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Paper 13
Date: June 3, 2020

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MED-EL ELEKTROMEDIZINISHCE GERÄTE GES.M.B.H.,
Petitioner,

v.

SONOVA AG,
Patent Owner.

IPR2020-00176
Patent 6,761,681 B2

Before PATRICK R. SCANLON, ERIC C. JESCHKE, and RICHARD H. MARSCHALL, *Administrative Patent Judges*.

MARSCHALL, *Administrative Patent Judge*.

DECISION
Granting Institution of *Inter Partes* Review
35 U.S.C. § 314

INTRODUCTION

MED-EL Elektromedizinische Geräte Ges.m.b.H. ("Petitioner") filed a Petition (Paper 1, "Pet.") requesting institution of an *inter partes* review of claims 6–9, 11, and 12 of U.S. Patent No. 6,761,681 B2 (Ex. 1001, "the '681 patent"). Sonova AG ("Patent Owner") filed a Preliminary Response. Paper 7 ("Prelim. Resp."). With our authorization (*see* Paper 9), Petitioner filed a Reply (Paper 10, "Pet. Reply"), to which Patent Owner filed a Sur-reply (Paper 12, "PO Sur-reply"). Under 35 U.S.C. § 314(a), an *inter partes* review may not be instituted "unless . . . there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition."

Upon consideration of the Petition and for the reasons explained below, we determine that Petitioner has shown that there is a reasonable likelihood that it would prevail with respect to at least one of the challenged claims. As such, we institute an *inter partes* review of all challenged claims on all presented challenges and, thus, institute an *inter partes* review of claims 6–9, 11, and 12 of the '681 patent.

BACKGROUND

A. Real Parties in Interest

Petitioner states that its real parties in interest are itself and its subsidiary MED-EL Corporation, USA. Pet. 6. Patent Owner states that its real parties in interest are itself, Advanced Bionics AG, and Advanced Bionics, LLC. Paper 8, 2.

B. Related Matters

The parties identify several related proceedings pursuant to 37 C.F.R. § 42.8(b)(2): (1) *MED-EL Elektromedizinische Geräte Ges.m.b.H. and*

MED-EL Corporation, USA v. Advanced Bionics, L.L.C., 1:18-cv-01530 (D. Del. 2018) (filed October 3, 2018) ("Delaware Litigation"); (2) IPR2019-01469 (petition filed by Patent Owner's real party in interest Advanced Bionics, LLC related to patent that "Petitioner purports to own and has asserted in the Delaware Litigation"); (3) IPR2019-01572 (petition filed by Patent Owner's real party in interest Advanced Bionics, LLC related to patent that "Petitioner purports to own and has asserted in the Delaware Litigation"); and (4) IPR2020-00190 (petition filed by Petitioner related to patent owned by Patent Owner's real party in interest Advanced Bionics AG, which has been asserted in the Delaware Litigation). Pet. 4–5; Paper 8, 2–3.

C. The '681 Patent

The '681 patent issued on July 13, 2004, from an application filed on August 14, 2001. Ex. 1001, codes (22), (45). The '681 patent relates to a "percutaneous or transcutaneous connecting device, featuring at least one passage or a passage-free connection through . . . the skin." *Id.* at code (57). "Percutaneous access ports extend in physical, mechanical fashion through the skin," while "[t]ranscutaneous access does not usually involve access hardware but often employs the induction principle, creating an electrical connection between the inside of the body and its external surroundings." *Id.* at 1:16–22. According to the '681 patent, "an objective of this invention to provide a percutaneous or transcutaneous connection with the body of a living being and especially of a human which avoids" drawbacks such as complex designs that are awkward to use and not user friendly. *Id.* at 1:30–55. The '681 patent describes the use of internal and external parts that use elongated magnets to provide the necessary coupling pressure and to align

the access ports, which allows the use of the invention with "greater ease." *Id.* at 1:58–65.

Figures 1A and 1B of the '681 patent are reproduced below.

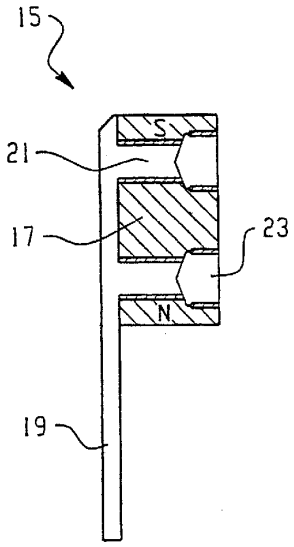

Fig. 1A

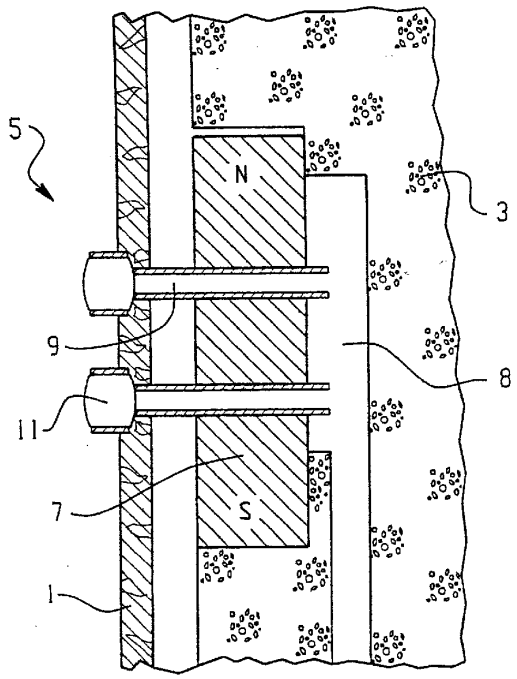

Fig. 1B

Figures 1A and 1B are "longitudinal section" views of "a percutaneous connection with separate passages." Ex. 1001, 2:15–16. Figure 1A depicts external plug-in part 15 having permanent magnet 17, two ports 21, connecting openings 23 on each end of ports 21, and intake/exit conduit 19. *Id.* at 2:40–46. Figure 1B depicts internal part 5 having "permanent magnet 7 positioned beneath the epidermis 1," and two passages 9 with flared openings 11. *Id.* at 2:26–34. Connecting openings 23 on external part 15 face and plug into flared openings 11 on internal part 5. *Id.* at 2:45–48. The Figures show the magnetic poles marked "N" and "S" on each of magnets 7, 17 extending in a direction generally parallel to epidermis 1. *Id.* at 2:29–30, 2:41–42. The conduits within both parts are

"designed as to permit the introduction of substances such as medication, nutrients and the like, as well as the withdrawal of fluids from inside the body." *Id.* at 2:53–56.

