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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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MEDICOMP, INC.  
Requester, Respondent, and Cross-Appellant

v.

Patent of CARD GUARD SCIENTIFIC, LTD.  
Patent Owner, Appellant, and Cross-Respondent

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Appeal 2012-012494  
*Inter Partes* Reexamination Control 95/001,312  
U.S. Patent No. 7,542,878 B2  
Technology Center 3900

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Before RICHARD M. LEOVITZ, MICHAEL R. ZECHER, and  
JENNIFER S. BISK, *Administrative Patent Judges*.

LEOVITZ, *Administrative Patent Judge*.

DECISION ON APPEAL

This is a decision on appeal by the Patent Owner from the Patent Examiner's decision to reject pending claims 2-35 in an *inter partes* reexamination of U.S. Patent No. 7,542,878. This is also a decision on a

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Patent U.S. 7,542,878 B2

cross-appeal by the Third-Party Requester from the Patent Examiner's decision not to adopt proposed rejections of certain claims in the same *inter partes* reexamination proceeding. The Board's jurisdiction for this appeal is under 35 U.S.C. §§ 6(b), 134, and 315. We affirm the appeal; and designate certain grounds in the cross-appeal as new grounds under 37 C.F.R. § 41.77(b).

#### STATEMENT OF CASE

The patent in dispute in this appeal is U.S. Patent No. 7,542,878 (hereinafter, "the '878 patent"), which issued June 2, 2009. Claims 1-35 are pending. The claims of the patent are directed to a personal health monitor that comprises a physiological data input device and a multi-purpose personal data accessory. There are also pending method claims involving the use of the health monitor. According to the '878 patent, the device is used to monitor the health of a person. '878 patent, col. 5, ll. 5-9. In preferred embodiments, the multi-purpose personal data accessory is a cellular phone. *Id.* at col. 5, ll. 10-14. For example, physiological data, such as heart and blood information, can be collected by an input device and sent to a cellular phone which processes the data and then transmits the processed data to a remote medical center.

A request for *inter partes* reexamination under 35 U.S.C. §§ 311-318 and 37 C.F.R. §§ 1.901-1.997 for the '878 patent was filed March 16, 2010 by a Third Party Requester. Corrected Request for *Inter Partes* Reexamination. The Third Party Requester is Medicomp, Inc. Third Party Requester Respondent Br. 2, dated February 17, 2012. The Patent Owner in this appeal is Card Guard Scientific Survival Ltd. Patent Owner App. Br. 2,

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dated January 17, 2012. An oral hearing was held November 28, 2012. A transcript of the hearing will be entered into the record in due course.

*Related cases*

*Ex parte* reexamination 90/010,751 of the '878 patent is currently pending with respect to all its pending claims.

Reissue application No. 12/706,541 of the '878 patent was filed on February 16, 2010.

The *ex parte* reexamination and the reissue application were merged together on June 4, 2010. An appeal in this case has been concurrently decided with this appeal. Appeal 2012-010812.<sup>1</sup>

This appeal is also related to the litigation captioned *Lifewatch, Inc. v. Medicomp, Inc.*, Case No. 6:09-cv-1909-31DAB (M.D. Fla.), currently stayed.

*Appeal of Adopted Rejections*

Patent Owner appeals the Examiner's decision to adopt the following rejections (Patent Owner App. Br. 7):

1. Claims 2, 4-7, 9, 11, 13-17, 19, 20, 22-26, 30, 31, 34, and 35 as anticipated under 35 U.S.C. § 102 by Mazar.<sup>2</sup>

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<sup>1</sup> Claims 1-37 are pending in Appeal 2012-010812, and thus the appeal in the merged reissue/ex parte reexamination has two additional claims – claims 36 and 37 – which are not under consideration in this appeal. The reason for this discrepancy is not clear.

<sup>2</sup> Scott T. Mazar et al., U.S. 7,009,511 B1 (Mar. 7, 2006).

2. Claims 2, 4-6, 8, 12, 16, 17, 19, 20, 23, 25, 31, 34, and 35 as anticipated under 35 U.S.C. § 102 by Korman.<sup>3</sup>
3. Claims 2, 4-6, 8, 14, 16, 18-20, 22, 23, 25, and 28-33 are anticipated under 35 U.S.C. § 102 by Mault.<sup>4</sup>
4. Claims 2, 4, 5, 9-12, 17, 19, 20, 22, 23, 25-27, 30, and 31 as anticipated under 35 U.S.C. § 102 by Sackner.<sup>5</sup>
5. Claims 2, 4, 7, 10, 13, 16, 17, 19, 20, 22, 24, 25, 27, and 31 as anticipated under 35 U.S.C. § 102 by Kumar.<sup>6</sup>
6. Claims 2-4, 7, 11-14, 19-22, 24, 28, 29, and 31 as anticipated under 35 U.S.C. § 102 by Ross.<sup>7</sup>
7. Claims 2, 4-6, 12-14, 17, 19, 20, 22, 23, and 31 as anticipated under 35 U.S.C. § 102(e) by Nizan.<sup>8</sup>
8. Claims 2, 9, 10, 12, 19, 20, 26, 27, and 31 as anticipated under 35 U.S.C. § 102(b) by Davis.<sup>9</sup>
9. Claims 2-8, 10-14, 17-25, 27, 28, 32, and 33 as obvious under 35 U.S.C. § 103(a) over Hjelt<sup>10</sup> in view of Davis.
10. Claims 2-7, 9-12, 17-27, and 30 as obvious under 35 U.S.C. § 103(a) over Sackner in view of Hjelt.

