

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

STRYKER CORPORATION,
Petitioner,

v.

KARL STORZ ENDOSCOPY-AMERICA, INC.,
Patent Owner.

Case IPR2015-00764
Patent 7,844,657 B2

Before KEN B. BARRETT, BRYAN F. MOORE,
and BARRY L. GROSSMAN, *Administrative Patent Judges*.

BARRETT, *Administrative Patent Judge*.

DECISION
Denying Institution of *Inter Partes* Review
37 C.F.R. § 42.108

I. INTRODUCTION

Petitioner Stryker Corporation filed a Petition (Paper 1, “Pet.”) for an *inter partes* review of U.S. Patent No. 7,844,657 B2 (“the ’657 patent”). The Petition challenges the patentability of claims 21, 22, 28–31, 35, 61, 62, 68–71, and 75 of the ’657 patent on the grounds of anticipation under 35 U.S.C. § 102(e) and of obviousness under 35 U.S.C. § 103(a). Karl Storz Endoscopy-America, Inc., the owner of the ’657 patent, filed a Corrected Preliminary Response to the Petition. Paper 10 (Prelim. Resp.). We have jurisdiction under 35 U.S.C. § 314, which provides that an *inter partes* review may not be instituted “unless . . . 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.”

After considering the information presented in the Petition, we determine that Petitioner has not established a reasonable likelihood that it would prevail with respect to any of the claims challenged in the Petition. Accordingly, we do not authorize an *inter partes* review to be instituted as to any challenged claim of the ’657 patent.

II. BACKGROUND

A. *The ’657 Patent*

The ’657 patent pertains to a system of simultaneously controlling in an operating room primary medical devices, which are connected to a surgical network, and ancillary medical devices not connectable to that network. See Ex. 1001, col. 1, ll. 11–17, col. 9, ll. 39–43, col. 12, ll. 21–23.

B. The Challenged Claims

The Petition challenges the patentability of claims 21, 22, 28–31, 35, 61, 62, 68–71, and 75. Of the challenged claims, claims 21 and 61 are independent. Illustrative claim 21 is reproduced below.

21. A system which controls ancillary medical devices, comprising:

a surgical network;

an input device, connected to said surgical network, which inputs a medical command;

a controller, connected to said surgical network, which receives the medical command and generates corresponding medical command data;

a translator, connected to said surgical network, which receives the medical command data via said surgical network and translates the medical command data;

at least one ancillary medical device not connectable to said surgical network, in communication with said translator via an ancillary network, which receives the translated medical command data and carries out the corresponding medical command; and

feedback data generated by said at least one ancillary medical device and communicated to said translator via said ancillary network.

Ex. 1001, col. 9, ll. 28–46.

C. Related Matters

The parties identify as a related proceeding regarding the '657 patent *Karl Storz Endoscopy-America, Inc. v. Stryker Corporation et al.*, Civil Action No. 3:14-cv-00876-RS (N.D. Cal. filed Feb. 26, 2014). Paper 7; Pet. 1. Petitioner additionally identifies as related matters IPR2015-00672,

IPR2015-00673, IPR2015-00674, IPR2015-00675, IPR2015-00677,
IPR2015-00678, and IPR2015-00679. Pet. 1.

D. The Asserted Grounds

Petitioner asserts the following grounds of unpatentability:

Reference[s]	Basis	Claims
Ghoduoussi ¹	§ 102(e)	21, 22, 28–31, 35, 61, 62, 68–71, and 75
Ghoduoussi and Webb ²	§ 103(a)	28 and 68
Ghoduoussi and Nazarian ³	§ 103(a)	35 and 75
Wang ⁴	§ 102(e)	21, 22, 28–31, 35, 61, 62, 68–71, and 75
Ghoduoussi and Wang	§ 103(a)	21, 22, 28–31, 35, 61, 62, 68–71, and 75
Wang and Webb	§ 103(a)	28 and 68
Wang and Nazarian	§ 103(a)	35 and 75

Petitioner relies also on the Declaration of Harold J. Walbrink, dated February 18, 2015, (Ex. 1008) in support of Petitioner’s arguments.

III. ANALYSIS

A. Claim Construction

In an *inter partes* review proceeding, we give claim terms in unexpired patents their broadest reasonable interpretation in light of the

¹ U.S. Patent No. 6,951,535 B2, iss. Oct. 4, 2005, filed Sept. 17, 2002 (Ex. 1003).

