

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

CAREFUSION CORPORATION,
Petitioner,

v.

BAXTER INTERNATIONAL, INC.,
Patent Owner.

Case IPR2016-01463
Patent 6,231,560 B1

Before RICHARD E. RICE, ROBERT J. WEINSCHENK, and
AMANDA F. WIEKER, *Administrative Patent Judges*.

RICE, *Administrative Patent Judge*.

DECISION ON REQUEST FOR REHEARING
37 C.F.R. §§ 42.5, 42.71(d)

I. INTRODUCTION

On February 21, 2017, Baxter International, Inc. (“Patent Owner”), pursuant to 37 C.F.R. § 42.71, filed a Request for Rehearing (Paper 11, “Req.”) of our Decision (Paper 9, “Decision” or “Dec.”) granting an *inter partes* review of claims 1–3, 6, 7, and 16 of U.S. Patent No. 6,231,560 B1 (Ex. 1001, “the ’560 Patent”). Our Decision granted *inter partes* review of those claims on two grounds—obviousness over Bollish¹ and obviousness over Bollish and TITRATOR.² Patent Owner seeks rehearing with respect to only the second ground—obviousness over Bollish and TITRATOR. For the reasons that follow, Patent Owner’s Request for Rehearing is denied.

II. DISCUSSION

A. Applicable Requirements

A request for rehearing will be reviewed for abuse of discretion. 37 C.F.R. § 42.71(c). The request must identify specifically all matters that a party believes the Board misapprehended or overlooked, and the place in the record where each matter was previously addressed. 37 C.F.R. § 42.71(d); see Office Patent Trial Practice Guide, 77 Fed. Reg. 48,756, 48,768 (Aug. 14, 2012). In the present case, the burden of persuasion falls on Patent Owner as the moving party. 37 C.F.R. § 42.71(d).

¹ US 5,957,885 to Bollish et al., which issued Sept. 28, 1999 from an application filed Nov. 6, 1996 (Ex. 1004, “Bollish”).

² *Directions for Use: TITRATOR™, Sodium Nitroprusside Closed Loop Module – Model 10K*, IVAC Corp., San Diego, CA (1990) (Ex. 1005, “TITRATOR”).

B. Patent Owner's Argument That The Board Misapprehended Evidence

Patent Owner argues: “Patent Owner and its expert explained in detail the complexity of the relevant technologies, why the disclosure in [TITRATOR] fails to provide any teaching of how to modify Bollish, and why one of ordinary skill in the art would not have been motivated to make the alleged combination.” Req. 4 (citing Prelim. Resp. 39–57; Ex. 2001 ¶¶ 80–102). Patent Owner further argues: “Accordingly, the Petition failed to even show how one of ordinary skill in the art **could** have made the alleged combination, let alone show that one of skill in the art **would** have made that combination as it needed to.” Req. 4–5 (citing Prelim. Resp. 45–54). Patent Owner also argues:

Without **any** cited disclosure or explanation in the Petition of a single physical component from [TITRATOR] that one of ordinary skill in the art could have combined with Bollish or used to modify Bollish, there is insufficient evidence for the Board to base its obviousness findings. Therefore, the Petition fails to describe, in terms of the Instituted Claims, **how** Bollish is to be modified, and further fails to identify any actual **components** from the TITRATOR that one of ordinary skill in the art could or would combine with Bollish. ([Prelim. Resp. 40–42, 53; Ex. 2001 ¶¶ 80–102].) As a result, the alleged combination is based on pure hindsight reconstruction, using the patent itself as a guide to combining the insufficient technical disclosure of [TITRATOR] to achieve the result of the claims. ([Prelim. Resp. 49–54].) Accordingly, the combination is not adequately explained or grounded in substantial evidence.

Id. at 5 (footnote omitted).

Contrary to Patent Owner's argument, an actual, physical substitution of elements is not required for obviousness. *In re Mouttet*, 686 F.3d 1322, 1332 (Fed. Cir. 2012) (“It is well-established that a determination of

obviousness based on teachings from multiple references does not require an actual, physical substitution of elements.”). Nor does obviousness depend upon precise teachings directed to the specific subject matter of the challenged claims. See *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 418 (2007) (“[T]he [obviousness] analysis need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ.”). Moreover, in arguing that one of ordinary skill in the art would not have been motivated to make the asserted combination, Patent Owner relies on its own arguments and testimonial evidence, but does not address the arguments and evidence of Petitioner that we found sufficient at this stage of the proceeding to support Petitioner’s challenge to claims 1–3, 6, 7, and 16 as obvious over Bollish and TITRATOR.

