

Filed on behalf of: Facet Technologies, LLC

Entered: May 3, 2024

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 SUR-REPLY

[REDACTED]

[REDACTED]

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Exhibit List

Exhibit	Description
2001	Declaration of John M. Collins in support of the Patent Owner Preliminary Response ("Collins POPR Decl.")
2002	<i>Curriculum Vitae</i> of John M. Collins
2003	Order re Joint Stipulation to Modify Schedule (ECF No. 65), <i>Facet Techs., LLC v. LifeScan, Inc.</i> , No. 2:22-cv-01717 (C.D. Cal. Sept. 21, 2022), ECF No. 68
2004	Order Regarding Motion to Stay Pending <i>Inter Partes</i> Review (ECF No. 129), <i>Facet Techs., LLC v. LifeScan, Inc.</i> , No. 2:22-cv-01717 (C.D. Cal. May 1, 2023), ECF No. 162
2005	Order Regarding Defendant's Motion to Amend the Scheduling Order (ECF No. 130), and Parties' Joint Stipulation to Amend the Scheduling Order (ECF No. 166), <i>Facet Techs., LLC v. LifeScan, Inc.</i> , No. 2:22-cv-01717 (C.D. Cal. May 4, 2023), ECF No. 171
2006	Order Regarding Motion to Strike LifeScan, Inc.'s Supplemental Invalidity Contention (ECF No. 172), <i>Facet Techs., LLC v. LifeScan, Inc.</i> , No. 2:22-cv-01717 (C.D. Cal. June 7, 2023), ECF No. 193
2007	Plaintiff Facet Technologies, LLC's Notice of Motion for Summary Judgment of No Inequitable Conduct and No Incorrect Inventorship, <i>Facet Techs., LLC v. LifeScan, Inc.</i> , No. 2:22-cv-01717 (C.D. Cal. May 29, 2023), ECF No. 189
2008	Defendant LifeScan, Inc.'s Notice of Motion for Summary Judgment of Invalidity of Claims 6, 8, 14 and 18, <i>Facet Techs., LLC v. LifeScan, Inc.</i> , No. 2:22-cv-01717 (C.D. Cal. May 29, 2023), ECF No. 190

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2009	Memorandum of Points and Authorities in Support of LifeScan, Inc.'s Motion for Summary Judgment of Invalidity, <i>Facet Techs., LLC v. LifeScan, Inc.</i> , No. 2:22-cv-01717 (C.D. Cal. May 29, 2023), ECF No. 190-1
2010	Opening Expert Report of Joel Delman Regarding Invalidity of U.S. Patent No. 8,840,635, <i>Facet Techs., LLC v. LifeScan, Inc.</i> , No. 2:22-cv-01717 (C.D. Cal. June 7, 2023)
2011	U.S. District Courts, National Judicial Caseload Profile (as of Dec. 31, 2023)
2012	Daniel S. Hong Disclaimer in Patent Under 37 C.F.R. 1.321(a) regarding Claims 1-5, <i>Facet Techs., LLC</i> , U.S. Patent No. 8,840,635, signed June 14, 2023 (U.S. Pat. & Trademark Dkt. No. 2G02.1-453)
2013-2020	RESERVED
2021	Order Regarding LifeScan's Motion for Summary Judgment [ECF No. 190], <i>Facet Techs., LLC v. LifeScan, Inc.</i> , No. 2:22-cv-01717 (C.D. Cal. July 27, 2023), ECF No. 224
2022	U.S. Patent No.4,259,792 ("Halberstadt")
2023	LifeScan, Inc.'s Third Supplemented Objections and Responses to Facet Technologies, LLC's First Set of Interrogatories (Response to No. 3), <i>Facet Techs., LLC v. LifeScan, Inc.</i> , No. 2:22-cv-01717 (C.D. Cal. May 26, 2023) (CONFIDENTIAL)
2024	Deposition transcript of Gregory A. Lamps, <i>Facet Techs., LLC v. LifeScan, Inc.</i> , No. 2:22-cv-01717 (C.D. Cal. May 25, 2023) ("Lamps Dep.") (CONFIDENTIAL)
2025	Deposition transcript of Joel Delman, <i>Facet Techs., LLC v. LifeScan, Inc.</i> , No. 2:22-cv-01717 (C.D. Cal. July 7, 2023) ("Delman Dist. Ct. Dep.")

Exhibit	Description
2026	BD Medical, <i>BD Ultra-Fine Lancets — A Difference You Can See and Feel</i> (June 2007), https://www.bd.com/resource.aspx?IDX=4437 (English & French versions)
2027	Centers for Disease Control & Prevention (CDC), <i>Diabetes: Monitoring Your Blood Sugar</i> (CDC last review Dec. 30, 2022), https://www.cdc.gov/diabetes/managing/managing-blood-sugar/bloodglucosemonitoring.html (last visited Dec. 13.2023, 5:27 AM)
2028	Deposition transcript of Joel Delman, <i>LifeScan, Inc. v. Facet Techs., LLC</i> , IPR2023-00712 (P.T.A.B. Dec. 5, 2023) (“Delman IPR Dep.”)
2029	Bettina Barisch-Fritz et al., <i>Evaluation of the Rule-of-Thumb: Calculation of the Toe Allowance for Developing Feet</i> , FOOTWEAR SCI. 1 (2016), https://www.tandfonline.com/doi/full/10.1080/19424280.2016.1144654
2030	Facet P&L [produced in <i>Facet Techs., LLC v. LifeScan, Inc.</i> , No. 2:22-cv-01717 (C.D. Cal.), FACET_532894] (HIGHLY CONFIDENTIAL – AEO & REDACTED VERSIONS)
2031	RESERVED
2032	<i>Lateral</i> , MERRIAM-WEBSTER.COM, https://www.merriam-webster.com/dictionary/lateral (last visited Dec. 10, 2023, 2:16 PM)
2033	<i>Lateral Orientation</i> , MEDLINEPLUS MED. ENCYC., https://medlineplus.gov/ency/imagepages/9505.htm (last visited Dec. 10, 2023, 2:49 PM)
2034	U.S. Food & Drug Administration (FDA) letter to James Bonds of Facet Technologies, LLC, dated July 15, 2022, Re: Trade/Device Name: Facet 28G Universal Lancet, Regulation Number: 21 CFR 878.4850, Regulation Name: Blood Lancets, Regulatory Class: Class II, Product Code: QRK, QRL, Dated: May 16, 2022, Received: May 17, 2022

Exhibit	Description
2035	Certification & Notice of Interested Parties (Local Rule 7.1-1), <i>Facet Techs., LLC v. LifeScan, Inc.</i> , No. 2:22-cv-01717 (C.D. Cal. May 18, 2022), ECF No. 46
2036	Mass. Inst. Tech. (MIT), Design And Manufacturing I, Undergraduate Course (Spring 2009), DESIGN HANDBOOK: ENGINEERING DRAWING AND SKETCHING, MIT (2001-2023)
2037	RESERVED
2038	<i>Cylinder</i> , OXFORD ENGLISH DICTIONARY, OED.COM, https://www.oed.com/dictionary/cylinder_n?tab=meaning_and_use&tl=true#7621109 (last visited Dec. 1, 2023, 7:38 PM)
2039	<i>Span</i> , MERRIAM-WEBSTER.COM, https://www.merriam-webster.com/dictionary/span (last visited Dec. 10, 2023, 3:49 PM)
2040	LifeScan P&L [produced in <i>Facet Techs., LLC v. LifeScan, Inc.</i> , No. 2:22-cv-01717 (C.D. Cal.), (LSI0000245820.xlsx)] (HIGHLY CONFIDENTIAL – AEO)
2041	<i>Thickness</i> , MERRIAM-WEBSTER.COM, https://www.merriam-webster.com/dictionary/thickness (last visited Dec. 10, 2023, 2:23 PM)
2042	<i>Transverse</i> , MERRIAM-WEBSTER.COM, https://www.merriam-webster.com/dictionary/transverse (last visited Dec. 10, 2023, 2:19 PM)
2043	<i>Anatomy of the Hand</i> , Johns Hopkins Medicine, https://www.hopkinsmedicine.org/health/treatment-tests-and-therapies/anatomy-of-the-hand (last visited Dec. 14, 2023, 10:01 AM)
2044	Asahi email exchanges <i>Facet Techs., LLC v. LifeScan, Inc.</i> , No. 2:22-cv-01717 (C.D. Cal.), ASA08257–8260] (CONFIDENTIAL)

Exhibit	Description
2045	Asahi PowerPoint [produced in <i>Facet Techs., LLC v. LifeScan, Inc.</i> , No. 2:22-cv-01717 (C.D. Cal.), ASA258968–258969] (HIGHLY CONFIDENTIAL – AEO)
2046	LifeScan IP Holdings, LLC, <i>OneTouch® Delica® Plus Lancing Device: Frequently Asked Questions (FAQ) Guide</i> (2019) [produced in <i>Facet Techs., LLC v. LifeScan, Inc.</i> , No. 2:22-cv-01717 (C.D. Cal.), FACET_002122–2126]
2047	LifeScan IP Holdings, LLC, <i>Getting Started Guide: OneTouch® Delica® Plus Lancing Device</i> (2019) [produced in <i>Facet Techs., LLC v. LifeScan, Inc.</i> , No. 2:22-cv-01717 (C.D. Cal.), FACET_002127–2128]
2048	LifeScan IP Holdings, LLC, <i>Lancets – 33 Gauge OneTouch® Delica® Plus Lancets OneTouch Solutions</i> (Mar. 11, 2022), https://shop.onetouch.com/onetouch-delica-plus-lancets-33g/product/OTSUS01_0014 (last visited Jan. 5, 2023, 16:47:17 GMT) [produced in <i>Facet Techs., LLC v. LifeScan, Inc.</i> , No. 2:22-cv-01717 (C.D. Cal.), FACET_002129–2131]
2049	LifeScan IP Holdings, LLC, <i>OneTouch® Delica® Plus Lancets - 30 Gauge OneTouch Solutions</i> (Mar. 11, 2022), https://shop.onetouch.com/onetouch-delica-plus-lancets-30g/product/OTSUS01_0008 (last visited Jan. 5, 2023, 16:47:19 GMT) [produced in <i>Facet Techs., LLC v. LifeScan, Inc.</i> , No. 2:22-cv-01717 (C.D. Cal.), FACET_002132–2134]
2050	Email exchanges between Facet and Asahi [produced in <i>Facet Techs., LLC v. LifeScan, Inc.</i> , No. 2:22-cv-01717 (C.D. Cal.), LSI0000003603–3604] (CONFIDENTIAL)
2051	Email exchanges between Facet and Asahi [produced in <i>Facet Techs., LLC v. LifeScan, Inc.</i> , No. 2:22-cv-01717 (C.D. Cal.), LSI0000003605–3607] (CONFIDENTIAL)
2052	LifeScan Agreement [produced in <i>Facet Techs., LLC v. LifeScan, Inc.</i> , No. 2:22-cv-01717 (C.D. Cal.), LifeScan000001–14] (CONFIDENTIAL)

