

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ENOVATE MEDICAL, LLC,
Petitioner,

v.

INTERMETRO INDUSTRIES CORPORATION,
Patent Owner.

Case IPR2015-00300
Patent 6,721,178 B1

Before MICHAEL R. ZECHER, JENNIFER S. BISK, and
MICHAEL J. FITZPATRICK, *Administrative Patent Judges*.

BISK, *Administrative Patent Judge*.

FINAL WRITTEN DECISION
35 U.S.C. § 318(a)

I. INTRODUCTION

Petitioner, Enovate Medical, LLC, filed a Petition to institute an *inter partes* review of claims 2, 5, 25, 27, 28, 43, 68, 88, 101, and 108 of U.S. Patent No. 6,721,178 (U.S. Patent No. 6,721,178 B1, as amended by *ex parte* reexamination certificate U.S. Patent No. 6,721,178 C1 (Ex. 1001, “the ’178 patent”)). Paper 1 (“Pet.”). Patent Owner, InterMetro Industries Corporation, filed a Preliminary Response pursuant to 35 U.S.C. § 313. Paper 9 (“Prelim. Resp.”). We granted the Petition in part, instituting trial on whether claims 27, 28, 88, and 101 are unpatentable as obvious over Dell¹, Sweere², and Allan³, and claim 108 as obvious over Dell, Sweere, Allan, and Planar.⁴ Paper 12.

During the trial, Patent Owner filed a Response under seal (Paper 20, “PO Resp.”),⁵ and Petitioner filed a Reply. Paper 25 (“Reply”). Additionally, both parties filed Motions to Exclude evidence. Paper 33⁶; Paper 35. Finally, Patent Owner filed a Motion to Dismiss and Terminate (Paper 37, “Mot. to Term.”), against which Petitioner filed an Opposition (Paper 40, “Opp. to Mot. to Term.”),

¹ U.S. Patent No. 5,806,943, issued Sept. 15, 1998. Ex. 1003.

² U.S. Patent No. 5,842,672, issued Dec. 1, 1998. Ex. 1004.

³ U.S. Patent No. 5,685,235, issued Nov. 1, 1997. Ex. 1008.

⁴ Webpage found at <http://www.planar.com/pds/products/cleanscreen/cleansc.htm>, as of July 3, 1997, as archived at <http://web.archive.org/web/19970703043920/>. Ex. 1007.

⁵ Patent Owner’s Response, with information relating to sales of its point-of-care (or POC) carts redacted, is publicly available as Paper 21.

⁶ The evidence Petitioner seeks to exclude—Exhibits 2005–2008—was filed by Patent Owner under seal. Thus, Petitioner filed its Motion to Exclude under seal, as it discusses certain details from Patent Owner’s sealed exhibits. Petitioner’s Motion to Exclude, with such details redacted, is publicly available as Paper 32.

and in support of which Patent Owner filed a Reply (Paper 49).

A consolidated hearing for oral arguments in this *inter partes* review and Case IPR2015-00301 was held January 13, 2016. A transcript of the hearing appears in the record. Paper 51 (“Tr.”).

We hold claims 27, 28, 88, 101 and 108 unpatentable.

A. Related Matters

Patent Owner has asserted the ’178 patent along with additional patents, including related U.S. Patent No. 6,493,220 B1 (“the ’220 patent”), against Petitioner in *InterMetro Industries Corp. v. Enovate Medical, LLC*, Case No. 3:13-cv-02854 (M.D. Pa.) (the “related lawsuit”). Pet. 2; Paper 8, 2. Claims of the related ’220 patent are being challenged by Petitioner in another an *inter partes* review before us. *See* Case IPR2015-00301, Paper 1.

B. The ’178 Patent

The ’178 patent describes “a mobile workstation that can include an adjustable-height horizontal tray, a pull-out keyboard tray, a vertically-mounted docking station mounted to the tray, a computer terminal mounted beneath the tray, a display screen mounted to the horizontal tray, and a power unit.” Ex. 1001, B1 at 1:10–15.⁷ The mobile workstation can be pushed from room to room, for example, by a medical practitioner during patient rounds at a hospital. *Id.* at 2:65–67.

⁷ Petitioner filed U.S. Patent Nos. 6,721,178 B1 and 6,721,178 C1 together as Exhibit 1001. Both documents include column and line numbers. In our citations to Exhibit 1001, we distinguish between the exhibit’s two documents using their kind codes.

Figure 4b of the patent is reproduced below.

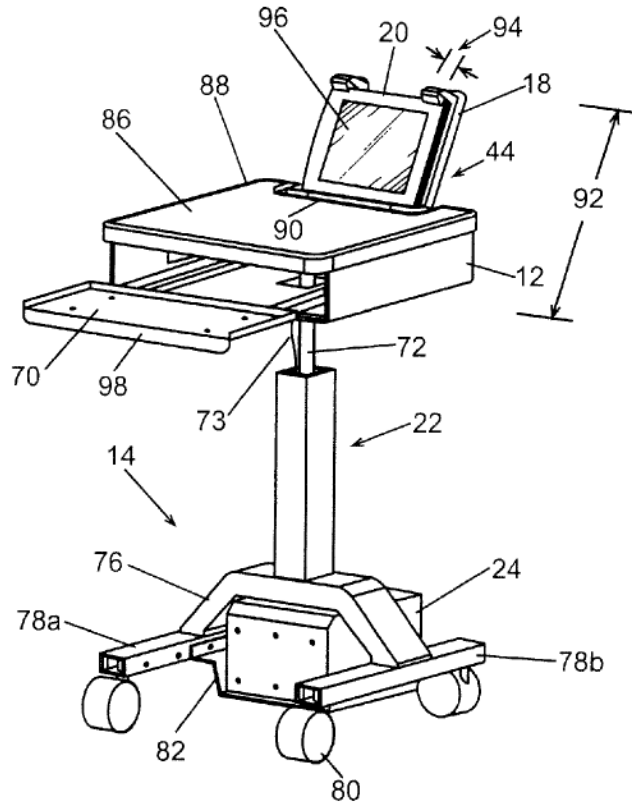


Figure 4b shows a perspective view of the mobile workstation. Ex. 1001, B1 at 4:41–43. The workstation includes adjustable-height horizontal tray 12 supported by chassis 14. *Id.* at 8:53–55. The horizontal tray includes upper surface 86 that provides a work surface. *Id.* at 12:9–12. Horizontal tray 12 supports docking station 18 that removably supports wireless computer terminal 20 having a display screen. *Id.* at 8:58–61. The docking station is attached to the horizontal tray via tiltable bracket 44. *Id.* at 10:10–12.

