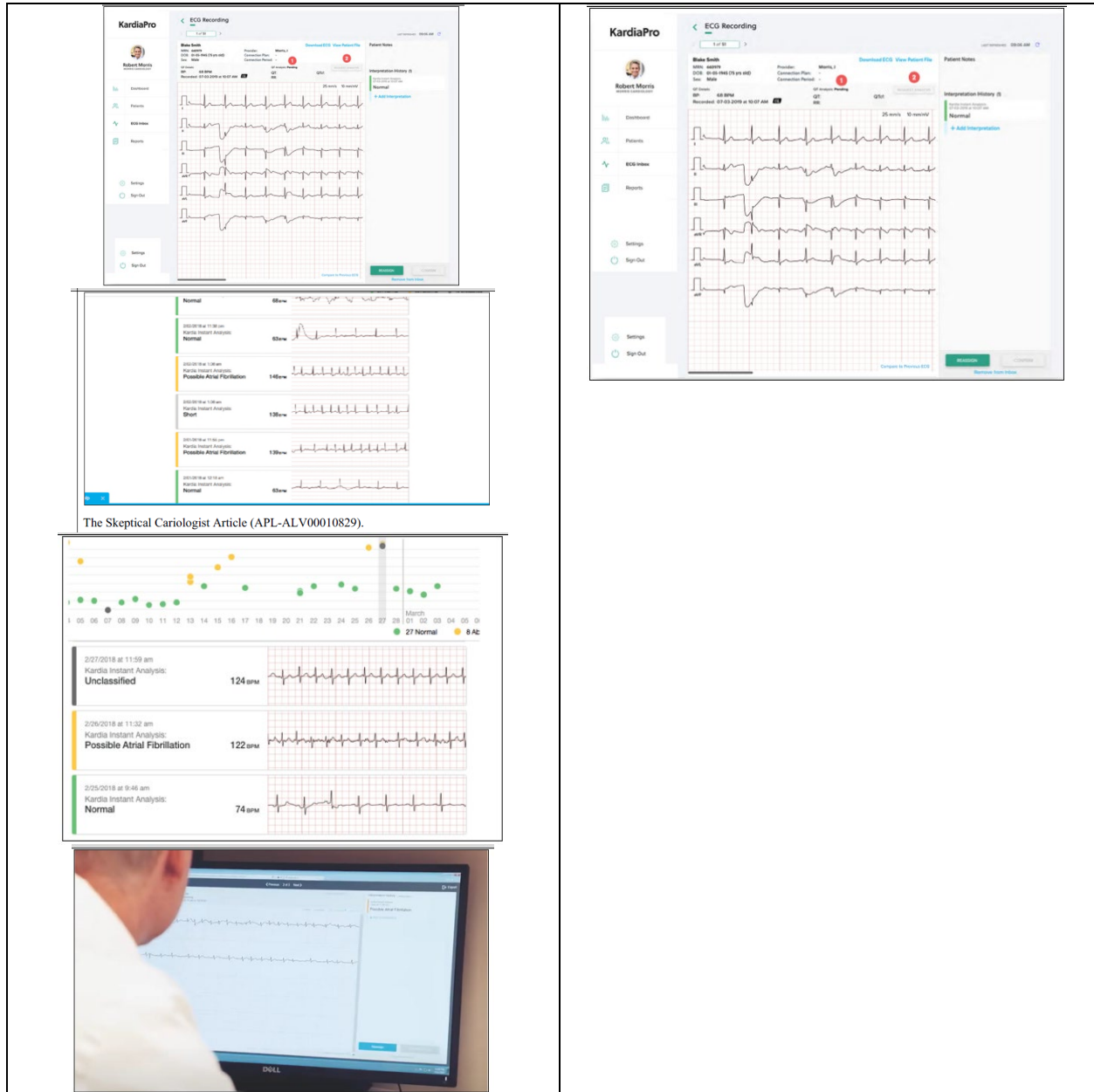
A. Overview of the Related Proceeding

On December 2, 2022, Patent Owner filed a complaint against Petitioner in the Northern District of California alleging infringement of the ’898 Patent, amongst others. On July 25, 2022, Patent Owner served its Disclosure of Asserted Claims and Infringement Contentions (“Contentions”), alleging that Petitioner infringes claims 1, 9, 23, and 32 of the ’898 Patent. Patent Owner’s Contentions included an infringement chart purporting to map the asserted claims to Petitioner’s

KardiaMobile devices. *See* Ex. 1017.

