

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ULTHERA, INC.,
Petitioner,

v.

DERMAFOCUS LLC,
Patent Owner.

Case IPR2016-01459
Patent 6,113,559

Before MEREDITH C. PETRAVICK, FRANCES L. IPPOLITO, and
JAMES A. WORTH, *Administrative Patent Judges*.

WORTH, *Administrative Patent Judge*.

FINAL WRITTEN DECISION ON REMAND AS TO REMAINING
CLAIMS

35 U.S.C. § 318(a) and 37 C.F.R. § 42.73

I. INTRODUCTION

On July 19, 2016, Petitioner Ulthera, Inc. (“Ulthera”) filed a Petition (Paper 1) requesting *inter partes* review of claims 1–18 of U.S. Patent No. 6,113,559 (the ’559 patent, Ex. 1001). Having determined that the information presented in the Petition demonstrated a reasonable likelihood that Ulthera would prevail with respect to claims 1–4, 6–9, and 11–18 of the ’559 patent, pursuant to 35 U.S.C. § 314, we instituted trial as to those claims on January 23, 2017. Paper 11, 2. At that time, we did not institute an *inter partes* review with respect to claims 5 and 10. *Id.*

After a trial, and pursuant to 35 U.S.C. § 318(a), we issued a Final Written Decision on January 19, 2018, concluding that Ulthera had failed to demonstrate that the instituted claims were unpatentable. Paper 30, 36–37 (“Final Dec.”). Ulthera appealed to the U.S. Court of Appeals for the Federal Circuit (“Federal Circuit”). Paper 32. Subsequent to appeal, the Supreme Court issued a decision in *SAS Institute Inc. v. Iancu*, 138 S. Ct. 1348 (2018), holding that a final written decision under 35 U.S.C. § 318(a) must decide the patentability of all claims challenged in the petition. Ulthera moved to remand the case to the Board for additional proceedings in light of *SAS Institute*, and the Federal Circuit granted the motion. *Ulthera, Inc. v. DermaFocus LLC*, Case No. 18-1542, Order, slip op. 1, 3 (Fed. Cir. May 25, 2018). In its Order, the Federal Circuit directed the Board “to promptly issue a final written decision as to all claims challenged by Ulthera in its petition.” *Id.* at 3.

On June 11, 2018, we issued an Order modifying our January 23, 2017 institution decision to include review of all challenged claims and all grounds presented in the Petition. Paper 34, 3. In particular, we instituted

on Petitioner's assertion that claim 5 is unpatentable under 35 U.S.C. § 103 over Knowlton¹ and the Technomed patent publication², and Petitioner's assertion that claim 10 is unpatentable under 35 U.S.C. § 103 over Knowlton, the Technomed patent publication, and Technomed PCT³. *Id.* at 2. In the Order, we directed the parties to confer as follows:

Within one week of this Order, the parties should confer as to mutually agreeable times for a conference call (i.e., for a status conference) and jointly email the agreed upon times to Trials@uspto.gov. The parties should also confer as to whether they are requesting further briefing and an oral hearing for claims 5 and 10. The parties may waive further briefing and argument at this time and on this particular procedural posture, i.e., in view of *In re Fritch*, 972 F.2d 1260, 1266 (Fed. Cir. 1992) (“dependent claims are nonobvious if the independent claims from which they depend are nonobvious”). Based on the scope of the remand from the Federal Circuit, we do not anticipate relitigating at this time the decision in the final written decision made with respect to independent claim 1.

Id. at 3.

On June 15, 2018, counsel for Petitioner submitted the following to the Board via e-mail, as follows:

¹ Knowlton, WO 96/34568, pub. Nov. 7, 1996 (Ex. 1005).

² Cathignol et al., FR Pub. No. 2,672,486, pub. Aug. 14, 1992 (Ex. 1006). We will refer herein to the translation (Ex. 1007) (hereinafter, “Technomed patent publication”). This reference is referred to in the Petition as “the Technomed patent.” However, the Petitioner states that it is not relying on an issued patent but rather on a printed publication as prior art under 35 U.S.C. § 102(b). Therefore, for clarity, we refer to it as “the Technomed patent publication.”

³ Chapelon et al., WO 93/12742, pub. July 8, 1993 (Ex. 1008). We will refer herein to the translation (Ex. 1009) (hereinafter, “Technomed PCT”).

The parties jointly respond to the Board's June 11, 2018 Order (Paper 34) that the parties confer about further briefing and availability for a conference call in *Ulthera v. DermaFocus*, No. IPR2016-01459.

The parties have conferred and reached the following agreement conditioned on the Board issuing a Final Written Decision finding that dependent claims 5 and 10 of the '559 Patent are patentable solely based on its prior finding that independent claim 1 is patentable. If the Board issues such a Final Written Decision, the parties agree that no further briefing or hearing is required concerning Claims 5 and 10 before the Board enters the Final Written Decision addressing those claims. If the Board intends to address other issues, the parties have not reached an agreement and request a conference call with the Board to discuss the scope of the remand proceedings and a schedule for further briefing and a hearing.