Exhibit	Description
2053	<i>Wire-Twist™ Wire Connectors: Models WT1, WT2, WT3, WT4, WT6</i> (Product Fact Sheet), Ideal Industries, Inc.
2054	Japan Patent Office, Patent Publication (B2), No. 3621502 (“Morita”)
2055	Karl Warsi, SIMPLY MATHS 101 (Michael Clark et al. eds. 2022) (excerpt)
2056	Declaration of John M. Collins in support of the Patent Owner Response (“Collins POR Decl.”)
2057	Answer to Complaint, <i>Facet Techs., LLC v. LifeScan, Inc.</i> , No. 2:22-cv-01717 (C.D. Cal. May 11, 2022), ECF No. 42
2058	Facet Supply Agreement [produced in <i>Facet Techs., LLC v. LifeScan, Inc.</i> , No. 2:22-cv-01717 (C.D. Cal.), FACET_00005340] (CONFIDENTIAL)
2059	Declaration of Don Colter Regarding Facet P&L (Ex.2030) [<i>served, not filed</i>]
2060	Declaration of Susan Y. Tull in Response to Petitioner's Objections to Patent Owner's Exhibits [<i>served, not filed</i>]
2061	[Executed] Deposition Transcript of Joel Delman, <i>Facet Techs., LLC v. LifeScan, Inc.</i> , No. 2:22-cv-01717 (C.D. Cal. July 7, 2023) (signed January 4, 2024) [<i>served, not filed</i>]
2062	Errata Sheet and Acknowledgement of Deponent for Deposition Transcript of Joel Delman, <i>LifeScan, Inc. v. Facet Techs., LLC</i> , IPR2023-00712 (P.T.A.B. Dec. 5, 2023) (signed December 30, 2023) [<i>served, not filed</i>]
2063	Errata Sheet and Certificate of Deponent for Deposition Transcript of Gregory A. Lamps, <i>Facet Techs., LLC v. LifeScan, Inc.</i> , No. 2:22-cv-01717 (C.D. Cal. May 25, 2023) (signed January 4, 2024) [<i>served, not filed</i>]

Exhibit	Description
2064	Deposition transcript of Joel Delman, <i>LifeScan, Inc. v. Facet Techs., LLC</i> , IPR2023-00712 (P.T.A.B. Apr. 25, 2024) (“Delman IPR Dep. II”)
2065	Deposition transcript of Paul Hatch, <i>LifeScan, Inc. v. Facet Techs., LLC</i> , IPR2023-00712 (P.T.A.B. Apr. 10, 2024) (“Hatch Dep.”)

I. Introduction

Petitioner has failed to prove that the claims of the '635 patent are invalid. Facet showed that the Petition was replete with inconsistencies and unreliable analysis. Petitioner's Reply, accompanied by 25 new exhibits and 3 new declarations, adds several new contradictions on all the key disputes. Petitioner and Mr. Delman, for example, identify two different lengths for Saikley's alleged gripping handle portion—one extending to the end of the cap, one extending only to the secondary sheath. Petitioner's ever-shifting mapping to the art highlights that it has failed to carry its burden of setting forth credible, reliable, legally-sound evidence proving that the claims are invalid.

Petitioner's obviousness arguments are also full of contradictions. As just one example, Mr. Delman argues that a POSITA would be motivated to make a lancet cap *larger*, but Mr. Hatch argues that a POSITA would be motivated to make it *smaller*. Petitioner cannot establish obviousness with its own dueling experts.

Mr. Hatch even contradicts *himself* in relation to secondary considerations. In his declaration, he first argues that a user would *never* grip the Delica lancet at the end of the cap (i.e., at the secondary sheath), and then argues that this exact location is the *only* place that a user would grip the same lancet.

Petitioner's experts' contradictions not only undermine Petitioner's rebuttal on secondary considerations, but undercut Petitioner's invalidity arguments more

broadly. These very contradictions demonstrate that the claimed invention is not anticipated and was not obvious to a POSITA; they also strip Petitioners' experts of any credibility they may have had.

The evidence of record—including overwhelming objective indicia—confirms that Petitioner failed to prove the claims invalid.

II. Petitioner's Reply strengthens non-obviousness via objective indicia.

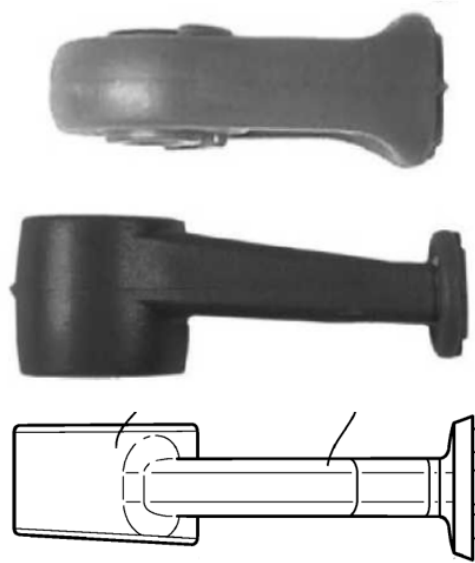
Petitioner has not only failed to rebut Facet's objective indicia, but it has strengthened them with its evidence and arguments.

A. Petitioner's reply reinforces LifeScan's copying of the '635 patent.

1. Differences in the lancets do not disprove copying.

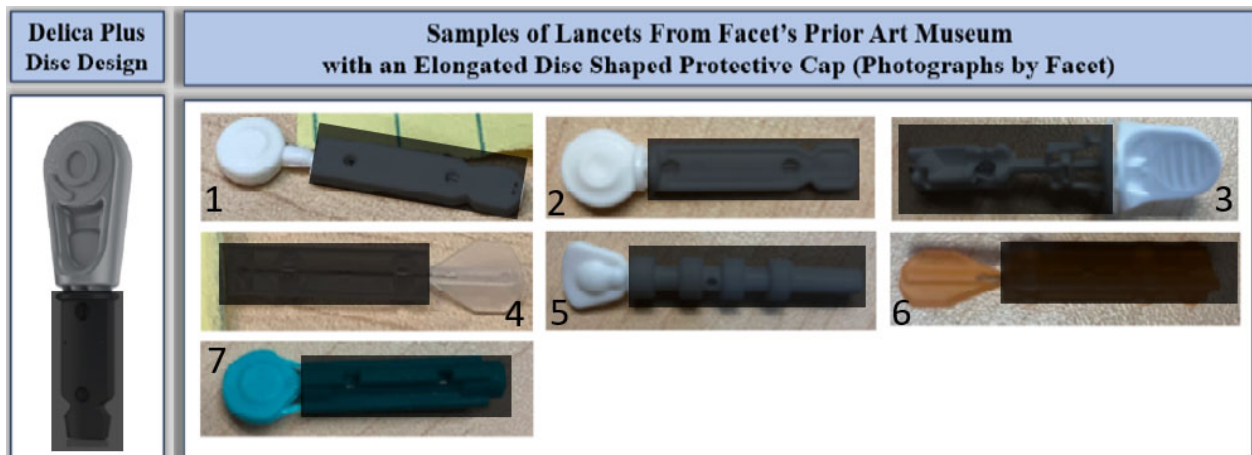
LifeScan points to irrelevant differences between the Delica and Delica Plus lancets in attempting to disprove copying. Reply 46-47. LifeScan cites differences in shape of the secondary sheaths and hollowness of the Delica "neck." Reply 46. But LifeScan cannot escape copying by modifying aspects of the lancet that do not relate to the claims.

The evidence shows that LifeScan copied the claimed features of the Delica lancet—and thus copied the '635 patent—including its primary sheath, its secondary sheath, and importantly, the gripping handle portion extending between the sheaths.



LifeScan's Delica Plus (top), Facet's Delica (middle), '635 Figure 5C (bottom)
(Ex. 1034 46)

Other designs reinforce LifeScan's copying. Petitioner describes these lancets as having "Elongated Disc Shaped Protective Cap[s]." Reply 46. But as shown below with the cap highlighted, none of these lancets have elongated disc-shaped caps.



Reply 47 (annotated)

Several of these designs (3, 4, 6) do not have a secondary sheath—and in the ones that might, the potential secondary sheath either overlaps with (2, 5, 7) or directly abuts (1) the primary sheath. None of these lancets have the “neck” that Petitioner admits to be in the Delica, Delica Plus, and the '635 patent designs, at least part of which forms a gripping handle portion extending between the sheaths—let alone with the claimed dimensions.

Petitioner further compares the Delica lancet to lancets with supposed “Cup-Shaped Protective Cap.” But again, as shown below, when the caps are highlighted, not one has a “neck” forming the gripping handle portion of the claims, let alone the recited dimensions.



Reply 47 (annotated)

Mr. Delman further shows that LifeScan has designs for other lancets.

Ex.1034 ¶¶56-57. Just as with the lancets above, its sheaths overlap with no “neck” or gripping handle portion extending between sheaths.



Ex.1034 35 (annotated)

Mr. Hatch asserts these or similar designs are non-infringing alternatives that LifeScan could have used to avoid the '635 patent. Ex.1045 ¶¶230-31. Yet LifeScan chose to copy the '635 patent and include the gripping handle portion of the claimed dimensions in the Delica Plus lancet. As discussed below, that choice was deliberate.

2. Mr. Hatch's testimony supports copying.

Arguing a lack of nexus, Mr. Hatch asserts that Facet's Delica lancet and LifeScan's Delica Plus do not read on the claims *for the exact same reasons*. Ex.1044 ¶10. Specifically, Mr. Hatch asserts that both lancets have “necks” that are not

designed to be gripped and are therefore not gripping handle portions. Ex.1044 ¶11.

Mr. Delman agrees with Mr. Hatch. Ex.1034 ¶51.

