

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

FISHER & PAYKEL HEALTHCARE LIMITED,
Petitioner,

v.

RESMED R&D GERMANY GMBH,
Patent Owner.

Case IPR2017-00272
Patent 9,242,062 B2

Before BARRY L. GROSSMAN, BEVERLY M. BUNTING and
JAMES J. MAYBERRY, *Administrative Patent Judges*.

BUNTING, *Administrative Patent Judge*.

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

I. INTRODUCTION

Fisher & Paykel Healthcare Limited (“Petitioner”) filed a Petition (Paper 1, “Pet.”) requesting an *inter partes* review of claims 1–26 of U.S. Patent No. 9,242,062 B2 (Ex. 1001, “the ’062 patent”). ResMed R&D Germany GmbH (“Patent Owner”) filed a preliminary response to the Petition. Paper 7 (“Prelim. Resp.”). Upon consideration of the information presented in the Petition, we determined that there was a reasonable likelihood that Petitioner would prevail with at least one challenged claim, and instituted this trial, pursuant to 35 U.S.C. § 314(a), as to claims 1–26 (“the instituted claims”) of the ’062 patent based on a subset of grounds relying on McCall and Schwartz. Paper 8, 27 (“Decision on Institution” or “Dec.”).

Subsequent to institution, Patent Owner filed a Patent Owner Response (Paper 13, “PO Resp.”), and Petitioner filed a Reply (Paper 15, “Reply”).¹ A transcript of the first oral hearing held on February 13, 2018, has been entered into the record as Paper 23 (“Tr. I”). Pursuant to the U.S. Supreme Court’s decision on April 24, 2018, in *SAS Inst., Inc. v. Iancu*, 138 S. Ct. 1348 (2018), we modified our Decision on Institution on May 3, 2018, to include the challenge to claims 1–26 based on the combination of McCall and Kopacko. Paper 25 (modifying the Decision on Institution to include all claims and all grounds presented in the Petition). Although the one-year period normally available to issue a Final Written Decision was to expire on May 4, 2018, the Chief Judge determined that good cause existed to extend

¹ Both Petitioner filed evidentiary objections to certain of Patent Owner’s Exhibits (Paper 16) but did not file a motion to exclude, which is required to preserve any evidentiary objection. See 37 C.F.R. § 42.64(c).

this deadline by up to six months. Papers 26, 27. Based on the parties' requests for additional briefing to address the newly-added challenges, we found that good cause existed to permit additional briefing addressing the newly added challenges. Paper 28. Patent Owner submitted a Supplemental Response (Paper 30, "Supp. Resp.") and Petitioner filed a Supplemental Reply (Paper 31, "Supp. Reply"). Papers 30, 31. A supplemental hearing was held on July 11, 2018 and a transcript has been entered into the record. Paper 40 ("Tr. II").

This Final Written Decision is entered pursuant to 35 U.S.C. § 318(a). For the reasons that follow, we conclude that Petitioner has not demonstrated, by a preponderance of the evidence, that claims 1–26 of the '062 patent are unpatentable.

II. BACKGROUND

A. Real Party in Interest

Petitioner names Fisher & Paykel Healthcare Limited as the real party in interest. Pet. 5.

B. Related Matters

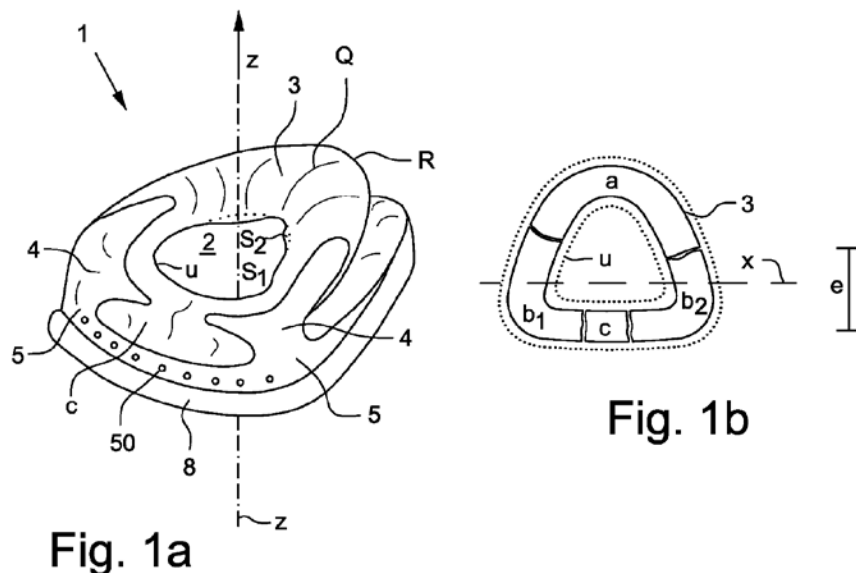
The parties indicate that the '062 patent has been asserted in: *Fisher & Paykel Healthcare Ltd. v. ResMed Corp.*, Case No. 3:16-cv-02068-DMS-WVG (S.D. Cal.). Pet. 5–6; Paper 4, 2.

C. The '062 Patent (Ex. 1001)

The '062 patent, titled "Breathing Mask and a Sealing Lip Device for a Breathing Mask," issued on January 26, 2016, and claims priority based on a series of applications dating back to February 25, 2000. Ex. 1001, 1:7–15. The '062 patent "concerns breathing masks which can be fitted to the nose region in sealing relationship and which have a sealing device extending in

the region of the upper lip of the mask wearer between the mouth and the nose.” *Id.* at 1:22–25. “The object of the [] invention is to provide a breathing mask in which a high level of sealing action can be reliably achieved, with a high degree of wearing comfort.” *Id.* at 1:39–41.

Figure 1a of the '062 patent illustrates the mask pad, and Figure 1b illustrates the load bearing capability of mask pad 1 of Figure 1.



Figures 1a and 1b are perspective views of the mask pad. Mask pad 1 includes sealing lip 3 having a plurality of zones of differing load-bearing capabilities. Ex. 1001, 7:3–12. First zone “a” is adapted to abut against the bridge of a patient’s nose; second zone “c” is adapted to abut against the patient’s face at a location opposite the first zone; and intermediate zones “b₁” and “b₂” are adapted to engage the patient’s face adjacent the patient’s nostrils. *Id.* at 7:13–20, Abstract. Higher load-bearing capability is achieved by “zones 4 which are thickened in a pad-like manner” and run into the sealing lip 3. *Id.* at 7:23–26. Intermediate zones b₁ and b₂ are thickened relative to the elastic walls of first zone a and

second zone c, such that zones b1 and b2 have a higher loadbearing capability than zones a and c. *Id.* at 7:23–26, Abstract. Zone c includes a further zone of reduced wall thickness that forms a “local folding bellows structure or rolling bellows structures.” *Id.* at 8:4–5. Mask pad 1 also includes local folding bellows structure 9 in the sealing region of the bridge of the nose. *Id.* at 23–25.

