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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

TELADOC HEALTH, INC.,

PETITIONER,

V.

DATA HEALTH PARTNERS, INC.,

PATENT OWNER.

Case No. IPR2024-00616
U.S. Patent No. 11,144,554

PATENT OWNER'S SUR-REPLY TO PETITIONER'S REPLY

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I. ARGUMENT

A. All Grounds: Petitioner does not allege Douglas discloses a “plan of action” separate from the “goals” and “thresholds” (all claims)

1. Claim construction

Petitioner blatantly mischaracterizes the POR, which never “advocat[ed] a *per se* rule that separately listed claim elements must always be construed as separate and distinct components,” (Reply, 4) but instead recited the well-settled principle that “[w]here a claim lists elements separately, as done here, there is ‘a presumption that those components are distinct.’” (POR, 11 (citing *Barrday, Inc. v. Lincoln Fabrics Inc.*, No. 2022-1903, 2023 WL 7871688, at *4 (Fed. Cir. Nov. 16, 2023) (quoting *Kyocera Senco Indus. Tools Inc. v. Int’l Trade Comm’n*, 22 F.4th 1369, 1382 (Fed. Cir. 2022)).) Indeed, it is Petitioner whose position contravenes binding Federal Circuit precedent by arguing—falsely—that “claim elements are not separate and distinct **unless required by both the claim language and specification.**”¹ (Reply, 6.) Not so.

Petitioner makes much of its reliance on a case “which postdates all of the caselaw relied upon by PO.” (Reply, 5 (citing *Google LLC v. EcoFactor, Inc.*, 92 F.4th 1049 (Fed. Cir. 2024).) However, less than two months ago, the Federal Circuit set forth a virtual treatise on this topic. Specifically, in *Regeneron*, the Federal Circuit explained that the first step in a case such as this is to “evaluate[]

¹ All emphases added unless otherwise indicated.

the applicability and effect of the claim construction principle, reiterated in *Becton*, that explains “[w]here a claim lists elements separately, the clear implication of the claim language is that those elements are distinct components of the patented invention.” *Regeneron Pharms., Inc. v. Mylan Pharms. Inc.*, 130 F.4th 1372, 1377 (Fed. Cir. 2025) (citations omitted). Petitioner has not disputed that a “plan of action,” “goals,” and “thresholds” are separately recited in each of the Challenged Claims. (*See* Reply, 4-9.)

Contrary to Petitioner’s argument, the Federal Circuit explained that the next step is to “consider[] whether the evidence overcame ‘the clear implication’ of separateness under *Becton*.” *Regeneron*, 130 F.4th at 1377. This is the inverse of what Petitioner argues when it faults PO for allegedly having “included no intrinsic evidence that the goals, plan of action, and thresholds should be separate and distinct, other than two sentences in the Abstract.” (Reply, 4-5.) In other words, the *Becton* presumption exists—regardless of what evidence PO put forth—absent *Petitioner* providing evidence to “overc[o]me ‘the clear implication’ of separateness under *Becton*.” *Regeneron*, 130 F.4th at 1377.

Petitioner’s arguments that the goals, plan of action, and thresholds are not distinct in the specification are similarly unavailing. Indeed, the only “evidence” that Petitioner points to in the specification is a misquotation of claim 7 which recites “establishing the goals and the plan of action for the client using goal

creating and tracking software, wherein the data, goals, plan of action, compiled data, and thresholds are associated with the account of the client.” (Ex. 1001, claim 7.) Contrary to requiring that the plan of action include goals as Petitioner argues, claim 7 treats the goals and plan of action as separate items to be established using goal creating and tracking software—not a single item that can be pointed to as both the goals and plan of action as in the Petition.

Petitioner then attempts to create a false dichotomy, arguing that “plan of action” cannot be construed as being “wholly distinct” from the “goals” and “thresholds” because the claims recite that “the plan of action” is modified “in response to one or more thresholds not being met.” (Reply, 7.) This is not the standard the Federal Circuit has set forth. It will almost always be the case that separately-listed elements in a claim will be related in some way—this is why they appear in the same claim. The “separateness under *Becton*” that the Federal Circuit describes has nothing to do with being “wholly distinct” as Petitioner argues, but instead is where two separately listed elements cannot “coexist as the same element”; these elements, instead, have distinct and identifiable boundaries. *See Willis Elec. Co., Ltd. v. Polygroup Macau Ltd. (BVI)*, 777 F. App’x 495, 498–99 (Fed. Cir. 2019) (affirming the Board’s construction applying *Becton* separateness where the claim recites an “inner void” of a tree trunk section “comprising a female end having a channel void,” such that the “inner void” and “channel void”

cannot “coexist as the same element” and “properly construing ‘channel void’ thus requires determining the physical boundaries of the female end.”); *Becton, Dickinson & Co. v. Tyco Healthcare Grp., LP*, 616 F.3d 1249, 1253–54 (Fed. Cir. 2010) (reversing construction of a “spring means connected to said hinged arm for urging said guard along said needle cannula” where the construction failed to “require a spring means that was a distinct structural element from the hinged arm.”); *Comcast Cable Commc'ns, LLC v. Promptu Sys. Corp.*, 838 F. App’x 551, 553 (Fed. Cir. 2021) (affirming the Board’s construction that “a speech recognition system coupled to a wireless node” requires “that the ‘speech recognition system’ and ‘wireline node’ be distinct elements,” even though they are coupled together). As shown in the POR and above, the ’554 patent does not contain a single example of the goals, plan of action, and/or thresholds coexisting as a single element, and so the *Becton* presumption stands.

