

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

TELADOC HEALTH, INC.,
Petitioner,

v.

DATA HEALTH PARTNERS, INC.,
Patent Owner.

IPR2024-00617
Patent 11,151,142 B2

Before ROBERT J. WEINSCHENK, SHARON FENICK, and
ANDREAS BALTATZIS, *Administrative Patent Judges*.

WEINSCHENK, *Administrative Patent Judge*.

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

I. INTRODUCTION

A. *Background and Summary*

Teladoc Health, Inc. (“Petitioner”) filed a Petition (Paper 1, “Pet.”) requesting an *inter partes* review of claims 1–7, 9–14, 16–18, and 20 (“the challenged claims”) of U.S. Patent No. 11,151,142 B2 (Ex. 1001, “the ’142 patent”). Data Health Partners, Inc. (“Patent Owner”) filed a Preliminary Response (Paper 6, “Prelim. Resp.”) to the Petition.

An *inter partes* review may not be instituted unless “the information presented in the petition . . . and any response . . . shows that there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.” 35 U.S.C. § 314(a). Further, when instituting an *inter partes* review, we “will authorize the review to proceed on all of the challenged claims and on all grounds of unpatentability asserted for each claim.” 37 C.F.R. § 42.108(a). Here, Petitioner demonstrates a reasonable likelihood of prevailing in showing that at least one of the challenged claims is unpatentable. Thus, we institute an *inter partes* review of the challenged claims on all the grounds of unpatentability in the Petition.

B. *Real Parties in Interest*

The parties identify themselves as the only real parties in interest. Pet. 1; Paper 4, 1.

C. *Related Matters*

The parties indicate that the ’142 patent is the subject of the following district court case: *Data Health Partners, Inc. v. Teladoc Health, Inc.*, No. 1:23-cv-00160 (D. Del.). Pet. 2; Paper 4, 1. Petitioner also filed petitions

for *inter partes* review in IPR2024-00616 and IPR2024-00618 that challenge other patents asserted in the above district court case.

D. The '142 Patent

The '142 patent relates to “tracking goal progression.” Ex. 1001, code (57). The '142 patent states that “electronic systems, equipment, software, and processes for tracking, treating, and recording results, such as for individuals with special needs, have not improved . . . significantly.” *Id.* at 1:27–30. As a result, according to the '142 patent, “viewing, updating, managing, and sharing, relevant information may be more difficult than it should be.” *Id.* at 1:33–35. To address this identified problem, the '142 patent describes “a system, method, server, controller, and computer readable medium for tracking goal progression” that includes establishing accounts for providers serving clients, assigning each client to one or more providers in response to selections from an administrator, establishing goals for each client, compiling data associated with each client, and communicating alerts if the compiled data varies from a threshold to become significant. *Id.* at 1:39–52.

E. Illustrative Claim

Of the challenged claims, claims 1, 11, and 16 are independent. Claim 1 is reproduced below.

1. A method for tracking goal progression, the method comprising:

receiving input establishing accounts for providers serving clients, wherein the clients are individuals receiving treatment or assistance, and wherein the accounts are stored in a server available through one or more networks;

creating fields required for compiling data associated with the treatment or assistance of each of the clients from the providers;

assigning each of the clients to one or more of the providers in response to selections from an administrator, wherein the one or more of the providers include at least individuals available to treat or assist the client;

establishing desired outcomes for each of the clients based on treatment and assistance required to meet the desired outcomes, wherein one or more thresholds indicates whether the desired outcomes are met;

compiling data associated with at least performance of the desired outcomes by each of the clients received from the providers utilizing computing or communications devices in communication with the server;

automatically determining whether 1) the desired outcomes are being met in response to rules governing data analysis that are utilized based on the compiled data, and 2) the compiled data varies from one or more thresholds to become significant for one or more of the clients; and

automatically communicating alerts in response to the compiled data varying from the one or more thresholds to become significant for the one or more of the clients.

Ex. 1001, 31:25–55.

