

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

CARDIOVASCULAR SYSTEMS, INC.,
Petitioner,

v.

CARDIOFLOW, INC.,
Patent Owner.

Case IPR2018-01549
Patent 9,788,853

Before BARRY L. GROSSMAN, JAMES A. TARTAL, and
JAMES J. MAYBERRY, *Administrative Patent Judges*.

GROSSMAN, *Administrative Patent Judge*.

DECISION
Denying Institution of *Inter Partes* Review
35 U.S.C. §§ 312(a)(3), 314

I. INTRODUCTION

A. *Background*

Cardiovascular Systems, Inc. (“Petitioner”) filed a Petition, Paper 1 (“Petition” or “Pet.”), to institute an *inter partes* review of claims 1–15 (the “challenged claims”) of U.S. Patent No. 9,788,853 (the “853 patent”). 35 U.S.C. § 311. Cardio Flow, Inc. (“Patent Owner”) timely filed a Preliminary Response. Paper 8 (“Prelim. Resp.”). Petitioner filed an authorized Reply. Paper 9 (“Reply”). Patent Owner filed an authorized Sur-reply. Paper 10 (“Sur-Reply”).

We have jurisdiction under 35 U.S.C. § 314, which authorizes the Director of the U.S. Patent and Trademark Office to decide whether to institute an *inter partes* review to reconsider the patentability of claims in existing patents. The Board determines whether to institute a trial on behalf of the Director. 37 C.F.R. § 42.4(a).

For the reasons set forth below, upon considering the Petition, Preliminary Response, Reply, Sur-Reply, and the evidence of record, we determine that the Petition fails to identify with particularity the grounds on which each challenge to each claim is based, and the evidence that supports the grounds for each challenge to each claim. *See* 35 U.S.C. § 312(a)(3). Accordingly, we do not institute an *inter partes* review.

B. *Related Proceedings*

The parties state that there are no related proceedings. Pet. 1; Paper 5. In its Reply, however, Petitioner cites “*Cardiovascular Systems, Inc. v. Cardio Flow, Inc.*, Case No. 0:18-cv-1253-SRNKMM (D. Minn.),” which Petitioner states is litigation between Petitioner and Patent Owner “arising

from a breach of a Settlement Agreement.” Reply 1. In that suit, Petitioner “seeks a judgment declaring CSI [Petitioner in the proceeding before us] the owner and assignee of the ‘Counterweight Patents.’” Ex. 3001 ¶ 34.

The ’853 patent is included in the defined “Counterweight Patents.” *Id.* ¶ 20. Thus, Petitioner is seeking a declaration that it is the owner of the ’853 patent. At the time the Petition was filed, however, it is clear that Petitioner was *not* the owner and assignee of record of the ’853 patent. Ex. 3002. A person who is not the owner of a patent may file with the Office a petition to institute an *inter partes* review of the patent. 35 U.S.C. § 311(a); *see also First Data Corp. v. Inselberg*, 870 F.3d 1367, 1375 (Fed. Cir. 2017) (holding that a declaratory judgment plaintiff did not have standing where jurisdiction relied “on the ‘contingent future event[]’ of recovering title to the patents by having a court invalidate the assignment agreement”). In the case before us, Petitioner was eligible to file the Petition because its claim of ownership is merely contingent on future events that may never occur.

C. Asserted Grounds of Unpatentability

Petitioner challenges claims 1–15 under 35 U.S.C. § 103¹ on the following grounds:

¹ The Leahy-Smith America Invents Act (“AIA”), Pub. L. No. 112-29, 125 Stat. 284, 296–07 (2011), took effect on September 16, 2012. Because the application for the patent at issue in this proceeding has an effective filing date of January 15, 2014, the AIA version of the statute applies to this proceeding.

References	Claims
“Shturman ’633 ² in combination with Kallok ³ <i>and any one or more of</i> Narveson ⁴ , Cambronne ⁵ , Shturman ’444 ⁶ and Wulfman ⁷ ”	1–10, 12–14
“Shturman ’633 in combination with Kallok <i>and any one or more of</i> Narveson, Cambronne, Shturman ’444 and Wulfman, <i>and Liprie</i> ⁸ ”	11
“Shturman ’633 in combination with Kallok <i>and any one or more of</i> Narveson, Cambronne, Shturman ’444 and Wulfman, <i>and Campbell</i> ⁹ ”	15

Pet. 5 (emphases added). Petitioner also relies on the Declaration testimony of Morten Olgaard Jensen, Ph.D., Dr. Med. *See* Ex. 1002 ¶ 9.

