

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ALIVECOR, INC.,
Petitioner,

v.

APPLE INC.,
Patent Owner.

IPR2024-00095
Patent 10,568,533 B2

Before JOSIAH C. COCKS, HYUN J. JUNG, and ROBERT L. KINDER,
Administrative Patent Judges.

JUNG, *Administrative Patent Judge.*

DECISION

Denying Petitioner's Request on Rehearing of
Decision Denying Institution of *Inter Partes* Review
37 C.F.R. § 42.71(d)

I. INTRODUCTION

AliveCor, Inc. (“Petitioner”) requested institution of an *inter partes* review of claims 20–22, 24, 29, and 37 of U.S. Patent No. 10,568,533 B2 (Ex. 1001, “the ’533 patent”). Paper 2 (“Pet.”). Apple, Inc. (“Patent Owner”) responded. Paper 6 (“Prelim. Resp.”).

After considering the arguments and cited evidence of the Petition, we determined that Petitioner did not show a reasonable likelihood of prevailing with respect to at least one of the challenged claims of the ’533 patent. Paper 7 (“Decision” or “Dec.”). Petitioner subsequently filed a Request for Rehearing. Paper 8 (“Reh’g Req.”).

For the reasons stated below, Petitioner has not shown that we abused our discretion in denying the Petition, and thus, Petitioner’s Request for Rehearing is *denied*.

II. ANALYSIS

A. *Request for Rehearing*

When rehearing a decision on institution, the Board reviews the decision for an abuse of discretion. 37 C.F.R. § 42.71(c). An abuse of discretion may arise if the decision is based on an erroneous interpretation of law, if substantial evidence does not support a factual finding, or if an unreasonable judgment is made in weighing relevant factors. *Star Fruits S.N.C. v. U.S.*, 393 F.3d 1277, 1281 (Fed. Cir. 2005); *Arnold P’ship v. Dudas*, 362 F.3d 1338, 1340 (Fed. Cir. 2004); *In re Gartside*, 203 F.3d 1305, 1315–16 (Fed. Cir. 2000); *see also* Reh’g Req. 8 (citing 37 C.F.R. § 42.71(c)).

Also, 37 C.F.R. § 42.71(d) sets forth, in relevant part that:

A party dissatisfied with a decision may file a single request for rehearing without prior authorization from the Board. The burden of showing a decision should be modified lies with the party challenging the decision. The request must specifically identify all matters the party believes the Board misapprehended or overlooked, and the place where each matter was previously addressed in a motion, an opposition, or a reply.

See also Reh’g Req. 8 (quoting, in part, 37 C.F.R. § 42.71(d)).

Petitioner challenged (1) claims 20, 21, 24, 29, and 37 as obvious over AHIT,¹ Hooper,² and Cho;³ (2) claim 22 as obvious over AHIT, Hooper, Cho, and Mayor;⁴ (3) claims 20, 21, 24, 29 and 37 as obvious over Petterson,⁵ Albert,⁶ and Nakada;⁷ and (4) claim 22 as obvious over Petterson, Albert, Nakada, and Mayor. Pet. 1–2, 8–81.

Petitioner’s arguments in its Request for Rehearing are related only to the challenges based on Petterson, not AHIT. *See, e.g.*, Reh’g Req. 4–7 (providing an overview of only the combination of Petterson and Nakada), 8–12 (contending an argument for Petterson modified by Nakada was overlooked). In particular, Petitioner contends that the totality of the proposed combination starting with Petterson was overlooked, arguments and evidence for the modification of Petterson with Nakada were overlooked, and Patent Owner’s apparent inconsistent claim interpretation

¹ CN 106901720A, published June 30, 2017. Ex. 1006.

² US 7,111,157 B1, issued Sept. 19, 2006. Ex. 1007.

³ US 2016/0196635 A1, published July 7, 2016. Ex. 1008.

⁴ US 2014/0173521 A1, published June 19, 2014. Ex. 1012.

⁵ US 10,685,090 B2, published Mar. 1, 2018, issued June 16, 2020. Ex. 1009.

⁶ US 2015/0073285 A1, published Mar. 12, 2015. Ex. 1010.

⁷ US 7,313,435 B2, issued Dec. 25, 2007. Ex. 1011.

from a district court proceeding should have been addressed. *See id.* at 8–15.

1. Asserted Overlooked Argument

Petitioner argues that “the Board overlooked the totality of the combination and Petitioner’s arguments and supporting evidence regarding the modification of Petterson . . . in view of Nakada.” Reh’g Req. 8. According to Petitioner, Patent Owner mischaracterized its proposed combination. *Id.* at 9 (citing Prelim. Resp. 16–17, 26). Petitioner contends that it argued “Nakada confirms that after 30 seconds have elapsed an error is displayed and then the system is returned to the beginning state of the routine, ‘**which in the case of Petterson would be FIG. 2B.**’” *Id.* (citing Pet. 70–71).

