

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

C.R. BARD, INC.,
Petitioner,

v.

MEDLINE INDUSTRIES, INC.,
Patent Owner.

IPR2019-00036
Patent 9,745,088 B2

Before JOSIAH C. COCKS, MITCHELL G. WEATHERLY, and
TIMOTHY J. GOODSON, *Administrative Patent Judges*.

WEATHERLY, *Administrative Patent Judge*.

FINAL WRITTEN DECISION
35 U.S.C. § 318(a), 37 C.F.R. § 42.73

I. INTRODUCTION

A. BACKGROUND

C.R. Bard, Inc. (“Petitioner”) filed a petition (Paper 2, “Pet.”) to institute an *inter partes* review of claims 45–58, 60–74, 76–90, and 92 (the “challenged claims”) of U.S. Patent No. 9,745,088 B2 (Ex. 1001, “the ’088 patent”). 35 U.S.C. § 311. Medline Industries, Inc. (“Patent Owner”) timely filed a Preliminary Response. Paper 11 (“Prelim. Resp.”). Based on

our review of the record at that preliminary stage, we concluded that Petitioner was reasonably likely to prevail with respect to at least one of the challenged claims, and we therefore instituted *inter partes* review of all challenged claims on all the grounds set forth in the Petition. *See* Paper 18, 27–28.

Petitioner contends that the challenged claims are unpatentable under 35 U.S.C. § 103 based on the following grounds (Pet. 25–82):

Claims challenged	35 U.S.C. §	References
45–48, 50–51, 55–58, 60–64, 66–67, 71–74, 76–80, 82–83, 87–90, 92	103	Solazzo, ¹ Serany ² , Disston ³
49, 54, 65, 70, 81, 86	103	Solazzo, Serany, Disston, Salvadori ⁴
52–53, 68–69, 84, 85	103	Solazzo, Serany, Disston, Franks-Farah ⁵
55, 71, 87	103	Solazzo, Serany, Disston, Bierman ⁶

After we instituted this review, Patent Owner filed a Patent Owner Response in opposition to the Petition. Paper 36 (“PO Resp.”). Petitioner filed a Reply in support of the Petition. Paper 55 (“Reply”). Patent Owner

¹ U.S. Patent No. 7,278,987 B2 (Ex. 1005, “Solazzo”).

² U.S. Patent No. 3,329,261 (Ex. 1006, “Serany”).

³ U.S. Patent No. 3,166,189 (Ex. 1008, “Disston”).

⁴ U.S. Patent No. 5,931,303 (Ex. 1009, “Salvadori”).

⁵ U.S. Patent No. 6,840,379 B2 (Ex. 1007, “Franks-Farah”).

⁶ U.S. Patent Publication No. 2008/0249476 A1 (Ex. 1020, “Bierman”).

filed a Sur-reply. Paper 64 (“Sur-reply”). With our authorization, each party filed a brief addressing a recent decision from our reviewing court, *Fox Factory, Inc. v. SRAM, LLC*, 944 F.3d 1366 (Fed. Cir. 2019). Papers 69, 70. Patent Owner did not move to amend any claim of the ’088 patent.

We heard oral argument on January 6, 2020. A transcript of the argument has been entered in the record (Paper 71, “Tr.”).

We have jurisdiction under 35 U.S.C. § 6. The evidentiary standard is a preponderance of the evidence. *See* 35 U.S.C. § 316(e); 37 C.F.R. § 42.1(d). This Final Written Decision is issued pursuant to 35 U.S.C. § 318(a) and 37 C.F.R. § 42.73.

For the reasons expressed below, we conclude that Petitioner has failed to demonstrate by a preponderance of evidence that claims 45–58, 60–74, 76–90, and 92 are unpatentable.

B. RELATED PROCEEDINGS

The parties identified as a related proceeding the co-pending district court proceeding of *Medline Industries, Inc. v. C. R. Bard, Inc.*, Case Number 1:17-cv-07216 (N.D. Ill.) (“*Medline III* Litigation”). Pet. 82; Paper 4, 2. The parties also identify IPR2019-00035, in which Petitioner challenges claims 1, 2, 6–10, 16–19, and 25–44 of the ’088 patent, as a related matter. *Id.* Patent Owner further identifies as related matters U.S. Patent Application Nos. 15/684,787 and 15/803,383, which are continuations of the application leading to issuance of the ’088 patent. Paper 4, 2. Patent Owner further identifies U.S. Patent Application Nos. 14/265,920; 15/804,520; 15/051,964; 13/374,509; 15/640,224; and 15/703,514 as related matters because these applications “share similar disclosures and claim language” with the ’088 patent. *Id.*

C. THE '088 PATENT

The '088 patent is directed to “storage containers for medical devices, and more particularly to a storage container for a long, flexible medical implement, such as a catheter, and related medical devices.” Ex. 1001, 1:34–37. The Specification describes tray 100 shown in Petitioner’s annotated and colorized version of Figure 7, which we reproduce below.