Parties' agreement

Provided that the Board issues a Final Written Decision finding that dependent claims 5 and 10 of the '559 Patent are patentable based solely on its prior finding that independent claim 1 is patentable, the parties have reached the following agreements for this IPR proceeding and any subsequent appeal therefrom: Ulthera does not dispute that the Board may find claims 5 and 10 patentable based solely on its prior finding that independent claim 1 is patentable. This agreement does not restrict Ulthera's right to challenge the Board's Final Written Decision on appeal. For this IPR proceeding and any subsequent appeal therefrom, DermaFocus solely asserts claims 5 and 10 are patentable based on the fact that these two claims incorporate the limitations of claim 1, and will not assert, in this IPR proceeding and any subsequent appeal therefrom, that the additional limitation in dependent claims 5 and 10 ("wherein the ultrasound beam is repeatedly applied until the wrinkles are visibly reduced") also makes these claims patentable. For clarity, DermaFocus reserves the right, in the co-pending district court litigation, to assert that the additional limitation in claims 5 and 10 is a basis for validity

(provided that the ‘559 patent is not invalidated in this IPR or any appeal therefrom), and Ulthera reserves the right to dispute this assertion. The parties reserve all arguments in the event of a remand by the Federal Circuit.

Ex. 3001.

II. ANALYSIS

Claims 1–4, 6, 7, and 12–16 as obvious over Knowlton and the Technomed Patent Publication; claims 8, 9, 11, 17, and 18 are unpatentable as obvious over Knowlton, the Technomed patent publication, and the Technomed PCT

In our January 19, 2018 Final Written Decision, we determined that Petitioner has not demonstrated by a preponderance of the evidence that claims 1–4, 6, 7, and 12–16 are unpatentable as obvious over Knowlton and the Technomed Patent Publication, nor that claims 8, 9, 11, 17, and 18 are unpatentable as obvious over Knowlton, the Technomed patent publication, and the Technomed PCT. Final Dec. 11–37. We incorporate our January 19, 2018 Final Written Decision by reference for purposes of this Decision. We understand this determination to be undisturbed at this time based on the scope of the remand Order, which has directed the Board to promptly issue a final written decision as to all claims challenged by Ulthera in its petition.

Claim 5 as obvious over Knowlton and the Technomed Patent Publication

Claim 5 depends indirectly but ultimately from claim 1, i.e., claim 2 depends from claim 1, claim 3 depends from claim 2, claim 4 depends from claim 3, and claim 5 depends from claim 4. Ex. 1001, 10:33–44. Claim 5 recites: “The method of claim 4, wherein the ultrasound beam is repeatedly applied until the wrinkles are visibly reduced.” *Id.* at 10:43–44.

In view of our determination that independent claim 1, as well as dependent claims 2–4, have not been shown to be unpatentable over Knowlton and the Technomed Patent Publication (Final Dec. 11–34, 36), we further determine that Petitioner has not demonstrated that dependent claim 5 is obvious over Knowlton and the Technomed Patent Publication. *See In re Fritch*, 972 F.2d 1260, 1266 (Fed. Cir. 1992) (“dependent claims are nonobvious if the independent claims from which they depend are nonobvious”).

Claim 10 as obvious over Knowlton, the Technomed patent publication, and the Technomed PCT

Claim 10 depends indirectly but ultimately from claim 1, i.e., claim 8 depends from claim 1, claim 9 depends from claim 8, claim 10 depends from claim 9. Ex. 1001, 10:53–60. Claim 10 recites: “The method of claim 9, wherein the ultrasound beam is repeatedly applied until the wrinkles are visibly reduced.” *Id.* at 10:59–60.

We previously determined that “Petitioner does not rely on the Technomed PCT to remedy the deficiency in the combination of Knowlton and the Technomed patent publication, i.e., Petitioner does not argue that the Technomed PCT discloses sending focused ultrasound into the dermis.” Final Dec., 35. On that basis, we determined that Petitioner has failed to prove by a preponderance of the evidence that the combination of Knowlton, the Technomed patent publication, and the Technomed PCT renders obvious claims 8 and 9 for the same reasons explained for the asserted ground of obviousness of independent claim 1 over Knowlton and the Technomed patent publication. *Id.* at 35–37.

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In view of our determination, we further determine that Petitioner has not demonstrated that dependent claim 10 is obvious over Knowlton, the Technomed Patent Publication, and the Technomed PCT. *See In re Fritch*, 972 F.2d at 1266 (“dependent claims are nonobvious if the independent claims from which they depend are nonobvious”).

III. ORDER

In consideration of the foregoing, it is hereby:

ORDERED that claims 1–18 have not been shown to be unpatentable on the grounds as asserted and instituted in this proceeding.

PETITIONER:

Michelle E. Armond
John B. Sganga, Jr.
Matthew S. Bellinger
KNOBBE, MARTENS, OLSON & BEAR, LLP
2mea@knobbe.com
2jbs@knobbe.com
2msb@knobbe.com

PATENT OWNER:

Sean Luner
DOVEL AND LUNER LLP
sean@dovel.com

Timothy M. Salmon
EMPIRE IP, LLC
tsalmon@empireipllc.com