Petitioner, thus, contends that its

argument was that, in view of Nakada’s disclosure of an error and powering down, thus resetting its routine, the [person of ordinary skill in the art] would have known the system is returned to a beginning state of the routine (in which the device is off, in S15 and S1), and that with such knowledge, the [person of ordinary skill in the art] would have found it obvious to modify Petterson to return from FIG. 3 to its beginning state of the routine – FIG. 2B.

Reh’g Req. 9–10 (citing Pet. 70–71); *see also id.* at 11–12 (arguing that adequate explanation was provided for modifying Petterson in view of Nakada to “return to the beginning state of its routine (e.g., from FIG. 3 to FIG. 2B) so as to maintain battery life of the device as well as keep the user informed as to device and/or recording status.”).

Petitioner argues that

the Board overlooked Petitioner’s statement regarding returning to the beginning state of Petterson’s routine (from FIG. 3 to FIG. 2B) in view of Nakada’s return to the beginning state of its

routine, and the evidence in support of Petitioner’s arguments, including Petitioner’s Motivation to Combine section, Dr. Rosenberg’s testimony, and Dr. Rosenberg’s Technical Background section – all of which were properly cited and referenced in the relevant portions of the Petition.

Reh’g Req. 10. Petitioner also argues that it explained that Petterson “would have been modified to return to its routine’s beginning state (i.e., FIG. 2B), so as to maintain battery life of the device as well as keep the user informed as to device and/or recording status.” *Id.* (citing Pet. 49–50, 70–71; Ex. 1003 ¶ 307). Petitioner further argues that the Board overlooked the explanation that one of ordinary skill in the art “would have understood the importance of a standby or inactive state to save battery.” *Id.* (citing Ex. 1003 ¶¶ 65–76).

In Petitioner’s view, its declarant “explained in detail what the [person of ordinary skill in the art] would have understood with respect to user interface timeouts” with supporting evidence. Reh’g Req. 11 (citing Ex. 1003 ¶¶ 65–76; Ex. 1020; Ex. 1021). According to Petitioner, it “had fully and adequately explained, with evidentiary support, why a [person of ordinary skill in the art] would have found it obvious for Petterson to replace the user interface shown in FIG. 3 with the user interface shown in FIG. 2B in absence of the first criteria being met.” *Id.*

Petitioner identifies in its Request for Rehearing the argument that contended a person of ordinary skill in the art:

would have understood that, in user interface design, it would have been preferred to use the lapsing of a specific period of time to return back to FIG. 2B of *Petterson* in the absence of the first criteria being met because the [person of ordinary skill in the art] would have understood that resetting the user interface at least because of lack of interaction is suggestive that the user wants to start over.

Pet. 70–71 (citing Pet. 45–50; Ex. 1003 ¶ 382); Reh’g Req. 9–10. Petitioner also contended that “*Nakada* confirms that after 30 seconds have elapsed an error is displayed and then the system is returned to the beginning state of the routine, which in the case of *Petterson* would be FIG. 2B.” Pet. 71 (citing Ex. 1003 ¶ 382).

Another asserted overlooked argument is that a person of ordinary skill in the art “would have understood that *Petterson* could have been modified to include the change of the display as in *Nakada*, as a result of the error condition, so as to maintain battery life of the device as well as keep the user informed as to device and/or recording status.” Pet. 49–50 (citing Ex. 1003 ¶ 307).

In our Decision, we determined that Petitioner’s arguments based on *Petterson* alone for “replacing display of the second user interface with the first user interface” lacked sufficient evidentiary support. Dec. 38–39 (citing Pet. 68–69; Ex. 1003 ¶ 379). Petitioner does not dispute that determination. *See generally* Reh’g Req.

We also determined that Petitioner’s “cited portions of *Nakada* do not describe replacing one user interface with another and, instead, describes displaying an error on a display section.” Dec. 39 (citing Ex. 1011, 9:45–47); Ex. 1011, 9:54–57 (“[I]f 30 seconds have already elapsed, the microcomputer 3 determines that an accurate measurement could not be made this time and displays an error on the display section 4 (STEP S11).”).

We further determined that “Petitioner does not explain adequately why or how one of ordinary skill in the art would have understood *Nakada* to be replacing a user interface when it describes displaying an error and then turning off the display.” Dec. 39–40 (citing Pet. 70–71).