D. Instituted Claims

Of the instituted claims, claims 1, 8, and 17 are independent. Ex. 1001, 13:34–14:2, 14:49–15:13; 15:63–16:18. Claim 1, reproduced below, is illustrative of the subject matter:

1. An elastomeric cushion for a breathing mask configured for sealed delivery of a flow of breathable gas at a positive pressure with respect to ambient air pressure to an entrance of a patient’s airways including at least an entrance of the patient’s nares, the elastomeric cushion comprising:
 - a peripherally extending shell engaging portion configured to secure the elastomeric cushion to a shell of the breathing mask;
 - a sealing lip configured to contact the patient’s face, the sealing lip:
 - (a) defining an opening adapted to receive at least a part of the patient’s nose, and
 - (b) comprising an elastomeric wall divided into a first zone, a second zone opposite the first zone and a pair of intermediate zones spanning between the first and second zones, wherein a thickness of the elastomeric wall in the first and second zones is thinner than a thickness of the elastomeric wall in the intermediate zones so that when the elastomeric cushion engages the patient’s face, a thickness of a portion of the elastomeric wall in contact with the patient’s face varies from the pair of intermediate zones to the first zone and varies from the pair of intermediate zones to the second zone and so that the pair of intermediate

zones has a higher load-bearing capability than the first and second zones, wherein the first zone comprises a portion of the elastomeric cushion adapted to sealingly engage a bridge of a patient's nose and the second zone comprises a portion of the elastomeric cushion adapted to sealingly engage the patient's face at a location opposite the first zone; and

a peripheral wall extending from the shell engaging portion to the sealing lip, the peripheral wall comprising a bellows structure positioned between the shell engaging portion and the first zone of the sealing lip.

Id. at 13:35–14:2.

E. Evidence

Petitioner relies on the following prior art references (Pet. 3–4):

References	Patent	Date	Exhibits
McCall	U.S. Patent No. 5,921,239	July 13, 1999	1002
Schwartz	U.S. Patent No. 2,228,218	Jan. 7, 1941	1003
Kopacko	U.S. Patent No. 6,467,483	Oct. 22, 2002	1005
Gleason	U.S. Patent No. 6,016,804	Jan. 25, 2000	1006
Sullivan-I	U.S. Patent No. 5,243,971	Sept. 14, 1993	1007
Kidd	U.S. Patent No. 5,746,201	May 5, 1998	1008
Sullivan-II	U.S. Patent No. Des. 322,318	Dec. 10, 1991	1009

Additionally, Petitioner relies on the declaration of Jason Eaton, P.E. (Ex. 1011) and Patent Owner relies on the declaration of Mr. Geoffrey Sleeper (Ex. 2002). The parties rely on other exhibits as discussed below.

F. Instituted Grounds of Unpatentability

We instituted the instant trial based on the following grounds of unpatentability. Dec. 27; Paper 25, 2–3.

References	Basis	Claims Challenged
McCall and Schwartz	§ 103(a)	1, 5, 8, 10–12, 14, 17–20, 23, and 24
McCall, Schwartz, and Sullivan-II	§ 103(a)	2 and 13

References	Basis	Claims Challenged
McCall, Schwartz, and Kidd	§ 103(a)	3, 9, 16, and 22
McCall, Schwartz, and Gleason	§ 103(a)	4 and 21
McCall, Schwartz, and Sullivan-I	§ 103(a)	6, 15, and 25
McCall, Schwartz, Sullivan-II, Kidd, and Gleason	§ 103(a)	7 and 26
McCall and Kopacko	§ 103(a)	1, 3, 5, 8–12, 14, 16–20, and 22–24
McCall, Kopacko, and Sullivan-II	§ 103(a)	2 and 13
McCall, Kopacko, and Gleason	§ 103(a)	4 and 21
McCall, Kopacko, and Sullivan-I	§ 103(a)	6, 15, and 25
McCall, Kopacko, Sullivan-II, and Gleason	§ 103(a)	7 and 26

III. ANALYSIS

A. Legal Principles

We analyze the instituted grounds of unpatentability in accordance with the principles stated below.

1. Burden of Proving Unpatentability

In an *inter partes* review, the petitioner bears the burden of proving unpatentability of the challenged claims, and the burden of persuasion never shifts to the patent owner. *Dynamic Drinkware, LLC v. Nat’l Graphics, Inc.*, 800 F.3d 1375, 1378 (Fed. Cir. 2015). To prevail in this proceeding, Petitioner must support its challenges by a preponderance of the evidence. 35 U.S.C. § 316(e); 37 C.F.R. § 42.1(d). Accordingly, all of our findings and conclusions are based on a preponderance of the evidence.

2. Obviousness

A claim is unpatentable under § 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).

As the Supreme Court explained in *KSR*, an invention “composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art.” 550 U.S. at 418. Rather, “it can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does.” *Id.* When identifying this reason, “there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *Id.* (quoting *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006)). Accordingly, the U.S. Court of Appeals for the Federal Circuit has made clear that a petitioner in an *inter partes* review proceeding cannot “satisfy its burden of proving obviousness” by “employ[ing] mere conclusory statements” and “must instead articulate specific reasoning, based on evidence of record” to support an obviousness determination. *In re Magnum Oil Tools Int’l*, 829 F.3d 1364, 1380–81 (Fed. Cir. 2016).

We analyze the following grounds of unpatentability in accordance with the above-stated principles. Because Patent Owner does not provide evidence regarding secondary considerations, our determination is based on the first three factors. *See* PO Resp.; Pet. 79–80.

B. Level of Skill in the Art

In determining the level of ordinary skill in the art, various factors may be considered, including the “type of problems encountered in the art; prior art solutions to those problems; rapidity with which innovations are made; sophistication of the technology; and educational level of active workers in the field.” *In re GPAC, Inc.*, 57 F.3d 1573, 1579 (Fed. Cir. 1995) (citation omitted). In that regard, Petitioner asserts that a person having ordinary skill in the art (“PHOSITA”) “would have at least a bachelor’s degree in mechanical engineering, biomedical engineering or other similar type of engineering degree combined with at least two years of experience in the field of masks, respiratory therapy, patient interfaces or relevant product design experience.” Pet. 15 (citing Ex. 1011 ¶ 27). Patent Owner does not expressly state its position on the level of ordinary skill in the art in its Patent Owner Response. *See* PO Resp. Mr. Sleeper, Patent Owner’s expert, generally accepts Petitioner’s framework, but according to his formulation, the POSITA “would have at least a bachelor’s degree in mechanical engineering, biomedical engineering, or a similar technical field, with at least two years of relevant product design experience. An increase in experience could compensate for less education, and an increase in education could likewise compensate for less experience.” Ex. 2002 ¶ 12.

Our determination regarding the patentability of the challenged claims does not turn on the minor differences between these definitions. However,

for the purpose of our analysis, we accept Petitioner’s formulation, finding that the POSITA “would have at least a bachelor’s degree in mechanical engineering, biomedical engineering or other similar type of engineering degree combined with at least two years of experience in the field of masks, respiratory therapy, patient interfaces or relevant product design experience.” Ex. 1011 ¶ 27.

C. Claim Construction

The Board interprets claims of an unexpired patent using the broadest reasonable construction in light of the specification of the patent in which they appear. 37 C.F.R. § 42.100(b); *Cuozzo Speed Techs., LLC v. Lee*, 136 S. Ct. 2131, 2144–46 (2016). Under the broadest reasonable interpretation standard, and absent any special definitions, claims terms are given their ordinary and customary meaning, as would be understood by one of ordinary skill in the art in the context of the entire disclosure. *In re Translogic Tech. Inc.*, 504 F.3d 1249, 1257 (Fed. Cir. 2007). Any special definitions for claim terms or phrases must be set forth with reasonable clarity, deliberateness, and precision. *In re Paulsen*, 30 F.3d 1475, 1480 (Fed. Cir. 1994). In the absence of such a definition, limitations are not to be read from the specification into the claims. *See In re Van Geuns*, 988 F.2d 1181, 1184 (Fed. Cir. 1993).

Petitioner does not propose a specific construction for any claim term in its Petition, applying the “broadest reasonable interpretation in light of the specification of the ’062 patent.” Pet. 12. Patent Owner likewise “submits no express construction” in its Patent Owner Response. PO Resp. 18–19. In our Decision on Institution, we determined that no express construction of any claim term was necessary. Dec. 8–9 (citing *Vivid Techs., Inc. v. Am.*

Sci. & Eng'g, Inc., 200 F.3d 795, 803 (Fed. Cir. 1999) (“[O]nly those terms need be construed that are in controversy, and only to the extent necessary to resolve the controversy.”)).