Although the lead line for computer terminal 20 points to the display screen, which is positioned above the horizontal work surface, the terminal itself may be below the horizontal work surface. *See id.* at 1:14 (“computer terminal mounted beneath the tray”); *id.* at 6:50–52 (“Because the docking station is vertically

mounted, the computer terminal does not occupy the top surface of the horizontal tray”); *id.* at 6:65–67 (“The horizontal tray includes an underside front mounting bracket to support the wireless computer terminal”); *id.* at 8:14–17 (“When the computer terminal is mounted beneath the horizontal tray, the computer terminal does not occupy the top surface of the horizontal tray, which allows this area to be used as a work surface.”); *id.* at Figs. 12a–c, ref. 274.

The chassis includes vertical beam 22 connecting the horizontal tray to a dolly assembly, the dolly assembly being comprised of arched beams 76 and horizontal beams 78a and 78b. *Id.* at 8:61–62, 11:59–61. The horizontal beams include casters (wheels) 80. *Id.* at 11:61–63. The vertical beam is adjustable via a gas-spring or other adjustment mechanism. *Id.* at 8:63–9:10. Power unit 24 is supported on a lower end of the chassis. *Id.* at 9:17–18.

C. Previous Reexamination of the ’178 Patent

The ’178 patent issued on April 13, 2004, with forty-four claims. Ex. 1001, B1. Rioux Vision, Inc., an entity unrelated to the parties in this proceeding, filed a Request for *Inter Partes* Reexamination of the ’178 patent on September 20, 2007. *See* Ex. 1013, 4. The Office granted Rioux’s request, finding a substantial new question of patentability with respect to all forty-four claims. *Flo Healthcare Solutions, LLC v. Kappos*, 697 F.3d 1367, 1370 (Fed. Cir. 2012). During the reexamination, Patent Owner added over one hundred dependent claims, cancelled claims 1, 26, and 75, changed the dependencies of corresponding claims, and rewrote claims 2 and 27 in independent form. The Examiner ultimately rejected claims 8–17, 23, 24, 35, 40–42, 73, 76–79, 87, and 88 over various references. These rejections were affirmed by the Board and the Federal Circuit. *Flo*

Healthcare, 697 F.3d at 1369. Thus, the '178 patent currently includes claims 2–6, 7, 18–22, 25, 27–33, 39, and 43–130. Claims 2 and 27 are independent. Ex. 1001, C1 at 1:14–8:5.

D. Illustrative Claim

This proceeding concerns claims 27, 28, 88, 101 and 108 of the '178 patent. Claim 27 is illustrative of the claimed subject matter and is reproduced below.

27. A mobile workstation, comprising:
- a moveable chassis;
 - a substantially horizontal tray supported by the chassis that defines a work surface:
 - a display screen positioned so that at least a portion of the display screen is visible above the work surface, wherein the display screen is tiltable relative to the work surface;
 - an input device tray proximate to the work surface;
 - a computing device positioned below the work surface; and
 - a power unit for supplying power to the computing device,
 - wherein the chassis comprises a height adjustment mechanism for adjusting the height of the chassis to adjust the height of the work surface.

Ex. 1001, C1 at 1:59–2:6.

E. Claim Construction

“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). Pursuant to that standard, the claim language should be read in light of the specification, as it would be interpreted by one of ordinary skill in the art. *In re Suitco Surface, Inc.*, 603 F.3d 1255, 1260 (Fed. Cir. 2010). Thus,

we generally give claim terms their ordinary and customary meaning. *See In re Translogic Tech., Inc.*, 504 F.3d 1249, 1257 (Fed. Cir. 2007) (“The ordinary and customary meaning is the meaning that the term would have to a person of ordinary skill in the art in question.”) (internal quotation marks omitted).

No limitation requires an express construction for purposes of the patentability challenge at issue here. *See* Pet. 6–7 (offering only one proposed construction, which was not material to the patentability challenge);⁸ PO Resp. 11 (“Patent Owner agrees that the claim terms involved in the [instituted Grounds] do not require construction for purposes of resolving this [*inter partes* review (IPR)].”).

II. PATENT OWNER’S MOTION TO DISMISS AND TERMINATE

Patent Owner moves to “dismiss and terminate this *inter partes* review because Petitioner failed to identify all real parties-in-interest in its original Petition, as required by 35 U.S.C. § 312(a)(2) and 37 C.F.R. § 42.8(b)(1).” Mot.

⁸ Petitioner proposed a construction for one limitation, but it did so for purposes of complying with a Board Rule. More specifically, and as discussed in the Institution Decision, Petitioner proposed a construction for claim 2’s “means for altering the length of the vertical beam and maintaining the tray at a plurality of selectable distances from the dolly assembly,” which is governed by 35 U.S.C. § 112, ¶ 6. *See Williamson v. Citrix Online, LLC*, 792 F.3d 1339, 1349 (Fed. Cir. 2015) (en banc) (explaining that use of the word “means” in a claim limitation creates a rebuttable presumption that the limitation invokes § 112 ¶ 6). By rule, Petitioner was required to (and did) identify the purported corresponding structure in its Petition. *See* 37 C.F.R. § 42.104(b)(3) (“Where the claim to be construed contains a means-plus-function or step-plus-function limitation . . . the construction of the claim must identify the specific portions of the specification that describe the structure, material, or acts corresponding to each claimed function.”).

To Term. 1. In particular, Patent Owner argues that Riverside Partners LLC (“Riverside”), who indisputably was not identified by Petitioner as a real party-in-interest in this *inter partes* review, in fact, is one. *See generally id.*

There is no specific definition for who constitutes a real party-in-interest. The *Office Patent Trial Practice Guide* (“*Guide*”) states the following:

Whether a party who is not a named participant in a given proceeding nonetheless constitutes a “real party-in-interest” or “privy” to that proceeding is a highly fact-dependent question. Such questions will be handled by the Office on a case-by-case basis taking into consideration how courts have viewed the terms “real party-in-interest” and “privy.” Courts invoke the terms “real party-in-interest” and “privy” to describe relationships and considerations sufficient to justify applying conventional principles of estoppel and preclusion. Accordingly, courts have avoided rigid definitions or recitation of necessary factors. Similarly, multiple Federal Rules invoke the terms without attempting to define them or what factors trigger their application.