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<sup>3</sup> Ronen Korman, WO 02/08762 A1 (pub. Oct. 17, 2002).

<sup>4</sup> James R. Mault, U.S. 6,790,178 B1 (Sept. 14, 2004).

<sup>5</sup> Marvin A. Sackner et al., U.S. 2002/0032386 A1 (Mar. 14, 2002).

<sup>6</sup> Kishore Kumar et al., U.S. 7,188,151 B2 (Mar. 6, 2007).

<sup>7</sup> Lynette Ross et al., U.S. 7,108,659 B2 (Sept. 19, 2006).

<sup>8</sup> Yaniv Nizan, U.S. 2003/0149344 A1 (Aug. 7, 2003).

<sup>9</sup> Charles L. Davis et al., U.S. 5,544,661 (Aug. 13, 1996).

<sup>10</sup> Kari Tapani Hjelt et al., U.S. 2004/0266480 A1 (Dec. 30, 2004).

11. Claim 31 as anticipated under 35 U.S.C. § 102 by Rohde.<sup>11</sup>

*Appeal of Non-Adopted Rejections*

The Third Party Requester cross-appeals the Examiner decision not to adopt the following rejections (Third Party Requester App. Br. 4-5):

1. Claims 2, 8, 11, 12, 19, 20 and 25 under 35 U.S.C. § 102(b) as anticipated by Rohde.
2. Claims 2, 5, 17, 19, 20 and 23 under 35 U.S.C. § 102(b) as anticipated by Albert.<sup>12</sup>
3. Claim 27 and 31-35 under 35 U.S.C. § 112, second paragraph, as indefinite.
4. Claim 31 under 35 U.S.C. § 102(b) as anticipated by Albert.
5. Claim 31 and 34 under 35 USC § 103(a) as obvious over Rohde in view of Admitted Prior Art; claims 31, 34, and 35 under 35 USC § 103(a) as obvious over Davis in view of Admitted Prior Art and Rohde.

Representative claims

Claims 2 and 19 are representative (independent claim 1 is included, although not part of this appeal, because claim 2 is dependent on it):

1. A personal health monitor comprising:  
a physiological data input device operative to gather physiological data; and  
a multi-purpose personal data accessory, whereas the multi-purpose personal data accessory is adapted to execute health monitoring software such as to enable the multi-

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<sup>11</sup> Mitchell M. Rohde, U.S. 5,876,351 (Mar. 2, 1999).

<sup>12</sup> David E. Albert et al., U.S. 5,735,285 (Apr. 7, 1998).

purpose personal data accessory to receive the physiological data, process the physiological data to provide processed physiological data and control a long range transmission of the processed physiological data to a remote entity.

2. The personal health monitor of claim 1, wherein the multi-purpose personal data accessory is a cellular phone or Hand-Held device.

19. A method for health monitoring, comprising:

gathering physiological data, by a physiological data input device; providing the physiological data to a multi-purpose personal data accessory; executing health monitoring software, by the multi-purpose personal data accessory to process the physiological data to provide processed physiological data; and transmitting the processed physiological data.

### **CLAIM INTERPRETATION**

Before a claim can be compared to the prior art, it must be properly interpreted. We therefore begin with claim interpretation. During reexamination, the PTO must give claims their broadest reasonable construction consistent with the specification. *In re Am. Acad. of Sci. Tech Ctr.*, 367 F.3d 1359, 1364 (Fed. Cir. 2004); *In re Suitco Surface, Inc.*, 603 F.3d 1255, 1259 (Fed. Cir. 2010).

- “multi-purpose personal data accessory”

“Multi-purpose personal data accessory” is not explicitly defined in the written description of the ‘878 Patent. However, there is guidance in the patent specification as to its meaning.

The '878 patent describes several examples of multi-purpose personal data accessories, including a cellular phone, a hand-held device, and a palm computer. '838 Patent, col. 1, ll. 26-28; col. 4, ll. 32-35; col. 5, ll. 14-18. The personal data accessory is described in the "Summary of the Invention" as "adapted to execute health monitoring software such as to enable the personal data accessory to receive the physiological data," a function which is also expressly ascribed to the device in independent claims 1 and 34. '838 Patent, col. 4, ll. 35-38. Similar language is also in claim 19. The claims also explicitly require the personal data accessory to process physiological data. The latter functions are what appear to differentiate the claimed multi-purpose personal data accessory from prior art cellular phones and other prior art personal data devices. *Id.* at col. 5, ll. 31-34.

The '878 patent does not define "multi-purpose." However, in view of the disclosure in the patent of cellular phones and palm computers as multi-purpose devices, we interpret it to mean that the claimed device has the functions of a prior art cellular phone or handheld computer, but also is enabled to execute a health monitoring function, including receiving and processing physiological data.

As explained below, the ability of the multi-purpose personal data accessory to execute the health monitoring software is described in the '878 Patent as a function of the data accessory hardware, itself. In distinguishing, the invention from the prior art, the '878 Patent acknowledges that "[v]arious methods and devices for monitoring the health of a person are known in the art." '878 Patent, col. 3, ll. 44-46. Such prior art devices are characterized in the "Background of the Invention" as requiring "special"

and “dedicated” hardware. *Id.* at col. 3, ll. 45-50. The ‘878 invention is consistently described as being enabled to perform its health monitoring function “without any addition of complex hardware, such as additional processors.” *Id.* at col. 5, ll. 13-14. The illustrative examples in the ‘878 Patent are of a self-contained cellular phone which is enabled to execute health monitoring software. *Id.* at Figs. 3-6, 8, 10, and 11; col. 6, ll. 30-33, 39-42; col. 8, ll. 41-47; col. 10, ll. 11-13. In other words, the phrase “execute . . . health monitoring software” by the multi-purpose personal data accessory as recited in claims 2 and 19 is reasonably interpreted in view of the ‘878 Patent to mean that the software is carried out by the hardware of the data accessory.