Now, having considered the entire record, our determination regarding the obviousness of the challenged claims does not turn on the interpretation of any of the claim terms. Based on the final trial record before us, we determine that no express construction of any claim term is necessary for purposes of this Final Written Decision.

D. Obviousness Based on at least McCall and Schwartz

Petitioner challenges the patentability of claims 1, 5, 8, 10–12, 14, 17–20, 23, and 24 of the '062 patent under 35 U.S.C. § 103 as obvious based on McCall and Schwartz (Pet. 16–47); the patentability of claims 2 and 13 based on McCall, Schwartz, and Sullivan-II (*id.* at 48–51); the patentability of claims 3, 9, 16, and 22 based on McCall, Schwartz, and Kidd (*id.* at 52–56); the patentability of claims 4 and 21 based on McCall, Schwartz, and Gleason (*id.* at 57–61); the patentability of claims 6, 15, and 25 based on McCall, Schwartz, and Sullivan-I (*id.* at 61–66); and the patentability of claims 7 and 26 based on McCall, Schwartz, Sullivan-II, Kidd, and Gleason (*id.* at 67–68). In support thereof, Petitioner identifies the disclosures in the cited references alleged to describe the subject matter in the challenged claims, as well as a reason why one of skill in the art would modify McCall based on the teachings of Schwartz. *Id.* at 16–68.

Patent Owner disagrees, arguing that the proposed combination of McCall and Schwartz, alone or in combination with the other cited references, is unavailing for the reasons discussed *infra*. PO Resp. 19–66.

We have reviewed each party's contentions and supporting evidence of record in this trial. As explained below, we conclude that Petitioner has not met its burden and demonstrated by a preponderance of the evidence that claims 1–26 of the '062 patent would have been obvious. We begin our analysis with a brief summary of the cited references and then address the parties' contentions in turn.

1. McCall (Ex. 1002)

McCall relates to “a respiratory mask that is comfortable for patients to use, and that enables the patient to move around somewhat relative to the supply of air without breaking the seal between the mask and the patient's face.” Ex. 1002, 1:6–10. Figure 2, reproduced below, illustrates the mask.

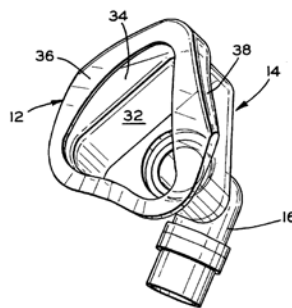


FIG. 2

Figure 2 is a perspective view of the mask body and seal.

Similarly, Figure 3, reproduced below, is another view of the mask.

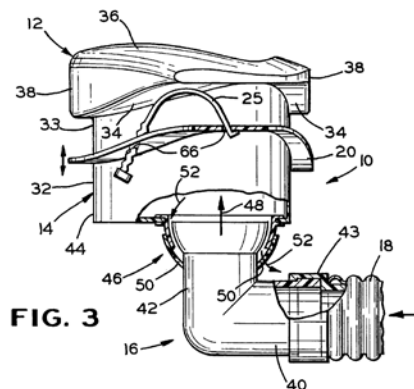


FIG. 3

Figure 3 is a plan view of the mask body and seal.

Mask 10 includes seal 12, frame 20, spacer 25, mask body 14, and vent tube 16. Ex. 1002, 3:7–20. Seal 12 includes mask body flange 34 and patient face flange 36, connected to each other at circumferential edge 38 in the form of a fold or joint that “gives a spring-like resiliency to the seal.” *Id.* at 3:34–39. Frame 20 is generally planar, and contoured, so that “when pressed against the seal it applies different forces or pressures to different areas of the seal, and therefore applies different pressure to different areas of the patient's face.” *Id.* at 4:8–11. Spacer 25 is a bendable elongated member, and includes ratchet 68 at ratchet end 70. *Id.* at 4:41–43. Spacer 25 can be adjusted by ratchet 68 to control “the relative amount of force applied to various areas of the seal by the frame.” *Id.* at 4: 61–64. “Increased extension of the ratchet end 70 of the spacer toward the seal will result in a greater pressing of the seal in those areas, and a consequent backing off or reduction in pressure on the nose bridge and the upper jaw of the patient.” *Id.* at 4:67–5:4.

2. Schwartz (Ex. 1003)

Schwartz relates to filter type respirators for protection against dust fumes and injurious gases. Ex. 1003, 1:1–4. Figure 1 of Schwartz is reproduced below.

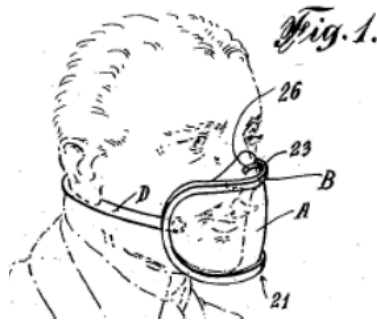


Figure 1 is a perspective view of the respirator.

Schwartz's respirator includes face piece A, filter unit B, valve C, and head band D. *Id.* at 2:38–41. Figure 2, reproduced below, illustrates a top view and the respirator.

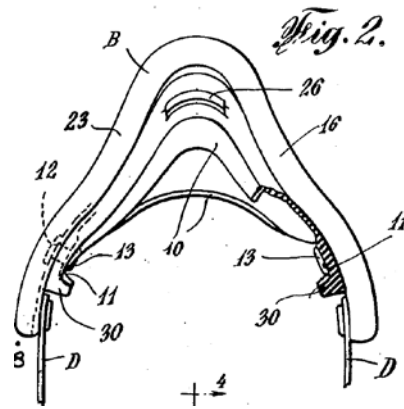


Figure 2 is a top view of the respirator showing cheek flange 11. Face piece A includes inwardly directed flange 10, which compressingly engages the wearer's face. *Id.* at 2:47–49. Flange 10 “is thickened at the sides 11 for engaging the cheeks and an extra amount of thickening is required at the side of the face piece 30.” *Id.* at 2:50–53. Schwartz further discloses that “the musculatures which are present at the cheek portion require a greater and firmer compression than that required at the nose and mouth” (*Id.* at 2:54–3–2) and that “the cheek portion of the face is not as sensitive to pressure as the chin and nose parts and therefore the right angle flange at the cheek part is thick for the reason that only little yield or none is necessary” (*id.* at 4:47–52).

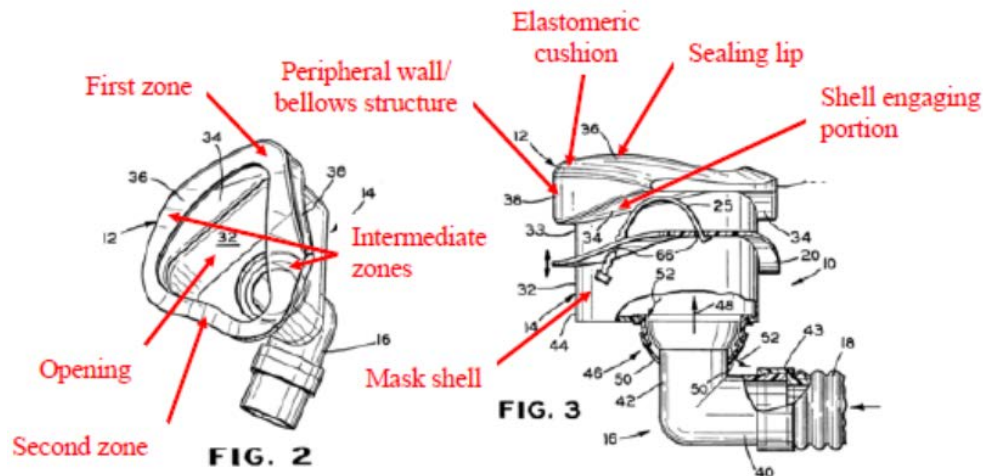
3. Discussion

a. Independent Claims 1, 8 and 17

i. Undisputed Limitations

Petitioner argues that the mask assembly and seal of McCall satisfies “most” of the limitations of claims 1, 8, and 17. Pet. 22. Petitioner

annotated Figures 2 and 3 of McCall, reproduced below, to illustrate the alleged correspondence. *Id.* at 23.



