

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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SIEMENS HEALTHCARE  
DIAGNOSTICS INC.,  
Petitioner,

v.

RADIOMETER MEDICAL APS,  
Patent Owner.

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Case IPR2018-00311  
Patent 8,728,288 B2

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Before JO-ANNE M. KOKOSKI, JEFFREY W. ABRAHAM, and  
JULIA HEANEY, *Administrative Patent Judges*.

HEANEY, *Administrative Patent Judge*.

DECISION  
Denying Institution of *Inter Partes* Review  
35 U.S.C. § 314(a)

## I. INTRODUCTION

Siemens Healthcare Diagnostics Inc. (“Petitioner”) filed a Petition (“Pet.”) to institute an *inter partes* review of claims 1–13 of U.S. Patent No. 8,728,288 B2 (“the ’288 patent,” Ex. 1001). Paper 1. Radiometer Medical APS (“Patent Owner”) filed a Preliminary Response. Paper 5 (“Prelim. Resp.”). We have jurisdiction under 35 U.S.C. § 314.

Upon consideration of the Petition and Preliminary Response, and the evidence of record, we determine that the Petition presents substantially the same prior art or arguments as those previously presented to the Office, and, thus, exercise our discretion under 35 U.S.C. § 325(d) to deny institution of an *inter partes* review as to claims 1–13 of the ’288 patent.

### A. *The ’288 Patent*

The ’288 patent, titled “Sensor Assembly,” describes a “sensor assembly comprising electrochemical sensor elements” that is “suitable for simultaneously measuring a plurality of different parameters, e.g., blood parameters.” Ex. 1001, 1:1–7. Analyte sensors within the assembly are positioned in a way that they are able to contact a very small volume of a fluid sample and measure several parameters within the sample. *Id.* at 2:11–14. Figure 1 of the ’288 patent is reproduced below:

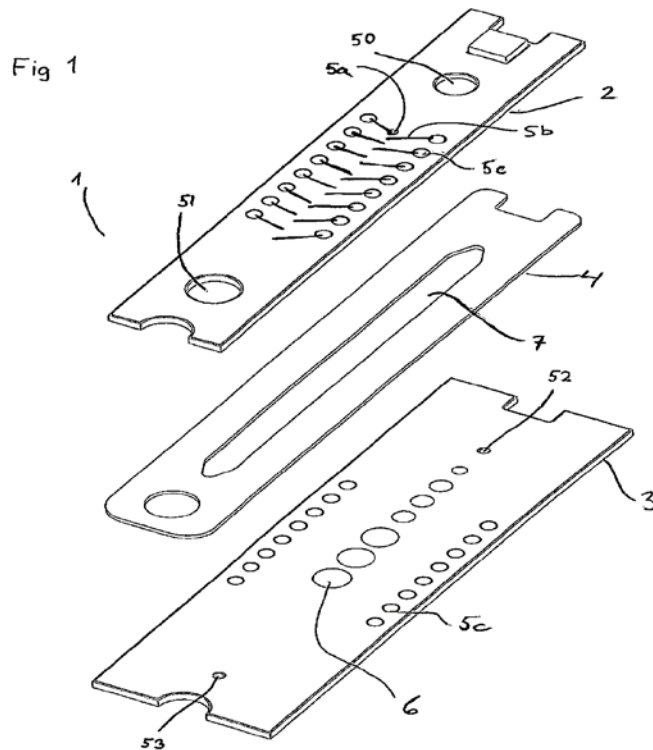


Figure 1 is an exploded view of a sensor assembly according to an embodiment of the '288 patent. *Id.* at 7:25–26. The sensor assembly includes first substrate 2, second substrate 3, and spacer 4. *Id.* at 8:3–4. A plurality of analyte sensors 6 and electrical contact points 5c are arranged on a first surface of second substrate 3 (facing upward in Figure 1). *Id.* at 8:16–20. A plurality of analyte sensors is also arranged on a first surface of first substrate 2 (facing downward (not visible in Figure 1)); the sensors are connected to electrical contact points 5c via wires 5b and tiny bores 5a in the substrate that are filled with conductive material. *Id.* at 8:5–15. Spacer 4 has recess 7 that forms a measuring cell when the spacer is positioned between the first and second substrates, such that the analyte sensors of both substrates may be in fluid contact with the measuring cell. *Id.* at 8:36–51.

