

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 IPR2026-00390
Patent 11,675,791 B2

**PETITIONER'S OPPOSITION TO PATENT OWNER'S REQUEST FOR
DISCRETIONARY DENIAL**

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PETITIONER'S EXHIBIT LIST

Exhibit	Shorthand	Description
1001	'791 Patent	U.S. Patent No. 11,675,791 B2
1002	Douglas	Pub. No. WO 1999/003045 A1
1003		Omitted
1004	Chitiveli	Pub. No. US 2013/0179450 A1
1005		Omitted
1006		Omitted
1007		Omitted
1008	ArchiveDec	Declaration of Nathaniel E Frank-White
1009	Koh	Hian Chye Koh & Gerald Tan, <u>Data Mining Applications in Healthcare</u> , 19 J. Healthcare Information Management 64 (2005)
1010	KohArchive	Printout of: https://web.archive.org/web/20050418095732/http://www.himss.org/ASP/publications_jhim_issue.asp?issue=3/30/2005 , evidencing 2005 public availability of Koh
1011	Hall-Ellis	Declaration of Sylvia D. Hall-Ellis, Ph.D.
1012	Bergeron	Declaration of Bryan Bergeron, M.D.
1013	BergeronCV	Curriculum Vitae of Bryan Bergeron, M.D.
1014	Microsoft	<u>Microsoft Computer Dictionary</u> (5th ed. 2002)
1015		Omitted
1016		Omitted
1017		Omitted
1018	NetSuite	Printout of https://web.archive.org/web/20111102042326/https://www.netsuite.co.uk/portal/uk/resource/articles/cloud-computing.shtml
1019		Omitted
1020		Omitted
1021		Omitted
1022	Virginia	<u>Autism Spectrum Disorders and the Transition to Adulthood</u> , VA Dep't of Educ. (2010)
1023	VirginiaArchive	Printout of https://web.archive.org/web/20111208001834/http://www.doe.virginia.gov/special_ed/disabilities/

Exhibit	Shorthand	Description
		autism/index.shtml, evidencing 2011 public availability of Virginia
1024	Khanuja	Pub. No. US 2004/0102683 A1
1025	'616FWD	Final Written Decision in IPR2024-00616 for U.S. Patent No. 11,144,554 B2
1026	'617FWD	Final Written Decision in IPR2024-00617 for U.S. Patent No. 11,151,142 B2
1027		Omitted
1028		Omitted
1029		Omitted
1030		Prosecution History of U.S. Patent App. No. 17/499,725 assigned to Data Health Partners Inc.
1031		Prosecution History of U.S. Patent App. No. 18/502,813 assigned to Data Health Partners Inc.
1032		First Amended Complaint for Patent Infringement (Dkt. 14), No. 1:23-cv-160-JCG (D. Del.)

I. INTRODUCTION

Patent Owner (“Data Health”), not Petitioner, is responsible for the situation it now complains about. In the parallel litigation, Data Health deliberately chose not to assert the ’791 Patent when it amended its complaint to add other patents in the same family. Instead, Data Health strategically withheld the ’791 Patent while it awaited final decisions on the asserted patents from the same family. Only after most of the asserted claims were found to be unpatentable did Data Health decide to assert the ’791 Patent in litigation, where it was promptly challenged by the Petition at issue.

The ’791 Patent presents precisely the scenario that *inter partes* review exists to address. The patent is less than three years old and was only recently asserted by Data Health—strategically, and for the first time—in a second amended complaint filed on February 11, 2026. The Petition presents compelling evidence of invalidity, grounded in the same primary reference—Douglas—that the Board already found sufficient to render unpatentable the overwhelming majority of claims in the closely related U.S. Patent Nos. 11,144,554 and 11,151,142. And institution of this Petition will actually eliminate duplicative efforts at the district court—allowing the Board to render a decision on subject matter it has already analyzed well before the June 2028 trial date—providing the district court with a fully adjudicated record on the

very prior art and claim limitations it would otherwise have to examine independently.

Data Health presents no persuasive reasoning or legal precedent to support that denying institution would advance the purpose of AIA reviews. Instead, Data Health seeks to create a new rule under which a patent owner can shield continuation applications from meritorious IPR challenges by gaming its infringement assertions in parallel litigation. Denying institution would frustrate the fundamental purpose of *inter partes* review by rewarding strategic manipulation of the IPR system and establishing a blueprint for immunizing future continuation applications from the very error-correction mechanism Congress created the AIA to provide.

II. BACKGROUND

U.S. Patent No. 11,675,791 (“the ’791 Patent”)—which is at issue in the present IPR—is one of five members of a single patent family that Data Health has asserted against Petitioner (“Teladoc”) in ongoing litigation in the District of Delaware.