Petitioner identifies the challenge as based on three grounds. Pet. 5 (listing Grounds “1,” “2,” and “3”). In fact, Petitioner asserts 45 separate and distinct grounds of unpatentability.

² U.S. Patent Appl. Publ. No. U.S. 2012/0035633, filed October 21, 2011 (Shturman ’633”) (Ex. 1010).

² U.S. Patent (“Shturman ’633”) (Ex. 1010).

³ U.S. Patent No. 8,177,801, filed March 17, 2009 (“Kallok”) (Ex. 1003).

⁴ U.S. Patent No. 8,628,550, filed February 19, 2009 (“Narveson”) (Ex. 1005).

⁵ U.S. Patent No. 9,289,230, filed September 17, 2012 (“Cambronne”) (Ex. 1006).

⁶ U.S. Patent No. 6,132,444, filed August 8, 1997 (“Shturman ’444”) (Ex. 1013).

⁷ U.S. Patent No. 5,584,843, filed December 20, 1994 (“Wulfman”) (Ex. 1004).

⁸ U.S. Patent No. 5,556,389, filed March 31, 1994 (“Liprie”) (Ex. 1016).

⁹ U.S. Patent Appl. Publ. No. U.S. 2012/0178986, filed January 6, 2012 (“Campbell”) (Ex. 1009).

For example, Petitioner’s “Ground 1” asserts unpatentability based on “Shturman ’633 in combination with Kallok *and any one or more of . . .*” the four secondary references. *Id.* (emphasis added). The combinations of references results in fifteen separate and distinct grounds asserted against each claim in Petitioner’s “Ground 1.” These fifteen separate and distinct asserted grounds are listed below¹⁰:

1. Shturman ’633, Kallok, Narveson;
2. Shturman ’633, Kallok, Narveson, Cambronne;
3. Shturman ’633, Kallok, Narveson, Shturman ’444;
4. Shturman ’633, Kallok, Narveson, Wulfman;
5. Shturman ’633, Kallok, Narveson, Cambronne, Shturman ’444;
6. Shturman ’633, Kallok, Narveson, Cambronne, Wulfman;
7. Shturman ’633, Kallok, Narveson, Shturman ’444, Wulfman;
8. Shturman ’633, Kallok, Narveson, Cambronne, Shturman ’444,
Wulfman;
9. Shturman ’633, Kallok, Cambronne;
10. Shturman ’633, Kallok, Cambronne, Shturman ’444;
11. Shturman ’633, Kallok, Cambronne, Wulfman;
12. Shturman ’633, Kallok, Cambronne, Shturman ’444, Wulfman;

¹⁰ We have eliminated duplicate permutations of the asserted grounds based on the order of cited references. The order of references is irrelevant. *See, e.g., In re Bush*, 296 F.2d 491, 496 (CCPA 1961) (“[i]n a case of this type where a rejection is predicated on two references each containing pertinent disclosure which has been pointed out to the applicant, we deem it to be of no significance, but merely a matter of exposition, that the rejection is stated to be on A in view of B instead of B in view of A, or to term one reference primary and the other secondary.”); *see also In re Cook*, 372 F.2d 563, 566 n.4 (CCPA 1967).

Figure 8 is a side, cross-section, view of a rotational atherectomy system within a blood vessel. *Id.* at 5:54–56. As shown in Figure 8, rotational atherectomy device 700 and flush tube 750 provide an atherectomy treatment to stenotic lesion 890 within blood vessel 880. *Id.* at 14:39–42. During rotation of drive shaft 710 about its axis 702, stabilization balloon 754 is in an expanded configuration, as shown in Figure 8. *Id.* at 50–52.¹¹ In this configuration, ribs 756 make contact with the inner wall of blood vessel 880 to maintain the position of balloon 754 relative to blood vessel 880 while also permitting continued blood flow past balloon 754. *Id.* at 14:52–55. Drive shaft 710 can then be rotated to cause eccentric abrasive element 740 to orbit around axis of rotation 703 of atherectomy device 700 to ablate lesion 890. *Id.* at 14:55–58.

