

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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TELADOC, INC.,  
Petitioner,

v.

AMERICAN WELL CORP.,  
Patent Owner.

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Case IPR2015-00924  
Patent 7,590,550 B2

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Before BRIAN J. McNAMARA, MICHAEL J. FITZPATRICK, and  
DANIEL J. GALLIGAN, *Administrative Patent Judges*.

GALLIGAN, *Administrative Patent Judge*.

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

## I. INTRODUCTION

Teladoc, Inc. (“Petitioner”) filed a Petition (“Pet.”) requesting *inter partes* review of claims 10, 11, 23, and 30 of U.S. Patent No. 7,590,550 B2 (“the ’550 patent,” Ex. 1001). Paper 1. American Well Corporation (“Patent Owner”) did not file a Preliminary Response. We have jurisdiction under 35 U.S.C. § 314 and 37 C.F.R. § 42.4(a).

The standard for instituting an *inter partes* review is set forth in 35 U.S.C. § 314(a), which provides:

THRESHOLD—The Director may not authorize an *inter partes* review to be instituted unless the Director determines that the information presented in the petition filed under section 311 and any response filed under section 313 shows that there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.

For the reasons set forth below, we conclude that the information presented in the Petition establishes that there is a reasonable likelihood that Petitioner will prevail in challenging claims 10, 11, 23, and 30 as unpatentable under 35 U.S.C. § 102(e). Pursuant to 35 U.S.C. § 314, we institute an *inter partes* review as to claims 10, 11, 23, and 30 of the ’550 patent.

### A. *Related Matters*

Petitioner indicates that the ’550 patent was asserted against it in *American Well Corp. v. Teladoc, Inc.*, 1:15-cv-12274-IT (D. Mass). Paper 6, 1.

### B. *The ’550 Patent (Ex. 1001)*

The ’550 patent generally relates to a system and method for receiving requests from consumers to consult with service providers and establishing a

connection between consumers and service providers. Ex. 1001, Abst. One aspect of the '550 patent, to which the challenged claims are directed, involves connecting patients and medical service providers, such as physicians. Ex. 1001, 2:62–67. In particular, the system keeps track of the availability of physicians to handle consumer requests. *Id.* at 3:3–12. A patient (consumer) can request a consultation with a physician, following which a connection is made between the patient and the physician. *Id.* at 3:13–19.

### *C. Illustrative Claims*

Claims 10, 23, and 30 of the '550 Patent are independent claims. Claim 11 depends from independent claim 10. Claims 10 and 11 are reproduced below:

10. A computer-implemented method comprises:  
accessing a data repository that stores information pertaining to medical service providers, including present availability of the medical service providers for participating in a consultation;  
receiving in a computer, indications that members of a pool of medical service providers have become presently available;  
receiving in the computer, a request from a consumer of services to consult with a medical service provider;  
identifying in the computer, an available member of the pool; and  
establishing a real-time communication channel between the consumer of services and the identified member of the pool.

11. The method of claim 10 wherein:  
the request includes an identification of a time in the future; and  
identifying the member of the pool and establishing the communication channel take place at the identified time.

Ex. 1001, 27:25–44.

*D. Prior Art Relied Upon*

Petitioner relies upon the following prior art references:

Haines et al. (hereinafter “Haines”)	US 2003/0023458 A1	Jan. 30, 2003	Ex. 1004
Lurie et al. (hereinafter “Lurie”)	US 6,704,403 B2	Mar. 9, 2004	Ex. 1003
Haq	US 7,412,396 B1	Aug. 12, 2008 (filed July 30, 2001)	Ex. 1002

*E. Asserted Grounds of Unpatentability*

Petitioner challenges claims 10, 11, 23, and 30 of the ’550 patent based on the asserted grounds of unpatentability set forth in the table below.