On February 13, 2023, Data Health filed an action for patent infringement against Teladoc alleging infringement of various claims of U.S. Patent Nos. 11,144,554 (“the ’554 Patent”) and 10,061,812 (“the ’812 Patent”). EX2008, 3/8. On June 13, 2023, the ’791 Patent was issued. A few weeks *after* the ’791 Patent had issued, Data Health filed a first amended complaint to add U.S. Patent No.

11,151,142 (“the ’142 Patent”) to its infringement claim, but chose **not** to assert the ’791 Patent. EX1032, 3/13.

Shortly thereafter, Teladoc challenged all of the asserted patents (the ’554, ’142, and ’812 Patents) in IPRs 2024-00616, -00617, and -00618, respectively. The Board instituted the IPRs 2024-00616 and -00617, which challenged the ’554 Patent and ’142 Patent.¹ After institution of two of the three IPRs, the parties agreed to stay the district court litigation as of December 4, 2024. On September 12, 2025, the Board issued final written decisions invalidating nearly all of the challenged claims in the ’554 and ’142 Patents.

In early February 2026, the stay of the district court proceeding was lifted, and on February 11, 2026—three years after Data Health filed the initial complaint and two and a half years after the ’791 Patent was issued—Data Health filed a second amended complaint asserting, for the first time, the ’791 Patent and U.S. Patent No. 11,809,431 (“the ’431 Patent”). Within four months after Data Health’s amended complaint, Teladoc promptly filed this IPR challenging the ’791 Patent, which

¹ IPR 2024-00618, which challenged the ’812 Patent, was denied institution for reasons not at issue in the ’791 Patent and Data Health subsequently dropped the ’812 Patent from the litigation based on statements it made in its Patent Owner Preliminary Response.

largely relies on the same arguments and prior art already considered by the Board.

See Paper 6 (“DD Br.”), 11.

III. THE CIRCUMSTANCES STRONGLY FAVOR INSTITUTION

A. Institution Advances the AIA’s Purpose of Providing a Single, Efficient Alternative to Litigation

Data Health’s attempts to frame this filing as a serial petition and a tool for harassment in its Request for Discretionary Denial (Paper 6) are unavailing. Teladoc’s Petition, precipitated by Patent Owner’s delayed assertion of the ’791 Patent in co-pending district court litigation, presents meritorious challenges that overlap with subject matter the Board has already evaluated. Such a challenge advances the AIA’s central purpose of providing a single, efficient alternative to district court litigation.

To start, this is the first post-grant challenge of the ’791 Patent and is *not* a “serial petition”—a term that addresses scenarios where multiple petitions are “directed to the same claims of the same patent.” *General Plastic Indus. Co. v. Canon Kabushiki Kaisha*, IPR2016-01357, Paper 19 (PTAB Sept. 6, 2017). Even if this were a “serial” challenge, as Patent Owner alleges, institution would be warranted. The Board has repeatedly held that second petitions challenging the same patent are warranted where Patent Owner’s own litigation conduct precipitated the need for a subsequent filing. *Savant Techs. LLC d/b/a GE Lighting v. Feit Electric*

Co., Inc., IPR2025-00260, Paper 16 (June 12, 2025) (designated: Jan. 9, 2026) (declining to discretionarily deny institution of a second petition necessitated by Patent Owner’s assertion of additional claims in district court after Petitioner filed its first IPR); *Mercedes-Benz USA, LLC v. Carucel Invs., L.P.*, IPR2019-01644, Paper 9 at 11–13 (Mar. 26, 2020) (a second petition is warranted where it “was precipitated by [Patent Owner’s] own addition of claims to the co-pending district court litigation.”).

The same logic applies with greater force here: Patent Owner’s strategic decision to withhold the ’791 Patent from the parallel litigation precipitated the timing of this IPR. Petitioner could not have predicted which additional patents, if any, Patent Owner would add to the district court litigation. This is especially true here, where the ’791 Patent issued before Patent Owner filed its first amended complaint on June 27, 2023. *See* EX1001, 1; EX1032, 13/13. Patent Owner had the opportunity to assert the ’791 Patent in 2023—as it did with the ’142 Patent—but purposely chose not to do so. Patent Owner is therefore solely responsible for the situation it now complains about.

