Trials@uspto.gov
Tel: 571-272-7822

Paper 15
Entered: September 2, 2015

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

STRYKER CORPORATION,
Petitioner,

v.

KARL STORZ ENDOSCOPY-AMERICA, INC.,
Patent Owner.

Case IPR2015-00677
Patent 8,069,420 B2

Before BRYAN F. MOORE, BARRY L. GROSSMAN, and MICHELLE N. WORMMEESTER, *Administrative Patent Judges.*

GROSSMAN, *Administrative Patent Judge*.

DECISION
Institution of *Inter Partes* Review
37 C.F.R. § 42.108

I. INTRODUCTION

Stryker Corporation ("Petitioner") filed a Petition requesting an *inter partes* review of claims 1–4, 6, 7, 9, 10, 12–14, 17, 22, 32–35, 37, 39–43, 46–48, 50–55, 57, 68, 72–74, 76, 77, and 79–83 of U.S. Patent No. 8,069,420 B2 ("the '420 patent"). Paper 2 ("Pet."). Karl Storz Endoscopy-America, Inc. ("Patent Owner") filed a Preliminary Response. Paper 8 ("Prelim. Resp."). We review the Petition under 35 U.S.C. § 314, which provides that an *inter partes* review may not be instituted "unless . . . there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition."

On the record before us, we are persuaded, for purposes of this Decision, that it is reasonably likely that Petitioner will prevail in establishing that claims 1, 2, 4, 6, 7, 9, 10, 12–14, 17, 22, 32–35, 37, 39–43, 46–48, 50–55, 57, 68, 73, 76, 77, 79, 80, 82, and 83 are not patentable.

A. Related Proceedings

Petitioner states that the '420 patent is involved in *Karl Storz Endoscopy-America, Inc. v. Stryker Corp.*, Case No. 14-00876 (N.D. Cal.), filed February 26, 2014. Pet. 1. The '420 patent also is the subject of pending *inter partes* review IPR2015-00678, filed by Petitioner.

B. The '420 Patent

The '420 patent discloses a system for controlling the communication of medical imaging data. Ex. 1001, col. 1, ll. 7–8. It allows a user to manage multiple data inputs and multiple destinations for the data, and to select which data inputs are viewable at which destinations. *Id.* at col. 2, ll. 19–30. Thus, it can provide an operating surgical team with information it needs, and can also provide to others in the surgical suite or located remotely, who may be assisting or observing the surgical procedure, information they need.

The basic components of the disclosed system are shown in Figure 1, which is reproduced below.

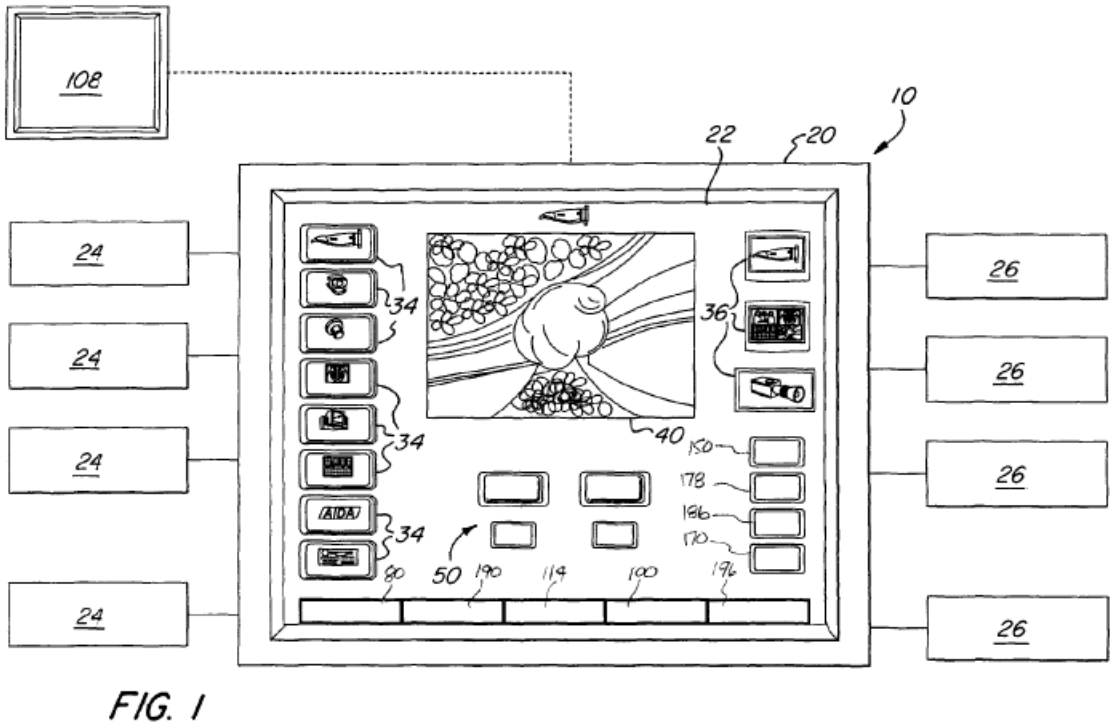

FIG. 1

Figure 1 from the ’420 patent shows a schematic view of the disclosed system for controlling the communication of medical imaging data.

As shown generally in Figure 1, and as described in the written description, the system includes computer 20, touchscreen 22 controlled by computer 20, a plurality of sources 24 of medical imaging data connected to computer 20, and a plurality of destinations 26 for the medical imaging data connected to computer 20. *Id.* at col. 4, ll. 34–38.

Sources 24 may include endoscopic cameras, video endoscopes, room cameras, light cameras, boom cameras, recording, storage, and/or archival devices, image capture devices, a PACS (Picture Archiving and Communication System) computer, or a Hospital Information System, or other devices from which medical imaging data may be received. *Id.* at col. 4, ll. 43–56.

The ’420 patent acknowledges that prior art systems provide medical images from numerous sources to various destinations. *Id.* at col. 1, ll. 17–49. An objective of the disclosed system is to provide a way of interfacing with all of the imaging devices available that is simpler to use and permits quicker execution than known systems. *Id.* at col. 1, ll. 55–67. The emphasis in the disclosure is on the touchscreen interface and its ease of use. *Id.* The fact that 23 of the 24 figures in the patent are screenshots of the touchscreen display in various operating configurations reflects this emphasis.

C. Representative Claim

Claims 1 and 79 are independent claims. Claim 1 is representative and is reproduced below.

> 1. A system for controlling the communication of medical imaging data, comprising:
>
> a computer;
>
> a plurality of sources of medical imaging data in communication with said computer;
>
> a plurality of destinations for the medical imaging data in communication with said computer; and
>
> a touchscreen controlled by said computer for simultaneously displaying a plurality of source icons and a plurality of destination icons;
>
> wherein the plurality of source icons correspond to said plurality of sources in order to allow a user of said system to select a particular source of medical imaging data, and the plurality of destination icons correspond to said plurality of destinations in order to allow the user to select at least one particular destination to receive the medical imaging data supplied by the selected source.

D. References Relied Upon

Petitioner relies upon the following prior art references:

Reference	Date	Exhibit Number
SP3 Manual Stryker Communications SwitchPoint III Operations & Maintenance Manual	Pub. Oct. 21, 2002	Ex. 1003
Howell, U.S. Pat. No. 5,767,897	Iss. June 16, 1998	Ex. 1004

E. The Asserted Grounds

Petitioner asserts the following grounds of unpatentability:

Claims Challenged	**References**	**Grounds**
1–4, 10, 12–14, 17, 22, 32–35, 37, 39–43, 46–48, 50–53, 57, 68, 72–74, 76, 77, and 79–83	SP3 Manual	35 U.S.C. § 102(b)
3, 4, 6, 7, 9, 54, 55, 81, and 82	SP3 Manual and Howell	35 U.S.C. § 103(a)

Petitioner also relies on the declaration of Harold J. Walbrink (Ex. 1008), proffered as an expert to opine on the patentability of the challenged claims.

II. ANALYSIS

A. Claim Construction

In an *inter partes* review, claim terms in an unexpired patent are interpreted according to their broadest reasonable construction in light of the specification of the patent in which they appear. 37 C.F.R. § 42.100(b); *In re Cuozzo Speed Technologies LLC*, 793 F.3d 1268, 1278–79 (Fed. Cir. 2015) ("Congress implicitly approved the broadest reasonable interpretation standard in enacting the AIA," and

"the standard was properly adopted by PTO regulation"). Claim terms also are given their ordinary and customary meaning, as would be understood by one of ordinary skill in the art in the context of the entire disclosure. *In re Translogic Tech., Inc*., 504 F.3d 1249, 1257 (Fed. Cir. 2007).