Figures 2 and 3 of McCall as annotated by Petitioner.

In particular, Petitioner contends that the preamble, which is directed to “an elastomeric cushion for a breathing mask” (Ex. 1001, 13:35) is satisfied by the description in McCall of “elastomeric cushion 12 connected to an outlet end of a respiratory mask 10 that contacts the patient’s face in a sealing relationship.” Pet. 30–31 (citing Ex. 1002, 2:11–18).

As to the “sealing lip configured to contact the patients’ face” claim element (Ex. 1001, 13:43), Petitioner relies on the disclosure in McCall of “elastomeric cushion 12 with a peripherally extending shell engaging portion 34 and a sealing lip 36 that are connected to each other by a peripheral wall 38.” Pet. 31 (citing Ex. 1002, 3:34–37). For the claim element of the sealing lip “defining an opening adapted to receive at least a part of the patient’s nose” (Ex. 1001, 13:45–46), Petitioner relies on Figure 2 of McCall. *Id.* at 33 (citing Ex. 1002, 3:60–64, Figure 2). Petitioner contends that the claim element concerning the sealing element having “an elastomeric wall divided into a first zone, a second zone opposite the first

zone and a pair of intermediate zones spanning between the first and second zones” (Ex. 1001, 13:47–50) is met by the teaching in McCall regarding the division of mask frame 20 into “an upper jaw portion **58**, a nose bridge portion **60** and two lateral portions **62**.” (citing Ex. 1002 4:6–20, Figure 2; Ex. 1011 ¶ 46).

Petitioner argues that the “first zone” and “second zone” claim elements are satisfied by the teaching in McCall regarding the sealing relationship created when sealing lip 36 of the elastomeric cushion 12 “is pressed against the patient’s face with enough force to close off any external air path to the patient’s nose.” Pet. 35 (citing Ex. 1002, 3:60–64). Petitioner also argues that the “peripherally extending shell engaging portion” claim element (Ex. 1001, 13:40) is satisfied by the description in McCall of how shell engaging portion 34 and sealing lip 36 are interconnected by peripheral wall 38. Pet. 37 (citing Ex. 1002, 3:34–37).

Patent Owner does not dispute Petitioner’s contentions with regards to the above limitations, referred to as the undisputed claim limitations. See PO Resp. We previously instructed Patent Owner that “any arguments for patentability not raised in the [Patent Owner Response] will be deemed waived.” Paper 8, 6; *see also* 37 C.F.R. § 42.23(a) (“Any material fact not specifically denied may be considered admitted.”); *In re NuVasive, Inc.*, 842 F.3d 1376, 1380–81 (Fed. Cir. 2016) (determining Patent Owner waived arguments made only in its Preliminary Response but not raised in the Patent Owner Response after institution). Now, in view of the entire record, we adopt as our own Petitioner’s analysis of the undisputed claim limitations as recited in independent claims 1, 8 and 17, and find that McCall teaches these limitations.

ii. Bellows Structure Limitation

We turn next to the disputed limitations. Claim 1 recites “a peripheral wall extending from the shell engaging portion to the sealing lip, the peripheral wall comprising a bellows structure positioned between the shell engaging portion and the first zone of the sealing lip.” Ex. 1001, 13:66–14:2 (“the bellows structure limitation”). Petitioner argues that the bellows structure limitation is met by the description in McCall of how peripheral wall 38 interconnects shell engaging portion 34 with sealing lip 36 “in the form of a fold or joint.” Pet. 38 (citing Ex. 1002, 3:34–37). Petitioner describes the “hinging or folding between the shell engaging portion 34 and the sealing lip 36” as giving “a ‘spring-like resiliency’ to the elastomeric cushion 12.” *Id.* (citing Ex. 1002, 3:34–39, Figure 3; *see also* Ex. 1011 ¶ 53).

In response, Patent Owner makes two main arguments. PO Resp. 21–24. Patent Owner first argues that element 38 in McCall is not a bellows because circumferential edge 38 is flat, and does not contain a fold or hinge. *Id.* at 22–23 (citing Ex. 1002, Fig. 1; Ex. 2002 ¶ 39). As to the disclosure in McCall of a fold (Ex. 1002, 3:34–39), Patent Owner contends McCall does not indicate “exactly where the ‘fold or joint’ is located on the mask body flange 34 or the patient face flange 36, nor does it explain how it hinges or folds” (*Id.* at 23 (citing Ex. 2002, ¶ 40)).

Patent Owner argues in the alternative that “[e]ven if McCall’s ‘fold or joint’ necessarily disclosed a bellows structure (which it does not), McCall states that ‘[t]he hinging or folding of the mask body flange and patient face flange gives a spring-like resiliency to the seal 12.’” *Id.* at 24 (citing Ex. 1002, 3:37–39; Petition, 38–39). According to Patent Owner,

McCall “discloses folds in the shell engaging portion and the seal engaging lip, but not *between* them.” *Id.* Patent Owner annotated Figure 3 of McCall, as reproduced below, to illustrate its argument.

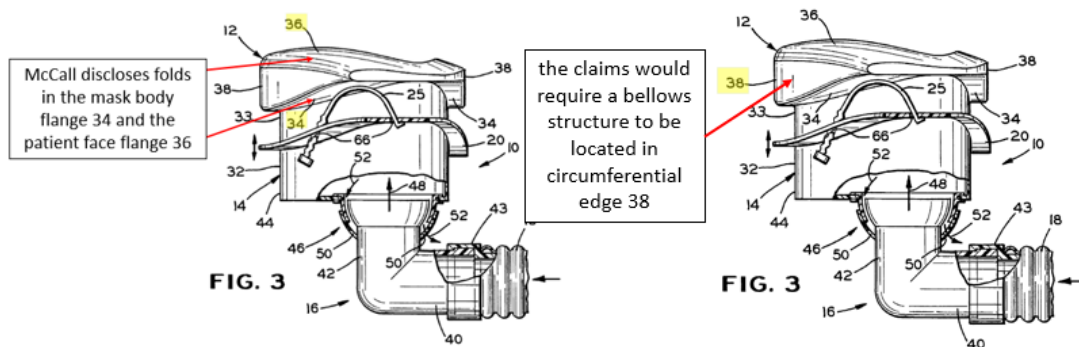


Figure 3 of McCall as annotated by Patent Owner. *Id.*

As to Patent Owner’s first argument, Petitioner argues persuasively that the passage in McCall describing seal or cushion 12 as having “a mask body flange 34 and a patient face flange 36 which are connected to each other by a circumferential edge 38 ***in the form of a fold*** or joint” satisfies the bellows structure limitation. Reply 4 (citing Ex. 1002, 3:34–37). Specifically, because McCall’s Figure 3 illustrates that circumferential edge 38 is a peripheral wall extending between shell engaging portion 34 and sealing lip 36, and circumferential edge 38 includes a fold that forms a bellows. *Id.* Also persuasive is the cross-examination testimony of Patent Owner’s expert, Mr. Sleeper, confirming that a bellows could be a fold. *Id.* at 5 (citing Ex. 1020, 111:1–11). Indeed, as Petitioner points out, the ’062 patent itself describes fold 9 as a bellows structure. *Id.* (citing Ex. 1001, 8:23–25; Figure 2a).