B. The Board’s Unpatentability Findings For the ’554 and ’142 Patents Weigh Against Discretionary Denial

Contrary to Patent Owner’s assertion, the Board’s previous unpatentability findings for the ’554 and ’142 Patents weigh *in favor of* institution, not against it. In *Tesla, Inc. v. Intellectual Ventures II LLC*, Director Coke Morgan Stewart noted

that situations where “the Board previously determined there was a reasonable likelihood that similar claims of an ancestor patent were unpatentable” would “counsel *against* discretionary denial.” IPR2025-00217, Paper 9 at 2 (June 13, 2025) (emphasis added). Here, the Board has found more than a reasonable likelihood of unpatentability in similar claims—the Board has issued Final Written Decisions finding similar claims with largely overlapping subject matter to be unpatentable under the more stringent preponderance-of-the-evidence standard.

As Patent Owner itself concedes, this IPR involves “significant overlap” with the proceedings the Board has already decided. DD Br., 12. The Board has already analyzed meritorious challenges based on the same primary reference—Douglas—to invalidate overlapping subject matter in the closely related ’554 and ’142 Patents, which “are directed to the same core goal-tracking, threshold, and alert architecture” as claimed in the ’791 Patent. *Id.* The Board is therefore already familiar with the technology, the claims, and the prior art references at issue. Rather than requiring the Board to develop expertise in entirely new subject matter, the Board needs only re-examine much of the same technology, informed by much of the same prior art, that it has already analyzed. On the other hand, denial of institution would require a different tribunal to analyze patentability challenges that the Board has already substantially adjudicated, increasing the risk of inconsistent findings and straining

the resources of the Court. The Board's familiarity with this technology strongly weighs in favor of institution.

Furthermore, estoppel will substantially limit any potentially duplicative effort before the Board. Patent Owner has not appealed either Final Written Decision finding claims of the '142 and '554 Patents invalid, and those decisions are now final and uncontested. *See* 37 C.F.R. § 90.3(a)(1). It is well established that collateral estoppel applies in IPR proceedings, including to claims of family applications where related claims have been held invalid in a Final Written Decision. *See Papst Licensing GMBH & Co. KG v. Samsung Elecs. Am., Inc.*, 924 F.3d 1243, 1251 (Fed. Cir. 2019).

As Patent Owner itself concedes, most of the limitations of the challenged claims of the '791 Patent substantially overlap with the claims already invalidated in the prior Final Written Decisions. Claim 1 of the '791 Patent contains only a few features that materially differ from the invalidated claims, as shown in the table below (with highlighting used to show overlapping subject matter):

'791 Claim Language	Parent Claim Language
1[p]: A method for tracking progression toward a customized goal, comprising:	'142 1[p]: "A method for tracking goal progression, the method comprising:" '554 1[p]: "A method for tracking goal progression, the method comprising:"

1[a]: receiving input establishing accounts for 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;	‘142 1[a]: “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;” ‘554 1[a]: “receiving input, by an administrator, for establishing an account for a client, wherein the client is an individual receiving treatment or assistance, and wherein the accounts are stored in a server available through one or more networks;”
1[b]: assigning each of the clients to one or more of providers in response to selections from an administrator, wherein the one or more providers communicate with the client via at least a communications device	‘142 1[c]: “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;” ‘142 1[e]: “compiling data associated with ... each of the clients received from the providers utilizing computing or communications devices in communication with the server;” ‘554 1[b]: “assigning the client to one or more of providers in response to selections from the administrator ...”
1[c]: establishing customized goals for each of the clients based on treatment or assistance required;	‘142 1[d]: “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;” ‘554 1[c]: “determining, by the one or more providers, treatment and assistance for the client, which is used for establishing goals, a plan of action, and thresholds for the client, wherein the thresholds represent certain points of progress towards the goals;”
1[d]: receiving data associated with each of the clients from a biometric device via the communication device;	‘142 1[e]: “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;” ‘554 1[d]: “periodically receiving updated data, from the one or more providers, about the status and/or well-being of the client;”
1[e]: compiling data associated with each of the clients;	‘142 1[e]: “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;” ‘554 1[e]: “compiling data associated with the client ...”

1[f]: determining whether the customized goals are being met in response to consecutive data points of the compiled data passing one or more thresholds to become significant for one or more of the clients; and	‘142 1[f]: “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” ‘554 1[f]: “determining whether the thresholds associated with the goals are being met based on the compiled data; and”
1[g]: automatically communicating alerts to at least the one or more providers to at least perform a review of the goals for the one or more of the clients in response to consecutive data points of the compiled data varying from the one or more thresholds to become significant for the one or more of the clients	‘142 1[g]: “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.” ‘554 Claim 2: “The method according to claim 1, further comprising: automatically communicating alerts in response to the compiled data varying from one or more of the thresholds to become significant for the client.”