Finally, Petitioner argues that “the cases relied upon by PO all involve claims with unequivocal and/or unambiguous language that require separate and distinct structural elements, as confirmed by explicit language in the specification,” or claims that “would be rendered nonsensical” without *Becton* separateness. (Reply, 5-6.) This is false and is not the standard the Federal Circuit set forth in *Regeneron*, which **applies the *Becton* presumption unless** there is evidence to “overc[o]me ‘the clear implication’ of separateness under *Becton*.” *Regeneron*, 130

F.4th at 1377. There is no requirement of evidence—whether “unequivocal and/or unambiguous” or not—needed to support the *Becton* presumption. *See Kyocera*, 22 F.4th at 1382–83 (applying *Becton* separateness even though the written description contained two embodiments, one of which was not claimed when applying *Becton* separateness); *Barrday*, 2023 WL 7871688, at *6 (applying *Becton* separateness even though “there is an alternative embodiment disclosed that is not encompassed” by the construction applying *Becton* separateness); *Comcast*, 838 F. App’x at 553 (applying *Becton* separateness to a “speech recognition system” and “wireless node” when the specification “contains an embodiment where a speech recognition system is ‘in’ a wireline node, [but] also describes an embodiment with a speech recognition system ‘near’ a wireline node.”).

2. The Petition conflates goals, thresholds, and a plan of action

As the POR established, the Petition identified Douglas’s “overall therapeutic program” as allegedly disclosing the claimed “plan of action,” and acknowledged that the alleged “goals” and “thresholds” are included in this “overall therapeutic program.” (POR, 18-21; Petition, 25-26, 29, 33, 37.)

Recognizing that this claim mapping is problematic under the Federal Circuit precedent of *Becton* separateness discussed above, Petitioner now attempts to conflate “weight loss” with its identified plan of action. But “[s]hifting arguments

in this fashion is foreclosed by statute, [Federal Circuit] precedent, and Board guidelines.” *Wasica Fin. GmbH v. Cont’l Auto. Sys., Inc.*, 853 F.3d 1272, 1286–87 (Fed. Cir. 2017).

Indeed, even on Reply, Petitioner admits that “the Petition states that ‘the claimed plan of action is met by Douglas’s overall ‘therapeutic program’” (Paper 1 at 25-26) and the therapeutic program (plan of action) provides for weight loss...and dietary improvements.’ *Id.* at 23-24.” (Reply, 2.) This argument and citation prove PO’s point. On pages 25-26, the Petition maps “plan of action” to Douglas’s “**overall therapeutic program**,” but then on pages 23-34, the Petition maps “weight loss...and dietary improvements” to Douglas’s “**goals 52**, ‘one month goals 61,’ and ‘final goals 62’ for, e.g., weight loss, smoking cessation, reduction of alcohol consumption, and dietary improvements.” (Petition, 23-26.) Thus, under Petitioner’s mapping of Douglas to the claims, goals such as weight loss are wholly consumed by the overall therapeutic program—of which they are a part. Under Petitioner’s mapping, therefore, goals and a plan of action are not separate elements.

Had the Petition identified a “plan of action” as “moving the patient from their current status to the claimed goals” as Petitioner’s expert attempted to do for the first time at deposition (Ex. 2006, 24:5-26:1), then the plan of action would be separate from the claimed goals. However, Petitioner—as master of its own

Petition—erroneously mapped “plan of action” to Douglas’s “overall therapeutic program,” and then admitted that this “overall therapeutic program” includes the claimed goals and thresholds, such that the elements are not distinct as the law requires here. As such, Petitioner’s argument must fail as to all Challenged Claims and Grounds. *See In re Magnum Oil Tools*, 829 F.3d 1364, 1381 (Fed. Cir. 2016) (IPRs are “a system that is predicated on a petition followed by a trial in which the petitioner bears the burden of proof. Given that framework, we find no support for the PTO’s position that the Board is free to adopt arguments on behalf of petitioners that could have been, but were not, raised by the petitioner during an IPR.”).

B. All Grounds: Petitioner fails to provide evidence of “assign[/ing] the client to one or more of providers in response to selections from the administrator, wherein the one or more providers include at least individuals available to treat or assist the client” (all claims)

Petitioner still fails to identify where Douglas discloses assigning clients to providers *in response to* selections from the administrator. (*See* POR, 26-28.)