² U.S. Patent Publication No. 2001/0037366 A1, pub. Nov. 1, 2001 (Ex. 1005).

³ U.S. Patent No. 5,813,972, iss. Sept. 29, 1998 (Ex. 1006).

⁴ U.S. Patent No. 6,911,916 B1, iss. June 28, 2005, filed July 13, 2000 (Ex. 1004).

specification of the patent in which they appear. 37 C.F.R. § 42.100(b). Under that standard, we assign claim terms their ordinary and customary meaning, as understood by a person of ordinary skill in the art, in the context of the entire patent disclosure. *In re Translogic Tech., Inc.*, 504 F.3d 1249, 1257 (Fed. Cir. 2007).

On this record and for purposes of this Decision, we determine that only the claim term addressed below requires express construction.

“ancillary medical device not connectable to said surgical network”

Independent claim 21 recites an “ancillary medical device not connectable to said surgical network.” Independent claim 61 contains a similar recitation. For purposes of this Decision, we, as do the parties, treat the phrases as synonymous.

Petitioner maintains that this language means a “medical device that cannot send data to or receive data from the surgical network absent a translator.” Pet. 5. Patent Owner maintains that the language means a “medical device that is not connectable to said surgical network and is either (i) unable to communicate data to, or receive data from, a device or network without the translation of that data or (ii) a device that generates high-bandwidth data.” Prelim. Resp. 6. Thus, the parties agree that a medical device is “not connectable” to the ancillary network, within the meaning of the claims, at least when translation of the data is required. In support of their positions, both parties point to the Specification’s definition of the similar term “not compatible” as “unable to communicate data to, or receive data from, a device or network without the translation of that data.” Ex. 1001, col. 4, ll. 17–19; Pet. 5; Prelim. Resp. 6.

Patent Owner argues that the term “not connectable” is broader in that it also refers to a device that generates high bandwidth data. Prelim. Resp. 6–7. We need not reach, for purposes of this Decision, Patent Owner’s argument for a broader construction of “not connectable” because Petitioner does not assert that the pertinent limitations are satisfied by the disclosure of a high-bandwidth embodiment.

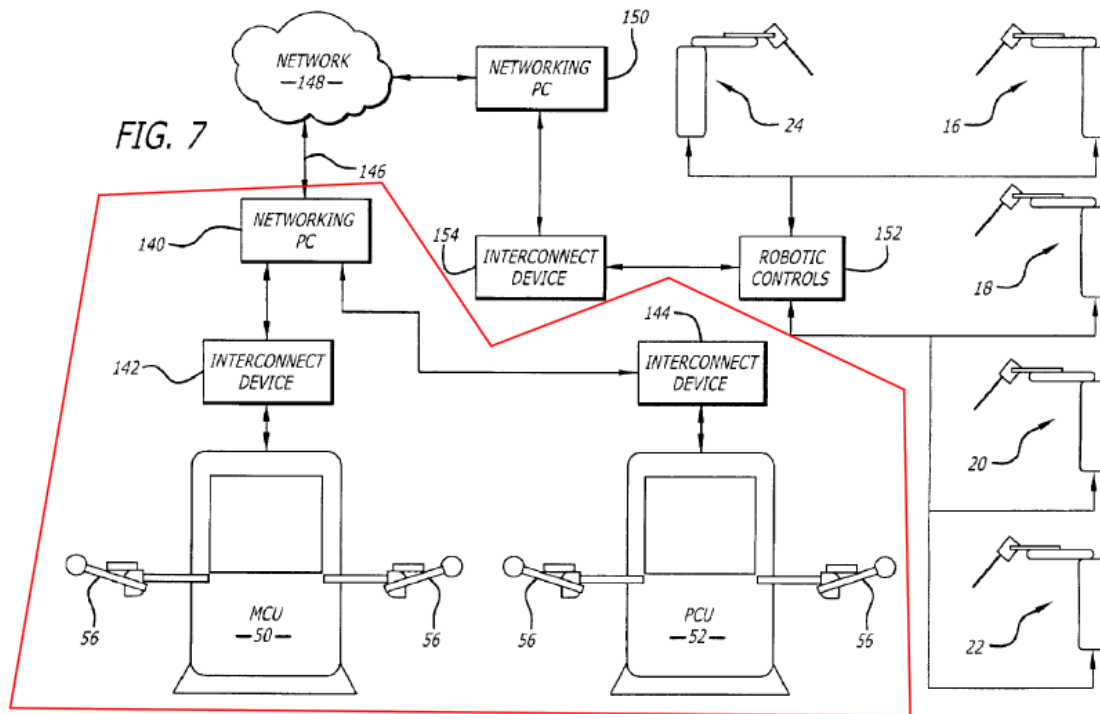
For purposes of this Decision and based on the record currently before us, we construe “ancillary medical device not connectable to said surgical network” as meaning, at least, “an ancillary device unable to communicate data to, or receive data from a surgical network without the translation of that data.”