77 Fed. Reg. 48,756, 48,759 (Aug. 14, 2012) (internal citations omitted).

Generally, “the ‘real party-in-interest’ [on the petitioner side] is the party that desires review of the patent. Thus, the ‘real party-in-interest’ may be the petitioner itself, and/or it may be the party or parties at whose behest the petition has been filed.” *Id.*

Patent Owner’s Motion primarily focuses on Riverside’s alleged control of, or at least ability to control, Petitioner with respect to this *inter partes* review and the related lawsuit. *See generally* Mot. to Term. 7–11; *see also Guide*, 77 Fed. Reg. at 48,759 (“A common consideration [with respect to real party-in-interest] is whether the non-party exercised or could have exercised control over a party’s participation in a proceeding.”). In support of its Motion, Patent Owner relies on

the following general allegations: (1) Riverside owns a substantial majority of Petitioner, (2) three people “from Riverside” sit on Petitioner’s Board of Directors, including specifically on its six-member Executive Committee, (3) the decision to file the Petition was made by the Executive Committee, (4) Riverside is involved in assessing settlement scenarios for the related lawsuit; (5) and Riverside is integrally involved with the general business operations of Petitioner. Mot. to Term. 7–11.

As Petitioner concedes, Riverside does own a substantial majority—83.5%—of Petitioner. Opp. to Mot. to Term. 8 (citing Ex. 1028 ¶ 17). Owning a percentage of a party (even all of it), however, does not render the owner a real party-in-interest. If it did, every parent corporation of a 100% wholly-owned subsidiary party would be a real party-in-interest, and that is not the law. Patent Owner also points out three people “from Riverside Partners”⁹ sit on Petitioner’s six-person Executive Committee, which is a subset of Petitioner’s Board of Directors. Mot. to Term. 8 (citing Ex. 2019, 93:9–13, 101:6–102:14).¹⁰ But, this is not an additional factor of any significance. Riverside’s 83.5% ownership stake

⁹ Patent Owner refers to these individuals, by title, as follows: “(i) Riverside Partners General Partner Philip Borden; (ii) Riverside Partners Vice President Craig Stern, (iii) Riverside Partners Operating Partner Mike Magliochetti.” Mot. to Term. 8 (citing Ex. 2019, 93:9–13). The cited evidence, however, is not probative of these titles, but rather only that these three individuals are “from Riverside Partners.” See Ex. 2019, 93:9–13.

¹⁰ Exhibit 2019 consists of select excerpts of deposition testimony of Nick Mendez taken in the related lawsuit. Ex. 2019, 1. Mr. Mendez is a former Chief Executive Officer of Petitioner. *Id.* at 103:16–24; Ex. 1028 ¶ 11.

would be expected to provide Riverside control over who is elected to Petitioner's Board of Directors.

Patent Owner has submitted evidence that the Executive Committee (of Petitioner's Board of Directors) made the decision to file the Petition. Mot. to Term. 8–9 (citing Ex. 2019, 100:25–103:15). Patent Owner additionally alleges that “Riverside Partners ‘approved’ filing the Petition for *Inter Partes* Review.” *Id.* at 9 (citing Ex. 2019, 100:25–101:5). The cited testimony of Mr. Mendez, however, is not probative of the allegation. It reads:

Q. . . . And so you didn't make the decision to file the IPR on your own; you took it to the board and said, “This is my recommendation based on advice of counsel,” and the *board approved it* and you went ahead and filed the IPR; is that correct?

A. Correct.

Ex. 2019, 100:25–101:5 (emphasis added). Having reviewed the available surrounding testimony, we understand “the board” in Mr. Mendez's cited testimony to mean the Board of Directors *of Petitioner*, not a board of directors of Riverside.¹¹ *See generally* Ex. 2019; *see also* Mot. to Term. 7 (“Petitioner's Board of Directors includes a six-person Executive Committee”).

¹¹ Additionally, it is questionable whether Mr. Mendez's testimony should be interpreted as agreeing fully with the compound question presented by the examining attorney. Mr. Mendez executed an errata, which amended his answer, for “clarification” purposes, as follows: “Correct. I recommended we follow advice of counsel and no one objected to that recommendation.” Ex. 1030, 2 (underlining denoting testimony added by errata). Thus, as Petitioner argues in its Opposition, Mr. Mendez appears to have affirmed only part of the examining attorney's question, and not the portion about board approval. Opp. to Mot. to Term. 5–6.

Patent Owner alleges that Riverside is involved in assessing settlement scenarios for the related lawsuit. Mot. to Term. 9 (citing Ex. 2018, 75:23–77:14). To support that allegation, it quotes the following testimony taken during the deposition of Bob Brolund:

Q. You've had discussions of that nature, though, with Craig Stern at Riverside Partners, that is, with respect to what the possible scenarios would be for settling versus not settling the case and what the potential damages claims would be; is that correct?

A. Yes.

Ex. 2018, 77:8–14. Mr. Brolund and Craig Stern are “from Riverside Partners,” but they are also on Petitioner’s Executive Committee. Ex. 2019, 93:9–13.¹² Their discussions as members of Petitioner’s Executive Committee are not automatically attributable to Riverside, and Patent Owner has not provided any reason to justify attributing them as such. Moreover, the content of Mr. Brolund’s quoted testimony, which is extremely general, does not demonstrate control *by anyone* of any settlement process.

Patent Owner alleges that “Riverside Partners is integrally involved with the general business operations of Petitioner.” Mot. to Term. 10. However, all but one of the purported examples Patent Owner provides of integral involvement are merely reflections of the fact that certain individuals simultaneously are “from Riverside Partners” and members of Petitioner’s Executive Committee. The sole exception is Patent Owner’s allegation that the related lawsuit is a topic that is reported to Riverside on a regular basis. *Id.* (citing Ex. 2018, 69:12–70:9). This is

¹² Additionally, Mr. Brolund is the current Chief Financial Officer of Petitioner. Opp. to Mot. to Term. 5.

not a factor that supports finding Riverside to be a real party-in-interest. As we mentioned above, Riverside owns 83.5% of Petitioner. Thus, for financial reasons, it behooves Riverside to know what is going on in the lawsuit. Additionally, the fact that Riverside receives “reports” implies that Riverside is passively observing the lawsuit, not controlling it. Ex. 2018, 69:19–22. In any event, the related lawsuit is not the instant proceeding.