In sum, we interpret the claimed multi-purpose personal data accessory to be a device which is adapted to execute the claimed health monitoring function using hardware, such as a processor, and which is not solely devoted to performing the health monitoring function. That is, the multi-purpose personal data accessory is not “dedicated” to a single purpose or function, but has a function other than health monitoring, such as a function conventionally available on a cellular phone or palm computer.

- “adapted” to “control a long range transmission of the processed physiological data to a remote entity”

Claims 2, 9, 10, and 12, which depend on claim 1, require the multi-purpose personal data accessory to “control a long range transmission of the processed physiological data to a remote entity.” The ‘878 Patent describes the use of a multi-purpose personal data accessory comprising a long-range

transmitter to transmit information to remote stations. For example, with respect to a cellular phone, the '878 Patent teaches that "cellular phone 210 is capable of determining whether to transmit the processed physiological data, to transmit a portion of the data or not to transmit it at all." '878 Patent, col. 7, ll. 54-56. The patent also describes a mode in which the device continuously captures physiological data and transmits it automatically to the remote station. *Id.* at col. 8, ll. 33-38. In other words, the transmission of data is controlled by the phone, without intervention by a person, consistent with the ordinary meaning of "control . . . to exercise restraining or directing influence over" or "to have power over."<sup>13</sup>

With respect to long range transmission, the '878 Patent discloses various examples of wireless networks for long-range transmission and the internet. '878 Patent, col. 7, ll. 57-59; col. 8, ll. 45-50.

- "process the physiological data to provide processed physiological data"

According to claims 2 and 19, physiological data is gathered by a physiological data input device. The claimed health monitoring software is then executed to process "the physiological data to provide processed physiological data." The term "processed physiological data" is not expressly defined in the Specification, but illustrative examples are disclosed. For instance, the '878 Patent teaches that the "physiological data processing software component 314 can apply various well-known algorithms for processing the physiological data" and gives several examples which include "automatic arrhythmia analysis," "perform one lead

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<sup>13</sup> <http://www.merriam-webster.com/dictionary/control>

arrhythmia detection,” and “perform continuous automatic adaptation to the patient normal heartbeat morphology.” ‘878 Patent, col. 9, ll. 1-17. In each case, physiological data collected from an input device is subjected to analysis and then the analyzed data is transmitted. Thus, “processed data” indicates that the gathered data is acted upon by the monitoring software, consistent with the ordinary meaning of “process” to mean “a series of actions or operations conducing to an end.”<sup>14</sup> The processing also involves application of an “algorithm” which is “a set of rules for solving a problem in a finite number of steps.”<sup>15</sup>

The patent also teaches that the “health monitoring software 300 can detect various medical events and determine a medical state of a person. In some operational modes out of the mentioned above modes an occurrence of a medical event can initiate a transmission of processed physiological data.” ‘878 Patent, col. 9, ll. 18-22. Similarly, the patent discloses that continuous monitoring may be provided with a “[d]evice-activated event recorder where physiological data is detected which fall outside preset parameters.” *Id.* at col. 8, ll. 24-27, 33-34. The physiological data that is detected, and then determined to be outside certain preset parameters, is “processed physiological data” because the data is subjected to a set of rules or an analytic operation (e.g., outside preset threshold) to determine whether the predetermined event has occurred.

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<sup>14</sup> <http://www.merriam-webster.com/dictionary/process>

<sup>15</sup> <http://dictionary.reference.com/browse/algorithm>

### **PRIORITY**

The '838 Patent, filed February 16, 2005, claims priority to a chain of applications:

- Continuation of application No. 10/876,139, filed on June 23, 2004, now abandoned, which is a

- Continuation-in-part of application No. 10/086,633 (the '633 Application), filed on March 4, 2002, now U.S. Patent No. 7,222,054, which is a

- Continuation-in-part of application No. 09/261,136 (the '136 Application), filed on March 3, 1999, now U.S. Patent No. 6,366,871;

- Provisional application No. 60/076,660 (the '660 Application), filed on March 3, 1998.

Whether the claims are entitled to the priority dates is an issue in this reexamination proceeding because there is intervening prior art between the provisional filing date of March 3, 1998<sup>16</sup> and the June 23, 2004 filing date of the subject parent patent application.

There are two main priority issues. First, the Examiner found that the '838 Patent was not entitled to the priority date of the '660 Application because the latter did not disclose transmission of "processed physiological data" as recited in the claims. RAN 14-15. Second, the Third Party Requester contends that Patent Owner's argument that Davis does not anticipate the claimed invention conflicts with the Examiner's finding that the '660 Application provides support for the claimed "multipurpose

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<sup>16</sup> The '878 patent lists the filing date of the provisional as March 3, 1999. However, the Patent Owner provided a copy of the provisional application and it has a date stamp of March 3, 1998.

personal data accessory” because the descriptions in the Application and Davis are the same. Third Party Requester Respondent Br. 16. We address each issue below.

