

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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ENOVATE MEDICAL, LLC,  
Petitioner,

v.

INTERMETRO INDUSTRIES CORPORATION,  
Patent Owner.

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Case IPR2015-00301  
Patent 6,493,220 B1

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

FITZPATRICK, *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 1 and 2 of U.S. Patent No. 6,493,220 B1 (“the ’220 patent,” Ex. 1001). 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, instituting trial on one of Petitioner’s two asserted grounds, namely, whether claims 1 and 2 are unpatentable as obvious over Dell<sup>1</sup> and Sweere.<sup>2</sup> Paper 11.

During the trial, Patent Owner filed a Response under seal (Paper 14, “PO Resp.”),<sup>3</sup> and Petitioner filed a Reply. Paper 20 (“Reply”). Additionally, both parties filed Motions to Exclude evidence. Paper 28 (“Pet. Mot. to Excl.”<sup>4</sup>); Paper 30 (“PO Mot. Excl.”). Finally, Patent Owner filed a Motion to Dismiss and Terminate (Paper 32, “Mot. to Term.”), against which Petitioner filed an Opposition (Paper 35, “Opp. to Mot. to Term.”), and in support of which Patent Owner filed a Reply (Paper 45).

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

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

<sup>3</sup> Patent Owner’s Response, with information relating to sales of its point-of-care (or POC) carts redacted, is publicly available as Paper 15.

<sup>4</sup> The evidence Petitioner seeks to exclude—Exhibits 2003–2006—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 27.

A consolidated hearing for oral arguments in this *inter partes* review and Case IPR2015-00300 was held January 13, 2016. A transcript of the hearing appears in the record. Paper 47 (“Tr.”).

We hold claims 1 and 2 unpatentable.

*A. Related Matters*

Patent Owner has asserted the ’220 patent along with additional patents, including related U.S. Patent No. 6,721,178 B1 (“the ’178 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 7, 2. Claims of the related ’178 patent are being challenged by Petitioner in Case IPR2015-00300.

*B. The ’220 Patent*

The ’220 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, 1:7–12. The mobile workstation can be pushed from room to room, for example, by a medical practitioner during patient rounds at a hospital. *Id.* at 2:63–65.

Figure 4b of the patent is reproduced below.

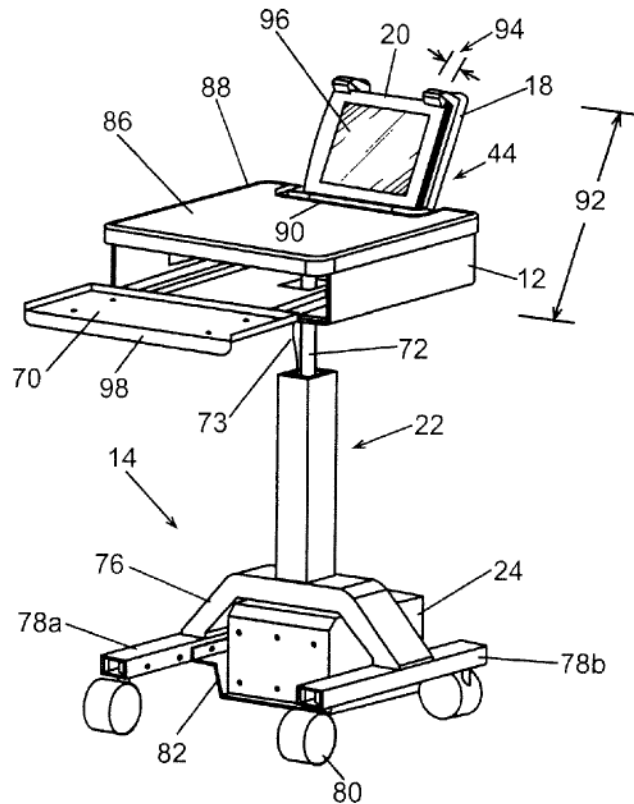


Figure 4b shows a perspective view of the mobile workstation. The workstation includes adjustable-height horizontal tray 12 supported by chassis 14. Ex. 1001, 8:53–55. The horizontal tray includes upper surface 86 that provides a work surface. *Id.* at 12:9–12. Horizontal tray 12 supports docking station 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 1:10–11 (“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, 12:59–61. The horizontal beams include casters (wheels) 80. 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. The Challenged Claims*

Claims 1 and 2 are reproduced below.