Boiled down, Petitioner’s arguments are as follows: (1) “assignment” of the client to a provider is satisfied by the administrator’s “entering the patient prescription form” into Douglas’s system; and (2) the inputs of information from the prescription form (e.g., by “double tapping”) by the case administrator are the claimed “selections.” (Petition, 16-17; Reply, 10-11.) But if the entry of the patient

prescription form by the administrator into Douglas’s system is both “assigning” and “selecting,” one cannot be done “in response to” the other as the claims require.

Again, this argument defies both reason and established Federal Circuit case law, which Petitioner ignores altogether. (*See* POR, 26-28; Reply, 11-12.) Instead, Petitioner insists that the Petition maps “‘selections from an administrator’ to the act in Douglas of the ‘case administrator set[ing] [sic] up the patient on Douglas’s system by entering the information contained in the patient prescription form’” and then “[s]*eparately*...maps ‘assignment...to one or more providers in response to selections from an administrator’ to the assignment resulting from such selections.” (Reply, 11-12 (citing Petition, 15-17).) But this is false and notably not a quotation to any portion of the Petition. There is no independent “assignment resulting from such selections” identified in either Douglas or the Petition.

Indeed, the Petition expressly identifies the “assignment” as the same entry of the patient prescription form, stating that “a POSITA would have understood Douglas’s disclosure of the administrator *entering this patient-physician information from the patient prescription form to be disclosure of the administrator’s assignment of the patient to the physician within Douglas’s system.*” (Petition, 16.) Petitioner cannot now run from its Petition to improperly and belatedly attempt to distinguish between “selections” and “assignment,”

particularly when there is nothing it could point to in Douglas as any separate or independent assignment, anyway.

Further, Petitioner’s argument ignores the fact that the “prescription form” identified in Figure 2 merely represents a paper form that does not, itself, allow the administrator to make any “selection,” even if “double tapping” could be found to be a “selection.” (Douglas, Fig. 2 (“FAX THIS FORM TO SALUS MEDIA”); *see also id.*, 6:36-10 (describing the physician “***circling*** the appropriate response in field 30” and “***circles or fills in*** desired 3-month targets”) (emphasis added).) Douglas generally discloses that the case administrator “sets up a new patient based on information” in the prescription form but does not describe that process or identify any fields allowing an administrator to make any “selection” other than to generally show patient folders in Figure 3. (*See id.*, Fig. 3, 7:11-16.)²

In sum, this argument is more than a hindsight stretch of Douglas’s disclosure; it is a distortion of it. Petitioner must convince the Board to agree not only that Douglas’s administrator’s entry of the paper prescription form filled out

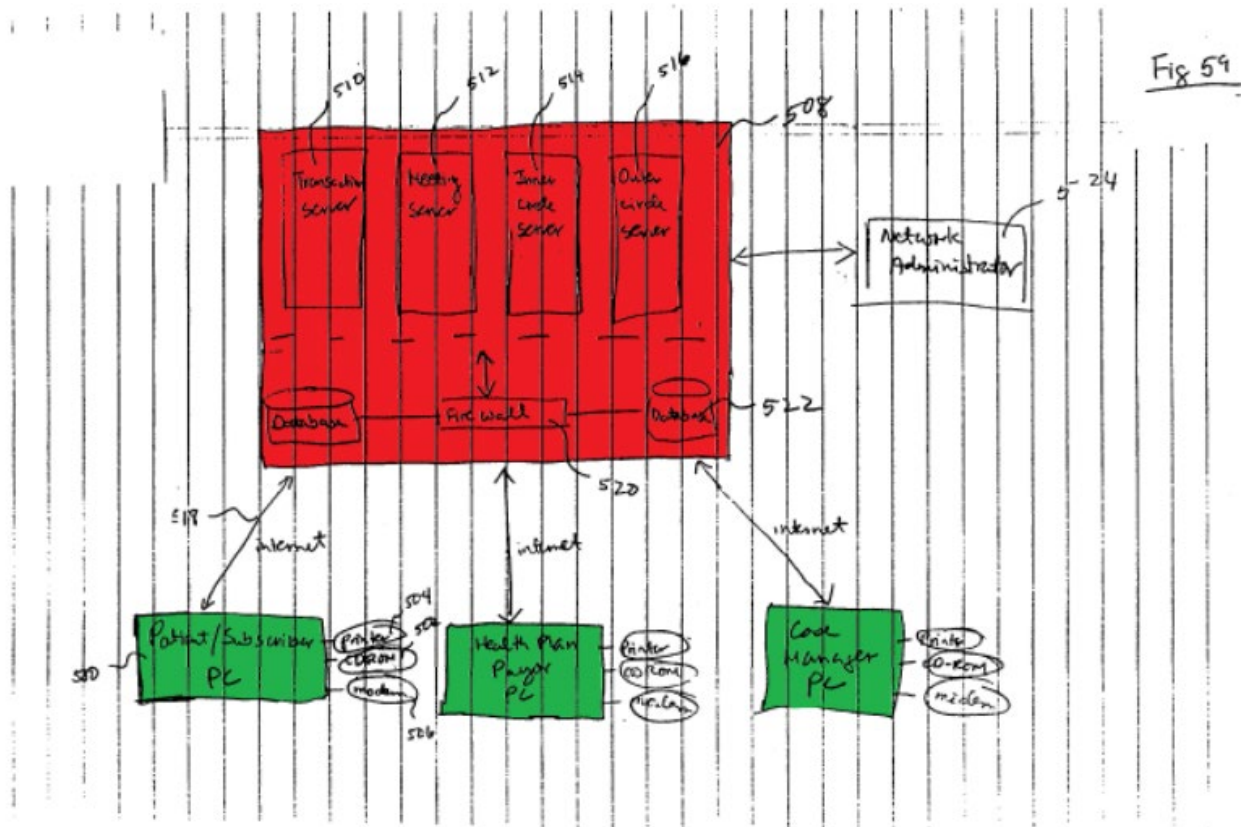
² Petitioner relies on an obviousness argument to transform Douglas’s paper prescription form into graphical user interface components, which Patent Owner rebutted. (*See* Petition, 17-21; POR, 28-31.) Petitioner does not substantively address Patent Owner’s rebuttal. (*See* Reply, 12.)