We are also not persuaded by Patent Owner’s alternative argument, i.e., that even if McCall’s fold or joint is a bellows, it does not satisfy the bellows structure limitation because McCall’s cushion does not fold *between*

the mask body flange and patient face flange. PO Resp. 24. Instead, we are more persuaded by Petitioner's position that folding of the mask body flange with respect to the patient face flange does not "preclude a folding bellows between the shell engaging portion and the seal engaging lip" as shown at portion 38. Reply 6; *see also* Ex. 1002, Fig. 1 (illustrating seal 12 against frame 20 at the nasal bridge area of mask 10, supporting, in part, our finding that a fold is in circumferential edge 38).

Based on the entire record, Petitioner present sufficient arguments and credible evidence to support a finding that Schwartz discloses the bellows structure limitation.

iii. Varying Thickness Limitation

Claim 1 also recites:

a thickness of the elastomeric wall in the first and second zones is thinner than a thickness of the elastomeric wall in the intermediate zones so that when the elastomeric cushion engages the patient's face, a thickness of a portion of the elastomeric wall in contact with the patient's face varies from the pair of intermediate zones to the first zone and varies from the pair of intermediate zones to the second zone and so that the pair of intermediate zones has a higher load-bearing capability than the first and second zones.

Ex. 1001, 13:50–60, ("the varying thickness limitation"). Claims 8 and 17 similarly recite the varying thickness limitation. Pet. 24–25; Ex. 1001, 15:4–11, 16:5–18.

Relying on the testimony of Mr. Eaton, Petitioner argues that "providing thinner portions in the first and second zones (nose bridge and upper jaw regions) and thicker portions in the intermediate zones (cheek regions) of the elastomeric wall of the sealing lip was well-known and common in the prior art." Pet. 25 (citing Ex. 1011 ¶ 56). Schwartz, in

Petitioner's view, expressly teaches that the elastomeric wall is thinner in the first and second zones than in the intermediate zones. *Id.* at 25–26 (citing Ex. 1003, 2:50–3:2, 4:9–18). Relying on the testimony of Mr. Eaton, Petitioner contends “[w]hen the elastomeric cushion engages the patient’s face, the thickness of a portion of the elastomeric wall in contact with the patient’s face varies from the pair of intermediate zones 11 to the first and second zones.” *Id.* at 26 (citing Ex. 1011 ¶ 57). Petitioner also supports its position by directing us to the discussion in Schwartz suggesting “that the intermediate zones 11 should be thicker than the portions of the sealing lip in the first and second zones because the cheek portions of the face are less sensitive to pressure and little or no yield is necessary.” *Id.* (citing Ex. 1003, 4:47–58). Again relying on the testimony of Mr. Eaton, Petitioner asserts that “[a] person of skill would have recognized that the thickened pair of intermediate zones 11 in Schwartz have a higher load-bearing capability than the first and second zones.” *Id.* at 26–27 (citing Ex. 1011 ¶ 57). Petitioner annotated Figure 3 of Schwartz to illustrate the alleged correspondence, reproduced below.

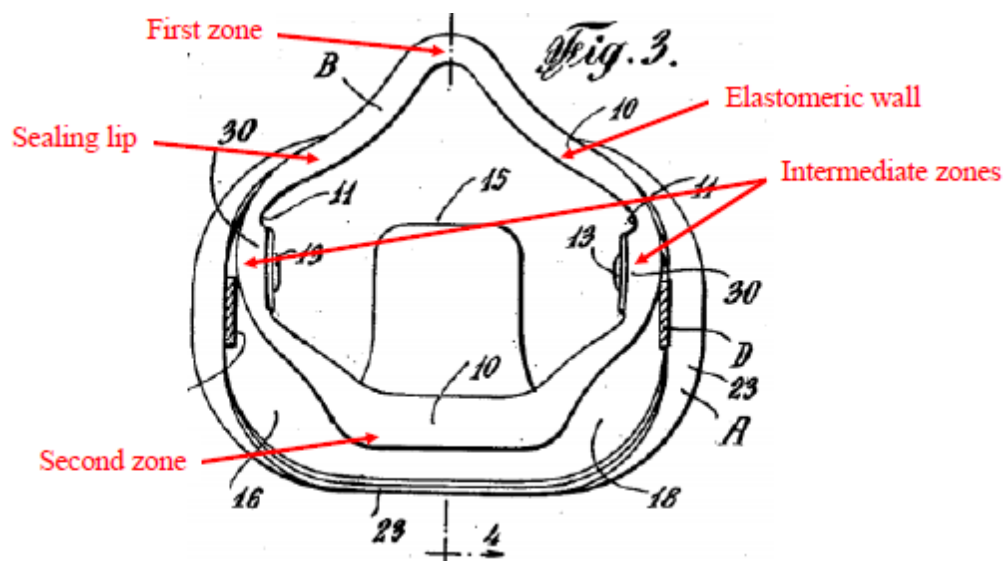


Figure 3 of Schwartz as annotated by Petitioner. Pet. 26.

Patent Owner argues that “[t]he figures that most clearly depict Schwartz’s alleged ‘thickened portion’ show that the sidewall of the cushion is thickened, not the face engaging portion.” PO Resp. 38. Patent Owner supports its argument with annotated Figure 2 of Schwartz, reproduced below.

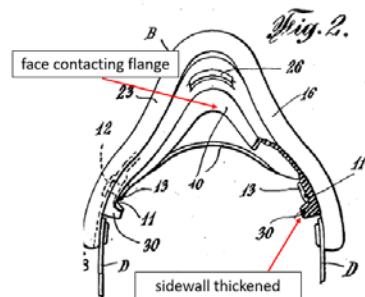


Figure 2 as annotated by Patent Owner. *Id.*

Patent Owner’s arguments directed to the teachings of Schwartz are not persuasive. As Petitioner points out, Schwartz explicitly states that (1) “flange 10 is thickened at the sides 11 for engaging the cheeks and an extra amount of thickening is required at the side of the face piece 30” (Reply 2 (citing Ex. 1003, 2:50–53, Fig. 3)); and (2) “side flanges 11 engage the face of the wearer” and that “at the chin and also at the nose sections the flanges are comparatively thin” (*id.* (citing Ex. 1003, 4:8–20)). Also persuasive is the cross-examination testimony of Patent Owner’s expert, Mr. Sleeper, describing flange portions 10 and 11 as engaging the face, and face contacting portions 11 as thickened. *Id.* at 3 (citing Ex. 1020, 91:18–25, 97:18–98:1; Ex. 1021, Figure 3).

Nonetheless, we must also consider Petitioner’s rationale for combining the teachings of McCall and Schwartz in the manner proposed. Pet. 27–29. McCall and Schwartz are combinable, in Petitioner’s view,

because (1) both teach masks with cushions for sealing against the face (*id.* at 27 (citing Ex. 1011 ¶ 58–60)); and (2) “the features of Schwartz would have been readily compatible with and easily incorporated into the mask of McCall with a reasonable expectation of success” (*id.* (citing Ex. 1011 ¶ 58)). Petitioner explains that Schwartz is analogous art to both McCall and the ’062 patent mask cushion because all of from the same field of endeavor, i.e., “breathing masks that form a seal with a person’s face” and all are pertinent to the problem of “maintaining a proper seal while also providing comfort in the sensitive areas of the face.” *Id.* at 27–28 (citing Ex. 1011 ¶ 58, Ex. 1001, 1:39–41; Ex. 1002, 1:26–61).