Patent Owner argues that the facts here are similar to those of *Galderma S.A. v. Allergan Industrie, SAS*, Case IPR2014-01422, Paper 14 (PTAB Mar. 5, 2015) (“*Galderma*”), but *Galderma*’s facts bear a significant distinction. In *Galderma*, the non-identified party that was held to be a real party-in-interest was a parent corporation (Nestle Skin Health S.A.) that ultimately owned both named petitioners (Galderma S.A. and Q-Med AB). One of the named petitioners (Q-Med AB) manufactured devices that were accused of infringement in a related lawsuit, but another entity, which was also ultimately owned by the non-identified Nestle Skin Health S.A., distributed the accused devices. *Galderma* at 8. Furthermore, the *Galderma* panel found that the business entities involved “do not maintain well-defined corporate boundaries, and are so intertwined that it is difficult to determine where one ends and another begins.” *Id.* at 9 (internal quotation marks omitted). We have not made that finding here, nor is there sufficient evidence to support such a finding.

It is Petitioner alone who stands accused of infringement in the related lawsuit. Riverside has not been named in that lawsuit. Paper 8, 2. Nor has Patent Owner shown that Riverside has a legal, and not merely financial, interest in this *inter partes* review. As noted in the Guide, “the ‘real party-in-interest’ [on the

petitioner side] is the party that desires review of the patent.” *Guide*, 77 Fed. Reg. at 48,759. Under the facts before us, it is Petitioner who, having been sued for infringement of the ’178 patent, desires review of the patent.

We, therefore, deny Patent Owner’s Motion to Dismiss and Terminate this *inter partes* review.

III. ASSERTED GROUNDS OF UNPATENTABILITY

Petitioner asserts that claims 27, 28, 88, and 101 would have been obvious under § 103(a) over Dell, Sweere, and Allan, and claim 108 would have been obvious under § 103(a) over Dell, Sweere, Allan, and Planar. Pet. 33–37, 44–49, 54–59. Under § 103(a), “the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved.” *Graham v. John Deere Co.*, 383 U.S. 1, 17 (1966). Additionally, secondary considerations such as “commercial success, long felt but unsolved needs, failure of others, etc., might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented. As indicia of obviousness or nonobviousness, these inquiries may have relevancy.” *Id.* at 17–18.

1. Dell Disclosure

Dell teaches a wheeled mobile workstation for use in hospital and other health related industries. Ex. 1003, 1:6–11. Figures 1 and 4 of Dell are reproduced below.

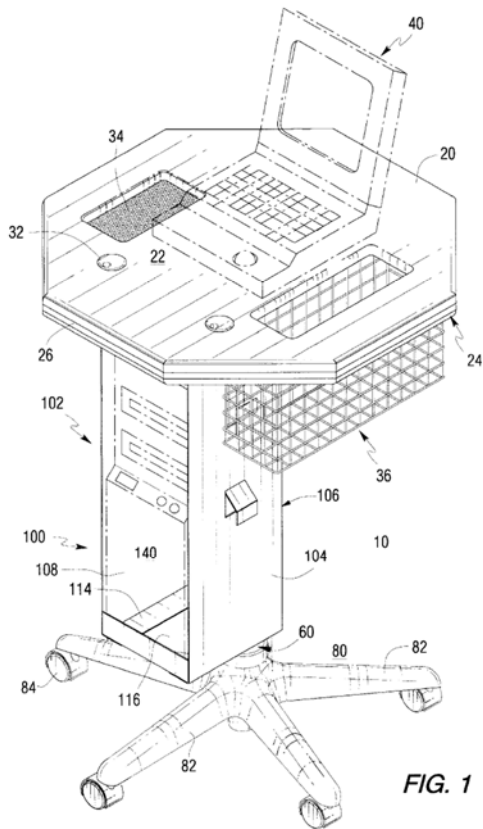


FIG. 1

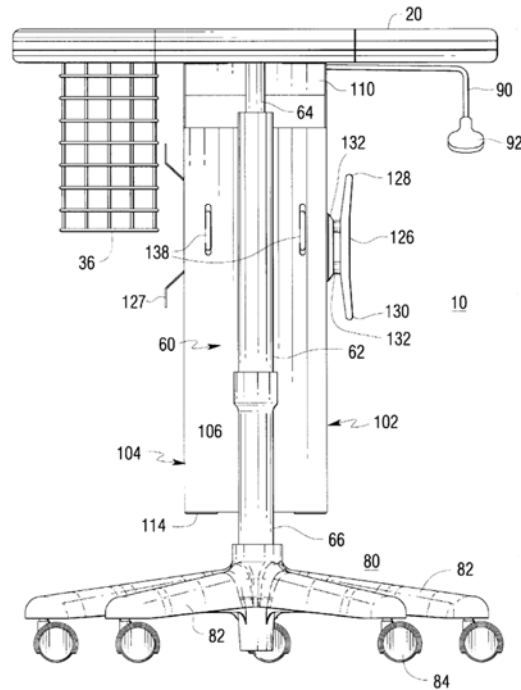


FIG. 4

Figures 1 and 4 show different views of mobile workstation 10. Ex. 1003, 1:63–64, 2:25–27, 1:67. The workstation includes horizontal work surface 20 supported by leg 60 and base 80. *Id.* at 2:28–29. The base includes spokes 82 having casters 84. *Id.* at 2:66–3:2. The leg is adjustable in length vertically as it “includes an upper inner tube 62 which houses a height adjustment mechanism, typically a piston and cylinder 64.” *Id.* at 2:59–60.

Compartment 100 is mounted to a plate (not shown in figures above) that is mounted to the underside of the work surface. *Id.* at 2:37–39, 3:7–12. “[T]he compartment is used to counterbalance the weight of a lap/top computer or other types of equipment that may be carried on the work surface.” *Id.* at 3:48–52. For

example, laptop computer 40 is shown in phantom lines resting on the work surface in Figure 1. *Id.* at 2:43–47, Fig. 1, ref. 40. To act as a counterbalance, the compartment includes ballast 140, which may be in the form of an uninterruptible power supply, and which is shown in phantom in Figure 1. *Id.* at 3:31–36, Fig. 1, ref. 140. The uninterruptible power supply provides backup power to equipment on the work surface (e.g., a laptop). *Id.* at 3:57–60.