by a physician is “assignment” of a physician (ignoring the plain language of that term), that such entry—which is not actually described in Douglas—is also “selections” (ignoring the plain language of that term), and, critically, that Petitioner can point to the same act for both limitations despite established Federal Circuit case law prohibiting doing so, as well as the claim language requiring one to be done “in response to” the other. The Petition fails here.

C. All Grounds: Petitioner’s Inconsistent Allegations for Claims 6 and 13

Claims 6 and 13 each require that the client management program is executed by different devices: claim 6 requires that the “client management program is executed by the computing or communications devices,” whereas claim 13 requires that a “server includes a processor that executes a client management program.” (Ex. 1001, claims 6, 13.) Petitioner’s challenges to both claims 6 and 13 both rely upon Douglas, for which Petitioner alleges that “[a] POSITA would have understood that Douglas’s compliance monitoring and feedback system resided on Douglas’s network server 508 and so did the processor that executed it.” (Petition, 41.)

However, Petitioners allege that in the Douglas-Chitiveli System, “a client management program is executed by the computing or communications devices” because Douglas’s “PCs 500 [green] used by physicians to transmit patient data to the network server [red] ... would have done so using a client application like Chitiveli’s [sic] analytics client 140,” where “[s]uch client applications disclose the claimed client management program,” as shown in Douglas’s Figure 59, below (Petition, 62.) Not so.



As shown in Chitiveli’s Figure 1, below, Chitiveli, like Douglas, discloses a server (red) that executes its program—the content analytics tool (blue)—and the

analytics client yellow) contained on the client computer system (green) merely communicates to the content analytics tool on Chitiveli's server through the cloud network 120. (See Ex. 1004, [0035]-[0037], [0043] (client computer system executes only the analytics client or web browser used to log in, whereas actual functions of the program, including the analytical processing, generating of reports on the analyzed data to monitor progress on issues, and dynamically generating reports as new data is provided, is performed by the content analysis tool 110, which resides on the server).