Thus, according to Petitioner's own experts, the Delica and Delica Plus lancets rise and fall together with respect to their reading on the claims.¹ This further highlights LifeScan's copying.

3. [REDACTED] show copying.

Although Petitioner disputes specific details of the copying, it remains un rebutted that LifeScan copied Facet's design when creating the Delica Plus lancets.

Petitioner does not rebut that [REDACTED]

[REDACTED]

[REDACTED] (Ex.2044-003), and that [REDACTED]

[REDACTED]. Ex.2044-001

([REDACTED]). [REDACTED]

[REDACTED] (Ex.2044-001-

002) [REDACTED] Ex.2024 144:15-17.

* * *

Petitioner's evidence shows that the Delica lancet is distinct from other lancet designs and that LifeScan copied the claimed features of the Delica lancet when

¹ Petitioner has not disproven that both lancets practice claim 6. *See* §II.B.

designing the Delica Plus [REDACTED]

[REDACTED]. LifeScan's copying is strong objective indicia of non-obviousness that overcomes Petitioner's obviousness grounds.

B. Delica/Delica Plus practice the claims.

Petitioner relies on Mr. Hatch's declaration to argue that the Delica/Delica Plus do not contain a "gripping handle portion." Reply 30. In doing so, Petitioner and its declarants read limitations into the claim and improperly compare the products to embodiments in the specification.

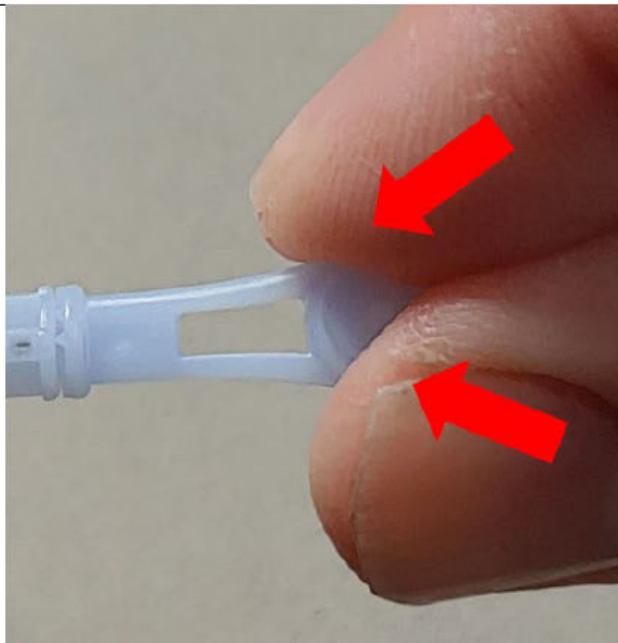
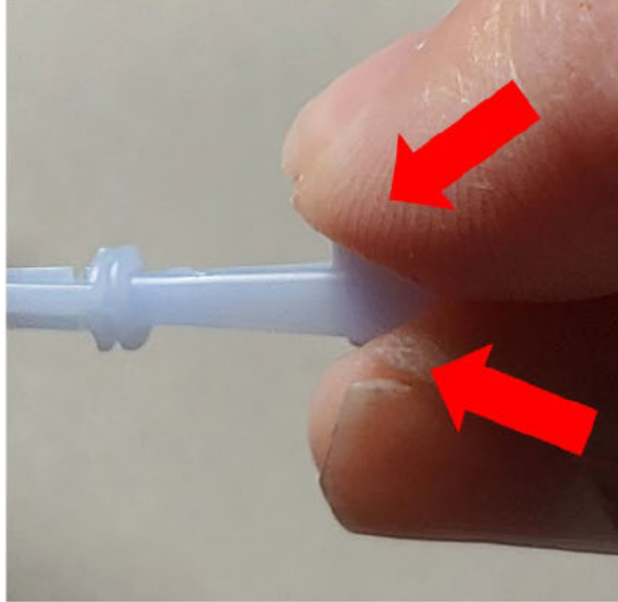
But even setting those errors aside, Mr. Hatch's testimony should not be given any weight because it is self-contradictory. When disparaging the motivation by a POSITA to lengthen the cap, Mr. Hatch approvingly quotes from "an instructional video on how to handle the Delica Lancet" as teaching "***You don't want to hold it up here [on the secondary sheath]*** because the lancet[']s [needle] so fine you can bend it." Ex.1045 ¶170. Mr. Hatch reproduces a screenshot from this video showing exactly where "You ***don't*** want to hold" the Delica Lancet—i.e., on the secondary sheath.

**Ex.1045 ¶170**

To the contrary, “it’s *best* you just *hold it in the middle and push.*” Ex.1045 ¶170 (quoting *One Touch Verio*, YOUTUBE.COM (last visited May 2, 2024), <https://www.youtube.com/watch?v=OVSrbH25oo0>). The below screenshot from the video cited by Mr. Hatch shows where “it’s best” to hold the Delica lancet “and push.” Specifically, “*it’s best*” to hold the lancet *at the gripping handle portion* of the Delica lancet, which Mr. Hatch calls the “neck.”



But when opining on whether the Delica lancet has a gripping handle portion, Mr. Hatch flip-flops. Here, Mr. Hatch states that the *best* place to grip the Delica lancet while pushing into the lancing device is at the secondary sheath. Ex.1044 ¶16. (“[T]he secondary sheath is the only structure that physically accommodates the human finger while providing advantages when handling the lancet during normal use I also conducted a similar handleability analysis the [*sic*] Delica protective cap and reached the same conclusions.”); Ex.1045 ¶214 (secondary sheath is “the best point from which to twist”).

Table 2: Gripping Positions**Push Movement****Delica****Ex.1044 9**

Mr. Hatch thus makes the contradictory arguments that 1) a user would only grip the secondary sheath and 2) a user should avoid gripping the secondary sheath due to risk of bending the needle. The latter argument strips Mr. Hatch's credibility on the gripping handle portion of the Delica/Delica Plus lancets and leaves Petitioner with no credible evidence for its *only* argument that these lancets do not practice the claims. Mr. Delman does not cure Mr. Hatch's testimony as he merely relies on and adopts Mr. Hatch's methodology. Ex.1034 ¶51.

Nevertheless, Mr. Hatch also applies a different claim interpretation than Petitioner's invalidity grounds. Specifically, Mr. Hatch requires a gripping handle portion to be "designed to (i) physically fit or accommodate the users' hand and or fingers; and (ii) to provide a physical advantage to use." Ex.1045 ¶207. Additionally, "[t]hese physical attributes are also usually visibly communicated to the user" Ex.1045 ¶207; *see also* Ex.2065 28:17-31:6 (Mr. Hatch reading these requirements into the claims). These requirements are based on nothing more than Mr. Hatch's conclusory testimony, and Petitioner does not apply them in its invalidity grounds. Petitioner and Mr. Hatch also err by directly comparing the products to embodiments in the specification rather than the claims. *E.g.*, Reply 30-32.

C. Petitioner did not rebut co-extensiveness of the Delica or Delica Plus.

Petitioner has not rebutted co-extensiveness of the Delica/Delica Plus lancets with the '635 claims. Petitioner asserts that the *lancing device* is unclaimed.² Reply 39. Both Petitioner and Facet cite to sales of *lancets*, not lancing devices. The relevant product is not the lancing device, but rather the lancets that Mr. Delman admits are sold separately. Ex.2064 44:19-46:1.

Petitioner fails to discredit the Delica/Delica Plus lancets as coextensive with the claims. Although Petitioner alleges “several critical and unclaimed features” of these lancets, Petitioner only cites to “the structure and design of the lancet body that allows the lancet to be seated within the Delica or Delica Plus lancing device” and “particular aspects of the lancet needle (including its 30 or 33 gauge).” Reply 39. But the key aspects of the “structure and design of the lancet body” are claimed via the dimensional limitations involving the lancet body. Petitioner has not shown that any other aspects of the lancet body structure and design are critical. For example, Petitioner's expert admits that the lancet does not need to be used with a lancing system (Ex.1034 ¶71), and therefore doesn't need to be seated within the lancing device to be used. Further, the Delica Plus lancets are sold with both 30 or 33 gauge

² Petitioner falsely asserts that Dr. Collins did not evaluate co-extensiveness. Reply 38; *but see* Ex.2056 ¶¶136-51.

needles that the user can choose based on their own personal preferences and skin sensitivity. Ex.2056 ¶137. Unlike *Fox Factory*, where the patent owner extolled the criticality of unclaimed features, here the record supports that the allegedly unclaimed features are not critical. *Fox Factory, Inc. v. SRAM, LLC*, 944 F.3d 1366, 1374-75 (Fed. Cir. 2019).

Facet's marking practices do not disprove co-extensiveness. Petitioner relies on a statement that products "may" be covered by more than one patent without looking at the patents to determine whether they disprove co-extensiveness. Reply 40-42. Mr. Delman admitted he hasn't analyzed Facet's other patents. Ex.2064 52:12-19. But Petitioner has no legal support for its assertion that mere marking—let alone marking with "may" language—defeats co-extensiveness. Rather, in *Fox Factory*, the court found that the patent owner's obtainment of another patent "covering [a combination of features] leads us to conclude that this combination of features amounts to more than an insignificant feature not claimed by the" challenged patent. 944 F.3d at 1375. And in *Therasense*, the patent owner's expert admitted that the products met all of the limitations of another patent. *Therasense, Inc. v. Becton, Dickinson & Co.*, 593 F.3d 1289, 1299 (Fed. Cir. 2010). Here, there is no such analysis and no record of the products embodying two patents. Nevertheless, even if Facet's marking related to the *FMT lancet* defeated co-

extensiveness, it does not defeat the co-extensiveness of the claims with respect to the *Delica Plus* lancets, which Facet does not produce or mark.

D. Petitioner has not rebutted the presumption of nexus for commercial success.

Petitioner does not deny commercial success of the Delica and Delica Plus lancets. Instead, Petitioner argues lack of nexus. Reply 38. Citing to Mr. Rosenfarb, Petitioner first asserts that [REDACTED], and then argues that [REDACTED].

Mr. Rosenfarb's testimony [REDACTED] holds no weight because it is based on either evidence not in the record in this proceeding or inadmissible hearsay, which Facet has moved to exclude (Paper 43). Mr. Rosenfarb's opinion is not based on any facts or admissible evidence, and should not be given any weight.