Claims 1–3, for example, are method claims that require, *inter alia*, the step of obtaining information pertaining to the patient’s current medication. Ex. 1001, 14:15–16. In its claim chart, Petitioner identifies pertinent disclosures of Bollish and TITRATOR and, notably, asserts that TITRATOR *expressly discloses* the step of obtaining information pertaining to the patient’s current medication. (Pet. 51; Dec. 26).³ Specifically, Petitioner asserts:

TITRATOR discloses that the infusion pump monitors and displays total volume infused and retains in memory the current volume infused. (Ex. 1005 at APP0222.) TITRATOR also states that “[s]etting the concentration and patient weight

³ As discussed below, Petitioner relies on inherency or obviousness (not express disclosure) to show that Bollish alone teaches the step of “obtaining information pertaining to the patient’s current medication.” Pet. 34; Dec. 26.

enables the limits for SNP dosage infusion rate (dosage rate limit) and the total dosage delivered (toxicity limit). Limits are automatically calculated and observed.” (*Id.* at APP0234-35; *see also id.* at APP0218.)

Pet. 51. In its Request for Rehearing, Patent Owner does not identify specifically any matter that we misapprehended or overlooked in determining that Bollish and TITRATOR teach the steps and limitations of claims 1–3, including the step of obtaining information pertaining to the patient’s current medication.

Dr. Bollish⁴ (Petitioner’s declarant) testifies that “it would have been obvious to a person of ordinary skill in the art [“POSA”] to modify the PCA Pause technology disclosed in [the Bollish reference] with the [addition] of a control module such as that taught by [TITRATOR].” Ex. 1003 ¶ 26; Dec. 24–25. Dr. Bollish further testifies: “A [POSA] in 1999 would have readily understood that the TITRATOR module could have been modified to control other infusion pumps besides the IVAC 560i, and to automatically control the dosage of other infused drugs besides sodium nitroprusside,” and, further, that “[b]oth of those modifications would have been relatively simple changes, combining known elements from different infusion pumps according to their normal functions to yield a predictable result.” Ex. 1003 ¶ 25; Dec. 24–25. Additionally, Dr. Bollish testifies that such a modified infusion pump could automatically adjust the patient’s medication level (both the basal rate and bolus doses) based on information pertaining to the patient’s current condition and medication—rather than merely deactivating

⁴ Dr. Bollish testifies that he is the “lead inventor” of Petitioner’s “PCA Pause technology,” which is “disclosed and claimed” in the Bollish reference. Ex. 1003 ¶ 13.

the pump in response to out-of-limit readings and denying bolus requests in excess of the allowed maximum. Ex. 1003 ¶ 26; Dec. 25.

As noted above, Patent Owner argues: “Patent Owner and its expert explained in detail the complexity of the relevant technologies, why the disclosure in [TITRATOR] fails to provide any teaching of how to modify Bollish, and why one of ordinary skill in the art would not have been motivated to make the alleged combination.” Req. 4 (citing Prelim. Resp. 39–57; Ex. 2001 ¶¶ 80–102). As such, Patent Owner requests that we resolve in its favor the issues of fact created by Patent Owner’s testimonial evidence.

Patent Owner’s argument fails to recognize that genuine issues of material fact created by Patent Owner’s testimonial evidence cannot be resolved in Patent Owner’s favor at this preliminary stage of the proceeding. See 37 C.F.R. § 108(c). Rather, all genuine issues of material fact created by Patent Owner’s testimonial evidence must be viewed in the light most favorable to Petitioner solely for purposes of deciding whether to institute an *inter partes* review. See *id.* Patent Owner has not persuaded us that in taking into account the Petition and Patent Owner’s Preliminary Response, including the conflicting testimony of Dr. Bollish and Mr. Heim (Patent Owner’s declarant),⁵ our Decision misapprehended or overlooked any matter.

Further, in our Decision, we determined: “At this stage of the proceeding, we do not discern that the asserted modifications to Bollish’s PCA pump would have been beyond the skill of a POSA.” *Id.* at 26 (citing *KSR*, 550 U.S. at 417 (“[I]f a technique has been used to improve one

⁵ See, e.g., Dec. 25 (citing Prelim. Resp. 53–54 (citing Ex. 2001 ¶¶ 95–99)).

device, and a person of ordinary skill in the art would recognize that it would improve similar devices in the same way, using the technique is obvious unless its actual application is beyond his or her skill.”)). Petitioner has not persuaded us that we abused our discretion, or misapprehended or overlooked any matter, in making that determination.