1. Medical Imaging Data

Petitioner proposes a specific construction for the term "medical imaging data," which appears in independent claims 1 and 79. Pet. 5. Petitioner proposes that we construe the term to mean "data corresponding to images generated during a medical procedure," thus focusing on *when* the data is generated. *Id.* (citing Ex. 1008 ¶ 30)[1]. Patent Owner asserts that the broadest reasonable construction of the term "medical imaging data" is "video or still images of a medical procedure," thus focusing on the subject matter of the data. Prelim. Resp. 7. Both Petitioner and Patent Owner agree, however, that the claim phrase is limited to a "medical procedure." For purposes of this Decision, we determine that Petitioner's proposed interpretation is too limiting. As explained below, we have not been directed to persuasive evidence to limit medical imaging data to *when* the data is generated, such as "during a medical procedure."

As noted by Petitioner (Pet. 5), the "Background" section of the Specification states that in known prior art medical imaging systems "both still images and live video being acquired *during the surgery* can be output to various

[1] We note that paragraph 30 of Mr. Walbrink's declaration (Ex. 1008) is a nearly verbatim repetition of the arguments in the Petition (Pet. 5–6). In order to allow an expert to state an opinion as evidence, we must find that "the expert's scientific, technical, or other specialized knowledge will help the trier of fact to understand the evidence or to determine a fact in issue." Fed. R. Evid. 702. Repeating verbatim in the declaration of a proposed expert an argument from the Petition is not helpful to a trier of fact. It also does not give that argument enhanced probative value.

different screens or recording devices." Ex. 1001 col. 1, ll. 31–33 (emphasis added). Thus, while the described sources of imaging data in prior art systems are disclosed in the context of images acquired "during surgery," the disclosure of the '420 patent is not so limited. The Specification contains the following extensive listing of the sources of medical imaging data.

> The sources 24 of medical imaging data connected to the computer 20 may include any devices, systems, or networks that generate, acquire, *store*, monitor, or control imaging data for use in generating *medical* images, such as still images or video. For example, the sources 24 may include image acquisition devices, such as endoscopic cameras, video endoscopes, room cameras, light cameras, and boom cameras. Likewise, the sources 24 may include any recording, *storage, and/or archival devices* or systems, such as traditional video cassette recorders or digital video recording devices (such as a linear tape deck or DVD recording device), image capture devices, a PACS (Picture Archiving and Communication System) computer, or *a Hospital Information System*. Finally, the sources 24 may include other devices from which medical imaging data may be received, such as a patient monitor or a central computer for controlling various devices, or may simply be *auxiliary inputs* for connecting external devices that may supply medical imaging data to the system.
>
> Additionally, a source 24 may be a source of medical imaging data that receives medical imaging data from yet another source 24. For example, a source 24 may be a linear tape deck that is recording live video as it supplies the video to the computer 20. The linear tape deck, in turn, may receive the live video from an endoscopic camera presently being used on a patient, as is further described below. As another example, a source 24 may be a processor for routing images from multiple other sources 24 to the computer 20 (i.e., a screen splitter), such as a quad image processor.

Id. at col. 4, ll. 39–66 (emphases added). As is clear from this extensive discussion in the Specification, medical imaging data is not limited to data acquired "during a

medical procedure," as proposed by Petitioner. Data may come from storage or archival sources or from a hospital information system.

Moreover, the prosecution history cited by Petitioner (Pet. 5–6, citing Ex. 1002) belies Petitioner's proposed construction. During prosecution of the application that matured into the '420 patent, the applicant stated

> [t]he present invention is directed to a system that provides a central point from which a user can control the routing of *medical imaging data*. With the improvement of various audiovisual devices and their increased incorporation into the operating room, it has become *common to have multiple sources of imaging data*, such as, for example, images from different types of cameras or images from different procedures (*such as previously stored diagnostic imaging and current, live video imaging*).

Ex. 1002, p. 114 (emphases added). Applicant referred to "previously stored diagnostic imaging," but did not define the term "diagnostic imaging." Our understanding of the term "diagnostic imaging" is that it is anything that provides images of inside the body, and includes X-rays, CT scans, Nuclear medicine scans, MRI scans, and Ultrasound. Ex. 3001.[2] It is *not* limited to data acquired *during* surgery or a "medical procedure."

Both parties use the phrase "medical procedure" in their respective claim interpretations, thus suggesting their agreement that the phrase "medical imaging data" is limited to something "medical." Neither party, however, directs us to any persuasive evidence that defines the phrase "medical procedure." Patent Owner suggests that the phrase "medical procedure" is limited to "diagnostic and surgical

[2] Ex. 3001 is a printout of the Medline Plus website http://www.nlm.nih.gov/medlineplus/diagnosticimaging.html (discussing various types of diagnostic imaging). MedlinePlus is the National Institutes of Health's website produced by the U.S. National Library of Medicine.

procedures." Prelim. Resp. 8 ("the ['420] patent discusses the need for improved medical imaging systems for performing 'diagnostic and surgical procedures' (i.e. medical procedures)"). Patent Owner, however, does not direct us to any evidence in the '420 patent or elsewhere supporting this proposed interpretation.

The Specification uses the phrase "medical procedure" only once, in the "Background" section of the Specification, to refer generally to "imaging devices potentially useful in a medical procedure." Ex. 1001, col. 1, ll. 63–67. The "Background" section of the Specification uses the word "procedure" or "procedures" several times to refer to diagnostic and surgical procedures. *E.g.*, *id.*, at col. 1, ll. 15–16 ("Today, a wide variety of medical imaging systems are known for performing diagnostic and surgical procedures"); col. 1, ll. 20–22 ("during various types of minimally invasive surgeries – such as endoscopic, arthroscopic, and laparoscopic procedures"); col. 1, ll. 28–31 ("to allow both the surgeon, as well as others in the surgical suite or located remotely therefrom who may be assisting or observing, to better monitor the procedure").

A medical dictionary definition of a "procedure is "[a] series of steps taken to accomplish an end;" [a] surgical operation or technique."[3]

As explained above, the '420 patent contains a detailed discussion of what is meant by the phrase "medical imaging data." Thus, the proposed interpretations replace the phrase "medical imaging data" with a new phrase, "medical procedure," of uncertain meaning. It is uncertain from the '420 patent, for example, whether a "medical procedure" is limited to active surgery, whether it also includes diagnostic medical images such as archival X-rays or photographs of a patient "before" and "after" surgery, or whether it is any "series of steps taken to

[3] *The American Heritage® Medical Dictionary*. (2007). Retrieved August 21 2015 from http://medical-dictionary.thefreedictionary.com/procedure.

accomplish an end." We see no benefit in substituting an uncertain term, "medical procedure," for the term "medical imaging data" used and described in the Specification.

We agree with the parties, however, that the word "medical" should not be eliminated from the properly construed claim language. Ultimately, the interpretation to be given a term can only be determined and confirmed with a full understanding of what the inventors actually invented and intended to envelop with the claim. *Renishaw PLC v. Marposs Societa' per Azioni*, 158 F.3d 1243, 1250 (Fed. Cir. 1998) (citing *Markman v. Westview Instruments, Inc.*, 517 U.S. 370, 389 (1996)). The construction that stays true to the claim language and most naturally aligns with the patent's description of the invention will be, in the end, the correct construction. *Id.* "A claim construction is persuasive, not because it follows a certain rule, but because it defines terms in the context of the whole patent." *Id.* "[C]laim terms are construed in light of the specification and prosecution history, not in isolation." *Pacing Technologies, LLC v. Garmin Int'l, Inc*., 778 F.3d 1021, 1024 (Fed. Cir. 2015).

Independent claims 1 and 79 each recite "[a] system for controlling the communication of *medical* imaging data." The claims refer repeatedly to "medical imaging data."