Petitioner's [REDACTED] does not weigh against nexus. Petitioner assumes, without basis, that all lancets practicing the invention must have similar sales to show nexus. Reply 43. But this assumption wrongly requires commercial success to be entirely attributable to the claims. But nexus does not require the claimed invention to be the sole reason for commercial success, and that other factors can contribute to commercial success. *Cont'l Can Co. USA, Inc. v. Monsanto Co.*, 948 F.2d 1264, 1273 (Fed. Cir. 1991). Here, where both products embody the claimed invention, it does not diminish nexus [REDACTED].

Petitioner also fails to address the fact [REDACTED]

[REDACTED]

[REDACTED]

[REDACTED] POR 3. [REDACTED]

[REDACTED]

[REDACTED] POR 1-4.

LifeScan's copying of the Delica [REDACTED]

[REDACTED] (Ex.2044-003) further contradicts its arguments [REDACTED].

E. Saikley and Iio did not meet the long-felt need.

Despite Petitioner discussing various commercial lancet designs (*id.* 47), there is no evidence that anything like Saikley's or Iio's lancets was ever commercialized or ever met the long-felt need before the priority date of the '635 patent. *Monarch Knitting Mach. Corp. v. Sulzer Morat GmbH*, 139 F.3d 877, 884 (Fed. Cir. 1998) (two prior-developed designs did not meet need where they were not commercialized before priority date of disputed patent).

III. Grounds 1-3: Petitioner failed to rebut Facet's Saikley arguments.

Facet's Response highlighted inconsistencies in Petitioner's mapping of Saikley to the primary sheath, secondary sheath, and gripping handle portion. In Reply, rather than clarifying its argument, Petitioner compounded its inconsistencies

by submitting contradictory declarations. As shown below, Petitioner's Reply further demonstrates that Petitioner has not met its burden.

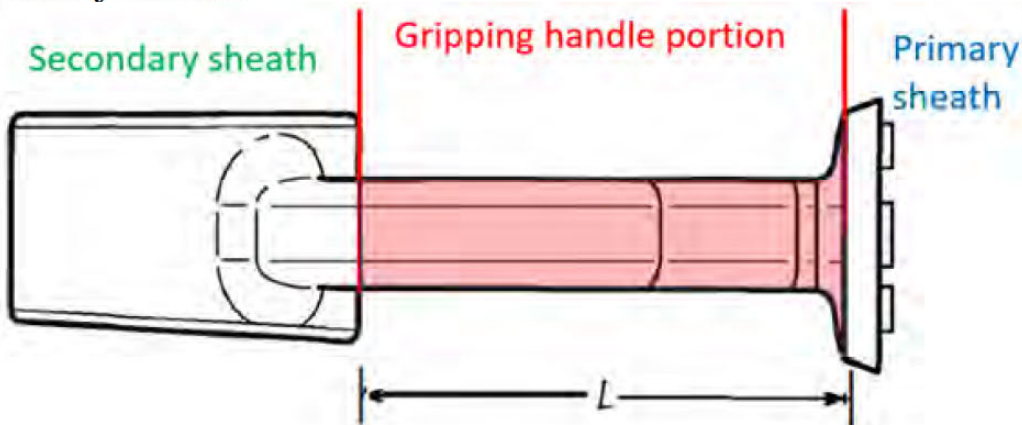
A. Petitioner's own experts contradict its improper claim construction.

Petitioner accuses Facet of making a claim construction argument for "gripping handle portion" that Petitioner disputes. Reply 10. Facet made no such claim construction argument, but rather showed that Petitioner's ever-shifting approach to invalidity cannot meet the limitations as arranged in the claims under their plain and ordinary meanings. POR 5-15. Petitioner uses Facet's arguments as a pretext to introduce a broadening claim construction late in this proceeding.

Petitioner asserts that "[a] gripping handle portion extends between the sheaths even if portions of the handle also extend around one or both sheaths." Reply 10. To the extent Petitioner intended to mean that the "gripping handle portion" can "also extend around one or both sheaths," *Petitioner's own expert disagrees*. According to Mr. Hatch, "the gripping handle is distinct from the primary sheath and *starts where the sheath ends*." Ex.1045 ¶176.³ In support of his opinion, Mr. Hatch annotated Figure 5C of the '635 patent as shown below.

³ Exhibit 1045 is Mr. Hatch's report from the district court. In his IPR declaration (Exhibit 1044), he adopts and swears to Ex. 1045. Ex.1044 ¶¶7-9.

Table 11: The length “L” terminates where it meets the primary and secondary sheaths.



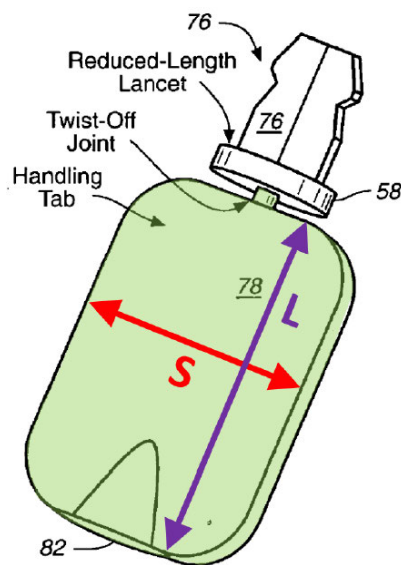
Annotated Figure 5C of the '635 Patent

Ex.1045 ¶139

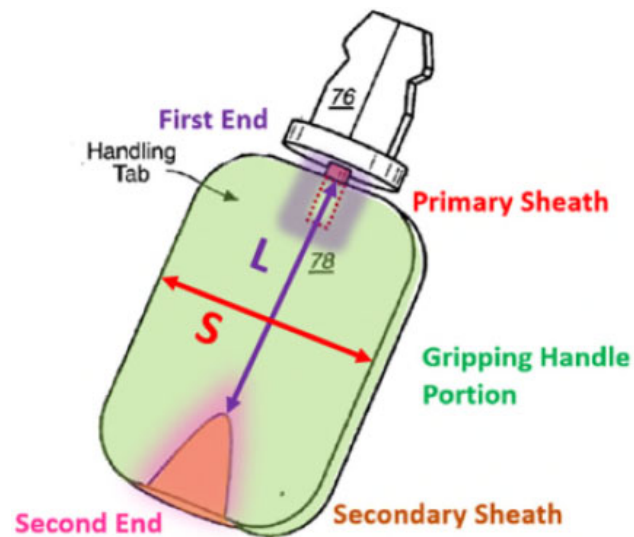
Mr. Hatch agreed with the district court's claim construction order (Ex.1004) that the above figure “shows the length of the gripping handle ‘L’ as a line segment that *terminates at each respective end of the gripping handle portion, between the primary and secondary sheaths.*” Ex.1045 ¶139.

Petitioner cites to Mr. Delman's discussion of a “PHOSITA's understanding of ‘extends between’” (Reply 10), but ignores the contradictory testimony by its other expert, Mr. Hatch. Where Mr. Delman cites to Figure 5C as showing “the length ‘L’ of gripping handle portion . . . from a location that is ‘surrounding’ and ‘engulfing’ the primary sheath” (Ex.1034 ¶11), Mr. Hatch asserts that “the gripping handle . . . starts where the sheath ends” (Ex.1045 ¶176), and that defining the gripping handle to “overlap the secondary sheath . . . contradicts the [’635] patent” (Ex.1045 at 95).

Mr. Delman even contradicts himself. As detailed below in Section III.C, Mr. Delman changed the way he measures the length of the gripping handle portion of Saikley between his two declarations. In his first declaration, Mr. Delman measured the length of the gripping handle portion as the entire length of the cap (below, left). In his reply declaration, however, he measured the length of the gripping handle—contradicting Petitioner—*where the secondary sheath ends* (below, right).