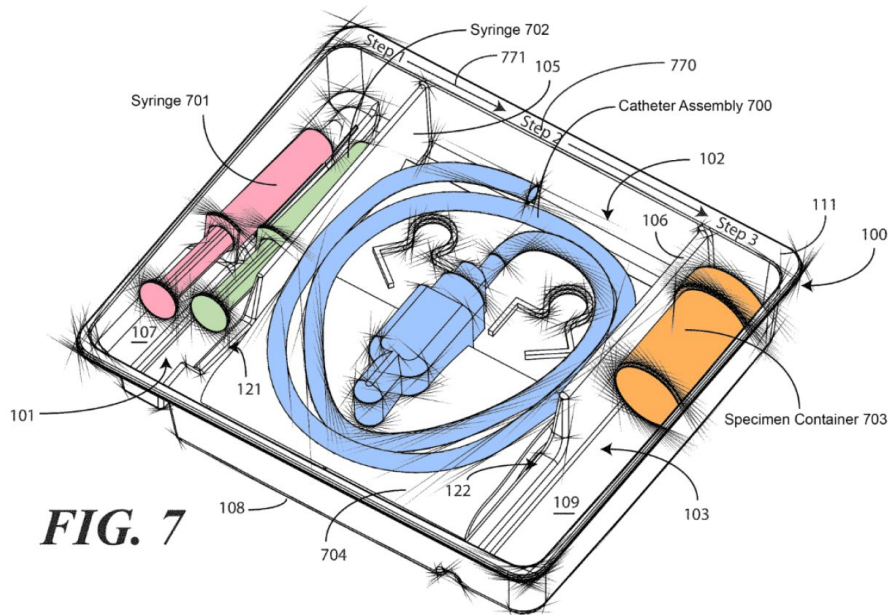


Figure 7 illustrates a catheter, two syringes, and a specimen bottle located within single-level tray 100. *Id.* at 2:45–49.

Before use, tray 100 is double-wrapped to ensure that components in the tray remain sterile up to and through their initial use with tray 100 being wrapped in CSR wrap 1000 and then outer sterile wrap 1002. *Id.* at 11:45–46; 11:51–52; Fig. 10. Tray 100 includes three compartments 101, 102, 103 adapted to receive various items used in a catheterization procedure. *Id.* at 5:12–18. First compartment 101 accommodates syringes 701, 702 (red, green) containing sterile water or lubricants. *Id.* at 4:18–21, 9:24–26. Second compartment 102 accommodates catheter assembly 700 (blue) and fluid bag. *Id.* at 9:26–28. Third compartment 103 accommodates

specimen container 703 for capturing samples taken from the patient via catheter 700. *Id.* at 4:22–23, 5:64–65. Additional objects can be included with the tray, including one or more towels, a drape to cover the patient, rubber gloves, hand sanitizing materials, swab sticks, a securement device, printed instructions, and so forth. *Id.* at 5:46–51.

Claims 45, 61, 77 are the independent claims among the challenged claims. *Id.* at 30:58–33:21. The text of each independent claim is reproduced below in Parts II.E–II.G below respectively.

II. ANALYSIS

A. CLAIM INTERPRETATION

“A claim in an unexpired patent that will not expire before a final written decision is issued shall be given its broadest reasonable construction in light of the specification of the patent in which it appears.” 37 C.F.R. § 42.100(b) (2018)⁷; *see also* *Cuozzo Speed Techs., LLC v. Lee*, 136 S. Ct. 2131, 2144–46 (2016) (affirming that USPTO has statutory authority to construe claims according to Rule 42.100(b)). When applying that standard, we interpret the claim language as it would be understood by one of ordinary skill in the art in light of the specification. *In re Suitco Surface, Inc.*, 603 F.3d 1255, 1260 (Fed. Cir. 2010). Thus, we give claim terms their ordinary and customary meaning. *See In re Translogic Tech., Inc.*, 504 F.3d 1249,

⁷ Our recently changed version of this Rule, which requires that we interpret claims in the same manner used in a civil action under 35 U.S.C. § 282(b), does not apply here because the Petition was filed before the effective date of the new Rule, November 13, 2018. *See Changes to the Claim Construction Standard for Interpreting Claims in Trial Proceedings Before the Patent Trial and Appeal Board*, 83 Fed. Reg. 51,340, 51,344 (Oct. 11, 2018).

1257 (Fed. Cir. 2007) (“The ordinary and customary meaning ‘is the meaning that the term would have to a person of ordinary skill in the art in question.’”). Only terms that are in controversy need to be construed, and then only to the extent necessary to resolve the controversy. *Vivid Techs., Inc. v. Am. Sci. & Eng’g, Inc.*, 200 F.3d 795, 803 (Fed. Cir. 1999).

Although Petitioner separately and expressly addresses various claim terms including, “barrier” and “lubricating jelly application chamber/compartment,” Pet. 22–23, we do not express an opinion about the meaning of these phrases because we determine that the controversy between the parties does not require it.

