

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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CARDIOCOM, LLC

Petitioner

v.

ROBERT BOSCH HEALTHCARE SYSTEMS, INC.

Patent Owner

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CASE IPR2013-00468

Patent No. 7,516,192

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**PATENT OWNER'S REPLY IN SUPPORT OF  
MOTION TO EXCLUDE EVIDENCE**

Over the course of *inter partes* review, issues are supposed to be narrowed and focused for trial. As the petitioner, Cardiocom bears the burden of proof (35 U.S.C. § 316(e)) and was required to submit in its petition the evidence upon which it intended to rely (35 U.S.C. § 312(a)(3)). Once the Board instituted review, Bosch submitted evidence and arguments showing why Cardiocom’s prior art did not invalidate the claims under review. Cardiocom was then entitled to a reply to respond to Bosch’s opposition. Cardiocom seeks to upend this orderly process by submitting for the first time in reply entirely new claim constructions, evidence, and arguments. This is improper as Bosch has no chance to respond.

**I. Cardiocom and Dr. Stone Withheld His Construction of “Database.”**

The most apparent example of Cardiocom’s sandbagging is its entirely new construction for the claim term “database.” While Cardiocom was required to state in its petition “[h]ow the challenged claim is to be construed” (37 C.F.R. § 42.104(b)(3)), Cardiocom did not propose a construction of “database” and merely argued that this limitation was met by the prior art. Bosch’s response proved that it was not, but neither Bosch nor its expert proposed a different construction of “database.” Rather than reply to Bosch’s argument, Cardiocom instead avoids it entirely by offering a new, legally improper, and significantly overbroad construction of the term and then, *relying entirely upon this new construction*, arguing the prior art met the newly construed database limitation.

Cardiocom’s new construction of database—which literally includes “[a]nything stored on a computer in a file” (Ex. 2069, 1191:11-21)—is hopelessly overbroad and inconsistent with the other claims. By presenting this construction for the first time in its reply, Cardiocom seeks to deny Bosch the opportunity to explain why the construction is improper. Indeed, Cardiocom specifically object to Bosch having an opportunity to address this new construction. Resp., 10-11.

Cardiocom’s argument that its previously-undisclosed construction is simply a response to Bosch’s arguments that the prior art does not disclose the “database” claimed in the ’192 patent is disingenuous. Resp., 9. Nothing in Bosch’s response required Cardiocom to posit a new claim construction, and the fact that it has done so is a tacit admission that the prior art does not teach this limitation without an entirely new construction. Cardiocom’s effort to supplement the grounds raised in its petition based on new constructions is contrary to the Board’s rules and unfair to patent owners. Office Patent Trial Guide, 77 Fed. Reg. 48756, 48767 (Aug. 14, 2012). At least ¶¶ 99-104, 121, 136, 142, and 215 of Ex. 1022 rely upon this new and improper construction of “database” and should be excluded. See Mot., 8.<sup>1</sup>

## II. Cardiocom Failed to Present Evidence of Secondary Considerations.

Cardiocom also seeks to introduce new evidence and arguments about the

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<sup>1</sup> Dr. Stone’s new opinions on “script program” should also be excluded for similar reasons. See Mot., 12-13.

secondary indicia of non-obviousness that should be stricken. Cardiocom and its expert, Dr. Stone, knew of the long-felt need and demand for the claimed inventions of the '192 patent when Cardiocom filed its original petition. *See* Ex. 2069, 835:23-836:7, 1302:24-1303:19; Ex. 1008, ¶¶ 12-13 (“pressures” addressed by invention existed “[l]ong before the ‘192 Patent”). Yet Cardiocom chose not to address such evidence in its petition, despite the Federal Circuit’s emphasis on the importance of secondary considerations in the obviousness inquiry.

In response to Cardiocom’s obviousness arguments, Bosch submitted publicly available exhibits establishing secondary considerations of non-obviousness. Cardiocom’s expert conceded that these documents were equally available to Cardiocom. Ex. 2069, 784:2-9. Cardiocom is a player in the remote health monitoring field, competes with Bosch, and was capable of identifying secondary considerations evidence at the time of its petition. *See* Ex. 1020 ¶¶ 2-3.

Cardiocom does not offer any excuse for its decision to ignore secondary considerations evidence in its petition. Rather, Cardiocom argues it had no affirmative obligation to disclose its arguments until its reply brief. Resp. 3-4. Cardiocom is mistaken; such evidence of secondary considerations must always be considered and Cardiocom was required to have raised it in the petition. *See Plantronics, Inc. v. Aliph, Inc.*, 724 F.3d 1343, 1355 (Fed. Cir. 2013). Moreover, Cardiocom bears the burden of production, and has offered no legitimate excuse

for failing to produce evidence regarding secondary considerations in its petition. *See Mot.*, 2. Having chosen not to address secondary indicia of non-obviousness, Cardiocom cannot make rebuttal arguments on this issue in its reply. Doing so denies Bosch the opportunity to respond and fails to meet Cardiocom’s burden of production on the issue. Thus, Bosch respectfully requests that the Board exclude Paragraphs 61-90 of Ex. 1022.

**III. Dr. Stone’s Secondary Considerations Methodology is Unreliable.**

Cardiocom’s decision to withhold until its reply any evidence and argument related to secondary indicia of non-obviousness is particularly prejudicial because Cardiocom and its expert employ the wrong legal standard. This error of law provides an independent basis to exclude Cardiocom’s untimely arguments.

As noted in Bosch’s motion, Cardiocom and its expert argue that each claim must be mapped on an “element-by-element” basis to the secondary indicia of non-obviousness. *Mot.*, 5. This is wrong as a matter of law—while a showing of nexus is required, an undefined “element-by-element” analysis is not part of this showing. *In re GPAC Inc.*, 57 F.3d 1573, 1580 (Fed. Cir. 1995). Moreover, by withholding its view of secondary considerations until reply, Cardiocom seeks to prevent Bosch from challenging its flawed methodology. *See Resp.*, 8.

Fundamentally, Cardiocom still fails to provide case law supporting the “element-by-element” claim chart test Dr. Stone relied upon in his new argument

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