The '288 patent describes that the analyte sensors measure parameters of a body fluid sample positioned in the measuring cell, and are arranged on both substrates in order to increase the number of sensors without decreasing the size of an individual sensor. *Id.* at 3:44–46, 52–60. Preferably, spacing between the sensors is arranged to avoid interference between the different sensors. *Id.* at 4:1–5. The measuring cell may have a shape that allows the fluid sample to flow through the cell in a substantially linear movement, avoiding bends and turns. *Id.* at 4:6–10

*B. Challenged Claims*

Petitioner challenges claims 1–13 of the '288 patent, of which claims 1 and 11 are independent. Claim 1, reproduced below, is illustrative of the challenged claims:

1. A sensor assembly comprising:

- a first electronic wiring substrate having a first surface and a second surface and at least two analyte sensors formed on the first surface thereof, the at least two analyte sensors being connected with electrical contact points,
  - a second electronic wiring substrate having a first surface and a second surface and at least two analyte sensors formed on the first surface thereof, the at least two analyte sensors being connected with electrical contact points, and
  - a spacer having a through-going recess with a first opening and a second opening,
- wherein the first substrate, the second substrate and the spacer are arranged in a layered structure, where the first surface of the first substrate closes the first opening of the spacer and the first surface of the second substrate closes the second opening of the spacer, thereby forming a measuring cell in which all the analyte sensors on the first surface of the first substrate face the measuring cell through the first opening of the spacer and wherein all the analyte sensors on the first

surface of the second substrate face the measuring cell through the second opening of the spacer, the measuring cell having a shape allowing fluid flow through the measuring cell to be substantially linear.

Ex. 1001, 12:28–52. Claims 2–10 depend from claim 1; claims 12 and 13 depend from claim 11.

*C. The Prior Art*

Petitioner relies on the following prior art references:

Reference	Description	Date	Exhibit No.
Leader '425	U.S. Pat. No. 5,916,425 <sup>1</sup>	June 29, 1999	1003
Wang	Joseph Wang et al., <i>Coated Amperometric Electrode Arrays for Multicomponent Analysis</i> , 62 ANAL. CHEM. 1924-27 (1990)	Sep. 15, 1990	1005
Schibli	U.S. Pat. App. No. 2004/0043477 A1	Mar. 4, 2004	1007
Glezer	U.S. Pat. App. No. 2004/0189311 A1	Sep. 30, 2004	1008

*D. Asserted Grounds of Unpatentability*

Petitioner challenges the patentability of claims 1–13 on the following grounds:

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<sup>1</sup> As discussed below, during prosecution the Examiner considered a related reference, U.S. Patent No. 5,858,452 to Leader (“Leader ’452”). Patent Owner asserts that the disclosures of Leader ’425 and Leader ’452 are substantively identical.

References	Basis	Claims Challenged
Leader '425 and Wang	§ 103(a)	1 and 6–13
Leader '425, Wang, and Schibli	§ 103(a)	2–5
Leader '425, Wang, and Glezer	§ 103(a)	2–5

The Petition is supported by the Declaration of Richard M. Crooks, Ph.D. (Ex. 1020).

## II. ANALYSIS

Institution of *inter partes* review is discretionary. *See* 35 U.S.C. § 314(a). Our discretion on whether to institute is guided by 35 U.S.C. § 325(d), which states that “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.” Patent Owner contends that Petitioner’s challenges rely on the same or substantially the same prior art and arguments that were already considered during prosecution of the ’288 patent. Prelim. Resp. 9–20.