Patent Owner's Contentions did not contend or otherwise put Petitioner on notice that “a detailed view” must include both “a graph representation” and “a selectable data sharing option” on a single view. Instead, as shown below, Patent Owner contended that “the KardiaMobile devices display a detailed view of a graph representation of wellness data...” on one user interface (*i.e.*, view) and that “the KardiaMobile devices display a detailed view of a selectable data sharing option” on a *different* user interface (*i.e.*, view). *See, e.g.*, Ex. 1017, 37–48, elements [1.d] and [1.e]. For example, the table below compares the user interfaces that Patent Owner identified for each element:

Element 1[d] “graph representation”	Element 1[e] “selectable data sharing option”
 Graphical representation of sub-category of wellness data KardiaPro Information Page (APL-ALV00010802).  KardiaMobile 6L System, Inpatient User Guide (APL-ALV00010459) at 0485.	



Ex. 1017, 33–52. The above excerpts show graph representations on one interface and a “reassign” option (*i.e.*, the purported selectable data sharing option) on a different user interface.

Further, for the limitations identified as limitations 1[h] and 1[i] in Patent Owner’s Contentions, Patent Owner appeared to allege that the display of the

“plurality of approved sources” and “plurality of approved destinations” in response to user selection of the “selectable data sharing option” was not required, as nowhere did Patent Owner identify a display with approved sources and approved destinations as required by the claims. *See, e.g.*, Ex. 1017, 59–67.

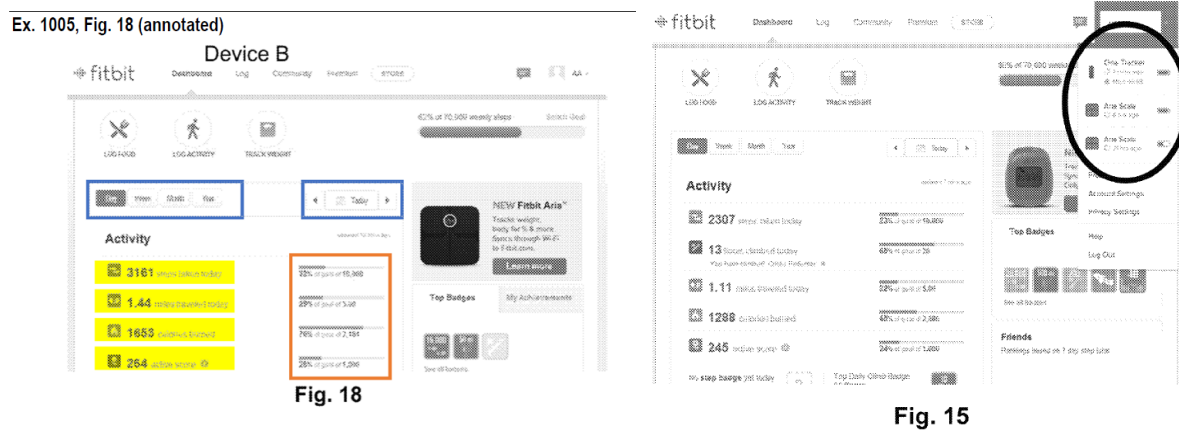
On September 22, 2024, the parties exchanged proposed terms for construction in accordance with court’s scheduling order. Patent Owner did not identify *any* term, phrase, or clause of the ’898 Patent that it contended should be construed. On November 17, 2023, Patent Owner served validity contentions in response to Petitioner’s interrogatory requests. Patent Owner’s validity contentions again did not explain that the detailed view must comprise both elements.