2. Sweere Disclosure

Sweere teaches a “multi-jointed, pivoted support arm for support and position of a flat panel display screen.” Ex. 1004, 1:50–52, Figs. 20–23. Sweere also teaches a mobile workstation termed “rolling cart assembly.” *Id.* at 15:3–5, Fig. 29. Figure 29 is reproduced below.

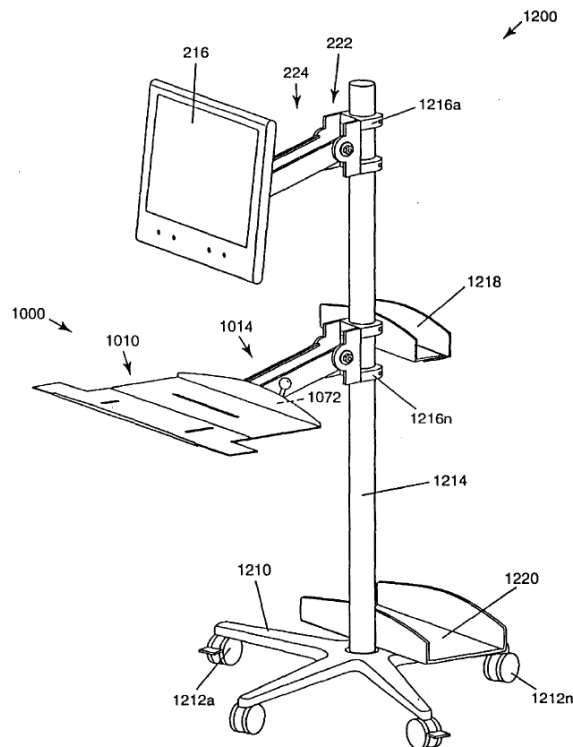


Figure 29 shows the workstation including base 1210 with casters 1212a–n, vertically-oriented mounting pole 1214, display screen 216, central processing unit (CPU) mounting bracket 1218, and UPS¹³ mounting bracket 1220. Ex. 1004, 15:3–15.

3. Allan Disclosure

Allan teaches an adjustable support mechanism for a computer keyboard. Ex. 1008, 1:8–9. Figure 1 of Allan is reproduced below.

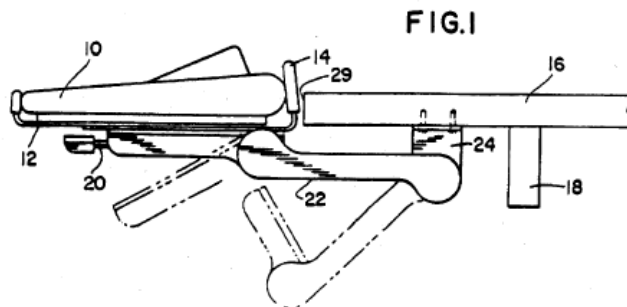


Figure 1 is a side elevation drawing of a keyboard support assembly. Ex. 1008, 3:7–8. As shown in Figure 1, keyboard 10 is mounted on keyboard platform 12, which is supported by spaced support arms 21, 22 with first ends pivotally mounted to opposite sides of keyboard platform 12 and second ends pivotally mounted to mounting bracket 24. *Id.* at 3:43–49. Mounting bracket 24 is attached to the underside of work surface 16. *Id.* at 3:49–50. Keyboard platform 12 is generally horizontal in orientation, but can be tilted about a horizontal axis—

¹³ Sweere does not disclose what UPS means, but Petitioner asserts that it means a power supply (Pet. 10) and provides evidence that UPS is known in the art to mean uninterruptible power supply. Ex. 1005 ¶ 5. Also, Patent Owner has not disputed that Sweere’s UPS mounting bracket is a mounting bracket for a power supply.

illustrated in phantom lines in Figure 1. *Id.* at 3:63–4:5. Figure 3 of Allan is reproduced below.

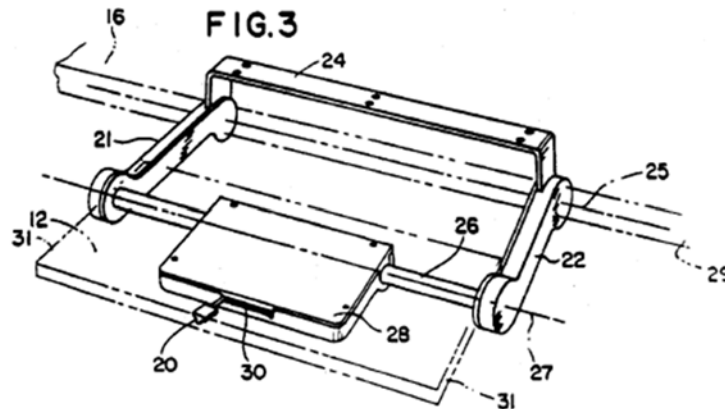


Figure 3 illustrates the location of the tilt adjustment mechanism of the support mechanism. *Id.* at 3:14–17. Keyboard platform 12 (shown in phantom lines) is mounted upon casing 28 with a pivot shaft or rod 26 passing through casing 28 in a manner that permits rotation. *Id.* at 4:19–26. Support arms 21, 22 pivot about first horizontal pivot axis 25 passing through mounting bracket 24. *Id.* at 3:51–52. At the same time, computer keyboard 10 and platform 12 are moved from a work position to a storage position under work surface 16 and keyboard platform 12 pivots about second horizontal pivot axis 27, thereby maintaining the same orientation with respect to work surface 16. *Id.* at 3:52–63.

The tilt feature, shown in Figure 1, in combination with the pivoting motion of support arms 21, 22, shown in Figure 3, allows keyboard 10 “to be efficiently stored under the work surface 16, even if the work surface 16 has an obstruction such as a lateral support 18 [shown in Figure 1].” *Id.* at 4:5–10.

