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Paper 9
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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

INTROMEDIC CO., LTD.,
Petitioner,

v.

GIVEN IMAGING LTD.,
Patent Owner.

Case IPR2015-00579
Patent 7,009,634 B2

Before JUSTIN T. ARBES, PATRICK R. SCANLON, and MICHELLE N. WORMMEESTER, *Administrative Patent Judges.*

ARBES, *Administrative Patent Judge.*

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

Petitioner IntroMedic Co., Ltd. filed a Petition (Paper 2, "Pet.") to institute an *inter partes* review of claim 1 of U.S. Patent No. 7,009,634 B2 (Ex. 1001, "the '634 patent") pursuant to 35 U.S.C. §§ 311–19. Patent Owner Given Imaging Ltd. filed a Preliminary Response (Paper 7, "Prelim. Resp."). We have jurisdiction under 35 U.S.C. § 314. For the reasons that follow, we have decided not to institute an *inter partes* review.

I. BACKGROUND

A. The '634 Patent

The '634 patent describes an "in vivo imaging device and system such as for imaging the digestive tract" of a patient. Ex. 1001, col. 1, ll. 13–14. Specifically, the '634 patent discloses a swallowable capsule comprising a charge-coupled device (CCD) or complementary metal oxide-semiconductor (CMOS) imaging camera, optical system (e.g., lens) for focusing images onto the camera, white light-emitting diodes (LEDs) for illuminating the walls of the digestive tract, radio frequency transmitter, and battery. *Id.* at col. 3, l. 34–col. 4, l. 54. The capsule captures image data as it passes through the patient's digestive tract and transmits the data to a receiver, such as "an array of antennas attached to [the] patient's body," for subsequent collection and analysis. *Id.* at col. 3, ll. 55–61, col. 7, l. 48–col. 8, l. 6.

B. Challenged Claim

Claim 1 of the '634 patent recites:

> 1. A swallowable capsule for in-vivo imaging of the gastrointestinal tract, said capsule comprising:
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> a housing, said housing including at least a dome type optical viewing window portion disposed along a longitudinal

axis of said capsule, said dome type optical viewing window portion being part of the external surface of said housing, said housing enclosing at least:

at least one CMOS or CCD imaging camera;

at least two white LED illuminating sources for illuminating said gastrointestinal tract site only through said optical viewing window;

an optical system comprising at least one lens for collecting light from said gastrointestinal tract site through said optical viewing window onto said CMOS or CCD imaging camera for imaging said gastrointestinal tract site onto said CMOS or CCD imaging camera, said optical system being separated from said dome type optical viewing window portion, which is not part of said optical system, by a gap, the at least two white LED illuminating sources positioned in the vicinity of said optical system and not on the longitudinal axis of said optical system so that the at least two white LED illuminating sources illuminate said gastrointestinal tract site directly through said optical viewing window and not through said optical system, and said CMOS or CCD imaging camera imaging said gastrointestinal tract site via said optical viewing window and via said optical system; and

a transmitter for transmitting the signal of the CMOS or CCD imaging camera to a receiving system.

C. The Prior Art

Petitioner relies on the following prior art:

U.S. Patent No. 5,734,418, issued Mar. 31, 1998 (Ex. 1033, "Danna");

U.S. Patent No. 6,277,064 B1, filed Dec. 29, 1998, issued Aug. 21, 2001 (Ex. 1031, "Yoon");

U.S. Patent No. 6,324,418 B1, filed Sept. 29, 1997, issued Nov. 27, 2001 (Ex. 1032, "Boston Scientific");

Japanese Unexamined Patent Application Publication No. S57-45833, published Mar. 16, 1982 (Ex. 1004, "Gastric Camera");

Japanese Unexamined Patent Application Publication No. 1992-144533, published May 19, 1992 (Ex. 1028, "Olympus");

Japanese Patent Application Publication No. 10-216085, published Aug. 18, 1998 (Ex. 1029, "Katsunori");[1]

International Patent Application Publication No. WO 99/30610, published June 24, 1999 (Ex. 1027, "Iddan"); and

European Patent Application Publication No. EP 0941691 A1, published Sept. 15, 1999 (Ex. 1030, "Welch Allyn").

D. The Asserted Grounds

Petitioner challenges claim 1 of the '634 patent on the following grounds:

References	Basis
Yoon, Katsunori, and Gastric Camera	35 U.S.C. § 103(a)
Welch Allyn and Gastric Camera	35 U.S.C. § 103(a)
Iddan and Welch Allyn	35 U.S.C. § 103(a)
Iddan, Katsunori, and Danna[2]	35 U.S.C. § 103(a)

[1] Petitioner provided affidavits attesting to the accuracy of the English translations of Gastric Camera, Olympus, and Katsunori. *See* Exs. 1004, 1028, 1029; 37 C.F.R. § 42.63(b).