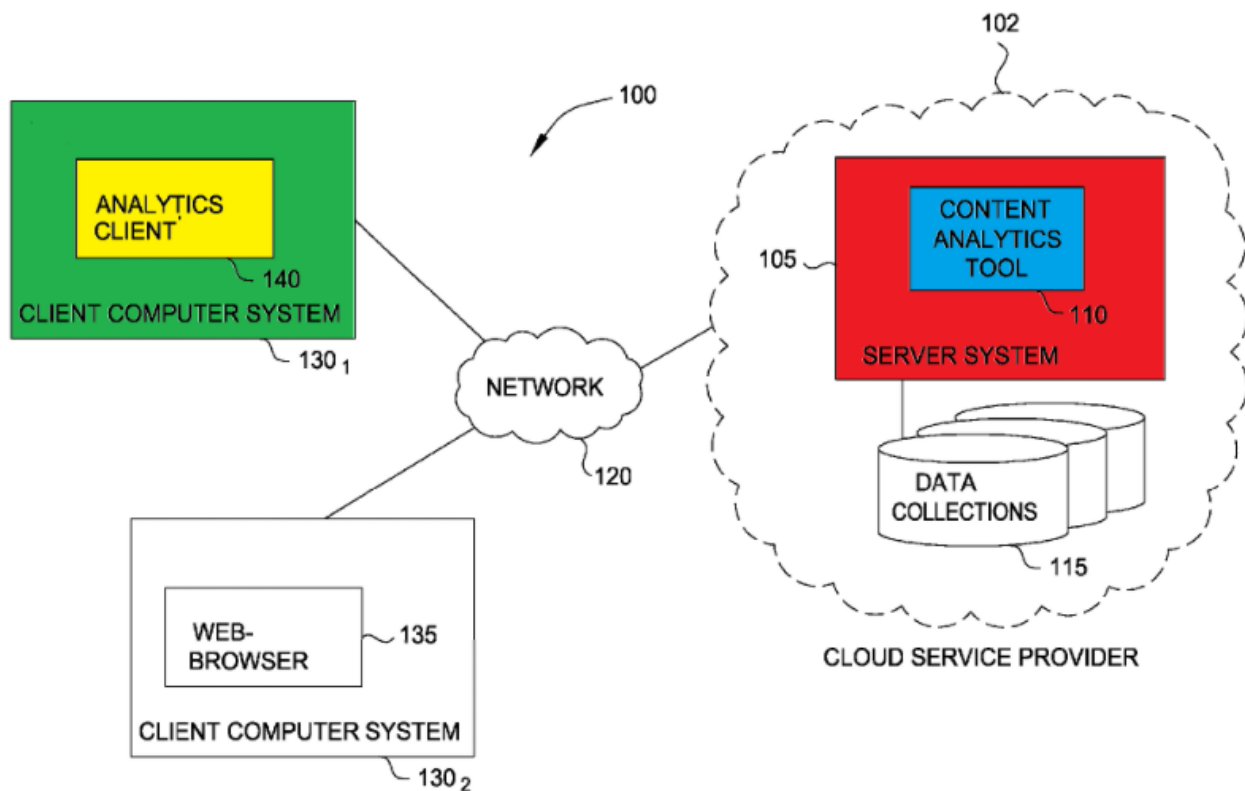


FIG. 1

Thus, Petitioner's reliance on Douglas's combination with Chitiveli does nothing to remove the execution of the claimed client management program from the server, as Petitioner alleges is the case for Douglas. In sum, Petitioner cannot be right that Douglas and the similarly functioning Douglas/Chitiveli combination discloses execution of the client management program on both the server as claim 5 requires and on the computing or communication devices as claim 13 requires.

Additionally, Petitioner's argument on Reply that its arguments are not inconsistent because claims 6 and 13 are not related by dependency misses the point. The disclosures of Douglas and Chitiveli are not impacted by the language of claims 6 and 13, and the Board has consistently refused to credit arguments that inconsistently map the elements of the prior art to different claim elements. *See ZTE (USA) Inc. v. Fundamental Innovation Sys. Int'l LLC*, IPR2018-00274, Paper 34 at 17 (PTAB Aug. 29, 2018) (holding that "Petitioner fails to establish that the [claimed] combination renders obvious" a claim limitation "because, *inter alia*, the combination deviates from standard USB signaling, thus contradicting Petitioner's reasoning" elsewhere in the Petition); *Apple Inc. v. Zentian Ltd.*, IPR2023-00037, Paper 34 at 31 (PTAB June 11, 2024) (finding no challenged claims unpatentable where Petitioner's contention "that to perform speech recognition, the processors in each cluster would not need to access the memories of the other clusters" "is inconsistent with Petitioner's contention that '[o]nce the cumulative probability

score is calculated, inter-cluster processing of the results for each tree search would be communicated.”); *see also Ultratec, Inc. v. CaptionCall, LLC*, 872 F.3d 1267, 1272–73 (Fed. Cir. 2017) (noting that it would “be in the interest of justice to consider sworn inconsistent testimony on the identical issue,” which “would be highly relevant to both the Board’s analysis of the specific issues on which [the expert] gave inconsistent testimony and to the Board’s overall view of his credibility.”).

D. Grounds 1-2, 5-8: Petitioner fails to provide evidence that Douglas discloses “a database in communication with the server configured to store the data, goals, plan of action, compiled data, and thresholds with the account associated with the client and the one or more providers” (claims 13-16)

The law is clear that an “IPR petition[] must provide an understandable explanation of the element-by-element specifics of the patentability challenges, including the identification of particular portions of prior art on which the petitioner is relying.” *Corephotonics, Ltd. v. Apple Inc.*, 84 F.4th 990, 1001–02 (Fed. Cir. 2023).

Although claim 13 requires “a database in communication with the server,” the Petition merely alleged “that network server 508 *includes* ‘one or more relational databases 522,’” but never alleges that network server 508’s inclusion of relational database 522 requires that database 522 is “*in communication*” with server 508. (Petition, 47 (citing Bergeron, ¶109), 57.) On Reply, Petitioner relies

on an unexplained citation to Douglas 24:28-37, which states that “[t]he servers 510-516 have access to one or more relational databases 522.” Petitioner’s argument fails for at least two reasons.

First, a server having access to a database does not mean it actually communicates with that database as claim 13 requires, and the Petition provided no evidence to the contrary. **Second**, Petitioner’s attempt to provide this evidence on Reply is improper and should be stricken, as “the expedited nature of IPRs bring with it an obligation for petitioners to make their case in their petition to institute,” such that Petitioners cannot “cure the petition’s deficiencies in its subsequent briefing to the Board.” *Wasica*, 853 F.3d at 1286 (quoting *Intelligent Bio-Sys., Inc. v. Illumina Cambridge Ltd.*, 821 F.3d 1359, 1369 (Fed. Cir. 2016).)