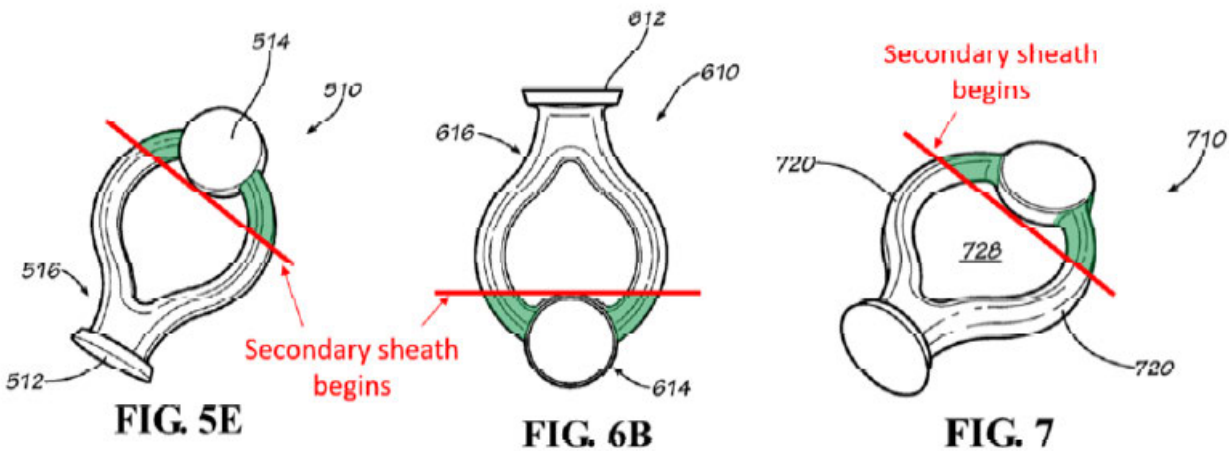
Ex.1002 76



Ex.1034 21

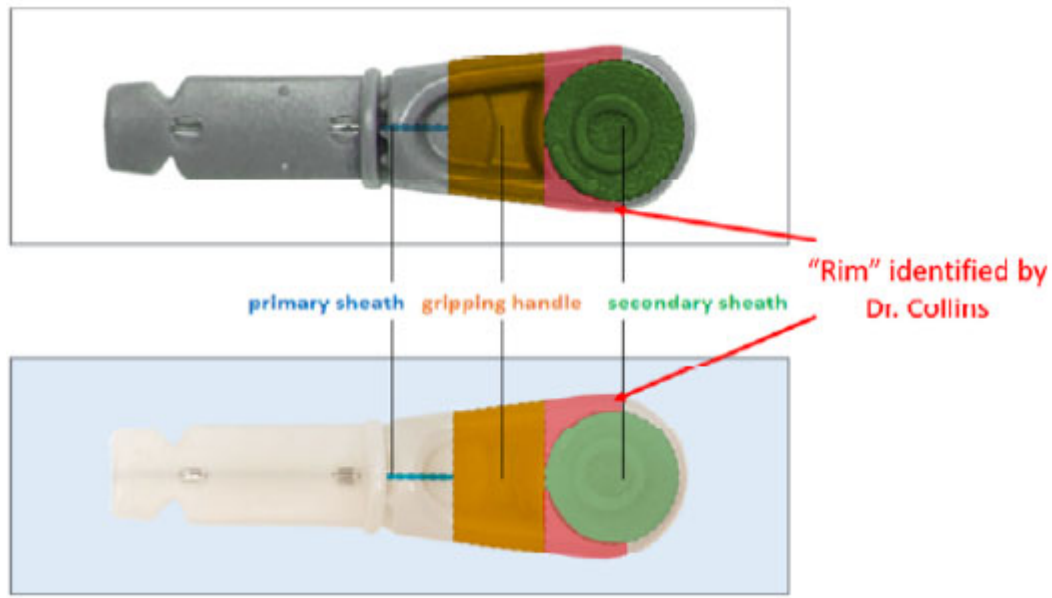
Petitioner has no support for its assertion that any interpretation contrary to its own would “exclude every cap embodiment” in the ’635 patent. Reply 10-11. Petitioner draws a line where the “Secondary sheath begins” in Figures 5E, 6B, and 7 of the ’635 patent and argues that the gripping handle portion cannot end there without excluding these embodiments. Reply 10-11.

Ex.1001, Figure 5E, 6B, 7

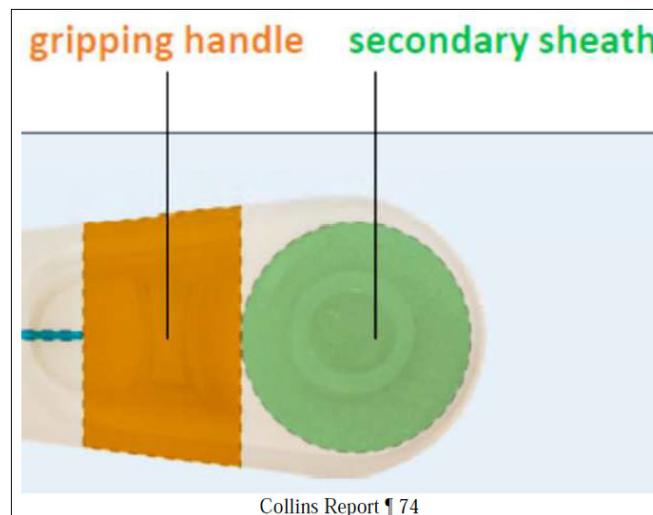


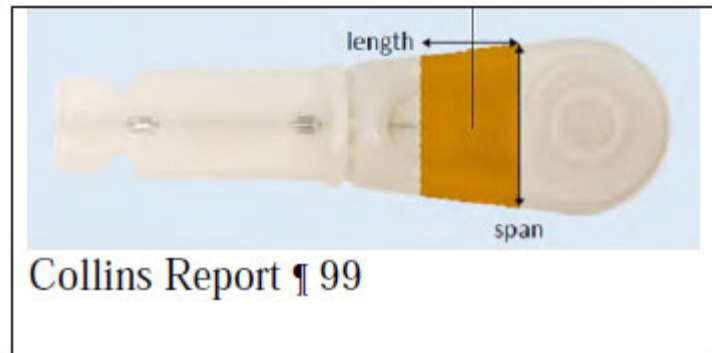
But in fact, as shown above, Mr. Hatch shows that the illustrated embodiments easily map to the claimed gripping handle portion in the '635 patent, such that the gripping handle portion “starts where the sheaths end.” Ex.1045 ¶176.

Dr. Collins's district court testimony is consistent with his positions in this IPR. As explicitly shown in the excerpts cited by Petitioner, Dr. Collins defines the accused gripping handle portions (bronze) to end where the sheaths (blue and green respectively) begin, and vice versa.

**Reply 12 (annotated)**

The red “rim” was added by Petitioner and is not part of Dr. Collins’s infringement analysis. *Cf.* Ex. 1045 ¶176 (reproducing Dr. Collins’s annotations for length and span of the gripping handle portion).

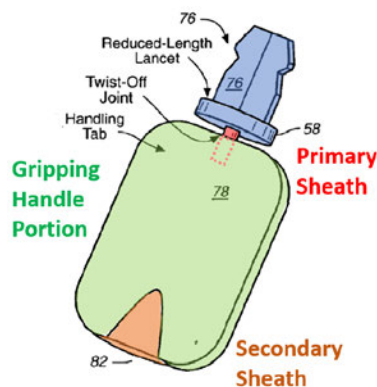
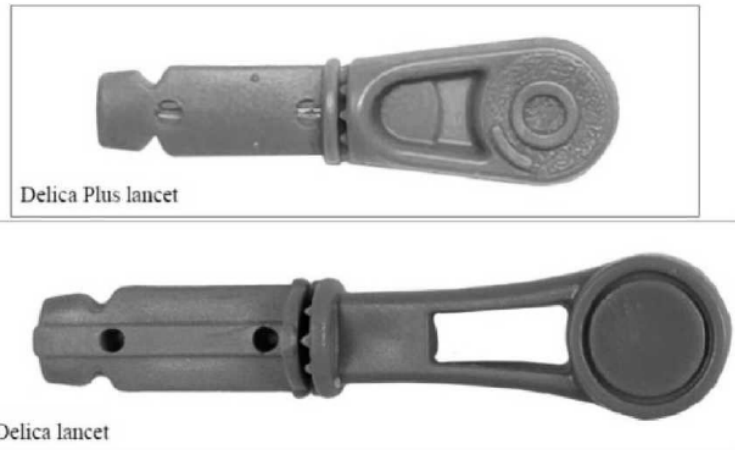
**Ex.1045 90**

**Ex.1045 93**

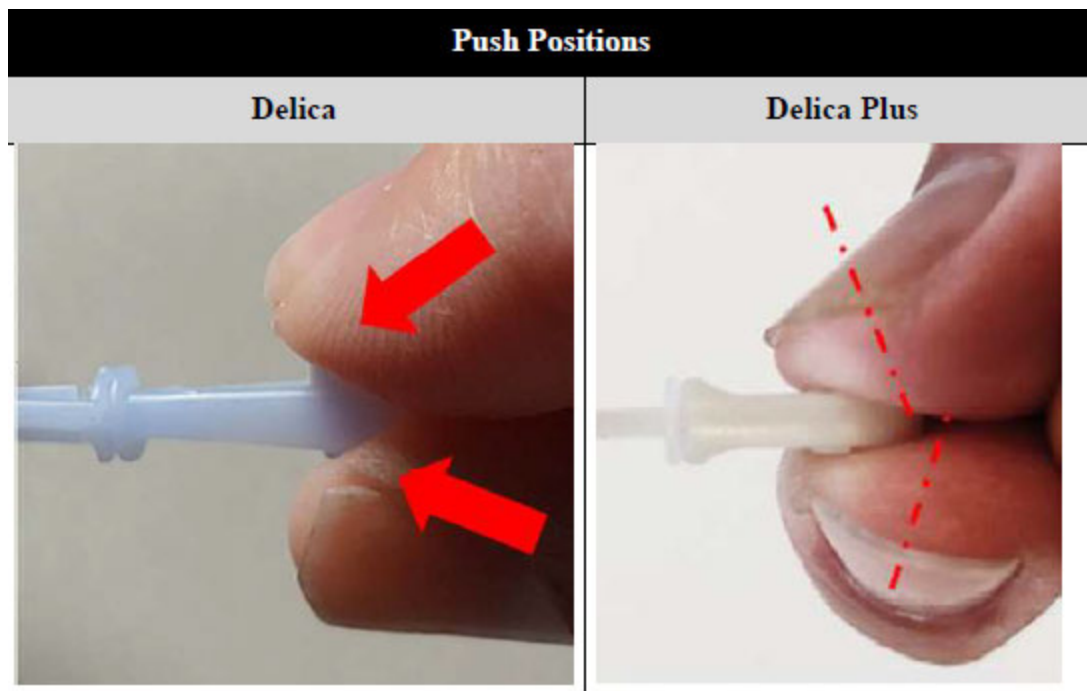
The deposition testimony cited by Petitioner conveys that, at best, Dr. Collins had not considered the question at the time, yet answered that he did not think the “rim” was part of the gripping handle. Reply 12.

B. Petitioner's Delica/Delica Plus arguments contradict Grounds 1-3.

Petitioner applies a double standard for mapping the claims in its asserted grounds and its nexus argument. Petitioner asserts that Saikley's entire tab 78, shown in green below, left, is a gripping handle portion, and yet the “necks” extending between the primary and secondary sheaths of the Delica and Delica Plus, below, right, are not.

**Petition 19****Ex.1034 45**

But to find that the “necks” are not “gripping handle portions,” Petitioner applies Mr. Hatch’s understanding of “gripping handle portion,” imposing three requirements that Petitioner does not address when mapping Saikley. *See* Section II.B, *supra*. Mr. Hatch performed a comparison of grips on the pushing and twisting motions for these caps and graded each grip with subjective commentary. Ex.1044 ¶16. Mr. Hatch concluded that a POSITA would have held the Delica/Delica Plus caps at the farthest point away from the needle, at the secondary sheath, as shown below.



