

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

AURIS HEALTH, INC.,
Petitioner,

v.

INTUITIVE SURGICAL OPERATIONS, INC.,
Patent Owner.

IPR2019-01496
Patent 9,452,276 B2

Before ULRIKE W. JENKS, TINA E. HULSE, and JAMES A. WORTH,
Administrative Patent Judges.

HULSE, *Administrative Patent Judge.*

DECISION

Denying Petitioner's Request on Rehearing of Decision Denying Institution
37 C.F.R. § 42.71(d)

I. INTRODUCTION

Auris Health, Inc. (“Petitioner”) filed a Request for Rehearing (Paper 14, “Reh’g Req.”) of our Decision Denying Institution of *Inter Partes* Review, holding that Petitioner had failed to establish a reasonable likelihood that it would prevail in showing that claims 1, 4, 10, 12, and 14 of U.S. Patent No. 9,452,276 B2 (Ex. 1001, “the ’276 patent”) are unpatentable. Paper 13 (“Dec.”).

Petitioner requests a rehearing of our decision, arguing that we overlooked or misapprehended the embodiment of Gilboa¹ that Petitioner relied upon in its Petition. Reh’g Req. 2–7.

For the reasons stated below, Petitioner’s request is *denied*.

II. STANDARD OF REVIEW

The party requesting rehearing has the burden to show that the decision should be modified. Under 37 C.F.R. § 42.71(d), the request for rehearing must identify, specifically, 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. When rehearing a decision on a petition, we review the decision for an abuse of discretion. 37 C.F.R. § 42.71(c). An abuse of discretion may arise if a decision is based on an erroneous interpretation of law, if a factual finding is not supported by substantial evidence, or if an unreasonable judgment is made in weighing relevant factors. *In re Gartside*, 203 F.3d 1305, 1315–16 (Fed. Cir. 2000).

¹ P. Gilboa, US 7,233,820 B2, issued June 19, 2007 (“Gilboa,” Ex. 1004).

III. ANALYSIS

Petitioner argues that we “incorrectly relied solely on a preferred embodiment and determined that Gilboa does not disclose the claimed ‘*measurement signals generated by the sensor system when the imaging device has been removed from the catheter.*’” Reh’g Req. 2. In our Decision, we found that Gilboa teaches an imaging system integrated into a position sensor, which is integrated into the distal tip of the guide element. Dec. 15. As such, we found that when Gilboa teaches removing the guide element and the integrated imaging device, Gilboa also teaches removing the position sensor, which can no longer generate measurement signals, as required by the claims. *Id.*

Petitioner argues we overlooked the embodiment that Petitioner relied on for its obviousness combination that “expressly discloses the claimed sensor system (‘location sensor element 44’) is integrated in the ***sheath***, which is not removed and continues to provide measurement signals even when the imaging device (‘imaging sensor 62’) is removed.” Reh’g Req. 3 (citing Pet. 54–56). Petitioner argues that it relied on the disclosure in Gilboa that states “the steering mechanism . . . may optionally be included within the sheath rather than the guide element,” and that “a multi-directional steering mechanism such as that of FIGS. 3–5C is used.” *Id.* at 4 (citing Pet. 54; Ex. 1004, 24:17–36). According to Petitioner, Figure 3 of Gilboa, which we allegedly overlooked, “shows a ‘steering mechanism’ that includes the position sensor (44) as part of its structure.” *Id.*

Figure 3 of Gilboa is reproduced below:

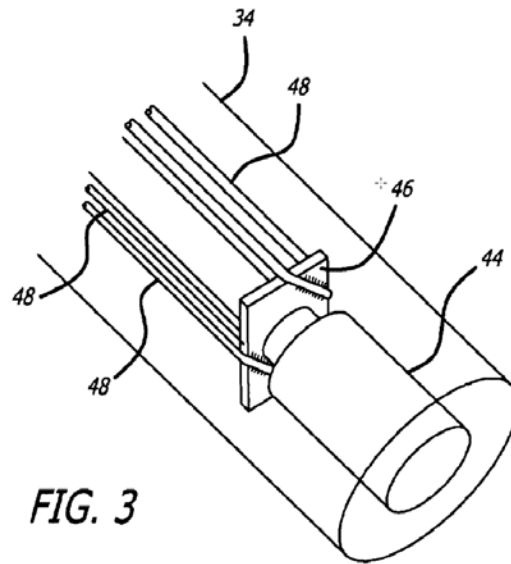


Figure 3 depicts “an enlarged view of distal tip 34 [of catheter 30] with position sensor element 44 mounted on base 46 to which at least three, and preferably four, elongated tensioning elements (‘steering wires’) 48 are attached.” Ex. 1004, 11:62–65. According to Petitioner, because “the ‘steering mechanism’ of Figure 3 is incorporated into the sheath, the position sensor, which is a structural component of Figure 3’s ‘steering mechanism,’ is incorporated into the sheath as well” and generates measurement signals when the guide is removed. Reh’g Req. 5. Petitioner also asserts that we improperly relied on the preferred embodiment that “imaging sensor 62 is integrated into location sensor element 44,” because Gilboa “does not **require** the position sensor to be integrated with the removable imaging sensor.” *Id.* at 5–6.

