

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

C.R. BARD, INC.,
Petitioner,

v.

MEDLINE INDUSTRIES, INC.,
Patent Owner.

Case IPR2015-00514
Patent 8,678,190 B2

Before JOSIAH C. COCKS, JENNIFER MEYER CHAGNON, and
TIMOTHY J. GOODSON, *Administrative Patent Judges*.

GOODSON, *Administrative Patent Judge*.

DECISION
On Request for Rehearing
37 C.F.R. § 42.71

I. INTRODUCTION

On July 10, 2015, C.R. Bard, Inc. (“Petitioner”) filed a Request for Rehearing (Paper 12, “Req. Reh’g”) of our Decision to Institute (Paper 10, “Dec.”), which instituted *inter partes* review of claims 1–7, 9, and 11–13 of U.S. Patent No. 8,678,190 B2 (“the ’190 patent”), but denied institution as to claims 10 and 14–18.

For the reasons set forth below, the request for rehearing is *denied*.

II. LEGAL STANDARD

Under the rules governing requests for rehearing on a decision whether to institute a trial, the decision is reviewed for an abuse of discretion. 37 C.F.R. § 42.71(c). “The burden of showing a decision should be modified lies with the party challenging the decision.” 37 C.F.R. § 42.71(d). Further, “[t]he request must specifically identify all matters the party believes the Board misapprehended or overlooked, and the place where each matter was previously addressed in a motion, an opposition, or a reply.” *Id.*

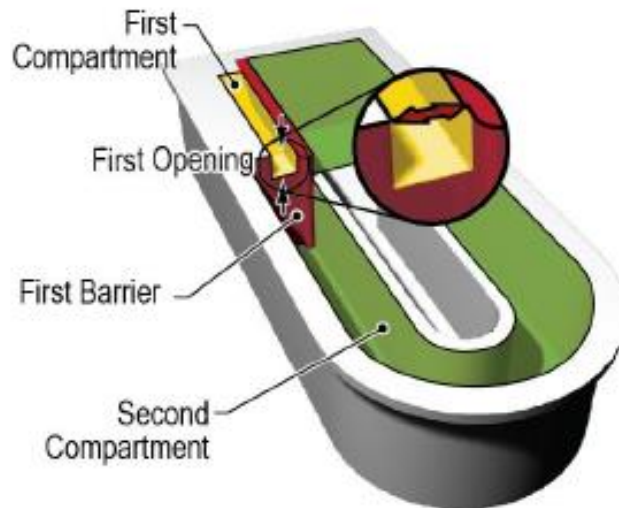
III. ANALYSIS

Petitioner argues that rehearing should be granted because, in denying institution on the Petition’s challenge to claims 10 and 14–18, we misapprehended or overlooked Petitioner’s argument regarding why Brezette satisfies the “first barrier” element of claims 10 and 14–18. Req. Reh’g 2.

Independent claim 15, from which claims 16–18 depend, as well as claims 10 and 14, all recite “an opening in a first barrier separating the first compartment from the second compartment.” Ex. 1001, col. 22, ll. 12–15, 41–43, 63–65. In challenging the patentability of claims 10 and 14–18, the

Petition relied on Brezette as disclosing this limitation. *See* Pet. 44–47. The Decision determined that the Petition did not make a sufficient showing that Brezette teaches this limitation. In reaching that determination, the Decision considered the portions of Brezette that Petitioner pointed to as corresponding to the claimed “first compartment,” “second compartment,” “first barrier,” and “opening,” as illustrated in a rendering of Brezette’s tray included in the Petition. Dec. 18–19.

For convenience, Petitioner’s rendering of Brezette’s tray is reproduced below:



Pet. 45.

The Decision noted that Petitioner’s expert, Dr. Kimmel, testified that the red double-sided arrow in the rendering is the claimed “opening” and “the barrier [is] the wall between the first and second compartment.”

Dec. 19 (quoting Ex. 1002 ¶ 109). But the Decision found that “Brezette’s Figures 1–3, as well as Petitioner’s perspective drawing, show no separation between the lubrication channel 15 and the neighboring portion of the tray, which Petitioner points to as the claimed ‘second compartment.’” *Id.*

The Request argues that the analysis in the Decision overlooked or misunderstood Petitioner’s argument that Brezette “disclosed this element in the form of a reverse L-shaped barrier.” Req. Reh’g 2. The Request quotes testimony from Dr. Kimmel’s declaration that the first barrier is “on the right hand side of the first compartment and turning the corner along the front of the first compartment.” *Id.* (quoting Ex. 1002 ¶ 104) (emphasis omitted). The Request contends that “[b]y using one color, red, the drawing in the Petition clarifies what Brezette discloses—that both portions of the reverse L-shape are part of the ‘first barrier.’” *Id.* at 4.