1. A mobile workstation, comprising:
  - a wheeled chassis;
  - a tray supported by the chassis and having a lower surface and an upper surface defining a substantially horizontal work surface;
  - a bracket mounted to the bottom of the horizontal work surface to support a wireless computer terminal;
  - a display screen mounted substantially perpendicular to and above the top of the horizontal work surface, wherein the display screen mounts to a tiltable bracket connecting the display screen to the tray and for rotating the display screen relative to the tray; and
  - a power unit for the wireless computer terminal and supported by the chassis.

2. The mobile workstation of claim 1, wherein the chassis further comprises:

a dolly assembly;

a vertical beam having a first end connected to the dolly assembly and a second end connected to the tray; and

means for altering the length of the vertical beam and maintaining the tray at a plurality of selectable distances from the dolly assembly.

#### *D. 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. 4–5 (offering only one proposed

construction, which was not material to the patentability challenge);<sup>5</sup> PO Resp. 9 (“Patent Owner agrees that the claim terms involved in the Ground 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 Petition, as required by 35 U.S.C. § 312(a)(2) and 37 C.F.R. § 42.8(b)(1).” Mot. 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

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<sup>5</sup> 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.”).

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. 1017 ¶ 17). Owning a percentage of a party (or 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”<sup>6</sup> sit on Petitioner’s six-person Executive Committee, which is a subset of Petitioner’s Board of Directors. Mot. to Term. 8 (citing Ex. 2017, 93:9–13, 101:6–102:14).<sup>7</sup> But, this is not an additional factor of any significance. Riverside’s 83.5% ownership stake 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. 2017, 100:25–103:15). Patent Owner additionally alleges that “Riverside Partners ‘approved’ filing the Petition for *Inter Partes* Review.” *Id.* at 9 (citing Ex. 2017, 100:25–101:5). The cited testimony of Mr. Mendez, however, is not probative of the allegation. It reads:

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<sup>6</sup> 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. 2017, 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. 2017, 93:9–13.

<sup>7</sup> Exhibit 2017 consists of select excerpts of deposition testimony of Nick Mendez taken in the related lawsuit. Ex. 2017, 1. Mr. Mendez is a former Chief Executive Officer (CEO) of Petitioner. *Id.* at 103:16–24; Ex. 1017 ¶ 11.

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. 2017, 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.<sup>8</sup> *See generally* Ex. 2017; *see also* Mot. to Term. 7 ("Petitioner's Board of Directors includes a six-person Executive Committee").

Patent Owner alleges that Riverside is involved in assessing settlement scenarios for the related lawsuit. Mot. to Term. 9 (citing Ex. 2016, 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.

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<sup>8</sup> 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. 1019, 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.

Ex. 2016, 77:8–14. Mr. Brolund and Craig Stern are “from Riverside Partners,” but they are also on Petitioner’s Executive Committee. Ex. 2017, 93:9–13.<sup>9</sup> 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. 2016, 69:12–70:9). This is 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. 2016, 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*, IPR2014-01422, Paper 14 (PTAB March 5, 2015)

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<sup>9</sup> Additionally, Mr. Brolund is the current Chief Financial Officer (CFO) of Petitioner. Opp. to Mot. to Term. 5.

(“*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 7, 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 ’220 patent, desires review of the patent.

Patent Owner’s Motion to Dismiss and Terminate is denied.