In addition to the percutaneous embodiment described above, the '681 patent discloses a transcutaneous embodiment in Figure 3, near a user's ear 31. Ex. 1001, 2:20–21, Fig. 3. The transcutaneous embodiment includes implanted part 25 having coil 27 that can receive or send electrical signals or transfer electrical energy. *Id.* at 3:19–21. Implanted part 25 also includes permanent magnet 29, "which serves to align and retain in place an external part in relation to the implanted part." *Id.* at 3:22–24. "Both the coil 27 and the permanent magnet 29 are implanted underneath the skin and are not visible from the outside," such that, "in contrast to percutaneous connections, there is no physical, mechanical passage from inside the body to the outside or from the outside to the inside of the patient." *Id.* at 3:26–31.

D. Challenged Claims

Petitioner challenges claims 6–9, 11, and 12. Pet. 7. Of those claims, claims 6, 8, 9, and 12 are independent. Ex. 1001, 4:32–6:4. Claim 6 is reproduced below.

> 6. A percutaneous or transcutaneous connecting device for providing a connection through an outer surface of a living being characterized by a permanent magnet (7, 29) adapted to be positioned in the area of the outer surface (1,3) with its poles extending essentially parallel thereto, and at least one inductive, capacitive or other passage-free connection adapted to be between inside and outside of the body of a wearer.

Id. at 4:32–49.

E. Evidence and Asserted Grounds

Petitioner asserts that claims 6–9, 11, and 12 are unpatentable on the following grounds:

Claim(s) Challenged	35 U.S.C. §	Reference(s)/Basis
6–9, 11	103(a)	Dormer,[1] Goldberg[2]
12	103(a)	Dormer, Goldberg, Ely[3]
9	102(b)	Hooven[4]

Petitioner also relies on the Declaration of David L. Trumper. Ex. 1002 ("Trumper Declaration").

ANALYSIS

A. Denial Under 35 U.S.C. § 325(d)

Patent Owner argues that we should exercise our discretion to deny institution because the Examiner already considered the substance of the references at issue here during prosecution. Prelim. Resp. 33–44.

1. Legal Background

Section 325(d) provides that, in determining whether to institute an *inter partes* review, "the Director may take into account whether, and reject the petition or request because, the same or substantially the same prior art or arguments previously were presented to the Office." The Board uses a two-part framework in determining whether to exercise its discretion under § 325(d), specifically:

> (1) whether the same or substantially the same art previously was presented to the Office or whether the same or substantially

[1] US 4,352,960, issued October 5, 1982 ("Dormer") (Ex. 1003).

[2] US 3,766,928, issued October 23, 1973 ("Goldberg") (Ex. 1004).

[3] US 3,749,853, issued July 31, 1973 ("Ely") (Ex. 1006).

[4] US 4,676,772, issued June 30, 1987 ("Hooven") (Ex. 1005).

> the same arguments previously were presented to the Office; and (2) if either condition of [the] first part of the framework is satisfied, whether the petitioner has demonstrated that the Office erred in a manner material to the patentability of challenged claims.

Advanced Bionics, LLC v. Med-El Elektromedizinische Geräte GmbH, IPR2019-01469, Paper 6, 8 (PTAB Feb. 13, 2020) (precedential).

In applying the two-part framework, we consider several non-exclusive factors, including: (a) the similarities and material differences between the asserted art and the prior art involved during examination; (b) the cumulative nature of the asserted art and the prior art evaluated during examination; (c) the extent to which the asserted art was evaluated during examination, including whether the prior art was the basis for rejection; (d) 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; (e) whether Petitioner has pointed out sufficiently how the Examiner erred in its evaluation of the asserted prior art; and (f) 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*, IPR2017-01586, Paper 8 at 17–18 (PTAB Dec. 15, 2017) (precedential as to § III.C.5, first paragraph). If, after review of factors (a), (b), and (d), we determine that the same or substantially the same art or arguments previously were presented to the Office, then factors (c), (e), and (f) relate to whether the petitioner demonstrates that the Office erred in a manner material to the patentability of the challenged claims. *Advanced Bionics*, Paper 6 at 10.

For the reasons set forth below, under the facts presented and arguments made, we decline to exercise our discretion under 35 U.S.C. § 325(d) to deny instituting trial.

2. The Prosecution History and the Parties' Positions

During prosecution, the Examiner rejected pending claims as anticipated by two different references, Hennig[5] and Kaplan.[6] Ex. 1007, 80–82; Ex. 1008; Ex. 1009. The applicant argued that Hennig discloses a device for closing an intestinal opening rather than percutaneous or transcutaneous access into the skin or body and that Kaplan does not teach magnetic poles that extend parallel to the outer surface as required by the pending claims. Ex. 1007, 96, 98. The Examiner allowed several claims after withdrawing the rejection based on Kaplan, and some of the rejections based on Hennig, but maintained an anticipation rejection based on Hennig. *Id.* at 102, 105–107. In response, the applicant filed additional amendments and argued that Hennig fails to disclose "at least one inductive, capacitive or other passage-free connection . . . between inside and outside of the body of a wearer" as required by the remaining rejected independent claim. *Id.* at 110–117. The Examiner agreed with the applicant's argument and allowed the claims after additional amendments were made to overcome additional rejections. *Id.* at 121–123, 140, 142 (Notice of Allowability). Dormer was listed on an Information Disclosure Statement during prosecution, but the Examiner did not rely on Dormer in any of the rejections. *Id.* at 66–67. Goldberg, Ely, and Hooven were not before the Examiner.

[5] US 3,952,726, issued April 27, 1976 ("Hennig") (Ex. 1008).

[6] US 4,726,378, issued February 23, 1988 ("Kaplan") (Ex. 1009).

Patent Owner argues that the *Becton, Dickinson* "factors all weigh against institution." Prelim. Resp. 34. As to the first three factors, Patent Owner argues that Dormer was considered during prosecution and that Kaplan's discussion and incorporation by reference of Dormer shows that the Examiner considered and rejected Petitioner's current Dormer-based arguments. *Id.* at 35–36. Patent Owner also argues that "there is no material difference between Dormer and Kaplan" because they "both disclose cochlear implant systems that use magnets to hold and align an external signal coil to an implanted signal coil." *Id.* at 36 (citing Ex. 1003, 1:7–16; Ex. 1009, Abstract). As to the other references not before the Examiner, Patent Owner argues that Goldberg is cumulative of Hennig because both "disclose that the ring magnets are magnetized across the magnet diameter, which the Examiner expressly noted with respect to Hennig." *Id.* at 37 (citing Ex. 1004, 3:39–42; Ex. 1007, 81; Ex. 1008, 1:28–31). Patent Owner further argues that Ely was only relied on for its sound conduit, not any magnet arrangement, and that Hooven is cumulative of Hennig because they both disclose internal magnets with "poles parallel to the skin of a patient." *Id.* at 39 (citing Ex. 1005, Fig. 7; Ex. 1008, 1:28–31, Figs. 1–2).

