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571-272-7822

Paper 10
Date: April 19, 2022

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

AMERICAN WELL CORPORATION,
Petitioner,

v.

TELADOC HEALTH, INC.,
Patent Owner.

IPR2022-00038
Patent 8,179,418 B2

Before LYNNE H. BROWNE, KARA L. SZPONDOWSKI, and STEVEN M. AMUNDSON, *Administrative Patent Judges.*

SZPONDOWSKI, *Administrative Patent Judge*.

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

I. INTRODUCTION

American Well Corporation ("Petitioner") filed a Petition (Paper 2, "Pet.," "second Petition," or "present Petition") to institute an *inter partes* review of claims 6, 7, and 9–24 of U.S. Patent No. 8,179,418 B2, issued on May 15, 2012 (Ex. 1001, "the '418 patent"). Teladoc Health, Inc. ("Patent

Owner") filed a Preliminary Response (Paper 6, "Prelim. Resp."). With our authorization, Petitioner filed a Preliminary Reply (Paper 8, "Prelim. Reply") and Patent Owner filed a Preliminary Sur-reply (Paper 9, "Prelim. Sur-reply"). We have jurisdiction under 35 U.S.C. § 314.

We have authority, acting on the designation of the Director, to determine whether to institute an *inter partes* review under 35 U.S.C. § 314. *See also* 37 C.F.R. § 42.4(a) ("The Board institutes the trial on behalf of the Director."). Upon consideration of the Petition, the Preliminary Response, Preliminary Reply, Preliminary Sur-reply, and the supporting evidence, we exercise our discretion to deny institution of trial on this Petition under 35 U.S.C. § 314(a). Accordingly, we do not institute an *inter partes* review as to any of the challenged claims of the '418 patent.

II. BACKGROUND

A. Real Parties in Interest

Petitioner identifies itself, American Well Corporation, as the sole real party in interest. Pet. 86. Patent Owner identifies itself, Teladoc Health, Inc., and InTouch Technologies, Inc. as the real parties in interest. Paper 4, 1.

B. Related Matters

The parties advise that the '418 patent is the subject of the following district court litigation: *Teladoc Health, Inc. v. American Well Corporation*, 1:20-cv-1377-MN (D. Del.). Pet. 86; Paper 4, 1.

Petitioner also filed IPR2021-00748 challenging claims 1–24 in the '418 patent ("00748 IPR"). Pet. 86; Paper 4, 1. We instituted an *inter partes* review on October 7, 2021. IPR2021-00748, Paper 10. Trial is

concurrently ongoing in the 00748 IPR, with oral argument scheduled for July 28, 2022. IPR2021-00748, Paper 13.

Petitioner concurrently filed IPR2022-00039 involving U.S. Patent No. 10,471,588 ("the '588 patent"), which is a continuation of the '418 patent, and has also filed IPR2021-00749, also challenging the '588 patent. Pet. 86; Paper 4, 1.

Petitioner also filed IPR2021-00742, -00743, -00810, -00833, -00836, -00871, and -00933 involving U.S. Patent Nos. 8,780,165; 9,602,765; 8,849,680; 8,670,017; 10,483,007; 10,059,000; and 7,761,185, respectively, which are also owned by Patent Owner and concern similar subject matter to that of the '418 patent. Paper 4, 1.

C. The '418 Patent (Ex. 1001)

The '418 patent is titled "Robotic Based Health Care System" and is generally directed to "a robotic system that can be used to treat a patient." Ex. 1001, codes (54), (57). The '418 patent describes a mobile robot that is controlled by a remote station. *Id.* at 2:14–15. A physician can use the remote station to move the mobile robot into view of the patient. *Id.* at 2:15–16. Medical personnel at the robot site can enter patient information into the system through a user interface, and the patient information can be stored in a server. *Id.* at 2:18–20. The physician at the remote station can access the patient information, and it may be displayed via graphical user interface. *Id.* at 2:20–22.

Figure 1, reproduced below, depicts an illustrative robotic system.

FIG. 1

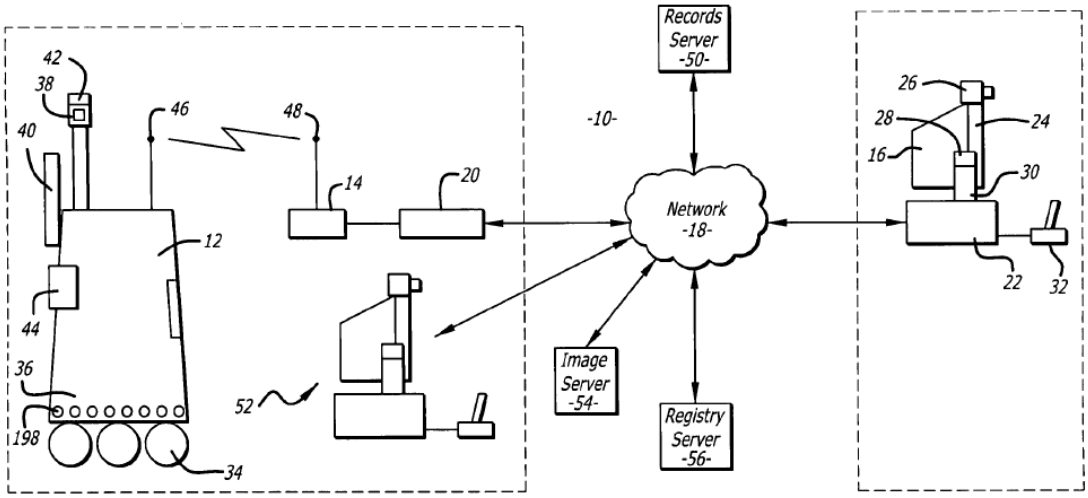

Figure 1 shows robotic system 10, which includes robot 12 with base station 14 that is coupled via network 18 to remote station 16. Ex. 1001, 2:34–43. Robot 12 may include camera 38, monitor 40, microphone 42, and speaker 44. *Id.* at 2:60–63. Remote station 16 may include a computer 22, monitor 24, camera 26, microphone 28, speaker 30, and input device 32. *Id.* at 2:48–51. A user at remote station 16 may move robot 12 through operation of input device 32. *Id.* at 2:66–67. Further, the user at the remote station 16 can view the patient, the patient can view the user, and the two may engage in audible communications. *Id.* at 3:3–4.