B. LEGAL STANDARDS

Petitioner challenges the patentability of claims 45–58, 60–74, 76–90, and 92 on the grounds that the claims are obvious in light of various references including: Solazzo, Serany, Disston, Salvadori, Franks-Farah, and Bierman. To prevail in its challenges to the patentability of the claims, Petitioner must establish facts supporting its challenges by a preponderance of the evidence. 35 U.S.C. § 316(e); 37 C.F.R. § 42.1(d). “In an [*inter partes* review], the petitioner has the burden from the onset to show with particularity why the patent it challenges is unpatentable.” *Harmonic Inc. v. Avid Tech., Inc.*, 815 F.3d 1356, 1363 (Fed. Cir. 2016) (citing 35 U.S.C. § 312(a)(3) (requiring *inter partes* review petitions to identify “with particularity . . . the evidence that supports the grounds for the challenge to each claim”)). This burden never shifts to Patent Owner. *See Dynamic Drinkware, LLC v. Nat’l Graphics, Inc.*, 800 F.3d 1375, 1378 (Fed. Cir. 2015) (citing *Tech. Licensing Corp. v. Videotek, Inc.*, 545 F.3d 1316, 1326–27 (Fed. Cir. 2008)) (discussing the burden of proof in *inter partes* review).

The Supreme Court in *KSR International Co. v. Teleflex Inc.*, 550 U.S. 398 (2007), reaffirmed the framework for determining obviousness as set forth in *Graham v. John Deere Co.*, 383 U.S. 1 (1966). The *KSR* Court summarized the four factual inquiries set forth in *Graham* that we apply in determining whether a claim is unpatentable as obvious under 35 U.S.C. § 103(a) as follows: (1) determining the scope and content of the prior art, (2) ascertaining the differences between the prior art and the claims at issue, (3) resolving the level of ordinary skill in the pertinent art, and (4) considering objective evidence indicating obviousness or nonobviousness. *KSR*, 550 U.S. at 406 (citing *Graham*, 383 U.S. at 17–18). In an *inter partes* review, Petitioner cannot satisfy its burden of proving obviousness by employing “mere conclusory statements.” *In re Magnum Oil Tools Int’l, Ltd.*, 829 F.3d 1364, 1380 (Fed. Cir. 2016). Thus, to prevail Petitioner must explain how the proposed combinations of prior art would have rendered the challenged claims unpatentable. With these standards in mind, we address each challenge below.

C. LEVEL OF ORDINARY SKILL IN THE ART

The parties generally agree that a person having an ordinary level of skill in the relevant art would have a bachelor’s degree in packaging engineering, mechanical engineering, or industrial design. Pet. 21 (citing Ex. 1002 ¶¶ 14–16); PO Resp. 13–14 (citing Ex. 2026 ¶ 38). Alternatively, such a person could have an engineering degree in another technical field along with about two years of experience designing medical packaging. Pet. 21 (citing Ex. 1002 ¶¶ 14–16); PO Resp. 13–14 (citing Ex. 2026 ¶ 38). Neither party contends that a person of ordinary skill needs to be a medical practitioner, but both parties agree that the person of ordinary skill would

consult with medical practitioners familiar with catheterization procedures.
Pet. 21; PO Resp. 14 (citing Ex. 2027 ¶ 78).

Although slight differences exist in the formulation of the level of ordinary skill between the parties, we discern no meaningful difference because none of those differences would affect the outcome of our analysis. Accordingly, we apply the level of skill set forth in the preceding paragraph.

D. OVERVIEW OF PERTINENT PRIOR ART

1. *Solazzo*

Solazzo is directed to an ergonomic, single layer catheterization/irrigation tray 1 having multiple compartments, including recessed area 3, compartment 27, and wells 31, 33 as shown in Figure 1, which we reproduce below. Ex. 1005, 4:15–25; Fig.1. Solazzo's Figure 1 is a perspective view of the catheterization and irrigation tray illustrating its major features. *Id.* at 3:31–33. Divider wall 17 is optional and, when present, divides recessed area 3 into two compartments, with compartment 27 being configured to receive fluid passing over top 25 of wall 17. *Id.* at 4:15–20.