F. Evidence

Petitioner submits the following evidence:

Evidence	Exhibit No.
Douglas, WO 99/003045, published Jan. 21, 1999 (“Douglas”)	1002
Wager, US 2006/0149589 A1, published July 6, 2006 (“Wager”)	1003
Chitiveli, US 2013/0179450 A1, published July 11, 2013 (“Chitiveli”)	1004

Evidence	Exhibit No.
Hian Chye Koh & Gerald Tan, <i>Data Mining Applications in Healthcare</i> , 19 J. HEALTHCARE INFO. MGMT. 64 (2005) (“Koh”)	1009
Declaration of Dr. Bryan Bergeron	1012
VA. DEPT. OF EDUC., AUTISM SPECTRUM DISORDERS AND THE TRANSITION TO ADULTHOOD (2010) (“Virginia”)	1022

G. Asserted Grounds

Petitioner asserts that the challenged claims are unpatentable on the following grounds:

Claim(s) Challenged	35 U.S.C. §	Reference(s)/Basis
1, 3, 4, 6, 7, 10, 11, 14, 16, 17	103	Douglas
1, 3, 4, 6, 7, 10, 11, 14, 16, 17	103	Douglas, Wager
2, 20	103	Douglas, Chitiveli
2, 20	103	Douglas, Wager, Chitiveli
5, 12, 13, 18	103	Douglas, Koh
5, 12, 13, 18	103	Douglas, Wager, Koh
9	103	Douglas, Virginia
9	103	Douglas, Wager, Virginia

II. ANALYSIS

A. Level of Ordinary Skill in the Art

According to Petitioner, a person of ordinary skill in the art as of the ’142 patent’s earliest claimed priority date “would have had at least a bachelor’s degree in a healthcare field as well as 1–2 years of experience with health information technology, including specific experience with computer-based systems for recording, tracking, and analyzing patient health information.” Pet. 6 (citing Ex. 1012 ¶ 36). Petitioner’s description of the level of ordinary skill in the art is supported by the testimony of Petitioner’s declarant, Dr. Bryan Bergeron. Ex. 1012 ¶ 36. Patent Owner does not

dispute Petitioner’s description at this stage of the proceeding. Prelim. Resp. 2. We adopt Petitioner’s description for the purposes of this Decision.

B. Claim Construction

In an *inter partes* review proceeding, a patent claim is construed using the same standard used in a civil action under 35 U.S.C. § 282(b), including construing the claim in accordance with the ordinary and customary meaning of the 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). Neither party proposes an express construction for any claim terms. Pet. 7; Prelim. Resp. 10. We determine that no claim terms require express construction for purposes of this Decision.

C. Obviousness of Claims 1, 3, 4, 6, 7, 10, 11, 14, 16, and 17 over Douglas

Petitioner argues that claims 1, 3, 4, 6, 7, 10, 11, 14, 16, and 17 would have been obvious over Douglas. Pet. 7–47. Patent Owner disputes Petitioner’s showing. PO Prelim. Resp. 12–28. For the reasons discussed below, Petitioner demonstrates a reasonable likelihood of prevailing in showing that claims 1, 3, 4, 6, 7, 10, 11, 14, 16, and 17 would have been obvious over Douglas.

1. Claim 1

Claim 1 recites “[a] method for tracking goal progression.” Ex. 1001, 31:25–26. Petitioner presents evidence that Douglas teaches tracking a “patient’s progress with previously established goals.” Pet. 9 (citing Ex. 1002, 2:36–3:2; Ex. 1012 ¶ 45). Patent Owner does not dispute that

Douglas teaches the preamble of claim 1. On this record, Petitioner shows sufficiently that Douglas teaches the preamble of claim 1.¹

Claim 1 recites “receiving input establishing accounts for providers serving clients, wherein the clients are individuals receiving treatment or assistance, and wherein the accounts are stored in a server available through one or more networks.” Ex. 1001, 31:26–31. Petitioner presents evidence that Douglas teaches establishing accounts for physicians treating patients and storing the accounts in a network server available through the Internet. Pet. 9–12 (citing Ex. 1002, 6:6–14, 6:24–35, 8:28–31, 19:27–30, 21:14–15, 24:12–16, 24:28–37, 25:5–11, 25:17–19, Figs. 29, 36, 38, 57, 59; Ex. 1012 ¶¶ 46, 48–52). Patent Owner does not dispute that Douglas teaches this limitation of claim 1. On this record, Petitioner sufficiently shows that Douglas teaches this limitation of claim 1.

Claim 1 recites “creating fields required for compiling data associated with the treatment or assistance of each of the clients from the providers.” Ex. 1001, 31:32–34. Petitioner presents evidence that Douglas teaches creating fields for compiling pertinent patient data.² Pet. 12–14 (citing Ex. 1002, 7:22–29, 11:26–28, Fig. 4; Ex. 1012 ¶¶ 53–54). Patent Owner does not dispute that Douglas teaches this limitation of claim 1. On this

¹ We need not decide whether the preamble of claim 1 is limiting because Petitioner presents evidence sufficient, for the purposes of institution, that the prior art teaches the recitations in the preamble.