[2] Petitioner challenges claim 1 as unpatentable over "Iddan in view of Welch Allyn *or* in view of Katsunori and Danna." Pet. 13 (emphasis added), 36. We view these as two separate grounds. *See* 37 C.F.R. § 42.104(b)(2).

References	Basis
Boston Scientific, Katsunori, and Danna	35 U.S.C. § 103(a)
Olympus, Katsunori, and Danna	35 U.S.C. § 103(a)

E. Related Inter Partes *Reexamination*

The ’634 patent is the subject of a pending *inter partes* reexamination, Control No. 95/002,175, involving the same parties. Petitioner (Third Party Requester in the reexamination) filed its request for *inter partes* reexamination on September 11, 2012, asserting that claim 1 is unpatentable under 35 U.S.C. § 103(a) based on the following grounds:

> (1) Japanese Patent Application Publication No. 1992-109927 (“Toshiba”), Olympus, and/or German Patent No. DE 3440177 A1 (“German ’177”);
>
> (2) Olympus and Toshiba;
>
> (3) German ’177, Toshiba, and/or Olympus; and
>
> (4) U.S. Patent No. 7,039,453 (“Mullick”), Toshiba, and Olympus.

Ex. 1040, 19–31. The Office granted the request on November 27, 2012. Ex. 1013. The Examiner found that Petitioner had demonstrated a reasonable likelihood of prevailing based on its fourth ground, but not the first three grounds, and issued an Office Action rejecting claim 1 as unpatentable over Mullick, Toshiba, and Olympus. *Id.* at 4–5, 13–15. In response to the rejection, Patent Owner submitted arguments and amended claim 1 to (1) replace “CMOS or CCD imaging camera” with “CMOS imaging camera,” and (2) replace “said optical viewing window” with “said optical viewing window portion.” Ex. 1014, 3, 5–34. Patent

Owner also submitted various declarations to attempt to swear behind Mullick and to provide evidence of secondary considerations of non-obviousness. *See* Exs. 1018, 1019. Petitioner then filed comments proposing new grounds of rejection based on the prior art submitted with its request and two additional prior art references. Ex. 1021.

On May 30, 2014, the Examiner issued an Action Closing Prosecution (1) concluding that Mullick is not prior art to the '634 patent based on the evidence submitted by Patent Owner, (2) refusing to adopt Petitioner's new proposed grounds of rejection, (3) finding Patent Owner's evidence of secondary considerations of non-obviousness unpersuasive, and (4) finding amended claim 1 patentable. Ex. 1026; *see* Pet. 7. The Examiner then issued a Right of Appeal Notice, and Petitioner filed a Notice of Appeal to the Board. Briefing in Petitioner's appeal is now complete, as Petitioner filed its Rebuttal Brief on July 27, 2015. The appeal is pending.

II. DISCUSSION

Pursuant to 35 U.S.C. § 314(a), an *inter partes* review may not be instituted "unless . . . the information presented in the petition . . . and any response . . . shows that there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition." As we have recognized in other proceedings, "Congress did not mandate that an *inter partes* review must be instituted under certain conditions. Rather, by stating that the Director—and by extension, the Board—*may not* institute review *unless* certain conditions are met, Congress made institution discretionary." *Intelligent Bio-Systems, Inc. v. Illumina Cambridge Ltd.*, Case IPR2013-00324, slip op. at 4 (PTAB Nov. 21, 2013)

(Paper 19). Thus, in determining whether to institute an *inter partes* review, the Board "may deny some or all grounds for unpatentability for some or all of the challenged claims." 37 C.F.R. § 42.108(b); *see* 35 U.S.C. § 314(a).

In exercising our discretion, we are guided by the statutory requirement, in promulgating regulations for *inter partes* review, to consider the effect of any regulations on "the efficient administration of the Office [and] the ability of the Office to timely complete proceedings," 35 U.S.C. § 316(b), as well as the requirement to construe our rules to "secure the just, speedy, and inexpensive resolution of every proceeding," 37 C.F.R. § 42.1(b). Also, with respect to other proceedings or matters involving a challenged patent that may be before the Office, we "may determine the manner in which the *inter partes* review or other proceeding or matter may proceed, including providing for stay, transfer, consolidation, or termination of any such matter or proceeding." 35 U.S.C. § 315(d); *see* 37 C.F.R. § 42.122(a). Finally, although not directly applicable here, 35 U.S.C. § 325(d) provides that "[i]n determining whether to institute or order [an *inter partes* review], the Director may take into account whether, and reject the petition or request because, the same or substantially the same prior art or arguments previously were presented to the Office." Allowing such challenges would risk harassment of patent owners and frustration of Congress's intent in enacting the Leahy-Smith America Invents Act ("AIA"). *See* H.R. Rep. No. 112-98, pt.1, at 48 (2011) ("[AIA proceedings] are not to be used as tools for harassment or a means to prevent market entry through repeated litigation and administrative attacks on the validity of a patent. Doing so would frustrate the purpose of the section as providing quick and cost effective alternatives to litigation.").