B. Illustrative Claims

Claim 1 is the sole independent claim. It is reproduced below.¹²

1[a]. A system for performing rotational atherectomy to remove stenotic lesion material from a blood vessel of a patient, the system comprising:

[1b] an elongate flush tube defining a first lumen and a second lumen; and

¹¹ The written description refers, in error, to “balloon 756.” Ex. 1001, 14:51, 53–55. It is clear from the description of related Figure 7 that the balloon is shown at reference numeral 754 and the ribs of the balloon are shown at reference numeral 756. *See, e.g., id.* at 13:56–67; *see also id.* at 14:52 (referring to “ribs 756” in the context of Figure 8).

¹² In the Petition, Petitioner added letters to identify the clauses in claim 1. *See, e.g.,* Pet. 18 (labelling the preamble of claim 1 as clause “[1a]”). For ease of discussion and analysis of the Petition, we also have added the same lettering scheme used by Petitioner.

[1c] a rotational atherectomy device comprising:

[1d] an elongate flexible drive shaft comprising helically wound metallic filars that form a coil having a constant outer diameter, the drive shaft defining a longitudinal axis, the drive shaft configured for rotation about the longitudinal axis, the drive shaft configured to be at least partially disposed within the second lumen when the system is used for performing the rotational atherectomy;

[1e] an array of at least three spherical abrasive elements positioned adjacent to one another along the coil, the spherical abrasive elements being fixed to the drive shaft such that a center of mass of each abrasive element is offset from the longitudinal axis, each abrasive elements being spaced apart from an adjacent abrasive element by an element spacing distance; and

[1f] a metallic stability element having a cylindrical shape defining an inner diameter, the metallic stability element being fixed along the inner diameter to the helically wound metallic filars of the drive shaft, the metallic stability element having a center of mass aligned with the longitudinal axis, the stability element being distally spaced apart from a distal-most abrasive element of the spherical abrasive elements by a distal separation distance, the distal separation distance being greater than the element spacing distance;

[1g] wherein the drive shaft includes a distal extension portion extending distally beyond a distal end of the metallic stability element; and

[1h] wherein the drive shaft, the abrasive elements, and the metallic stability element rotate together about the longitudinal axis.

Ex. 1001, 15:41–16:12.

C. Asserted Unpatentability

1. Claims 1–10, 12–14

Based on “Shturman ’633 in combination with Kallok and any one or more of Narveson, Cambronne, Shturman ’444 and Wulfman”

Petitioner asserts that claims 1–10 and 12–14 would have been obvious under 35 U.S.C. § 103 based on “Shturman ’633 in combination with Kallok *and any one or more of* Narveson, Cambronne, Shturman ’444 and Wulfman.” *E.g.*, Pet. 5 (emphasis added).

Patent Owner argues that “the petition should be denied because it fails to identify ‘with particularity’ the grounds to which the challenge to each claim is based, as required by statute.” Prelim. Resp. 6 (Section heading “III”). We agree with Patent Owner.

As we explain below, for each of the fifteen asserted grounds against independent claim 1, the Petition fails to persuasively explain, with the particularity required by the applicable statute and rules, *what* would have been obvious, and *why*, for each of the fifteen separate and distinct grounds asserted against claims 1–10 and 12–14. We first set out the basic legal principles that require this conclusion.

A petition “may be considered only if . . . the petition identifies, in writing and with particularity, each claim challenged, the grounds on which the challenge to each claim is based, and the evidence that supports the grounds for the challenge to each claim.” 35 U.S.C. § 312(a)(3); *see also* 37 C.F.R. §42.104(b)(4) (requiring the petition to “specify where each element of the claim is found in the prior art patents or printed publications relied upon”); 37 C.F.R. §42.22(a)(2) (requiring “a detailed explanation of

the significance of the evidence including material facts, and the governing law, rules, and precedent”).

Section 103(a) forbids issuance of a patent when “the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.” *KSR Int’l v. Teleflex Inc.*, 550 U.S. 398, 406 (2007).