Petitioner argues that although Dormer was before the Examiner during prosecution, the Examiner "failed to see its importance to the patentability of the examined claims and never mentioned it." Pet. 13. Petitioner also argues that none of Goldberg, Ely, and Hooven were before the Examiner during prosecution. *Id.* at 14–16.

3. Discussion

We first consider "whether the same or substantially the same art previously was presented to the Office or whether the same or substantially

the same arguments previously were presented to the Office." *Advanced Bionics*, Paper 6 at 8.

Petitioner bases its first ground on a combination of Dormer and Goldberg. Pet. 7. Dormer was "presented to the Office" during prosecution, although never discussed; Goldberg was not before the Office and therefore was not "the same" as the prior art before the Office. Patent Owner asserts that Goldberg is merely cumulative to Hennig, which was discussed by the Examiner during prosecution, but we disagree. As the applicant pointed out during prosecution of the '681 patent, "Hennig discloses a device for closing the intestinal opening of a human body or for arranging a waste bag at the intestinal opening." Ex. 1007, 96 (citing Ex. 1008, 1:57–2:14, Figs. 1, 4). Goldberg, on the other hand, discloses a pacemaker disposed directly under a patient's skin rather than about an existing opening. *See* Ex. 1004, code (57), 3:32–37, Figs. 1, 4. Further, although Patent Owner argues that the figures of Hennig and Goldberg both disclose magnets "magnetized across the magnet diameter," Goldberg's figures more clearly show "diametrically magnetized ring magnets." Prelim. Resp. 37–38 (citing Ex. 1004, Figs. 2, 5; Ex. 1008, Figs. 1–2); Ex. 1004, 2:64–66, 4:52–53, Figs. 2, 5; Ex. 1008, Fig. 1 (showing poles adjacent one anther rather than across a diameter), Fig. 2 (showing device entering hole in middle of disc magnet)). These differences are sufficient to distinguish the potential combination before the Examiner based on Kaplan and Hennig (or Dormer and Hennig) from Petitioner's proposed combination based on Dormer and Goldberg. Based on the foregoing, we conclude that Petitioner bases its first challenge on prior art and arguments that are not the same or substantially the same as the prior art or arguments before the Examiner.

Petitioner bases its second ground on a combination of Dormer, Goldberg, and Ely. Pet. 7. For the same reasons discussed above in the context of Petitioner's first ground, a combination including Dormer and Goldberg does not present substantially the same art or arguments before the Examiner. The addition of Ely, which was not before the Examiner, further distinguishes Petitioner's art and arguments from those at issue during prosecution. Patent Owner argues that Ely "is merely added to the combination" and does not "disclose any magnet arrangement," but those statements do not suggest, much less establish, that Ely is cumulative of any art before the Examiner during prosecution. Prelim. Resp. 38–39. Petitioner relies on Ely to disclose claim 12's "conduit," a limitation added to obtain allowance of the claim. Pet. 47; Ex. 1007, 137–138, 140. Patent Owner does not argue that any prior art or arguments before the Examiner already addressed the claimed "conduit," and Ely's addition to the combination distinguishes the art and arguments in this challenge from those before the Examiner.

As to Petitioner's third ground based on anticipation by Hooven, Patent Owner argues that Hooven is cumulative of Hennig. Pet. 8; Prelim. Resp. 39. Hooven discloses a device for use on a patient's head that distinguishes it from Hennig's device in the area of an intestinal opening. *See* Ex. 1005, Fig. 1; Ex. 1008, Fig. 1. Hooven also expressly discloses extracting fluid from the brain, which is relevant to claim 9's "withdrawal of medication, samples or other substances" language, while Patent Owner does not point to any similar disclosure in Hennig. *See* Ex. 1005, 3:30–40; Prelim. Resp. 39. We conclude that Petitioner's ground based on Hooven

does not present the same or substantially the same art or arguments as those before the Examiner.

Based on the foregoing, we determine that none of the grounds in the Petition rely on the same or substantially the same prior art or arguments as the art and arguments before the Examiner. Accordingly, the first part of the framework set forth in *Advanced Bionics* is not met. We need not reach "whether the petitioner has demonstrated that the Office erred in a manner material to the patentability of challenged claims." *Advanced Bionics* at 8–9.

4. Conclusion

After considering the framework set forth in *Advanced Bionics* and the appropriate *Becton, Dickinson* factors, the particular circumstances of this case do not indicate that we should exercise our discretion under § 325(d) to deny institution.

B. Denial Under 35 U.S.C. § 314(a) Based on the Delaware Litigation

Patent Owner argues that we should deny institution under § 314(a) because a trial on the issues here is scheduled in the Delaware Litigation just prior to our deadline to issue a final decision in this matter. Prelim. Resp. 26–33. Institution of an *inter partes* review under 35 U.S.C. § 314(a) is discretionary. *See* 35 U.S.C. § 314(a) (stating "[t]he Director *may not* authorize an *inter partes* review to be instituted unless the Director determines that the information presented in the petition . . . shows that there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition" (emphasis added)); *Cuozzo Speed Techs., LLC v. Lee*, 136 S. Ct. 2131, 2140 (2016) ("[T]he agency's decision to deny a petition is a matter committed to the Patent Office's

discretion."). The Board will consider the advanced state of a district court proceeding as a "factor that weighs in favor of denying the Petition under § 314(a)." *NHK Spring Co. v. Intri-Plex Techs., Inc.*, IPR2018-00752, Paper 8 at 20 (PTAB Sept. 12, 2018) (precedential); *see also Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 at 5–6 (PTAB March 20, 2020) (precedential) (listing factors that the Board has considered when the patent owner raises an argument for discretionary denial due to the advanced state of a parallel proceeding).

Patent Owner contends that the Delaware Litigation involves the same prior art and parties and "is scheduled for (no more than) a 10-day jury trial on May 10, 2021, before this Board would be statutorily required to issue a final written decision in this proceeding." Prelim. Resp. 26. Patent Owner also argues that "instituting review here would not be an efficient use of the Board's resources and would not serve the objective of providing an effective and efficient alternative to district court litigation." *Id.* at 26–27. As to the schedule in the Delaware Litigation, Patent Owner contends that a "*Markman* hearing will be held March 27, 2020," a "*Markman* decision will issue no later than May 27, 2020," and a series of deadlines follow those dates, leading to the May 2021 trial date. *Id.* at 32 (citing Ex. 2010, 14; Ex. 2011, 2). Patent Owner also argues that Petitioner unreasonably waited four months after filing its invalidity contentions before filing the Petition here. *Id.* at 33.