The Specification states that "[t]he *present invention* relates to a system for controlling the communication of medical imaging data." Ex. 1101, col. 1, ll. 7–8 (emphasis added). The Specification identifies six objectives "*of the present invention*" all focused on medical imaging data. *Id.* at col. 2, ll. 19–49 (emphasis added). To meet these objectives, the Specification states "*the invention comprises* a system for controlling the communication of medical imaging data," and

identifies the medical imaging components of the system. *Id.* at col. 2, ll. 50–65 (emphasis added).

Whether one considers the preamble to be limiting, and the Specification and prosecution history to be a clear disavowal or disclaimer to limit the claims, as found in *Pacing Technologies*, or whether one simply interprets the claims in light of the Specification, as we do here, it is clear that the broadest reasonable interpretation of the claims in light of the Specification is limited to a system for controlling the communication of medical imaging data. As stated above, both parties asserted a claim construction that limited the claims to *medical* procedures.[4]

Accordingly, for purposes of this Decision, based on the record before us, we determine that the term "medical imaging data" is *not* limited to data acquired during surgery or during a medical procedure. It comprehends all medical imaging information, including diagnostic imaging information, archival information, patient information, as well as other sources of medical imaging information referred to in the Specification.

We determine, for purposes of this Decision, that specific construction is not required of other terms in the challenged claims.

[4] Alternatively, we note that the specific recitation of "medical imaging data" may also be non-functional descriptive material which lacks patentable weight. Whether the recited "imaging data" is related to a medical application does not affect the other limitations of the claim, rather the information is simply routed to a destination. *In re Ngai*, 367 F.3d 1336, 1339 (Fed. Cir. 2004); *In re Gulack*, 703 F.2d 1381, 1385 (Fed. Cir. 1983) (holding when descriptive material is not functionally related to the substrate, the descriptive material will not distinguish the invention from the prior art in terms of patentability).

B. Asserted Grounds of Unpatentability

1. Anticipation by the SP3 Manual

Petitioner asserts that claims 1–4, 10, 12–14, 17, 22, 32–35, 37, 39, 40–43, 46–48, 50-53, 57, 68, 72-74, 76, 77, and 79–83 are anticipated under 35 U.S.C. § 102(b) by the SP3 Manual. Pet. 8. Patent Owner raises the threshold issue of whether the SP3 Manual is a "printed publication" under § 102(b). Prelim. Resp. 8. According to Patent Owner, Petitioner "has failed to show that the SP3 Manual was publicly accessible before the critical date of the '420 patent (December 29, 2003)." Prelim. Resp. 9. Patent Owner asserts that the SP3 Manual is "confidential" and is a "working draft," and thus, is not a printed publication. *Id.* We address first the threshold issue of whether the SP3 reference is a printed publication.

a. Printed Publication

Under 35 U.S.C. § 102(b), a person is entitled to a patent unless "the invention was patented or described in a printed publication in this or a foreign country . . . more than one year prior to the date of the application for patent in the United States." Whether a document qualifies as a printed publication under § 102 is a legal conclusion based on underlying factual determinations. *SRI Int'l, Inc. v. Internet Sec. Sys., Inc.*, 511 F.3d 1186, 1192 (Fed.Cir.2008) (citation omitted). "Public accessibility" has been called the touchstone in determining whether a reference constitutes a printed publication bar under 35 U.S.C. § 102(b). *Id.* at 1194. A reference is publicly accessible upon a satisfactory showing that it has been disseminated or otherwise made available to the extent that persons interested and ordinarily skilled in the subject matter or art exercising reasonable diligence, can locate it. *Bruckelmyer v. Ground Heaters, Inc.*, 445 F.3d 1374, 1378 (Fed. Cir. 2006).; *see also In re Cronyn*, 890 F.2d 1158, 1160 (Fed. Cir. 1989) ("The

statutory phrase 'printed publication' has been interpreted to mean that before the critical date the reference must have been sufficiently accessible to the public interested in the art; dissemination and public accessibility are the keys to the legal determination whether a prior art reference was 'published.'") (quoting *Constant v. Advanced Micro-Devices, Inc.*, 848 F.2d 1560, 1568 (Fed.Cir.1988)).

In *In re Klopfenstein*, 380 F.3d 1345 (Fed. Cir. 2004), our reviewing court rejected an argument that "distribution and/or indexing" are the key components to a "printed publication" inquiry because that argument "fails to properly reflect what our [Federal Circuit] precedent stands for," explaining that "printed publication" means reasonably accessible through generally available media that serve to disseminate information. *Id.* at 1348. A printed publication need not be easily searchable after publication if it was sufficiently disseminated at the time of its publication. *Suffolk Technologies, LLC v. AOL Inc.*, 752 F.3d 1358, 1364 (Fed. Cir. 2014).[5]

Where professional and behavioral norms entitle a party to a reasonable expectation that the information displayed will not be copied or disclosed, courts are more reluctant to find something a "printed publication." *Klopfenstein*, 380 F.2d at 1351. Where parties have taken steps to prevent the public from copying or disclosing information, the opportunity for others to appropriate that information and assure its widespread public accessibility is reduced. These protective measures could include license agreements, non-disclosure agreements, anti-copying software or a simple disclaimer informing members of the viewing public that no copying or disclosure of the information will be allowed. *Id.*

[5] As explained in *Klopfenstein*, the word "disseminate" is not used in its literal sense, i.e. "make widespread" or "to foster general knowledge of" and does not require distribution of reproductions or photocopies. 380 F.2d. at 1352, n. 3.

Protective measures are to be considered insofar as they create a reasonable expectation that the information will not be copied. *Id.*

The determination of whether a reference is a "printed publication" under 35 U.S.C. § 102(b) involves a case-by-case inquiry into the facts and circumstances surrounding the reference's disclosure to members of the public. *Klopfenstein*, 380 F.2d at 1350. [6]

Against this general background, we consider the evidence and arguments on which the parties rely.

Petitioner takes the position that the SP3 Manual is a "printed publication" within the meaning of § 102(b), and was first published "at least as early as October 21, 2002. Pet. 8. This date is prior to the critical date, December 29, 2003, one year before the filing date of the application that matured into the '420 patent. As support, Petitioner proffers declarations of Steven Maulick (Ex. 1009), Richard A. Beutter (Ex. 1010), Leif Nilsen (Ex. 1011), Jules Ryckebusch (Ex. 1012), and Amit Mahadik (Ex. 1013) to confirm the publication and authenticity of the SP3 Manual.

Patent Owner disagrees. Patent Owner asserts that Petitioner "has failed to show that the SP3 Manual was publically accessible" before December 29, 2003. Prelim. Resp. 9. Patent Owner asserts that the SP3 Manual is a confidential working draft, not a printed publication. *Id.* at 9–10.

b. The SP3 Manual

The SP3 Manual is a comprehensive, 99-page operations and maintenance manual for the Switch Point III, an integrated voice, video, and data router and

[6] *See also ServiceNow, Inc. v. Hewlett-Packard Co.*, Case IPR2015-00707, slip op. at 9–10 (PTAB Aug. 26, 2014) (Paper 12) (discussing case law and prior *inter partes* reviews that considered whether a document was a printed publication).

conferencing interface. Ex. 1003, p. 10. The SP3 Manual bears "Part # 0100-000-595 Rev D" and is dated "October 21, 2002." *Id.* at 2. It also bears a copyright notice stating "© Copyright 2002 Stryker Communication Corporation." *Id.*

A "confidential" notice appears in seven different places in the 99-page Manual, including the front cover, and on the first page of each of the Manual's four chapters, the Appendix, and the Technical Bulletins. *Id.* at 1 (front cover), 9 (Chapter 1), 17 (Chapter 2), 33 (Chapter 3), 71 (Chapter 4), 81 (Appendix), and 97 (Technical Bulletins). Each of the seven "confidential" notices is the same, and is reproduced below.

> This Operations and Maintenance Manual contains *confidential information that shall not be disclosed or duplicated for any reason other than to use and maintain a SwitchPoint III installation*. This restriction does not limit the right to use information contained in this manual if it is obtained from another source without restriction. The information subject to this restriction is contained in all pages of this manual.