Reference(s)	Basis	Claim(s) Challenged
Haq	§ 102(e)	10, 11, 23, and 30
Lurie	§ 102(b)	10, 11, 23, and 30
Lurie	§ 103(a)	11
Lurie and Haq	§ 103(a)	11
Haines	§ 102(b)	10, 23, and 30
Haines and Haq	§ 103(a)	11

II. CLAIM CONSTRUCTION

In an *inter partes* review, “[a] claim in an unexpired patent shall be given its broadest reasonable construction in light of the specification of the patent in which it appears.” 37 C.F.R. § 42.100(b); *In re Cuozzo Speed Techs., LLC*, 793 F.3d 1268, 1275–78 (Fed. Cir. 2015), *reh’g en banc denied*, 793 F.3d 1297 (Fed. Cir. 2015). In determining the broadest

reasonable construction, we presume that claim terms carry their ordinary and customary meaning. *See In re Translogic Tech., Inc.*, 504 F.3d 1249, 1257 (Fed. Cir. 2007). This presumption may be rebutted when a patentee, acting as a lexicographer, sets forth an alternate definition of a term in the specification with reasonable clarity, deliberateness, and precision. *In re Paulsen*, 30 F.3d 1475, 1480 (Fed. Cir. 1994).

Petitioner proposes constructions for three terms of the '550 patent: “information pertaining to medical service providers,” “a real-time communication channel,” and “a time in the future.” *See* Pet. 13–16. With respect to “information pertaining to medical service providers” and “a time in the future,” Petitioner proposes to add the word “any” before each of these phrases, so as to construe them as “any information pertaining to medical service providers” and “any time in the future,” respectively. Pet. 13–16. The claim terms are clear and stand on their own. We are not persuaded that the broadest reasonable interpretation of these terms requires the addition of the word “any.”

Petitioner proposes to construe “a real-time communication channel” as “any communication channel which permits a consumer and a medical service provider to correspond in real time.” Pet. 15. We are not persuaded that the broadest reasonable interpretation of “a real-time communication channel” includes parties to the communication, as proposed by Petitioner. Indeed, other language in claims 10, 23, and 30 expressly specifies the parties to the communication. Further, we are not persuaded that the broadest reasonable interpretation of this term requires the addition of the word “any.”

For the foregoing reasons, we are not persuaded that the terms identified by Petitioner require express constructions as proposed. Instead, we apply the plain and ordinary meaning of these terms. All remaining claim terms or phrases recited in claims 10, 11, 23, and 30 need not be construed explicitly at this time.

### III. ANALYSIS

#### A. 35 U.S.C. § 102(e) Ground of Unpatentability Based on Haq

Petitioner contends that claims 10, 11, 23, and 30 are anticipated under 35 U.S.C. § 102(e) by Haq. Pet. 18–25. Petitioner provides arguments and a claim chart to explain how Haq allegedly discloses the claimed subject matter. *Id.* On this record, we are persuaded by Petitioner’s claim charts and explanation of invalidity over Haq.