² Petitioner also asserts that “[t]o the extent [Patent Owner] argues that the claimed fields themselves must allow for data entry and Douglas’s fields do not, . . . using fields to allow the physician to enter the data would have been obvious.” Pet. 14 (citing Ex. 1002, 11:1–5, Fig. 60; Ex. 1012 ¶ 56). We do not address this assertion at this stage of the proceeding because Petitioner shows sufficiently that Douglas teaches this limitation of claim 1.

record, Petitioner sufficiently shows that Douglas teaches this limitation of claim 1.

Claim 1 recites “assigning each of the clients to one or more of the providers in response to selections from an administrator, wherein the one or more of the providers include at least individuals available to treat or assist the client.” Ex. 1001, 31:35–38. Petitioner presents evidence that a “case administrator sets up each of the patients on Douglas’s system by entering the information contained in the patient prescription form . . . , where such information includes information associating the patient with a physician.” Pet. 18–19 (citing Ex. 1002, 6:33–7:13, Fig. 2; Ex. 1012 ¶ 66). Petitioner presents evidence that a person of ordinary skill in the art “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.”³ *Id.* at 19–20 (citing Ex. 1012 ¶ 66).

Patent Owner argues that Petitioner does not show sufficiently that Douglas teaches assigning each of the clients to one or more of the providers in response to selections from an administrator. Prelim. Resp. 22–28. Specifically, Patent Owner argues that Douglas “does not teach that a physician or provider is ‘assigned’ to any patient as part of the program” because “the patient’s subscription into Douglas’s system is done *after* the patient has already seen a physician and the physician has filled out a patient

³ Petitioner also asserts that it “would have been obvious for the case administrator to assign the patients to their physicians.” Pet. 20 (citing Ex. 1012 ¶ 67). We do not address this assertion at this stage of the proceeding because Petitioner shows sufficiently that Douglas teaches this limitation of claim 1.

prescription form.” *Id.* at 23 (emphasis original). Thus, according to Patent Owner, “selection of the physician by the patient happens outside the context of the claimed system,” and “Douglas therefore does not teach ‘assigning’ the client to one or more providers.” *Id.* at 24 (citing Ex. 1002, 6:28–35). Patent Owner also argues that “[e]ven if the case advisor’s entry of the treating physician’s name in the system could be fairly characterized as ‘assignment’ to a ‘provider,’ it is not done ‘in response’ to any ‘selection[] from the administrator’—it merely reflects that a particular provider has already seen and begun treating the patient.” *Id.* at 26 (alterations original).

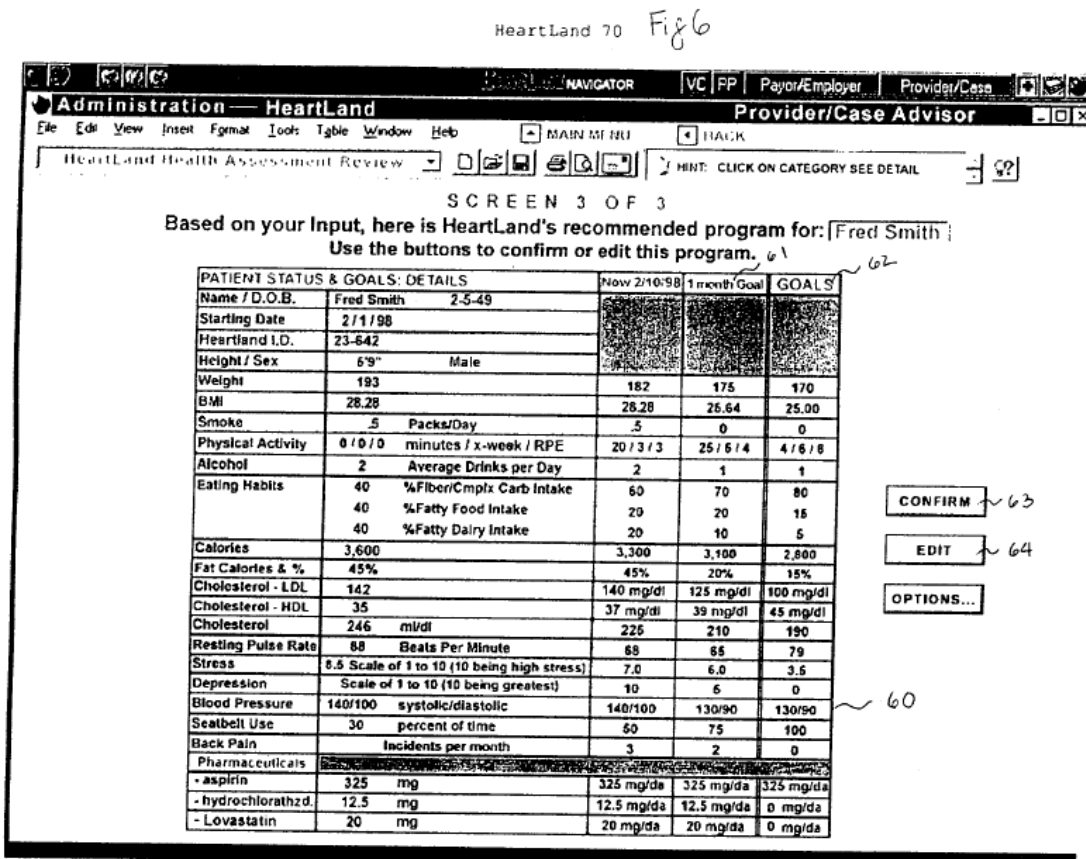
On this record, Patent Owner’s arguments are unavailing. Claim 1 recites “[a] method for tracking goal progression” that includes “assigning each of the clients to one or more of the providers in response to selections from an administrator.” Ex. 1001, 31:25, 31:35–37. In other words, claim 1 requires that an administrator assign each client to a provider in connection with the claimed method for tracking goal progression. *Id.* Claim 1, however, does not prohibit assigning a client to a provider from whom the client received treatment prior to the administrator’s selection. *See id.* In fact, claim 1 indicates that the client may receive treatment from the provider prior to the administrator’s selection. *Id.* at 31:27–31 (“the clients are individuals receiving treatment or assistance”).