B. Anticipation of Claims 21, 22, 28–31, 35, 61, 62, 68–71, and 75 by Ghodoussi

Petitioner argues that Ghodoussi anticipates independent claims 21 and 61 as well as certain dependent claims. Pet. 9–26. As mentioned above, both challenged independent claims 21 and 61 require a device that is not connectable to the surgical network. Patent Owner argues that this feature is missing from Ghodoussi. Prelim. Resp. 13–16.

Ghodoussi discloses a tele-medicine system involving robotically controlled medical devices, mentor control unit 50 (which may be in a remote location) and pupil control unit 52 (which may be located in the operating room). Ex. 1003, col. 2, ll. 54–57; col. 4, ll. 27–32. Petitioner maintains that the surgical network in Ghodoussi is the surgeon side of the system from networking computer 140 to the handle assemblies 56 of the control units, that the recited ancillary network is network 148, that the

ancillary medical devices are items such as articulate arms 16 and 24, and that the ancillary medical devices are connected to the ancillary network (Ghodoussi's network 148). Pet. 9, 13, 18–19, 21. An annotated version of Figure 7 of Ghodoussi is reproduced below:



The annotated version of Figure 7 is an illustration of a network system (Ex. 1003, col. 2, l. 7) with a line drawn around that which Petitioner asserts is the surgical network (Pet. 9).

Petitioner further maintains that Ghodoussi's networking computer 140 and interconnect devices 142 and 144 collectively comprise the claimed translator. *Id.* at 12, 13–14. Thus, in Petitioner's articulated ground, the

translator is within the surgical network⁵ and the signals pass without translation from that surgical network to the ancillary network, to which the ancillary medical devices are connected. *See* Ex. 1003, col. 6, ll. 26 (element 146 merely is a communication link). Petitioner argues that, because “[t]he control units 50 and 52 may provide output signals and commands that are incompatible with a computer,” the articulate arms (the ancillary medical devices) are not connectable with control units 50 and 52 absent translation. Pet. 14–15 (quoting Ex. 1003, col. 6, ll. 29–30). However, this argument is misplaced as the pertinent claim limitation is concerned with the “connectable” relationship between the ancillary device and the surgical network and Petitioner has included the purported translator within the surgical network. We determine that Petitioner has not explained adequately how the ancillary medical device is not connectable to the surgical network as required by independent claims 21 and 61.

Petitioner has not demonstrated a reasonable likelihood that it would prevail in showing that Ghodoussi anticipates independent claims 21 and 61 and the respective dependent claims 22, 28–31, 35, 62, 68–71, and 75.

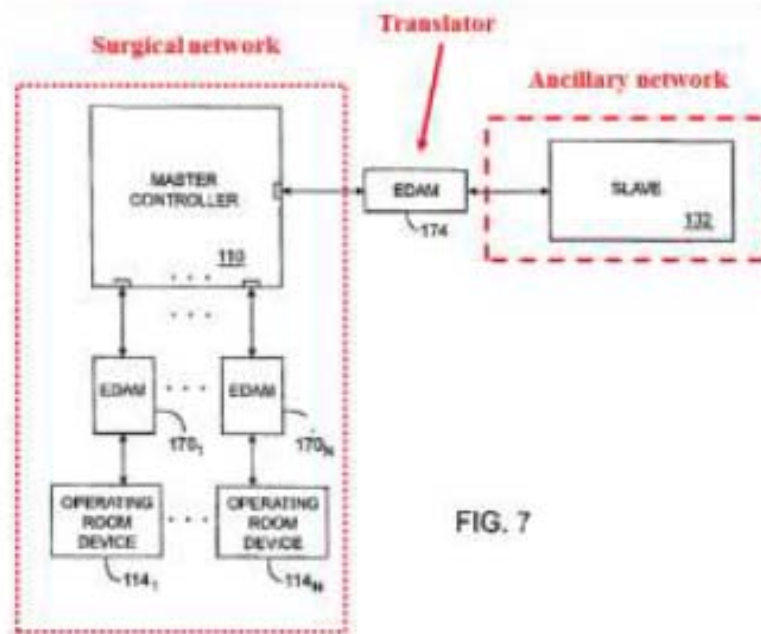
C. Anticipation of Claims 21, 22, 28–31, 35, 61, 62, 68–71, and 75 by Wang