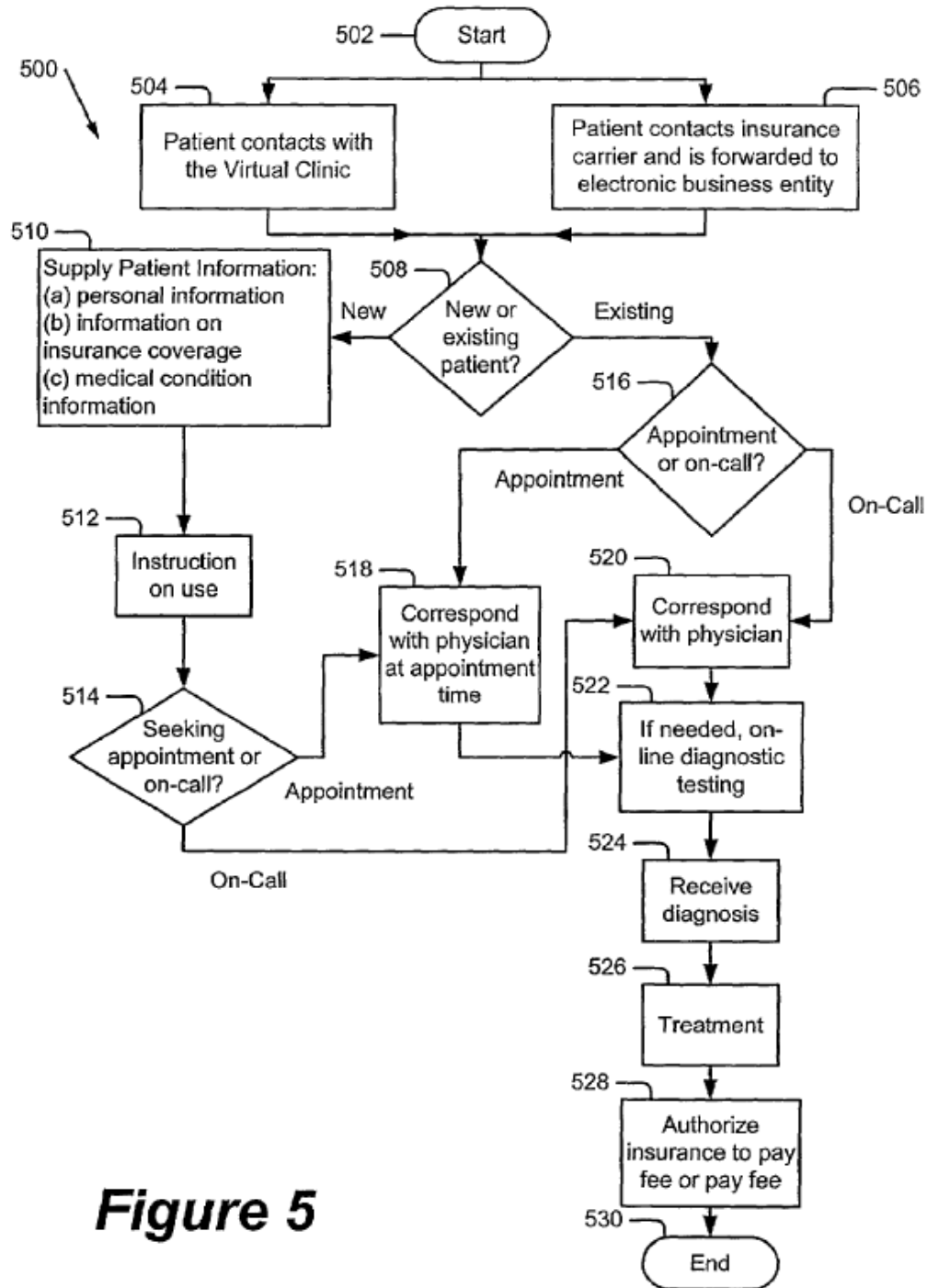
We begin our analysis with a general discussion of Haq and then turn to the positions taken by Petitioner with respect to the claimed subject matter recited in independent claim 10 and dependent claim 11.

#### 1. Haq (Ex. 1002)

Haq generally relates to “a system and method for enabling patients, with equipment readily available off the shelf, to correspond in real-time with their physicians without the need for expensive facilities in remote locations.” Ex. 1002, 2:35–38. The “virtual clinic” of Haq “enables a patient to request consultation with a medical professional.” *Id.* at 4:61–65. A patient can select a physician, or the virtual clinic can assign a physician. *Id.* at 6:10–15. Once a medical professional is selected, “the virtual clinic establishes communications with the medical professional (typically a physician) and then either coordinates the communications link between the physicians and patient or simply tells the patient or physician how to contact

the other party directly.” *Id.* at 5:19–24. Haq also discloses that a patient can request to set up an appointment. *Id.* at 10:1–8.