### Legal Principle

Claims found in a later-filed application are entitled to the filing date of an earlier application, if, *inter alia*, the disclosure in the earlier application provides an adequate written description of the later-filed claims under 35 U.S.C. §112, ¶ 1. *See Tronzo v. Biomet, Inc.*, 156 F.3d 1154, 1158 (Fed. Cir. 1998).

- “processed physiological data”

The Examiner’s determination that the ‘660 Application does not describe “processed physiological data” is not supported by a preponderance of the evidence.

We have construed the phrase “processed physiological data” to mean that the physiological data gathered by a physiological input device is acted upon by the health monitoring software, such as subjected to an analytic operation or a set of rules (algorithm). The ‘660 Application describes an example in which physiological data is subjected to analysis by applying a set of rules:

In second case the required sensors are connected to a patient (as ECG electrodes, pressure cutoff, oxygen sensor or other) the unit is continuously activated. The measured data is continuously monitored the [sic] and compared to preset parameters. If the measured data is outside the preset parameters, cellular communication is activated by a control

logic. The unit automatically dials the central station, [sic] send the measured data and patient's location.

'660 Application, p. 7. This example provides adequate written description for "processed physiological data." As discussed below, testimony by Patent Owner's expert, Dr. John Moss, is consistent with this conclusion.

To support their position that "processed physiological data" is described in the '660 Application, Patent Owner provided a written declaration under 37 C.F.R. § 1.132 by Dr. John Moss, Chief Technology Officer of LifeWatch Inc., the assignee of the '878 Patent. Moss Decl. ¶ 1, April 5, 2011. Dr. Moss states that he has over 30 years of work experience in the healthcare industry and has "developed medical devices, including wearable, wireless physiological monitoring devices." *Id.* at ¶¶ 1, 3. Citing the same passage reproduced above and another disclosure in the '660 Application that describes arrhythmia, Dr. Moss testified that such data would be understood by the ordinary skilled worker to be processed physiological data. *Id.* at ¶¶ 12-13. Dr. Moss's testimony is reasonable and consistent with the explicit disclosure in the '660 Application.

The Third Party Requester contends that Patent Owner "took the position to gain allowance during the original examination that 'processed physiological data' meant a 'material processing' resulting in 'medically significant' data." Third Party Requester Respondent Br. 8. However, the Third Party Requester has not provided sufficient evidence that determining whether a preset parameter is met or not ('660 Application, p. 7) is not medically significant or material processing. Thus, we find the Requester's arguments unavailing.

- “Multipurpose personal data accessory”

We construed the claimed “multi-purpose personal data accessory” to be a device which is adapted to executing the claimed health monitoring function using a processor or other component which is not solely devoted to the health monitoring function, but has a function other than health monitoring, such as a function available on a cellular phone or palm computer. The Third Party Requester argues that the Davis publication has as much description of a multi-purpose personal data accessory as does the ‘660 Application, and if we reverse the Davis rejection as Patent Owner proposes, we must also find the ‘660 Application deficient in its description of a the claimed multi-purpose personal data accessory. For this reason, we first turn to the ‘660 Application, and the subsequently filed continuation-in-part applications, to determine whether there is a description of the claimed “a multi-purpose personal data accessory” as we have interpreted that phrase.

The ‘660 Application does not use the phrase “a multi-purpose personal data accessory.” Instead, it refers to a “personal ambulatory cellular health monitor.” The ‘660 Application discloses in Figure 1 a control subsystem 600 which comprises a DSP subsystem. Figure 1; ‘660 Application. DSP is defined in later patent applications as the digital signal processing system. This system appears to correspond to the health monitoring software that receives and processes data. The DSP system is not described in the ‘660 Application as performing any function other than digital data processing and thus does not describe the multi-purpose personal

data accessory as we have interpreted that phrase because it is dedicated solely to one function.

The monitor is described in more detail in the '136 Application as follows:

[T]he present invention ambulatory patient monitoring apparatus including a portable housing including at least one physiological data input device operative to gather physiological data of the patient, **location determination circuitry** operative to determine geographic location information of the patient, **cellular telephone communications circuitry for communicating the physiological data and the geographic location information** to a central health monitoring station, **voice communications circuitry** whereby the patient conducts voice communications with a clinician at the central health monitoring station, **digital signal processing circuitry for processing signals associated with any of the physiological data input device, the location determination circuitry, the cellular telephone communications circuitry, and the voice communications circuitry, and control circuitry for controlling any of the digital signal processing circuitry, the physiological data input device, the location determination circuitry, the cellular telephone communications circuitry, and the voice communications circuitry.**

'136 Application, p. 2, ll. 19-32 (emphasis added).

As indicated by the above disclosure, the '136 Application describes separate circuitry for performing each of the functions assigned to the personal ambulatory cellular health monitor. In particular, the circuitry for processing digital signals obtained from the physiological input device is described in the '660 application as circuitry separate from the circuitry used to perform other functions by the health monitor. The digital signal processing circuitry appears to correspond to the claimed "health monitoring

software” which enables the multi-purpose personal data accessory “to receive the physiological data” and “process the physiological data.”

This description, or ones similar to it, is repeated elsewhere in the ‘136 Application. For example:

Additional reference is now made to Fig. 2 which is a simplified block diagram illustration of the personal ambulatory cellular health monitor 12 of Fig. 1, constructed and operative in accordance with a preferred embodiment of the present invention. Monitor 12 typically includes a medical subsystem 100, a personal location subsystem (PLC) 200, a digital signal processing (DSP) subsystem 300, a voice processing subsystem 400, a radio subsystem 500 and a control subsystem 600.