We are not persuaded. Petitioner repeatedly argues that Gilboa “expressly discloses” that the claimed sensor is integrated into the sheath. *Id.* at 3, 5, 6. Petitioner’s argument, however, assumes that Gilboa includes the position sensor element as part of the “steering mechanism” that can be integrated into the sheath. As support, Petitioner relies on the statement that

“the steering mechanism . . . may optionally be included within the sheath rather than the guide element” and that “[m]ore preferably, a multi-directional steering mechanism such as that of FIGS. 3–5C is used.” *Id.* at 4 (citing Ex. 1004, 24:22–27).

We disagree that that disclosure amounts to an “express disclosure” of the claim limitation. Nowhere does Gilboa expressly refer to the position sensor element as part of the steering mechanism of the catheter. Rather, Gilboa consistently describes the steering mechanism as including elongated tensioning elements for deflecting the tip of the catheter, an actuator, and a selector mechanism for selectively connecting the tensioning elements to the actuator:

There is also provided according to the teachings of the present invention, a steering mechanism for selectively deflecting a distal portion of a steerable catheter in any one of at least two independent directions, the mechanism comprising: (a) at least three elongated tensioning elements extending along the catheter and configured such that tension applied to any one of the tensioning elements causes deflection of a tip of the catheter in a corresponding predefined direction; (b) an actuator displaceable from a first position to a second position; and (c) a selector mechanism configured for selectively mechanically interconnecting a selected at least one of the elongated tensioning elements and the actuator such that displacement of the actuator from the first position to the second position applies tension to the selected at least one of the elongated tensioning elements.

Ex. 1004, 7:64–8:11; *see also id.* at 29:10–27 (claim 43 reciting same), 12:48–52 (“[T]he structure described offers a highly controllable and easily operated steering mechanism in which a plurality of steering wires provides selective deflection of the catheter tip in any of at least two independent directions.”).

Petitioner argues that because the position sensor element is shown in Figure 3, which Gilboa states depicts the steering mechanism, the position sensor element must be part of the steering mechanism. When viewed as a whole, however, Gilboa's disclosure does not support Petitioner's argument. For example, in the Brief Description of the Drawings, Gilboa identifies Figure 3 as "a schematic isometric view of a tip portion of the catheter of FIG. 2," not as the steering mechanism of the invention. *Id.* at 8:66–67; *see also id.* at 11:62–63 ("Turning now to FIG. 3, this shows an enlarged view of distal tip 34 . . ."). In our view, when Gilboa refers to the "steering mechanism such as that of Figures 3–5C," it is referring to those elements in the figures that depict the three parts of the steering mechanism—that is, the elongated tensioning elements in Figure 3 (*see id.* at 11:64–65), the actuator in Figures 4A and 4B (*see id.* at 9:1–4, 12:13–14), and the selector mechanism shown in Figures 5A–5C (*see id.* at 9:5–7, 12:14–19).

Moreover, Gilboa consistently refers to the position sensor element as a separate feature from the steering mechanism of its invention. For example, the claims recite the "position sensor element being part of a position measuring system" in claim 1, and then separately recite "a steering mechanism" in claim 43, which depends from claim 1. *Id.* at 24:58–65 (claim 1), 29:10–27 (claim 43). Similarly, in the specification, Gilboa states "[a] position sensor element 44, operating as part of the position measuring system . . . is integrated with distal tip 34." *Id.* at 11:40–44. Gilboa then distinguishes the steering mechanism from the position sensor element by starting a new paragraph with the transition phrase, "[t]urning now to the steering mechanism of catheter 30." *Id.* at 11:45–48 (emphasis added). Thus, when read as a whole, Gilboa makes clear that the position sensor element is distinct from the steering mechanism.

In light of that reading, we are not persuaded by Petitioner’s argument that Gilboa includes the position sensor element as part of the steering mechanism when it refers to the “steering mechanism such as that of Figures 3–5C.” Accordingly, we are not persuaded that we misapprehended or overlooked the embodiment of Figure 3, as Petitioner asserts. Nor are we persuaded that our reading of Gilboa is an abuse of discretion that is not supported by substantial evidence. *In re Gartside*, 203 F.3d at 1315–16.

IV. CONCLUSION

For the foregoing reasons, Petitioner has not demonstrated that we abused our discretion by misapprehending or overlooking any evidence or argument in its Petition.

V. ORDER

Accordingly, it is hereby:

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

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