Figure 5 of Haq is reproduced below:



**Figure 5**

Figure 5 of Haq is a flow chart showing an embodiment of the virtual clinic process from a patient's perspective. Ex. 1002, 4:8–9.

## *2. Petitioner's Contentions*

Petitioner presents an analysis of Haq accompanied by a claim chart to explain how Haq allegedly discloses the steps recited in claims 10 and 11. Pet. 19–25. Petitioner's analysis and claim chart have not been addressed by Patent Owner at this stage of the proceeding.

First, Petitioner argues that Haq's disclosure of a process using a “virtual clinic” discloses a computer-implemented method, as recited by the preamble of claim 10. Pet. 21 (citing Ex. 1002, 1:14–19, 2:35–38, 3:26–31, 4:26–31). Haq discloses “a method for a patient to remotely contact a physician and receive medical services which utilizes a virtual clinic to contract with physicians and insurance companies.” Ex. 1002, 4:26–29. Haq discloses that the “virtual clinic” is computer-based by stating the following: “The virtual clinic can be a hardware device that is connected to a suitable network, or a software program running on a computer system that is connected to the network, or any combination there between.” *Id.* at 4:39–42.

Next, Petitioner contends that Haq discloses the following steps of independent claim 10: “accessing a data repository that stores information pertaining to medical service providers, including present availability of the medical service providers for participating in a consultation”; and “receiving in a computer, indications that members of a pool of medical service providers have become presently available.” Pet. 21 (citing Ex. 1002, 5:62–6:9, 10:21–26, Fig. 6). Haq discloses that the virtual clinic stores information about medical service providers. Ex. 1002, 6:6–9 (“The virtual



clinic maintains a list of the physicians with their specialties [sic], their qualifications and relevant information (board certification, school and year of graduation, experience and expertise, etc.).”). Haq further discloses that physicians inform the virtual clinic when they are available such that the virtual clinic maintains information regarding the present availability of a physician. For example, Haq discloses: “Initially, the physician contacts the virtual clinic, step 604, informing the virtual clinic whether he is going on-line to conduct an appointment or is available for on-call conferences, step 606.” *Id.* at 10:23–26.

Petitioner then contends that Haq discloses “receiving in the computer, a request from a consumer of services to consult with a medical service provider,” as recited in independent claim 10. Pet. 21 (citing Ex. 1002, 3:4–14, 4:61–65, 9:1–5, Figs. 4, 5). Indeed, Haq states that “[o]nce the virtual clinic establishes sufficient working relationships with physicians and/or insurance carriers and/or employers, it creates a presence on the network by, for example, creating a web page that enables a patient to request consultation with a medical professional.” Ex. 1002, 4:61–65. Further, Figures 4 and 5 of Haq depict a process for a consumer to contact the virtual clinic to request services. *See* Ex. 1002, Figs. 4, 5, 4:5–9.

Petitioner then contends that Haq discloses the following steps of independent claim 10: “identifying in the computer, an available member of the pool”; and “establishing a real-time communication channel between the consumer of services and the identified member of the pool.” Pet. 22 (citing Ex. 1002, 2:35–38, 3:23–31, 5:11–24, 5:38–44, 5:62–6:1, 6:10–15, 6:59–66, 8:24–29, 9:1–31, 9:38–43, 10:8–14, 10:59–62, 11:64–12:5, Figs. 4–6). Indeed, Haq states the following:

Based upon information uploaded by the patient, as well as an optional comparison with patient information retrieved from a database, the time of day, the availability of the patient's standard physician, the type of medical condition, etc., a particular doctor is selected by the virtual clinic. The virtual clinic then provides the proper connectivity between the selected physician and the patient or otherwise enables them to communicate.

Ex. 1002, 6:59–66. Haq discloses that the virtual clinic allows the patient and the physician to communicate in real time, stating that the system “enable[es] patients, with equipment readily available off the shelf, to correspond in real-time with their physicians without the need for expensive facilities in remote locations.” *Id.* at 2:35–38. Haq provides an example of such connectivity in which “[t]he patient and physician are able to see each other via a camera hooked up to their PCs and can communicate directly with each other verbally or by typing on their respective screens.” *Id.* at 10:59–62.