Id. at 1 (emphasis added).

c. Petitioner's Declarations

(i). Steven Maulick

Steven Maulick states in his Declaration that he has been employed at Stryker Endoscopy (a division of Stryker Corporation) since 2000, and has been Associate Director or Manager of Engineering Services since 2003. Ex. 1009 ¶ 3. His responsibilities as Associate Director of Engineering Services include Document Control. *Id.* He also states that he has "personal knowledge regarding the records, documents, and manuals relating to the SwitchPoint III products made and kept by Stryker Endoscopy. *Id.* ¶ 5. A copy of the Exhibit 1003 Manual is attached to Mr. Maulick's Declaration as Declaration Exhibit A. Mr. Maulick states his "belief" and "understanding" that the Manual "was indeed a released

version that was shipped to customers as of October 2002." *Id.* ¶ 7. Mr. Maulick states he "confirmed" that the SP3 Manual was released in October 2002 by checking "physical copies of its legacy documents." *Id.* ¶ 8.

(ii). Richard A. Beutter

Richard A. Beutter states in his Declaration that he has been employed at either Stryker Communications or Stryker Endoscopy since 1997, and has been Vice President of Strategy for Stryker Communications since 2014. Ex. 1010 ¶3. Mr. Beutter previously served as Vice President of Research and Development for Stryker Communications. *Id.* ¶ 4. His responsibilities in this position included directing the activities of R&D managers who manage teams that design, develop, and maintain product lines, including SwitchPoint product lines. *Id.* Contrary to Patent Owner's argument (Prelim. Resp. 12), Mr. Beutter also states that he has been "personally involved with research and development for SwitchPoint products." *Id.*; *see also* Ex. 2001 (corrected), p. 19, ll. 3–18 (stating an "advisory-type role" in the SwitchPoint product on, among other topics, "why we have done something in the past," and stating that for four and a half years he was "in charge of the ORIS SwitchPoint family."). Mr. Beutter states that in his present position he has "personal knowledge regarding the records, documents, and manuals relating to the SwitchPoint III products made and kept by Stryker Communications." *Id.* ¶ 6.

According to Mr. Beutter's testimony, it was a "regular practice to include an Operations and Maintenance Manual with each sale of its SwitchPoint III product. *Id.* ¶ 7. He also states his "belief" that the SP3 Manual attached to his Declaration as Beutter Declaration Exhibit A "is the version that was released" once Engineering Change Notice ("ECN") #619, which is Beutter Declaration

Exhibit B, "had been authorized." *Id.* ¶ 12. Mr. Beutter does not state his belief of the date of authorization.

ECN #619 was reviewed and approved by various people from ten different departments. Ex. 1010 p. 109. The approvals by eight of the departments are dated before October 21, 2002. *Id.* These dates are consistent with Mr. Maulick's testimony that the SP3 Manual "was released in October 2002." Ex. 1009 ¶¶ 7, 8. It also is consistent with the SP3 Manual itself, which is "Dated: October 21, 2002." Ex. 1003 p. 2. At least one of the approvals, however, the approval for "Regulatory," is dated "10/23/02," which, as Patent Owner correctly observes (Prelim. Resp. 14), is after the October 21, 2002 date printed on the SP3 Manual. Ex. 1010 p. 109.[7] Even if Exhibit 1003 was publicly accessible on October 23, 2002, or even the last day of October[8], it would still be available as reference against the '420 patent.

Mr. Beutter also testifies that as of April 16, 2002, a copy of the SP3 Manual "was included as a matter of course in each shipment of the SwitchPoint III product." Ex. 1010 ¶15. Additionally, Mr. Beutter testifies that the "SwitchPoint III product was advertised to potential customers." *Id.* ¶ 16. According to Mr. Beutter's testimony, "*[a] customer or any other member of the public could also have obtained a copy of the SP3 Manual by calling Stryker and requesting one*." *Id.* (emphasis added).

Patent Owner asserts nine reasons why Mr. Beutter's Declaration is "deficient." Prelim. Resp. 12–17. Patent Owner asserts that Mr. Beutter "had no

---

7 We have referred to 9 of the 10 reviews and approvals. The date of the approval for "Documentation" is not clear from the copy of the exhibit available to us. We decline to speculate on this date.

8 Mr. Maulick states he "confirmed" that the SP3 Manual was released in October 2002 by checking "physical copies of its legacy documents." Ex. 1009 ¶ 8.

involvement in the SwitchPoint product or SwitchPoint family." *Id.* at 12 (citing Ex. 1010 ¶ 4; Ex. 2001). As discussed above, the cited evidence does not support Patent Owner's argument.

Patent Owner also argues that Mr. Beutter's "mere 'belief' is insufficient to show that Ex. 1003 was publicly accessible before the '420 patent's critical date." *Id.* at 13. Our review of the Petition under 35 U.S.C. § 314 is not to determine whether an individual asserted fact is indisputable. Our review is to determine whether the totality of the information presented in the Petition and Preliminary 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. "The 'reasonable likelihood' standard is a somewhat flexible standard that allows the Board room to exercise judgment." Office Patent Trial Practice Guide, 77 Fed. Reg. 48,756, 48,765 (Aug. 14, 2012). Whether a petitioner has met the threshold is considered on a case-by-case basis. As discussed above, Mr. Beutter's "belief" is based on factual information. That factual information and his testimony are part of the totality of the evidence in the present record that persuades us that there is a reasonable likelihood Petitioner will prevail with respect to at least one of the challenged claims.

Patent Owner argues that the 2002 copyright notice on the SP3 Manual "does not mean that the Manual was publicly accessible in 2002." Prelim. Resp. 13. We agree. A copyright notice informs the public that copyright protection is claimed, identifies the copyright owner, and states the asserted year of first publication. 17 U.S. C. § 401. The purpose of a copyright notice is, simply, to put a reader on notice that a claim has been made that the work is copyrighted. It does not establish copyright protection and is not required. It also does not

establish when a document was publicly accessible under patent law.[9] In weighing the evidence, we note merely that the 2002 copyright notice printed on the SP3 Manual is not inconsistent with Petitioner's assertion that the Manual was publicly accessible on October 21, 2002.

Patent Owner argues that metadata for Exhibit 2002, an apparent draft version of the SP3 Manual, shows the file name on the Exhibit 2002 draft version was "SwitchPoint III Manual Draft of Rev D as of 20 Sept. 2002.pdf." Prelim. Resp. 13. The Exhibit 2002 document cited by Patent Owner, however, is different from the document on which Petitioner relies, which is Exhibit 1003. The fact that a different document, Exhibit 2002, which Patent Owner acknowledges was referred to as a "draft," has a file name indicating it was a "draft," is not persuasive as to the date Exhibit 1003 was publicly accessible.

Patent Owner asserts that Exhibit 1003 "is *likely* just one of many drafts of Rev D rather than a published version." *Id.* (emphasis added). Patent owner cites no evidence to support this speculation.

Patent Owner states accurately that "ECN #619 does not have an 'Effective Date.'" Prelim. Resp. 14 (citing Ex. 1010 at 109 showing a blank "Effective Date" field). ECN #619 is dated "9/24/02." Mr. Maulick states he "confirmed" that the SP3 Manual was released in October 2002 by checking "physical copies of its legacy documents." Ex. 1009 ¶ 8. Thus, whether the ECN #619 document has, or does not have, an effective date written on the document, there is evidence that the SP3 Manual (Ex. 1003) was publicly accessible no later than October 31, 2002.

[9] *See ServiceNow v. Hewlett-Packard Co.*, Case IPR2015-00707, slip op. at 17 (Paper 12) discussing reliance on a copyright notice as evidence that a reference was a printed publication.

Patent Owner also asserts that Exhibits C, D, and E to Mr. Beutter's Declaration fail to support Petitioner's argument," noting that there are several date and signature discrepancies, as well as other issues. Prelim. Resp. 15–16. Beutter Declaration Exhibit C is a copy of ECN #642. Ex. 1010 ¶ 13. Mr. Beutter relies on Exhibit C to show that "the SP3 Manual was identified as a part or accessory to be included in the packaging for all SwitchPoint modules." *Id.* Separately from any reference to or reliance upon ECN #642, Mr. Beutter also testifies that it was "regular practice to include an Operations and Maintenance Manual with each sale of its SwitchPoint III product." *Id.* ¶ 7.

Beutter Declaration Exhibit D is a copy of a Bill of Materials, dated April 4, 2003, for the "SP3 Modem." *Id.* ¶ 14. Mr. Beutter relies on Exhibit D to show that a copy of the SP3 Manual was included with the shipment of any SP3 Modem product.

Beutter Declaration Exhibit E is a copy of a Device History Record. *Id.* ¶ 15. Mr. Beutter relies on Exhibit E to show that a copy of the SP3 Manual was "included as a matter of course" in each shipment of the SwitchPoint III product.