EX1001, 30:62-31:19; EX1025, 4-5, 37; EX1026, 4-5.

For all elements other than minor portions of 1[d], 1[f], and 1[g], collateral estoppel will completely resolve the patentability questions as a matter of law, substantially narrowing the issues before the Board. *Ohio Willow Wood Co. v. Alps S., LLC*, 735 F.3d 1333, 1342 (Fed. Cir. 2013); *Google LLC v. Hammond Dev. Int’l, Inc.*, 54 F.4th 1377, 1381 (Fed. Cir. 2022). Institution of this IPR is therefore not a full reexamination of the same technology; it is a targeted review of the narrow distinctions between the ’791 Patent and the already-invalidated claims of the ’142 and ’554 Patents. That is an efficient and appropriate use of Board resources.

IV. FINTIV ANALYSIS WEIGHS AGAINST DISCRETIONARY DENIAL

As set forth below, each of *Fintiv* factors 1-4 weighs heavily against discretionary denial. Moreover, the circumstances presented in this case, under

Fintiv Factor 6, independently and strongly favor institution such that they would outweigh any considerations that might otherwise support discretionary denial.

A. Factor 1 Favors Institution

Factor 1 slightly favors review or is, at minimum, neutral. Petitioner intends to move to stay the litigation pending institution of this IPR, and the district court has demonstrated its willingness to stay this case to allow the Board to decide issues of patentability. EX2002, 1.

B. Factor 2 Favors Institution

Factor 2 strongly favors review because the expected date of the Final Written Decision precedes the expected trial date. Trial is currently set for June 26, 2028, which is six months *after* the projected due date for the Final Written Decision on December 10, 2027. EX2005, 25.

C. Factor 3 Favors Institution

Factor 3 strongly favors review because the parties and the court have not made significant investment in the litigation.

The relevant inquiry is the investment of the district court and the parties in the patent at issue in the Petition—not the aggregate investment across all patents in the case. The '791 Patent was not asserted until February 11, 2026—only four months before this Petition was filed. Patent Owner does not identify any concrete investment that the parties or the court have made in regard to the '791 Patent

specifically, nor any investment that will be made before an institution decision issues.

As of now, there has been almost no activity in the district court regarding the '791 Patent. The parties remain free to amend their pleadings, and claim construction has not yet begun. EX2005, 24. Even at the time of institution, claim construction briefing will have just started, and the *Markman* hearing will still be over three months away. *Id.* As *Fintiv* explains, limited pretrial proceedings do not render a case advanced for discretionary denial purposes, especially where, as here, trial will not occur before a final written decision. *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 at 10 (PTAB Mar. 20, 2020). Thus, any work completed before institution would not constitute a significant investment warranting discretionary denial.

D. Factor 4 Favors Institution

Factor 4 strongly favors review because there is no overlap of issues with the district court.

Patent Owner fundamentally misunderstands the Factor 4 analysis. Patent Owner's identified "overlap" improperly focuses on the overlap between the petition and two previous ***PTAB proceedings***—not the overlap between the issues in the Petition and the parallel (*i.e.*, district court) proceeding. The district court has not analyzed or made any findings regarding the validity of the asserted patents in view

of Douglas or other prior art. Thus, there is no overlap between the issues raised in the Petition and the parallel proceeding.

The conceded “significant overlap” between the claims of the ’791 Patent and the claims the Board already found unpatentable favors institution as the Board can efficiently resolve the patentability questions without duplicating any prior effort. As explained above, collateral estoppel prevents any risk of inconsistent conclusions resulting from the Board’s previous findings. Contrary to Patent Owner’s arguments, the only pathway to inconsistent conclusions between the Board and the district court is by denying institution—thereby requiring the district court to weigh in on findings that the Board has *already made*.

Further, Petitioner submits that if the Board institutes trial in this *inter partes review* proceeding, and if the Board does not subsequently vacate or reverse institution, or otherwise terminate or resolve the instituted trial prior to final written decision, Petitioner will not pursue in the co-pending district court litigation any grounds raised or that reasonably could have been raised in the Petition. This stipulation further “mitigates any concerns of duplicative efforts between the district court and the Board, as well as concerns of potentially conflicting decisions.” *Sotera Wireless, Inc. v. Masimo Corp.*, IPR2020-01019, Paper 12 at 19 (PTAB Dec. 1, 2020) (precedential as to § II.A).

E. Factor 6 Favors Institution

Factor 6 strongly favors review because independent evidence demonstrates compelling merits and examiner error. Even if Factors 1-4 did not favor institution, this case presents circumstances that would outweigh any factors favoring discretionary denial.

