

## **Cardiocom, LLC v. Robert Bosch Healthcare Systems, Inc.: Final Written Decision IPR2013-00431**

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*Takeaway: To successfully assert secondary considerations such as commercial success and industry praise, Patent Owner must establish a nexus between the claimed invention and the commercial success or industry praise.*

In its [Final Written Decision](#), the Board found that Petitioner had established by a preponderance of the evidence that claims 1-16 of the '186 Patent are unpatentable. The Board also dismissed as moot both Petitioner's and Patent Owner's Motions to Exclude Evidence and considered Patent Owner's observations to the cross-examination testimony of Dr. Stone, who was cross-examined after Petitioner filed its Reply.

The '186 Patent relates to a method for collecting data relating to the health status of patients and communicating information to patients.

The Board began its analysis with claim construction. Neither of the parties disputed any of the interpretations taken by the Board in the Decision to Institute, and thus the Board maintained those interpretations.

The Board then turned to the grounds of unpatentability for claims 1-6 and 8-15 based on obviousness over Goodman and Wahlquist, and further in view of Lyons for claims 7 and 16.

Patent Owner argued that Goodman failed to disclose a "server," "first communication interface," "response to a query, message or information received over the second communication interface," "responses or other messages generated by the individual and sent to the host computed," "the server assigning said programming information to said individual," "said programming information is presented to said individual by executing said computer program on said apparatus," or "said computer program comprises a custom script program," as required by claim 1. For each element, Petitioner had provided a detailed explanation for why the element was taught by the combination of Goodman and Wahlquist. Further, Patent Owner's arguments for why those features were not obvious over the proposed combination of references relied on overly narrow interpretations of the claim terms and the references. The Board was also not persuaded by Patent Owner's arguments with regard to the other independent claim or dependent claims.

Patent Owner further argued that Wahlquist was not analogous to the invention of the '186 Patent. Specifically, Patent Owner argued that the field of endeavor of the claimed invention "must be identified with reference to the 'the claimed invention.'" The Board did not agree with Patent Owner's contention that a reference is only analogous to a "claimed invention" if the reference discloses specific recited claim terms. Further, the Board did not even need to address this interpretation of "field of endeavor," because Wahlquist was found to be reasonably pertinent to the problem faced by the inventor of the '186 patent. Specifically, the Board found that a problem faced by the inventor was how to associate a script program with a specific entity, such that the appropriate program would be executed for a corresponding user, and Wahlquist discloses a solution to that problem regardless of whether Wahlquist related to patient monitoring problems.

Patent Owner further argued that it would not have been obvious to one of ordinary skill in the art to have combined the teachings of Goodman and Wahlquist, because such a combination would result in a system that "communicate[s] directly with a patient's messaging device, without communication . . . by the user that Goodman's system is intended to serve," thus teaching away from increasing communications with a person. However, the Board found that Patent Owner did not explain sufficiently how the system of Wahlquist eliminates communication with the user. Patent Owner also argued that Petitioner was relying on impermissible hindsight reasoning, but the Board determined that Patent Owner did not indicate how Petitioner's expert's analysis relied on knowledge that was beyond the level of ordinary skill in the art at the time the claimed invention was made or that was gleaned only from the '186 patent specification.

Patent Owner also asserted that commercial success, long-felt need, industry praise, teaching away by others, and copying demonstrate that the challenged claims would not have been obvious to a person of ordinary skill in the art, relying on an expert for these assertions. First, the Board determined that Patent Owner failed to establish a nexus between the claimed invention and the commercial success or industry praise. Specifically, Patent Owner failed to explain in detail why it was the unique characteristics of the claimed apparatus or method that drove sales or industry praise for its Health Buddy. Similarly, Patent Owner failed to establish the requirements for long-felt need, such as explaining why there was a long-felt need to solve a problem that others recognized but were unable to meet or whether the claimed invention actually satisfied the alleged need. Patent Owner also failed to persuade the Board regarding its assertion of teaching away by others and copying. Thus, the Board determined based on all of the evidence of record that all of the challenged claims are unpatentable.

***Cardiacom, LLC v. Robert Bosch Healthcare Systems, Inc.*, IPR2013-00431**

**Paper 67: Final Written Decision**

**Dated: January 15, 2015**

**Patent: 7,291,186 B2**

**Before: Stephen C. Siu, Justin T. Arbes, and Miriam L. Quinn**

**Written by: Siu**

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