For purposes of this Decision, based on the record before us, we agree with Patent Owner's observations about the probative weight of Beutter Declaration Exhibits C, D, and E, and we have considered Patent Owner's observations in weighing the totality of the evidence.

As its final argument regarding the probative weight of the Mr. Beutter's Declaration, Patent Owner asserts that Mr. Beutter's testimony concerning advertising and public accessibility is "conclusory," unsupported by citation to other evidence, and inconsistent with the confidential notice on the SP3 Manual.

We have considered Patent Owner's position in weighing the totality of the evidence and it probative effect.

iii. Leif Nilson

Mr. Nilson has been employed by Stryker Corporation since 2001. Ex. 1011, ¶ 3. Currently, he is Director of Finance for Stryker Neurovascular. *Id.* ¶ 1. Mr. Nilson testifies that the current version of the SP3 Manual included as Exhibit A to the Nilson Declaration would have been included in the shipment of parts shown in Exhibit B of the Nilson Declaration. *Id.* ¶ 6. Mr. Nilson states his belief that each of the shipments shown in Exhibit C of his Declaration would have included the "current released version of the SP3 Manual as part of the shipped materials." *Id.* ¶ 7. Mr. Nilson also testifies that Stryker "would also ship the SP3 Manual by itself if a customer requested a copy of that document." *Id.* ¶ 8. Mr. Nilson further testifies that "salespeople were often provided with multiple copies of Stryker's manuals, including the SP3 Manual, so that they could freely distribute the manuals to existing or potential customers." *Id.* Mr. Nilson also identifies actual shipments of the Manual to customers. *Id.* ¶ 9. Mr. Nilson states that the SwitchPoint III product "was advertised to potential customers." *Id.* ¶ 10.

iv. Jules Ryckebusch

Mr. Ryckebusch also has been employed by Stryker since 2001 and is a current employee. Ex. 1012 ¶¶ 1, 3. Mr. Ryckebusch testifies that he remembers that during the period from 2002–2005 the SP3 Manual was given to customers who requested a Manual and at training sessions for biomedical engineers who worked at hospitals where a SwitchPoint III system was installed. *Id.* ¶¶ 4, 5. Mr. Ryckebusch also testifies that the Manual "was not treated as confidential in any way" and that "[t]here were no confidentiality restrictions placed on information provided at those training sessions." *Id.*

Patent Owner asserts that the Maulick, Nilson, and Ryckebusch Declarations "are deficient" for the same reasons asserted against the Beutter Declaration, as well as other reasons. Prelim. Resp. 17–19.

Based on the evidence, discussed above, through advertising, any interested member of the public would have been aware of, and able to purchase, the SwitchPoint III, and thereby obtain access to the SP3 Manual. The need to purchase a system to obtain a manual goes to its cost, not its accessibility. The testimony also establishes, however, that manuals were available to potential customers from sales persons, or upon general request to Stryker. Copies of the Manual also were distributed for training. The testimony also establishes that the confidentiality restriction, which appears on the SP3 Manual and limits disclosure of information, was not enforced, because, according to the testimony, the Manual was not treated as confidential and that there were no confidentiality restrictions placed on the Manual when used in training engineering personnel on how to operate the SwitchPoint III system.

We have considered all of Patent Owner's assertions regarding whether the SP3 Manual is a printed publication. We also recognize that Patent Owner has not had an opportunity to cross-examine the testimony of Petitioner's declarants, nor has Patent Owner had an opportunity to submit its own testimonial evidence. Our Decision reflects our determination that, at this preliminary stage of an *inter partes* review, based on the weight of the evidence before us, Petitioner has demonstrated sufficiently that prior to December 29, 2003, the SP3 Manual (Ex. 1003) had been disseminated or otherwise made available to the extent that persons interested and ordinarily skilled in the subject matter, exercising reasonable diligence, could have located it and obtained a copy. Thus, on this record, we are persuaded that the SP3 Manual is a "printed publication" under 35 U.S.C. § 102(b).

We now return to the merits of Petitioner's asserted grounds of unpatentability.

d. Ground 1. Claims 1–4, 10, 12–14, 17, 22, 32–35, 37, 39, 40–43, 46–48, 50–53, 57, 68, 72–74, 76, 77, and 79–83

Petitioner asserts claims 1–4, 10, 12–14, 17, 22, 32–35, 37, 39, 40–43, 46–48, 50–53, 57, 68, 72–74, 76, 77, and 79–83 are anticipated under 35 U.S.C. § 102(b) by the SP3 Manual.

"[U]nless a reference discloses within the four corners of the document not only all of the limitations claimed but also all of the limitations arranged or combined in the same way as recited in the claim, it cannot be said to prove prior invention of the thing claimed and, thus, cannot anticipate under 35 U.S.C. § 102." *Net MoneyIN, Inc. v. VeriSign, Inc.*, 545 F.3d 1359, 1371 (Fed. Cir. 2008). *See also Verdegaal Bros. v. Union Oil Co.*, 814 F.2d 628, 631 (Fed. Cir. 1987) ("A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference."). "The identical invention must be shown in as complete detail as is contained in the . . . claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236 (Fed. Cir. 1989).

i. Independent Claims 1 and 79

Patent Owner takes issue with only two elements in claims 1 and 79. First, Patent Owner argues that the SP3 Manual does not disclose a "touchscreen controlled by said computer," as required by independent claims 1 and 79. Prelim. Resp. 21. The Specification of the '420 patent discloses, and Figure 1 illustrates, computer 20. As shown in Figure 1, computer 20 is part of touchscreen 22. The Specification states that computer 20 controls touchscreen 22. Ex. 1001, col. 4, ll. 34–35. Neither Patent Owner nor Petitioner directs us to evidence further

explaining this cursory disclosure in the Specification. We understand from the general disclosure of the '420 patent that computer 20, like all computers, has an operating system and software that is responsive to inputs from a user. *Id.* at col. 5, ll. 11–12. In the '420 patent those inputs are provided by a touchscreen, just as in the SP3 Manual. According to Patent Owner, the SP3 Manual "does not state or suggest that the 'onboard computer' controls the Touchpanel Interface." *Id.* It is Patent Owner's position that the touchscreen in the SP3 Manual controls the onboard computer, rather than the converse, as stated in the claims. Patent Owner asserts that "it appears to be the 'Touchpanel Interface that controls computers in the SP3 system." *Id.* The fact that the touchscreen in the SP3 Manual controls the "system," does not mean the touchscreen controls the onboard computer. The touchscreen in the SP3 Manual does not do or control anything unless it is programmed to do so through the onboard computer during system setup. Ex. 1003, 82–86. Based on the evidence of record, and for purposes of this Decision, we determine that the touchscreen in the SP3 manual is controlled by the onboard computer.

Second, regarding claim 79, Patent Owner asserts that the SP3 Manual does not disclose software executing on the computer for displaying on the touchscreen a plurality of source and destination icons corresponding to the plurality of sources and destinations from which the user can select. Prelim. Resp. 22. The Specification states that computer 20 includes software that causes touchscreen 22 to simultaneously display source icons 34 and destination icons 36.

Petitioner asserts that the claimed software is disclosed in the SP3 Manual. Pet. 13 (citing Ex. 1003, 10, 19, 36, 78). The cited pages all disclose operating software that we determine for purposes of this Decision is executed by the onboard computer. We also note that software executed by the onboard computer

is used for assigning and naming routing buttons for routing medical image data from a source to a destination. Ex. 1003, 84–86.

Accordingly, for purposes of this Decision, and based on the record before us, we determine that the SP3 Manual discloses the "software" limitations in claim 79.

We have considered Petitioner's evidence as to the other claim elements in claims 1 and 79 and determine that each of those other elements is disclosed, either expressly or inherently, in the SP3 Manual arranged in the same way as recited in claims 1 and 79.

Based on our analysis above, we determine, for purposes of this Decision, that there is a reasonable likelihood that Petitioner would prevail in establishing that claims 1 and 79 are anticipated by the SP3 Manual.

ii. The Dependent Claims

Patent Owner does not take issue with every dependent claim. We address first the dependent claims with which Patent Owner takes issue.

(a). Claims 3 and 81

Claims 3 and 81 recite that the display window (claim 3) or medical images (claim 81) are located "between the plurality of source icons and the plurality of destination icons."