Reply 36

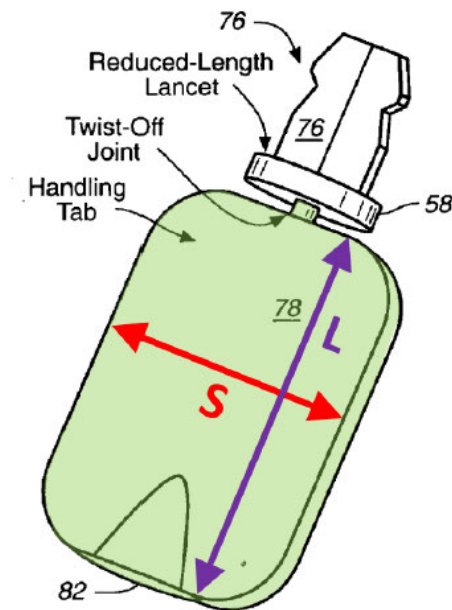
Although his analysis is fatally flawed, self-contradictory, and unreliable (as shown in Section II.B), Petitioner never performed anything close to this type of analysis for Saikley and Iio despite purporting to have 3D-printed models of these designs. Instead, Petitioner shows Saikley next to a picture of a key being turned in a door. Petition 25. Petitioner does not attempt to distinguish between any grip on Saikley's secondary sheath and the portion between the sheaths; let alone show that any portion extending between sheaths provides any physical advantage as compared to the rest of the cap. Instead, Petitioner focuses on the leverage provided by the *entire cap*. Petition 25-26. Nevertheless, Petitioner asserts that the users can "grip the lancet further away from the needle sharp," implying that the user would

grip it at the end of the cap—at the secondary sheath—not any portion extending between sheaths. Petition 26.

Petitioner cannot have it both ways. By applying a double standard to meet its varying needs for invalidity and nexus, Petitioner has failed to meet its burden.

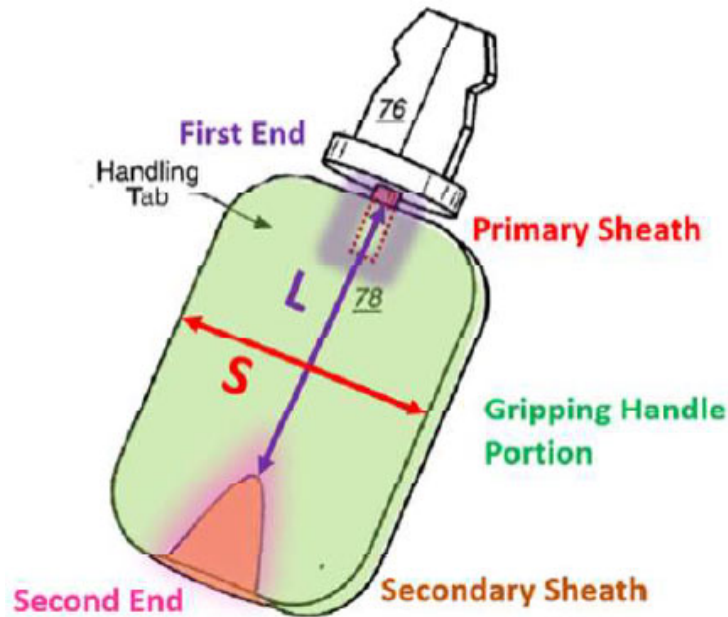
C. Petitioner and Mr. Delman changed how they measure the length defined by the gripping handle portion.

The Petition identified the entire length of the cap as the length defined by the gripping handle portion, as shown by the purple arrow below.



Petition 41; Ex.1002 76

In Reply, Petitioner changes its theory. In a drawing that Petitioner calls “Saikley’s Length” and Mr. Delman calls “Appropriate Length Measurement,” they both now measure length from the end of Saikley’s secondary sheath.



Reply 22; Ex.1034 21

When asked about these different measurements in deposition, Mr. Delman initially was unaware that he had changed how length was measured. Ex.2064 26:12-19. He subsequently admitted that the measurements were different but insisted that both were “accurate.” *Id.* 28:4-29:3. Declining to specify which measurement maps to the claims, Mr. Delman insisted that it was appropriate to provide a different length measurement in rebuttal to Dr. Collins’ opinion. *Id.* 28:13-36:22.

Changing arguments in reply and advocating for two different, contradictory mappings, demonstrates that a POSITA—without Petitioner’s benefit of hindsight and army of malleable experts—would not have understood Saikley to invalidate the ’635 claims. Petitioner’s shifting positions shows that it failed to meet its burden.

D. Petitioner continues to improperly rely on measurements of patent drawings.

Petitioner cites C.C.P.A. cases in support of using figures to teach dimensional limitations. Reply 13-15. These cases cannot outweigh subsequent Federal Circuit precedent. Indeed, *In re Mraz* has only been cited once by the Federal Circuit for its holding about patent drawings, in the non-precedential *PlaSmart* opinion already briefed by the parties. POR 18. Petitioner does not defend *PlaSmart* in its Reply.

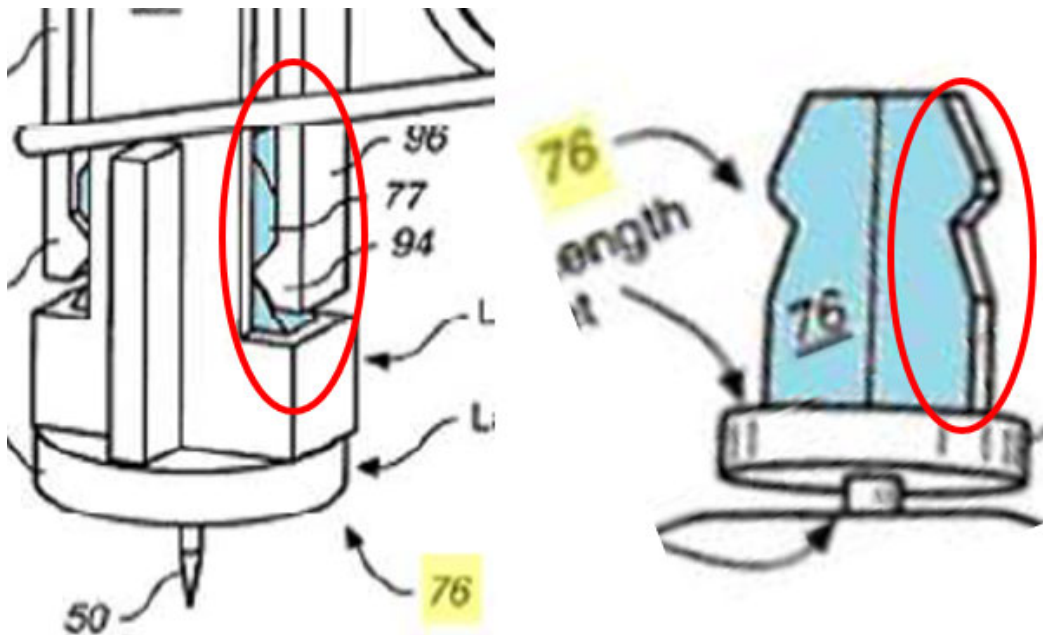
Petitioner's only Federal Circuit case is *Koito*, which found written description support for "significantly thicker and wider" in a figure. Reply 14. Unlike what the Board would have to find here, the court did not find clear disclosure of a dimensional ratio.

Nor does the Director's recent decision in *Mahle* contradict Facet's argument or override Federal Circuit precedent. There, rather than measuring distances, lengths, spans, or thicknesses, the Director observed that figures showing a claimed feature *at* an inlet can be relied upon for disclosure of a limitation that the feature be "within 10 inches" of the inlet. *Mahle Behr Charleston Inc. v. Catalano*, IPR2023-00861, Paper 15 at 4-6 (Vidal Apr. 5, 2024).

Petitioner criticized *Hockerson*, *Plantronics*, and *Source Vagabond* as relating to claim construction. But the Federal Circuit has expressly applied *Hockerson* to prior art, "indicat[ing] our disfavor in reading precise proportions into patent drawings which do not expressly provide such proportions." *Nystrom v. Trex Co.*,

424 F.3d 1136, 1149 (Fed. Cir. 2005) (reversing invalidity based on “evidence improperly derived from a patent drawing” where district court wrongly disregarded *Hockerson*).

Facet showed that Saikley does not clearly disclose the dimensional limitations. POR 5-15. Rather than dispute Saikley's discrepancies, Petitioner asserts that “Saikley's Figures 6, 7A, and 8 provide three different views, all depicting the same thin, flat lancet.” Reply 17. Not so. As annotated below, the lancet body of Figure 6 appears to be several times thicker than in Figure 7A, further demonstrating the unreliability of using Saikley's figures for dimensional measurements.



Reply 18 (annotated)

Saikley's specification does nothing to bolster its ground for the same reasons discussed in the POR. Further, Petitioner's allegations of inconsistency with a priority argument are meritless at least because there is no priority dispute in this proceeding. *Cf.* Reply 16-17.

E. Petitioner's new obviousness arguments are fatally flawed.

Rather than defend its argument that the dimensional limitations are "meaningless" (Petition 48-49), Petitioner changes its argument, citing to *In re Applied Materials* to argue that the dimensions are not "critical" and "there was no evidence of unexpected results." Reply 23. But these issues—criticality and unexpected results—are not applicable without a *prima facie* showing of invalidity based on an overlap of a claimed range in the prior art or a showing that the claimed dimensions are a result-effective variable. *In re Applied Materials, Inc.*, 692 F.3d 1289, 1297 (Fed. Cir. 2012) ("[O]ptimizing a result-effective variable may still be patentable if the claimed ranges are 'critical' Similarly, a *prima facie* case of obviousness established by the overlap of prior art values with the claimed range can be rebutted by evidence that the claimed range is 'critical' because it 'achieves unexpected results.'"). Petitioner has made no *prima facie* case of obviousness showing overlapping ranges, or that the ratio of cap-span to lancet-body-thickness was a known result-effective variable. Instead, Petitioner only argues lack of criticality, which cannot itself establish obviousness. Nevertheless Dr. Collins'

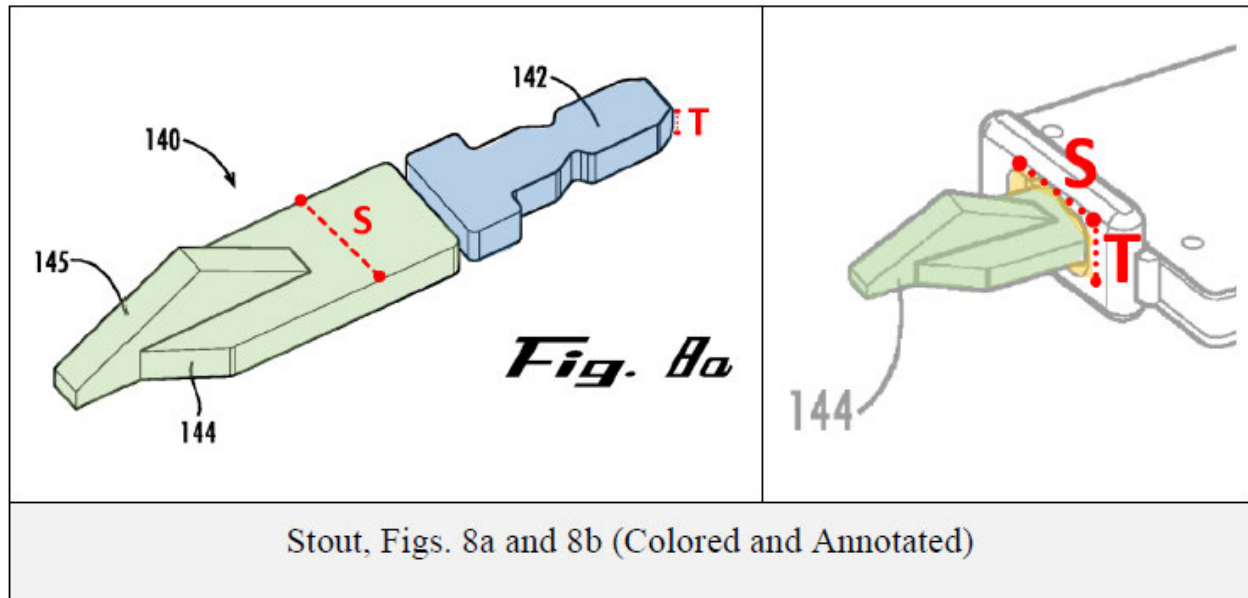
deposition testimony in this IPR supports criticality of the claimed dimensions. Ex.1058 67:22-69:4.