‘136 Application, p. 8, ll. 2-7.

Once again, different functions to be performed by the device are described as being delegated to different components. This description is also reflected in Figs. 2A-2C of the ‘136 Application, which shows separate components as performing each of the functions.

Taken together, we do not discern a description in the ‘660 and ‘136 Applications of a multi-purpose personal data accessory which is capable of executing the claimed health monitoring function using a processor which is not solely devoted to executing the health monitoring function. Rather, the ‘136 Application, as does the ‘660 Application, describes each of the functions of the personal ambulatory cellular health monitor being performed by a separate component. The health monitoring function of the ‘136 health monitor is shown as executed by digital signal processing circuitry and digital signal processing subsystem 300, which are separate from the other circuitry and systems of the health monitor. Thus, the ‘660 and ‘136 applications describe a health monitor with special and dedicated

hardware to achieve the health monitoring function, the same type of health monitoring system that the '878 Patent expressly distinguished its invention from. '878 Patent, col. 3, ll. 44-50; col. 5, ll. 13-14. Dr. Moss's testimony is consistent with this reading of the digital processing described in the priority applications as being performed by dedicated hardware with the single purpose of processing data. Moss Decl. ¶¶ 20, 23, & 28.

The device described by the '660 and '136 Applications is therefore not "multi-purpose" as that term would be understood by one of ordinary skill in the art when read in the context of the '878 Patent.

Because the '660 and '136 Applications lack such a description, we conclude that the claims of the '878 patent are not entitled to the '660 Application's March 3, 1998 priority date or the '136 Application's March 3, 1999 priority date. The next application in the chain of priority is Application No. 10/086,633, filed March 4, 2002, which is now US 7,222,054. The application also describes a personal ambulatory monitoring with separate circuitry and subsystems for the digital processing. US 7,222,054, col. 2, ll. 22-23; col. 3, ll. 10-31; col. 6, ll. 1-9. Thus, the claims are also not entitled to the priority date of March 4, 2002.

### Summary

The claimed multi-purpose personal data accessory was not described in the priority applications filed on March 3, 1998, March 3, 1999, or March 4, 2002, and thus claims 1-37 are not entitled to the benefit of these dates.

**APPEAL BY PATENT OWNER**

**PUBLISHED PRIOR TO MARCH 3, 1998**

8. *ANTICIPATION BY DAVIS*

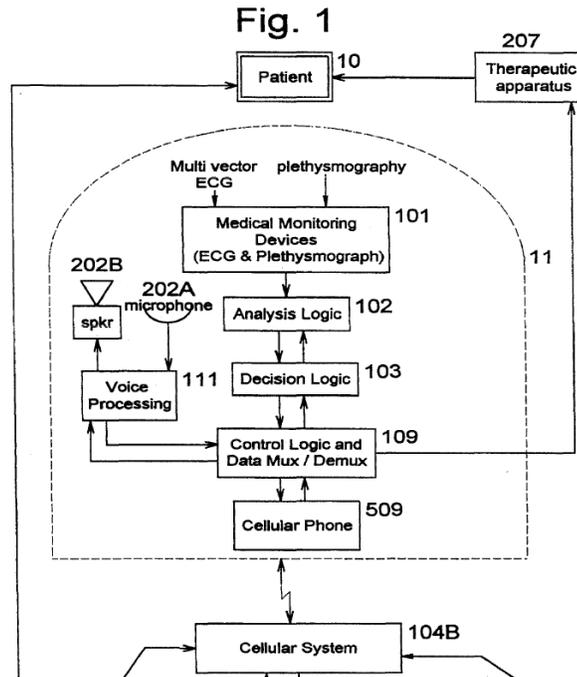
Claims 2, 9, 10, 12, 19, 20, 26, 27, and 31 of the '878 patent rejected under 35 U.S.C. § 102(b) over Davis.

Findings of Fact (“FF”)

FF1 Davis describes “a method and apparatus for monitoring the physical condition of a patient and for automatically notifying a central monitor if the patient’s condition requires attention.” Davis, col. 1, ll. 5-10.

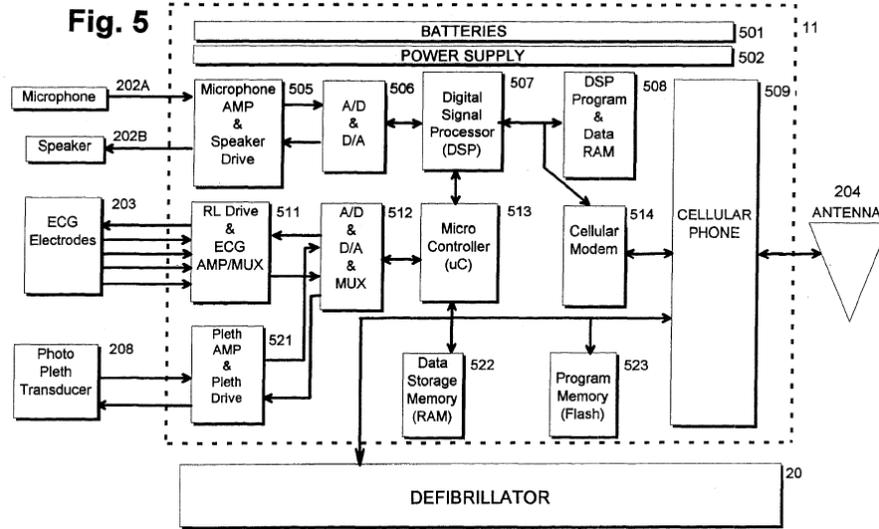
FF2 Davis describes a portable device which comprises “an expert system for determining if a pre-established critical parameter set has been exceeded; and a wireless communication device for automatically contacting the central station via a public cellular phone network when the critical parameter set has been exceeded.” Davis, col. 1, l. 64 to col. 2, l. 5.