Patient information may be provided to server 50 through user interface 52, which may or may not be in close proximity to the robot. *Id.* at 3:13–16. For example, the user interface may be a computer located at a nurse's station where information is entered when a patient checks into a facility. *Id.* at 3:17–18. The user interface 52 may be a separate computer terminal, or may be integral with the robot. *Id.* at 3:23–25. Figure 4,

reproduced below, shows an example of a graphical user interface provided at user interface 52.

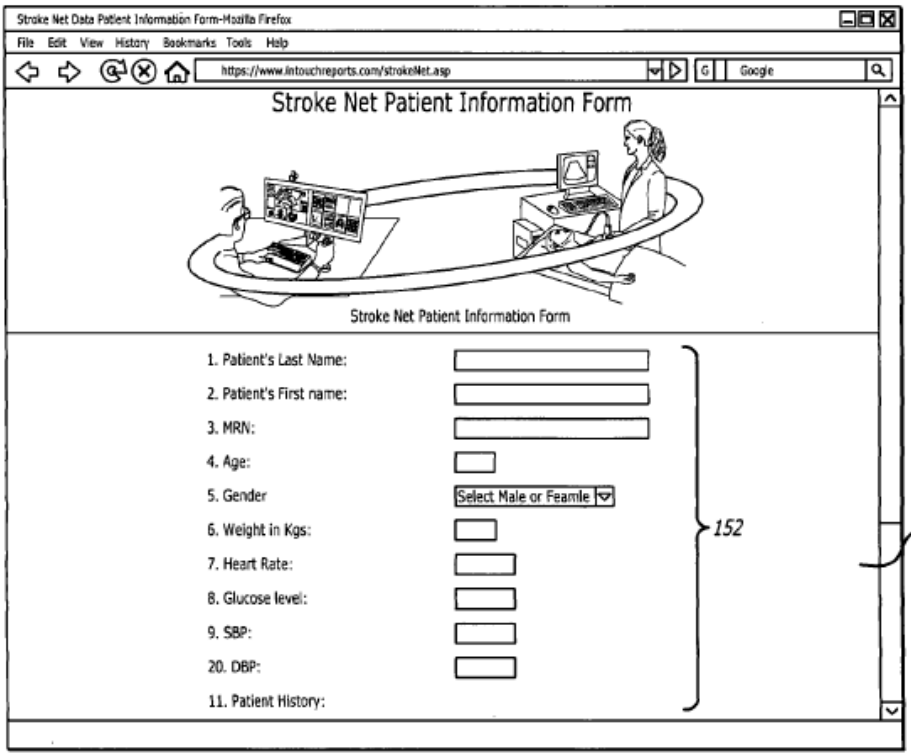

FIG. 4

Figure 4, above, shows graphical user interface 150 including a plurality of data fields 152 that can be filled in by the user. *Id.* at 4:46–52. "The data fields 152 can request patient information such as name, age, etc. The data fields may also include request for medical data such as heart rate, glucose level and blood pressure ('SBP' and 'DBP')." *Id.* at 4:48–52.

Figure 6, reproduced below, shows a graphical user interface 170 that is displayed on the monitor of remote station 16. *Id.* at 5:6–7.

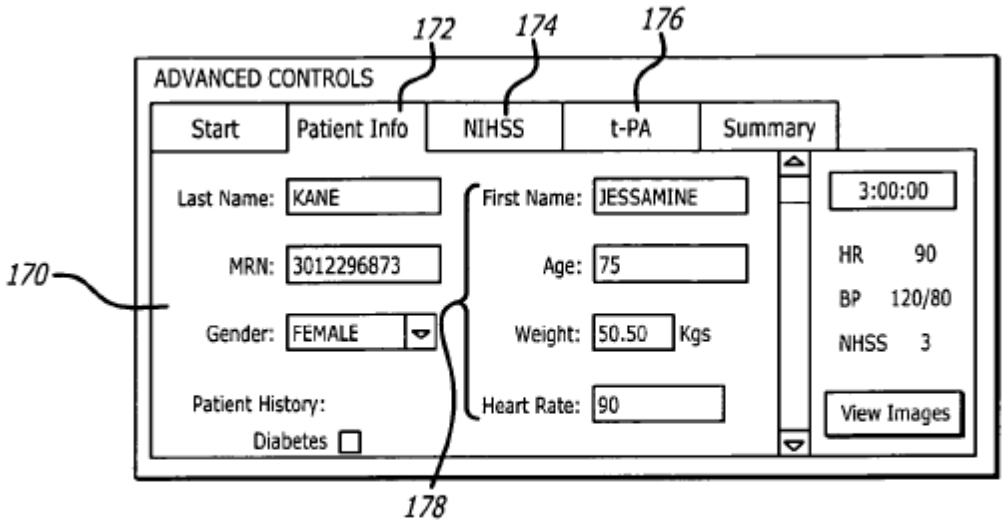

FIG. 6

Figure 6, above, shows interface 170 with "Patient Info" tab, "NIHSS" tab, and "t-PA" tab, where "Patient Info" tab is selected. *Id.* at 4:62–64. "Patient Info" tab displays data fields such as "Last Name," "First Name," "Age," "Gender," "Weight," and "Heart Rate." *Id.* at 4:65–67.