4. Planar Disclosure

Planar is a webpage describing a product called Clean Screen, described as a “space saving, full-featured workstation for medical and industrial use” consisting of a “flat panel display with a built-in and an optional locking, foldaway keyboard.” Ex. 1007, 1.

5. Obviousness Challenge: Claims 27, 28, 88, and 101

Petitioner argues that the combined teachings of Dell, Sweere, and Allan render claims 27, 28, and 88 unpatentable, stating:

[I]t would have been obvious to modify Dell by mounting the display screen and tiltable bracket of Sweere directly to the top of the horizontal work surface in order to provide for comfortable and adjustable viewing of the screen, such that the display is freely movable independent of both a separate keyboard and the work surface. Indeed, Sweere shows, in Figure 29, that its monitor mountings are usable in mobile workstations. . . .

It would have been obvious to modify Dell, as modified by Sweere, by mounting, proximate to the work surface, the input device tray of Allan. This would advantageously increase space on the work surface, especially when the keyboard is not in use, as well as provide for additional adjustability of the keyboard’s position.

It would have been obvious to make a further modification, in view of Sweere (which shows a near-identical five-wheeled base as Dell), to include Sweere’s disclosed UPS mounting bracket in a similar location (and include a UPS power supply therein) so that (i) bracket / compartment 100 of Dell would then be available to store a computing device, (ii) power could be provided to this computing device, and (iii) a power cord could be easily and safely run along the floor to a power outlet for recharging the power supply, and (iv) the power unit would be stored low on the cart, giving the cart a lower center of gravity, increasing its stability (*See* Sweere Fig. 29, and in particular

the relative heights of the CPU mounting bracket 1218 and UPS [power supply] mounting bracket 1220).

It further would have been obvious to use the now available bracket / compartment 100 mounted to the bottom of the horizontal work surface of Dell, modified to be of the appropriate size, to provide a location for supporting a computing device, advantageously keeping the computing device (i) out of the way of the user's hands and feet and (ii) close to the work surface for easy connection to a keyboard, mouse, display, and like computer peripherals. As discussed in the preceding paragraph, it would have been obvious to support the computing device relatively high up on the mobile workstation while supporting the power source relatively low down on the mobile workstation. (*See Sweere* Fig. 29, and in particular the relative heights of the CPU mounting bracket 1218 and UPS [power supply] mounting bracket 1220). Thus, the computing device would be located in the compartment below, and supported by, the horizontal tray.

Pet. 35–36. Petitioner adds that claim 101 would have been obvious over the three references because the “proposed combination would necessarily result in at least ‘a portion of the computing device [being] covered by the work surface.’” *Id.* at 49.

These stated reasons to combine the relied-upon prior art teachings of Dell, Sweere, and Allan, in the manner asserted, are sufficient, and the cited evidence supports the reasoning. *See KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 418 (2007) (requiring “an apparent reason to combine the known elements in the fashion claimed by the patent at issue”). Further, nothing unpredictable results from such a combination. *See id.* at 416 (“The combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.”).

Patent Owner argues that there was no reason in the art, other than impermissible hindsight, to locate a computer terminal in Dell's compartment 100 instead of on the top surface 22 in order to free up workspace. PO Resp. 29–31. Patent Owner further argues that it was the inventors of the '178 patent who “recognized” the need for an unobstructed work surface. *Id.* at 31. We disagree. Dell explicitly teaches that the work surface may omit the computer so that other equipment may be carried on it. Ex. 1003, 2:43–47 (“These openings can include grommets 32 which can be used to route wires or locking equipment in which to lock a lap/top computer (40 shown in phantom) or other equipment that may be carried on top of the work surface.”). Furthermore, each of Dell's seven claims requires a work surface, but none of its claims requires a computer (or any other equipment) on the work surface. *Id.* at 4:32–65. Thus, Dell teaches a top of a work surface that may be free of a computer. Further, Sweere teaches placing a computer separate from its display screen and out of the way. Ex. 1004, Fig. 29, 15:3–24. Petitioner's obviousness rationale does not rely on hindsight.

Patent Owner presents several additional arguments in opposition to Petitioner's challenge to the patentability of claims 27, 28, 88, and 101. First, Patent Owner argues that locating a computer below a work surface,¹⁴ as required by claims 27, 28, 88, and 101, “is not disclosed by any of the cited references.”

¹⁴ Specifically, Patent Owner refers to claim 27's recitation of “a computing device positioned below the work surface,” which claims 28 and 88 inherit through dependence, and claim 28's recitation of a tray that is “adapted to support a computing device so that at least a portion of the computing device is covered by the work surface,” which claim 101 inherits through dependence. PO Resp. 12 n.2.

PO Resp. 12–13. During the hearing, counsel for Patent Owner argued the same point, stating:

KSR analysis requires that you go one by one and find – at least start with finding each one of the elements in the prior art references, and then you take a look and see why you would combine them in a way that’s being proposed. But here you don’t even get past Step 1 because you can’t find *the computer underneath the right work surface which is clearly an element of all the claims that were at issue.*

Tr. 25:24–26:7 (emphasis added).

This is not an accurate view of the law—at least not in the context of how Patent Owner uses the term “element.” In that regard, Patent Owner asserts that the supposedly missing element is locating a computer below a work surface. But, this “element” is itself composed of elements, each of which exist in the prior art. In particular, Dell teaches mounting a power supply to the bottom to the horizontal work surface (Ex. 1003, 2:37–39, 3:7–12), and Sweere teaches mounting a wireless computer terminal, albeit at a different location than the bottom of a horizontal work surface (Ex. 1004, 15:3–15).

Patent Owner’s argument is a classic example of attacking prior art references individually. But, in determining obviousness, a reference “must be read, not in isolation, but for what it fairly teaches in combination with the prior art as a whole.” *In re Merck & Co.*, 800 F.2d 1091, 1097 (Fed. Cir. 1986) (“Non-obviousness cannot be established by attacking references individually where the rejection is based upon the teachings of a combination of references.”) (citing *In re Keller*, 642 F.2d 413, 425 (CCPA 1981)). Dell and Sweere, which are both directed to mobile workstations, fairly teach in combination locating a computer below a work surface.