Patent Owner asserts that the SP3 Manual does not disclose that the display window on the touchscreen (claim 3) or the medical images on the touchscreen (claim 81) are not located "between" the source and destination icons on the touchscreen, as recited in claims 3 and 81. The Specification states simply that "[i]n some embodiments, the display window 40 is located between the source icons 34 and the destination icons 36." Ex. 1001, col. 5, ll. 56–57.

Petitioner asserts that the preview screen disclosed in the SP3 Manual is a display between the source and display icons as recited in claims 3 and 81. Pet. 15 (citing Ex. 1003, 48.). Page 48 of the Manual, shown below, discloses a preview display window in the lower left hand corner of the touchscreen, with source icons and display icons to the right of the display window.

PREVIEWING VIDEO SOURCES

The SwitchPoint III displays a preview image of selected video sources directly on the touchpanel eliminating the need for an external preview monitor. To preview a Source, select the "Video Router" menu from the list of functions on the Menu Bar. The Video Router menu will display a list of **Sources** and **Devices** or **Displays** available within the Endosuite® OR or other hospital location. Select from the "**Sources**" list. A preview of that source will immediately be visible in the "preview" window in the lower left-hand corner of the touchpanel.

Ex. 1003, pg. 48, showing a preview window with source and display icons.

An ordinary and customary meaning of the word "between" is "intermediate to" or "connecting spatially."[10] We determine that the display window in the lower left corner of the image shown on page 48 of the SP3 Manual is *not* intermediate to the source and display icons shown in the figure. Thus, the preview window is *not* arranged in the same way as recited in claims 3 and 81.

Petitioner also asserts that the SP3 Manual discloses that the display window and displayed medical images can be shown on the touch screen in various sizes

[10] *American Heritage® Dictionary of the English Language, Fifth Edition*. Retrieved August 26 2015 from http://www.thefreedictionary.com/between.

and positions. Pet. 16 (citing Ex. 1008 ¶ 53). Petitioner then argues that "a person of ordinary skill would know how to place the display window "between" the source and destination icons" because "the placement of the display window and/or medical images has no impact on the functionality of the system and is entirely a design choice." Design choice modifications that would have been known to a person of ordinary skill are irrelevant to whether a reference anticipates a claim under 35 U.S.C. § 102. *Titanium Metals Corp. v. Banner*, 778 F.2d 775, 780 (Fed. Cir. 1985) ("[A]nticipation under § 102 can be found only when the reference discloses exactly what is claimed and that where there are differences between the reference disclosure and the claim, the rejection must be based on § 103 which takes differences into account.").

Accordingly, based on the information in the Petition and Preliminary Response, we determine that the Petition does *not* establish a reasonable likelihood that the SP3 Manual anticipates claims 3 and 81.

(b). Claim 22

Patent Owner asserts that claim 22 in not anticipated because the SP3 Manual does not disclose a "source of medical imaging data includes a processor for routing medical imaging data from a plurality of other sources to the computer simultaneously," as recited in claim 22. Prelim. Resp. 24.

The Specification of the '420 patent discloses that source 24 may be a processor for routing images from multiple other sources 24 to computer 20 (i.e., a screen splitter), such as a quad image processor. Ex. 1001, col. 4, ll. 64–66. As shown in Figure 9, the screen splitter is a distinct source icon. Upon selecting the screen splitter as the source, display window 40 divides into a plurality of sections 120 for separately displaying medical images generated from other sources. *Id.* at col. 8, ll. 33–42.

Neither party directs us to a definition of the term "processor" as used in claim 22. An ordinary and customary meaning of this term in the context of computer-controlled devices, such as a touchscreen, is a "key component of a computing device that contains the circuitry necessary to interpret and execute electrical signals fed into the device."[11]

Petitioner asserts that the "Picture-in-Picture or PIP" feature described in the SP3 Manual discloses the processor source recited in claim 22. Pet. 21 (citing Ex. 1003, 49). The SP3 Manual discloses that a "Picture-in-Picture or PIP is an optional feature on the SwitchPoint III that allows you to display up to 2 sources simultaneously on a single video monitor or flat panel display." Ex. 1003, 49. Based on this disclosure, we determine that the two simultaneous sources meet the limitation in claim 22 of a plurality of simultaneous sources. The Manual describes that pressing an icon activates this feature. *Id.* Based on the disclosure in the Manual, it is inherent in the disclosure that pressing an icon activates an electrical signal in the touchscreen, which is interpreted and executed by the onboard computer, i.e., a processor. *E.g.*, *Id.* at 34 ("The Touchpanel Interface controls nearly every function of the SwitchPoint III.").

Accordingly, based on the analysis above, and for purposes of this Decision, we determine that the SP3 Manual discloses a processor source for displaying a plurality of sources simultaneously, and thus there is a reasonable likelihood that the SP3 Manual anticipates claim 22.

(c). Claim 72

Claim 72 adds a "speakerphone icon" to the touchscreen for displaying controls associated with a speakerphone. As described in the Specification, and as

[11] Dictionary.com. *Dictionary.com Unabridged*. Random House, Inc. http://dictionary.reference.com/browse/processor (accessed: August 26, 2015).

illustrated in Figure 19, the user can press speakerphone icon 178 to display various controls associated with a speakerphone, such as speed dial buttons 180 for storing phone numbers, number pad 182 for entering the numbers, and buttons 184 for controlling volume. Ex. 1001, col. 9, ll. 33–37.

Patent Owner asserts that Petitioner "fails to identify a speakerphone icon in the SP3 Manual." Prelim. Resp. 24. According to Patent Owner, a phone key pad, as shown in the SP3 Manual is not a speakerphone icon on the touchscreen, as claimed.

Petitioner asserts that the SP3 Manual discloses "a 'Video Call' button on the CODEC menu," whereby pressing this button brings up a keypad that enables the user make a phone call. Pet. 30 (citing Ex. 1003, 63–66). Petitioner also asserts that the SP3 Manual discloses room speakers for "OR-Based Conferencing" and a surgeon's wireless microphone, which are accessories used in placing a speakerphone call. Claim 72 does not require speakerphone capability, which the SwitchPoint III system may have. It specifically requires a speakerphone icon on the touchscreen interface. The SwitchPoint III has the capability to add and name icons. Ex. 1003, 83–86. It may be possible to add a speakerphone icon, but Petitioner has not directed us to any disclosure so stating that this could be done.

In order for a reference to anticipate a claim, the identical invention must be shown in as complete detail as is contained in the claim." *Richardson v. Suzuki*, 868 F.2d at 1236. Claim 72 requires a specific speakerphone icon on the touchscreen. The SP3 Manual does not disclose such an icon on the touchscreen. Accordingly, based on the information in the Petition and Preliminary Response, we determine that the Petition does *not* establish a reasonable likelihood that the SP3 Manual anticipates claim 72.

(d). Claim 74

Claim 74 recites "a palette" containing source icons for communicating medical imaging data to a remote user, a display window for the images, and "controls" associated with the selected source and "controls" associated with "videoconferencing." As shown in Figure 1 and described in the Specification, touchscreen 22 includes a set of controls 50 associated with selected source 24, allowing the user to actively control the selected source 24 based on the images the user is viewing in display window 40. Ex. 1001, col. 6, ll. 1–4. Controls 50 are specific to each source 24 that has been selected by the user. *Id.* at col. 6, ll. 10–11. As shown in Figure 2, for example, if the selected source 24 is a tape deck, controls 50 may include play, stop, rewind, fast forward, and record buttons. *Id.* at col. 6, ll. 11–13. The specification also discloses that if a user would like to choose an available source not presently displayed on the touchscreen, or if a user would like to choose a destination that is remote (i.e., not in the surgical suite), the user may display "palettes" containing these additional sources and destinations. Ex. 1001, col. 5, ll. 24–28. Thus, "palettes" are additional screens with additional icons.

Patent Owner asserts that the "Remote Rooms" and "Video Router" asserted by Petitioner "are depicted as different features that are triggered by pressing two different buttons," which don't meet the limitations in claim 74. Prelim. Resp. 25–26. Patent Owner also asserts that the disclosure in the SP3 Manual on which Petitioner relies allows the medical imaging data to be communicated from a remote room to the user, not the converse as asserted to be required by claim 74. *Id.*

Petitioner asserts that "[t]he Figure shown below, which depicts the "Off Site Control" menu on the SwitchPoint touch panel, *discloses most of these claim*

elements." Pet. 30 (citing Ex. 1003, 62) (emphasis added). The figure cited by Petitioner is reproduced below, as annotated by Petitioner.