We are persuaded that the particular facts of this proceeding counsel against institution. Our decision whether to institute an *inter partes* review must be based on claim 1 of the '634 patent as it exists today. *See* 35 U.S.C. § 314(a); Pet. 13. The patentability of that claim, however, was before the Office in the *inter partes* reexamination. Petitioner challenged claim 1, the Examiner rejected the claim based on certain prior art, Patent Owner amended the claim in an attempt to overcome the prior art, and prosecution is now closed. *See* Exs. 1013, 1014, 1026, 1040. A reexamination certificate will issue after resolution of Petitioner's appeal to the Board and any appeal to the U.S. Court of Appeals for the Federal Circuit. *See* 35 U.S.C. § 316(a) (2002).

As both parties recognize, with respect to claim 1, the reexamination will result in either an amended version of claim 1 (if Patent Owner prevails) or the cancellation of claim 1 (if Petitioner prevails). *See* Prelim. Resp. 54; Ex. 2003, 9–10, 12.[3] But in either situation, claim 1, as it is today, will no longer exist once the reexamination is concluded, and any decision as to the patentability of claim 1 we might reach in this proceeding would be moot and purely advisory. To illustrate, if an *inter partes* review were instituted in this proceeding and a reexamination certificate entered during the resulting trial, the issue to be decided in this proceeding—the patentability of claim 1—immediately would become moot because the claim challenged in the Petition, on which the decision whether to institute was based, was cancelled. *See* 35 U.S.C. §§ 314(a), 318(a); *RPX Corp. v. MacroSolve, Inc.*,

[3] We conducted a conference call with the parties on July 20, 2015 to discuss the status of the pending *inter partes* reexamination, and have considered the parties' positions in rendering this Decision. Patent Owner filed a transcript of the call as Exhibit 2003.

Case IPR2014-00140, slip op. at 2 (PTAB June 20, 2014) (Paper 13) (terminating an *inter partes* review following the issuance of an *ex parte* reexamination certificate cancelling the challenged claims).[4] Similarly, should Patent Owner in this proceeding move to amend claim 1 in the same manner as in the reexamination—a situation both parties appear to believe is likely—the patentability of the same proposed amended claim would be before two separate deciding officials of the Office at the same time. *See* Pet. 45, 49; Prelim. Resp. 21–22.

Thus, we do not see how the efficient administration of the Office, or the just, speedy, and inexpensive resolution of every proceeding, would be secured by instituting an *inter partes* review in this proceeding. Rather, we agree with Patent Owner that "[i]t would be a waste of Office resources to allow two parallel proceedings on the same patent at the same time, on different versions of the claim, and the conclusion of the Reexamination with an amended claim [or no claims at all] would make an IPR proceeding moot." *See* Prelim. Resp. 1.

Prejudice to the parties also weighs against exercising our discretion to institute an *inter partes* review in this proceeding. In particular, we are not persuaded that Patent Owner should be forced to defend a claim that it voluntarily has given up in the reexamination and where prosecution is now

[4] The scenario described above may be distinguished from the situation where a reexamination certificate issues prior to institution of an *inter partes* review, in which case the Board's decision whether to institute is based on the claims of the patent as amended in the reexamination certificate. *See* 35 U.S.C. § 314(a); *Eizo Corp. v. Barco N.V.*, Case IPR2014-00358, slip op. at 5 (PTAB July 23, 2014) (Paper 11); *GEA Process Eng'g, Inc. v. Steuben Foods, Inc.*, Case IPR2014-00051, slip op. at 2–3, 10–11 (PTAB Mar. 10, 2014) (Paper 14).

closed. *See id.* at 54; Ex. 2003, 12. On the other hand, Petitioner already had an opportunity to challenge the patentability of claim 1 in an *inter partes* proceeding, and currently is challenging the patentability of amended claim 1. Further, based on the current record, we are aware of no statutory bar or other impediment to Petitioner filing another petition seeking *inter partes* review of the '634 patent, should a reexamination certificate issue in the future with amended claim 1 or any new claims. *See* Pet. 1 (identifying no litigation matters involving the '634 patent); Paper 6, 1–2.

Based on the particular factual circumstances of this proceeding, including the fact that the only claim being challenged by Petitioner has been amended in the reexamination, the advanced stage of the reexamination involving the same parties, and the balance of potential prejudice to the parties, we exercise our discretion under 35 U.S.C. § 314(a) and 37 C.F.R. § 42.108(b) and decline to institute an *inter partes* review. Accordingly, we do not reach the merits of the unpatentability arguments in the Petition, and express no opinion on those arguments at this time.

III. ORDER

In consideration of the foregoing, it is hereby:

ORDERED that the Petition is denied as to challenged claim 1 of the '634 patent.

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