B. Overview of the IPR Proceeding

Petitioner alleged that the challenged claims of the ’898 Patent were invalid as anticipated or obvious in view of the following references/combinations: 1) *Molettiere*, 2) *Cohen*, and 3) *Yuen and Molettiere*. *See generally*, Paper 1.

With respect to *Molettiere*, Petitioner explained that *Molettiere* teaches that “multiple data streams...are collected by, multiple devices” such as pedometers and an electric scale. Paper 1 at 7–8. To view the data collected, Patent Owner explained that *Molettiere* teaches that a user account may provide “a repository for user’s data” and “visualization of user data through a website,” such as the exemplary website illustrated in Figure 17 and 18. Ex. 1003, ¶¶ 127, 132; Paper 1 at 10–14.

In particular, Petitioner alleged that *Molettiere* discloses a graph representation of a sub-category of wellness data (i.e., “steps taken,” “miles traveled,” “calories burned,” and “active score”). Petitioner annotated Figure 18 to illustrate the graph representation (highlighted in Orange) and sub-category of wellness data (highlighted in Yellow) disclosed in *Molettiere*. The graph representation of wellness data depicted in Figure 18 is the same as Figures 14, 15, 17, and 18. Ex. 1005, Figs. 14, 15, 17, and 18. Figure 15 is reproduced below:



The selectable area of Figure 15 (annotated by the black circle) is available from each of Figures 14, 15, 17, and 18. In fact, Petitioner also made clear that *Molettiere* discloses an interface “for configuring tracking devices in use by the user.” Paper 1 at 8. *Molettiere* teaches that the user interface of Fig. 16 is an interface for managing a device, and that the user may select a device from a list of devices (e.g., the list displayed in Fig. 15 above) to view the profile information or device settings for that device. Paper 1 at 13–16, Ex. 1005, 22:6-14, 22:24-31.

III. LEGAL STANDARD

Director review of an institution decision is limited to decisions presenting (a) an abuse of discretion or (b) important issues of law or policy. 37 C.F.R. § 42.71(c),(d); *see Ericsson Inc. v. Intell. Ventures I LLC*, 901 F.3d 1374, 1379 (Fed. Cir. 2018) (stating that the Board abuses its discretion when its decision “is based on an erroneous conclusion of law” or “rests on clearly erroneous fact finding”).

IV. DIRECTOR REVIEW IS APPROPRIATE

A. The Board Abused Its Discretion by Denying Petitioner’s Request to File a Reply

After Patent Owner’s Preliminary Response argued Petitioner had not identified prior art that has a “detailed view” under Patent Owner’s proposed claim construction, Petitioner sought the Board’s authorization to file a reply to address Patent Owner’s unforeseeable argument. The Board abused its discretion by denying Petitioner’s request when it determined that Petitioner failed to demonstrate good cause, explaining that Patent Owner’s claim construction was foreseeable, and that the Board was equipped to assess the issue without further briefing. Paper 7 at 4.

The Board’s reasoning that Petitioner reasonably should have foreseen Patent Owner’s claim construction argument runs afoul of the Director’s guidance in *Google*, which vacated an institution decision where the Board failed to authorize petitioner to file a reply when petitioner could not reasonably foresee patent owner’s argument made in its preliminary response. *See Google LLC v. Valtrus Innovations*

Limited, IPR2022-01197, Paper 12 (PTAB Mar. 29, 2023). As the Director held, “a petitioner cannot be expected to anticipate every argument that may be raised by a patent owner.” *See Id.* Yet, here the Board expected Petitioner to anticipate Patent Owner’s arguments when those arguments directly contradicted the positions Patent Owner took in the Related Proceeding.

Specifically, in its Preliminary Response, Patent Owner took the position that “AliveCor improperly pointed to different user interfaces [i.e., for a graph representation and selectable data sharing option] that are not part of the same detailed view.” Paper 6 at 2. Patent Owner claimed this argument was dispositive of “all of AliveCor’s grounds.” *Id.* at 2. Patent Owner’s arguments were unforeseeable because, as explained in detail above, it did not argue that the detailed view must comprise both elements in the Related Proceeding. Nor did Patent Owner take the position that different user interfaces cannot satisfy these elements. In fact, Patent Owner’s Contentions show the exact opposite. There, Patent Owner pointed to *different* user interfaces as satisfying these elements. *See supra* Section II.A.