Ex. 1003, p.62 annotated by Petitioner

Following this annotated figure, Petitioner quotes or paraphrases the text on page 62 of the SP3 Manual without any further analysis or discussion of how this figure or text discloses "most of" the claim elements. *Id.*

As discussed above, in order for a reference to anticipate a claim, the *identical invention* must be shown *in as complete detail* as is contained in the claim. *Richardson v. Suzuki*, 868 F.2d at 1236. Disclosing "most of" the claim elements does not satisfy the requirements for anticipation.

Petitioner has the burden of proof to establish unpatentability by a preponderance of the evidence. 35 U.S.C. § 316(e). The petition must include a full statement of the reasons for the relief requested, including a detailed explanation of the significance of the evidence. *Id.* § 42.22(a). It is Petitioner's responsibility "to explain specific evidence that support its arguments, not the

Board's responsibility to search the record and piece together what may support Petitioner's arguments." *Dominion Dealer Solutions, LLC v. Autoalert, Inc*., Case IPR2013-00225, slip op. at 4 (PTAB Oct. 10, 2013) (Paper 15). "Thus, we will address only the basis, rationale, and reasoning put forth by the Petitioner in the petition, and resolve all vagueness and ambiguity in Petitioner's arguments against the Petitioner." *Liberty Mutual Ins. Co. v. Progressive Casualty Ins. Co.*, Case CBM-2012-00003, slip op. at 10 (PTAB Oct. 25, 2012) (Paper 8).

Based on the information in the Petition and Preliminary Response, we determine that the Petition does *not* establish a reasonable likelihood that the SP3 Manual anticipates claim 74.

(e). Anticipation of the Remaining Dependent Claims for Ground 1

We have considered the information in the Petition asserting anticipation of dependent claims 2, 4, 10, 12–14, 17, 22, 32–35, 37, 39–43, 46–48, 50–53, 57, 68, 73, 76, 77, 80, 82[12], and 83. Patent Owner does not provide any specific argument against the asserted anticipation of these claims. Based on the information in the Petition and Preliminary Response, we determine that the Petition establishes a reasonable likelihood that the SP3 Manual anticipates claims 2, 4, 10, 12–14, 17, 22, 32–35, 37, 39–43, 46–48, 50–53, 57, 68, 73, 76, 77, 80, 82, and 83.

[12] There is an inconsistency in the Petition concerning claim 82. Petitioner includes claim 82 in the list of claims asserted to be anticipated. Pet. 4, 8. Petitioner also argues that claim 82 would have been obvious. *Id.* at 16–18. Petitioner states, however, "[t]he SP3 Manual is missing only the narrow limitations of dependent claims 6, 7, 9, 54, 55, and *82*, which would have been obvious. *Id.* at 8 (emphasis added). This inclusion of claim 82 in the list of claims for which the SP3 Manual is "missing" limitations appears to have been a typographical error, in light of the consistent inclusion of claim 82 as being anticipated and the argument that claim 82 is anticipated by the SP3 Manual. Accordingly, we consider Petitioner's arguments that claim 82 is anticipated for purposes of this Decision on Institution.

e. Ground 2. Claims 3, 4, 6, 7, 9, 54, 55, 81, and 82

Petitioner asserts that claims 3, 4, 6, 7, 9, 54, 55, 81, and 82 would have been obvious under 35 U.S.C. § 103(a)[13] based on the combined disclosures of the SP3 Manual and Howell.

Section 103(a) precludes issuance of a patent when "the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains." 35 U.S.C. § 103(a). In *Graham v. John Deere Co.*, 383 U.S. 1 (1966), the Court set out a framework for applying the statutory language of § 103:

> Under § 103, the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved. Against this background, the obviousness or nonobviousness of the subject matter is determined.

Id., at 17–18. "While the sequence of these questions might be reordered in any particular case, the factors continue to define the inquiry that controls." *KSR Int'l. v. Teleflex Inc.*, 550 U.S. 398, 407 (2007).

The Supreme Court has made clear that we apply "an expansive and flexible approach" to the question of obviousness. *Id.* at 415. Whether a patent claiming the combination of prior art elements would have been obvious is determined by whether the improvement is more than the predictable use of prior art elements according to their established functions. *Id.* at 417. To reach this conclusion, however, requires more than a mere showing that the prior art includes references

[13] The Leahy-Smith America Invents Act ("AIA"), Pub. L. No. 112-29, 125 Stat. 284, 296–07 (2011), took effect on September 16, 2012. Because the application for the patent at issue in this proceeding has an effective filing date before that date, we refer to the pre-AIA versions of § 103.

covering each separate limitation in a claim under examination. *Id.* at 418 ("a patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art"). Rather, obviousness requires the additional showing that a person of ordinary skill at the time of the invention would have selected and combined those prior art elements in the normal course of research and development to yield the claimed invention. *Unigene Labs., Inc. v. Apotex, Inc.*, 655 F.3d 1352, 1360 (Fed. Cir. 2011).

Against this general background, we consider the references, other evidence, and arguments on which the parties rely.

i. Claims 3 and 81

Claims 3 and 81 recite that the display window (claim 3) or medical images (claim 81) are located "between the plurality of source icons and the plurality of destination icons."

Petitioner asserts that Figure 3 of Howell discloses "presentation" and "preview" windows centrally located on the touch screen. Figure 3 from Howell is reproduced below.

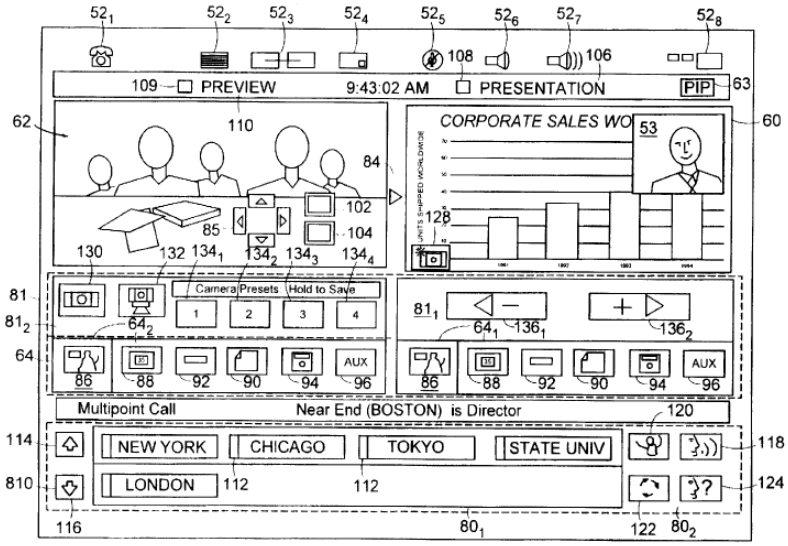

FIG. 3

Figure 3 from Howell showing a touchscreen with a preview window and a presentation window.

Howell discloses video display section 26 arranged to control the distribution of audio and video information signals selectively in accordance with command signals fed to the control section 24. Ex. 1004, col. 3, ll. 34–39. In one disclosed embodiment, video display section 26 is a touchscreen display 27 driven by a microprocessor. *Id.* at col. 5, ll. 10–12. The Howell system operates in one of two primary video display modes, a "Main screen" mode and a "Mark-up" mode, each with a different display. *Id.* at col. 5, ll. 17–20. The "Main screen" mode is shown in Figure 3. *Id.* at col. 6, ll. 6. In the "Main screen" mode, video display touch screen 27 is divided into two half areas; "presentation" display area 60 and "preview" display area 62. *Id.* at col. 6, ll. 6–14. "Presentation" and "preview" display areas 60, 62 are displayed simultaneously on touch screen display 27 during the "Main-screen" mode. *Id.* at col. 7, ll. 52–55.