We additionally determined that Nakada’s Figure 4 “shows that, after ‘Display Error’ at S11, Nakada goes directly to ‘Power Off’ at S15” and “does not show returning from ‘Display Error’ back to ‘Initial Screen.’” *Id.* (citing Pet. 69–70; Prelim. Resp. 15–17; Ex. 1011, 9:40–10:7, Fig. 4). We quoted from Nakada that “[u]pon passage of a give[n] time after display of the error in STEP S11 and display of the measurement result in STEP S14, the display is shut down, and the power of the body fat meter is also turned off automatically (STEP S15).” *Id.* (citing Ex. 1011, 10:4–7).

Our determinations regarding Nakada did not support Petitioner’s argument that Nakada’s “system is returned to the beginning state of the routine, which in the case of *Petterson* would be FIG. 2B.” Pet. 71; Dec. 39–40. We also stated that “the proposed combination does not address adequately Nakada’s description of powering down its display.” *Id.* at 40 (citing Pet. 48–50; Prelim. Resp. 25–26; Ex. 1011, Fig. 4).

We, thus, determined Petitioner failed to show sufficiently that either *Petterson* or Nakada teaches or suggests “replacing display of the second user interface with the first user interface.” Dec. 38–41 (citing Pet. 48–50, 68–69, 70–71; Ex. 1003 ¶¶ 379, 382; Ex. 1011, Fig. 4). The “totality of the combination” lacked replacing a user interface with any other user interface. Dec. 40–41 (determining “the asserted references neither individually nor combined as proposed would have, ‘in response to detecting that the first criteria are no longer met for a second period of time that is longer than the first period of time, replac[ed] display of the second user interface with the first user interface’”); Reh’g Req. 8 (arguing “the Board overlooked the totality of the combination and Petitioner’s arguments and supporting evidence regarding the modification of *Petterson* that would have been obvious . . . in view of Nakada”).

Petitioner contends we overlooked “in view of Nakada’s disclosure of an error and powering down, thus resetting its routine, the [person of ordinary skill in the art] would have known the system is returned to a beginning state of the routine (in which the device is off, in S15 and S1).” Reh’g Req. 9. As we stated in the Decision, Nakada’s Figure 4 “shows that, after ‘Display Error’ at S11, Nakada goes directly to ‘Power Off’ at S15” and “does not show returning from ‘Display Error’ back to ‘Initial Screen.’” Dec. 39 (citing Pet. 69–70; Prelim. Resp. 15–17; Ex. 1011, 9:40–10:7, Fig. 4).

The argument in the Petition, the cited testimonial evidence, and the argument in the Request for Rehearing do not address how powering off and then powering back on to reset Nakada’s routine would teach or suggest “in response to detecting that the first criteria are no longer met for a second period of time that is longer than the first period of time, replacing display of the second user interface with the first user interface.” Pet. 69–70; Reh’g Req. 8–12; Ex. 1003 ¶¶ 65–76, 307, 382.

Resetting Nakada’s routine fails to show replacing a user interface with any other user interface. Ex. 1011, 9:45–57, 10:4–7, Fig. 4; *see also* Dec. 39 (discussing those portions of Nakada). Nakada’s display has to be powered on for any user interface to be displayed. Ex. 1011, Fig. 4. Because nothing can be displayed before the “Power On” step, there can be no replacing of one user interface for another. Dec. 39; Ex. 1011, 9:45–57, 10:4–7, Fig. 4. Petitioner, at best, relies on Nakada’s first presenting a user interface, not replacing a user interface. Pet. 70–71; Ex. 1011, 9:40–10:7, Fig. 4.

Petitioner still does not point to adequate argument and evidence that explains why one of ordinary skill in the art would have understood there is

a replacement of one user interface for another in Nakada when its display is first powered on. *See* Reh’g Req. 8–12; Ex. 1003 ¶¶ 65–76, 307, 382.

Merely arguing that Nakada’s routine is reset insufficiently addresses how one user interface is replaced by another. *See* Pet. 70–71; Reh’g Req. 8–12.

Furthermore, Nakada indicates that Petitioner’s asserted “replacing” would be in response to powering off and then on, not in response to the lapse of Nakada’s 30 seconds. Pet. 71; Ex. 1003 ¶ 382; Ex. 1011, 9:45–57, 10:4–7. Petitioner does not point to sufficient argument and evidence that explains why the asserted replacement would be in response to the asserted “second period of time,” as recited by the claim, when Nakada indicates its first user interface is presented in response to its routine being reset and the display being powered on. *See* Reh’g Req. 8–12; Ex. 1003 ¶ 382.