Petitioner also contends Haq discloses the limitations of dependent claim 11, which recite: “the request includes an identification of a time in the future”; and “identifying the member of the pool and establishing the communication channel take place at the identified time.” Pet. 22 (citing Ex. 1002, 3:31–34, 5:41–44, 5:62–6:1, 9:63–10:8, 10:21–26, 10:46–49, Figs. 5, 6). Petitioner explains that “[t]he patient can request an appointment in the future and the virtual clinic will establish a real-time connection between the patient and an available physician at that future time.” *Id.* Haq discloses that the virtual clinic asks whether the patient wants an appointment or wants to converse with a physician on-call. Ex. 1002, 9:63–10:3, Fig. 5 (refs. 514 and 516). Haq then discloses that “if a patient wishes to correspond with physician pursuant to an appointment, an appointment is set

up through the virtual clinic with both the patient and physician, such that the patient may correspond with the physician at the appointment time, step 518.” Ex. 1002, 10:4–8; *see also id.* at Fig. 5.

Based on the record before us, Petitioner has demonstrated a reasonable likelihood of prevailing on its assertion that independent claim 10 and dependent claim 11 would have been unpatentable over Haq. In addition, Petitioner presents arguments and claim charts to explain how Haq allegedly discloses the subject matter of independent claims 23 and 30. *See* Pet. 18–21, 22–25. Claim 23 is directed to a “computer program product comprising instructions for causing a computer to” perform steps corresponding to the steps of claim 10. Similarly, claim 30 is directed to an apparatus having a processor and a “computer program product comprising instructions for causing the processor to” perform steps corresponding to the steps of claim 10. Based on our review of Petitioner’s arguments and claim charts, we are persuaded that Petitioner has demonstrated a reasonable likelihood of prevailing on its assertion that independent claims 23 and 30 would have been unpatentable over Haq.

#### *B. Remaining Grounds of Unpatentability*

Petitioner contends that: (1) claims 10, 11, 23, and 30 are unpatentable under 35 U.S.C. § 102(b) over Lurie; (2) claim 11 is unpatentable under 35 U.S.C. § 103(a) over Lurie; (3) claim 11 is unpatentable under 35 U.S.C. § 103(a) over the combination of Lurie and Haq; (4) claims 10, 23, and 30 are unpatentable under 35 U.S.C. § 102(b) over Haines; and (5) claim 11 is unpatentable under 35 U.S.C. § 103(a) over the combination of Haines and Haq. Pet. 25–46. These additional grounds of unpatentability address the same claims on which we already are

instituting an *inter partes* review. We have considered these additional grounds, and in view of our instituting *inter partes* review on the same claims, we exercise our discretion and do not authorize *inter partes* review on these additional grounds. *See* 37 C.F.R. § 42.108(a).

#### IV. CONCLUSION

For the foregoing reasons, we conclude that the information presented in the Petition establishes that there is a reasonable likelihood that Petitioner would prevail in showing that claims 10, 11, 23, and 30 of the '550 patent are unpatentable under 35 U.S.C. § 102(e) over Haq. However, we have not made a final determination with respect to the patentability of these claims.

#### V. ORDER

Accordingly, it is:

ORDERED that pursuant to 35 U.S.C. § 314(a), an *inter partes* review is hereby instituted as to claims 10, 11, 23, and 30 of the '550 patent as unpatentable under 35 U.S.C. § 102(e) over Haq;

FURTHER ORDERED that no other grounds of unpatentability are authorized for this *inter partes* review as to the claims of the '550 patent;

FURTHERED ORDERED that pursuant to 35 U.S.C. § 314(c) and 37 C.F.R. § 42.4, notice is hereby given of the institution of a trial. The trial will commence on the entry date of this decision.

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