When evaluating whether the same or substantially the same prior art or arguments previously were presented to the Office under § 325(d), the Board has considered a number of non-exclusive factors, including: (1) the similarity of the asserted art and the prior art involved during the examination; (2) the cumulative nature of the asserted art and the prior art evaluated during examination; (3) the extent to which the asserted art was considered during examination, including whether the prior art was the basis

for rejection; (4) the extent of the overlap between the arguments made during examination and the manner in which Petitioner relies on the prior art or Patent Owner distinguishes the prior art; (5) whether Petitioner has pointed out sufficiently how the Examiner erred in evaluating the asserted prior art; and (6) the extent to which additional evidence and facts presented in the Petition warrant reconsideration of the prior art or arguments. *Becton, Dickinson & Co. v. B. Braun Melsungen AG*, Case IPR2017-01586, slip op. at 17–18 (PTAB Dec. 15, 2017) (informative). After considering all of the relevant factors and the parties’ arguments, we are persuaded, for the reasons set forth below, that the Petition presents substantially the same prior art or arguments previously presented to the Office with regard to the asserted grounds.

*A. Prosecution History of the ‘288 Patent*

The ’288 patent issued from U.S. Patent Application No. 12/081,997 (“the ’997 application”). In the first office action dated April 15, 2011, the Examiner rejected *inter alia* original independent claim 1 as anticipated by U.S. Patent No. 6,123,820 to Bergkuist (“Bergkuist”) (Ex. 1004). Ex. 1002, 155–56.<sup>2</sup> Original claim 1 recited as follows:

A sensor assembly comprising:  
a first electronic wiring substrate having a first surface and a second surface and at least one analyte sensor formed on the first surface thereof, the at least one analyte sensor being connected with one or more electrical contact points,  
a second electronic wiring substrate having a first surface and a second surface and at least one analyte sensor formed on the first surface part thereof, the at least one analyte sensor being

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<sup>2</sup> The cited page numbers in Ex. 1002 refer to the page numbers added by Petitioner in the bottom left corner of the page.

connected with one or more electrical contact points, and a spacer having a through-going recess with a first opening and a second opening, wherein the first substrate, the second substrate and the spacer are arranged in a layered structure, where the first surface of the first substrate closes the first opening of the spacer and the first surface of the second substrate closes the second opening of the spacer, thereby forming a measuring cell which is faced by at least one sensor from each of the substrates.

*Id.* at 24; *see also* Pet. 12 (comparing as-filed claim 1 and issued claim 1). The Examiner relied on Bergkuist’s teaching of a sensor cartridge having first and second sensor arrays disposed on opposite surfaces of first and second substrates in a two-sided configuration. Ex. 1002, 155–56.

The Examiner also rejected pending claims 5 and 6, which depended from claim 1, as unpatentable over the combination of Bergkuist and Leader ’452.<sup>3</sup> Ex. 1002, 157–158. Aside from the different language of original claim 1 as compared to issued claim 1, pending dependent claims 5 and 6 contained the same limitations as dependent claims 2 and 3 in the issued ’288 patent, i.e. “the electrical contact points of the first substrate are arranged on the second surface of the first substrate and ... the electrical contact points of the second substrate are arranged on the first surface of the second substrate.” *Id.* at 24–25; *see also* n. 10 *infra*.<sup>4</sup> The Examiner found that Leader ’452 “teaches a method for fabricating wiring substrate for

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<sup>3</sup> Leader ’452 issued from a divisional application of Application No. 08/648,675, which issued as Leader ’425 (Ex. 1003).