Specifically, Petitioner reasons

[b]ased on the teachings of Schwartz and the knowledge of a person of skill in the art, such a person would have been motivated to include thicker intermediate zones in the sealing lip of McCall *to prevent the cushion of McCall from readily yielding to pressure in the cheek regions.* See Ex. 1003 at col. 4:54–58; Ex. 1011 ¶ 59; *see also KSR*, 550 U.S. at 419. Also, a person of skill would have known that providing thinner elastomeric wall portions in the first and second zones of the sealing lip *would provide more flexibility and less pressure in these regions that are more sensitive to pressure.* See Ex. 1003 at col. 4:47–52; Ex. 1011 ¶ 59.

Pet. 28. (emphasis added).

Recognizing that McCall’s mask includes a contoured frame that controls the force applied to portions of the cushion and Schwartz’s sealing lip has a varying elastomeric wall thickness, Petitioner proposes removing McCall’s contoured frame to simplify the assembly of McCall and reduce the number of parts “by eliminating the contoured frame.” Pet. 28–29 (citing Ex. 1011 ¶ 60). Petitioner reasons that “a person of skill would have recognized that modifying the design of McCall to utilize the varying wall

thickness of Schwartz would also simplify manufacturing and assembly of the mask, and would facilitate cleaning and improve ease-of-use for the patient. *Id.* at 29 (citing Ex. 1011 ¶ 60). Based on this understanding, Petitioner concludes that the proposed modification would have been “a mere combination of familiar elements according to known methods that does no more than yield predictable results. *Id.* (citing Ex. 1011 ¶ 60; *KSR*, 550 U.S. at 416).

Patent Owner challenges these contentions, arguing that absent hindsight, Petitioner has not demonstrated that a POSITA would have modified McCalls’s mask based on the teachings of Schwartz. PO Resp. 25–54. Central to Patent Owner’s argument is its position that

McCall already purports to teach a complete solution to the problem of increasing load bearing capacity in the cheek regions of a positive pressure mask cushion while improving comfort and seal quality in the nasal bridge and jaw regions, and Petitioner has provided no reason a POSITA would have discarded McCall’s original solution and would have drastically modified McCall’s design to solve that same problem.

PO Resp. 19–20. Patent Owner maintains there is an inference of nonobviousness if the reason for modifying a particular reference is the same as the problem the reference purports to solve. *Id.* at 25 (citing *DePuy*, 567 F.3d at 1326 (“An inference of nonobviousness is especially strong where the prior art’s teachings undermine the very reason being proffered as to why a person of ordinary skill would have combined the known elements.”)).

Based on further review of the record, we are not persuaded Petitioner has provided sufficient articulated reasoning with rational underpinning explaining why one with ordinary skill in the art would have modified the teachings of the applied references to address the noted differences. *See*

KSR, 550 U.S. at 418 (citing *Kahn*, 441 F.3d at 988) (“[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.”)). As the Federal Circuit has made clear, when a reason to combine or modify references is in dispute, we must make a finding of a motivation to combine and must have an adequate evidentiary basis for that finding. *See In re Nuvasive, Inc.*, 842 F.3d 1376, 1382 (Fed. Cir. 2016). “[C]onclusory statements’ alone are insufficient and, instead, the finding must be supported by a ‘reasoned explanation.’” *Id.* at 1383 (quoting *In re Lee*, 277 F.3d 1338, 1342, 1345 (Fed. Cir. 2002)); *accord id.* at 1384 (not permitting the Board to effectively adopt the petitioner’s argument, which “amount[ed] to nothing more than conclusory statements that a PHOSITA would have been motivated to combine the prior art references to obtain additional information.”). Moreover, the Board “cannot rely solely on common knowledge or common sense to support [our] findings.” *Id.*

Here, Petitioner’s underlying basis for modifying the mask of McCall using the increased thickness in the intermediate zone of Schwartz, is premised on Petitioner’s reasoning that a POSITA would have modified the mask of McCall “to include thicker intermediate zones in the sealing lip of McCall” and “thinner elastomeric wall portions in the first and second zones” to provide “less pressure in these regions that are more sensitive to pressure.” Pet. 28. Less clear, is whether Petitioner’s proposed modification

involves elimination of McCall’s frame and/or spacer.² Pet 24–29; *see also* Tr. 16:5–18:3 (discussing modifying McCall, with Petitioner’s counsel stating, at one point, “we think it’s pretty clear from the record that the modification doesn’t require elimination of the frame and spacer”). Our analysis, however, considers both possibilities, and our determination does not turn on this basis.

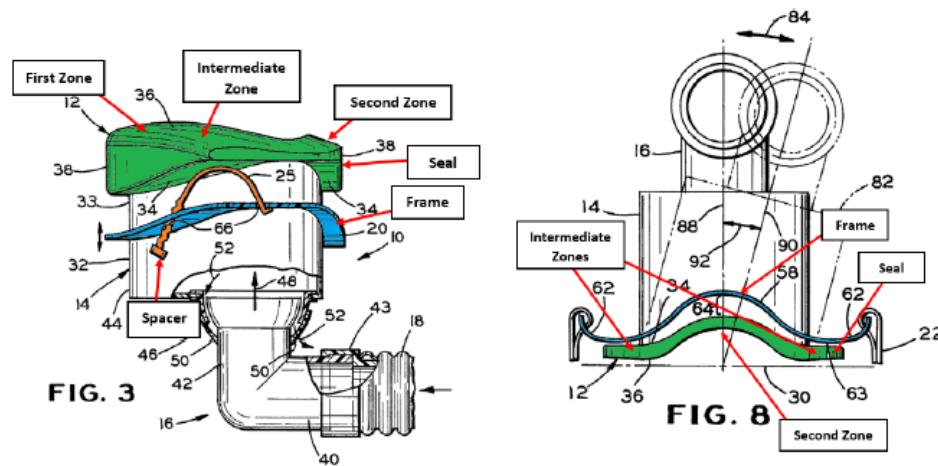
Patent Owner argues persuasively that McCall already solved the seal quality and comfort problem through the use of a “frame and spacer arrangement” that provides “‘higher load-bearing support’ in less-sensitive regions.” PO Resp. 25–26 (citing Pet. 28; Ex. 1002, 1:52–61; Ex. 2002 ¶ 44). Petitioner does not squarely address Patent Owner’s argument disputing whether one of skill in the art would eliminate McCall’s frame and spacer — which purportedly improves wearer comfort — in favor of Schwartz’s thickened face-contacting regions — which also improve wearer comfort. *See e.g.*, Reply 14 (“A POSITA seeking to provide more flexibility and less pressure in sensitive regions of the cushion would have looked to prior art references that address this same problem and would apply their teachings together.”).³

We are also persuaded by Patent Owner’s explanation of how “McCall’s frame includes contours to contact the seal of the mask (colored green) in the intermediate zones, as well as using a spacer (colored orange) that “controls the relative amount of force applied to various areas of the seal

² Petitioner confirmed during oral argument that its proposed modification contemplates both maintaining and eliminating the frame and/or spacer of McCall. TR. 16:13–18:3, 22:23–24:26.

³ We do not view Patent Owner’s citation to *DePuy Spine, Inc.* as a “teaching away” argument.

by the frame,” as illustrated in annotated Figures 3 and 8 of McCall reproduced below.



Figures 3 and 8 of McCall as annotated by Patent Owner.