Further, Patent Owner contended that AliveCor’s products display a detailed view of a graph representation and display a detailed view of a selectable data sharing option, but never specifically contended that Petitioner’s products displayed a *single* detailed view comprising both elements. Patent Owner’s contrary positions are not surprising because Petitioner’s products do not have a single detailed view

with both elements. In other words, Patent Owner improperly seeks to twist the patent one way to find infringement and another to avoid invalidity. *CommScope Techs. LLC v. Dali Wireless Inc.*, 10 F.4th 1289, 1299 (Fed. Cir. 2021). Petitioner could not have foreseen Patent Owner would take different positions.

Petitioner could also not have foreseen Patent Owner's construction because Patent Owner did not contend that any term of the '898 Patent required construction in the Related Proceeding. In fact, the intrinsic record did not support such a construction. At best, the '898 Patent allows a user to navigate from an interface, Figure 30, to a second interface, Figure 34, to toggle a data sharing option.

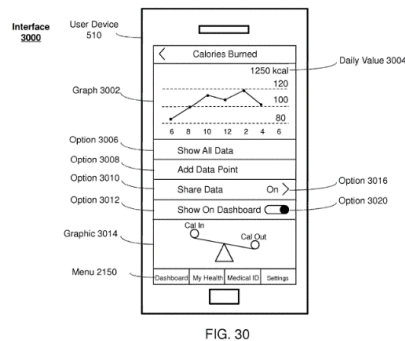


FIG. 30

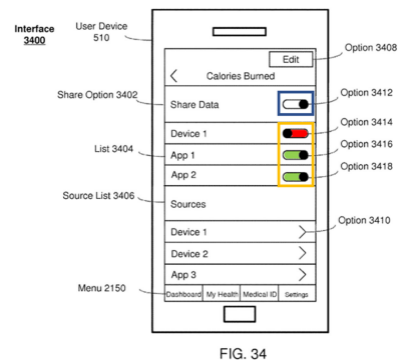


FIG. 34

Paper 1 at 3. The '898 Patent states: “For example, FIG. 34 illustrates an example interface 3400 that can be displayed in response to a selection of option 3010 in interface 3000. As shown, interface 3400 can include share option 3402 having selectable option 3412. The position of the switch of option 3412 can be used to **turn data sharing on or off.**” Ex. 1001, 57:20–23. That is, the “selectable options” (ORANGE, above), allow the user to turn on or off data sharing for each device. Paper 1 at 3 (citing Ex. 1001, 57:39-42; Ex. 1003, ¶ 67). There can be no doubt that

the graph and the selectable data sharing option are in different views.

Further, Patent Owner's Contentions in the Related Proceeding supported this view of the '898 Patent and suggested that the "detailed view" should be viewed even more broadly as it need not comprise both elements and that the claimed "selectable data sharing option" merely allowed the user to share data, consistent with Figs. 34 and 36 of the '898 Patent. Patent Owner's apparent position in the Related Proceeding does not reconcile with Patent Owner's current view—i.e., that Option 3010 of Fig. 30 constitutes "a selectable data sharing option," which merely transitions the user to another user interface (i.e., the user interface of Fig. 34). *See* Ex. 1001, 57:18-20, 57:20-57. Regardless, Petitioner's prior art addresses this unforeseen position, but Petitioner was prevented from further explaining such a position because of the lack of a reply. *See supra* Section II.B.

Under these unique circumstances, it was not reasonably foreseeable for Petitioner to have anticipated Patent Owner would take the position that the detailed view must comprise both elements when Patent Owner took the exact opposite position in the Related Proceeding. While Petitioner was afforded the opportunity to explain the basis for good cause through a telephone conference with the Board, a petitioner's argument before the Board requesting a reply should not undercut the actual need for a reply. As explained herein, a reply was necessary in this case and the Board improperly determined that it was equipped to assess Petitioner's positions

without briefing. And, as explained below, the Board was not so equipped because the prior art discloses a detailed view under Patent Owner's advanced construction.

