

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

AMERICAN WELL CORPORATION,
Petitioner,

v.

TELADOC HEALTH, INC.,
Patent Owner.

IPR2021-00749
Patent 10,471,588 B2

Before LYNNE H. BROWNE, KARA L. SZPONDOWSKI, and
STEVEN M. AMUNDSON, *Administrative Patent Judges*.

BROWNE, *Administrative Patent Judge*.

ORDER

Granting Petitioner's Motion to Submit Supplemental Information
37 C.F.R. § 42.123(a)

I. INTRODUCTION

We authorized Petitioner American Well Corporation (“Petitioner”) to file a Motion to Submit Supplemental Information (Paper 13, “Motion”), Patent Owner TelaDoc Health, Inc. (“Patent Owner”) to file an Opposition (Paper 14, “Opp.”), and Petitioner to file a Reply (Paper 16, “Reply”). Petitioner seeks authorization to submit the Supplemental Declaration of Dr. Gregory S. Fischer as Exhibit 1021. Motion 1. Upon consideration of the documents and the parties’ arguments, and for the reasons stated below, the Motion is *granted*.

II. BACKGROUND

We instituted trial of all claims and on all grounds on September 29, 2021. Paper 9 (“Inst. Dec.”). However, in order to provide the parties with insight into the Board’s analysis of all grounds, we determined that the Petition, supported by the preliminary record, had failed to persuade us of a reasonable likelihood of prevailing with respect to some of the asserted claims and grounds. In particular, we found that the Petition had not sufficiently shown, for purposes of institution, that the combination of Wang421 and Clements teaches claim 4. Inst. Dec. 54–58. Along with its Petition, Petitioner submitted the Declaration of Dr. Gregory S. Fischer (“Fischer Declaration”). Ex. 1003.

Petitioner now seeks to submit the Supplemental Declaration of Dr. Gregory S. Fischer (Exhibit 1021) (“Supplemental Fischer Declaration”), which Petitioner contends “would resolve confusion stemming from an inadvertent reference to claim 11 of the ’588 Patent in the Petition and in Dr. Fischer’s original declaration.” Motion 1 (footnote omitted). Petitioner contends that “[t]he Board specifically cited to this confusion as the basis for

why Petitioner had not demonstrated a reasonable likelihood that claim 4 is unpatentable,” and the proposed supplemental information is therefore relevant to that claim. *Id.* at 5. Petitioner further contends that submission of the Supplemental Fischer Declaration will neither prejudice Patent Owner nor delay the proceedings. *Id.* at 5–7.

Patent Owner responds that Petitioner “attempts to change, not supplement, its arguments and evidence in order to correct the identified deficiency in the Petition that Petitioner could and should have addressed at the time the Petition was filed.” Opp. 1. Patent Owner argues that “[a]llowing Petitioner to change its arguments and evidence in this manner would not only violate the statutory particularity requirement of § 312(a)(3), but would also prejudice Patent Owner.” *Id.*

III. ANALYSIS

Petitioner bears the burden of proof to establish that it is entitled to the requested relief. 37 C.F.R. § 42.20. The requirements for submission of supplemental information under 37 C.F.R. § 42.123(a) are as follows:

(a) *Motion to submit supplemental information.* Once a trial has been instituted, a party may file a motion to submit supplemental information in accordance with the following requirements:

- (1) A request for the authorization to file a motion to submit supplemental information is made within one month of the date the trial is instituted.
- (2) The supplemental information must be relevant to a claim for which the trial has been instituted.

With respect to the first prong, Petitioner requested authorization to file a motion to submit supplemental information on October 21, 2021,

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which is less than one month after the date we entered our Institution Decision. *See* Mot. 8; Ex. 1022. Patent Owner does not dispute that the request for authorization was made within the one-month time period. *See generally* Opp. Thus, Petitioner’s request was timely under 37 C.F.R. § 42.123(a)(1).

As to the second prong, Petitioner contends the Supplemental Fischer Declaration “is relevant to the invalidity of claim 4 because it resolves confusion regarding Dr. Fischer’s reference to missing claim 11¹ of the ’588 Patent.” Motion 5.

The Board has allowed the submission of supplemental information where the information did not change the grounds of patentability authorized in the proceeding, and did not change the evidence initially presented in the petition in support of those grounds. *See, e.g., DraftKings Inc., v. Interactive Games LLC*, IPR2020-01110, Paper 16 at 9 (PTAB Mar. 11, 2021) (granting entry of supplemental information that “simply correct[ed] typographical or clerical errors in the [original declaration], without adding any substantive information to what was intended to be included in the declaration, as reflected in the declaration itself”); *Group III Int’l, Inc. v. Targus Int’l, LLC*, IPR2021-00371, Paper 33 at 6 (PTAB Sept. 17, 2021) (granting entry of supplemental information where “the supplemental information . . . does not change the grounds of unpatentability authorized in this proceeding, nor does it change the evidence initially presented in the Petition to support those grounds of unpatentability”); *MED-EL*

¹ We note that the Petition and the Fischer Declaration refer to two claims that do not exist in the ’588 patent, namely claims 11 and 12. Pet. 53; Ex. 1003 ¶ 120.

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Elektromedizinische Geräte Ges.m.b.H. v. Advanced Bionics AG, IPR2020-00190, Paper 24 at 5 (PTAB Aug. 10, 2020) (granting motion to submit supplemental information where petitioner was “merely attempting to clarify arguments made in the Petition, not change its theories of unpatentability”); *Pac. Mktg Int’l, LLC v. Ignite USA, LLC*, IPR2014-00561, Paper 23 at 4 (PTAB Dec. 2, 2014) (granting entry of supplemental testimony that “does not operate to change any grounds of unpatentability . . . nor does it change the type of evidence initially presented in the Petition to support those grounds of unpatentability”); *Palo Alto Networks, Inc. v. Juniper Networks, Inc.*, IPR2013-00369, Paper 37 at 5 (PTAB Feb. 5, 2014) (granting entry of supplemental information confirming the public accessibility of the prior art, and where it did not change the grounds of unpatentability authorized in the proceeding or change the evidence initially presented in the petition to support the grounds of unpatentability).

In contrast, the Board has denied such motions where the petitioner sought to use the supplemental information to refine or bolster challenges originally presented in the petition, based on information in the preliminary response or institution decision. *See, e.g., Ooma, Inc. v. Deep Green Wireless LLC*, IPR2017-01541, Paper 14 at 3–4 (PTAB Jan. 23, 2018) (denying entry of supplemental testimony regarding the level of ordinary skill in the art; “Supplemental information is not intended to provide a petitioner an advantageous ‘wait-and-see’ opportunity to use a patent owner’s preliminary response and our decision on institution in order to refine or bolster petitioner’s position”); *Merck Sharp & Dohme Corp. v. Microspherix LLC*, IPR2018-00393, Paper 21 at 3 (PTAB Sept. 10, 2018) (denying motion to submit supplemental information where petitioner

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