PO Resp. 26 (citing Ex. 1002, Figures 3, 8; Ex. 2002 ¶ 43). Patent Owner’s argument, that McCall’s frame and spacer arrangement solves the problem of patient comfort by distributing the forces across the mask seal, is likewise convincing. *Id.* at 27 (citing Ex. 1002, 1:15–20, 4:11–32, 4:61–5:4; Ex. 2002 ¶44; Pet. 19, 25). We agree with Patent Owner that absent hindsight, “[a] POSITA would not have been prompted to start with McCall but then seek a wholly new way of solving a problem already resolved by McCall’s original design.” *Id.* (citing Ex. 2002, ¶¶45–47).

Along this vein, we are also persuaded by Patent Owner’s arguments and evidence that the POSITA would not have eliminated the frame and spacer of McCall in favor of Schwartz’s thicker cheek regions. PO Resp. 40–46. Specifically, that eliminating the frame would preclude the mask’s ability to vary pressure on the face “generally, as well as its ability to vary that pressure in specific zones.” *Id.* at 42 (citing Ex. 2002 ¶¶ 67–68. Patent Owner directs us persuasively to passages in McCall describing how the frame (1) “is mounted for movement along the mask body to press the seal

against the patient’s face” (*id.* (citing Ex. 1002, 2:23–25)); and the unique shape of the frame allows it “to exert more pressure in the cheek areas while not exerting that pressure on the sensitive areas of the face” (*id.* (citing Ex. 1002, 4:5–39)). Indeed, both experts agree that “a POSITA would have recognized that discarding this feature in favor of a cushion of varying thickness would eliminate McCall’s desired benefit/solution for applying varied pressure in the lateral cushion zones, as well as disrupt the mask’s adjustability and ability to maintain a comfortable seal. *Id.* (citing Ex. 2002, ¶¶ 67–68; Ex. 2003, 39:5–12 (“The frame in McCall is used to create different pressure on different parts of the cushion. Right? A. Yes. Q. and then that, in turn, creates different pressures on different parts of the patient’s face. Fair? A. Yes.”)).

Patent Owner additionally argues that excluding the spacer would eliminate the seal pressure adjustment feature of the McCall mask, and Petitioner does not explain sufficiently why one of skill in the art would have found it obvious to increase the thickness in the cheek regions of the cushion in order to control the force applied to portions of the user’s face. PO Resp. 42–43 (citing Ex. 2002 ¶ 69; Ex. 2003, 39:13–16 (“Q. In your opinion, in some embodiments McCall also adds a spacer to adjust the pressure created by the frame and cushion. Fair? A. Yes.”)).

In its Reply, Petitioner clarifies that the Petition contemplates both the inclusion and elimination of the frame and/or spacer. Reply 16–20.

According to Petitioner, “the Petition explains that a POSITA would have known to add Schwartz’s varied cushion thickness to further reduce pressure in sensitive areas and does not require that the frame and spacer, or any other features, must be eliminated.” *Id.* at 16 (citing Pet. 26–28). Nonetheless,

Petitioner maintains that elimination of the frame and/or spacer would simplify McCall's mask assembly by reducing the number of parts/features. *Id.* (citing Pet. 28–29. Petitioner argues that Patent Owner has not shown that these features are “‘critical’ or ‘key features necessary to McCall’s mask.’” *Id.*

The burden, however, rests with Petitioner to explain and prove that a person of ordinary skill in the art would have recognized the necessity of these features. See 35 U.S.C. § 316(e); *Magnum Oil*, 829 F.3d at 1380–81 (holding that because petitioner “bears the burden of proof,” the Board “must base its decision on arguments that were advanced by [petitioner]”); 35 U.S.C. § 312(a)(3); 37 C.F.R. §§ 42.22(a)(2), 42.104(b)(4)–(5). Here, Patent Owner directs us to passages in McCall describing the benefit of the spacer feature in reducing pressure in the nasal bridge and upper jaw regions. PO Resp. 9 (citing Ex. 1002, 1:52–56, 2:26–32, 4:30–32; Ex. 2002 ¶ 21). For example, McCall states that “[t]he use of the spacer enables the patient to adjust the mask of the invention so that maximum comfort can be obtained. The spacer controls the relative amount of force applied to various areas of the seal by the frame.” Ex. 1002, 4:61–64. This passage supports Patent Owner’s argument that one of skill in the art would understand the purpose of McCall’s frame and/or spacer as controlling pressure in sensitive regions of the cushion.

Thus, upon review of the entirety of the cited evidence, Petitioner does not provide sufficient arguments and credible evidence to support a finding that the proposed combination of McCall and Schwartz would teach or suggest the varying thickness limitation recited in claims 1, 8 or 17. Namely, Petitioner fails to provide persuasive reasoning as to why one

skilled in the art would eliminate McCall's frame and/or spacer and increase the thickness of the material in the intermediate zone of the mask to control pressure in sensitive regions of the cushion, when McCall's frame and spacer already achieve the same benefit. Nor does Petitioner provide persuasive reasoning explaining why one skilled in the art would both retain McCall's frame and/or spacer *and* increase the thickness of the material in the intermediate zone of the mask, to additively control pressure in sensitive regions of the cushion. In sum, Patent Owner argues persuasively that the proposed combination of McCall and Schwartz is based on hindsight bias. *See KSR*, 550 U.S. at 421 ("A factfinder should be aware, of course, of the distortion caused by hindsight bias and must be cautious of arguments reliant upon ex post reasoning."); *see also Metalcraft of Mayville, Inc. v. The Toro Co.*, 848 F.3d 1358, 1367 (Fed. Cir. 2017) ("[W]e cannot allow hindsight bias to be the thread that stitches together prior art patches into something that is the claimed invention.").

iv. Summary

In view of the foregoing, we conclude Petitioner has failed to establish by a preponderance of the evidence that independent claims 1, 8 and 17 are unpatentable as obvious based on McCall and Schwartz.

b. Dependent Claims 2–11, 13–23, 26–28

Petitioner provides a detailed mapping of the limitations of each of claims 5, 10–12, 14, 18–20, 23, and 24 onto the combined teachings of McCall and Schwartz (Pet. 16–47); claims 2 and 13 onto the combined teachings of McCall, Schwartz, and Sullivan-II (*id.* at 48–51); claims 3, 9, 16, and 22 onto the combined teachings of McCall, Schwartz, and Kidd (*id.* at 52–56); claims 4 and 21 onto the combined teachings of McCall,

Schwartz, and Gleason (*id.* at 57–60); claims 6, 15, and 25 onto the combined teachings of McCall, Schwartz, and Sullivan-I (*id.* at 61–66); and claims 7 and 26 onto the combined teachings of McCall, Schwartz, Sullivan-II, Kidd, and Gleason (*id.* at 67–68).

In asserting that dependent claims 2–11, 13–23, 26–28 are unpatentable, Petitioner relies on its position that the combination of McCall and Schwartz disclose the varying thickness limitation recited in the underlying based claim. *See e.g.*, Pet. 49–51 (addressing claims 2 and 13), 55–56 (addressing claims 3, 9, 16 and 22), 59–61 (addressing claims 4 and 21), 63–66 (addressing claim 6, 15, and 25), 67–68 (addressing claims 7 and 26). Because we are not persuaded that the combined teachings of McCall and Schwartz teach or suggest the varying thickness limitation, for the reasons discussed above in connection with our analysis of claims 1, 8, and 17, we determine that Petitioner has failed to demonstrate by a preponderance of the evidence that claims 2–7, 9–16, and 18–26 are unpatentable.