<sup>4</sup> The Examiner also rejected pending dependent claims 7 and 8, which depended from claims 6 and 7, as unpatentable over the combination of Bergkuist, Leader ’452, and Hanagan (U.S. Pat. No. 5,520,787 (Ex. 2002)). Ex. 1002, 159. *See also id.* at 231.



sensors with subminiature through holes (Fig. 9) comprising: electrically wiring the hemocrit sensor electrodes (1001) through a hole (702) in substrate (405)” and determined that it would have been obvious to couple Bergkuist’s electrochemical sensors and their respective electrical connection pads with Leader ’452’s wiring substrate because Leader ’452 further teaches that providing physical isolation of the sample from the conduction paths between the sensor electrodes and external devices provides for improved levels of accuracy. Ex. 1002, 158 (citing Leader ’452, Abstract). The Examiner also determined that it would have been obvious to a person of ordinary skill in the art to change the configuration of contact points of the second sensor array of Bergkuist, because such a rearrangement of parts would involve only routine skill in the art. *Id.* at 159.

In response to the April 15, 2011 office action, the Applicant filed an amendment adding new claims 14–17. Ex. 1002, 175–76. The Examiner then issued a final rejection of all pending claims, including the same rejection of claims 5 and 6 under 35 U.S.C. § 103 as unpatentable over the combination of Bergkuist and Leader ’452. *Id.* at 193–94. The Applicant responded by initiating an interview, during which the Examiner agreed with the Applicant that the pending claims differed from Bergkuist, and indicated he would withdraw the final rejection. *Id.* at 220. In a non-final rejection dated August 29, 2012, the Examiner issued a new rejection of pending independent claims 1 and 14 based on a combination of Bergkuist and Wohlstadter,<sup>5</sup> in which the Examiner relied on Wohlstadter’s teaching of a spacer defining a fluid channel sealed by upper and lower layers of

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<sup>5</sup> U.S. Pat. No. 6,207,369 B1 (Ex. 1009).

electrodes, to modify Bergkuist's sensor cartridge. *Id.* at 226. The Examiner rejected pending claims 5 and 6 as unpatentable over the combination of Bergkuist, Wohlstadter, and Leader '452, based on the same findings concerning Leader '452 and rationale for combining Leader '452 with Bergkuist, as stated in the previous rejections. *Id.* at 229–230. The Applicant responded to the rejection of claims 5 and 6 by referring back to its argument against the combination of Bergkuist and Leader '452 in previous responses. *Id.* at 247.

In the final rejection dated March 19, 2013, the Examiner again rejected independent claims 1 and 14 based on the combination of Bergkuist and Wohlstadter, and claims 5 and 6 based on the combination of Bergkuist, Wohlstadter, and Leader '452, relying on the same findings concerning Leader '452 and the rationale for combining the references. Ex. 2002, 257–262. The Applicant responded by filing a request for continued examination with an amendment<sup>6</sup> to pending independent claims 1 and 14 to distinguish over Bergkuist and Wohlstadter, and referred to its argument against Leader '452 in previous responses. *Id.* at 280. The Examiner then allowed the claims, noting in the reasons for allowance that Bergkuist teaches “a sensor having two substrates, each having a plurality of sensors disposed thereon, sandwiching a sample cell having openings for the sensors to come into fluidic contact with the sample,” but fails to teach “the flow cell having a shape allowing fluid flow through the measuring cell to be substantially linear.” *Id.* at 359.

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<sup>6</sup> See Pet. 12, showing issued claim 1 with highlighting indicating language added by amendment.