Figure 8, reproduced below, shows interface 190 with "t-PA" tab selected. *Id.* at 5:6–7.

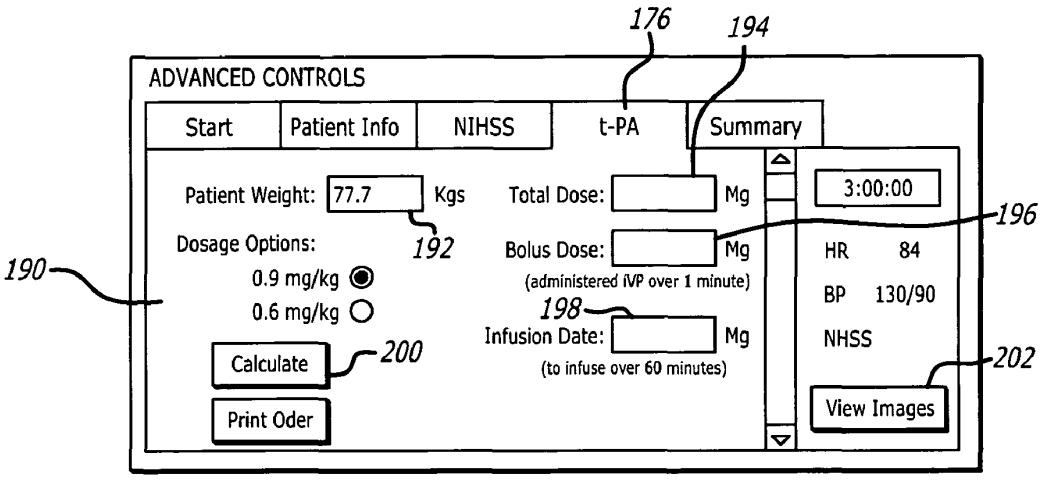

FIG. 8

Figure 8, above, shows interface 190 and is described as follows:

> [I]nterface **190** may include a data field **192** that provides the patient's weight, a "TOTAL DOSE" data field **194,** a "BOLUS DOSE" data field **196** and an "INFUSION DOSE" data field **198.** The interface **190** may also include a "CALCULATE" button **200.** When the CALCULATE button **182** is selected the data fields **194, 196** and **198** are automatically populated with a calculated dosage. This provides a patient management plan for the physician to review.

Id. at 5:7–14.

D. Illustrative Claims

Among the challenged claims, claims 11, 18, and 22 are independent. Independent claims 1,[1] 11, 18, and 22 are reproduced below, with brackets noting Petitioner's identifiers.

1. [1.pre] A robotic system, comprising:
[1.a] a mobile robot that has a camera and is located at a robot site;
[1.b] a user interface that is located at the robot site and allows medical information to be entered by a user; and,
[1.c.i] a remote station that is coupled to said mobile robot to control movement of said mobile robot, [1.c.ii] said remote station includes a monitor that is coupled to said mobile robot camera, [1.c.iii] and displays a graphical user interface that provides said medical information.

11. [11.pre] A robotic system, comprising:
[11.a] a mobile robot that has a camera;
[11.b] a user interface that allows patient information and patient statistics to be entered by a user;
[11.c.i] a remote station that is coupled to said mobile robot to control movement of said mobile robot, [11.c.ii] said remote station includes a monitor that is coupled to said mobile robot camera, [11.c.iii] and that displays a plurality of graphical user interfaces, said graphical user interfaces provide said patient statistics, a medical tool and a patient management plan.

18. [18.pre] A method for treating a patient, comprising:
[18.a] moving a mobile robot into a vicinity of a patient at a robot site through commands from a remote station;
[18.b] viewing the patient at the remote station through a camera of the mobile robot;
[18.c] entering information about the patient through a user interface located at the robot site;

[1] Independent claim 1 is not challenged in this Petition, but we reproduce it here because claims that depend from claim 1 are challenged.

[18.d] displaying the patient information at the remote station; and, displaying a patient management plan at the remote station.

22. [22.pre.i] A graphical user interface that is displayed on a monitor of a remote station that controls a mobile robot, [22.pre.ii.] the mobile robot having a camera, comprising:

[22.a] a graphical user interface that includes;

a patient information area;

[22.b] a medical assessment area; and,

[22.c] a patient management plan area.

Ex. 1001, 5:34–6:52.

E. Evidence

Petitioner relies on the following references (*see* Pet. 3).

Reference	Exhibit	Patent/Printed Publication
Wang421	1005	U.S. Patent Pub. No. 2004/0143421 A1 to Wang et. al., published July 22, 2004
Clements	1006	U.S. Patent Pub. No. 2006/0271400 A1 to Clements et al., published Nov. 30, 2006
Brown	1007	U.S. Patent No. 5,997,476 to Brown, issued Dec. 7, 1999
Hampton	1008	U.S. Patent No. 6,594,634 B1 to Hampton et al., issued July 15, 2003
Brun	1009	WO Patent Pub. No. 2007/009895 A1 to Brun et al., published Jan. 25, 2007

F. Prior Art and Asserted Grounds

Petitioner asserts that claims 6, 7, and 9–24 are unpatentable on the following grounds (Pet. 3):

Claims Challenged	35 U.S.C. §	References
9, 10	103	Wang421, Clements
6, 11–20	103	Wang421, Clements, Hampton
7, 21, 22–24	103	Wang421, Clements, Hampton, Brown, Brun

In support of its proposed grounds, Petitioner relies on the Declaration of Gregory S. Fischer, Ph.D. *See* Ex. 1003.