1. Compelling Merits

Factor 6 favors institution when “[the] issues raised by Petitioner are similar, if not identical, to those raised” in an “instituted” proceeding. *Google LLC v. Mullen Industries LLC*, IPR2025-00019, Paper 14 at 12-13 (May 12, 2025). As Patent Owner concedes, the Petition presents challenges that significantly overlap with past challenges in which the Board found “the overwhelming majority of the challenged claims ... unpatentable.” DD Br., 12. Thus, the Petition presents compelling merits that the claims of the ’791 Patent are invalid. *See e.g., Tesla, Inc. v. Intellectual Ventures II LLC*, IPR2025-00217, Paper 9 at 2. (“the merits are strong because the Board previously determined there was a reasonable likelihood that similar claims of an ancestor patent were unpatentable.”)

Because the Petition presents compelling merits, institution should not be denied regardless of whether any other *Fintiv* factors weigh against institution. *See CommScope Techs. LLC v. Dali Wireless, Inc.*, IPR2022-01242, Paper 23 (Feb. 27, 2023) (Precedential) (“The patent system and the public benefit from instituting

challenges where there is a showing of unpatentability by compelling merits”); *see also Padagis US LLC v. Neurelis, Inc.*, IPR2025-00464, Paper 12, 2-3 (July 16, 2025) (informative).

2. Examiner Error

As Director Squires has noted, correcting material error by the Office is an appropriate use of Office resources and should favor institution. *Magnolia Med. Techs., Inc. v. Kurin, Inc.*, IPR2026-00097, Paper 17, at 6 (Dir. May 14, 2026) (precedential). Indeed, “[a] substantial showing of apparent examiner error can overcome other factors that suggest discretionary denial.” *Id.*, at 8 (citing *Padagis US LLC v. Neurelis, Inc.*, IPR2025-00464, Paper 12 (Dir. July 16, 2025) (informative)). Here, the Examiner that granted the claims of the ’791 Patent has demonstrated that it was error to do so.

Specifically, the Examiner erred by failing to consider the Douglas reference (EX1002) during prosecution of the ’791 Patent. This error is clearly evidenced by pending continuation applications in this patent family where the same examiner who reviewed the ’791 Patent—Examiner Christopher Raab—is now rejecting substantially similar claims in multiple office actions in view of the Douglas reference.

U.S. Application Nos. 17/499,725 (the “’725 Application”) and 18/502,813 (the “’813 Application”) are pending applications that are in the same patent family

as the '791 Patent. EX1001, 2 (claiming priority to the '812 Patent and Provisional Application No. 61/791,218); EX1030, 667-668 (same); EX1031, 557 (same). These related applications are currently being examined by the same examiner who granted the '791 Patent. EX1001, 1 (listing primary examiner as "Christopher J Raab"); EX1030, 27 (same); EX1031, 1 (same). The claims of the '725 and '813 Applications relate to methods for tracking progression toward goals and significantly overlap with the independent claims of the '791 Patent, which Examiner Raab previously granted. *Compare* EX1001, cl. 1, *with* EX1030, 7 (pending claim 1) and EX1031, 34 (pending claim 1). In particular, all independent claims recite the steps of: (i) "receiving input establishing ... clients," (ii) "assigning each of the clients to" one or more of providers or accounts, (iii) "establishing ... goals," (iv) compiling "data associated with each of the clients," (v) "determining whether the ... goals are being met," and (vi) "communicating alerts." *Id.*

Despite previously granting similar subject matter in the '791 Patent, Examiner Raab now rejects all pending claims of the '725 and '813 Applications based on Douglas (EX1002). EX1030, 2-4, 38; EX1031, 12. Examiner Raab's current rejections of substantially similar claims illustrate that he would have rejected the claims of the '791 Patent had he been aware of the Douglas reference during prosecution. This clearly demonstrates examiner error as the Examiner's current rejections and the Board's previous findings of unpatentability directly

contradict the decision to grant the claims of the '791 Patent. *See Padagis*, IPR2025-00464, Paper 12, at 3 (such contradictions “raise[] concerns of material error such that review of the challenged patents is an appropriate use of Office resources”).

V. CONCLUSION

For the foregoing reasons, institution is appropriate.

Dated: September 10, 2026

Respectfully submitted,

/Michael Solomita/
Michael Solomita (Reg. No. 53,940)

CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.6(e), the undersigned certifies that on September 10, 2026, a complete copy of the foregoing Petitioner's Opposition to Patent Owner's Request for Discretionary Denial and Exhibits 1030-1032 were served on Patent Owner via email (by consent), at the following email address(s):

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