In its Reply, Petitioner argues that "[i]n the advent of the COVID19 crisis, the *Markman* hearing originally scheduled for March has been rescheduled twice since the filing of [Patent Owner's Preliminary Response], and is currently scheduled to be held June 2, 2020." Pet. Reply

2. Petitioner asserts that the *Markman* decision will not issue by May 27, as Patent Owner alleges, and that the trial currently set for May 10–21, 2021 has not been addressed. *Id.* Petitioner asserts that a final decision in this case will issue "far in advance of post-trial motions and even the trial itself should the schedule be delayed." *Id.* As to the alleged four-month delay in filing the Petition, Petitioner argues that the delay was necessary to determine which claims to challenge in the Petition. *Id.* at 1. More specifically, Petitioner asserts that it needed to view Patent Owner's amended infringement contentions to determine whether Patent Owner would continue to assert claim 12 against Petitioner after Petitioner set forth its basis for an invalidity challenge under 35 U.S.C. § 112. *Id.*

In its Sur-reply, Patent Owner argues that "any ruminations about the trial date moving is speculative" and that the parties' substantial work on document production and *Markman* briefing show that the case is not in its preliminary stages. PO Sur-reply 2–3. As to Petitioner's delay, Patent Owner asserts that Petitioner proffers no credible reason to support its assertion that Patent Owner may no longer assert claim 12, and does not address the potential prejudice of litigating "validity issues in parallel in two fora." *Id.* at 1–2.

In *NHK*, the trial in the district court proceeding was set to conclude six months before a final Board decision would be due. *See NHK*, Paper 8 at 20. Here, however, the trial date in the Delaware Litigation has been set to begin on May 10, 2021, less than one month before the deadline for a final decision in this case. Ex. 2010. We decline to speculate as to when a trial in the related district court proceeding will occur. While Petitioner plausibly suggests that the trial may run through May 21, 2021, and will be

followed by post-trial motions and a related decision that will not issue until after our final decision in this case, we need not speculate as to the length of the trial and the time necessary for any post-trial procedures. Given the minimal amount of overlap between the currently scheduled trial and the deadline for a decision in this proceeding—a few weeks—this factor strongly weighs in favor of instituting *inter partes* review.

We address briefly the other factors set forth in the precedential *Fintiv* Order.[7] As to the first factor, we have no evidence in the record before us that the district court has granted a stay, or that the district court has commented on the possibility of a stay in this case. Thus, this factor is neutral. The third factor weighs against discretionary denial because the parties and the court have not invested substantial effort on the substantive issues in the district court case at this stage. For instance, the district court has not yet held a claim construction hearing or issued a claim construction order. As to the fourth factor, the parties do not dispute that overlap exists between the invalidity issues in this case and in the district court. This overlap may inure to the district court's benefit, however, by simplifying issues for trial should we reach our determination on the challenges raised in the Petition before trial. Finally, the fact that the defendant in the district court and the petitioner in this case are the same parties weighs slightly in favor of denial. On balance, the factors in this case weigh against discretionary denial. Based on the foregoing, we decline to exercise our discretion under 35 U.S.C. § 314(a).

[7] The *Fintiv* Order was designated precedential on May 5, 2020, after briefing was complete.

C. Level of Ordinary Skill in the Art

Petitioner contends that a person having ordinary skill in the art would have had "the equivalent of a Bachelor of Science degree in electrical engineering, mechanical engineering or physics or a related discipline with course work in electromagnetics, and two years' experience designing or developing electromagnetic devices." Pet. 17–18 (citing Ex. 1002 ¶ 24). Patent Owner states that "[f]or purposes of this proceeding, Patent Owner does not dispute MED-EL's proposed definition, except to note that a POSA may have a Bachelor of Science degree in a range of fields including a degree in the field of physiology or bioengineering, along with two or three years of experience." Prelim. Resp. 18. Patent Owner also asserts that "[a]dditional education might compensate for a deficiency in experience, and vice-versa." *Id.*

For purposes of this Decision, we preliminarily adopt Petitioner's asserted level of ordinary skill because it is consistent with the problems addressed by the '681 patent and the prior art of record and Patent Owner agrees with the proposal for purposes of this proceeding. While not currently disputing Petitioner's proposal, Patent Owner sets forth an additional "note" that would broaden the proposal in potentially material ways. Prelim. Resp. 18. During trial, Patent Owner should make clear whether it disputes Petitioner's proposal and, if so, on what basis. In addition, both parties should address whether our adoption of either parties' proposals would alter the outcome of any of the issues in this case.

D. Claim Construction

We interpret claims in the same manner as in a civil action under 35 U.S.C. § 282(b) "including construing the claim in accordance with the

ordinary and customary meaning of such claim as understood by one of ordinary skill in the art and the prosecution history pertaining to the patent." 37 C.F.R. § 42.100(b) (2019). Only terms that are in controversy need to be construed, and then only to the extent necessary to resolve the controversy. *Nidec Motor Corp. v. Zhongshan Broad Ocean Motor Co.*, 868 F.3d 1013, 1017 (Fed. Cir. 2017).

Petitioner proposes constructions for several claim terms: "in the area of the outer surface" (claims 6, 8, and 9), "inductive, capacitive or other passage-free connection adapted to be between inside and outside of the body of a wearer" (claim 6), and "at least one conduit" (claim 12). Pet. 18–23. Patent Owner does not dispute Petitioner's proposed construction for "in the area of the outer surface" at this time because it "does not appear to impact any issue in" the Petition. Prelim. Resp. 19. Patent Owner provides competing constructions for the remaining terms. *Id.* at 19–23. Patent Owner also argues that the preamble to claim 9 limits the claim. *Id.* at 23–25.

Based on the parties' apparent agreement, we will apply Petitioner's proposed construction for "in the area of the outer surface," which means "near the skin or the bone adjacent the skin." Pet. 18–19. Although Petitioner did not expressly address whether the preamble to claim 9 limits the claim, Petitioner assumed that it did so for purposes of setting forth its challenges to claim 9, and we will do the same for purposes of this Decision. *See* Pet. 31 ("This preamble requires any of three alternatives."), 50–51 (asserting that Hooven discloses the requirements of the preamble). The parties are free to further address these issues during the trial.

We will address the parties' competing proposals for the construction of "inductive, capacitive or other passage-free connection adapted to be between inside and outside of the body of a wearer" in the context of our discussion of claim 6 below. We will address the parties' competing proposals for the construction of "at least one conduit" in the context of our discussion of claim 12 below. Based on the record before us, we need not expressly construe any claim terms to resolve the issues presented in this Decision.

E. Obviousness of Claims 6–9 and 11 Based on Dormer and Goldberg

Petitioner challenges claims 6–9 and 11 under 35 U.S.C. § 103 based on Dormer and Goldberg. Pet. 24–28. For these challenges, Petitioner cites to the asserted references and the Trumper Declaration. *Id.*

For the reasons discussed below, Petitioner has shown that there is a reasonable likelihood that it would prevail with respect to independent claim 6.

1. Legal Standard

A claim is unpatentable as obvious under 35 U.S.C. § 103(a) if the differences between the claimed subject matter 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 Co. v. Teleflex Inc.*, 550 U.S. 398, 406 (2007). The question of obviousness is resolved on the basis of underlying factual determinations, including: (1) the scope and content of the prior art; (2) any differences between the claimed subject matter and the prior art; (3) the level of skill in the art; and (4) where in evidence, so-called

secondary considerations. *Graham v. John Deere Co. of Kansas City*, 383 U.S. 1, 17–18 (1966).