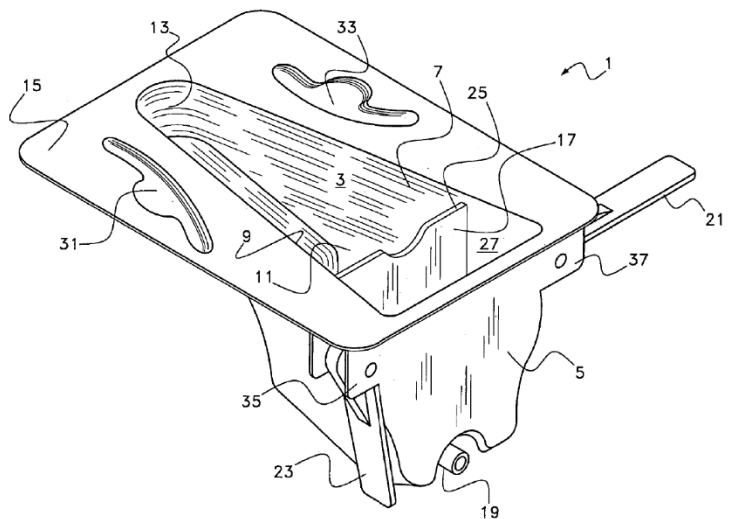
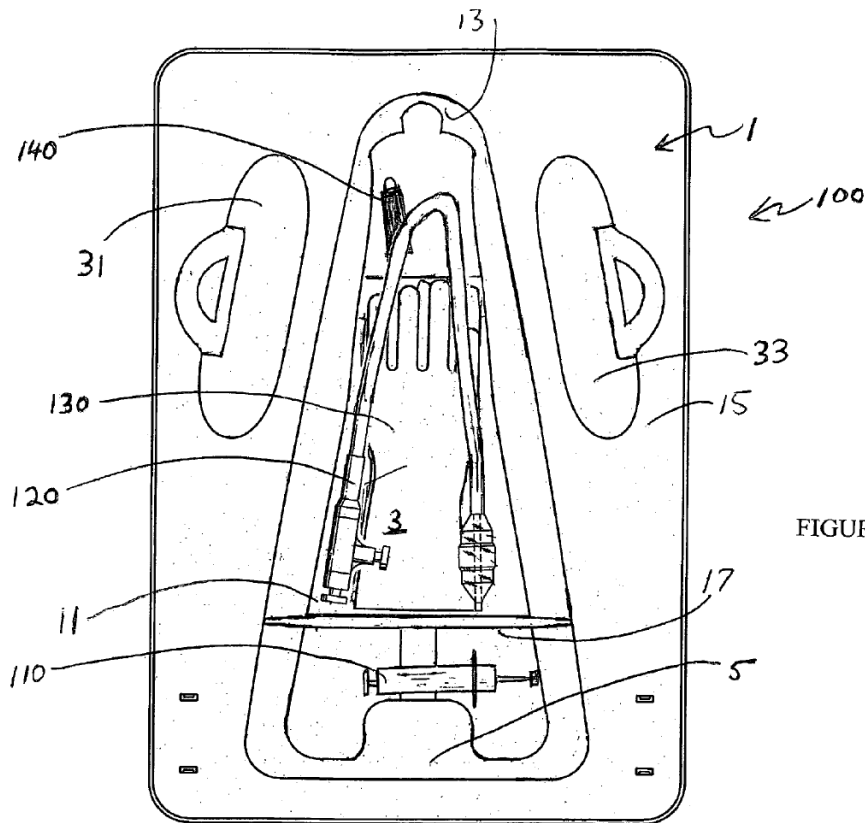
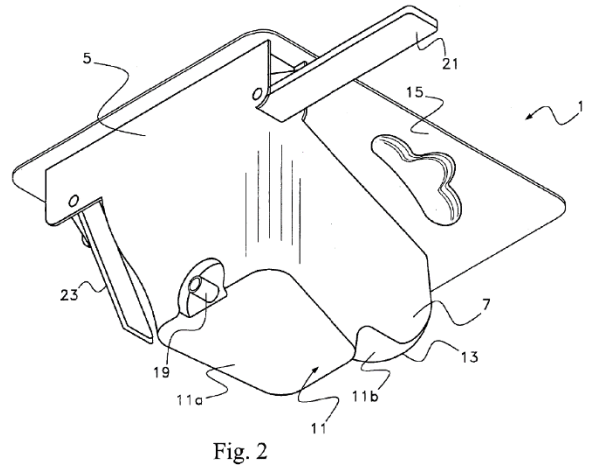


Fig. 1

Recessed area 3 is trapezoidal-shaped with a “non constant depth” provided by a terraced bottom 11 having low area 11A and shallow area 11B as shown in Figure 2, reproduced at right. *Id.* at 3:61–66; Fig. 5. Recessed area 3 and compartment 27 store medical devices of tray kit 100, including Foley catheter 120, urinary tract lubricant 140, surgical gloves 130, inflation syringe 110, irrigation syringe (not shown), evacuation tubing, and antiseptic solutions as shown in Solazzo’s Figure 8, which is a top view of kit 100 that we reproduce below. *Id.* at 3:14–24, 4:1–8; Fig. 8.



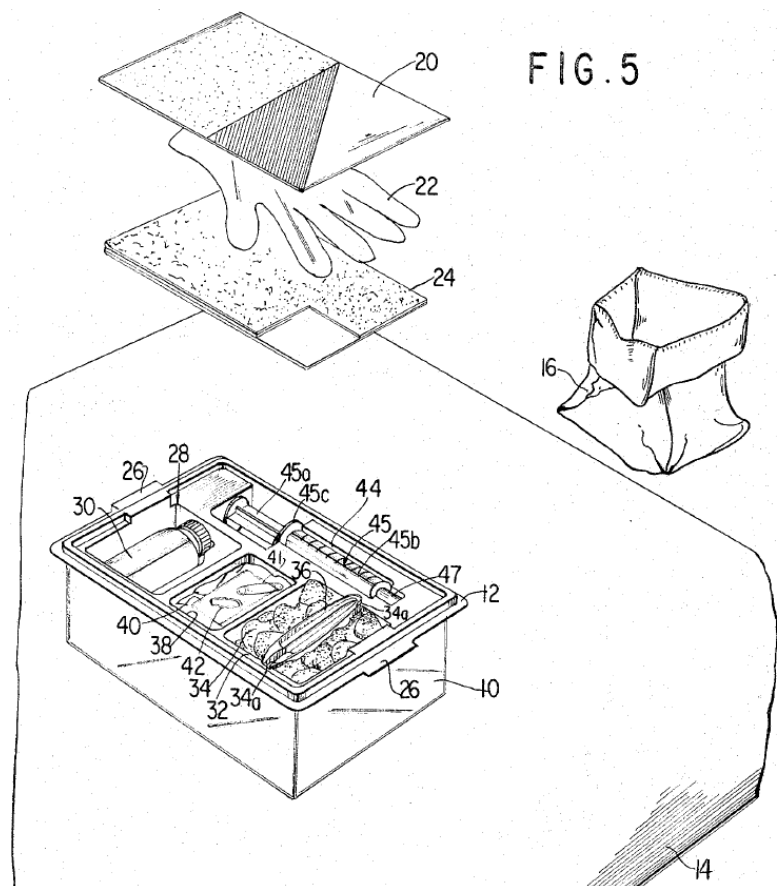
Solazzo’s Figure 8 is a top view of kit 100 illustrating various components stored in compartments of tray 1. *Id.* at 4:41–48.