Petitioner also abandons its “routine optimization” and “common sense” arguments in favor of new obvious-to-try arguments. Reply 23 (*cf.* Petition 49-53). Petitioner still failed to present a finite number of known solutions. Petitioner’s obvious-to-try argument fails for the same reasons as its similar argument for Iio—specifically, Petitioner’s own evidence shows a huge number of dimensions to consider and ranges for those dimensions, and Petitioner’s declarant Mr. Hatch asserts that a POSITA would have been motivated to make caps *smaller*, not larger. *See* Section IV.C, *infra*. Similar to his testimony about Iio, Mr. Delman’s obvious-to-try discussion for Saikley should be given no weight as it contradicts his own sources, is based on nothing but hindsight bias, and focuses on potato peelers rather than lancets. Ex.1034 ¶¶29-31.

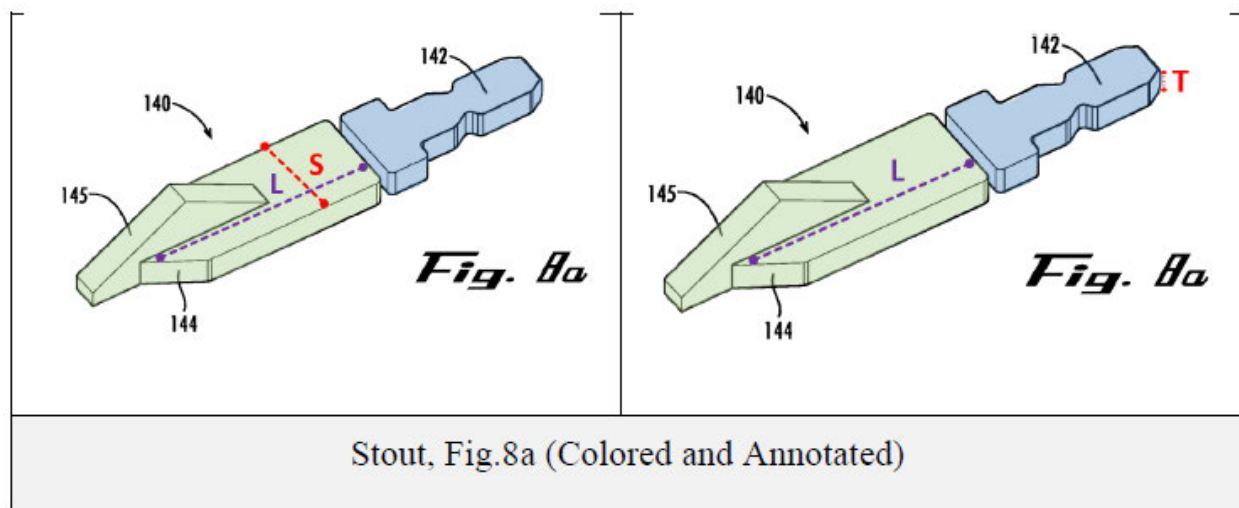
F. Petitioner’s Saikley-Stout combination is improper.

Petitioner accuses Facet of misunderstanding its Saikley-Stout combination. Reply 25. To the extent there is any confusion about Petitioner’s combination, it is because the combination is poorly defined in the Petition. For example, the Petition explicitly relies on dimensional measurements from Stout’s Figures 8a and 8b, as shown below, including reliance on the dimensions of the slotted opening of Stout’s

lancing device which, according to Petitioner, “lancet must pass through.” Petition 53.



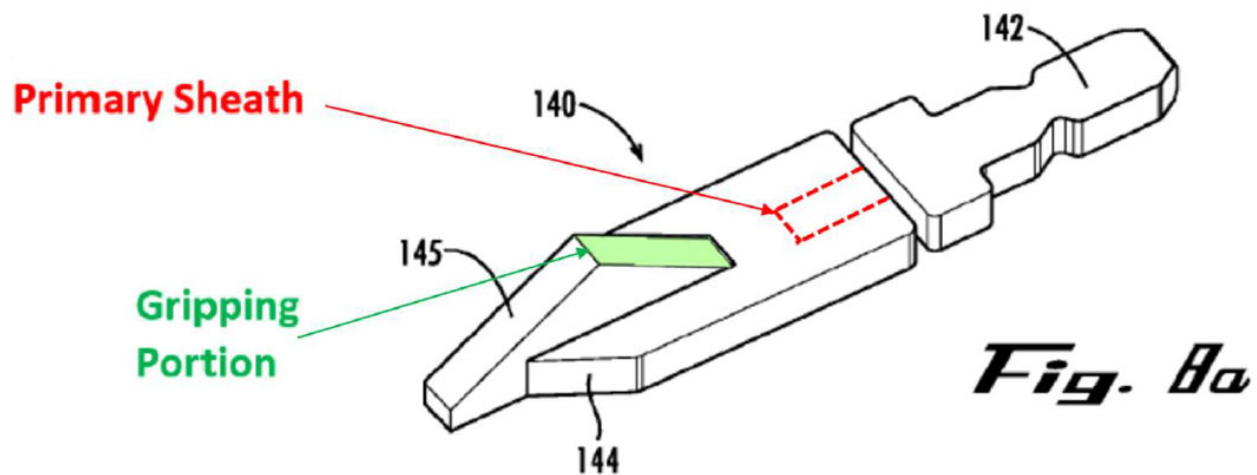
Petition 53



Petition 54

In Reply, Petitioner doesn't dispute that Stout lacks a secondary sheath and that Stout's gripping portion (to the extent there is one) is the small portion shown

below. Petitioner further does not dispute that this gripping portion (below) appears to have significantly smaller dimensions than those measured by Petitioner (above).



POR 45

Instead, Petitioner asserts that its combination “modif[ies] Saikley’s handling tab in view of Stout’s dimensions” in order to have “backwards-compatibility with Saikley’s system.” Reply 25-26. To that end, Petitioner asserts that Saikley’s handling tab would *not* be inserted into the lancing device. *Id.* 25.

Petitioner has not rebutted Facet’s criticisms of its combination. There is no need to modify Saikley’s dimensions to be backwards compatible with Saikley’s lancing system: it is already compatible. Further, to the extent Petitioner admits that the resulting cap would not serve the same purpose as Stout’s cap (e.g., being inserted into the lancing system and prying open the lancing device’s “forks” to

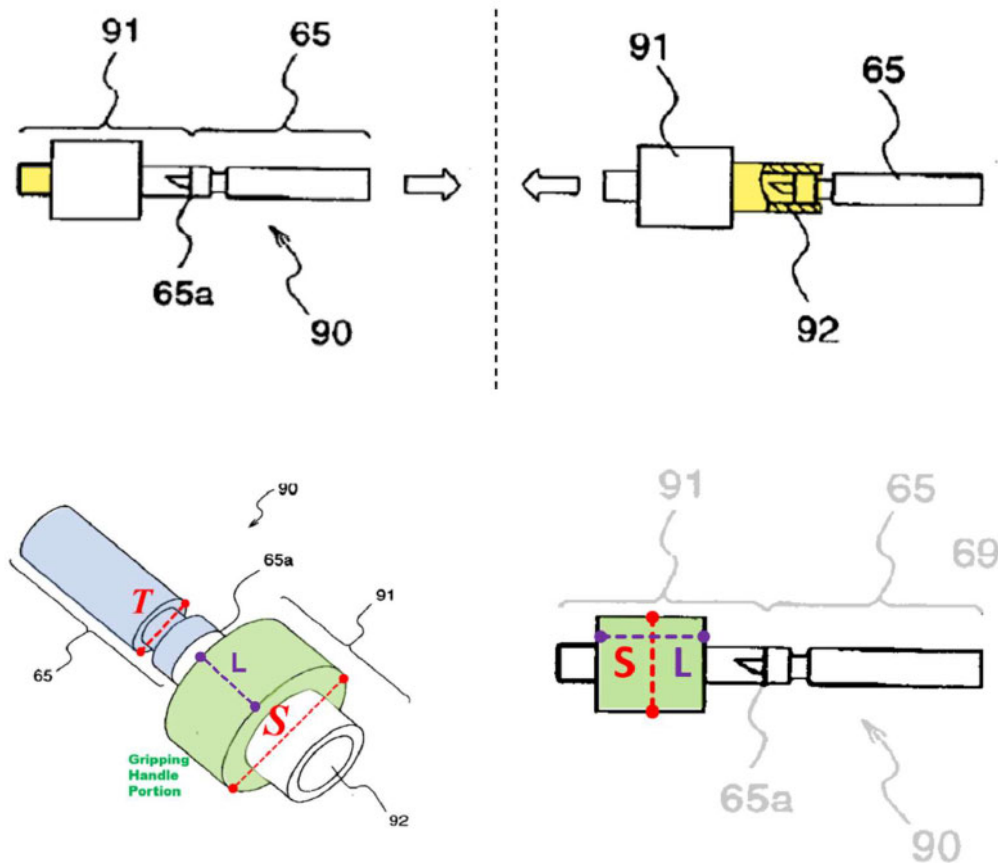
release the lancet after use), there is additionally no motivation to modify Saikley's lancet to have Stout's dimensions. POR 42-43.