2. Overview of Dormer

Dormer relates to "a bio-electronic signal coupling device (such as a hearing aid having a cochlear implant unit and a sound receiving unit) utilizing rare-earth magnets to properly align and secure an external member (such as a sound receiving unit) with an internal member (such as a cochlear implant unit)." Ex. 1003, 1:10–16. Dormer states that "it is desirable that there be no mechanical connection which extends through the skin of the user between the internal and external units." *Id.* at 1:66–2:1. Dormer discloses a "transcutaneous coupling apparatus" having magnets associated with a first member under the skin and a second member just outside a user's skin in order to magnetically secure the members. *Id.* at 2:33–38, 2:68–3:8. Dormer's Figure 1 is reproduced below.

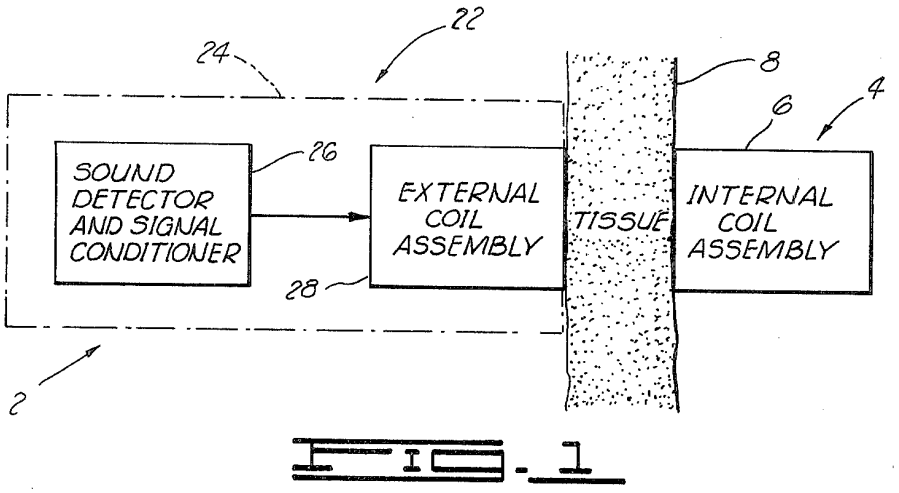

FIG. 1

Figure 1 "is a schematic illustration and block diagram of a preferred embodiment of the present invention." Ex. 1003, 3:29–30. Figure 1 depicts hearing aid 2 having internal first member 4 shown as internal coil assembly 6, which in the preferred embodiment is a cochlear implant unit including an

electronic receiver. *Id.* at 3:55–59. "[I]nternal coil assembly 6 is subcutaneously located beneath a layer of tissue 8[,] which includes the epidermal and dermal layers of the skin." *Id.* at 3:65–67. Figure 1 also depicts second member 22, which includes signal generating and transmitting means 24, which in turn includes sound detector and signal conditioner means 26 and external coil assembly 28." *Id.* at 4:16–22. Signal conditioner means 26 includes microphone 30, which detects sound and converts it into an electrical signal that is then amplified and modulated before "electromagnetic transmission transcutaneously through the intervening tissue 8." *Id.* at 4:38–53, Fig. 4.

Dormer discloses two embodiments for magnetically coupling the internal and external members. In the first embodiment, magnet 38 in the middle of pot-type core-half 20 of the internal member and a similar magnet in the external member couple the two members together. Ex. 1003, 5:8–13, 5:21–27, Fig. 2. In that embodiment, "[t]he magnetic coupling arises by placing attractive poles of the first and second magnets toward each other so that the magnetic lines of force extend through the intervening tissue 8 to retain the internal and external coil assemblies in alignment adjacent the intervening skin." *Id.* at 5:27–32. In a second embodiment, two separate magnets 44, 46 are disposed in each of the first and second members. *Id.* at 6:32–47, Fig. 5. According to Dormer, with this configuration, "misalignment is less likely to occur once the first and second members are magnetically coupled." *Id.* at 6:48–51. In addition to these two embodiments, Dormer states that "a ring magnet disposed along the periphery of the pot-type core-half could be used." *Id.* at 7:35–36.

3. Overview of Goldberg

Goldberg discloses a pacemaker having "a pacer rate adjustment mechanism which utilizes magnetic coupling." Ex. 1004, code (57). Goldberg's mechanism enables a user to adjust the "rate-controlling potentiometer" in the device from outside the patient. *Id.* Potentiometer 16 includes a shaft that, when turned, controls the pacer rate. *Id.* at 3:20–24. Goldberg discloses the potentiometer's shaft coupled to magnet 30 within housing 20, such that rotation of magnet 30 adjusts the pacer rate. *Id.* at 3:22–26. Magnet 30 "is in the form of a disc with a central hole, and it is magnetized diametrically," i.e., "the north and south poles of the magnet are at opposite ends of one of its diameters." *Id.* at 3:38–42, Fig. 2.

Goldberg discloses two methods of rotating shaft 30 and in turn modifying the pacer rate. In the first embodiment, a user can rotate magnet 30 by placing an external magnet, larger than magnet 30, "on the patient's skin in the vicinity of the pacer and then rotating it." *Id.* at 4:15–18; *see also id.* at Fig. 1 (showing pacer unit, including housing 20 that encloses magnet 30, for use in first embodiment), Fig. 2 (showing diametrically magnetized magnet 30). The poles of the rectangular external magnet are at opposite ends of its longest dimension. *Id.* at 4:10–13. In the second embodiment, Goldberg employs a second diametrically magnetized disc magnet 52 disposed just outside housing 20, with the north and south poles of magnets 30, 52 "disposed adjacent to each other" so that "[i]f magnet 52 is turned, magnet 30 turns with it." *Id.* at 4:51–53, 4:63–67, Figs. 4–5. Figure 5 "depicts the face-to-face relationship of the two diametrically magnetized disc magnets." *Id.* at 2:64–66. In this embodiment, both magnets are disposed under a patient's skin and are turned by inserting a needle through

the patient's skin and into axial bore 56a "so that when the needle is turned the disc and the embedded magnet [52] turn with it." *Id.* at 4:53–56.

4. Discussion of Claim 6

a) Disclosure of the Limitations of Claim 6

Petitioner asserts that the combination of Dormer and Goldberg discloses all limitations of claim 6. Pet. 24–28. Petitioner provides analysis of each limitation in claim 6, with citations to the references that correspond to each of the claim limitations. *Id.* Petitioner also cites to the relevant declarant testimony. *Id.* (citing various portions of Ex. 1002). Petitioner asserts that Dormer discloses all of the limitations of claim 6 with the exception of the orientation of the poles of the magnet "extending essentially parallel" to the outer surface of a living being, and relies on Goldberg for that limitation. *Id.* at 24 (citing Ex. 1002 ¶ 63). Although Patent Owner argues against the combination of Dormer and Goldberg, Patent Owner does not argue that the combination fails to disclose any specific limitation of claim 6. Prelim. Resp. 44–55.