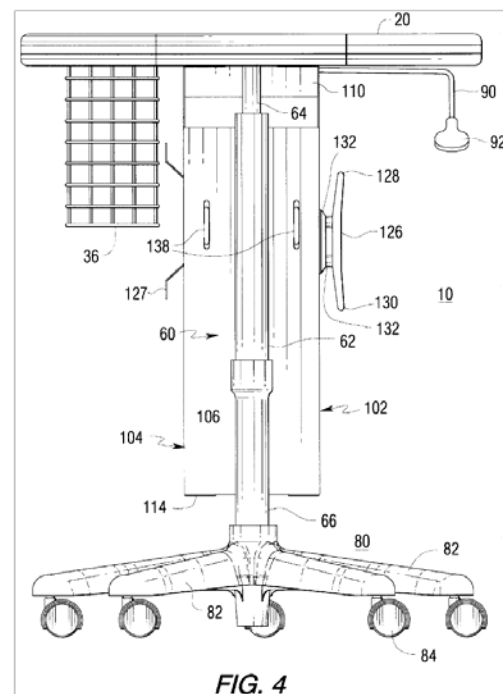
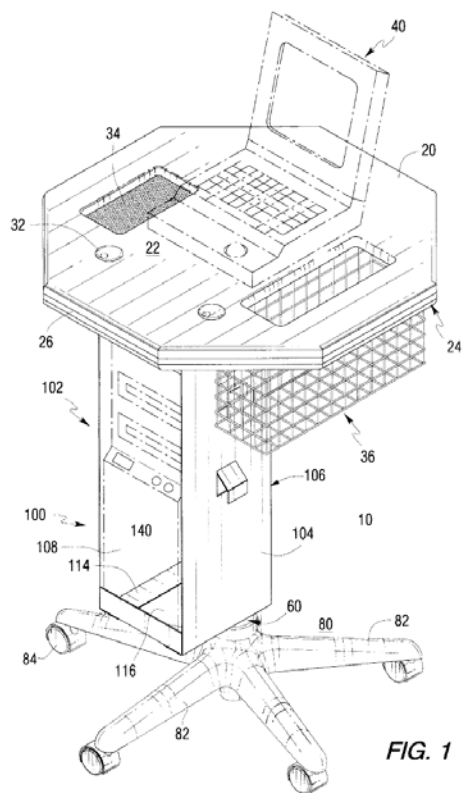
### III. ASSERTED GROUND OF UNPATENTABILITY

Petitioner asserts that claims 1 and 2 would have been obvious under § 103(a) over Dell and Sweere. Pet. 16–20. Under that statute, “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.



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.

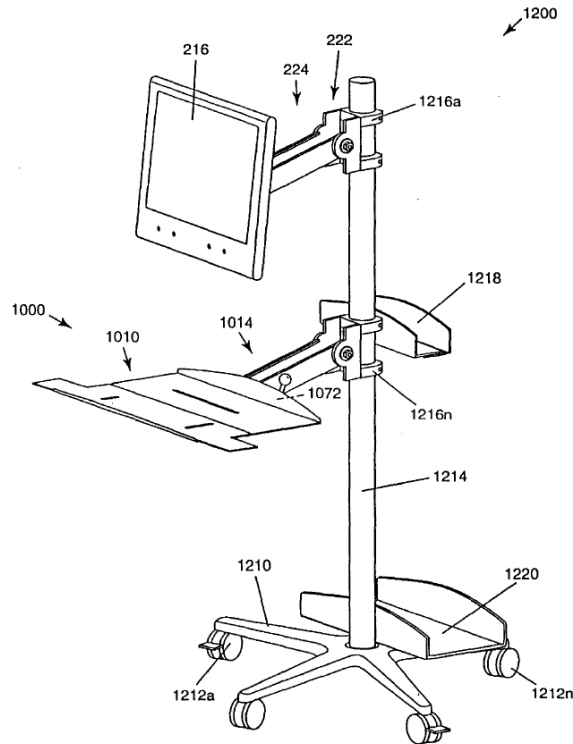


Figure 29 shows the workstation including base 1210 with casters 1212a–n, vertically-oriented mounting pole 1214, display screen 216, central processing unit (CPU) mounting bracket 1218, and UPS<sup>10</sup> mounting bracket 1220. Ex. 1004, 15:3–15.

### 3. Obviousness Challenge

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

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<sup>10</sup> Sweere does not disclose what UPS means, but Petitioner asserts that it means a power supply (Pet. 8, 15) 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.