Whether a patent claiming the combination of prior art elements would have been obvious is determined by whether the improvement is more than the predictable use of prior art elements according to their established functions. *Id.* at 417. To reach this conclusion, however, it is not enough to show merely that the prior art includes separate references covering each separate limitation in a challenged claim. *Unigene Labs., Inc. v. Apotex, Inc.*, 655 F.3d 1352, 1360 (Fed. Cir. 2011). Rather, obviousness additionally requires that a person of ordinary skill at the time of the invention “would have selected and combined those prior art elements in the normal course of research and development to yield the claimed invention.” *Id.*; see also *Orexo AB v. Actavis Elizabeth LLC*, 903 F.3d 1265, 1273 (Fed. Cir. 2018) (“The question is not whether the various references separately taught components of the ’330 Patent formulation, but whether the prior art suggested the selection and combination achieved by the ’330 inventors.”). In determining whether there would have been a motivation to combine prior art references to arrive at the claimed invention, it is insufficient to simply conclude the combination would have been obvious without identifying any reason *why* a person of skill in the art would have made the

combination. *Metalcraft of Mayville, Inc. v. The Toro Co.*, 848 F.3d 1358, 1366 (Fed. Cir. 2017).

Moreover, in determining the differences between the prior art and the claims, the question under 35 U.S.C. § 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious. *Litton Indus. Prods., Inc. v. Solid State Sys. Corp.*, 755 F.2d 158, 164 (Fed. Cir. 1985) (“It is elementary that the claimed invention must be considered as a whole in deciding the question of obviousness.” (citation omitted)); *see also Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 1537 (Fed. Cir. 1983) (“[T]he question under 35 U.S.C. § 103 is not whether the differences themselves would have been obvious. Consideration of differences, like each of the findings set forth in *Graham* [*v. John Deere Co.*, 383 U.S. 1 (1966)], is but an aid in reaching the ultimate determination of whether the claimed invention as a whole would have been obvious.” (citation omitted)).

Against this general background, we consider the references, other evidence, and arguments on which the parties rely.

a) Independent Claim 1

Petitioner provides a clause-by-clause analysis of the sole independent claim, claim 1. Pet. 18–41. We first identify Petitioner’s argument and evidence on each of clauses [a]–[h] and then provide our analysis of claim 1. We follow this format because Petitioner has argued whether the elements and limitations of the various clauses would have been obvious, but does not address the ultimate determination of whether the claimed invention as a whole would have been obvious.

(1) Clauses 1[a]–1[d]

For clause 1[a], Petitioner relies solely on Shturman '633 to show that the claimed elements or limitations are disclosed in the prior art. Pet. 18–19 (“Shturman '633 discloses . . .”) (citing Ex. 1002 ¶ 43).

For clause 1[b], Petitioner relies solely on Shturman '633 to show that the claimed elements or limitations are disclosed in the prior art. *Id.* at 19 (“Shturman '633 discloses . . .”) (citing Ex. 1002 ¶ 44).

For clause 1[c], Petitioner relies solely on Shturman '633 to show that the claimed elements or limitations are disclosed in the prior art. *Id.* at 20 (“Shturman '633 discloses . . .”) (citing Ex. 1002 ¶ 45).

For clause 1[d], Petitioner relies solely on Shturman '633 to show that the claimed elements or limitations are disclosed in the prior art. *Id.* at 20–21 (“Shturman '633 discloses . . .” or “implies”) (citing Ex. 1002 ¶¶ 46–53).

(2) Clause 1[e]

For clause 1[e], Petitioner asserts that Shturman '633 discloses the claimed elements or limitations. *Id.* at 21–23 (citing Ex. 1002 ¶¶ 54–58). According to Petitioner, “it would have been obvious to modify Shturman '633 to have at least three of its abrasive elements,” as recited in clause 1[e], “as routine design choice” providing “expected results.” *Id.* at 23.