The preamble of claim 6 states: "A percutaneous or transcutaneous connecting device for providing a connection through an outer surface of a living being." Petitioner asserts that Dormer discloses a "transcutaneous coupling device" with internal and external units allowing transfer of electrical signals via electromagnetic induction. Pet. 24–25 (citing Ex. 1003, code (57), 1:29–34, 2:63–66; citing Ex. 1002 ¶ 64). To the extent that the preamble limits the claim, Petitioner establishes sufficiently, based on the current record, that Dormer's transcutaneous coupling device discloses the claim terms recited in the preamble. *See id.*

Claim 6 requires "a permanent magnet (7, 29) adapted to be positioned in the area of the outer surface (1,3)." Petitioner argues that Dormer discloses magnets just above and below the surface of the skin of a patient. Pet. 25 (citing Ex. 1003, 2:69–3:5, 7:29–36). Petitioner also argues that the pot-type core-half Dormer employs was widely known in the industry, with the magnets located in the central portion or about the periphery as taught by Dormer. *Id.* at 25–26 (citing Ex. 1002 ¶¶ 65–66; Ex. 1012; Ex. 1014, 1:10–11). Petitioner establishes sufficiently that, based on the current record, Dormer discloses magnets positioned in the area of the outer surface. *See id.* at 25–26; Ex. 1002 ¶¶ 65–66.

Claim 6 requires that the magnet has "its poles extending essentially parallel thereto," i.e., essentially parallel to the outer surface. Petitioner argues that Dormer suggests use of a ring magnet along the periphery of a pot-type core-half and Goldberg discloses magnets that are magnetized diametrically. Pet. 26 (citing Ex. 1003, 7:35–36; Ex. 1004, 2:63–65, 3:39–42, Figs. 2, 5). Petitioner argues that when implementing the diametrically magnetized ring magnets of Goldberg on Dormer's connecting device, the magnets are attracted to one another, and will sandwich the skin tissue between the parts as in Dormer, if they are parallel to one another and the skin surface. *Id.* at 27 (citing Ex. 1002 ¶ 67) (illustrating modified version of Dormer by placing Goldberg's ring magnets directly adjacent tissue 8). Based on the current record, Petitioner establishes sufficiently that Dormer, when modified by adding Goldberg's diametrically magnetized magnets, discloses a magnet with "its poles extending essentially parallel" to the outer surface. *See id.* at 26–27; Ex. 1002 ¶ 67.

Claim 6's final limitation requires "at least one inductive, capacitive or other passage-free connection adapted to be between inside and outside of the body of a wearer." Petitioner argues that Dormer discloses electromagnetically inductive transmission between the coils in the internal and external parts. Pet. 27–28 (citing Ex. 1002 ¶ 64; Ex. 1003, 3:65–4:4, 4:23–24, 4:58, 5:26–27). Based on the current record, Petitioner establishes sufficiently that Dormer discloses an inductive connection between the inside and outside of the body that meets the requirements of this limitation.

Petitioner and Patent Owner offer competing constructions on the meaning of this claimed "inductive, capacitive or other passage-free connection." Petitioner argues that the limitation means "a paired relationship between an implanted element interacting via energy with an external element without a physical passage between the inside and outside of the body." Pet. 19–21. Patent Owner argues that it means "connection via electrical or electromagnetic signals and/or electrical energy that takes place without physical passages." Prelim. Resp. 19–21. Patent Owner asserts that Petitioner's construction improperly attempts to encompass magnetic energy to bolster its reliance on Goldberg. *Id.* at 19. We need not resolve this dispute at this time because, as noted above, Petitioner relies on Dormer as disclosing this limitation, not Goldberg, and we do not view Petitioner's arguments for the proposed combination as turning on whether Goldberg also discloses this limitation. We invite the parties to address these issues further during trial, if necessary.

Based on the foregoing, Petitioner has established a reasonable likelihood that it would prevail in showing that the combination of Dormer and Goldberg discloses all limitations of claim 6.

b) The Proposed Combination

Petitioner argues that Dormer and Goldberg both disclose implantable devices that employ magnetic coupling, and "fall within the field of transcutaneous connecting devices as identified in the preamble of the '681 patent claims." Pet. 35 (citing Ex. 1003, 1:7–9). Petitioner also argues that Dormer discloses all aspects of claim 6 with the exception of whether to orient the poles parallel or perpendicular to the skin, which were well known approaches in the art. *Id.* at 36 (citing Ex. 1002 ¶ 76; Ex. 1010, 25). Petitioner notes that a "horseshoe magnetization could have been considered" as well, leaving a finite number of orientations that would have been considered by one of ordinary skill in the art to implement the ring magnet embodiment Dormer describes. *Id.* Petitioner contends that implementing Goldberg's diametrically magnetized magnets, with the poles lined up parallel to the skin, "would have been one of just a finite number of practical predictable orientations." *Id.* at 37 (citing Ex. 1002 ¶ 77). Petitioner also argues that the proposed combination merely involves prior art elements "arranged according to known methods to yield predictable results." *Id.* at 38 (citing Ex. 1002 ¶¶ 38, 78–80; Ex. 1010, 155; Exs. 1012–1013).

Petitioner further argues that Dormer provides motivation for diametric magnetization by teaching the use of multiple, oppositely-polarized magnets on each of the internal and external parts to achieve proper alignment of the parts, and that approach would lead to the diametrically magnetized approach if applied to Dormer's ring magnet. *Id.* at 39–41 (citing Ex. 1002 ¶¶ 40–41, 81–82; Ex. 1003, 5:21–44, 7:1–29, 7:34–35). Petitioner contends that "[o]rienting the magnetization as taught

by Goldberg is further motivated by Dormer's explanation for achieving a single predetermined alignment." *Id.* at 41–42 (citing Ex. 1002 ¶¶ 83–84; Ex. 1003, 7:1–5; Ex. 1004, Fig. 5).