*B. Petitioner's Arguments*

Petitioner asserts that Leader<sup>7</sup> is directed to the same problem as the '288 patent, namely minimizing sample size in the field of blood analysis (Pet. 29 (citing Ex. 1003, 1:20–38)), and that Leader addresses the problem by allowing more sensors to be fabricated in a smaller area (*id.* at 30).<sup>8</sup> Petitioner contends Leader teaches that reducing the size of individual sensors and moving them closer together provides a way to reduce sample volume in a flow cell sensor assembly. *Id.* at 31 (citing Ex. 1020 ¶ 50). Specifically, Petitioner contends, with support from Dr. Crooks, that the structure of sensors and through-holes as shown in Figure 9 of Leader “prevents contact between the flowing solution and the sensor circuitry, and allows for significant miniaturization of the device.” *Id.* at 23 (citing Ex. 1020 ¶¶ 53–54). Petitioner further asserts that the '288 patent recognizes that Leader's sensor structure with a small diameter through-hole allows a relatively large number of sensors to be formed on the surface of the substrate within a relatively small fluid flow cell (*id.* (citing Ex. 1003, 4:7–13)), and that the '288 patent incorporates Leader's sensors and wiring substrates (*id.* at 30 (citing Ex. 1001, 2:65–3:2)).

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<sup>7</sup> According to Patent Owner, the disclosures of Leader '425 and Leader '452 are substantively identical, and, therefore, the distinction between them is not consequential for the purpose of Patent Owner's arguments. Prelim. Resp. n. 1. Petitioner does not address any difference between Leader '452 and Leader '425. Patent Owner refers to both Leader '452 and Leader '425 as simply “Leader” (*id.*); accordingly, we follow that nomenclature when discussing the parties' arguments.

<sup>8</sup> Petitioner further asserts that the '288 patent recognizes that Leader achieved this goal. Pet. 30 (citing Ex. 1001, 1:42–46, 2:65–3:2).

Petitioner asserts that Leader’s sensors are disposed along the bottom of the flow channel in sensor assembly 400, which is enclosed by an encasement having plastic cover 1200 that sits atop the assembly and forms the flow cell. Pet. 22–23, 33 (citing Ex. 1003, Figs. 12–13, 20:5–10, 63–65; Ex. 1020 ¶¶ 75–76)). Petitioner argues that a person of ordinary skill in the art “would have been led to consider a design similar to Leader, but with sensors on both surfaces of the flow cell rather than just a single surface.” *Id.* at 33. Petitioner further argues that a person of ordinary skill “would have pursued the two-sided design as a solution to the sample volume problem” in part because it was one of the few ways available to increase sensor density. *Id.* (citing Ex. 1020 ¶¶ 50, 79). Petitioner also argues that a person of ordinary skill would have modified Leader to provide a two-sided design because Wang and Ziegler<sup>9</sup> expressly taught this solution. *Id.* (citing Ex. 1006, 2:17–27). Petitioner relies on Wang as teaching construction of a flow cell consisting of two dual electrode half cells separated by gaskets, in order to create space for flow of the sample solution. *Id.* at 24–25, 34 (citing Ex. 1005, 1924). Petitioner argues that the close structural compatibility of Leader and Wang would have made it simple for a person of ordinary skill to apply Wang’s design process to Leader by taking Leader’s one-sided planar substrate with analyte sensors, mirroring it with another planar substrate with analyte sensors, and using an intermediate layer to create space for fluid to flow. *Id.* at 34 (citing Ex. 1020 ¶¶ 76–77).

Petitioner argues that the combination of Leader’s substrate and sensors with Wang’s two-sided flow cell comprising a spacer to form a two-

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<sup>9</sup> U.S. Pat. No. 6,652,810 B1 (Ex. 1006).

sided version of Leader (“Leader-Wang”), teaches all of the limitations of claims 1 and 6–13. *Id.* at 41–50, 59–66. With regard to dependent claims 2–5, Petitioner argues that a person of ordinary skill in the art would have understood the benefit of facing all electrical contacts in the same direction, as required by claims 2–5,<sup>10</sup> because of Leader’s teaching about the design of its cartridge-analyzer interface, and would have been able to rearrange the contacts on one substrate of Leader-Wang to face in the same direction. *Id.* at 51–52 (citing Ex. 1003, 3:6–16, 20:21–30; Ex. 1020 ¶ 106). Petitioner further argues that facing all electrical contacts in the same direction is further taught by Schibli and Glezer. *Id.* at 52.