Petitioner argues that Wang anticipates independent claims 21 and 61 as well as certain dependent claims. Pet. 35–55. As with the Ghodoussi anticipation ground, Patent Owner argues that Wang fails to disclose an

⁵ Petitioner presumably includes the purported translator in the surgical network because, without networking computer 140 and interconnect devices 142 and 144, all that remains is two non-connected control units 50 and 52.

ancillary device not connectable to the surgical network, as recited in independent claims 21 and 61. Prelim. Resp. 19–21.

Wang “relates generally to control systems, and specifically, to information control systems for accessing and integrating medical data for medical purposes.” Ex. 1004, col. 1, ll. 24–26. In Figure 6, Wang discloses master controller 110 coupled to slave device 132 via communication lines 130. *Id.*, col. 9, ll. 41–58. In Figure 7, Wang discloses the master controller and slave device coupled via module 174. *Id.*, col. 11, ll. 18–23. Petitioner provides an annotated version of Figure 7, reproduced below, to illustrate its arguments regarding the “not connectable” limitation.



The annotated version of Figure 7 depicts a logical connection between master controller 110 and the operating room devices including slave device 132, and depicts Petitioner’s annotations indicating the purported surgical network, translator, and ancillary network. Pet. 40–41; *see also*

Ex. 1004, col. 2, ll. 14–16. Petitioner maintains that the ancillary device (slave device 132) is not connectable to the surgical network (which includes, *inter alia*, master controller 110) and argues:

[this is] because the slave device can receive commands from the master controller 110 only if those commands have been translated by module 174 (i.e., the “*translator*”): “The master controller 110 issues service requests or commands 210. If a voice command received by the master controller 110 is a recognized command for querying the slave device 132 for information, the master controller 110 forwards a service request 210 (e.g., ‘get angiography information’) to the module 174. The module 174 translates and/or processes the command into a format recognized by the slave device and forwards a trigger code command 214 to the slave device 132.”

Pet. 40 (quoting Ex. 1004, col. 11, ll. 42–65) (emphasis in Petition); *see also id.* at 50–51 (claim charts quoting the same); Ex. 1008 at 58–60 (the portion of the Walbrink Declaration, paragraph 95, directed to the “not connectable” limitation).

As discussed above in the claim construction section, the parties agree that a medical device is “not connectable” to the ancillary network, within the meaning of the claims, at least when translation of the data is required. *See* Pet. 5; Prelim. Resp. 6. Patent Owner persuasively argues that “Wang does not disclose that all commands from the master controller 110 must be translated in order to be received by the slave device 132.” Prelim. Resp. 20.

The above-quoted material from Wang may arguably address the “ancillary medical device . . . which receives the translated medical command data” language of claims 21 and the “communicating the

translated medical command data to an ancillary medical device” language of claim 61. However, Petitioner does not adequately address the “not connectable” language of those independent claims. Petitioner’s assertion (and the Expert’s parroting of the same) that “the slave device can receive commands from the master controller 110 *only if* those commands have been translated” (Pet. 40 (emphasis added)) is conclusory and lacks necessary elaboration and explanation. We note that the quoted portion of Wang states the module “translates and/or processes” the command thus suggesting that not all commands forwarded to the slave device require translation. If not all commands need translation, then the “not connectable” limitation of independent claims 21 and 61 is not satisfied. Further and as Patent Owner points out (Prelim. Resp. 20), the same slave device 132 of the relied-upon Figure 7 is directly connected to the purported surgical network in Figure 6.