Patent Owner makes several arguments against the combination of Dormer and Goldberg. First, Patent Owner argues that Petitioner improperly combines Goldberg's two embodiments without providing a reason to combine those embodiments. Prelim. Resp. 44–49. According to Patent Owner, Petitioner indiscriminately cites to both embodiments, but Goldberg's embodiments are not interchangeable. *Id.* at 45–46. Second, Patent Owner argues that because Dormer already discloses a functional magnet solution, one of ordinary skill in the art would not look to Goldberg to alter that solution. *Id.* at 50–53. Patent Owner contends that Petitioner "identifies nothing wrong with Dormer's designs that requires modification" and Dormer already provides a solution to the alleged problem of aligning the internal and external parts using multiple magnets. *Id.* at 50–52. Third, Patent Owner argues that Petitioner fails to establish that one of ordinary skill in the art would have sought to combine Dormer with either of Goldberg's embodiments. *Id.* at 53–56. According to Patent Owner, Goldberg's first embodiment requires an external magnet too large to work in Dormer, and the second embodiment places both magnets beneath the skin, contrary to Dormer's approach. *See id.*

As to Patent Owner's first argument, we agree that Goldberg discloses two embodiments that are not interchangeable, but we disagree that Petitioner relies on a combination of those embodiments and, therefore, must provide a reason to combine those embodiments. Patent Owner appears to recognize this point when it acknowledges that "the Petition does not even

argue that features from these different embodiments are combined." *Id.* at 49. We read the Petition as relying on Goldberg only for its teaching of diametrically magnetized magnets that have poles running parallel to the patient's skin, which would result in magnets having poles running parallel to the skin if applied to Dormer's device. *See* Pet. 26–27. Petitioner does cite to both embodiments of Goldberg, but both embodiments disclose diametrically magnetized magnets, and adding such a magnet from *either* embodiment of Goldberg to Dormer results in the disclosure of all of the limitations of claim 6, which only requires a single magnet. *See id.* Petitioner did not allege, and based on the current record had no need to rely upon, some unarticulated combination of Goldberg's embodiments.

As to Patent Owner's second and third arguments, we note that the arguments are premised on numerous unsupported assumptions as to how persons of ordinary skill in the art would interpret Dormer and Goldberg and seek to modify Dormer based on Goldberg's teachings. *See* Prelim. Resp. 50–56. None of these assertions are supported by declarant testimony, and on this record the assertions amount to unsupported attorney argument. Petitioner, on the other hand, supports its interpretations of the references and the reasons for combining Dormer and Goldberg with declarant testimony. *See* Pet. 35–43 (citing Ex. 1002). We need not resolve these issues at this time, but we note that Dormer's disclosure of a functional device, standing alone, does not establish that one of ordinary skill in the art would not have sought to modify it, and the Petition does not appear to propose incorporating Goldberg's large magnet, or two magnets disposed beneath the skin, to Dormer. The parties may address these issues further during trial.

Based on the current record, Petitioner establishes sufficiently that one of ordinary skill in the art at the time of invention would have been motivated to modify Dormer with the teachings of Goldberg in the manner Petitioner proposes.

c) Conclusion

Based on our review of the current record, Petitioner has established sufficiently that the combination of Dormer and Goldberg discloses all limitations of claim 6 and that one of ordinary skill in the art would have been motivated to modify Dormer based on the teachings of Goldberg. Accordingly, we determine that Petitioner has demonstrated a reasonable likelihood that it would prevail with respect to claim 6.

5. Claims 7–9 and 11

We have also reviewed Petitioner's challenge to claims 7–9 and 11 based on the Dormer/Goldberg combination. Pet. 28–35. Aside from Patent Owner's arguments we address above in the context of claim 6, Patent Owner does not address Petitioner's arguments and evidence as to these claims. Based on our review of Petitioner's arguments and evidence for these claims, we determine that Petitioner has demonstrated a reasonable likelihood that it would prevail in showing claims 7–9 and 11 to be unpatentable under 35 U.S.C. § 103 based on Dormer and Goldberg.

F. Obviousness of Claim 12 Based on Dormer, Goldberg, and Ely

Petitioner challenges claim 12 under 35 U.S.C. § 103 based on Dormer, Goldberg, and Ely. Pet. 43–50. For these challenges, Petitioner cites to the asserted references and the Trumper Declaration. *Id.*

Ely discloses a hearing aid with a directional microphone system. Ex. 1006, code (57). Ely's microphone system 14 includes a "front-to-back sound conduit 21" defined by microphone casing 24. *Id.* at 3:12–16, Fig. 1.

Petitioner asserts that the Dormer/Goldberg combination discloses all of the limitations of claim 12 with the exception of the final limitation requiring "at least one conduit extending through the external part." Pet. 43–47. As to the conduit limitation, Petitioner relies on Ely's disclosure of a conduit extending through its hearing aid. *Id.* at 47 (citing Ex. 1006, 3:13–16, 5:14–15). Petitioner also argues that one of ordinary skill in the art would have reasons to combine Ely with the Dormer/Goldberg combination. *Id.* at 48–50 (citing Ex. 1002 ¶¶ 87–89; Ex. 1006, 1:45–47, 2:30–31, 3:12–16). Patent Owner argues that Ely fails to disclose the claimed "conduit," but does not address the reasons for the proposed combination with Ely. Prelim. Resp. 56–58.

The parties contest the proper construction of "at least one conduit" in claim 12. Petitioner contends that the phrase means "a pipe, tube, or the like for conveying water or other fluid." Pet. 21–23. Patent Owner contends that the phrase means "at least one channel or passage providing access to physical substances or electrical signals and energy." Prelim. Resp. 21–22. We are not persuaded by either construction based on the current record, but we are not persuaded that the term requires construction. The claim simply refers to a "conduit," without any qualification or suggestion that the conduit must convey anything specific. The '681 patent discloses "flexible tubing" in external part 15, including intake/exit conduit 19, which is consistent with an ordinary meaning for conduit and the first portion of Petitioner's construction, which encompasses a "tube." *See* Ex. 1001, 2:40–45, Fig. 1A.

Neither party establishes sufficiently, based on the current record, that we should construe "conduit" to require conveying anything specific. At this stage of the proceeding, Petitioner establishes sufficiently that Ely's sound conduit in a hearing aid discloses the claimed conduit in the claim's external part. *See* Ex. 1006, 3:13–16.

We recognize that the '681 patent describes uses for intake/exit conduit 19 that include conveying medication, but claim 12, unlike the other claims, only refers to a "transcutaneous connecting device" and "transcutaneous access through a skin surface" rather than a percutaneous device seemingly more amenable to introducing substances. *See* Ex. 1001, 2:53–57 (describing "introduction of substances such as medication, nutrients and the like" in the context of percutaneous embodiment shown in Figure 1A), 5:15–16. It does not appear that the '681 patent describes conveying substances through any conduits in a transcutaneous embodiment. In that sense, a broader construction that encompasses the physical structure of a conduit, not what it must convey, may be more appropriate and consistent with the context of claim 12, if any construction is necessary at all.

While we are not persuaded to adopt either parties' construction of "conduit" based on the current record, we note that Ely may still disclose a "conduit" under either construction. For example, the portion of Petitioner's construction stating that the conduit conveys "water or other *fluid*" may cover a sound conduit conveying sound waves through the *air*. *See* Pet. 23 (emphasis added); Prelim. Resp. 56–57. Patent Owner's construction covers a passage providing "access to . . . electrical signals and energy," which may cover access to sound waves transmitted through a hearing aid. Prelim.