III. ANALYSIS

A. Background

On April 2, 2021, in IPR2021-00748, Petitioner filed a Petition to institute an *inter partes* review of claims 1–24 of the '418 patent. IPR2021-00748, Paper 2 ("00748 Pet.", "00748 Petition" or "first Petition"). Patent Owner filed a Preliminary Response. IPR2021-00748, Paper 6. On October 7, 2021, we instituted trial of all claims and on all grounds. IPR2021-00748, Paper 10 ("00748 Inst. Dec." or "00748 Institution Decision"). However, in order to provide the parties with insight into the Board's analysis of all grounds, we determined that the 00748 Petition, supported by the preliminary record, had failed to persuade us of a reasonable likelihood of prevailing with respect to some of the asserted claims and grounds. In particular, we found that the 00748 Petition had not sufficiently shown, for purposes of institution, that (1) the combination of Wang421 and Clements teaches claim 9; (2) the combination of Wang421, Clements, and Hampton teaches claims 6 and 11–20; (3) the combination of Wang421, Clements, Brown, and Brun teaches claims 7 and 21; and (4) the combination of Wang421, Clements, Brown, Hampton, and Brun teaches claims 22–24. 00748 Inst. Dec. 46, 64–65, 68–70.

Following the 00748 Institution Decision, Petitioner e-mailed the Board, stating that it had filed and served a "follow-on" IPR petition directed to the '418 patent (the present Petition) in order "to correct inadvertent misstatements and incorrect citations made in the original IPR petition[]

(IPR2021-00748[])]."[2] Ex. 2001, 2. Petitioner stated that it "could not reasonably have sought corrective action earlier because the defects in question were not identified in Patent Owner's Preliminary Response but were first brought to Petitioner's attention in the Institution Decision." *Id.* Petitioner further stated that "[o]nly claims for which the Board found that Petitioner's burden had not been met are challenged in the . . . follow-on petition[]." *Id.* Petitioner further stated that "Petitioner will attempt to correct the defects in the . . . original petition[] by submitting Supplemental Information under 37 CFR § 42.123(a) in the form of supplemental expert declarations. If the supplemental information submissions are successful in correcting the original petitions, Petitioner would be amenable to withdrawing . . . the follow-on petition[] if doing so would be beneficial to all concerned." *Id.* at 3.[3]

B. Discretion to Deny Institution Under § 35 U.S.C. 314(a)

The present Petition asserts a subset of the same grounds of unpatentability as those upon which we instituted review in the 00748 IPR. *Compare* Pet. 3, *with* 00748 Inst. Dec. 9, 70. Indeed, Petitioner contends that "the present Petition is nearly identical to the earlier -748 petition, with minor evidentiary tweaks to address purported defects that the Board identified in the -748 proceeding." Prelim. Reply 1.

The Director has discretionary authority under 35 U.S.C. § 314(a) to institute an *inter partes* review and has delegated that authority to the Board.

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[2] For similar reasons, Petitioner filed a follow-on petition in IPR2022-00039 following the IPR2021-00749 institution decision. Ex. 2001, 2.

[3] As discussed below, Petitioner also filed a Motion to Submit Supplemental Information in IPR2021-00748.

See SAS Inst. Inc. v. Iancu, 138 S. Ct. 1348, 1356 (2018); 37 C.F.R. § 42.4(a); *Harmonic Inc. v. Avid Tech., Inc.*, 815 F.3d 1356, 1367 (Fed. Cir. 2016) ("the PTO is permitted, but never compelled, to institute an IPR proceeding"). Patent Owner argues that the present Petition should be denied under § 314(a), as "mandated" under the Board's designated precedential decision in *General Plastic Industries Co. v. Canon Kabushiki Kaisa*, IPR2016-01357, Paper 19 (PTAB Sept. 6, 2017) (precedential as to § II.B.4.i.). Prelim. Resp. 1–4. According to Patent Owner, Petitioner "has expressly admitted to doing exactly what *General Plastic* prohibits—using the Board's first institution decision as a roadmap to incrementally alter its challenges in a second, follow-on Petition." *Id*. at 3. Petitioner, on the other hand, contends that "the *General Plastic* factors are inapplicable to the facts of this case" because "the target of *General Plastic* and its progeny" is "strategic withholding—where a petitioner staggers its prior art grounds until a ground is found that results in institution." Prelim. Reply 1.

In *General Plastic*, the Board identified seven nonexclusive factors that bear on the issue of whether the Board should invoke its discretion to deny institution of an *inter partes* review under 35 U.S.C. § 314(a) and 37 C.F.R. § 42.108(a) in the context of a follow-on petition. *General Plastic*, Paper 19 at 8–10, 16. These seven factors are:

1. whether the same petitioner previously filed a petition directed to the same claims of the same patent;

2. whether at the time of filing of the first petition the petitioner knew of the prior art asserted in the second petition or should have known of it;

3. whether at the time of filing of the second petition the petitioner already received the patent owner's preliminary

response to the first petition or received the Board's decision on whether to institute review in the first petition;

4. the length of time that elapsed between the time the petitioner learned of the prior art asserted in the second petition and the filing of the second petition;

5. whether the petitioner provides adequate explanation for the time elapsed between the filings of multiple petitions directed to the same claims of the same patent;

6. the finite resources of the Board; and

7. the requirement under 35 U.S.C. § 316(a)(11) to issue a final determination not later than 1 year after the date on which the Director notices institution of review.