FF3 A preferred embodiment is a cellular phone unit 11 as shown in Figure 1. Davis, col. 2, ll. 57-67. Figure 1 is reproduced below:



FF4 Figure 1, above, shows device 11 interconnected with a patient 10 and cellular system 104B. The device 11 comprises an “analysis logic 102” which is described as “a programmed microprocessor which can perform a wide variety of analysis.” Davis, col. 3, ll. 2-4. Davis teaches that the “output of the analysis logic 102 goes to decision logic 103 which compares the patient data to certain preset parameters. If the patient’s data is outside the preset parameters, cellular phone 509 is activated by controller logic 109.” Davis, col. 3, ll. 1-7.

FF5 Figure 5, reproduced below, is an overall block diagram of the monitoring, processing and communication unit 11 which is worn by the patient. Davis, col. 4, ll. 22-24.



The figure, reproduced above, is described as having the following features:

FF6 “The central components of unit 11 include digital signal processor 507, programmable micro controller 513, DSP program and data ram 508, data storage memory 522 and control program memory 523.”

Davis, col. 4, ll. 27-31.

FF7

The details of the cardiac measurement and analysis algorithm operations (block 932) are shown in FIG. 13 and 14. It is noted that all of the operations shown in FIGS. 13 and 14 are controlled by stored programs and performed by digital signal processor 507 and microcontroller 513.

Davis, col. 7, ll. 45-50.

### Discussion

The issue in this rejection is whether Davis’s device 11 meets the claimed limitations of a “multi-purpose personal data accessory” which “execute[s] health monitoring software” as those terms would be interpreted

by one of ordinary skill in the art in light of the '878 Patent. We have construed the claimed multi-purpose personal data accessory to be a device which is capable of executing health monitoring software *without* using additional hardware. In other words, the health monitoring software is executed by hardware in the multi-purpose personal data accessory which also performs other functions associated with the data accessory.

Davis describes specific processors, 102, 103, 507, and 513, who's only disclosed function is to monitor the health of the patient wearing the device. FF4, FF6, & FF7. The processors can therefore be characterized as hardware "dedicated" to health monitoring. As already discussed, the '878 Patent specifically distinguishes its invention from health monitoring devices that comprise additional processors and hardware dedicated only to health care monitoring and cuts against the Davis device as being "multi-purpose."

FF8

Various methods and devices for monitoring the health of a person are known in the art. They include special hardware for gathering and processing physiological data and a wireless device utilizes for transmitting the gathered information. The special hardware is much less sophisticated and less efficient as the hardware of cellular phones. The development of dedicated hardware is usually costly.

'878 Patent, col. 3, ll. 44-50.

FF9

The following description also refers to a cellular phone that can be provided with health monitoring software that enables the cellular phone to process physiological data, and especially without any addition of complex hardware, such as additional processors. It is noted that the invention can be applied to other

multi-task and/or multi-purpose accessories, especially personal data accessories (PDAs) other than [sic] cellular phones that in turn may include palm-computers and the like.

‘878 Patent, col. 5, ll. 10-18.

Davis describes a device with a cellular phone 509 and separate hardware to process the physiological data on the patient’s physical condition. Such a device is the type of health monitor which the ‘878 Patent expressly characterizes as prior art. FF8. Consistently, the illustrative examples in the ‘878 Patent are drawn to a cellular phone which executes the health monitoring software without recourse to additional special hardware as described by Davis. In view of these specific disclosures in the ‘878 Patent, it would be unreasonable to read “multi-purpose data accessory device” with the claimed software execution function to cover Davis’s device which contains a separate processor “to execute the health monitoring software” devoted to this purpose and no other.

Our analysis is consistent with *In re Abbott Diabetes Care Inc.*, 696 F.3d 1142, 1150 (Fed. Cir. 2012), in which disparaging remarks in the patent specification with respect to a certain structural feature of a prior art device, coupled with the finding that every embodiment in the specification lacked such a structure, was sufficient basis to interpret the claim language to exclude the structural feature.

In sum, we reverse the rejection of claims 2, 9, 10, 12, 19, 20, 26, 27, and 31 as anticipated by Davis.

*ANTICIPATION REJECTION 11*

Claim 31 is rejected as anticipated by Rohde. Claim 31 depends on claim 19. Patent Owner asks us to reverse the rejection of claim 31 because the Examiner withdrew the rejection of claim 19. Patent Owner App. Br. 33. As discussed below, we reverse the Examiner's decision to withdraw the anticipation of claim 19. Accordingly, we affirm the anticipation rejection of claim 31 for the reasons given by the Examiner.