Petitioner asserts that Schibli teaches a three-layer biosensor comprising a capillary channel where a sample fluid comes into contact with two electrodes on the top surface and two on the bottom surface, and shows that all of the electrical contacts connected to the electrodes face in the same direction. *Id.* at 25–26 (citing Ex. 1007, Fig 1, ¶¶ 39–41; Ex. 1020 ¶ 67). Petitioner further asserts that Schibli, like Wang, teaches increasing sensor density by inserting additional sensors into a fixed volume. *Id.* at 31 (citing Ex. 1020 ¶ 50). Petitioner asserts that Glezer describes a one-sided sensor design “similar in some ways to Leader” and recognizes “that design need might call for moving the contact to either surface of the substrate, and describes how to do that.” *Id.* at 53–54 (citing Ex. 1008, Fig. 23, ¶¶ 102, 253; Ex. 1020 ¶ 111).

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<sup>10</sup> Claim 2 recites in pertinent part: “the electrical contact points of the first substrate are arranged on the second surface of the first substrate and ... the electrical contact points of the second substrate are arranged on the first surface of the second substrate.” Ex. 1001, 12:54–57.

*C. Same or Substantially the Same Prior Art or Arguments*

Patent Owner argues that Petitioner's asserted grounds of unpatentability are substantially the same as those considered by the Examiner during prosecution of the '288 patent because: (1) the Examiner considered Leader in each of the four office actions; (2) Bergkuist teaches everything that Wang is purported to teach (i.e., a two-sided sandwich sensor array); and (3) Wang adds nothing of substance to the combination of references considered by the Examiner. Prelim. Resp. 11–12. Patent Owner also argues that Bergkuist is “substantially closer art to Leader’s sensor assembly than Wang, because like Leader, Bergkuist discloses a stop-flow measuring cell in which the analyte remains in the measuring cell during analysis.” *Id.* at 12–13. Further, Patent Owner argues that the combination of Bergkuist, Wohlstadter, and Leader considered by the Examiner contains substantially the same teachings as Leader, Wang, Schibli, and Glezer that Petitioner presents as grounds for unpatentability of claims 2–5. *Id.* at 13.

*1. Leader and Wang*

As discussed above, the Examiner relied on Leader during prosecution of the '288 patent. Specifically, the Examiner found that Leader “teaches a method for fabricating wiring substrate for sensors with subminiature through holes (Fig. 9) comprising: electrically wiring the hemocrit sensor electrodes (1001) through a hole (702) in substrate (405).” Ex. 1002, 158 (citing Leader '452, Abstract). The Examiner repeated these findings in each subsequent rejection. *Id.* at 229–230, 261–262. Here, Petitioner also relies on the structure of sensors and through-holes in the substrate of Leader’s Figure 9, and argues that a person of ordinary skill in the art would have been led to consider a design similar to Leader because it is also

directed to the problem of minimizing sample volume by increasing sensor density. Pet. 22–23, 29–33. We conclude that the disclosure Petitioner relies on in Leader, and the arguments Petitioner makes based on that disclosure, are substantially the same as that relied upon by the Examiner during prosecution of the '288 patent. Our conclusion does not change because the Examiner relied on Bergkuist, rather than Leader, as the primary reference. *Id.* at 13. Petitioner does not explain how the difference between its reliance on Leader as a primary reference here, and the Examiner's reliance on Leader as a secondary reference applied during prosecution, establishes that the Examiner was not aware of the contents of Leader in material respects applicable to the challenged claims. We find more persuasive Patent Owner's analysis under the *Becton Dickinson* factors (Prelim. Resp. 10–17), showing that the Office previously considered Leader extensively, and in substantially the same way as Petitioner now argues in the Petition.