We, therefore, are not persuaded that Petitioner has presented sufficient evidence to support a finding that Wang discloses “at least one ancillary medical device not connectable to said surgical network” as recited in independent claim 21 and similarly recited in independent claim 61. Accordingly, Petitioner has not demonstrated a reasonable likelihood that it would prevail in showing that Wang anticipates independent claims 21 and 61 and the respective dependent claims 22, 28–31, 35, 62, 68–71, and 75.

D. Obviousness of Claims 28 and 68 over Ghodoussi and Webb (Ground 2) and over Wang and Webb (Ground 6), and Obviousness of Claims 35 and 75 over Ghodoussi and Nazarian (Ground 3) and over Wang and Nazarian (Ground 7)

Dependent claims 28 and 68 call for the surgical network to comprise an Ethernet. Dependent claims 35 and 75 call for the ancillary network to

include a self-configuring bus. In articulating these obviousness grounds (Grounds 2, 3, 6, and 7), Petitioner, as alternatives to the Ghodoussi and Wang anticipation grounds, relies upon Webb for the teaching of the use of an Ethernet (Pet. 26–30, 56–58) and upon Nazarian for the teaching of a self-configuring bus (*id.* at 30–34, 58–59). Petitioner does not articulate obviousness grounds that cure the above-discussed underlying defects of the anticipation ground based on Ghodoussi and the anticipation ground based on Wang.

For the reasons set forth in the discussion of the Ghodoussi and Wang anticipation grounds, we determine Petitioner has not demonstrated that there is a reasonable likelihood that it would prevail in showing that the combination of references in these grounds renders obvious the subject matter of the respective claims.

E. Obviousness of Claims 21, 22, 28–31, 35, 61, 62, 68–71, and 75 over Ghodoussi and Wang

Petitioner offers this obviousness ground in the alternative to the anticipation rejection based on Ghodoussi alone. Pet. 55. Petitioner relies on Wang for the disclosure of a translator. *Id.*

It is not entirely clear as to how Petitioner proposes to combine the references. We note that, unlike for the other grounds, Petitioner does not include in its Petition a claim chart for Ground 5. Petitioner asserts that “[a] person of ordinary skill would have known how to use a translator, like that disclosed in Wang, between the two networks of Ghodoussi if needed to enable communications among devices therein that operated using different network and/or command protocols.” Pet. 56. We assume Petitioner is

referring to the “networks” identified by Petitioner in its Ghodoussi anticipation ground. In that scenario, we fail to see, and Petitioner does not adequately explain, why it would be obvious to add a translator to redundantly perform the function that Petitioner maintains is performed by the interconnect devices and network computer located within the surgical network. *See id.* Although Petitioner asserts one would have known *how* to use a translator “if needed,” Petitioner has not explained adequately why it would have been needed or why it would have been obvious to do modify Ghodoussi’s system to have a translator. *Id.*

We have considered but find unpersuasive Petitioner’s argument that Ghodoussi provides a teaching, suggestion, or motivation through its recognition that different devices *may* communicate using different protocols. Pet. 55. Without more elaboration from Petitioner, we are left to speculate as to whether Petitioner is proposing a combination where different protocols are used.

We determine that Petitioner has not set forth adequately an articulated rationale based on rational underpinning for combining the references’ teachings so as to render obvious the subject matter of the challenged claims.

IV. CONCLUSION

For the foregoing reasons, we determine Petitioner has not demonstrated there is a reasonable likelihood of establishing the unpatentability of claims 21, 22, 28–31, 35, 61, 62, 68–71, and 75 of the ’657 patent.

V. ORDER

For the foregoing reasons, it is
ORDERED that the Petition is *denied* as to all challenged claims, and
no trial is instituted.

FOR PETITIONER:

Robert A. Surette
Merle S. Elliott
Christopher M. Scharff
Caroline A. Teichner
MCANDREWS, HELD & MALLOY
bsurette@mcandrews-ip.com
melliott@mcandrews-ip.com
cscharff@mcandrews-ip.com
cteichner@mcandrews-ip.com

FOR PATENT OWNER:

Wesley W. Whitmyer, Jr.
Michael J. Kosma
Michael A. Lavine
WHITMYER IP GROUP LLC
litigation@whipgroup.com
mkosma@whipgroup.com
mlavine@whipgroup.com