

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ABS GLOBAL, INC.,
GENUS, PLC,
Petitioner,

v.

CYTONOME/ST, LLC,
Patent Owner.

IPR2021-00306
Patent 10,689,210 B2

Before LYNNE H. BROWNE, SCOTT A. DANIELS, and
JAMES A. WORTH, *Administrative Patent Judges*.

BROWNE, *Administrative Patent Judge*.

DECISION

Denying Petitioner's Request for Rehearing of
Decision Denying Institution of Post-Grant Review
37 C.F.R. § 42.71(d)

I. INTRODUCTION

A. Background

ABS Global, Inc. and Genus, PLC (“Petitioner”) filed a Petition for *inter partes* review of claims 1–10 (“challenged claims”) of U.S. Patent No. 10,689,210 B2 (Ex. 1001, “the ’210 patent”). Paper 1 (“Pet.”).

Cytonome/ST, LLC (“Patent Owner”) filed a Preliminary Response. Paper 9 (“Prelim. Resp.”).

In its Preliminary Response, Patent Owner requested that the Board exercise discretion under 35 U.S.C. § 325(d) to deny institution of the Petition. Prelim. Resp. 11. Patent Owner asserted that the Petition was “based entirely on prior art that was previously presented to the Patent Office and Petitioner [] failed to demonstrate that the Patent Office materially erred in connection with that prior art.” Prelim. Resp. *Id.* Anticipating this assertion, Petitioner argued the Examiner’s misunderstanding of the prior art favors institution. Pet. 73–81.

On June 7, 2021, the Board issued a Decision denying institution pursuant to 35 U.S.C. § 325(d). Paper 13 (“Dec.”). The Decision explains the two-part framework used to assess arguments under § 325(d) and that the Board considers several factors (i.e. the “*Becton, Dickinson*” factors) when determining:

- (1) whether the same or substantially the same art previously was presented to the Office or whether the same or substantially the same arguments previously were presented to the Office; and
- (2) if either condition of first part of the framework is satisfied, whether the petitioner has demonstrated that the Office erred in a manner material to the patentability of challenged claims.

Dec. 8. In the Decision, the Board determined that “Weigl, Ohki, and Wada were previously presented to the Office” and that Petitioner had “not

demonstrated that the Examiner materially erred when considering these references.” *Id.* at 16. Based on this determination, the Board exercised discretion to deny institution of *inter partes* review. *Id.*

On July 7, 2021, Petitioner filed a Request for Rehearing of the Decision. Paper 14 (“Req. Reh’g”). Two days later (July 9, 2021), Petitioner filed a request for Precedential Opinion Panel (“POP”) Review. Ex. 3001. Petitioner’s request for POP Review was denied on September 7, 2021. Paper 16. We have considered Petitioner’s Request for Rehearing and, for the reasons below, determine that Petitioner has not shown that we abused our discretion in denying the Petition. Accordingly, the Request for Rehearing is denied.

B. Request for Rehearing Standards

When rehearing a decision on institution, the Board reviews the decision for an abuse of discretion. 37 C.F.R. § 42.71(c). An abuse of discretion may arise if the 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. *Star Fruits S.N.C. v. U.S.*, 393 F.3d 1277, 1281 (Fed. Cir. 2005); *Arnold P’ship v. Dudas*, 362 F.3d 1338, 1340 (Fed. Cir. 2004); *In re Gartside*, 203 F.3d 1305, 1315–16 (Fed. Cir. 2000).

Additionally, 37 C.F.R. § 42.71(d) further provides that “[t]he burden of showing a decision should be modified lies with the party challenging the decision,” i.e., Petitioner, and “[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.”

C. Petitioner's Arguments

In its Request, Petitioner makes three main arguments, which we address below. Specifically, Petitioner asserts that: (1) “the Board’s holding that Petitioners failed to demonstrate material error with respect to Weigl is based on an erroneous application of the law and should be reversed;” (2) “[t]he Board’s failure to independently consider the Petition’s arguments regarding the materiality of Ohki is a misapplication of the *Advanced Bionics* framework and *Becton Dickinson* factor (e) that warrants reversal; and (3) “[t]he Board’s holding that Petitioners failed to demonstrate material error with respect to Wada is therefore not supported by substantial evidence and misapplies the law, and should be reversed.” Req. Reh’g 12–15.

II. DISCUSSION

A. Arguments re Weigl

In the Decision we determined that Petitioner failed to demonstrate that the Office erred in a manner material to the patentability of the challenged claims. Dec. 11–14. Specifically, we determined that “Petitioner has made no allegation of material error beyond the allegation that the Examiner did not apply the Weigl reference and has not pointed out any specific disclosure from Weigl that was overlooked by the Office.” *Id.* at 13–14. Based on this determination we determined that “Petitioner fails to demonstrate material error.” *Id.* at 14. In making this determination, we noted that the ’210 patent is a continuation in a series of patents that claim priority to the same provisional patent application and that all of the patents in this series were examined by the same Examiner. *Id.* at 12. We further noted that Petitioner’s arguments regarding Weigl in this proceeding closely track the arguments raised in other proceedings involving this series of

patents and that in those proceedings the Board denied institution. *Id.* at 12–13.

