

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

LUMENIS BE LTD.,¹
Petitioner,

v.

BTL HEALTHCARE TECHNOLOGIES A.S.,
Patent Owner.

IPR2021-01278, IPR2021-01285, IPR2021-01402, IPR2021-01403,
IPR2021-01404, IPR2021-01405, IPR2022-00126, and IPR2022-00127²

Before BARBARA A. PARVIS, ZHENYU YANG, and DAVID COTTA,
Administrative Patent Judges.

COTTA, *Administrative Patent Judge.*

DECISION
Dismissal Prior to Institution of Trial
35 U.S.C. § 314

¹ Further to Petitioner's request, we have changed the case caption to reflect that Lumenis Be Ltd., is the successor-in-interest of Lumenis Ltd. Paper 4.

² This Order addresses issues that are common to each of these cases. We exercise our discretion to issue one Order to be filed in each case. The parties are not authorized to use this style heading for any subsequent papers.

IPR2021-01278, IPR2021-01285, IPR2021-01402, IPR2021-01403, IPR2021-01404, IPR2021-01405, IPR2022-00126, and IPR2022-00127

In the period between August 5, 2021 and November 10, 2021 Lumenis Be Ltd. (“Petitioner”) filed a total of sixteen related petitions requesting *inter partes* review of eight different patents. We have issued decisions denying institution for eight of these petitions. *See* IPR2021-01273, Paper 8; IPR2021-01275, Paper 8; IPR2021-01276, Paper 8; IPR2021-01279, Paper 8; IPR2021-01280, Paper 8; IPR2021-01282, Paper 8; IPR2021-01283, Paper 8; IPR2021-01284, Paper 8. There are eight remaining petitions for which we have not yet issued an institution decision.

On March 18, 2022, Petitioner emailed the Board requesting authorization to file a Motion to Withdraw IPR2021-01278, IPR2021-01285, IPR2021-01402, IPR2021-01403, IPR2021-01404, IPR2021-01405, IPR2022-00126, and IPR2022-00127. Ex. 3001.³ BTL Healthcare Technologies A.S. (“Patent Owner”) opposed the request. *Id.* On March 22, 2022, we held a teleconference to discuss Petitioner’s request and authorized each party brief the issue. Ex. 2024, 25:4-17.⁴ Pursuant to our authorization, Petitioner filed a Motion to Dismiss and Terminate the Proceeding (Paper 9, “Mot.”) and Patent Owner filed an Opposition to Petitioner’s Motion to Terminate (Paper 8, “Opp.”).

The parties do not dispute that we have discretionary authority to terminate the eight remaining proceedings. Mot. 1 (“The Board has discretion to ‘grant, deny, or dismiss any petition or motion.’”) (quoting 37

³ Petitioner’s email also requested termination of IPR2021-01279 and IPR2021-01284. Ex. 3001. Shortly after receipt of Petitioner’s request, we issued decisions denying institution in those proceedings, rendering Petitioner’s request with respect to those cases moot.

⁴ For convenience, throughout this opinion, we cite to the papers and exhibits filed in IPR2021-01278. Similar papers were filed in each of the other captioned proceedings.

IPR2021-01278, IPR2021-01285, IPR2021-01402, IPR2021-01403, IPR2021-01404, IPR2021-01405, IPR2022-00126, and IPR2022-00127

C.F.R. § 42.71(a)); Ex. 2024, 13 (“Patent Owner is not disputing that the Board has discretion to terminate if it so chooses.”). Rather, the parties dispute whether we should exercise our discretion to allow Petitioner to withdraw the eight remaining Petitions.

Petitioner submits that the grounds set forth in the remaining petitions are “substantially identical” to those in the eight petitions for which we denied institution. Mot. 2. According to Petitioner, if the Board were to issue decisions on the remaining petitions, it would simply be “repeating itself” which would “serve no useful purpose for Patent Owner,” “provide no additional value to the public,” and “simply waste agency resources.” *Id.* Petitioner further argues that termination is appropriate because the proceeding is at a preliminary stage. *Id.* at 1. Petitioner explains that at the time it first raised the issue of termination to the board, the earliest statutory deadline for the remaining proceeding was “almost three weeks” away, and the latest was “more than two months away.” *Id.* at 3.

Patent Owner argues that “[t]aking Petitioner at its word, the Petition here ‘presents *the same ultimate issues* that have already been decided in the earlier denied petitions.’” Opp. 1 (citing Ex. 2024, 5:3–7). Thus, according to Patent Owner, “[i]ssuing an institution decision would require modest additional effort.” *Id.* Patent Owner emphasizes the “great expense” it incurred in filing 16 preliminary responses and asserts that it “should obtain the benefit of its investment through public notice as to the merits of the petitions.” *Id.* at 1, 3. Patent Owner contends that Petitioner bears the burden to establish good cause and asserts that Petitioner has not met this standard because:

- (1) pre-trial briefing is complete;
- (2) institution decisions are imminently due (between two weeks and two months);
- (3) the

IPR2021-01278, IPR2021-01285, IPR2021-01402, IPR2021-01403, IPR2021-01404, IPR2021-01405, IPR2022-00126, and IPR2022-00127

Board has invested significant resources addressing the relevant validity issues (same primary references, common issues, etc.); (4) the parties have not reached any settlement agreement (*see* EX2025, 1-3); and (5) Petitioner continues to refuse to assure PO that it will not attack the same patents again at the Office.