E. Grounds 1-2, 5-8: Petitioner fails to provide evidence that Douglas discloses “a processor for executing a set of instructions” (claims 17-20)

Although Claim 17 requires “a processor for executing a set of instructions,” Petitioner failed to provide *any* explanation as to why Douglas allegedly “discloses or renders obvious a processor within network server 508 for executing a set of instructions for implementing Douglas’s system.” (Petition, 48.) Instead, on Reply, Petitioner relies on its citation to its discussion of Limitation 13[a]—which notably says nothing about “a processor for executing a set of instructions”—and that discussion’s citation to Douglas, 25:22-26 as support for the statement that

“Douglas’s system is software and therefore a processor executes the system.” (Reply, 14.) From this citation, Petitioner now asks the Board to credit a new argument not contained in the Petition—that this citation to Douglas also “makes clear that its ‘system is constructed using the C++ programming language’” such that “Douglas discloses a processor executing a set of instructions, as its system is constructed using the C++ programming language, which is used to generate the set of instructions, as would be understood by a POSITA.” (Reply. 14.) This could not be further from the “understandable explanation of the element-by-element specifics of the patentability challenges, including the identification of particular portions of prior art on which the petitioner is relying,” that the Petition requires. *Corephotonics*, 84 F.4th at 1001–02. Indeed, the Federal Circuit has held that “the Board is not permitted to entertain ‘[s]hifting arguments’ but must, instead, reject any ‘entirely new theory of *prima facie* obviousness absent from the petition,’ if the petitioner attempts to inject such a theory into the proceeding post-petition.” (*Id.*, 1002 (quotation omitted).)

Even worse, Petitioner for the first time attempts to support this knowledge of a POSA with a supplemental declaration. (*Id.* (citing *Bergeron* Supp, ¶¶14-19).) This is the epitome of impermissible new evidence submitted on Reply for the purpose of establishing the *prima facie* case Petitioners were required to have made in the Petition. (See U.S. Patent Trial and Appeal Board, Consolidated Trial

Practice Guide, 73-75 (Nov. 2019) (“**Petitioner may not submit new evidence or argument in reply** that it could have presented earlier, e.g. **to make out a prima facie case of unpatentability**. ... Examples of **indications that a new issue has been raised in a reply include new evidence necessary to make out a prima facie case** for the patentability or unpatentability of an original or proposed substitute claim, such as newly raised rationale to combine the prior art references that was not expressed in the petition. *See Intelligent Bio-Sys.*, 821 F.3d at 1369–70 (holding that the Board did not err in refusing the reply brief as improper under 37 C.F.R. § 42.23(b) because petitioner relied on an entirely new rationale to explain why one of skill in the art would have combined the references at issue). It is also **improper for a reply to present new evidence (including new expert testimony) that could have been presented in a prior filing, for example newly cited prior art references intended to “gap-fill” by teaching a claim element that was not present in the prior art presented with the petition.**”).) As such, the Board should not consider this evidence and Patent Owner requests that it be stricken from the record and from the Reply. *See Intelligent Bio-Sys.*, 821 F.3d at 1369 (“Once the Board identifies new issues presented for the first time in reply, neither this court nor the Board must parse the reply brief to determine which, if any, parts of that brief are responsive and which are improper. As the Board noted,

‘it will not attempt to sort proper from improper portions of the reply.’” (quotation omitted).)

F. Grounds 1-2: Petitioner fails to provide evidence of “determining whether the data required is received from each of the providers” or “sending an alert to one or more providers in response to determining there is missing data for one or more clients associated with the one or more providers” (claim 10)

Petitioner’s Reply sidesteps the central issues Patent Owner raised concerning claim 10. Faced with clear and specific arguments that Douglas neither discloses nor suggests (1) determining whether the required data is received from each provider, nor (2) sending alerts based on a finding of missing data, Petitioner gestures vaguely at Douglas’s disclosure of acceptance of updated data *from the patient*—without ever bridging the conceptual or evidentiary gap required to establish the claimed “determination” and data-specific “alerts.” (Reply, 18-20.) That is because it cannot; Douglas simply does not teach or suggest what the claims require.

For example, alleging that Douglas discloses “receiving updated data, from one or more providers” does not establish whether it discloses “whether the data required is received from *each of the providers*.” (Reply, 19.) Petitioner also ignores the permissive nature of even that cited disclosure in Douglas, which makes clear that the system “*accepts*” additional patient data, and that the physician “*may*” input additional data into the system. (Douglas, 11:1-5.)

Receiving updated patient data is permitted but not required. *See id.* Petitioner points to nothing in Douglas that suggests otherwise.