Inflation syringe 110 is stored at low area 11A, and lubricant 140 is stored at shallow area 11B. *Id.* at 4:41–45; Fig. 8.

In use, the recessed area 3 and compartment 27 fit between the legs of a “patient requiring an urological procedure” while flange 15 and wing supports 21, 23 rest atop the legs while the patient is seated. *Id.* at 1:8–12, 3:66–4:10, 4:26, 4:32–33; Fig.1. A surgeon proceeds to “evacuate the bladder of its contents, urine and/or clots” using kit 100, e.g., by wearing the gloves, lubricating and inserting the catheter, and inflating it with inflation syringe 110. *Id.* at 4:32–33, 4:46–48.

2. Serany

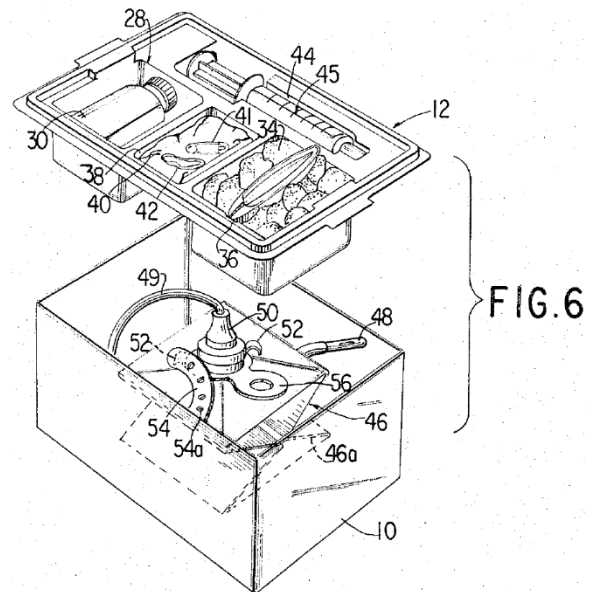
Serany is directed to a double-wrapped, sterile package providing catheterization components ready for use in the order needed. Ex. 1006, 1:8–16, 1:60–63, 3:63–4:2; Figs. 1–3, 5. Serany’s Figure 5 (reproduced at right in pertinent part) is an exploded view illustrating how various compartments are positioned within Serany’s box 10. The package includes multi-compartment single-layer tray 12 mounted on box 10 and enclosed with



sealed outer envelope 16 and inner wrap 14 that unfolds to provide a sterile field work area. *Id.* at 1:60–72, 2:17–20; Figs. 1–5.

For example, prefilled syringe 45 of sterile water in depression 44, which includes indentations 44d along the sides to accommodate the syringe's flange. *Id.* at 2:40–41, 3:6–22; Figs. 6–7. Serany's package further includes a waterproof underpad 20, gloves 22, fenestrated drape 24, cleansing solution bottle 30, rayon balls 34, forceps 36, lubricating jelly pouch 40, safety pin 41, and rubber band 42. Serany describes its package as containing "all the essential equipment, . . . for a complete catheterization procedure. . . . Everything is available in the proper order of use and in a sterile condition." *Id.* at 1:16–25.

Box 10 also includes Foley catheter 48 that is preconnected to a collapsible drainage bottle 46 via tube 49 and "ready for use" as shown in Serany's Figure 6, which is reproduced at right. *Id.* at 2:22–33, 2:57–70, 3:1–5, 3:23–26, Figs. 5–6. The collapsible drainage "bottle 46 is made of flexible plastic material having fold lines 46a . . . so that it may be folded flat for storage . . . and expanded into cube form when in use. The bottle is shown in FIG. 6 partially expanded for illustration purposes." *Id.* at 3:26–31; Fig. 6. Catheter 48 and tubing 49 are coiled in the box about bottle 46 as shown in Figure 6. *Id.* at 3:33–35.



3. *Disston*

Disston is directed to a double-wrapped catheterization tray package that “provide[s] for the first time a complete, properly organized, conveniently arranged, sterile set of equipment for catheterization, the entire drainage system being pre-assembled.” Ex. 1008, 1:59–67, 2:60–63, Figs. 2–3. The single-level tray 2 contains catheterization devices “arranged in such order and position as to be most conveniently available when the container is opened.” *Id.* at 2:15–23. The tray is slidably received in an open-ended sleeve 1 having a flap 3 folded downwardly over an edge of the tray, and further wrapped in a plastic outer envelope. *Id.* at 1:59–67, 2:23–26, Figs. 2–3.