Patent Owner argues that Wang is cumulative of Bergkuist and Wohlstadter, which the Examiner relied on as teaching a two-sided sandwich sensor array (Bergkuist) and a spacer (Wohlstadter), and that Petitioner is applying Wang here in the same way that the Examiner applied the combination of Bergkuist and Wohlstadter during prosecution. *Id.* at 11–12. Patent Owner further argues that Bergkuist teaches the same feature of disposing sensors along both the top and bottom of the flow channel, as Ziegler, upon which Petitioner relies. *Id.* at 13.

We agree with Patent Owner that Wang is cumulative with respect to the references that the Examiner considered during prosecution of the '288

patent. Petitioner does not address whether the disclosures of Wang upon which it relies are substantially the same as those in Bergkuist and Wohlstadter that the Examiner considered during prosecution. Further, Petitioner admits that the '288 patent specification "recognizes that Bergkuist also attempted to address the sample size problem by disposing sensors on both sides of a measuring cell." Pet. 13 (citing Ex. 2001, 1:51–55). Based on the disclosures in Bergkuist and Wohlstadter described above, as well as the disclosures of Wang and Ziegler cited by Petitioner, we are persuaded that Petitioner relies on Wang and Ziegler in substantially the same way as the Examiner applied Bergkuist and Wohlstadter during prosecution. In view of the similarity of disclosures of the references and the way in which those disclosures were applied by the Examiner and are applied now by Petitioner, Petitioner's argument that the Examiner did not allow the pending claims over Bergkuist until the Applicant amended the claims to recite a "substantially linear" measuring cell to distinguish over Bergkuist's zig-zag cell does not persuade us, on balance, that the Examiner relied on Bergkuist in a materially different way. *Id.* at 13.

*D. Schibli and Glezer*

With respect to dependent claims 2–5, Petitioner argues that a person of ordinary skill in the art would have understood the benefit of facing all electrical contacts in the combined Leader-Wang sensor assembly in the same direction, as required by claim 2, "in order to facilitate a simple and reliable cartridge-analyzer interface, and to minimize changes that would have been needed to existing analyzers when switching from a one-sided design to a two-sided design." Pet. 51–52. As discussed above, we find that



Petitioner relies on substantially the same disclosures in Leader and Wang in substantially the same way as the Examiner applied Leader, Bergkuist and Wohlstadter during prosecution.

Petitioner further argues that Schibli and Glezer “further reinforce[d]” the obviousness of claim 2” and its dependent claims. *Id.* at 52. Patent Owner argues that the Examiner considered substantially the same teachings as those provided by Schibli and Glezer by considering various combinations of Bergkuist, Wohlstadter, Leader, and Hanagan. Prelim. Resp. 13–14, 18. Specifically, Patent Owner points to the Examiner’s reliance on Hanagan’s teaching of “part of the second substrate extending beyond the first substrate, with electrical contact points on the extending part of the second substrate” with respect to pending claims 7 and 8, which correspond to issued claims 4 and 5. *Id.* at 14 (citing Ex. 1002, 231). Upon review of the record, we find that the Examiner’s reasoning that it would have been obvious to a person of ordinary skill in the art to change the configuration of contact points of the second sensor array of Bergkuist, because a rearrangement of parts would involve only routine skill in the art (Ex. 1002, 159), is substantially the same rationale Petitioner now presents for unpatentability of claims 2–5 based on the combined teachings of Leader, Wang, Schibli, and Glezer. *See* Pet. 51–52.

*E. Discretion to Deny Institution of Trial*

Having found that the Petition raises the same or substantially the same prior art or arguments as those previously presented to the Office, we now decide whether to exercise our discretion to deny institution under § 325(d). Our discretion under § 325(d) involves a balance between several

competing interests. *See Neil Ziegman, N.P.Z., Inc. v. Stephens*, Case IPR2015-01860, slip op. at 12–13 (PTAB Feb. 24, 2016) (Paper 11). “On the one hand, there are the interests in conserving the resources of the Office and granting patent owners repose on issues and prior art that have been considered previously.” *Fox Factory, Inc. v. SRAM, LLC*, Case IPR2016-01876, slip op. at 7 (PTAB Apr. 3, 2017) (Paper 8). “On the other hand, there are the interests of giving petitioners the opportunity to be heard and correcting any errors by the Office in allowing a patent—in the case of an *inter partes* review—over prior art patents and printed publications.” *Id.*