Patent Owner also argues “Petitioner’s proposed repositioning of Dell’s power supply 140 would change the principle of operation of Dell’s cart and render Dell’s power supply 140 incapable of performing one of its primary stated functions.” PO Resp. 20. In particular, Patent Owner argues that “taking Dell’s power supply 140 out of compartment 100 and mounting it to the base 80 via Sweere’s bracket 1220 would destroy the ability of Dell’s power supply 140 to ‘counterbalance[] the weight carried by the work surface and assist[] in distributing the weight . . .’” *Id.* at 17 (quoting Ex. 1003, 3:52–57). This argument is another attack on the Dell reference individually, whereas Petitioner’s asserted ground of unpatentability is based on the combined teachings of Dell and Sweere, in which the counterbalancing function is preserved, albeit with a computer ballast in lieu of a power supply ballast. Dell itself suggests that the ballast does not need to be in the form of a power supply. *See* Ex. 1003, 3:31–33 (“Finally, the counterbalance means may also include a ballast 140 which *may* be in the form of an uninterruptable power supply.”); *also compare* Ex. 1003, 4:40–49 (independent claim 1 reciting “a ballast” generally), *with id.* at 4:52–55 (dependent claim 3 reciting “[t]he mobile workstation according to claim 1 wherein said ballast includes a power supply”).

Secondly, Patent Owner argues that Petitioner’s proposed modification “fundamentally transform[s] the Dell cart from a general purpose cart to a dedicated mobile *computer* cart.” PO Resp. 22. But, Patent Owner has not shown—as its argument implies—that a general purpose cart and a computer cart are mutually exclusive. Patent Owner asserts that “[t]he modified Dell cart would *only* be useful as a dedicated computer cart,” but does not cite persuasive evidence

in support of that assertion. *Id.* at 23 (citing Ex. 2003 ¶¶ 45, 49) (emphasis added). The most relevant aspect of the cited testimony—which is from Arthur G. Erdman, Ph.D.—is that modifying the Dell cart as Petitioner proposes would “*reduc[e]* its ability to effectively meet its objective as a general purpose workstation that can support various types of equipment.” Ex. 2003 ¶ 45 (emphasis added). Dr. Erdman did not testify that the modification would eliminate that ability. In fact, common sense indicates nothing would prevent the modified Dell cart from carrying “other types of equipment . . . on the work surface.” Ex. 1003, 3:51–52. In any event, a person of ordinary skill in the art would not be led merely by what Dell sought to provide, and Sweere specifically teaches providing a mobile computer cart. Ex. 1004, 15:13–15.

Patent Owner also argues that objective evidence of secondary considerations demonstrates non-obviousness of the claimed subject matter. PO Resp. 33. In that regard, Patent Owner first argues that the ’178 patent has been licensed by all of its “primary competitors” save Petitioner. *Id.* at 34–35 (citing Exs. 2005–2007). The cited licenses, however, cover numerous patents, and Patent Owner does not show a nexus with the inventions embodied in the claims challenged here. *See* Exs. 2005–2007. Thus, whatever commercial success may be demonstrated by the licenses, it has not been demonstrated to be the result of the claimed inventions of the ’178 patent. *See In re GPAC Inc.*, 57 F.3d 1573, 1580 (Fed. Cir. 1995). For example, the consideration Patent Owner received from the licensees may have been driven by a patent or patents other than the ’178 patent.

In an attempt to establish a nexus between those licenses, as well as Patent Owner's sales of its own POC carts, on the one hand and the challenged claims of the '178 patent on the other hand, Patent Owner states the following:

Further still, a nexus exists between the '178 Patent and relevant Enovate products. Ron Sgro and Fred Calero, founders of Enovate IT, a predecessor to Petitioner, and current Board Members of Petitioner, have cumulatively testified in the co-pending federal court litigation that it is important that a computer cart (i) be mobile, (ii) be height adjustable, (iii) have a work surface, (iv) have the computer, keyboard and display mounted/supported off of the work surface, and (v) include a power unit in order to compete in the marketplace for computer workstations used in medical settings. EX 2009, pp. 110–23; EX 2010, pp. 83–87. Therefore, the challenged claims directly correspond to features that are admittedly important to the commercial success of Petitioner, Patent Owner and Patent Owner's licensees with respect to medical computer workstations. Accordingly, there is also a direct nexus between the challenged claims and the desire of the licensees to license the '178 patent.

PO Resp. 39.

Dell teaches four of the five aspects that Patent Owner points out are commercially important (i.e., (i), (ii), (iii), and (v)). To establish nexus, however, the commercial success must derive from features of the claims not readily available in the prior art. *See J.T. Eaton & Co. v. Atl. Paste & Glue Co.*, 106 F.3d 1563, 1571 (Fed. Cir. 1997) (“[Plaintiff] cannot demonstrate commercial success, for purposes of countering the challenge of obviousness, unless it can show that the commercial success of the product results from the claimed invention.

Furthermore, the asserted commercial success of the product must be due to the merits of the claimed invention beyond what was readily available in the prior art.”). For this reason, Patent Owner's evidence of commercial success is given

little weight and does not demonstrate non-obviousness of the claimed subject matter.

In conclusion, after weighing Petitioner's strong evidence of obviousness and Patent Owner's purported evidence of secondary consideration, on balance, we conclude that Petitioner has shown by a preponderance of the evidence that claims 27, 28, 88, and 101 would have been obvious over Dell, Sweere, and Allan.

6. Obviousness Challenge: Claim 108

Petitioner asserts that claim 108 would have been obvious over a combination of Dell, Sweere, Allan, and Planar. Pet. 54–59. Petitioner relies on Dell, Sweere, and Allan for the limitations of claim 108 that are substantially similar to those of claim 101. *Id.* In addition, Petitioner relies on Planar and Sweere for teaching “a power unit supported by the chassis for powering the computing device” and Planar, exclusively, for “said power unit is disposed directly underneath said vertical beam.” *Id.* at 56–57. Specifically, Petitioner asserts “Planar discloses, particularly in the beige object near the wheels of the cart comprising a housing and ‘two hotswappable battery packs,’ a power unit supported by the chassis, directly underneath a vertical beam.” *Id.* at 57. Also, the Petition articulates sufficient reasoning to combine Dell, Sweere, Allan, and Planar. In addition to the rationale discussed above explaining the combination of Dell, Sweere, and Allan, Petitioner states:

It would have been obvious to make a further modification, in view of Planar, to add the power unit of Planar (comprising a housing and “two hot-swappable battery packs”) to the base 80 of Dell, so that (i) bracket / compartment 100 of Dell would then be available to store a computing device, (ii) power could be provided to this computing

device, (iii) the power unit would be out of the way of the body of the user, and (iv) the weight of the power unit would be distributed low on the cart, increasing the stability and movability of the cart (See *Sweere* Fig. 29, and in particular the relative heights of the CPU mounting bracket 1218 and UPS [power supply] mounting bracket 1220). This proposed modification meets the elements of “a power unit supported by the chassis for powering the computing device” and “said power unit is disposed directly underneath said vertical beam” (as disclosed in *Planar*).