Further, Douglas teaches that the case administrator establishes an account by entering information from the patient prescription form that includes the “Physician Name” and “Physician ID.” Ex. 1002, 6:33–35, 7:11–13, Fig. 2. And the evidence of record indicates that a person of ordinary skill in the art “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.*” Ex. 1012 ¶ 66 (emphasis added). On this record, Petitioner sufficiently shows that Douglas teaches the above limitation of claim 1.

Claim 1 recites “establishing desired outcomes for each of the clients based on treatment and assistance required to meet the desired outcomes, wherein one or more thresholds indicates whether the desired outcomes are met.” Ex. 1001, 31:39–42. Petitioner presents evidence that Douglas teaches establishing goals⁴ (i.e., desired outcomes) for the patient and assessing whether those goals are met by comparing patient data to respective thresholds for the goals. Pet. 23–27 (citing Ex. 1002, 7:33–37, 8:1–13, 11:18–28, Figs. 5–6; Ex. 1012 ¶¶ 77–82). Petitioner specifically relies on Figure 6 of Douglas, which is reproduced below. *Id.* at 25–26 (citing Ex. 1002, Fig. 6).

⁴ Petitioner states that “Douglas’s goals 51, 61, 62 are each a desired outcome.” Pet. 25. Patent Owner notes that “Douglas refers to ‘levels 51’ and ‘goals 52,’ not ‘goals 51.’” Prelim. Resp. 12 n.1; *see* Ex. 1002, 7:34, 8:2. On this record, we understand Petitioner’s references to “goals 51” to be a typographical error.



Ex. 1002, Fig. 6. Figure 6 depicts patient record 60 that includes columns for “1 month Goal” 61 and final “GOALS” 62, as well as rows for information about a patient’s “calories, cholesterol level, blood pressure, and seat belt use,” among other things. *Id.* at 8:10–11, 8:16–19. Petitioner presents evidence that “Douglas’s system assesses whether [] desired outcomes are met by comparing data relating to the patient to respective thresholds of the desired outcomes . . . such as the patient’s blood pressure being below 130/90 and the patient’s weight being below 175.” Pet. 25–26 (citing Ex. 1002, 11:18–28, Fig. 6; Ex. 1012 ¶ 78).

Patent Owner argues that Petitioner does not show sufficiently that Douglas teaches one or more thresholds that indicate whether the desired outcomes are met. Prelim. Resp. 12–19. Specifically, Patent Owner

contends that “Petitioner functionally points to the purported ‘desired outcomes,’ themselves, as the ‘thresholds.’” *Id.* at 15 (citing Pet. 25–26). According to Patent Owner, “Petitioner has not alleged or shown how any of the goals identified as purported ‘thresholds’ did or could ‘indicate[] whether the desired outcomes are met.’” *Id.* at 16 (alteration in original). Patent Owner also contends that “Petitioner improperly conflates the claims’ separate requirements for ‘desired outcomes’ and ‘thresholds.’” *Id.* at 17.