Petitioner also suggests that because Douglas “correlates the patient’s input with the physician’s to check for accuracy” and “provides the physician with reports of patient progress,” the system must necessarily determine whether required data is missing. (Reply, 19.) But that inference stretches Douglas beyond its disclosure. The fact that Douglas compares *available* data for accuracy does not mean it makes any determination about whether all required data has been received from each provider. Indeed, Douglas offers no indication that it tracks provider-specific data completeness, nor that it triggers alerts in response to missing entries—let alone alerts targeted to individual providers based on such determinations. (POR, 47-51.) And as made clear in the POR, Petitioner’s attempt to overcome this failure with conclusory expert testimony that merely tracks the Petition with no support is unavailing. (POR, 50-51; *Xerox Corp. v. Bytemark, Inc.*, IPR2022-00624, Paper 9 at 15 (PTAB Aug. 24, 2022) (precedential) (denying institution where the expert’s declaration “merely repeats, verbatim, the conclusory assertion for which it is offered to support” and “does not cite to any additional supporting evidence or provide any technical reasoning to support his statement. Thus, the cited declaration testimony is conclusory and unsupported, adds little to

the conclusory assertion for which it is offered to support, and is entitled to little weight.”.)

G. Grounds 4, 6, 8: Petition failed to identify proposed combinations of Douglas/Wager/Chitiveli (claim 6), Douglas/Wager/Klotsche (claims 11, 16, and 19), or Douglas/Wager/Koh (claims 8, 14, and 20)

Petitioner argues that because “PO does not dispute that the Douglas-Chitiveli System is sufficiently disclosed for Ground 3 regarding the implementation of Douglas using a cloud and client architecture of Chitiveli,” PO was supposed to miraculously divine that “Ground 4 simply takes the Douglas-Wager System of Ground 2 and adds Chitiveli to Douglas in the same way recited for Ground 3.” (Reply, 21.) Similarly, Petitioner argues that because “PO does not dispute that Ground 5 and 7 are sufficiently disclosed,” it is irrelevant that the Petition never explained that “Petitioner is simply taking the Douglas-Wager System of Ground 2 and adding Klotsche for Ground 6 and Koh for Ground 8 in the same way that Douglas is modified by Klotsche in Ground 5 and by Koh in Ground 7.” (Reply, 21-22.)

But these belated explanation of the specifics of Petitioner’s proposed Douglas/Chitiveli/Wager, Douglas/Klotsche/Wager and Douglas/Koh/Wager combinations are wholly absent from the Petition—where they were statutorily required to be. *See Intelligent Bio-Sys.*, at 1369 (“It is of the utmost importance that petitioners in the IPR proceedings adhere to the requirement that the initial petition

identify ‘with particularity’ the ‘evidence that supports the grounds for the challenge to each claim...[T]he expedited nature of IPRs bring[s] with it an obligation for petitioners to make their case in their petition to institute. While the Board’s requirements are strict ones, they are requirements of which petitioners are aware when they seek to institute an IPR.”) Indeed, Petitioner’s citations to a supplemental declaration from its expert, rather than to the Petition—as evidence of its proposed combination—proves PO’s point. (Reply, 21 (citing BergeronSupp, ¶¶37-47).) For this reason, Petitioners inadequately disclosed combinations must fail. *See Live Power Intelligence Co. NA, LLC v. Genscape Intangible Holding, Inc.*, IPR2019-00169, Paper 7 at 13-14 (PTAB June 7, 2019) (“Our role is not to remedy the deficiencies in Petitions that fall short.”).

H. Grounds 2, 8: A POSA would not have been motivated to combine Douglas with Wager (all claims)

Petitioner claims that PO has not addressed its argument that “incorporating the interface of Wager [into Douglas] would have helped ensure that the assigned physician was equipped with the proper skill set to treat the patient.” (Reply, 15.) Not so. Petitioner ignores the fact that in support of this argument, it alleged that the purpose of this incorporation was to “make appropriate provider-to-patient assignments.” (Petition, 54.) But as the POR discussed in detail, a POSA utilizing Douglas would have been subscribed into the system by their own physician and so would not need or desire further provider assignments. (POR, 37-45.)

Petitioner then doubles down on its argument that Douglas’s “Fig. 57 clearly shows that different physicians in the same specialty have different caseloads” such that Wager would “help ensure a physician has the capacity to treat a patient and is not overloaded,” despite the fact that Petitioner’s own expert admitted this is factually incorrect. (Reply, 15.) Petitioner falsely claims that its argument about Douglas’s Figure 57 is “confirmed by PO’s expert,” but Petitioner’s citation to Dr. Ardehali’s deposition transcript never mentions Douglas, much less its paragraph 57. (Reply, 15 (citing Ex. 1024, 110:14-112:6).) Yet in another portion of his deposition, Dr. Ardehali reiterates what Petitioner’s own expert stated: Douglas’s Figure 57 says nothing about a physician’s total caseloads, but only that the two listed cardiologists have different year-to-date (not current) coronary artery disease cases—without providing any information about the physician’s total caseloads, much less current caseloads, and so say nothing about any physician being overloaded. As the POR discusses, Petitioner’s own expert confirmed the inaccuracy of Petitioner’s Reply. (Ex. 2006, 63:14-64:11; POR, 37-40.)