E. Obviousness Based on McCall and Kopacko

Petitioner challenges the patentability of claims 1–26 of the '062 patent under 35 U.S.C. § 103 as obvious based at least in part on McCall and Kopacko. Pet. 72–79. Essentially, Petitioner replaces Schwartz with Kopacko in its asserted grounds, and relies on Kopacko for the same reasons it relied on Schwartz, namely for the varying thickness limitation. *See Id.* at 69 (“In Grounds 7–11, Kopacko replaces Schwartz and Kidd for these limitations and all of the other aspects of the grounds remain the same, including the prior art combinations, differences, and reasons to combine.”). As to independent claims 1, 8, and 17, Petitioner notes that McCall does not

expressly disclose the varying thickness limitation, and argues that Kopacko teaches:

a sealing lip comprising an elastomeric wall divided into a first zone (bridge portion 40), a second zone opposite the first, and a pair of intermediate zones (side wall portions). Ex. 1005 at col. 6:53–56. Kopacko further discloses that a thickness of the elastomeric wall in the first and second zones is thinner than a thickness of the elastomeric wall in the intermediate zones. *Id.* at cols. 6:53–60, 7:11–13. To provide additional support at the intermediate zones of the peripheral wall portion 26, Kopacko also discloses a plurality of thickened portions or ribs 34 that support the peripheral wall against excessive deformation. *Id.* at col. 7:14–22.

Pet. 74–75. Petitioner supports its argument by annotating Figure 4 of Kopacko, reproduced below.

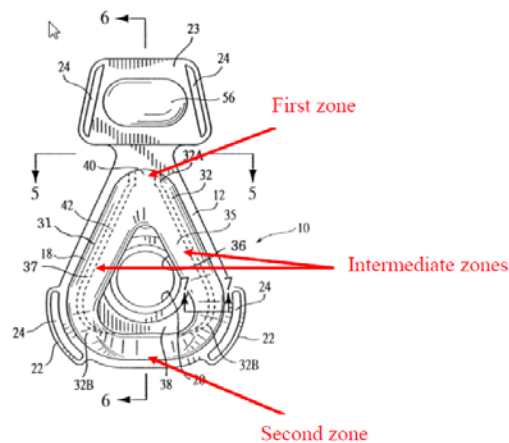


FIG. 4

Figure 4 of Kopacko as annotated by Petitioner. *Id.* at 75.

Petitioner argues that one of skill in the art would combine McCall and Kopacko because (1) “both relate to CPAP masks and improving the seal against the wearer’s face (*Id.* at 77 (citing Ex. 1011 ¶ 96)); and (2) thinner walls in the first and second zones of the sealing lip would “prevent pressure points and [] protect against excessive deformation of the cushion walls” (*id.* at 78 (citing Ex. 1005, 6:53–60, 7:20–22; Ex. 1011 ¶ 97)).

Petitioner relies on the same reasoning it provided with respect to the McCall-Schwartz combination, namely that

a person of skill would have been motivated to incorporate the wall thickness variations taught by Kopacko to distribute mask support loads in different sealing zones. *See supra* § VI(B)(4). A person of skill also would have recognized that molding the sealing lip of McCall to include thicker wall features would simplify the design and reduce manufacturing costs because the contoured frame of McCall would no longer be necessary. Ex. 1011 ¶ 97. Also, a person of skill would have recognized that modifying the design of McCall to utilize the varying wall thickness would have also been desirable for ease-of-use and cleaning for the patient. *Id.*

Pet. 78. As with the proposed McCall-Schwartz combination, Petitioner argues that the proposed modification would “permit the mask to more easily adapt to the contour of the human face and seal at low pressures with minimal facial pressure” (*Id.* (citing Ex. 1005, 5:1–5; Ex. 1011 ¶ 98)); and that the proposed combination of familiar element according to known methods would yield predictable results (*id.* at 79)).

Patent Owner disputes that Kopacko discloses the varying thickness limitation (Supp. Resp. 1–7) and that one of skill in the art would have modified McCall in view of Kopacko (*Id.* at 7–8). Relying on its arguments set forth with regards to the proposed McCall-Schwartz combination, Patent Owner contends that (1) “the Petition relies upon hindsight and legal error by ignoring the fact that McCall already solves the same problem that Petitioner alleged to be the source of the ‘motivation’ to modify McCall’s original design” (*Id.* at 7 (citing Ex. 2002, ¶¶42–47; PO Resp. 25–28)); and Petitioner’s reasoning “never explain[s] why one would have

discarded McCall’s principal of operation and detrimentally affected McCall’s seal quality” (*id.* at 8 (citing Ex. 2002, ¶¶64–85; PO Resp. 39–54)).

In turn, Petitioner responds that one of skill in the art would have looked to Kopacko “to provide more flexibility and less pressure in sensitive regions of the cushion.” Supp. Reply 8. Additionally, Petitioner directs us to arguments previously made in its Reply concerning the proposed McCall-Schwartz combination. Supp. Reply 9–10 (citing Reply 9–13, 16–20; Pet. 16–29; Supp. Resp. 8; Ex. 1011 ¶¶ 56–60; Ex. 1003, 2:50–3:2, 4:54–58).

For the same reasons as discussed above in Section III.D.3 in connection with the proposed McCall-Schwartz combination, we likewise are not persuaded that the combined teachings of McCall and Kopacko teach or suggest the varying thickness limitation of claims 1, 8, and 17, nor claims 2–7, 9–16, and 18–26 which depend from claims 1, 8, and 17 respectively. Thus, we conclude that Petitioner has failed to demonstrate by a preponderance of the evidence that claims 1–26 of the ’062 patent would have been obvious based on McCall and Kopacko.

F. Motion to Submit Supplemental Information

During supplemental oral argument, Petitioner requested authorization to file a motion for authorization to submit supplemental information under 37 C.F.R. § 42.123(b). Paper 37, 2. Specifically, office actions mailed in October 2017 and June 2018 in a related matter before the Patent Office, U.S. Patent Application Serial Number 15/593,934 (“the ’934 application”). *Id.* at 1–2. According to Petitioner, these office actions discuss the

Examiner's current view of Kopacko in ongoing prosecution of the '934 application. *Id.* We granted Petitioner's request, and at the same time authorized Patent Owner "to file a Reply addressing Petitioner's Motion to Submit Supplemental Information, including whether we can rely on the file history of a related patent application." *Id.* at 3. Petitioner filed its Motion (Paper 38, "Motion" or "Mot."), and Patent Owner filed a Reply (Paper 39, "PO Reply").

Petitioner's request centers around Patent Owner's contention that "the Examiner expressly found that 'Kopacko and other named publications **'do not disclose**, either by themselves or in combination, the above mentioned limitations, **specifically regarding the first, second, and intermediate zones, their sealing locations on the patient's face and the limitations regarding their thicknesses.**'" Mot. 1 (citing PO Resp. 3 (citing Ex. 1012 at 95)).

Our determination concerning the proposed combination of McCall and Kopacko does not rely on Patent Owner's contention concerning the disclosure of Kopacko. Rather, our determination is based on the insufficiency of Petitioner's articulated rationale for modifying McCall. Because we do not rely on Patent Owner's argument in this regard, Petitioner's Motion is denied as moot.

IV.CONCLUSION

Based on our further review of the record, and for the foregoing reasons, we conclude that Petitioner has not established by a preponderance of the evidence that claims 1–26 of the '062 patent are unpatentable under 35 U.S.C. § 103 based on McCall and Schwartz; nor has Petitioner

established by a preponderance of the evidence that claims 1–26 of the '062 patent are unpatentable under 35 U.S.C. § 103 based on McCall and Kopacko.

V. ORDER

In consideration of the foregoing, it is hereby:

ORDERED that claims 1–26 of U.S. Patent No. 9,242,062 B2 have not been shown to be unpatentable;

ORDERED that Petitioner's Motion for Authorization to Submit Supplemental Information is denied; and

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

IPR2017-00272
Patent 9,242,062 B2

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