On this record, Patent Owner’s arguments are unavailing. Petitioner does not assert that Douglas’s goals 61 and 62 correspond to both the claimed desired outcomes and the claimed thresholds. *See* Pet. 25–26. Petitioner identifies Douglas’s goals 61 and 62 as the desired outcomes, and Petitioner separately identifies the numeric values listed in Figure 6 as the thresholds that indicate whether goals 61 and 62 are met. *Id.*; Ex. 1002, 8:1–13, 11:18–28, Fig. 6; Ex. 1012 ¶ 78. For example, Petitioner explains that the “patient’s blood pressure being below 130/90 and the patient’s weight being below 175” are thresholds indicating whether goal 61 is met. Pet. 25–26; Ex. 1002, 11:18–28, Fig. 6; Ex. 1012 ¶ 78. On this record, Petitioner sufficiently shows that Douglas teaches the above limitation of claim 1.

Claim 1 recites “compiling data associated with at least performance of the desired outcomes by each of the clients received from the providers utilizing computing or communications devices in communication with the server.” Ex. 1001, 31:43–46. Petitioner presents evidence that Douglas teaches collecting patient data associated with performance of the goals from the provider. Pet. 28–29 (citing Ex. 1002, 11:1–12:2, 20:3–37, Fig. 60; Ex. 1012 ¶¶ 83–85). Petitioner also presents evidence that Douglas teaches entering the patient data using a computer linked to a network server via the

Internet. *Id.* at 28–29 (citing Ex. 1002, 24:3–26, Fig. 59; Ex. 1012 ¶ 86). Patent Owner does not dispute that Douglas teaches this limitation of claim 1. On this record, Petitioner sufficiently shows that Douglas teaches this limitation of claim 1.

Claim 1 recites “automatically determining whether 1) the desired outcomes are being met in response to rules governing data analysis that are utilized based on the compiled data, and 2) the compiled data varies from one or more thresholds to become significant for one or more of the clients.” Ex. 1001, 31:47–52. Petitioner presents evidence that Douglas teaches automatically determining whether the goals are being met by comparing collected patient data with the thresholds and determining whether any variation between the collected patient data and the thresholds is significant for the patient. Pet. 29–31 (citing Ex. 1002, 11:6–12:2; Ex. 1012 ¶¶ 88–90). Patent Owner does not dispute that Douglas teaches this limitation of claim 1. On this record, Petitioner sufficiently shows that Douglas teaches this limitation of claim 1.

Claim 1 recites “automatically communicating alerts in response to the compiled data varying from the one or more thresholds to become significant for the one or more of the clients.” Ex. 1001, 31:53–55. Petitioner presents evidence that Douglas teaches “identif[ying] when a health risk is present for a patient based on the compiled data varying from the goals’ corresponding thresholds” and “automatically communicat[ing] an alert.” Pet. 31 (citing Ex. 1002, 11:11–17; Ex. 1012 ¶ 91).

Patent Owner argues that Petitioner does not show sufficiently that Douglas teaches automatically communicating alerts in response to the compiled data varying from the one or more thresholds to become

significant. Prelim. Resp. 19–22. First, Patent Owner contends that Petitioner “cites only to Douglas **automatically** sending an alarm or notification under the condition of a health risk being present—not when the patient’s goals are not being met.” *Id.* at 20 (emphasis original). According to Patent Owner, “Douglas directly contrasts ‘a health risk’ such as ‘a patient’s blood pressure’ that ‘is potentially dangerous,’ with its next paragraph where it explicitly describes a scenario in which a patient’s ‘goals are not being met’—such as when ‘a patient has lost 5 pounds instead of 10’—as ‘not life-threatening.’” *Id.* at 20–21 (citing Ex. 1002, 11:11–17, 11:19–22). Patent Owner contends that, in the latter scenario, Douglas will “‘simply’ notify” the physician rather than “specifically automatically notify.” *Id.* at 20 (citing Ex. 1002, 11:18–21).

On this record, Patent Owner’s arguments are unavailing. Claim 1 recites “automatically communicating alerts in response to the compiled data varying from the one or more thresholds *to become significant*.” Ex. 1001, 31:53–55 (emphasis added). In other words, claim 1 requires communicating an alert when there is a *significant* variation between the compiled data and the threshold. *Id.* But claim 1 does not require communicating an alert for *any* variation between the compiled data and the threshold. *See id.* Further, Douglas teaches communicating an alarm when the collected patient data varies from the threshold to become potentially dangerous to the patient. Ex. 1002, 11:11–17.

Moreover, on this record, we disagree with Patent Owner’s characterization of Douglas. Patent Owner alleges that Douglas’s system automatically notifies the physician when the patient is in danger, but does not do so automatically when the patient’s goals are not being met. Prelim.