Id. The *General Plastic* factors are not dispositive, but part of a balanced assessment of the relevant circumstances in a proceeding, including the merits. *See* Patent Trial and Appeal Board, Consolidated Trial Practice Guide, 58 (Nov. 2019) ("Trial Practice Guide"), *available at https://www.uspto.gov/sites/default/files/documents/tpgnov.pdf?MURL=*.

a) Factor 1: whether the same petitioner previously filed a petition directed to the same claims of the same patent;

We are mindful of the fact that Petitioner is permitted to file a petition for *inter partes* review within one year of being served with a complaint for infringement. *See* 35 U.S.C. § 315(b). Yet, it is undisputed that Petitioner previously filed the 00748 Petition directed to the same claims of the '418 patent. *See* Prelim. Resp. 4; Prelim. Reply 1 ("the present Petition is nearly identical to the earlier -748 petition, with minor evidentiary tweaks"). In the 00748 Petition, Petitioner challenged claims 1–24 of the '418 patent. 00748 Pet. 2–3. Here, in the present Petition, Petitioner challenges a subset of

those claims, claims 6, 7, and 9–24. Pet. 3.[4] Therefore, this factor weighs in favor of denial.

b) Factor 2: whether at the time of filing of the first petition the petitioner knew of the prior art asserted in the second petition or should have known of it;

There is no dispute that the present Petition asserts the same prior art as in the 00748 Petition. *See* Prelim. Resp. 4, 7; Prelim. Reply 12. As a result, there is no dispute that Petitioner knew of the prior art asserted in the present Petition at the time of filing the 00748 Petition. According to Patent Owner, Petitioner "could have and should have raised the challenges relying on these same references earlier." Prelim. Resp. 5.

Petitioner does not dispute that the same references are asserted as in the 00748 Petition, but contends that this factor "relate[s] to withheld prior art." Prelim. Reply 2 (citing *Intel Corp. v. Alacritech, Inc.*, IPR2018-00226, Paper 7 at 12 (PTAB June 5, 2018); *Cavium, Inc. v. Alacritech, Inc.*, IPR2018-00401, Paper 8 at 9 (PTAB June 5, 2018); *Choirock Contents Factory Co., Ltd. v Spin Master Ltd.,* IPR2019-00900, Paper 17 at 14 (PTAB Sept. 26, 2019)). According to Petitioner, this factor (as well as factor 4, discussed below) is inapplicable to this proceeding because Petitioner relies on the same prior art in the present Petition as it did in the 00748 Petition. *Id.* at 2–4, 5 n.2 ("*General Plastic* is factually distinguishable because . . . petitioner 'shift[ed] the prior art asserted' in the second petition after identifying new prior art." (alteration in original)).

[4] We note that although the table setting forth the grounds only identifies claims 6, 7, and 9–24, the analysis in the Petition addresses all of claims 1–24. *Compare* Pet. 3 (grounds), *with* Pet. 22–40 (addressing claims 2–4, 8), 63–68 (addressing claim 5).

We are not persuaded that factor 2 is inapplicable because the present Petition relies on the same prior art as in the 00748 Petition. *General Plastic* states that "we are concerned here by the *shifts in the prior art asserted and the related arguments* in follow-on petitions." Paper 19 at 17 (emphasis added); *see also General Plastic* at 18 ("Considering other factors (i.e., factors 2, 4, and 5) allows us to assess and weigh whether a petitioner should have or could have raised the new challenges earlier."). In connection with factor 2, *General Plastic* cites to *Conopco, Inc. v. Procter & Gamble Co.*, IPR2014-00506, Paper 25 at 4 (PTAB Dec. 10, 2014), Paper 17 at 6 (PTAB July 7, 2014) and *Toyota Motor Corp. v. Cellport Systems*, *Inc.*, IPR2015-01423, Paper 7 at 8 (PTAB Oct. 28, 2015). *See General Plastic*, Paper 19 at 9 n.12.

In *Conopco*, although the prior art was not identical, some of the references were the same, and the Board exercised discretion to reject the petition because "the same or substantially the same prior art" previously was "presented to the Office" in a prior petition. *Conopco*, Paper 25 at 4, 6. There, the Board found that:

> Based on the information presented, we are persuaded that the instant Petition uses our prior Decision on Institution to bolster challenges that were advanced, unsuccessfully, in the [prior] Petition. Specifically, [Petitioner] argues that the instant Petition "obviates purported deficiencies" illuminated in our prior decision. Joinder Mot. 8. [Patent Owner], on the other hand, contends that [Petitioner] seeks to revive and augment challenges that were rejected in the 505 proceeding, "[a]rmed with the Board's guidance as to the flaws in the [505 Petition]." Prelim. Resp. 9.

Conopco, Paper 17 at 8 (fifth and sixth alterations in original). Similarly, in *Toyota Motor Corp.*, the petitioner filed a second petition on the same

grounds, but for substitution of one new reference. IPR2015-01423, Paper 7 at 7. The Board found that "[d]espite the substitution of [one reference], the prior art and arguments presented in this proceeding are substantially the same as those previously presented." *Id.* There, the Board stated that "[w]ithout explanation, Petition[er] seeks another opportunity to challenge the same claims on essentially the same grounds, albeit not based on the identical set of prior art references. Such a second bite at the apple wastes the Board's limited resources and imposes undue burden on the Patent Owner." *Id.* at 8. In both of these cases, cited by *General Plastic* in connection with factor 2, the Board found that the prior art was "the same or substantially the same."