For the reasons given, Patent Owner has not persuaded us that we abused our discretion, or misapprehended or overlooked any evidence, factual issue, or other matter.

C. Patent Owner’s Argument That The Instituted Grounds Are Redundant

Patent Owner argues that we overlooked its argument that the obviousness ground “based on the combination of Bollish and [TITRATOR] is redundant to the first obviousness ground based on Bollish alone.” Req. 7–8 (citing Dec. 26–27). In its Preliminary Response, Patent Owner argued: “When a petitioner asserts alternative grounds of unpatentability against the same challenged claims, the Board requires that they identify the strengths and weaknesses of different unpatentability grounds to avoid denial of those alternative grounds *as redundant*.” Prelim. Resp. 28 n.6 (emphasis added). In support of its redundancy argument, Petitioner cited *Old Republic Gen. Ins. Group, Inc. v. Intellectual Ventures I LLC*, Case IPR2015-01957, slip op. at 34 (PTAB Apr. 18, 2016) (Paper 18), for the proposition that denying institution on alternative obviousness grounds is appropriate when the petitioner “does not explain the weaknesses or strengths of one ground over the other, or express a preference for either ground.”

As noted above, Petitioner *does explain* weaknesses and strengths of its alternative challenges to claims 1–3. With respect to its obviousness

challenge based on Bollish alone, Petitioner relies on *inherency* or *obviousness* for the step of obtaining information pertaining to the patient's current medication. Pet. 34; Dec. 26.⁶ With respect to its alternative obviousness challenge based on Bollish and TITRATOR, Petitioner additionally relies on TITRATOR's *express disclosure*. Pet. 51; Dec. 26. In our Decision, we explicitly noted this difference in Petitioner's two grounds:

In its Preliminary Response, Patent Owner argues unpersuasively that Petitioner's claim chart generally commingles citations without ever describing which specific elements are being combined, in what manner, or why one of ordinary skill in the art would have been motivated to do so. Prelim. Resp. 40. We note, for example, that Petitioner relies on inherency and obviousness to show that Bollish alone teaches the "obtaining information . . ." limitations of claims 1–3, but asserts with respect to the combination of Bollish and TITRATOR that those limitations are disclosed expressly by TITRATOR. See Pet. 20, 22–23, 34, 51–53.

Dec. 26.

Further, as recognized by the panel in *Old Republic*, we have broad discretion to institute an *inter partes* review as to some asserted grounds and not others:

Under our Rules, we have broad discretion to institute an *inter partes* review as to some asserted grounds and not others. 37 C.F.R. § 42.108. Indeed, the United States Court of Appeals for the Federal Circuit recognized our discretion in this regard when it stated that "under [37 C.F.R. § 42.108(a)], it is clear that the Board may choose to institute some grounds and not institute others as part of its comprehensive institution

⁶ While Patent Owner has not sought rehearing of our Decision instituting *inter partes* review of claims 1–3 based on obviousness over Bollish alone, Patent Owner did oppose Petitioner's inherency and obviousness arguments in the Preliminary Response, and presumably will do so at trial. See Prelim. Resp. 33–39.

decision.” *Harmonic Inc. v. Avid Tech., Inc.*, No. 2015-1072, 2016 WL 798192, at *9 (Fed. Cir. Mar. 1, 2016); *see also HP Inc. v. MPHJ Tech. Inv., LLC*, No. 2015-1427, 2016 WL 1320920, at *6 (Fed. Cir. Apr. 5, 2016) (“§ 314(d) prevents our review of the Board’s reasons for its redundancy determination. Allowing an APA challenge to the Board’s decision to institute on the basis that the Board had insufficiently articulated its reasoning would eviscerate § 314(d) by allowing substantive review of the institution decision.”).

Old Republic, Case IPR2015-01957, slip op. at 34. Patent Owner has failed to persuade us that we abused our discretion, or misapprehended or overlooked any matter, in granting *inter partes* review on both of Petitioner’s asserted obviousness grounds.

III. CONCLUSION

Patent Owner has not persuaded us that we abused our discretion, or that we misapprehended or overlooked any matter. Accordingly, we *deny* the Request for Rehearing.

IV. ORDER

For the reasons given, it is

ORDERED that the Request for Rehearing is *denied*.

IPR2016-01463
Patent 6,231,560 B1

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