Resp. 20 (citing Ex. 1002, 11:18–21). The portion of Douglas cited by Patent Owner states that “[i]f the difference between current data and goals does not present a threatening situation, the system will simply notify the physician or case advisor that these goals are not being met.” Ex. 1002, 11:18–21. As such, Douglas distinguishes between sending an “alarm” when the patient is in danger and a “simpl[e] notif[ication]” when the patient’s goals are not being met. *Id.* at 11:11–21. But Douglas’s system appears to send both the alarm and the simple notification automatically. *Id.* Thus, Douglas’s simple notifications also teach automatically communicating an alert.

Second, Patent Owner argues that “Douglas only discloses alerts relating to current/single data points rather than compiled data.” Prelim. Resp. 21 (emphasis omitted). According to Patent Owner, “Douglas reflects only two specific instances of alarms or notifications based on data, and those . . . relate to (1) an instance wherein a ‘patient’s current blood pressure is potentially dangerous,’ and (2) ‘if the current data states that the patient has lost 5 pounds instead of 10.’” *Id.* (citing Ex. 1002, 11:15–21). Patent Owner contends that neither instance “constitutes ‘compiled data.’” *Id.* at 21–22.

On this record, Patent Owner’s arguments are unavailing. As discussed above, Douglas teaches collecting patient data (i.e., compiled data) and comparing that collected patient data “with the goals and parameters residing in the system’s database.” Ex. 1002, 11:1–17. Douglas also teaches sending an alert when the collected patient data varies from the one or more thresholds, such as the blood pressure threshold and the weight threshold. *Id.* at 11:15–21. Because the collected patient data includes the

patient's current blood pressure and weight, Douglas's alerts are in response to the collected patient data. On this record, Petitioner sufficiently shows that Douglas teaches the above limitation of claim 1.

2. Claims 3, 4, 6, 7, 10, 11, 14, 16, and 17

Petitioner presents evidence that Douglas teaches the limitations of claims 3, 4, 6, 7, 10, 11, 14, 16, and 17. Pet. 31–47. Other than the arguments discussed above for claim 1, Patent Owner does not dispute that Douglas teaches the limitations of claims 3, 4, 6, 7, 10, 11, 14, 16, and 17. On this record, Petitioner shows sufficiently that Douglas teaches the limitations of claims 3, 4, 6, 7, 10, 11, 14, 16, and 17.

3. Summary

For the foregoing reasons, Petitioner demonstrates a reasonable likelihood of prevailing in showing that claims 1, 3, 4, 6, 7, 10, 11, 14, 16, and 17 would have been obvious over Douglas.

D. Obviousness of Claims 1, 3, 4, 6, 7, 10, 11, 14, 16, and 17 over Douglas and Wager

Petitioner argues that claims 1, 3, 4, 6, 7, 10, 11, 14, 16, and 17 would have been obvious over Douglas in view of Wager. Pet. 47–53. For the reasons discussed below, Petitioner demonstrates a reasonable likelihood of prevailing in showing that claims 1, 3, 4, 6, 7, 10, 11, 14, 16, and 17 would have been obvious over the combination of Douglas and Wager.

1. Claim 1

Petitioner relies on the same arguments and evidence discussed above for the asserted ground based on Douglas for most of the limitations of claim 1. Pet. 52–53. Petitioner relies on Wager for the limitation of claim 1 discussed below.

Claim 1 recites “assigning each of the clients to one or more of the providers in response to selections from an administrator, wherein the one or more of the providers include at least individuals available to treat or assist the client.” Ex. 1001, 31:35–38. Petitioner presents evidence that Wager teaches a workforce management interface operated by a “staff manager” to “generate care provider-to-patient assignments.” Pet. 48, 52–53 (citing Ex. 1003 ¶¶ 11, 21; Ex. 1012 ¶¶ 136, 144). And, as discussed in more detail below, Petitioner presents evidence that it would have been obvious to include Wager’s workforce management interface in Douglas’s system. *Id.* at 50 (citing Ex. 1012 ¶ 139). Other than the arguments discussed above for the asserted ground based on Douglas, Patent Owner does not dispute that the Douglas and Wager combination teaches the limitations of claim 1. On this record, Petitioner sufficiently shows that the Douglas and Wager combination teaches the limitations of claim 1.