Petitioner *also* relies on Narveson for the disclosure of the elements or limitations in clause 1[e]. Pet. 23–26 (citing Ex. 1002 ¶¶ 59–62). According to Petitioner, “Narveson further teaches an orbital atherectomy device including multiple adjacent abrasive elements 130, 135, (102, 104), 140.” *Id.* at 26. Petitioner also argues that a “POSITA would recognize that Narveson’s abrasive elements are suggested to be spaced apart from each

other.” *Id.* Although Petitioner argues that having three spaced abrasive elements would have been a “routine design choice” based on Shturman ’633 alone (*id.* at 23), Petitioner also argues “the spherical abrasive element of Shturman ’633 would be predictably split into more than one spherical abrasive element or duplicated to achieve the claimed three spherical abrasive elements *following modification by Narveson* and without unexpected results” (*id.* at 26, emphasis added).

Still addressing clause 1[e], Petitioner *also* argues “[s]imilarly, Cambronne teaches an orbital atherectomy device having two or more eccentric abrading heads in spaced-apart longitudinal distribution along a flexible, elongated, rotational drive shaft.” *Id.* at 26–27 (citing Ex. 1002 ¶¶ 63–68). Petitioner argues that “Cambronne, like Narveson, discloses and relies on the application of the formula for centrifugal force and manipulation of the relevant variable described in Narveson.” *Id.* at 28. Petitioner concludes that “based on the teachings in *Cambronne alone, or in combination with the teachings of the preceding references*, the POSITA *will understand that* the principles that apply to a single eccentric abrading head also apply to more than one eccentric abrading head, for example, three or more eccentric abrading heads.” Pet. 29 (emphases added). This argument is repetitive of what Petitioner asserts is already disclosed in the “preceding references.”

Still addressing clause 1[e], Petitioner asserts “Wulfman *also* teaches a rotational atherectomy device with multiple adjacent and spaced-apart abrasive heads attached to a trifilar helically wound drive shaft.” Pet. 29 (emphasis added) (citing Ex. 1002 ¶¶ 69). Regarding the clause 1[e] elements and limitations, Petitioner asserts alternatively that (1) a “POSITA

could easily modify Shturman '633" to multiply its abrasive elements to have at least three elements, as routine design choice having no patentable distinction, and/or as taught by *at least one of* Cambronne, Wulfman, and Narveson as routine design choice" (*id.* at 30 (citing Ex. 1002 ¶¶ 70–71)), or (2) "over the collective teachings of *any or two or more*" of these same three references (*id.* at 32). The Petition fails to identify, however, what would be modified, or why, when relying on any "*two or more*" of the references.

With regard to clause 1[e], the Petition relies on *each* of Cambronne, Wulfman, and Narveson for the disclosure of *all* the recited elements and limitations. Petitioner does not sufficiently explain or show what a person of ordinary skill would have gleaned from *two or more* of these references that was not already revealed by any one of the references. We find that Petitioner's asserted ground based on *one of* Cambronne, Wulfman, and Narveson, along with Shturman '633 merely creates unnecessary duplication, and Petitioner's assertion of unpatentability based on *two or more* of these references does not satisfy the particularity required in an IPR proceeding.

The Supreme Court made clear that we apply "an expansive and flexible approach" to the question of obviousness. *KSR*, 550 U.S. at 415. But even a flexible approach has limits. Petitioner has far exceeded those limits by not stating with particularity the specific basis of the asserted grounds of patentability when relying on two or more of Cambronne, Wulfman, and Narveson to modify Shturman '633 in order to meet the limitation of clause 1[e]. If we rely on Cambronne and Shturman '633 for the disclosure of clause 1[e], the Petition does not explain with particularity why we also need Wulfman and Narveson.

(3) *Clause 1[f]*

For clause 1[f], Petitioner relies on Shturman '633, Kollok, and Shturman '444. Pet. 31–39. Petitioner asserts:

[t]he POSITA would have implemented Shturman '633 with its distal stability element having a center of mass aligned with the longitudinal axis as taught by Kollok, in combination with an eccentric abrasive head, or a system of eccentric abrading heads as in Narveson, Cambronne and/or Wulfman, as routine design choice having no patentable distinction.

Id. at 36 (citing Ex. 1002 ¶ 83).