Petitioner cites to three cases, none of which are binding precedent. Citing to *Intel*, *Cavium*, and *Choirock*, Petitioner contends that "[t]he PTAB has *repeatedly* confirmed that '*General Plastic* factors 2 and 4 . . . relate to withheld prior art.'" Prelim. Reply 2 (emphasis added). We disagree. *See, e.g.*, *Ivantis, Inc. v. Glaukos Corp.*, IPR2019-00475, Paper 8 at 9 (PTAB July 12, 2019) ("Contrary to Petitioner's argument, however, consideration of this factor is based solely on the *timing* of Petitioner's awareness of the prior art in question with respect to filing the first petition."). All three cases are factually distinct from the present circumstances. *Intel* and *Cavium* are related cases involving the same issue. In both *Intel* and *Cavium*, institution of a first petition was denied for failing to establish that one of the references was a publicly available printed publication as of the critical date. *Intel*, IPR2018-00226, Paper 7 at 12; *Cavium*, IPR2018-00401, Paper 8 at 9. In these two cases, the Board found that "Petitioner has simply re-filed to address an evidentiary issue raised in the first matter that resulted in the

previous non-institution of the first matter." *Intel*, Paper 7 at 13; *Cavium*, Paper 8 at 9. Unlike these cases, although Petitioner asserts the same prior art, there has been a shift in the related arguments that are a direct result of the 00748 Institution Decision. *Compare, e.g.*, Pet. 40–41 (claim 9), 56–57 (claim 6 rationale for combination), 70 (claim 21), *with* 00748 Pet. 40–41 (claim 9), 45–47 (claim 6 rationale for combination), 70 (claim 21); *see also* IPR2021-00748, Paper 23 (Order Denying Petitioner's Motion to Submit Supplemental Information). In *Choirock*, the petitioner filed a substantively identical petition with a motion for joinder in an attempt to join an already instituted proceeding. IPR2019-00900, Paper 17 at 14. Again, that is not the case here, where Petitioner's arguments have shifted as a result of the 00748 Institution Decision. As stated in *General Plastic*, "[e]ach case is decided on the basis of its own facts, and the Board's consideration of the factors . . . may vary from case to case." *General Plastic*, Paper 19 at 21.

Therefore, this factor weighs in favor of denial.

c) *Factor 3: whether at the time of filing of the second petition the petitioner already received the patent owner's preliminary response to the first petition or received the Board's decision on whether to institute review in the first petition;*

There is no dispute that Petitioner had already received Patent Owner's Preliminary Response to the 00748 Petition, as well as the Board's Institution Decision in the 00748 IPR prior to filing the present Petition. *See* Prelim. Resp. 5–6; Prelim. Reply 1, 3–5.

Patent Owner contends that "factor 3 is directed to Petitioner's potential benefit from receiving and having the opportunity to study Patent Owner's Preliminary Response, as well as our institution decisions on the first-filed petitions, prior to its filing of follow-on petitions." Prelim. Resp.

5 (quoting *General Plastic*, Paper 19 at 17). Patent Owner points out that Petitioner "explicitly admitted to having received, studied, and utilized the Board's . . . [00748 Institution Decision], describing the Petition as one of two 'follow-on petitions [that] were filed to correct inadvertent misstatements and incorrect citations made in the . . . [00748 Petition] ***as pointed out by the Board in the Institution Decision[]***." *Id.* at 5–6 (second alteration in original).

Petitioner, on the other hand, contends that "[f]actor 3 is concerned with prejudice to patent owners when petitioners 'strategically stage their prior art and arguments in multiple petitions, using our decisions as a roadmap, until a ground is found that results in the grant of review.'" Prelim. Reply 4 (quoting *General Plastic*, Paper 19 at 17). According to Petitioner, "[t]he genesis of the present Petition is a number of relatively small errors and omissions in the [00748 Petition] . . . [and] [n]o reasonable person could think that Petitioner 'strategically staged' these errors in the hope of eventually filing a petition that resolves them." *Id.* Petitioner further argues that factor 3 is inapplicable because the 00748 Petition "resulted in a 'grant of review,' and therefore Petitioner is necessarily not attempting to 'strategically stage prior art and arguments in multiple petitions . . . until a ground is found that results in review.'" *Id.* (emphasis omitted) (citing *General Plastics*, Paper 19 at 17; *NFL Enters. LLC v. Opentv, Inc.*, IPR2017-02092, Paper 7 at 17 (PTAB Mar. 19, 2018)). Petitioner also argues that "[f]actor 3 also has little relevance where, as here, Petitioner has simply refiled its earlier-filed petition with corrected evidence to overcome purported minor errors and omissions." *Id.* at 5 (citing *Intel*

Corp., IPR2018-00226, Paper 7 at 13; *Cavium*, IPR2018-00401, Paper 8 at 9).

Petitioner received both Patent Owner's Preliminary Response and our Institution Decision in the 00748 IPR prior to filing the present Petition, and Petitioner admits to using the Institution Decision to correct errors made in the 00748 Petition. *See* Prelim. Reply 1 ("to address purported defects that the Board identified in the -748 proceeding"). Although we recognize that Petitioner characterizes these errors as "unintentional," as opposed to "strategic," (e.g., Prelim. Reply 5–6), this still raises the roadmapping concerns, i.e., fairness and inefficiencies, that *General Plastic* counsels against. *See General Plastic*, Paper 19 at 17–18. If we were to institute, Patent Owner would be forced to defend its patent in an iterative fashion against challenges based on the same prior art, and newly shifted arguments as a result of the aforementioned roadmapping. As *General Plastic* explains, this has the potential to be unfair and inefficient. *Id.*

We are not persuaded that the absence of "strategically stage[d]" petitions makes this factor inapplicable. *See General Plastic*, Paper 19 at 17 ("[F]actor 3 is directed to Petitioner's potential benefit from receiving and having the opportunity to study Patent Owner's Preliminary Response, as well as our institution decisions on the first-filed petitions, prior to its filing of follow-on petitions"). The deficiencies Petitioner now seeks to correct through the present Petition *are not* "minor errors and omissions." These purported corrections are extensively discussed in our Order Denying Petitioner's Motion to Submit Supplemental Information in the 00748 IPR, and we need not repeat the full analysis here. *See* IPR2021-00748, Paper 23 (PTAB Feb. 28, 2022) (denying Petitioner's motion to submit supplemental

information because the proposed supplemental information changed the evidence originally relied on in the Petition). However, by way of example, in the 00748 Petition, Petitioner did not provide a rationale to combine Wang421, Clements, and Hampton to teach the limitation recited in claim 6 (patient management plan), but now seeks to provide that rationale for the combination through this second Petition. *See id.* at 8–13. Providing an entirely new rationale to combine references in an obviousness analysis is not a "relatively small error[]" or a "minor error[]," as Petitioner asserts. *See Rambus v. Rea*, 731 F.3d 1248, 1256 (Fed. Cir. 2013) (stating that "we will not affirm a Board rejection . . . which essentially provides a new motivation to combine the references"). Rather, such an error goes to the heart of Petitioner's case.

