

From: [Michael Solomita](#)
To: [Trials](#)
Cc: [Sarah Spires](#); [Daniel Jackson](#); [Stephen Guzzi](#); [Jeremy Albright](#)
Subject: RE: IPR2024-00616 | Petitioner's Request for a Preliminary Reply to Patent Owner's Preliminary Response
Date: Thursday, July 11, 2024 2:13:15 PM

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Dear Board,

With respect to IPR2024-00617 and -00618, Petitioner respectfully requests 10-page preliminary replies in each IPR to address four claim construction arguments raised in Patent Owner's Preliminary Response ("POPR"), as specified below. PO opposes the request.

IPR2024-00617 – U.S. Patent No. 11,151,142

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1. The claimed "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" requires determining whether the compiled data varies from one or more thresholds to indicate whether the desired outcomes are met (POPR at 12-17);
2. The claimed "desired outcomes" and "thresholds" must be completely separate from each other (POPR at 17-19);
3. The claimed "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" requires the alerts be responsive to all, or some specific unspecified subset, of the data received from providers and compiled in association with performance by the one or more clients (POPR at 19-22); and
4. The claimed "assigning the client to one or more of providers in response to selections from the administrator" requires the assigning to be before any contact between the client and the provider, and the selections from the administrator to be without input from the provider (POPR at 22-28).

IPR2024-00618 – U.S. Patent No. 10,061,812

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1. The claimed "compiling the data associated with each of the clients received from the providers without input from the clients" requires the compiled data to be devoid of any data provided by a client (POPR at 12-20);
2. The claimed "rules for determining progress of the clients" and "goals" must be completely separate from each other (POPR at 21-25);
3. The claimed "alert[s]" must include all, or some unspecified subset of, data that is

received from providers and compiled with respect to the one or more clients (claims 1 and 11), or must be in response to all, or some unspecified subset of, such data (claim 16) (POPR at 25-30); and

4. The claimed “assigning each of the clients to one or more of the providers in response to selections from the administrator” requires the assigning to be before any contact between the client and the provider, and the selections from the administrator to be without input from the provider (POPR at 31-37).

Petitioner’s Position

Good cause exists to grant the requested preliminary replies, as the above claim constructions were unforeseeable. Specifically, the constructions are unsupported by the intrinsic record. Further, each of the second constructions ignores contrary caselaw, and PO’s applications of each of the second constructions and the third construction in IPR2024-00618 mischaracterize Petitioner’s arguments.

Patent Owner’s Position

No good cause exists because Patent Owner’s arguments do not require resolving each of the multitude of claim construction arguments Petitioner sets forth. To the extent that the Petition relies on a deviation from the plain and ordinary meaning for its alleged claim mapping, that argument was legally required to have been made in the Petition.

Respectfully submitted, Michael Solomita
Counsel for Petitioner

From: Michael Solomita

Sent: Monday, July 8, 2024 3:18 PM

To: Trials <Trials@USPTO.GOV>

Cc: Sarah Spires <sspires@skiermontderby.com>; Daniel Jackson <DJackson@skiermontderby.com>; Stephen Guzzi <stephen.guzzi@nortonrosefulbright.com>; Jeremy Albright <jeremy.albright@nortonrosefulbright.com>

Subject: RE: IPR2024-00616 | Petitioner's Request for a Preliminary Reply to Patent Owner's Preliminary Response

Dear Board,

Petitioner and PO are available for a phone conference on Tuesday July 16 before noon Eastern. In addition, the parties will meet and confer this week regarding requests for preliminary replies in IPR2024-00617 and -00618. We will advise the Board accordingly after the meet and confer.

Best regards, Michael Solomita
Counsel for Petitioner

From: Trials <Trials@USPTO.GOV>

Sent: Monday, July 8, 2024 9:49 AM

To: Michael Solomita <michael.solomita@nortonrosefulbright.com>; Trials <Trials@USPTO.GOV>

Cc: Sarah Spires <sspires@skiermontderby.com>; Daniel Jackson <DJackson@skiermontderby.com>; Stephen Guzzi <stephen.guzzi@nortonrosefulbright.com>; Jeremy Albright <jeremy.albright@nortonrosefulbright.com>

Subject: RE: IPR2024-00616 | Petitioner's Request for a Preliminary Reply to Patent Owner's Preliminary Response

Counsel,

From the Board –

We would like to have a phone conference regarding the request for additional pre-institution briefing in IPR2024-00616. Please confer and Petitioner is to respond with the parties' mutual availability for a call on 7/15, 7/16 (before noon Eastern), and 7/17. This call will also cover any requests for pre-institution briefing in IPR2024-00617 and -00618; therefore, please also meet and confer this week to determine whether any requests will be made in those cases and whether such requests will be agreed upon or opposed.

Regards,

Esther Goldschlager
Supervisory Paralegal Specialist
Patent Trial & Appeal Board
U.S. Patent & Trademark Office

From: Michael Solomita <michael.solomita@nortonrosefulbright.com>

Sent: Wednesday, July 3, 2024 4:39 PM

To: Trials <Trials@USPTO.GOV>

Cc: Sarah Spires <sspires@skiermontderby.com>; Daniel Jackson <DJackson@skiermontderby.com>; Stephen Guzzi <stephen.guzzi@nortonrosefulbright.com>; Jeremy Albright <jeremy.albright@nortonrosefulbright.com>

Subject: IPR2024-00616 | Petitioner's Request for a Preliminary Reply to Patent Owner's Preliminary Response

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Case: IPR2024-00616

Patent: 11,144,554

Petitioner: Teladoc Health, Inc.

Patent Owner: Data Health Partners, Inc.

Dear Board:

Petitioner respectfully requests a 10-page preliminary reply to address two arguments raised in Patent Owner's Preliminary Response ("POPR"). These are PO's claim construction arguments that:

1. The claimed "plan of action" and "goals" must be completely separate from each other (POPR at 11-14); and
2. The claimed "assigning the client to one or more of providers in response to selections from the administrator" requires the assigning to be before any contact between the client and the provider, and the selections from the administrator to be without input from the provider (POPR at 14-30).

Petitioner does not oppose a 10-page preliminary sur-reply from PO. PO opposes this request for a reply.

Petitioner's Position

Good cause exists to grant the requested preliminary reply, as the above arguments were unforeseeable. Specifically, the first construction ignores contrary caselaw, is unsupported by the claim language and specification, and mischaracterizes the Petitioner's arguments. The second construction seeks to narrow "assigning" and "selections" in a way that is unsupported by the '554 Patent's specification.

PO's Position

No good cause exists because the arguments were not unforeseeable and were legally required to have been made in the Petition. The first argument falls squarely within a legally-established presumption that Petitioner was obligated to rebut in the Petition, if at all. As to the second argument, the law requires Petitioner to set forth any proposed claim construction, such as a deviation in the plain and ordinary meaning of "assign" in the Petition, if at all.

The parties are available for a call with the Board at the following times:

7/5: 9:30 am – 4:15 pm Eastern

7/8: 9:30 am – 2:30 pm Eastern

7/9: 9:30 am – 4:00 pm Eastern

7/11: 9:30 am – 12:00 pm, 2:00 pm – 4:00 pm Eastern

Respectfully submitted, Michael Solomita
Counsel for Petitioner

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