**PUBLISHED AFTER MARCH 3, 1998**

*ANTICIPATION REJECTIONS 1-7*

The claims stand rejected as anticipated by Mazar (Rejection 1), Korman (Rejection 2), Mault (Rejection 3), Sackner (Rejection 4), Kumar (Rejection 5), Ross (Rejection 6), and Nizan (Rejection 7). Each of these references were published after March 3, 1998, but before June 23, 2004, the filing date of the parent application of which the '878 Patent is a continuation of. Patent Owner contends the references are not prior art because the rejected claims of the '878 Patent are entitled to the benefit of the filing date of each of US Provisional Application No. 60/076,660, filed March 3, 1998; US. Non-provisional Application No. 091261,136, filed March 3, 1999; and US. Non-provisional Application No. 10/086,633, filed March 4, 2002 ("priority applications"). The only argument made by Patent Owner with respect to Rejections 1-7 is that the cited publications are not prior art. However, we decided that the '878 patent claims are not entitled to the benefit of the priority applications. Consequently, Patent Owner's

argument is unavailing. We affirm the rejections for the reasons given by the Examiner.

*OBVIOUSNESS REJECTIONS 9 & 10*

The claims stand rejected as obvious in view of Hjelt and Davis (Rejection 9) and Sackner and Hjelt (Rejection 10). Patent Owner contends the rejections are improper because the Hjelt and Sackner were published after the earliest filing date of the priority applications and are therefore not prior art. However, we decided that the '878 claims are not entitled to the benefit of the priority applications. Consequently, Patent Owner's argument is unavailing. We affirm the rejections for the reasons given by the Examiner.

**CROSS-APPEAL BY THE THIRD PARTY REQUESTER**  
**PUBLISHED PRIOR TO MARCH 3, 1998**

*1. ANTICIPATION BY ROHDE*

The Examiner withdrew the 35 U.S.C. § 102(b) rejection of Claims 2, 8, 11, 12, 19, 20, and 25 of the '878 patent over Rohde. RAN 19. Rohde was filed April 10, 1997, prior to the earliest priority date of the '878 Patent.

Rohde describes a portable modular diagnostic medical device. The medical device is "based on a portable multipurpose computerized platform, such as those designed primarily for playing video games." Rohde, Abstract. "In a preferred embodiment, the platform is a Nintendo Gameboy [sic] video game device, and the medical component is a cartridge that plugs

into the Gameboy [sic] device.” *Id.* at col. 3, ll. 7-10. The Examiner found that Rohde does not anticipate claims 2, 8, 11, 12, 19, 20, and 25 because “the GameBoy [sic] has no wireless communications capabilities nor control of a long-range transmission.” RAN 19. The Third Party Requester contends that this determination was erroneous.

Claims 2, 8, 11, and 12

Claim 2 depends on claim 1 and therefore incorporates all its limitations. Claim 1 comprises the multi-personal data accessory which is enabled to “control a long range transmission of the processed physiological data to a remote entity.” Claim 2 therefore also has the long range requirement.

As mentioned, Rohde describes a Game Boy<sup>®</sup> with a medical monitoring cartridge. Rohde describes an example in which the ECG of a patient is being monitored by the device. Rohde teaches:

FF10

The clinician is able to select an ECG signal from any of a number of different leads. Outputting of the signal via the serial port permits the acquired data to be sent via cable to a local laptop computer or smart modem. Outputting of the signal on the speaker or through the headphones may enhance data visualization for the clinician; the speaker can also be used as an acoustic modem to transmit the signal from a remote location to a hospital via a normal phone connection.

Rohde, col. 6, ll. 43-51.

The acquired data is sent to a “smart modem” or by an “acoustic modem” to “a remote location to a hospital via a normal phone connection.” The Third Party Requester did not provide

evidence in either case that the transmission by the modems were controlled by the Game Boy<sup>®</sup> as we have interpreted “control a long range transmission” to require. Consequently, we conclude that the Examiner’s decision not to adopt the anticipation rejection of claim 2, 8, 11, and 12 over Rohde is supported by a preponderance of the evidence.

#### Claims 19, 20, and 25

Claim 19 is a method claim and differs from claim 1 in not requiring that the device enable “long range transmission” of the processed data. Rather claim 19, simply recites “transmitting the processed physiological data.” Patent Owner distinguishes claim 19 from Rohde, arguing that “the local clinician in Rohde is required to operate, for example, the local telephone, to achieve any sort of transmission beyond the NINTENDO GAMEBOY.” Patent Owner’s Respondent Br. 6. However, the claim does not preclude the local clinician from transmitting the data by operating a phone. The “transmitting” step is the last of the claimed method for health monitoring. The claim does not require that the “transmitting” be accomplished automatically, by the multipurpose data accessory, or without intervention by the patient or clinician. Rather, the “transmitting” step does not specify how the transmission is accomplished. As argued by the Third Party Requester, “[i]ndependent Claim 19 does not require ‘controlling’ a long range transmission, rather, all that is claimed is ‘transmitting the processed physiological data.’” Third Party Requester App. Br. 8. For this

reason, we reverse the Examiner's decision not to adopt the rejection of claim 19, and dependent claims 20 and 25, as anticipated by Rohde.

*REJECTIONS 2 & 4. ANTICIPATION BY ALBERT*

On page 11 of the December 16, 2010, Action Closing Prosecution, the Examiner withdrew the 35 U.S.C. § 102(b) rejection of Claims 2, 5, 17, 19, 20, and 23 of the '878 patent over Albert. The Examiner found that Albert does not disclose "an MPDA [multi-purpose personal data accessory] able to *control a long range transmission of the processed physiological data*, which was instead performed by using a telephone." (Emphasis in the original.) Claim 31 was distinguished by the Examiner for the same reason. The Third Party Requester challenges this determination with respect to claim 19, 20, 23, and 31. Third Party Requester App. Br. 9-10.