We also are not persuaded that the situation here is different because institution was granted in the 00748 IPR.[5] As stated in the Trial Practice Guide, "The Board will not institute on fewer than all claims or all challenges in a petition." Trial Practice Guide 5 (citing *SAS*, 138 S. Ct. 1348 at 1359–60; *PGS Geophysical AS v. Iancu*, 891 F.3d 1354, 1359–62 (Fed. Cir. 2018); *Adidas AG v. Nike, Inc.*, 894 F.3d 1256, 1258 (Fed. Cir. 2018)). "If a trial is instituted, the Board generally will provide analysis of the strengths and weaknesses of all challenges in the petition in order to provide guidance to the parties for the upcoming trial." *Id.* at 6. That is precisely what happened here. However, such analysis by the Board is not an open invitation to shift arguments or evidence in a newly filed petition. *See Travelocity.com L.P. v. Cronos Tech., LLC*, CBM2015-00047, Paper 7 at 13

[5] We note that *General Plastic* was decided before *SAS Institute Inc. v. Iancu*, 138 S. Ct. 1348, 1359–60 (2018).

(PTAB June 15, 2015) ("Moreover, a decision on a petition . . . is not simply part of a feedback loop by which a petitioner may perfect its challenges through a subsequent filing."). We note that all of claims 1–24 have been challenged and are already under review in the 00748 IPR, with oral hearing scheduled for July 28, 2022. *SAS*, 138 S. Ct. at 1359 (Once instituted, "[petitioner] is entitled to a final written decision addressing all of the claims it has challenged."); IPR2021-00748, Paper 13.

An *inter partes* review proceeding begins with the filing of a petition. 37 C.F.R. § 42.104. Our regulations require that the Petition must "[p]rovide a statement of the precise relief requested for each claim challenged," including "[h]ow the construed claim is unpatentable," "where each element of the claim is found in the prior art," and "identifying specific portions of the evidence that support the challenge." 37 C.F.R. § 42.104(b); *see also* 35 U.S.C. § 312(a)(3) ("the petition identifies, in writing and with particularity, each claim challenged, the grounds on which the challenge to each claim is based, and the evidence that supports the grounds for the challenge to each claim"); 35 U.S.C. § 314(a) (Petitioner has the burden to present in the Petition information which would show a reasonable likelihood of success). Our regulations allow for the correction of clerical or typographical errors in a Petition (37 C.F.R. § 42.104(c)) and the filing of supplemental information under certain circumstances (37 C.F.R. § 42.123). *See also* 37 C.F.R. § 42.5(a) ("The Board may determine a proper course of conduct in a proceeding for any situation not specifically covered by this part and may enter non-final orders to administer the proceeding."). But Petitioner identifies no statute or regulation permitting it to substantively amend its first petition in this manner, i.e., by filing a second petition that

includes new arguments and evidence, following an Institution Decision on the first petition.

Petitioner's primary, and only, reason for filing the present Petition is to address deficiencies that were identified in the 00748 Institution Decision. Using the roadmap provided by the 00748 Institution Decision, Petitioner presents updated arguments and evidence as to the challenged claims. Such actions raise the fairness and efficiency concerns discussed in *General Plastic*, and thus, this factor weighs in favor of denial.

> d) *Factor 4: the length of time that elapsed between the time the petitioner learned of the prior art asserted in the second petition and the filing of the second petition;*
>
> *Factor 5: whether the petitioner provides adequate explanation for the time elapsed between the filings of multiple petitions directed to the same claims of the same patent;*

Patent Owner contends that factors 4 and 5 "are directed to 'whether a petitioner should have or could have raised the new challenges earlier.'" Prelim. Resp. 6–7. According to Patent Owner, Petitioner knew of the prior art, at the very latest, on April 2, 2021, when it filed the 00748 Petition, and did not file the present Petition until October 13, 2021, amounting to a delay of over at least six months. *Id.* at 7. Patent Owner argues that "a delay of only five months is sufficient for factor 4 to weigh in favor of denial." *Id.* (citing *Valve Corp. v. Elec. Scripting Prods., Inc.*, IPR2019-00064, Paper 10 at 13–14 (PTAB May 1, 2019) (precedential) ("*Valve I*")). Patent Owner further contends that Petitioner "provides no explanation [in the Petition] as to why it delayed the filing of the second Petition by over six months and to the very last day of the statutory bar period." *Id.* at 8. Patent Owner further argues that "[s]ince the [00748 Petition] was instituted on all challenges

raised in the first petition . . . substantial resources will continue to be expended to address all grounds in the [00748 IPR], and significant progress will continue to be made." *Id.* (emphases omitted). Patent Owner argues that the delay "causes the exact undue inequities and prejudices to Patent Owner that factors 4 and 5 seek to address." *Id.* at 9.