When opened, the tray presents contents including gloves, cleansing solution, protective pad or sheet, lubricant, sterile water packet, syringe, “and most importantly, a pre-assembled catheter-drainage tube-drip chamber-drainage bag and hanger, assembly, sterile and ready for use immediately.” *Id.* at 1:26–35, 2:41–52, Fig. 1. This assembly “not only saves time and trouble but practically eliminates the danger of faulty connections and loss of sterility, inherent in the former system.” *Id.* at 1:42–46.

E. INDEPENDENT CLAIM 45

Independent claim 45 recites:

45. A medical procedure kit, comprising:

[a] a single layer tray having a first compartment for receiving syringes and a second compartment for receiving a medical assembly;

[b] a first syringe and a second syringe disposed within the first compartment;

- [c] the medical assembly disposed in the second compartment, wherein the medical assembly comprises a coiled tubing coupled between a fluid drain bag and a Foley catheter;
- [d] at least one layer of wrap material enclosing the single layer tray within one or more folds of the at least one layer of wrap material; and
- [e] an outer packaging disposed about both the single layer tray and the at least one layer of wrap material.

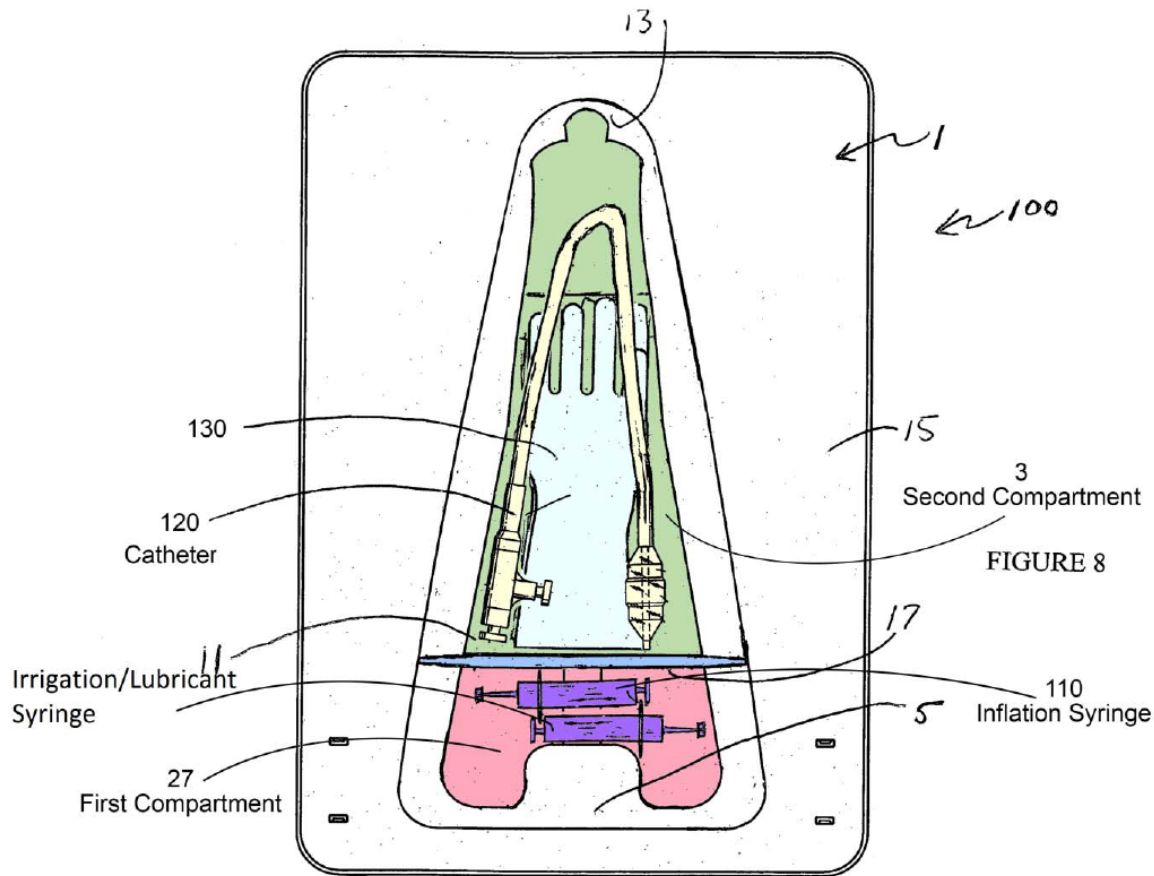
Ex. 1001, 30:58–31:5 (with added letter designations a–e to ease discussion).

Petitioner argues that claim 45 is unpatentable as obvious in view of the combined teachings of Solazzo, Serany, and Disston. Pet. 36–53. Patent Owner argues that Petitioner has failed to prove by a preponderance of evidence that the combination of Solazzo, Serany, and Disston describes elements 45b and 45c and thus fails to prove obviousness of claim 45. PO Resp. 19–35. For the reasons that follow, we agree with Patent Owner. Collectively, elements 45b and 45c require two syringes in one compartment and a medical assembly including a Foley catheter coupled to a drain bag by coiled tubing in another compartment.

