

Filed on behalf of: Facet Technologies, LLC

Entered: June 28, 2023

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

LIFESCAN, INC.,
Petitioner,

v.

FACET TECHNOLOGIES, LLC,
Patent Owner.

IPR2023-00712
Patent 8,840,635

**PATENT OWNER'S RESPONSE TO PETITIONER'S RANKING AND
EXPLANATION FOR TWO PETITIONS CHALLENGING U.S. PATENT
NO. 8,840,635**

I. Introduction

Patent Owner Facet Technologies, LLC (“Facet”) submits its Response to Petitioner’s Ranking and Explanation for Two Petitions Challenging U.S. Patent No. 8,840,635 (“’635 Patent”) (Paper 3) (“Ranking” or “Rank.”), filed by Petitioner LifeScan, Inc. (“LifeScan”).

This is a garden variety case where there should only be one petition on one patent. No exceptional circumstances exist to warrant the rare granting of two petitions on the same patent. The ’635 Patent has only 11 claims directed to a protective sterility cap for a lancet.¹ The ’635 Patent claims are not lengthy. And only four claims are asserted against LifeScan in a parallel district court case. The second petition only addresses one additional claim limitation—an “open loop.” LifeScan could have addressed the single claim limitation in one petition if LifeScan it did not double track in both petitions, i.e., assert the same claims as anticipated and/or obvious using two different primary references. LifeScan’s explanation is all the art and combinations it wanted to assert would not fit in one petition. But that is no different from any other petitioner when faced with the word count limit of an IPR Petition.

¹ Facet has disclaimed claims 1-5 and 9-10.

II. Background

Absent exceptional circumstances, only one petition should be filed against a single patent. *SolarEdge Techs. Ltd., v. SMA Solar Tech., AG.*, IPR2020-00966, Paper 9 at 10 (P.T.A.B. Jan. 11, 2021). The Patent Trial and Appeal Board Consolidated Trial Practice Guide (Nov. 2019) (“CTPG”) provides that “one petition should be sufficient to challenge the claims of a patent in most situations.” CTPG at 59. Thus, “multiple petitions by a petitioner are not necessary in the vast majority of cases.” *Id.* The CTPG recognizes that multiple petitions filed against the same patent at the same time “may place a substantial and unnecessary burden on the Board and the patent owner and could raise fairness, timing, and efficiency concerns.” *Id.* (citing 35 U.S.C. § 316(b)).

However, the CTPG recognizes two examples where more than one petition may be necessary. *Id.* They are: (1) when the patent owner has asserted a large number of claims in litigation; and (2) when there is a dispute about priority date requiring arguments under multiple prior art references. *Id.* Neither example applies here.

III. More Than One Petition Is Not Warranted

The '635 Patent now only has 11 claims when LifeScan challenged all of them over two petitions—7 claims in the IPR2023-00712 Petition and 5 claims in the IPR2023-00713 Petition (independent 14 challenged in both petitions). All of those

11 claims could have been challenged in one petition. The same was true when the '635 Patent had 18 claims. The Board routinely receives petitions challenging more than 11 and 18 claims. *Apple Inc. v. Koss Corp.*, IPR2021-00679, Paper 14 at 12 (P.T.A.B. Oct. 12, 2021); *see also Fitbit, Inc. v. Kononolijke Phillips N.V.*, IPR2020-00772, Paper 14 at 26 & n.8 (P.T.A.B. Oct. 19, 2020) (In fiscal year 2019, there were about 16 challenged claims per challenged patent.). Indeed, the basic filing fee for an *inter partes* review contemplates challenging up to 20 claims. *See* 37 C.F.R. § 42.15(a)(1), (3).

There is nothing unusual in the complexity of the '635 Patent's claims or the technology of the challenged patent and art that would distinguish it from many cases where one petition is sufficient. *Apple Inc.*, IPR2021-00679, Paper 14 at 12. The '635 Patent claims are not lengthy. The independent claims and the disclaimed independent claims average about 11 lines per claim. *Fitbit, Inc.*, IPR2020-00772, Paper 14 at 26 (finding an independent claim of 12 lines not to be “lengthy”). No dependent claims when LifeScan filed its petitions were more than 5 lines—with most only two or three lines. *Id.* (finding a dependent claim of 5 lines not to be “lengthy”). The '635 Patent claims are directed to a protective sterility cap for a lancet, which is not in a technology area with a fast-changing, complex landscape like artificial intelligence or biotechnology.

Neither of the recognized non-limiting examples for more than one petition are present here. Facet is currently asserting only 4 claims against LifeScan in the parallel district court case—claims 6, 8, 14, and 18—and only 5 claims when LifeScan filed its Petitions. Five claims is not a large number by any measure, and the claims are relatively short too. Plus there is no dispute over the priority date. So none of the situations contemplated by the CTPG is present here.

LifeScan instead argues that it should be allowed the unusual opportunity for two petitions because (1) it could not have challenged the open-loop claims 4, 9-13, and 15 in one petition, and (2) it risks losing its right to challenge the open-loop claims. Rank. at 2-3. Neither argument merit two petitions. The open-loop claims boil down to a single claim limitation (“the gripping handle portion comprises at least one open loop”), albeit appearing in seven claims due to dependencies. The Board should therefore deny this second petition. *Apple Inc.*, IPR2021-00679, Paper 14 at 12-14 (denying a second petition that only addressed one additional claim limitation in an 18-claim patent).

LifeScan conclusorily asserts that it needed different primary references and different obvious combination and that they could not fit in one petition. Rank. at 2. But LifeScan could have challenged all 18 claims in one petition. For example, LifeScan could have dropped one set of grounds based on one of the primary references in each of its petitions in IPR2023-00712 and IPR2023-00713 and then

combine the rest of the grounds. The word limits of IPR filings, which were thoughtfully chosen, forces tough choices on parties on what positions to take, just like patent rules in district courts that limit asserted claims and invalidity grounds as the case progresses to trial. These word limits are equally applicable to Petitioners and Patent Owners.

Finally, it is unclear how LifeScan would be surrendering its rights if it did not challenge the open loop claims now. Facet does not assert LifeScan infringes any of the open-loop claims in the parallel district court case, and in fact never did. All of the discretionary denial bases for a petition challenging the open-loop claims now will likely still be present in the future.

IV. Conclusion

The Board should not exercise its discretion to institute more than one petition (if it institutes at all).

Respectfully submitted,

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CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.6(e), I certify that on this 28th day of June, 2023, a true and correct copy of the foregoing **Patent Owner's Response to Petitioner's Ranking and Explanation for Two Petitions Challenging U.S. Patent No. 8,840,635** was served by electronic mail on Petitioner's lead and backup counsel at the following email addresses:

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