The Request does not persuade us that we overlooked or misapprehended Petitioner’s argument concerning this limitation. Nowhere in the Petition’s discussion of this limitation does the Petition assert that Brezette’s barrier has a reverse L-shape, as the Request now contends. *See* Pet. 44–47. Paragraphs 108–09 of Dr. Kimmel’s declaration, which the Petition cites in the discussion of this limitation, also make no reference to an L-shaped barrier in Brezette. Rather, as noted above, Dr. Kimmel’s testimony cited in the Petition is that the claimed barrier in Brezette’s tray is “the wall between the first and second compartment.” Ex. 1002 ¶ 109.

The Request relies on paragraph 104 of Dr. Kimmel’s declaration, but the Petition does not cite that paragraph in discussing this limitation. *See* Pet. 44–47. And Petitioner cannot reasonably expect that the Board would navigate its own way to paragraph 104 of Dr. Kimmel’s 134-page declaration in analyzing this limitation of claims 10 and 14–18 of the ’190 patent, particularly because the headings in Dr. Kimmel’s declaration indicate that paragraph 104 pertains to claim 1 of U.S. Patent No. 8,631,935,

an entirely different patent than the '190 patent that is the subject of this proceeding.

With respect to the argument in the Request that the color red in the rendering clarifies that the entire red portion is part of the “first barrier,” neither the Petition nor paragraphs 108–09 in the Kimmel declaration explain that the coloring carries that significance. Because the Petition did not articulate the position that both of the portions colored red in Petitioner’s rendering of Brezette together constitute the claimed “first barrier,” the Decision did not overlook or misapprehend that argument.

Moreover, even if the Petition had articulated such an argument, the argument is not persuasive. The face of the wall at the front of Brezette’s lubrication channel 15 is a separate and distinct structure from the wall along the right side of lubrication channel 15. In Figure 1 of Brezette, the portion of Brezette’s tray along the right side of lubrication channel 15 is shown to protrude past the face of the wall at the front of lubrication channel 15. Ex. 1010, Fig. 1. Neither the Petition nor Petitioner’s Request includes any explanation as to why these two distinct features of Brezette should be considered together as the claimed “first barrier.”

Aside from the two features in Brezette being structurally distinct from one another, there also is no apparent reason why a skilled artisan would consider the face of the wall at the front of lubrication channel 15 to be part of a “barrier separating the first compartment from the second compartment.” The face of the wall at the front of lubrication channel 15 does nothing to separate lubrication channel 15 from any other compartment of the tray. Only the wall along the right side of lubrication channel 15 separates lubrication channel 15 from a neighboring compartment.

Accordingly, the wall along the right side of lubrication channel 15 is the only feature that a skilled artisan would consider to be a barrier separating lubrication channel 15 and the neighboring compartment. We are not persuaded that a skilled artisan would understand *both* of the portions shown in red in Petitioner's rendering of Brezette's tray as *together* being the claimed "first barrier."

Further, neither of the two features individually can be considered a "first barrier" according to the claim limitation requiring "an opening in a first barrier separating the first compartment from the second compartment." The face of the wall at the front of Brezette's lubrication channel 15 cannot be considered the claimed barrier because the space between lubrication channel 15 and the neighboring portion of the tray in front of lubrication channel is entirely open, without any separation. *See* Ex. 1010, Figs. 1–3. The portion of Brezette along the right side of lubrication channel 15 cannot be considered the claimed barrier because it is completely solid and does not include an opening, as the claim limitation requires.

For the foregoing reasons, Petitioner has not shown that the Board abused its discretion in declining to institute on Petitioner's challenges to claims 10 and 14–18.

IV. CONCLUSION

Petitioner has not carried its burden of demonstrating that the Board misapprehended or overlooked any matters in connection with the Decision to Institute. 37 C.F.R. § 42.71(d). Accordingly, the Request is *denied*.

IPR2015-00514
Patent 8,678,190 B2

PETITIONER:

Richard Giunta
Rgiunta-PTAB@wolfgreenfield.com

Jason Honeyman
Jhoneyman-PTAB@wolfgreenfield.com

PATENT OWNER:

Christopher Campbell
ccampbell@cooley.com

John Mills
jmills@cooley.com