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Subject: Request for Director Review of the Final Written Decision in IPR2023-00712
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Attachments: [image002.png](#)
[image003.png](#)
[2024.09.26 \[077\] 635 PO's Request for Director Review \(-00712\).pdf](#)

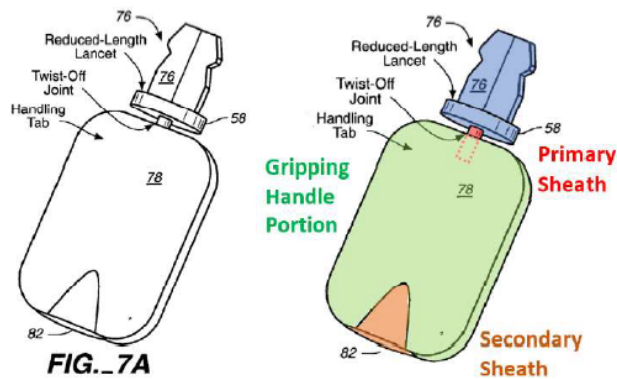
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Director Vidal,

Patent Owner, Facet Technologies, LLC, Requests Director Review of the Final Written Decision in IPR2023-00712. The Request is being filed pursuant to the Revised Interim Director Review Process (<https://www.uspto.gov/patents/ptab/decisions/revised-interim-director-review-process>) and is also attached for convenience.

The Request seeks review of two related issues (ranked below):

1. The Board abused its discretion by finding disclosure of a claim limitation based on **Petitioner's modifications** to a prior art patent drawing, rather than on what is shown in the prior art drawing itself. An image comparing the prior art figure to Petitioner's modified figure is below. In its finding of anticipation, the Board explicitly relied on Petitioner's modification of the prior art figure to add an assumed location and size for a "primary sheath," also relying on that modification to, in turn, find disclosure of a "gripping handle portion **extending between** the primary sheath and secondary sheath." The Board's decision contradicts Federal Circuit precedent and the Director's decision in *Mahle Behr Charleston, Inc. v. Catalano* that instructs the Board to rely on what a drawing "clearly shows" but does not permit finding of features that are not shown at all. This issue raises an important question of law and policy: it introduces uncertainty into the proper interpretation of the Director's decision in *Mahle*, raising questions about what may (and may not) be read into prior art figures. This error affects all challenged claims.



Saikley, Fig. 7A (left); Petitioner’s modification adding primary sheath (right)

- Relatedly, but for a “length” measurement recited in dependent claims, the Board abused its discretion by finding a “length” of the “gripping handle portion” based on a component not shown a prior art figure, relying instead on **Petitioner’s modified version** of that figure. In so finding, the Board misconstrued the “length” defined by the “gripping handle portion extending between” two sheaths as being measured “from where the sharp enters the sheaths”—contrary to the intrinsic and extrinsic record. Moreover, the Board also abused its discretion because under either the proper construction or the Board’s construction, the claimed length limitations, which recite relative sizes, are not clearly shown by Figure 7A and therefore cannot be relied upon to show disclosure of those limitations. Like the first issue, this too raises important questions of law and policy about what can be read into prior art figures and what measurements can be made of figures that are clearly not drawn to scale. This error affects claims 7-8 and 17-18.



Board’s length (left); Petitioner’s expert’s proposed length (right)

Respectfully Submitted,
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