2. Claims 3, 4, 6, 7, 10, 11, 14, 16, and 17

Petitioner presents evidence that the Douglas and Wager combination teaches the limitations of claims 3, 4, 6, 7, 10, 11, 14, 16, and 17. Pet. 52–53. Other than the arguments discussed above for the asserted ground based on Douglas, Patent Owner does not dispute that the Douglas and Wager combination teaches the limitations of claims 3, 4, 6, 7, 10, 11, 14, 16, and 17. On this record, Petitioner shows sufficiently that the combination of Douglas and Wager teaches the limitations of claims 3, 4, 6, 7, 10, 11, 14, 16, and 17.

3. Reason to Combine

Petitioner argues that a person of ordinary skill in the art would have had reason to combine the cited teachings of Douglas and Wager so that

Douglas’s system includes Wager’s workforce management interface. Pet. 50–52 (citing Ex. 1012 ¶¶ 138–141). Petitioner presents evidence that doing so would have been obvious because “Douglas’s system is used to treat patients with a variety of needs,” and Wager’s interface “would have helped ensure that the assigned physician was equipped, in terms of skill set, to treat the patient.” *Id.* at 50–51 (citing Ex. 1002, 6:36–7:4; Ex. 1012 ¶¶ 138, 140). Petitioner also presents evidence that combining the cited teachings of Douglas and Wager “would have . . . helped ensure that the assigned physician had the capacity to effectively treat the patient.” *Id.* at 51 (citing Ex. 1012 ¶ 141).

Patent Owner argues that Petitioner does not show sufficiently that it would have been obvious to combine the cited teachings of Douglas and Wager for several reasons. Prelim. Resp. 29–37. Specifically, Patent Owner argues that combining Douglas’s system with Wager’s interface is redundant because Douglas’s “patients are only subscribed to the system because they are already assigned to a physician.” *Id.* at 29–30. On this record, Patent Owner’s argument is unavailing. Even if a patient already saw a physician, the evidence of record indicates that Wager’s interface would have improved Douglas’s system by allowing the case administrator to assign a physician that has the appropriate skills and capacity to treat the patient. Ex. 1012 ¶¶ 140–141.

Patent Owner also argues that combining Douglas’s system with Wager’s interface would result in “absurd scenarios.” Prelim. Resp. 30–34, 36–37. Specifically, Patent Owner contends that the proposed combination would result in 1) “patients assigned to a cardiologist [being] reassigned to a primary care physician” (*id.* at 30–32); 2) patients being “reassigned to the

least popular primary care physician simply because that physician had the fewest numbers of patients” (*id.* at 32–33); 3) physicians being unlikely to use Douglas’s system because “an administrator would then reassign their patient to another physician who had fewer patients” (*id.* at 34); and 4) a decrease in “quality of care through inefficiencies caused by lack of interoperability of patient records” (*id.* at 36–37).

On this record, Patent Owner’s arguments are unavailing. Petitioner does not propose combining Douglas and Wager so that the case administrator assigns a patient to a physician simply because that physician has the fewest patients. *See* Pet. 47–52. Rather, Petitioner explains that Wager’s interface allows Douglas’s case administrator to “match[] the patients’ time- and skill-needs to the care providers’ capacities and skill sets,” which increases the quality of care. Pet. 49, 51–52; Ex. 1003 ¶¶ 18–22; Ex. 1012 ¶¶ 137, 141. In addition, even if Patent Owner is correct that Petitioner’s proposed combination would involve some tradeoff, the evidence of record indicates that the benefits gained outweigh any benefits potentially lost. *See* Ex. 1012 ¶¶ 140–141; *Winner Int’l Royalty Corp. v. Wang*, 202 F.3d 1340, 1349 n.8 (Fed. Cir. 2000) (“The fact that the motivating benefit comes at the expense of another benefit, however, should not nullify its use as a basis to modify the disclosure of one reference with the teachings of another.”).

Finally, Patent Owner argues that Douglas teaches away from the proposed combination. Prelim. Resp. 34–36. In particular, Patent Owner contends that “Douglas expresses that its invention is designed for use remotely,” whereas “Wager envisions its invention being used to coordinate staffing in a clinical setting such as a hospital.” *Id.* On this record, Patent

Owner's argument is unavailing. Petitioner does not propose combining Douglas and Wager so that Douglas's system is limited to in-person use. *See* Pet. 47–52. Rather, as discussed above, Petitioner only proposes modifying Douglas's system to include Wager's electronic workforce management interface. *Id.* at 50; Ex. 1012 ¶ 139. Thus, on the present record, we disagree that a person of ordinary skill in the art would be discouraged from combining the cited teachings of Douglas and Wager.

4. *Summary*

For the foregoing reasons, Petitioner demonstrates a reasonable likelihood of prevailing in showing that claims 1, 3, 4, 6, 7, 10, 11, 14, 16, and 17 would have been obvious over Douglas in view Wager.