Into this mixture of references, Petitioner also adds Shturman '444. *Id.* at 38–39. According to Petitioner, Shturman '444 “*further evidences* that shape and materials of stability elements as recited in claim 1 are merely routine design changes without patentable significance in light of the prior art and knowledge of POSITA.” *Id.* at 39 (citing Ex. 1002 ¶ 90). Petitioner concludes that “modification to have cylindrical shape would have been achieved as routine, and/or to provide appropriate surfaces in case of incidental contact.” *Id.* (citing Ex. 1002 ¶ 90).

While Petitioner labels this and other changes discussed above in other clauses as routine design changes or choices, Petitioner does not provide the particularity required by § 312(a) to support this conclusory label. Nor does Petitioner provide with particularity why a person of ordinary skill would have selectively gleaned isolated elements from six references and combined them as recited in independent claim 1.

(4) *Clause 1[g]*

Petitioner relies on Shturman '633 and Kollok for the disclosure of the elements and limitations in clause 1[g]. Pet. 40–41.

(5) *Clause 1[h]*

Petitioner asserts “Shturman ‘633, as modified by Kallok, and *one or more of* Narveson, Cambronne, Shturman ‘444 and Wulfman” discloses the elements of clause 1[h]. Pet. 41 (citing Ex. 1002 ¶¶ 92–93.

b) Discussion of Independent Claim 1

A patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art. *KSR*, 550 U.S. at 418. “[I]nventions in most, if not all, instances rely upon building blocks long since uncovered, and claimed discoveries almost of necessity will be combinations of what, in some sense, is already known.” *Id.* at 418–419. Petitioner’s argument shows that the cited references used for performing rotational atherectomy have similar common elements. Petitioner’s analysis fails to address the asserted obviousness of the invention as a whole.

We also determine that Petitioner’s assertion of 45 separate and distinct grounds, without specific supporting argument or evidence, fails to satisfy the requirements of 35 U.S.C. § 312(a)(3). For example, from our list above of the fifteen separate and distinct asserted grounds against claims 1–10 and 12–14, the ground we have labelled as “Ground 8” is based on a proposed combination of six references: Shturman ‘633, Kallok, Narveson, Cambronne, Shturman ‘444, Wulfman. The Petition fails to identify with particularity what disclosure is relied on from each of these six references, how it would be combined with the other five disclosures, and why the proposed combination would have been obvious to a person of ordinary skill in the relevant technology. Without any explanation as to what, how, and why the six references would have been combined in this

asserted Ground 8, we, and the Patent Owner, are left to speculate as to the specific details of asserted unpatentability based on combining these six references against claim 1 to arrive at the claimed invention. *See Metalcraft of Mayville*, 848 F.3d at 1367.

2. Dependent claims 2–15

The arguments and evidence presented against dependent claims 2–15, each of which depends directly or indirectly from claim 1, do not cure the deficiencies identified with the asserted grounds against claim 1.

3. Dependent Claim 11

Petitioner asserts that claim 11 would have been obvious “in view of Shturman ‘633 in combination with Kallok *and at least one or more of* Narveson, Cambronne, Shturman ‘444, Wulfman *and Liprie.*” Pet. 51–53 (emphases added).¹³ As discussed above, the combinations of references results in the same fifteen separate and distinct grounds asserted against

¹³ In stating the asserted grounds on page 5 of the Petition, Petitioner uses a comma after “Wulfman.” Pet. 5 (asserting “Ground 2” as “§ 103 Shturman ‘633 in combination with Kallok and any one or more of Narveson, Cambronne, Shturman ‘444 and Wulfman, and Liprie”). In repeating this asserted ground on page 51 of the Petition, Petitioner omits the comma after “Wulfman.” *Id.* at 51 (asserting “Shturman ‘633 in combination with Kallok and at least one or more of Narveson, Cambronne, Shturman ‘444, Wulfman and Liprie”). Omitting the comma changes the distinct reference combinations. Petitioner’s arguments for claim 11 are consistent with including a comma after “Wulfman.” Thus, we understand the fifteen grounds asserted against claim 11 to be identical to the fifteen grounds asserted against claim 1, with the addition of Liprie to each of the fifteen grounds.

claim 1 being asserted against claim 11, with the addition of Liprie to each ground.