B. Important Policy Reasons Warranted a Reply

There are two important policy reasons that warranted a reply in this case. First, the Board's improper focus on whether Patent Owner's construction was foreseeable, based on the plain language of the claim, without allowing Petitioner to fully address the positions Patent Owner took during the Related Proceeding would lead to bad legal policy. It encourages Patent Owner's to take inconsistent positions when it comes to pursuing patent infringement claims in the district court while saving the validity of the patent before the Board. The Board was never forced to wrestle with this inconsistency because Petitioner was not allowed to raise it and Patent Owner unsurprisingly did not address it in its Preliminary Response. In this instance, the positions taken by Patent Owner before the district court and the Board violated the fundamental tenet that "patent claims are construed the same way for validity and infringement." *See Abbott Labs. v. Sandoz, Inc.*, 566 F.3d 1282, 1318 (Fed. Cir. 2009). Without allowing Petitioner to fully address this issue in a reply, the Board precluded Petitioner from explaining the inconsistent infringement and validity positions thereby allowing Patent Owner to take such inconsistent positions to avoid institution. This contradicts the patent office's policy grounds for replacing the broadest reasonable interpretation standard with the *Philips* standard.

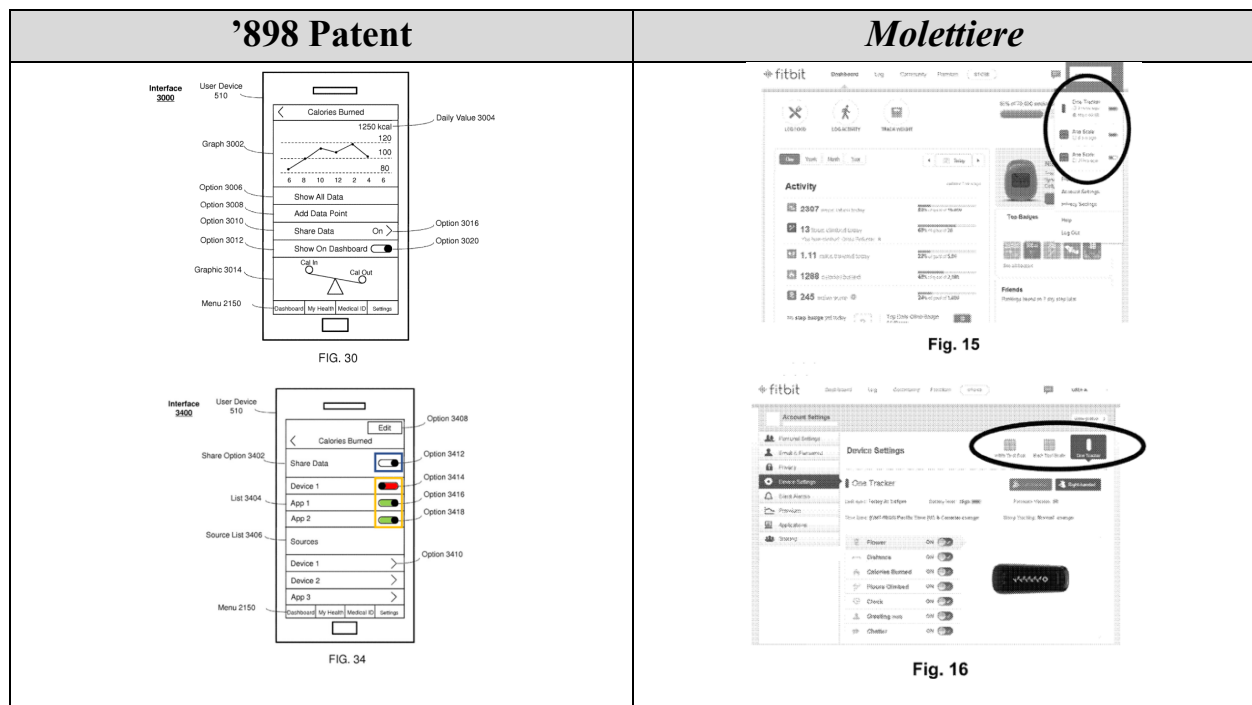
Second, both a patent owner and petitioner should have the opportunity to be fully heard regarding a claim construction dispute raised for the first time in a preliminary response, particularly where the disputed claim construction forms the basis of the Board's institution decision. The Board's decision in this case rested entirely on the disputed claim construction but the Board prevented Petitioner from fully explaining its claim construction positions, and how the prior art invalidated the claims. Instead, the Board stated it "expect[ed] to be able to discern Petitioner's implied constructions via its mapping of the limitations to the prior art." Paper 7 at 4. Allowing the Board to discern what it believes a petitioner implied about the construction without allowing petitioner to fully address its position invites legal error and would lead to bad legal policy as it would preclude petitioners from addressing important claim construction disputes that institution hinges on.