Petitioner's ill-defined and ill-motivated combination of Saikley and Stout fails to render any claims obvious.

IV. Ground 4-6: Petitioner failed to rebut Facet's arguments about Iio.

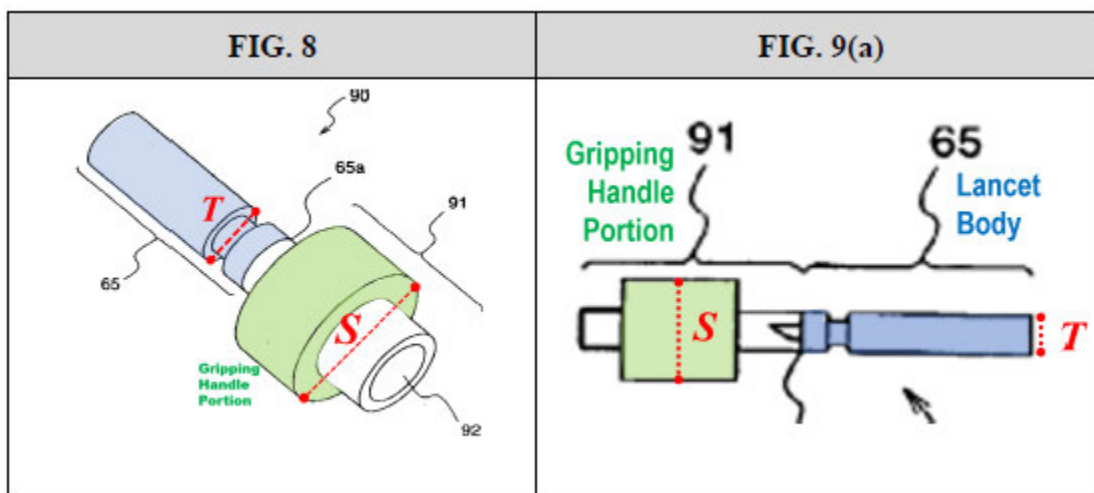
A. Petitioner's Reply does nothing to address the fatal flaws in its reliance on Iio's drawings.

In addition to the impropriety of relying on patent drawings for dimensional limitations, Facet showed that Petitioner's reliance on Iio's drawings is particularly improper because of the drastic variation in sizes between drawings. POR 54-59.



POR 58

In Reply, Petitioner asserts that Mr. Delman did not rely solely on the figures, but also on “the patent’s disclosures and technical benefits, and a PHOSITA’s knowledge.” Reply 27. But Petitioner indisputably relied on Iio’s figures for the dimensional limitations, including the length, span, and thickness. For example, for the lateral span/thickness ratio of claim 6, Petitioner cites to Figures 8 and 9a of Iio and Mr. Delman’s annotations of those figures and provides a “cursory visual comparison” to meet the claim limitations. Petition 79-80.

**Petition 80**

Petitioner further cites to Figures 11(b) and 11(c), as well as the “size of the [] thumb” in Figure 9a. Petition 81. There can be no reasonable dispute that Petitioner relies almost entirely on the figures for disclosure of the dimensional limitations.

The only passages of the specification cited by Petitioner are not helpful. The Board rightly criticized Petitioner’s citation to the “thin plastic film having a

thickness of 0.1 mm or less,” observing that “Petitioner has not identified a persuasive basis to correlate the precise thickness of the film to other elements illustrated in Iio.” ID 41-42. Petitioner abandons this argument in Reply. Petitioner’s additional citation to claim 20 of Iio also does not teach any claimed dimensional limitation.

Facet’s criticisms of these figures for dimensional limitations stands un rebutted.

B. Petitioner mischaracterizes Dr. Collins’s district court deposition.

Submitting cherry-picked portions of Dr. Collins’s district court deposition transcript, Petitioner mischaracterizes Dr. Collins’s testimony as agreeing that Iio discloses “all limitations except for the relative dimensions.” Reply 26 (citing Ex.1035 49:18-52:3). Not so. Dr. Collins was repeatedly asked, in that district court deposition, whether he *disputed* Iio’s disclosure *in the context of his district court reports*. *E.g.*, Ex.1035 50:40-14 (“Do you dispute in any of your reports that the second embodiment of Iio discloses a secondary sheath for receiving the sharp lancing tip of a used lancet?”). To the contrary, Dr. Collins never “agreed” that Iio discloses any limitation. There is no contradiction with his IPR declaration, where Dr. Collins rebutted the specific arguments of the Petition and Mr. Delman’s declaration.

Nor should any weight be given to Exhibit 1059. Petitioner intentionally omitted the line of questioning where Dr. Collins was asked to annotate this figure. Reply 26-27. The transcript's Exhibit List shows that Exhibit 9 (submitted as Exhibit 1059) is marked at page 89, line 5. Ex.1035 4:4-5. Petitioner's cherry-picked excerpts skip from page 53 to page 99—excluding the line of questioning. No conclusions can be drawn from Exhibit 1059.

C. Petitioner disproves its own obvious-to-try arguments.

Petitioner asserts that “practical constraints left only a finite number of choices” for lancet designs, but provides a laundry-list of factors affecting these dimensions—factors such as “anthropometric guidelines, user feedback, and critical hand dimensions” as well as “variation in pinch grips, hand and fingertip sizes, and other guidelines.” Reply 28. Mr. Delman provides a table of “anthropometric references” listing 19 “dimensions” that significantly differ not only between men and women, but also within each gender.

Ex. 1040, Table 6.1								
Dimension	Men				Women			
	5th %ile	50th %ile	95th %ile	SD	5th %ile	50th %ile	95th %ile	SD
1. Hand length	173	189	205	10	159	174	189	9
2. Palm length	98	107	116	6	89	97	105	5
3. Thumb length	44	51	58	4	40	47	53	4
4. Index finger length	64	72	79	5	60	67	74	4
5. Middle finger length	76	83	90	5	69	77	84	5
6. Ring finger length	65	72	80	4	59	66	73	4
7. Little finger length	48	55	63	4	43	50	57	4
8. Thumb breadth (IPJ) ^a	20	23	26	2	17	19	21	2
9. Thumb thickness (IPJ)	19	22	24	2	15	18	20	2
10. Index finger breadth (PIPJ) ^b	19	21	23	1	16	18	20	1
11. Index finger thickness (PIPJ)	17	19	21	1	14	16	18	1
12. Hand breadth (metacarpal)	78	87	95	5	69	76	83	4
13. Hand breadth (across thumb)	97	105	114	5	84	92	99	5
14. Hand breadth (minimum) ^c	71	81	91	6	63	71	79	5
15. Hand thickness (metacarpal)	27	33	38	3	24	28	33	3
16. Hand thickness (including thumb)	44	51	58	4	40	45	50	3
17. Maximum grip diameter ^d	45	52	59	4	43	48	53	3
18. Maximum spread	178	206	234	17	165	190	215	15
19. Maximum functional spread ^e	122	142	162	12	109	127	145	11

Ex.1034 27

Mr. Delman makes no attempt to try to show how this massive table would inform a POSITA's lancet design one way or another, let alone toward the claimed dimensions.

Petitioner has only shown how *complicated* lancet design is and has provided no evidence whatsoever that any particular dimensional size would have been obvious to try. To the contrary, the evidence cited by Petitioner's expert states that

there are an “infinite variety of actions of which the human hand is capable.” Ex.1040 34. Petitioner's obviousness ground based on Iio remains conclusory and grounded in hindsight. POR 59-61.

Mr. Hatch contradicts Petitioner's assertion that “a PHOSITA would have focused on designing larger gripping handle portions to achieve [Iio's] handleability, usability, and safety goals.” Petition 91. Specifically, Mr. Hatch asserts that a POSITA would have been motivated to make a *smaller* cap:

[T]he POSITA would understand that an extended length of the cap could have adverse effects on the needle. Specifically, if the cap is overly long the user is more likely to accidentally apply a leverage force on the cap thus bending the end of the needle. The POSITA would understand that *a shorter cap* would reduce the risk of this accidental leverage and bending of the lancet needle.

Ex.1045 ¶169.

Thus, Petitioner's obviousness argument is contradicted by its own evidence.

D. Petitioner's Iio-Peckham combination is improper.

Petitioner accuses Facet of criticizing “Iio or Peckham alone, not in combination.” Reply 28. Not so. Facet showed that the combination of Iio and Peckham would not disclose the dimensional limitations at least because 1) adding ridges to Iio would give the user a better grip, alleviating any need to provide an overly large gripping handle envisioned by Petitioner and “thus saving material costs” (POR 63) and 2) there's no reason to believe that Peckham's ridges would increase

the diameter of Iio's gripping handle to the claimed dimensions (POR 62). This is especially true because Peckham's cylindrical caps are roughly the same diameter as its lancets. POR 62-63. Petitioner's arguments are based on nothing but hindsight and Mr. Delman's conclusory beliefs. POR 62.

Further, Petitioner's Reply confirms that its Iio-Peckham combination relies on its failed obvious-to-try argument of Iio alone, and therefore fails for the same reasons as its standalone obviousness argument. Reply 28.

V. Claim 16 is patentable.

Dr. Collins did not make any admission about the legal conclusion of intended use, and Petitioner has not shown that claim 16 has no patentable weight. Reply 29. PO properly focused on the Iio-Freestyle combination and Petitioner does not dispute that the cited area is too small for branding. *Id.*; POR 63-64.

VI. Conclusion

For the reasons set forth above, the Board should find all claims patentable.

Respectfully submitted,

Dated: May 3, 2024

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CERTIFICATE OF COMPLIANCE WITH 37 C.F.R. § 42.24

I hereby certify that this Patent Owner's Sur-Reply complies with the word count limitation of 37 C.F.R. § 42.24(c)(4) because the Patent Owner's Sur-Reply contains 5,586 words using Microsoft Word's counting feature, excluding the cover page, signature block, and the parts of the Patent Owner's Sur-Reply exempted by 37 C.F.R. § 42.24(c).

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CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.6(e), I certify that on this 3rd day of May, 2024, a true and correct copy of the foregoing **Patent Owner's Sur-Reply and all Exhibits** were served by electronic mail on Petitioner's lead and backup counsel at the following email addresses:

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