Petitioner then continues to ignore the evidence that a POSA would not have looked to the “automatically generated” assignments of Wager to fill any patient provider need, but would have instead looked to the personalized referrals provided by a patient’s primary care provider. (Ex. 2003, 7 (“GPs are key to the future...because they are trusted by their patients....trust reinforced through

continuity of care directly improves healthcare outcomes. In order to deliver effective primary care GPs need to be expert generalists. Each consultation has exceptional power to manage healthcare costs, for example when the effective management of disease risk is negotiated, and when prescribing and **referral decisions** are made....They also manage the uncertainty inherent in the early presentation of health problems by arranging expectant care. In addition, GPs act as gatekeepers for the patients' entry into more specialised care, using their expertise to direct patients to where they will receive the most benefit at the right time. GPs understand the complex set of circumstances that accompany individuals and their healthcare history. It is through their professional training and a relationship built on trust and continuity that GPs act as gatekeepers to other NHS services. This saves the NHS money by preventing wasted out-patient assessments, unnecessary investigations and hospital admissions.”) (citation omitted).

Petitioner finally argues, without support, that Douglas/Wager “automatically generated” assignments would have had the advantage of “prompt care,” but the evidence shows the opposite to be true. (*See* Ex. 2003, 17 (“There may also be a problem when many doctors are involved. Those without a continuing relationship with a patient may assume that the usual doctor knows about, and will deal with, aspects of long-term care, when in fact no one takes responsibility for any action until it becomes urgent. This has been called the

Collusion of Anonymity and it still causes deaths.”), 19 (“Her GP...sent photographs of the rash with the **referral letter** and, **on the strength of that**, Catherine was **seen urgently** by a dermatologist.”) (emphasis added).)

I. Grounds 7, 8: A POSA would not have been motivated to combine Douglas and Koh (claims 8, 14, and 20)

When pressed to identify a specific reason why a POSA would combine Douglas with Koh, Petitioner’s Reply still only points generically to the patient health data generated by Douglas’s system and Koh’s aspirational statements that data mining could be developed to identify effective treatments and best practices, without specifying how. (Reply, 22-23 (quoting Koh, 65); *see also* Koh, 66 (“There is vast *potential* for data mining applications in healthcare.”); *see id.* (“Data mining applications *can be developed* to evaluate the effectiveness of medical treatments.”); *see id.* (“To aid healthcare management, data mining applications *can be developed* to better identify and track chronic disease states and high risk patients, design appropriate interventions, and reduce the number of hospital admissions and claims.”) (emphasis added).) Petitioner then summarily concludes that “there is clear motivation to combine Douglas and Koh so that Douglas’s copious data is mined based on Koh’s teachings.” (*Id.*) But motivation to combine requires an articulated explanation with a rational underpinning. *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 418 (2007). Petitioner provides neither.

Petitioner also does not identify any “teachings” from Koh that provide the limitations that Petitioner claims it supplies. Koh’s generic references to data mining applications do not disclose any particular methods or motivations for individualized feedback or integration into a compliance system such as Douglas’s. (See Koh, 65-66.) Petitioner accuses Patent Owner of ignoring the “details of the combination of Douglas and Koh in the Petition” but then does not identify any such details. (Reply, 22.) Indeed, the proposed “Douglas-Koh system” described in the Petition is just Douglas, modified to generically use data mining to perform the limitations of claims 8, 14, and 20. (See Petition, 70-71.) There are no specific features, details, or aspects of Koh that are incorporated into the proposed “system”—it is merely a functional rewriting of Douglas with the benefit of hindsight.

Petitioner waves away the failure of proof arguments made in the POR that detail the deficiencies in Petitioner’s proof for claims 8, 14, and 20. (Reply, 23.) Petitioner’s assertion in the Petition that data mining would be used to “identify...a therapeutic plan for a patient comes nowhere close to alleging—much less establishing—that Douglas discloses “recommending the best practices to providers *in response to* the best practices being associated with a client assigned to the one or more providers.” (Ex. 1001, claim 8 (emphasis added).)

II. CONCLUSION

For these reasons, Patent Owner respectfully requests the Board confirm that the Challenged Claims of the '554 patent are patentable.

Dated: May 9, 2025

Respectfully Submitted,

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CERTIFICATE OF WORD COUNT

Under the provisions of 37 CFR § 42.24(d), the undersigned hereby certifies that the Microsoft Office word count for the foregoing Patent Owner's Sur-Reply to Petitioner's Reply, excluding the table of contents, table of authorities, certificate of word count, and certificate of service, totals 5,543 words, which is less than the 5,600 words allowed under 37 C.F.R. § 42.24(c)(4).

Dated: May 9, 2025

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CERTIFICATE OF SERVICE

The undersigned certifies that on this 9th day of May, 2025, the foregoing document is being served by e-mail on counsel of record for Petitioner as follows:

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