Pet. 58.

Patent Owner argues, for the same reasons discussed above in connection to claim 101, that (1) Dell does not disclose locating a computer below a work surface¹⁵ (PO Resp. 32), and (2) it would not have been obvious to “fundamentally and extensively transform Dell’s cart in view of the Sweere reference in the manner suggested by Petitioner” (*id.* at 33). For the reasons discussed above, we are not persuaded by these arguments.

In addition, Patent Owner argues that Planar does not disclose “said power unit is disposed directly underneath said vertical beam.” *Id.* at 32. According to Patent Owner, instead of showing the hot-swappable battery packs as being “directly underneath a vertical beam,” Planar show the packs “as being mounted on the periphery base of the cart and outside of the vertical beam.” *Id.* at 32–33 (citing Ex. 1007, Ex. 2003 ¶ 38). The relevant photograph from Planar is reproduced below.

¹⁵ Claim 108 recites the same language as claim 101—namely, “the tray is adapted to support a computing devices so that at least a portion of the computing device is covered by the work surface.”



The photograph from Planar above shows a mounting option for the Clean Screen Workstation that “includes two hot-swappable battery packs.” Ex. 1007, 2.

According to Patent Owner’s expert Dr. Erdman, “the structure in Planar that Petitioner identifies as a power unit with battery packs is supported across about one-half of the wheeled base of a pole mounting system and each of the battery packs are located toward an outer edge of the base, where the handles are illustrated in the planar picture extending above and out of the base.” Ex. 2003 ¶ 38. Dr. Erdman, thus, concludes that a person of ordinary skill “would have understood that the power unit of Planar was offset from the pole and not disposed ‘directly underneath a vertical beam.’” *Id.* We do not agree that a person of ordinary skill would understand Planar’s disclosure to be so narrow. Patent Owner does not dispute that the entire beige object including both battery packs and the housing would be considered a “power unit” and that at least a portion of the “power unit” is shown directly under the vertical beam in the photo. Given that interpretation, it seems clear that a person of ordinary skill in the art would recognize that Planar fairly teaches the power unit sitting below the vertical beam.

We do not find credible Patent Owner's argument and Dr. Erdman's testimony to the contrary.

Finally, Patent Owner argues that objective evidence of secondary considerations confirms that claim 108 would not have been obvious. PO Resp. 33–39. For essentially the same reasons discussed above in connection with claims 27, 28, 88, and 101, Patent Owner's evidence of commercial success is given little weight and does not demonstrate non-obviousness of the claimed subject matter. In conclusion, after weighing Petitioner's strong evidence of obviousness and Patent Owner's purported evidence of secondary considerations, on balance, we conclude that Petitioner has shown by a preponderance of the evidence that claim 108 would have been obvious over Dell, Sweere, Allan, and Planar.

IV. MOTIONS TO EXCLUDE

Petitioner filed a Motion to Exclude Exhibits 2003–2006. Paper 33. Each of Exhibits 2003–2005 is a license agreement, and Exhibit 2006 is a Declaration by Robert A. Sobie. All of this evidence was submitted by Patent Owner as objective evidence of secondary considerations. Because we do not rely on any of that evidence in a manner adverse to Petitioner, we dismiss the Motion as moot.

Patent Owner filed a Motion to Exclude Exhibit 1007, which is a declaration by T.E. Schlesinger, Ph.D., which Petitioner filed with its Reply. Paper 35. Because we do not rely on Exhibit 1007 in any manner, we dismiss the Motion as moot.

V. EXHIBIT 2023

Exhibit 2023 is a license agreement between Patent Owner and another entity. It was filed without our authorization because it was filed with Patent Owner's Opposition to Petitioner's Motion to Exclude despite that Exhibit 2023¹⁶ is not responsive to the Motion to Exclude. Paper 42 ("Opp. to Pet. Mot. to Excl."). In fact, Patent Owner's Opposition requests that we enter into the record "new Exhibit 2023, which was finalized subsequent to Patent Owner's Response." Opp. to Pet. Mot. to Excl. 1. A request for relief should not be made in an opposition brief. It should be made in a motion. 37 C.F.R. § 42.20(a) ("Relief, other than a petition requesting the institution of a trial, must be requested in the form of a motion."). Further, a motion (and, thus, a request for relief) may be filed only if authorization has been obtained. 37 C.F.R. § 42.20(b) ("A motion will not be entered without Board authorization. Authorization may be provided in an order of general applicability or during the proceeding."). Consequently, Exhibit 2023 shall be expunged because it was filed without our authorization. *See* 37 C.F.R. § 42.7.

VI. ORDER

For the foregoing reasons,

Accordingly, it is

ORDERED that Patent Owner's Motion to Dismiss and Terminate is *denied*;

¹⁶ Patent Owner filed two versions of Exhibit 2023—a public version and a sealed version.

IPR2015-00300
Patent 6,721,178 B1

FURTHER ORDERED that claims 27, 28, 88, 101, and 108 of U.S. Patent No. 6,721,178 B1 are *unpatentable*;

FURTHER ORDERED that each party's Motion to Exclude is *dismissed as moot*;

FURTHER ORDERED that both versions (public and sealed) of Exhibit 2023 be *expunged*; and

FURTHER ORDERED that, because this Decision is final, a party to the proceeding seeking judicial review of the Decision must comply with the notice and service requirements of 37 C.F.R. § 90.2.

IPR2015-00300
Patent 6,721,178 B1

PETITIONER:

Norman H. Zivin
nzivin@cooperdunham.com

Richard S. Order
rorder@uks.com

PATENT OWNER:

Glenn E. Forbis
gforbis@hdp.com

David P. Utykanski
davidu@hdp.com

George D. Moustakas
gdmoustakas@hdp.com