

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ABS GLOBAL, INC.,
Petitioner,

v.

CYTONOME/ST, LLC,
Patent Owner.

Case IPR2017-02163
Patent 7,311,476 B2

Before SCOTT A. DANIELS, BEVERLY M. BUNTING, and
TIMOTHY J. GOODSON, *Administrative Patent Judges*.

GOODSON, *Administrative Patent Judge*.

DECISION
Denying Petitioner's Request for Rehearing
37 C.F.R. § 42.71

I. INTRODUCTION

Petitioner filed a Request for Rehearing (Paper 12, “Req. Reh’g”) of our Decision Denying Institution (Paper 11, “Decision” or “Dec.”). In that Decision, we concluded that Petitioner did not show a reasonable likelihood of prevailing in showing that any of the challenged claims of U.S. Patent No. 7,311,476 B2 (“the ’476 patent”) are unpatentable on any of the asserted grounds. *See* Dec. 22–27. Petitioner requests rehearing, arguing that we misapprehended or overlooked disclosures in Weigl,¹ which was the primary reference Petitioner relied on in the asserted grounds. *See* Req. Reh’g 1. For the reasons set forth below, Petitioner’s request for rehearing is *denied*.

II. LEGAL STANDARD

In a request for rehearing, “[t]he 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. ARGUMENTS REGARDING WEIGL

In our Decision, we determined that Petitioner had not demonstrated that in the regions of upstream portion 25b of Weigl’s Figures 5A and 5B, which Petitioner identified for the primary and secondary “focusing” regions, the sheath fluid is accelerated to apply a force to narrow the particle stream in the center fluid. Dec. 21. We noted that Petitioner’s annotated drawings showed the center fluid maintaining its dimension as it flows downstream, rather than being narrowed by the sheath fluid. *Id.* We also

¹ U.S. Patent No. 6,159,739, issued Dec. 12, 2000, Ex. 1005.

noted that these depictions are consistent with Weigl’s description, which teaches that channel depth is preferably increased at second inlet junction 21b and again at third inlet junction 41 to “preserve the fluid layer dimensions.” *Id.* (quoting Ex. 1005, 12:12–13).

In its Request for Rehearing, Petitioner argues that we overlooked Weigl’s configurations that maintain a constant depth of the flow channel. Req. 4–6. In particular, Petitioner argues that Weigl explains that the devices can be configured such that the depth of the flow channel does not increase but remains constant, and that the Petition identified this disclosure. *Id.* (citing Pet. 10–11). We are not persuaded that we overlooked an argument in the Petition that a constant depth configuration in Weigl causes it to satisfy the requirements for primary and secondary focusing regions. The portion of the Petition cited in the Request is a summary of Weigl appearing in the “Background of the Technology,” not the section analyzing the “primary focusing region” and “secondary focusing region” limitations. *See* Pet. 10–11, 39–44.

Introductory remarks summarizing a reference’s disclosure provide helpful context, but in analyzing whether a petitioner has shown that the cited reference teaches a particular limitation, we look primarily to the section of the petition presenting arguments regarding that limitation. This flows from “the requirement that the initial petition identify ‘with particularity’ the ‘evidence that supports the grounds for the challenge to each claim,’” *Intelligent Bio-Systems, Inc. v. Illumina Cambridge Ltd.*, 821 F.3d 1359, 1369 (Fed. Cir. 2016) (quoting 35 U.S.C. § 312(a)(3)), as well as the requirement that “the Board must base its decision on arguments that were advanced by a party, and to which the opposing party was given a

chance to respond.” *In re Magnum Oil Tools Int’l, Ltd.*, 829 F.3d 1364, 1381 (Fed. Cir. 2016). *See also Sirona Dental Systems GmbH v. Institut Straumann AG*, 892 F.3d 1349, 1356 (Fed. Cir. 2018) (“It would . . . not be proper for the Board to deviate from the grounds in the petition and raise its own obviousness theory. . . .”).

Here, the Request does not point to, and we do not find, any discussion of a constant-depth configuration in Weigl, in the Petition’s arguments regarding the “primary focusing region” and “secondary focusing region” limitations. *See* Pet. 39–44. Instead, as noted above, the Petition’s annotated drawings illustrating its contentions regarding these limitations show channel depth increasing, and the center fluid maintaining its dimensions as it flows downstream.

The Request also argues that, leaving aside the constant-depth configuration, even a channel with increased depth would still serve to accelerate and narrow the center fluid. Req. 7–10. But here again, Petitioner did not present any such argument in the portion of its Petition arguing the “primary focusing region” and “secondary focusing region” limitations. *See* Pet. 39–44. The Request points to the summary of Weigl in the “Background of the Technology” section of the Petition. Req. 7–10 (citing Pet. 10–11). As such, we are not persuaded that our Decision overlooked or misapprehended Petitioner’s arguments regarding the “primary focusing region” and “secondary focusing region” limitations.

IV. ORDER

Accordingly, it is

ORDERED that Petitioner’s Request for Rehearing is *denied*.

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