As shown in Figure 3 of Howell, the "Main-screen" mode divides display 27 into five basic areas: "preview" display area 62 on the left; "presentation" display area 60 on the right; site selection area 80 (*see* Figure 2) disposed along the bottom

of the "presentation" display area 60 and "preview" display area 62; video source selection area 64; a video source control area 81 directly under the "presentation" and "preview" display areas 60, 62. *Id.* at col. 7, ll. 55–63. Also, there are eight "hard button" icons 52_1-52_8 disposed across the top of touch screen display 27. *Id.* at col. 5, ll. 33–38. As shown and described in Howell, "presentation" screen 60 and preview screen 62 are located between "hard button" icons 52_1-52_8 and icons in the site selection area 80, the video source control area 81, and the video source selection area 64. Thus, Howell discloses that the display or image area on the touchscreen is located between various source icons. Petitioner does not direct us to persuasive evidence that Howell discloses a plurality of destination icons.

Petitioner asserts that, based on Howell, a person of ordinary skill "would have known how" to place these display windows between the source and destination icons, as recited by claims 3 and 81. Pet. 46 (citing Ex. 1008 ¶ 78). Petitioner also asserts that a person of ordinary skill "would know how to rewrite the relevant software of the SP3 system to move the display window to a particular location on the touch screen, which would be a trivial change to implement." *Id.* at 46–47 (citing Ex. 1008 ¶ 80). These are not the tests for obviousness. They do, however, reflect classic hindsight in that they use the claimed invention as a guide for combining references. *W.L. Gore & Assoc., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1553 (Fed. Cir. 1983) ("To imbue one of ordinary skill in the art with knowledge of the invention in suit, when no prior art reference or references of record convey or suggest that knowledge, is to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher.").

Petitioner also asserts that Howell suggests the proposed combination of elements because Howell discloses icons representing video *sources* are disposed

in the display section for easy actuation. Pet. 46 (citing Ex. 1004, col. 2, ll. 5–9). Howell's disclosure does not mention destination icons. Petitioner does not direct us to persuasive evidence that *source icons in the display section* would have suggested to a person of ordinary skill having the display section *between source icons and destination icons*, as recited in claim 3.

Petitioner also asserts that the proposed modification is "entirely a design choice that would serve no technical function whatsoever." *Id.* at 47. Petitioner provides no persuasive evidence to support this conclusion. We recognize that a person of ordinary skill is also a person of ordinary creativity, not an automaton. *KSR*, 550 U.S. at 421. We acknowledge that rearranging icons on a computer screen may seem today like a simple, common sense modification. We do not abandon our common sense when considering the issue of obviousness. *Id.* The mere recitation of the words "common sense" or "design choice," however, without any evidentiary support, adds nothing to the obviousness equation. *Mintz v. Dietz & Watson, Inc.*, 679 F. 3d 1372, 1377 (Fed. Cir. 2012). Here, we lack the evidentiary support required.

The evidence and arguments in the Petition do *not* persuade us that there is a reasonable likelihood that Petitioner would prevail in establishing that claims 3 and 81 are unpatentable. Our determination is that on this record Petitioner did not meet its burden of establishing a reasonable likelihood of unpatentability of claims 3 and 81.

ii. Claims 4 and 82

Claims 4 and 82 recite that there is a source indicator located adjacent to the display window, wherein the source indicator corresponds to the selected source.

We determined above that there is a reasonable likelihood that Petitioner will prevail in establishing that the SP3 Manual anticipates claims 4 and 82.

Generally speaking, and we find applicable here, "anticipation is the 'epitome of obviousness.'" *Cohesive Techs., Inc. v. Waters Corp.*, 543 F.3d 1351, 1363–64 (Fed. Cir. 2008) (quoting *In re Kalm*, 378 F.2d 959, 962 (CCPA 1967)); *Jones v. Hardy*, 727 F.2d 1524, 1529 (Fed. Cir. 1984) (noting that "though anticipation is the epitome of obviousness, [they] are separate and distinct concepts"). Also, as discussed above, both the SP3 Manual and Howell disclose a source indicator adjacent the display window.

Patent Owner asserts that Howell does not disclose that software executes on the computer as required by claim 82. Prelim. Resp. 29. Patent Owner also asserts that Howell does not cure the alleged deficiencies in the disclosure of the SP3 Manual argued by Patent Owner. *Id.* at 29–30. As discussed above, we found unpersuasive Patent Owner's arguments concerning the alleged deficiencies in the disclosure of the SP3 Manual.

Accordingly, we are persuaded that there is a reasonable likelihood that Petitioner would prevail in establishing that claims 4 and 82 would have been obvious based on the SP3 Manual and Howell.

iii. Claims 6, 7, 54, 55

Claims 6 and 54 recite that the source indicators or virtual buttons comprise "a graphic corresponding to the selected source." Claims 7 and 55 recite that the graphics comprise "a graphical representation of the selected source.

The Specification states that in some embodiments the source icons 34 and destination icons 36 are virtual buttons; in other embodiments, icons 34 may include a graphical representation of the corresponding source 24 or a logo representing the corresponding source 24. Ex. 1001, col. 5, ll. 30–36.

The SP3 Manual uses words on the source indicators. Howell discloses the use of graphics to indicate sources. Pet. 50–51 (citing Ex. 1004). Petitioner asserts

it would have been obvious to use the graphic of Howell rather than the words of the SP3 Manual because source icons enable users to quickly and easily identify which icon corresponds to a particular source. Pet. 52.

Patent Owner asserts that modifying the buttons of the SP3 system to display graphics or graphical representations "would likely entail a substantial system overhaul at least at the software level" and is "completely unnecessary." Prelim. Resp. 30. Patent Owner cites no evidence to support its assertion. Patent Owner also repeats its position that Howell does not cure the asserted deficiencies in the disclosure of the SP3 Manual.

Based on our analysis above, we determine that that there is a reasonable likelihood that Petitioner would prevail in establishing that claims 6, 7, 54, and 55 would have been obvious based on the SP3 Manual and Howell.

iv. Claim 9

Claim 9, which depends from claim 6, recites that touchscreen comprises text describing the selected source adjacent to the source indicator.

Petitioner asserts the SP3 Manual discloses that each source icon includes text identifying the source by name. Pet. 54 (citing Ex. 1003, 45). *See also* Ex. 1003 pp. 84–86 (describing how to assign and name routing buttons).

Patent Owner repeats its assertions for claim 6, discussed above, and for claim 1.

Based on our analysis above, we determine that that there is a reasonable likelihood that Petitioner would prevail in establishing that claim 9 would have been obvious based on the SP3 Manual and Howell.

III. CONCLUSION

Upon consideration of the Petition and Preliminary Response, we are persuaded, for purposes of this Decision, that the record before us demonstrates a

reasonable likelihood that Petitioner will prevail on the ground that claims 1, 2, 4, 10, 12–14, 17, 22, 32–35, 37, 39–43, 46–48, 50–53, 57, 68, 73, 76, 77, 79, 80, 82, and 83 are anticipated under 35 U.S.C. § 102(b) based on the SP3 Manual.

We also are persuaded that there is a reasonable likelihood that Petitioner would prevail in establishing that claims 4, 6, 7, 9, 54, 55, and 82 would have been obvious based on the SP3 Manual and Howell.

This is a decision to institute an *inter partes* review under 35 U.S.C. § 314. The Board has not made a final determination on the patentability of the challenged claims.

IV. ORDER

For the reasons given, it is:

ORDERED that *inter partes* review is authorized as to whether claims 1, 2, 4, 10, 12–14, 17, 22, 32–35, 37, 39–43, 46–48, 50–53, 57, 68, 73, 76, 77, 79, 80, 82, and 83 are anticipated under 35 U.S.C. § 102(b) based on the SP3 Manual;

FURTHER ORDERED that *inter partes* review is authorized as to whether claims 4, 6, 7, 9, 54, 55, and 82 would have been obvious based on the SP3 Manual and Howell;

FURTHER ORDERED that pursuant to 35 U.S.C. § 314(a), *inter partes* review of the ’420 patent is hereby instituted commencing on the entry date of this Order, and pursuant to 35 U.S.C. § 314(c) and 37 C.F.R. § 42.4, notice is hereby given of the institution of a trial; and

FURTHER ORDERED that no ground other than that specifically granted above is authorized for the *inter partes* review.

For PETITIONER:

Robert Surrette
bsurrette@mcandrews-ip.com

Merle Elliott
melliott@mcandrews-ip.com

Christopher Scharff
cscharff@mcandrews-ip.com

Caroline Teichner
cteichner@mcandrews-ip.com

For PATENT OWNER:

Wesley Whitmyer
litigation@whipgroup.com

Michael Kosma
mkosma@whipgroup.com

Michael Lavine
mlavine@whipgroup.com