Claim 19 does not require the multi-purpose personal data to "control" the transmission of data. Unlike claim 1, the term "control" is not recited in claim 19. Rather, claim 19 is a method claim with a last step which calls for "transmitting the processed physiological data." Contrary to Patent Owner's contention (Patent Owner Respondent Br. 7), the claim does not require that the personal data accessory control the transmission of the data. Because the Examiner's determination was based on an improper interpretation of claim 19, we are compelled to reverse the Examiner's decision not to adopt the anticipation rejection of claim 19, and dependent claims 20 and 23.

Claims 2, 5, and 17

As no arguments were presented for claims 2, 5, and 17, we affirm the Examiner's decision not to adopt the anticipation rejection of these claims.

Claim 31 (Rejection 4), depends on claim 19, and further recites that "wherein transmitting the processed physiological data comprises controlling a long range transmission of the processed physiological data, by the multi-purpose personal data accessory." As this claim differs from claim 19 in that it recites "controlling," and is rejected on other grounds, we shall not reach it.

### *3. 112, SECOND PARAGRAPH REJECTIONS*

The Examiner did not adopt the Requester's proposed rejections under 35 U.S.C. 112, second paragraph, over claims 27 and 31-35. We will not reach this rejection because the claims stand rejected on other grounds.

### *5. PROPOSED REJECTIONS OF CLAIMS 31, 34, & 34*

Requester proposed rejections of Claims 31, 34, and 35 which the Examiner found not to be compliant with 37 C.F.R. §§ 1.947 and 1.948. RAN 26. We shall not reach this issue because claims 31, 34, and 35 stand rejected on other grounds.

## **SUMMARY**

### Appeal

Rejections 1-7. Affirmed as to claims 2-35 (all pending claims in this proceeding).

Rejection 8. Reversed as to claims 2, 9, 10, 12, 19, 20, 26, 27, and 31.

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Rejections 9-10. Affirmed as to claims 2-14, 17-28, 30, 32, and 33.

Rejection 11. Affirmed as to claim 31.

### Cross-Appeal

Rejection 1. Affirmed as to claims 2, 8, 11, and 12. Reversed as to claims 19, 20, and 25 (new grounds).

Rejections 2. Affirmed as to claims 2, 15, and 17. Reversed as to claim 19, 20, and 23 (new grounds).

Rejection 3. Not reached.

Rejection 4. Not reached.

Rejection 5. Not reached.

### NEW GROUNDS

This decision contains new grounds of rejection pursuant to 37 C.F.R. § 41.77(b) which provides that “[a]ny decision which includes a new ground of rejection pursuant to this paragraph shall not be considered final for judicial review.” Correspondingly, no portion of the decision is final for purposes of judicial review. A requester may also request rehearing under 37 C.F.R. § 41.79, if appropriate, however, the Board may elect to defer issuing any decision on such request for rehearing until such time that a final decision on appeal has been issued by the Board.

For further guidance on new grounds of rejection, see 37 C.F.R. § 41.77(b)-(g). The decision may become final after it has returned to the Board. 37 C.F.R. § 41.77(f).

37 C.F.R. § 41.77(b) also provides that the Patent Owner, **WITHIN ONE MONTH FROM THE DATE OF THE DECISION**, must exercise one of the following two options with respect to the new grounds of rejection to avoid termination of the appeal as to the rejected claims:

(1) *Reopen prosecution*. The owner may file a response requesting reopening of prosecution before the examiner. Such a response must be

either an amendment of the claims so rejected or new evidence relating to the claims so rejected, or both.

(2) *Request rehearing.* The owner may request that the proceeding be reheard under § 41.79 by the Board upon the same record. ...

Any request to reopen prosecution before the examiner under 37 C.F.R. § 41.77(b)(1) shall be limited in scope to the “claims so rejected.” Accordingly, a request to reopen prosecution is limited to issues raised by the new ground(s) of rejection entered by the Board. A request to reopen prosecution that includes issues other than those raised by the new ground(s) is unlikely to be granted. Furthermore, should the patent owner seek to substitute claims, there is a presumption that only one substitute claim would be needed to replace a cancelled claim.

A requester may file comments in reply to a patent owner response. 37 C.F.R. § 41.77(c). Requester comments under 37 C.F.R. § 41.77(c) shall be limited in scope to the issues raised by the Board’s opinion reflecting its decision to reject the claims and the patent owner’s response under paragraph 37 C.F.R. § 41.77(b)(1). A newly proposed rejection is not permitted as a matter of right. A newly proposed rejection may be appropriate if it is presented to address an amendment and/or new evidence properly submitted by the patent owner, and is presented with a brief explanation as to why the newly proposed rejection is now necessary and why it could not have been presented earlier.

Compliance with the page limits pursuant to 37 C.F.R. § 1.943(b), for all patent owner responses and requester comments, is required.

The examiner, after the Board’s entry of a patent owner response and requester comments, will issue a determination under 37 C.F.R. § 41.77(d) as to whether the Board’s rejection is maintained or has been overcome. The proceeding will then be returned to the Board together with any comments and reply submitted by the owner and/or requester under 37 C.F.R. § 41.77(e) for reconsideration and issuance of a new decision by the Board as provided by 37 C.F.R. § 41.77(f).

AFFIRMED; 41.77(B)

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