E. Obviousness of Claims 2 and 20 over Douglas and Chitiveli

Petitioner argues that claims 2 and 20 would have been obvious over Douglas and Chitiveli. Pet. 53–60. Petitioner identifies evidence indicating that the Douglas and Chitiveli combination teaches the limitations of claims 2 and 20, and that a person of ordinary skill in the art would have had reason to combine these references. *Id.* Patent Owner does not raise any arguments relating to this asserted ground. On this record, Petitioner demonstrates a reasonable likelihood of prevailing in showing that claims 2 and 20 would have been obvious over Douglas and Chitiveli.

F. Obviousness of Claims 2 and 20 over Douglas, Wager, and Chitiveli

Petitioner argues that claims 2 and 20 would have been obvious over Douglas, Wager, and Chitiveli. Pet. 53–60. Petitioner identifies evidence indicating that the Douglas, Wager, and Chitiveli combination teaches the limitations of claims 2 and 20, and that a person of ordinary skill in the art would have had reason to combine these references. *Id.* Patent Owner does

not raise any arguments relating to this asserted ground. On this record, Petitioner demonstrates a reasonable likelihood of prevailing in showing that claims 2 and 20 would have been obvious over Douglas, Wager, and Chitiveli.

G. Obviousness of Claims 5, 12, 13, and 18 over Douglas and Koh

Petitioner argues that claims 5, 12, 13, and 18 would have been obvious over Douglas and Koh. Pet. 61–67. Petitioner identifies evidence indicating that the Douglas and Koh combination teaches the limitations of claims 5, 12, 13, and 18, and that a person of ordinary skill in the art would have had reason to combine these references. *Id.* Patent Owner does not raise any arguments relating to this asserted ground. On this record, Petitioner demonstrates a reasonable likelihood of prevailing in showing that claims 5, 12, 13, and 18 would have been obvious over Douglas and Koh.

H. Obviousness of Claims 5, 12, 13, and 18 over Douglas, Wager, and Koh

Petitioner argues that claims 5, 12, 13, and 18 would have been obvious over Douglas, Wager, and Koh. Pet. 61–67. Petitioner identifies evidence indicating that the Douglas, Wager, and Koh combination teaches the limitations of claims 5, 12, 13, and 18, and that a person of ordinary skill in the art would have had reason to combine these references. *Id.* Patent Owner does not raise any arguments relating to this asserted ground. On this record, Petitioner demonstrates a reasonable likelihood of prevailing in showing that claims 5, 12, 13, and 18 would have been obvious over Douglas, Wager, and Koh.

I. Obviousness of Claim 9 over Douglas and Virginia

Petitioner argues that claim 9 would have been obvious over Douglas and Virginia. Pet. 67–73. Petitioner identifies evidence indicating that the

Douglas and Virginia combination teaches the limitations of claim 9, and that a person of ordinary skill in the art would have had reason to combine these references. *Id.* Patent Owner does not raise any arguments relating to this asserted ground. On this record, Petitioner demonstrates a reasonable likelihood of prevailing in showing that claim 9 would have been obvious over Douglas and Virginia.

J. Obviousness of Claim 9 over Douglas, Wager, and Virginia

Petitioner argues that claim 9 would have been obvious over Douglas, Wager, and Virginia. Pet. 67–73. Petitioner identifies evidence indicating that the Douglas, Wager, and Virginia combination teaches the limitations of claim 9, and that a person of ordinary skill in the art would have had reason to combine these references. *Id.* Patent Owner does not raise any arguments relating to this asserted ground. On this record, Petitioner demonstrates a reasonable likelihood of prevailing in showing that claim 9 would have been obvious over Douglas, Wager, and Virginia.

III. CONCLUSION

Petitioner demonstrates a reasonable likelihood of prevailing in showing that at least one of the challenged claims is unpatentable. Accordingly, we institute an *inter partes* review on all grounds of unpatentability in the Petition. At this stage of the proceeding, we have not made a final determination with respect to the patentability of any of the challenged claims.

IV. ORDER

It is hereby

ORDERED that, pursuant to 35 U.S.C. § 314(a), an *inter partes* review of claims 1–7, 9–14, 16–18, and 20 of the '142 patent is instituted with respect to all grounds of unpatentability set forth in the Petition; and

FURTHER ORDERED that, pursuant to 35 U.S.C. § 314(c) and 37 C.F.R. § 42.4(b), *inter partes* review of the '142 patent shall commence on the entry date of this Order, and notice is hereby given of the institution of a trial.

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