C. The Board Erroneously Concluded that *Molettiere* Does Not Disclose a Detailed View Under Patent Owner's Construction

The Board also erroneously concluded that "Petitioner does not identify any disclosure in *Molettiere* of displaying a single view having both components." ID at 24. Assuming Patent Owner's construction of "a detailed view" is correct, Petitioner nonetheless identified the relevant disclosures in *Molettiere* that disclose a detailed view that comprises both a graph representation and a selectable data sharing option. Petitioner made clear that *Molettiere*'s displays include graph representations of the sub-category of wellness data—i.e., "steps taken," "miles traveled," "calories

burned” and “active score.” Paper 1 at 12; Ex. 1005, Figs. 14, 15, 17, 18. While Petitioner annotated Fig. 18, as an exemplary graph representation, Figs. 14, 15, and 17 include the exact same graph representation highlighted by Petitioner in Fig. 18.

As the Board acknowledged, *Molettiere* teaches that when a user clicks on a device on the display in Fig. 15, the interface of Figure 16 is presented, which allows the user to configure settings. ID at 23–24; Paper 1 at 13–14; Ex. 1005, 22:24–31. Figure 15 includes a view having the same graph representation of the sub-category of wellness data highlighted in Figure 18 (e.g., “steps taken”) and a selectable data sharing option (i.e., active tracking devices). Ex. 1005, Fig. 15; Paper 1 at 13. By selecting an active device, the user transitions to Fig. 16, which contains “selectable options” identical to the those in the ’898 Patent. Paper 1 at 14.



See Paper 1 at 3, 16.

As shown above, this sequence of transitioning from the user interface of Fig. 15 to Fig. 16 upon selection of an “active tracking device” is the same sequence Patent Owner argued in support of its construction. That is, Patent Owner argued that when a user selects Option 3010 in Fig. 30 of the ’898 patent, the user interface transitions to Fig. 34, which includes a source list with selectable options 3412, 3414, 3416, and 3418. ID at 17–18; Ex. 1007, 57:13–57.

Patent Owner’s contentions fair no better as they accuse a button that allows a user to share data with a provider (i.e., destination). Regardless, in each instance, and similar to *Molettiere*, the supposed data sharing option is simply a button or icon that transitions to a different interface that eventually allows data sharing. Accordingly, *Molettiere* discloses a “detailed view” under Patent Owner’s construction, and the Board erred when it held that Petitioner had not adequately identified any disclosure in *Molettiere* that displayed both elements.

V. CONCLUSION

Petitioner respectfully requests that the Director vacate the denial of the Decision Denying institution and remand to the Board for further proceedings.

Date: May 3, 2024

By: / Christopher TL Douglas /
Christopher TL Douglas, Reg. No. 56,950

CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. §§42.6(e), 42.105, the undersigned hereby certifies that true and correct copies of the above-captioned PETITION FOR DIRECTOR REVIEW was served in its entireties on May 3, 2024, upon the following attorneys of record for Patent Owner:

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Date: May 3, 2024

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