Resp. 21–22. We have not made any final determinations on these issues, but if the parties press the same claim constructions during trial, they should address the issues discussed above as well as the manner in which the constructions may, or may not, cover Ely's sound conduit.

Based on the foregoing, Petitioner has established a reasonable likelihood that it would prevail in showing that the combination of Dormer, Goldberg, and Ely discloses all limitations of claim 12. We have also reviewed Petitioner's reasons to combine the references, and determine that Petitioner has established a reasonable likelihood that it would prevail in showing that one of ordinary skill in the art would have been motivated to modify Dormer based on the teachings of Goldberg and Ely. Accordingly, we determine that Petitioner has demonstrated a reasonable likelihood that it would prevail with respect to claim 12.

G. Anticipation of Claim 9 Based on Hooven

Petitioner challenges claim 9 under 35 U.S.C. § 102(b) based on Hooven. Pet. 8, 50–53. For these challenges, Petitioner cites to the asserted references and the Trumper Declaration. *Id.* at 50–53.

1. Legal Standard

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. Inc., v. Union Oil Co.*, 814 F.2d 628, 631 (Fed. Cir. 1987). Moreover, "[b]ecause the hallmark of anticipation is prior invention, the prior art reference—in order to anticipate under 35 U.S.C. § 102—must not only disclose all elements of the claim within the four corners of the document, but must also disclose those elements 'arranged as in the claim.'" *Net MoneyIN, Inc. v. VeriSign, Inc.*, 545 F.3d 1359, 1369

(Fed. Cir. 2008). Whether a reference anticipates is assessed from the perspective of an ordinarily skilled artisan. *See Dayco Prods., Inc. v. Total Containment, Inc.*, 329 F.3d 1358, 1368 (Fed. Cir. 2003) ("[T]he dispositive question regarding anticipation [i]s whether *one skilled in the art* would reasonably understand or infer from the [prior art reference's] teaching that every claim element was disclosed in that single reference.").

2. Overview of Hooven

Hooven relates to an intracranial pressure relief valve used to maintain a desired pressure. Ex. 1005, 1:6–7, 3:29–31. Hooven discloses use of "non-invasively adjustable intracranial pressure relief valve 12" to drain fluid from a patient's head using catheter 17 in the brain and drain catheter 22 outside the brain. *Id.* at 3:32–45. Valve 12 and drain catheter 22 are implanted under a patient's skin, between skull 24 and scalp 25. *Id.* at 3:48–51. Drain catheter 22 leads away from valve 12, with its opposite end discharging into the patient's body, such as heart 23 or the patient's peritoneal cavity. *Id.* at 3:44–48. Hooven discloses use of external bar magnet 75 on the skin of the patient adjacent valve 12. *Id.* at 6:6–21. The poles of magnet 75 extend from its ends and line up with similar poles in magnetic wrench 70 in valve 12, such that rotating magnet 75 turns magnetic wrench 70 and adjusts valve 12. *Id.* at 5:50–59, 6:6–21.

3. Discussion

Petitioner argues that Hooven discloses the preamble of claim 9, which covers "introduction or withdrawal of . . . substances into or from inside a living being." Pet. 50. Petitioner relies on intracranial pressure relief valve 12, catheter 17, and catheter 22, and argues that Hooven's draining of fluid from the brain "involves withdrawal of substances inside a

living being." *Id.* at 50–51 (citing Ex. 1002 ¶ 91; Ex. 1005, 3:30–40). Petitioner also argues that Hooven's magnetic wrench 70 discloses the claimed "permanent magnet" and bar magnet 75 discloses the claimed "external functional element" that controls the drainage of fluid from the brain and adheres to magnetic wrench 70 during use. *Id.* at 51–53 (citing Ex. 1002 ¶¶ 93–95; Ex. 1005, 5:50–59, 6:6–21).

Patent Owner argues that Hooven does not anticipate because it does not disclose the preamble of claim 9 or the limitation requiring "percutaneous or transcutaneous feed-through, transmission or placement." Prelim. Resp. 58–61. Patent Owner asserts that Hooven's movement of fluid from inside the brain to another location within a patient's body does not amount to withdrawal "from inside a living being" as required by the preamble. *Id.* at 58–59. Patent Owner also argues that "percutaneous or transcutaneous feed-through" in the body of the claim refers to the same requirement of the preamble and requires "'feed-through' to occur through or across a skin surface," and Hooven does not disclose "movement of substances through or across a skin surface." *Id.* at 60–61.

The parties appear to agree that Hooven discloses withdrawal of fluid from the brain, as well as movement of that fluid to another area of the body, and that the fluid does not leave the patient's body. Resolution of the dispute here turns on what the preamble and related limitation in the body of the claim encompass, not merely whether the preamble limits the claim, and neither party fully addresses the issue on the current record. Petitioner implicitly takes the position that Hooven need not disclose withdrawal of the fluid from the patient's body because the claim covers "transcutaneous" withdrawal, which does not involve a physical passage through the skin. *See*

Pet. 51 (citing Ex. 1002 ¶ 91); Ex. 1001, 1:16–21, 3:26–31. Patent Owner's argument relies on the claim language, which arguably calls for physical access through the skin in order to withdraw fluid from a patient's body as Patent Owner contends. Prelim. Resp. 58–61. But Patent Owner does not explain how one can remove fluids entirely from the body or meet the "feed-through" requirement transcutaneously, as the claim contemplates, without physical access through the skin, or point to any transcutaneous embodiment in the '681 patent that performs this task. *See id.* Because Hooven discloses transcutaneous withdrawal of a fluid from one area inside a living being, based on the current record, Petitioner establishes sufficiently that Hooven discloses the preamble of claim 9 and the limitation requiring "percutaneous or transcutaneous feed-through."

Based on our review of the current record, Petitioner has established sufficiently that Hooven discloses all limitations of claim 9. Accordingly, we determine that Petitioner has demonstrated a reasonable likelihood that it would prevail with respect to this challenge to claim 9.

CONCLUSION

Because Petitioner has shown that there is a reasonable likelihood that it would prevail with respect to at least one of the challenged claims, we institute an *inter partes* review of all challenged claims on all presented challenges.

At this stage of the proceeding, the Board has not made a final determination as to the patentability of any challenged claims or any underlying factual and legal issues.

ORDER

In consideration of the foregoing, it is hereby:

ORDERED that, pursuant to 35 U.S.C. § 314(a), an *inter partes* review of claims 6–9, 11, and 12 of U.S. Patent No. 6,761,681 B2 is instituted with respect to all grounds set forth in the Petition; and

FURTHER ORDERED that, pursuant to 35 U.S.C. § 314(c) and 37 C.F.R. § 42.4(b), *inter partes* review of U.S. Patent No. 6,761,681 B2 shall commence on the entry date of this Order, and notice is hereby given of the institution of a trial.

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