Id. at 2.

We begin by considering how much work has been done by the panel and by the parties in each of the proceedings at issue. From the parties' standpoint, all eight cases are fully briefed and nothing more remains to be done in order for us to issue an institution decision. From the Board's perspective, the panel in each proceeding has not completed its review of the record in all of the remaining cases. Based on the parties' representations that there is substantial overlap in issues, we expect that the work required to prepare institution decisions would be diminished as compared to writing on a blank slate.⁵ That said, the panel for each case would still have to prepare each case in its entirety. The Board has more than a modest amount of work.

Having considered the burden on the Board of issuing eight more institution decisions, we next consider the benefit of issuing institution decisions in the eight remaining cases. As an initial matter, the parties have not identified the challenged patents as being involved in active district court litigation. Paper 2, 3; Paper 3, 1. Accordingly, issuing an opinion would not facilitate resolution of issues presented in district court.

Patent Owner argues that providing institution decisions would "help insulate [Patent Owner] from further attacks on its patents." Opp. 1. Patent Owner acknowledges (*id.* at 3) that the Board has already issued precedent

⁵ Because we have not completed our review of the record in all of the remaining cases, we have not verified the parties' assertions that already-decided issues are dispositive with respect to the still-pending cases.

IPR2021-01278, IPR2021-01285, IPR2021-01402, IPR2021-01403, IPR2021-01404, IPR2021-01405, IPR2022-00126, and IPR2022-00127

specifically addressing Patent Owner’s concerns regarding future attacks on its patents from Petitioner. *See General Plastic Industrial Co., v. Canon Kabushika Kaisha*, IPR2016-01357, Paper 19, 16–17 (precedential) (recognizing “the potential for abuse of the review process by repeated attacks on patents” and articulating factors for panels to consider in determining whether to institute on a patent that has previously been challenged, explaining “[o]ur intent in formulating the factors was to take undue inequities and prejudices to Patent Owner into account”). Patent Owner nonetheless argues that whether the Board previously issued an institution decision is an important factor in that analysis. Opp. 3. Petitioner disagrees, contending that “the Board already decided the Petitioner’s grounds in earlier, related proceedings” and “repeated issuance of a substantially same decision is a needlessly wasteful endeavor.” Mot. 1. At least with respect to future challenges from Petitioner, Patent Owner may rely on Petitioner’s statements. We find that issuing an opinion on the outstanding petitions would not place Patent Owner in a materially better position under the factors articulated in *General Plastic* than simply dismissing them.

As to third-parties, Patent Owner contends that issuing opinions on the remaining patents would provide “public notice” “thereby deterring future serial and meritless attacks.” Opp. 3. We do not dispute that an issued opinion would provide notice to the public. However, we are not persuaded that issuing an institution decision would provide substantially greater deterrent effect with respect to third-parties than a withdrawn petition, particularly when coupled with the already-issued eight related decisions denying institution on issues that the parties seem to agree are dispositive with respect to the remaining petitions. In addition, we note that

IPR2021-01278, IPR2021-01285, IPR2021-01402, IPR2021-01403, IPR2021-01404, IPR2021-01405, IPR2022-00126, and IPR2022-00127

a decision on institution is limited to an evaluation of the arguments and evidence presented in the Petition. It is not, as Patent Owner seems to suggest, an appraisal of the challenged patent as against hypothetical future challenges.

Weighing the burden on the Board to issue eight additional institution decisions against the potential benefits of issuing those decisions, we exercise our discretion to allow Petitioner to withdraw the eight remaining Petitions. While we are sympathetic to Patent Owner's desire to see these proceedings through, we find that Patent Owner does not sufficiently account for the additional work required of the Board to issue eight additional institution decisions. Further, we note that permitting Petitioner to withdraw its remaining petitions would achieve the goal Patent Owner presumably hoped for in filing its preliminary responses – non-institution.

I. ORDER

In consideration of the foregoing, it is hereby:

ORDERED that Petitioner's request to terminate IPR2021-01278, IPR2021-01285, IPR2021-01402, IPR2021-01403, IPR2021-01404, IPR2021-01405, IPR2022-00126, and IPR2022-00127 is granted.

IPR2021-01278, IPR2021-01285, IPR2021-01402, IPR2021-01403,
IPR2021-01404, IPR2021-01405, IPR2022-00126, and IPR2022-00127

FOR PETITIONER:

Scott A. McKeown
James L. Davis, Jr.
Keyna Chow
ROPES & GRAY LLP
scott.mckeown@ropesgray.com
james.l.davis@ropesgray.com
keyna.chow@ropesgray.com

FOR PATENT OWNER:

Richard D. Collier III
Jon E. Wright
Richard M. Bemben
Lestin L. Kenton
Christian Camarce
STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.
rcoller-PTAB@sternekessler.com
jwright-PTAB@sternekessler.com
rbemben-PTAB@sternekessler.com
lkenton-PTAB@sternekessler.com
ccamarce-PTAB@sternekessler.com