Moreover, the argument requires an interpretation of “replacing display of the second user interface with the first user interface,” because the argument goes beyond the plain and ordinary meaning. Such an interpretation was not presented explicitly. *See* Pet. 5, 22, 30, 33, 52–53, 61–62. As Petitioner notes, “Patent Owner pointed to a user interface that ***does not indicate*** the device is ready to detect biometric information as satisfying this element,” specifically “to turning off and turning on” for satisfying the same limitation. Reh’g Req. 12–13 (citing Pet. 33; Ex. 1023, 31–32). Because Petitioner was aware of Patent Owner’s alleged inconsistent interpretation in related litigation, Petitioner should have considered proposing an express interpretation for this proceeding. *See* 37 C.F.R. § 42.104(b)(3) (Petitioner must “[p]rovide a statement of the precise relief requested for each claim challenged,” and “[t]he statement must identify . . . [h]ow the challenged claim is to be construed.”).

2. *Patent Owner's Infringement Contentions*

Petitioner also argues that the Board “failed to address the inconsistency between Patent Owner’s arguments in District Court and in the IPR.” Reh’g Req. 12. According to Petitioner, Patent Owner contended in this proceeding that “replacing display of the second user interface with the first user interface” (“the replacing limitation”) “specifically requires replacing a user interface containing the “indication of progress” with a different user interface that “indicat[es] that [a] first electronic device is ready to detect biometric information.”” *Id.* (citing Prelim. Resp. 5, 16–17).

In the related proceeding, Petitioner contends that “Patent Owner pointed to a user interface that ***does not indicate*** the device is ready to detect biometric information as satisfying this element,” specifically “to turning off and turning on” for satisfying the limitation. Reh’g Req. 12–13 (citing Pet. 33; Ex. 1023, 31–32). Petitioner also contends that Patent Owner’s asserted first interface in related litigation for the replacing limitation is different from the first user interface asserted for a previous limitation. *Id.* at 13–14 (citing Ex. 1023, 31–32). Petitioner argues that “Patent Owner’s contrary positions are not surprising” because the accused products do not meet the replacing limitation. *Id.* at 14.

Petitioner, thus, argues that “[n]either Patent Owner nor the Board addressed this inapposite position, which, in and of itself, is an abuse of discretion.” Reh’g Req. 15 (citing Prelim. Resp.; Dec.). In Petitioner’s view, “[u]nder Patent Owner’s interpretation advanced in the Related Proceeding, the Board did not need to find that the ‘second user interface’ had to be replaced with ‘**the** first user interface’” and “[r]egardless, Petitioner’s prior art addresses this unforeseen position.” *Id.*

As we noted in our Decision, Petitioner asserted that claim terms should be given their plain and ordinary meaning and did not propose any express claim interpretation. Pet. 5; Prelim. Resp. 5 n.2; Dec. 9. We also noted that, “[i]n contending how the references disclose certain claim limitations, Petitioner provides arguments for the meaning or the scope of some claim terms based on the Specification of the ’533 patent and ‘Apple’s Preliminary Infringement Contentions.’” Dec. 9–11. We stated that “[f]or our analysis . . . , we appl[ie]d Petitioner’s understanding of” those terms. *Id.* at 11 (citing Pet. 22, 30, 33, 52–53, 61–62).

In other words, we applied Petitioner’s understanding and asserted scope of the claim terms presented for this proceeding that, according to Petitioner, were based on the ’533 patent and infringement contentions from related litigation. *See* Dec. 9–11; Pet. 52–53; Ex. 1003 ¶ 326; Ex. 1023, 14. Petitioner acknowledges that its “prior art addresses this unforeseen position” that the second user interface did not need to be replaced with the first user interface. Reh’g Req. 15.

Moreover, Petitioner quotes from page 33 of the Petition to support the contention that “Patent Owner points to turning off and turning on as satisfying [the replacing limitation].” Reh’g Req. 12–13 (citing Pet. 33; Ex. 1023, 31–32). The Preliminary Infringement Contentions appear to indicate that Patent Owner points to an asserted biometric sensor, not the device with the display, that turns off after a certain time. *See* Ex. 1023, 31 (“When the *KardiaMobile Card* automatically shuts off, the *Kardia App* on the first electronic device displays the first user interface”) (emphases added).

Because Petitioner presented arguments that were asserted to address Patent Owner’s inconsistency, we did not see a need to address an issue

Petitioner already took into consideration. *See also* Reh’g Req. 15 (arguing “Petitioner’s prior art addresses this unforeseen position as was described above.”). Also, as discussed above, we determined that neither Petterson nor Nakada teaches or suggests replacing a second user interface with any other user interface, regardless of whether or not it was the asserted “first user interface.” Dec. 38–39 (addressing Pet. 68–69; Ex. 1003 ¶ 379; Ex. 1011, 9:45–57).

III. CONCLUSION

For the reasons above, Petitioner has not shown that we abused our discretion in denying the Petition. Accordingly, the Request for Rehearing is denied.

IV. ORDER

In consideration of the foregoing, it is hereby:

ORDERED that Petitioner’s Request for Rehearing is *denied*.

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