Petitioner contends that factor 4 is inapplicable to this proceeding because Petitioner relies on the same prior art in the present Petition as it did in the 00748 Petition. Prelim. Reply 2–4, 5 n.2 ("*General Plastic* is factually distinguishable because . . . petitioner 'shift[ed] the prior art asserted' in the second petition after identifying new prior art."). With regard to factor 5, Petitioner contends that the present Petition was filed less than a week after the 00748 Institution Decision "in an effort to address . . . alleged defects." *Id.* at 6. Petitioner argues that "it was completely unaware of [the unintentional errors] until the institution decision, and thus they could not have been addressed sooner." *Id*. According to Petitioner, the six-day turnaround "is not evidence of delay, but of expeditiousness." *Id.*

As discussed above in connection with factor 2, we are not persuaded that factor 4 is inapplicable because Petitioner asserts the same prior art as in the 00748 Petition. As a result, there is no dispute that Petitioner knew of the prior art asserted in the present Petition at the time of filing the 00748 Petition.

With regard to factor 5, although it is true that Petitioner filed the second Petition within a week after the 00748 Institution Decision, this was six months after the 00748 Petition was filed. As reason for the delay, Petitioner asserts that "it was completely unaware of [the unintentional errors] until the institution decision, and thus they could not have been

addressed sooner." Prelim. Reply 6. However, we are not persuaded that the errors could not have been addressed or discovered sooner. For example, in the Preliminary Response, Patent Owner pointed out the alleged errors in Petitioner's analysis of claim 9. *See* IPR2021-00748, Paper 6 at 43–44. As this was nearly three months prior to the Institution Decision, it is reasonable to conclude that Petitioner should have been on notice of potential problems with its initial filing much sooner, and prior to the filing of the Institution Decision. Moreover, the errors in the 00748 Petition that Petitioner now seeks to correct by way of the present Petition were not of the type that required Patent Owner, or the Board to point out to Petitioner. *See, e.g.*, *General Plastic*, Paper 19 at 11 ("the shift in Petitioner's challenges was not the consequence of a position that Patent Owner surprisingly advanced or the Board surprisingly adopted"), 18 ("Considering other factors (i.e., factors 2, 4, and 5) allows us to assess and weigh whether a petitioner should have or could have raised the new challenges earlier."), 21 ("any such inquiry is directed to whether, from an objective perspective in the context of the applicable law and facts, Petitioner's alleged surprise is reasonable").

Thus, these factors weigh in favor of denial.

e) Factor 6: the finite resources of the Board;

Factor 7: the requirement under 35 U.S.C. § 316(a)(11) to issue a final determination not later than 1 year after the date on which the Director notices institution of review.

Patent Owner argues that factors 6 and 7 are "efficiency considerations." Prelim. Resp. 9. Relying on *Valve I*, Patent Owner argues that "duplicative petitioning would force the Board to repetitively address the same challenges to the same patent claims by the same Petitioner across

two differently timed proceedings, thereby wasting the Board's limited resources." *Id.* at 10. Patent Owner further contends with respect to Petitioner's assertion that it will seek to consolidate the follow-on Petition with the 00748 Petition that "such an assertion only goes to the Board's resources spent ***post***-institution." *Id.* at 11. Moreover, Patent Owner argues that "consolidation fails to address the fact that the [00748 IPR] has already proceeded . . . towards its one-year statutory deadline . . . [and] [c]onsolidation would thus force the parties and the Board to address the second Petition's grounds on a severely shortened timeline, requiring the Board and parties to expend significant resources while at the same time undermining due process." *Id.* at 11–12. Patent Owner also argues that consolidation fails to address the concerns relating to unfair tactical advantage and undue prejudice. *Id.* at 12.

Petitioner contends that "Patent Owner fails to allege, much less show, that the present Petition raises unusual issues challenging the finite resources of the Board, or its capacity to issue a final determination within the statutory deadline." Prelim. Reply 6–7 (citing *Prollenium US Inc. v. Allergan Industrie, SAS*, IPR2019-01632, Paper 18 at 28 (PTAB Mar. 31, 2020)). Petitioner also states that, should the Board institute review, it will move to consolidate this proceeding with IPR2021-00748. *Id.* at 7. According to Petitioner, the consolidated proceedings would not consume substantially more resources from the Board because the two petitions are "substantively almost identical." *Id.*

We determine that factors 6 and 7 weigh in favor of denial. In general, having multiple petitions challenging the same patent, especially when not filed at or around the same time, as in this case, is inefficient and

tends to waste resources. Here, Petitioner waited until after receiving the 00748 Institution Decision, and then filed an additional petition. These serial and repetitive attacks implicate the fairness and efficiency concerns underpinning *General Plastic*. Moreover, at this stage of IPR2021-00748, consolidation is not reasonable, given that the parties' experts have already been deposed (IPR2021-00748, Papers 15, 25), Patent Owner has filed a Response and Contingent Motion to Amend (IPR2021-00748, Papers 20, 21), and the hearing is scheduled for July 28, 2022. Thus, these factors weigh in favor of denying institution.

f) Conclusion

We have considered the circumstances and facts before us in view of the *General Plastic* factors. Because our analysis is fact driven, no single factor is determinative of whether we exercise our discretion to deny institution under § 314(a). However, Petitioner's admitted use of the 00748 Institution Decision as a roadmap to remedy deficiencies in Petitioner's case in chief weighs heavily against institution. Considering the *General Plastic* factors as part of a holistic analysis, we are persuaded that the interests of the efficiency and integrity of the system would be best served by invoking our authority under § 314(a) to deny institution.

IV. CONCLUSION

For the foregoing reasons, we exercise our discretion to deny institution under 35 U.S.C. § 314(a).

V. ORDER

In consideration of the foregoing, it is hereby:

ORDERED that the Petition is denied, and an *inter partes* review is not instituted.

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