It 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 free up work surface space and 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 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 unit therein) so that (i) bracket / compartment 100 of Dell would then be available to store a wireless computer terminal, (ii) power could be provided to this wireless computer terminal, and (iii) a power cord could be easily and safely run along the floor to a power outlet for recharging the power unit. (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 wireless computer terminal, advantageously keeping the wireless computer terminal (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. 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).

Pet. 18–19.

These stated reasons to combine the relied-upon prior art teachings of Dell and Sweere, and in the manner asserted, are sufficient. 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 work space. PO Resp. 27–28. Patent Owner further argues that it was the inventors of the ’220 patent who “recognized” the need for an unobstructed work surface. *Id.* at 28. 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. *See* Ex. 1004, Fig. 29 (illustrating CPU mounting bracket 1218 separate from display screen 216). 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 1 and 2. First, in its Response, Patent Owner argues that “a bracket mounted to the bottom of the horizontal work surface to support a wireless computer terminal,” as recited by claim 1 (and

incorporated into claim 2) “is not disclosed by any of the cited references.”

PO Resp. 10–11. 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 “a bracket mounted to the bottom of the horizontal work surface to support a wireless computer terminal,” which is recited in claim 1. But, this “element” is itself composed of elements, each of which exist in the prior art. In particular, Dell teaches a bracket mounted to the bottom of the horizontal work surface, albeit to support a power supply, not a wireless computer terminal (Ex. 1003, 2:37–39, 3:7–12), and Sweere teaches a bracket to support a wireless computer terminal, albeit not one that is mounted to 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 “a bracket mounted to the bottom of the horizontal work surface to support a wireless computer terminal,” as recited in claim 1.

Patent Owner also argues “Petitioner’s proposed modification of Dell in view of Sweere would change the principle of operation of Dell’s cart and render Dell inoperable for its intended purposes.” PO Resp. 14. 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 15 (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.”) (emphasis added); *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. 20. 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. PO Resp. 21 (citing Ex. 2001 ¶¶ 41, 45) (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. 2001 ¶ 41 (emphasis added). Thus, 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. 30. In that regard, Patent Owner first argues that the ’220 patent has been licensed by all of its “primary competitors” save Petitioner. *Id.* (citing Exs. 2003–2005). The cited licenses, however, cover numerous patents, and Patent Owner does not show a nexus with the inventions embodied in the challenged claims here. *See* Exs. 2003–2005. Thus, whatever commercial success may be demonstrated by the licenses, it has not been demonstrated to be the result of claims 1 and 2 of the ’220 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 '220 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 claims 1 and 2 of the '220 patent on the other hand, Patent Owner states the following:

Further still, a nexus exists between the '220 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 2007, pp. 110–23; EX 2008, 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 '220 patent.

PO Resp. 34.

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 considerations, on balance, we conclude that Petitioner has shown by a preponderance of the evidence that claims 1 and 2 would have been obvious over Dell and Sweere.

#### IV. MOTIONS TO EXCLUDE

Petitioner filed a Motion to Exclude Exhibits 2003–2006. Paper 28. 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 30. Because we do not rely on Exhibit 1007 in any manner, we dismiss the Motion as moot.

#### V. EXHIBIT 2021

Exhibit 2021 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 2021<sup>11</sup> is not responsive to the Motion to Exclude. Paper 37 ("Opp. to Pet. Mot. to Excl."). In fact, Patent Owner's Opposition requests that we enter into the record "new Exhibit 2021, 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 2021 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;  
FURTHER ORDERED that claims 1 and 2 of U.S. Patent No. 6,493,220 B1 are unpatentable;

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

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<sup>11</sup> Patent Owner filed two versions of Exhibit 2021—a public version and a sealed version.

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FURTHER ORDERED that both versions (public and sealed) of Exhibit 2021 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.



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Petitioner:

Norman H. Zivin  
nzivin@cooperdunham.com  
Richard S. Order  
rorder@uks.com

Patent Owner:

Glen E. Forbis  
gforbis@hdp.com  
David P. Utykanski  
davidu@hdp.com  
George D. Moustakas  
gdmoustakas@hdp.com