Claim 11 depends from claim 1. Ex. 1001, 16:50–54. Petitioner states that “[t]he reference[s] and arguments applied to claim 1 are incorporated here.” *Id.* at 52. Thus, the addition of Liprie to address the specific limitations of claim 11, does not cure the lack of particularity discussed above in the context of claim 1.

4. *Dependent Claim 15*

Petitioner asserts that claim 15 would have been obvious “in view of Shturman ‘633 in combination with Kallok *and at least one or more of* Narveson, Cambronne, Shturman ‘444, Wulfman, *and Campbell.*” Pet. 56 (emphases added). As discussed above, the combinations of references results in the same fifteen separate and distinct grounds asserted against claim 1 being asserted against claim 15, with the addition of Campbell to each ground.

Claim 15 depends from claim 13, which depends from claim 1. Ex. 1001, 17:4–6. Petitioner states that “[t]he references and arguments applied to claim 13 are incorporated here.” Pet. 56. Thus, the addition of Campbell to address the specific limitations of claim 11, does not cure the lack of particularity discussed above in the context of claim 1.

D. Conclusion

Petitioner has not satisfied the requirement to state, with particularity, the grounds on which the challenge to each claim is based, and the evidence that supports the grounds for the challenge to each claim, as required by 35 U.S.C. § 312(a)(3). The Supreme Court, in *SAS Institute, Inc. v. Iancu*, 138

S. Ct. 1348 (2018), held that an *inter partes* review must institute on all challenged claims or no challenged claims. The Patent Office has further taken the position that, if instituting an *inter partes* review, the Board will institute on all challenged claims and all grounds. See U.S. Patent and Trademark Office, Guidance on the Impact of SAS on AIA Trial Proceedings, available at <https://www.uspto.gov/patents-application-process/patent-trial-and-appeal-board/trials/guidance-impact-sas-aia-trial> (Apr. 26, 2018); see also *PGS Geophysical AS v. Iancu*, 891 F.3d 1354, 1360 (Fed. Cir. 2018) (“Equal treatment of claims and grounds for institution purposes has pervasive support in SAS.”). In this proceeding, if trial were instituted, we would need to institute trial on each of the 45 asserted grounds, notwithstanding Petitioner’s failure to comply with Section 312(a)(3) for most of the asserted grounds.

On this record, and based on the particular facts of this proceeding, instituting a trial with respect to all 15 claims and on all 45 grounds would not be an efficient use of the Board’s time and resources; see *Chevron Oronite Co. v. Infineum USA L.P.*, Case IPR2018-00923, slip op. at 10–11 (PTAB Nov. 7, 2018) (Paper 9).

Moreover, instituting a trial on all challenged claims and on all grounds also is unfair to Patent Owner. As stated in *Cuozzo Speed Techs., LLC v. Lee*, 136 S. Ct. 2131 (2016):

Section 312(a)(3)’s particularity requirement is designed, at least in part, to ensure that a patent owner has sufficient notice of the challenge against which it must defend. Once *inter partes* review is instituted, the patent owner’s response—its opening brief, essentially—is filed as an opposition to the challenger’s petition. See § 316(a)(8); 37 CFR § 42.120. Thus, if a petition fails to state its challenge with particularity—or if the Patent Office

IPR2018-01549
Patent 9,788,853

institutes review on claims or grounds not raised in the petition—the patent owner is forced to shoot into the dark. The potential for unfairness is obvious.

Id. at 2154 (Alito, J., concurring in part and dissenting in part); *see Repto-Med Systems, Inc. v. EMED Techs., Inc.*, Case IPR2018-00981, slip op. at 34–37 (PTAB Nov. 2, 2018) (Paper No. 8).

Accordingly, we do not institute an *inter partes* review.

III. ORDER

In consideration of the foregoing, it is hereby:

ORDERED that, pursuant to 35 U.S.C. § 314, the Petition is denied and no *inter partes* review is instituted.

IPR2018-01549
Patent 9,788,853

PETITIONER:

Anthony Son
ason@btlaw.com

Jeffrey Stone
jstone@btlaw.com

PATENT OWNER:

Michael Hawkins
hawkins@fr.com

Craig Deutsch
deutsch@fr.com

Grace Kim
gkim@fr.com

Mike Kane
kane@fr.com