Although Solazzo states that its kit contains an inflation syringe and an irrigation syringe, Solazzo does not describe where the irrigation syringe would be placed in its kit. Ex. 1005, 3:12–24. Serany describes a single syringe, its syringe 45 in its depression 44, but Serany fails to describe a second syringe. Ex. 1006, 3:6–22, Fig. 5. Disston also describes only one syringe 11. Ex. 1008, 2:41–52, Fig. 1. Based upon our review of Solazzo, Serany, and Disston, we determine that none of them describes or suggests a tray with two syringes in one compartment and the medical assembly in a different compartment as collectively required of elements 45b and 45c.

First, Petitioner contends that Solazzo expressly describes that its catheterization/irrigation tray kit includes two syringes, inflation syringe 110 and an irrigation syringe. Pet. 39 (citing Ex. 1005, 3:15–24). Although Solazzo does not expressly describe where the irrigation syringe is located within recessed area 3, Petitioner contends that compartment 27 is the “natural place to store the irrigation syringe because it already holds the inflation syringe.” *Id.* (citing Ex. 1002 ¶¶ 372–376). We are not persuaded by Petitioner’s speculation about the location of the irrigation syringe in the same compartment with the inflation syringe, especially given that Solazzo describes placing tube 140 in one compartment (recess 3) while inflation syringe 110 is placed in the other compartment (overflow compartment 27) of Solazzo’s “divider wall” embodiment. Ex. 1005, Fig. 8.

Second, Petitioner argues that it would have been obvious to place two syringes in Solazzo’s compartment 27, and provides its own illustration of such an arrangement that is modified rather extensively from Solazzo’s Figure 8. Pet. 39. We reproduce Petitioner’s modified figure below.



Petitioner’s modified version of Solazzo’s Figure 8 illustrates two syringes within compartment 27. Pet. 40; Ex. 1002 ¶ 377.

Petitioner’s argument is unpersuasive. Solazzo never expressly describes placing two syringes or even tube 140 within compartment 27. Petitioner attempts to account for this shortcoming by citing Serany’s disclosure of placing multiple balls of cleaning material in one compartment and Serany’s generalized statement that components in its kit are “arranged in logical step-by-step order.” Pet. 40 (citing Ex. 1006, 2:57–61, 1:31–35). Mr. Plishka cites the same portions of Serany as evidence for the same conclusion. Ex. 1002 ¶¶378–382. However, Serany never describes two syringes, much less how to arrange two syringes in an irrigation kit. *See* Ex. 1006, 3:6–7, Fig. 6 (describing and illustrating one syringe). Accordingly, we do not discern why the grouping of cleansing materials or

general statements about arranging components in “logical” order demonstrates the obviousness of arranging two syringes in one compartment rather than two as Solazzo expressly describes. None of the references suggest placing those two syringes in a separate compartment from the medical assembly.

Accordingly, we determine that Solazzo and Serany fail to describe the requirement of claim 45 that the first compartment contain two syringes and another compartment contain the medical assembly. Based upon our review of the parties’ arguments and the evidence of record, Petitioner fails to persuade us by a preponderance of evidence that the combined teachings of Solazzo, Serany, and Disston describe elements 45b and 45c. Accordingly, Petitioner’s challenge to independent claim 45 fails.

F. INDEPENDENT CLAIM 61

Independent claim 61 recites:

61. A medical procedure kit, comprising:

- [a] a surface defining a single layer tray having a first compartment separated by a barrier from a second compartment, the second compartment configured for receiving a medical assembly comprising a Foley catheter, a coiled tubing, and a fluid drain bag;
- [b] a first syringe and a second syringe disposed within the first compartment;
- [c] the medical assembly disposed in the second compartment;
- [d] at least one layer of wrap material enclosing the single layer tray within one or more folds of the at least one layer of wrap material; and
- [e] an outer packaging disposed about both the single layer tray and the at least one layer of wrap material.

Ex. 1001, 31:47–61 (with added letter designations a–e to ease discussion).

Petitioner argues that claim 61 is unpatentable as obvious in view of the combined teachings of Solazzo, Serany, and Disston. Pet. 62–64. Patent Owner argues that Petitioner has failed to prove by a preponderance of evidence that the combination of Solazzo, Serany, and Disston describes elements 61b and 61c and thus fails to prove obviousness of claim 61. PO Resp. 37 (cross-referencing its argument relating to elements 45b and 45c). For the reasons expressed in Part II.E above, we agree with Patent Owner. Accordingly, we conclude that Petitioner has failed to demonstrate that Solazzo and Serany render claim 61 unpatentable as obvious.

G. INDEPENDENT CLAIM 77

Independent claim 77 recites:

77. A medical procedure kit, comprising:

- [a] a single layer tray having a first compartment separated by a barrier from a second compartment configured for receiving a medical assembly;
- [b] a first syringe and a second syringe disposed within the first compartment;
- [c] the medical assembly disposed in the second compartment, the medical assembly consisting essentially of a Foley catheter coupled to a coiled tubing, wherein the coiled tubing is coupled to a fluid drain bag;
- [d] at least one layer of wrap material enclosing the single layer tray within one or more folds of the at least one layer of wrap material; and
- [e] an outer packaging disposed about both the single layer tray and the at least one layer of wrap material.