For the following reasons, we deny the Petition. Petitioner relies on the disclosures in Leader and Wang in substantially the same manner as the Examiner applied the combined teachings of Bergkuist, Wohlstadter, Leader, and Hanagan during prosecution of the ’288 patent. The disclosures in Leader and Wang are substantively similar to, and cumulative of, the disclosures in Bergkuist, Wohlstadter, Leader, and Hanagan that the Examiner considered before allowing the ’288 patent.

Petitioner does not present any arguments distinguishing the Office’s previous decisions on substantially the same issues or provide a compelling reason why we should re-adjudicate substantially the same prior art and arguments presented during prosecution and considered by the Examiner. Petitioner has not pointed us to any error in the Examiner’s analysis of Bergkuist, Wohlstadter, and Leader. To the extent Petitioner argues that the Examiner erred by failing to consider Leader as a primary reference,<sup>11</sup> we

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<sup>11</sup> *See* Pet. 13 (“[T]he examiner apparently never considered whether a person of ordinary skill in the art, rather than altering Bergkuist’s zig-zag

find that argument unsupported and speculative. Nor does Petitioner point to any additional facts or evidence that would warrant our reconsideration of the arguments on the basis of Examiner error. The Crooks Declaration does not provide additional facts or evidence that warrant reconsideration of the disclosures in Leader, Wang, Schibli, and Glezer that are substantially the same as, or cumulative of, the disclosures already considered by the Office.

We recognize that Petitioner has a direct interest in pursuing the instant Petition, but we also acknowledge the burden and expense to Patent Owner in having to defend the '288 patent based on substantially the same prior art or arguments already considered by the Office. Additionally, we are not persuaded that adjudicating a dispute on already-considered issues is an efficient use of Board or party resources. *See Unified Patents Inc. v. John L. Berman*, Case IPR2016-01571, slip. op. at 12 (PTAB Dec. 14, 2016) (Paper 10) (informative); *see also Cultec, Inc. v. StormTech LLC*, Case IPR2017-00777 (PTAB Aug. 22, 2017) (Paper 7) (informative) (denying institution of *inter partes* review under § 325(d) because the same or substantially the same prior art or arguments previously were presented to the Office during prosecution); *Hospira, Inc. v. Genentech, Inc.*, Case IPR2017-00739 (PTAB July 27, 2017) (Paper 16) (informative) (denying institution of *inter partes* review under § 325(d) because the Office already decided the dispositive issue of whether the asserted references qualified as prior art with respect to the challenged patent); *Juniper Networks, Inc. v. Mobile Telecomm'ns Techs., LLC*, Case IPR2017-00642, slip op. at 13

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design, would have simply started with the one-sided Leader device and made a mirror image, two-sided device.”)

(PTAB July 27, 2017) (Paper 24) (finding that “the Examiner was aware of the contents of [the asserted prior art] in material respects applicable to [the challenged claims]” and that the Board “was shown no reason sufficient to reevaluate [the asserted prior art] with respect to any of the challenged claims”).

### III. CONCLUSION

Based on the information presented in the Petition and the Preliminary Response, we conclude that the instant Petition raises the same or substantially the same prior art or arguments as those previously presented to the Office. In light of the circumstances of the present case, we exercise our discretion under 35 U.S.C. § 325(d) and decline to institute *inter partes* review of the '288 patent.

### IV. ORDER

In consideration of the foregoing, it is hereby:

ORDERED that the Petition is denied, and no *inter partes* review is instituted.

IPR2018-00311  
Patent 8,728,288 B2

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