Petitioner asserts that it “was not required to identify a ‘specific disclosure from Weigl that was overlooked by the Office.’” Req. Reh’g 8–9. In support, Petitioner cites *Amgen Inc. v. Alexion Pharm., Inc.*, IPR2019-00740, Paper 15 at 65 (PTAB Aug. 30, 2019) for the proposition that “[t]he Board ‘has consistently declined exercising its discretion under Section 325(d) when the only fact a Patent Owner can point to is that a reference was disclosed to the Examiner during the prosecution.’” *Id.* at 7–8.

The facts of this case, however, are distinguishable from those in *Amgen*, because in this case Patent Owner points to more than the fact that Weigl was disclosed to the Examiner during prosecution. Patent Owner also relies on the fact that Petitioner’s arguments regarding Weigl closely track the arguments the Board previously rejected in IPR2017-02163¹ and IPR2017-02161.² Prelim. Resp. 5–6.

We are not persuaded that we abused our discretion in determining that Petitioner failed to demonstrate that the Office erred in a manner material to the patentability of the challenged claims. Given that the Board rejected Petitioner’s arguments pertaining to Weigl in two prior IPR proceedings challenging patents that share the same specification with the

¹ Challenging claims 1–8, 10, 13–15, 21–23, 25–29, and 31 of US 7,311,476, issued December 25, 2007, which is a parent of the ’210 patent through a series of continuations and shares its specification. Dec. 2.

² Challenging claim 14 of US 7,611,309, issued November 3, 2009, which is a parent of the ’210 patent through a series of continuations and shares its specification. *Id.*

'210 patent, we found Petitioner's challenges alone to be insufficient to demonstrate material error.

B. Arguments re Ohki

In the Decision we determined that "Petitioner's allegation of error is premised on the idea that the Examiner's rejection should have relied upon Weigl as the base reference and then modified Weigl in view of Ohki." Dec. 14–15 (citing Pet. 76–78). We reiterated that "Petitioner fails to demonstrate material error based on Petitioner's contention that the Examiner[']s did not apply Weigl during the prosecution of the '210 patent" and with this in mind we were "not persuaded by Petitioner's further contention that the Examiner's failure to modify Weigl based on a teaching of Ohki constitutes material error." *Id.* at 15.

Petitioner argues that "regardless of whether the Examiner's failure to consider Weigl alone were error, the Examiner's failure to properly apply Ohki—to modify Weigl—is itself material error." Req. Reh'g 13. According to Petitioner, "[t]he Board's failure to independently consider the Petitioner's arguments regarding the materiality of Ohki is a misapplication of the *Advanced Bionics* framework and *Becton Dickinson* factor (e) that warrants reversal. *Id.* at 14.

We did, however, consider whether the Examiner's failure to consider the combined teachings of Weigl and Ohki was material error. Dec. 14. In particular we noted and agreed with Patent Owner's contention that "even if Petitioner is correct that Ohki fails to disclose two focusing regions, 'that only means that the [Ohki] reference is less material to patentability than the Examiner recognized, not more material.'" *Id.* (quoting Prelim. Resp. 22). We are not persuaded that the Examiner's failure to consider Weigl and

Ohki was material error or that we abused our discretion in determining that Petitioner failed to demonstrate that the Office erred in a manner material to the patentability of the challenged claims.

C. Arguments re Wada

In the Decision we determined that “in this case ‘where Petitioner argues that these claim elements were generally known in the art,’ material error is not shown because the Examiner relied on other equivalent references.” Dec. 16.

Petitioner argues that “of the four claims the Petition challenges as obvious over Weigl in view of Wada (claims 7-10), two of them—corresponding to issued claims 8 and 9 (relating to the size of the microchannels)—were allowed by the Examiner in his first office action, and were never rejected.” Req. Reh’g. 14. Thus, for at least these two claims, Petitioner asserts that “the Examiner materially erred in failing to consider Wada. Accordingly, the Board’s holding that the Examiner relied on equivalent references is erroneous, and should be reversed.” *Id.* at 14–15.

As noted in the Petition, Petitioner has asserted Weigl and Wada to no avail in other related IPR proceedings. Dec. 11. On the record before us, we determined that Petitioner fails to demonstrate that it was material error for the Examiner to not apply the combined teachings of Weigl and Wada. Even if we assume that our determination that the Examiner relied on other equivalent references in considering claims 8 and 9 is erroneous, we are not

persuaded that we abused our discretion in denying institution of the instant proceeding.

III. CONCLUSION

For the forgoing reasons, Petitioner has not shown that we abused our discretion in denying institution of *inter partes* review. Accordingly, the Request for Rehearing is denied.

IV. ORDER

For the reasons given, it is:

ORDERED that

Petitioner's Request for Rehearing (Paper 16) is *denied*.

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