Ex. 1001, 32:35–49 (with added letter designations a–e to ease discussion).

Petitioner argues that claim 77 is unpatentable as obvious in view of the combined teachings of Solazzo, Serany, and Disston. Pet. 62–64. Patent

Owner argues that Petitioner has failed to prove by a preponderance of evidence that the combination of Solazzo, Serany, and Disston describes elements 77b and 77c and thus fails to prove obviousness of claim 77. PO Resp. 39 (cross-referencing its argument relating to elements 45b and 45c). For the reasons expressed in Part II.E above, we agree with Patent Owner. Accordingly, we conclude that Petitioner has failed to demonstrate that Solazzo and Serany render claim 77 unpatentable as obvious.

H. DEPENDENT CLAIMS 46–58, 60, 62–74, 76, 78–90, AND 92

Petitioner argues that dependent claims 46–58, 60, 62–74, 76, 78–90, and 92 are obvious in view of Solazzo, Serany, and Disston or the same combination in further view of one of Salvadori, Franks-Farah, or Bierman. Pet. 53–62 (claims 46–48, 50, 51, 55–60, 62–64, 66, 67, 71–76, 78–80, 82, 83, 87, 90, 92), 65–70 (claims 49, 54, 65, 70, 81, 86), 70–75 (claims 52, 53, 68, 69, 84, 85), 71–79 (claims 55, 71, 87).

Claims 46–58, and 60 depend ultimately from independent claim 45; claims 62–74, and 76 depend ultimately from independent claim 61, and claims 78–90 and 92 depend ultimately from independent claim 77. Because we have concluded that Petitioner has failed to demonstrate obviousness by a preponderance of evidence for any of independent claims 45, 61, and 77, we reach the same conclusion with respect to dependent claims 46–58, 60, 62–74, 76, 78–90, and 92. *See Mylan Pharms. Inc. v. Research Corp. Techs., Inc.*, 914 F.3d 1366, 1376 (Fed. Cir. 2019) (“Dependent claims, with added limitations, are generally not obvious when their parent claims are not.”) (citing *W.L. Gore & Assocs., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1555 (Fed. Cir. 1983)).

I. OBJECTIVE INDICIA OF NONOBVIOUSNESS

Because our evaluation of the first three *Graham* factors leads us to determine that Petitioner has not demonstrated that the challenged claims would have been obvious in view of the cited art, we need not determine whether Patent Owner's evidence of objective indicia of nonobviousness weighs further against a conclusion of obviousness.

The Federal Circuit has found it unnecessary to consider arguments relating to objective indicia of nonobviousness when the patent challenger failed to establish obviousness. *See Otsuka Pharmaceutical Co. v. Sandoz, Inc.*, 678 F.3d 1280, 1296 (Fed. Cir. 2012) ("Because we agree with the district court that the Defendants failed to prove that claim 12 of the '528 patent would have been prima facie obvious over the asserted prior art compounds, we need not address the court's findings regarding objective evidence of nonobviousness."); *Palo Alto Networks, Inc. v. Finjan, Inc.*, 748 F. App'x 317, 324 (Fed. Cir. 2018) ("The Board, having found that Finjan had failed to carry its burden of showing that the instituted prior art disclosed [a particular] limitation, did not reach the issue of secondary considerations of nonobviousness. Therefore, it was not necessary for the Board to consider Dr. Bims's testimony, which was limited to the issue of secondary considerations of nonobviousness.").

Accordingly, we do not reach the merits of Patent Owner's objective indicia of nonobviousness.

J. SUMMARY

Petitioner has not demonstrated by a preponderance of the evidence that any challenged claim is unpatentable as obvious.

III. CONCLUSION

Claims	35 U.S.C. §	References	Claims Shown Unpatentable	Claims Not Shown Unpatentable
45–48, 50–51, 55–58, 60–64, 66–67, 71–74, 76–80, 82–83, 87–90, 92	103	Solazzo, Serany, Disston		45–48, 50–51, 55–58, 60–64, 66–67, 71–74, 76–80, 82–83, 87–90, 92
49, 54, 65, 70, 81, 86	103	Solazzo, Serany, Disston, Salvadori		49, 54, 65, 70, 81, 86
52–53, 68–69, 84, 85	103	Solazzo, Serany, Disston, Franks-Farah		52–53, 68–69, 84, 85
55, 71, 87	103	Solazzo, Serany, Disston, Beirman		55, 71, 87
Overall Outcome				45–58, 60–74, 76–90, 92

IV. ORDER

For the reasons given, it is:

ORDERED, Petitioner has failed to establish based on a preponderance of evidence that claims 45–58, 60–74, 76–90, and 92 of U.S. Patent 9,745,088 B2 are unpatentable as obvious under 35 U.S.C. § 103; and

FURTHER ORDERED because this is a final written decision, the parties to this proceeding seeking judicial review of our Decision must comply with the notice and service requirements of 37 C.F.R. § 90.2.

IPR2019-00036
Patent 9,745,088 B2

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