

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SHENZHEN CHIC ELECTRICS CO., LTD.,
Petitioner,

v.

PILOT, INC.,
Patent Owner.

IPR2023-00810
Patent 11,376,971 B2

Before JEFFREY W. ABRAHAM, JULIA HEANEY, and
STEVEN M. AMUNDSON, *Administrative Patent Judges*.

ABRAHAM, *Administrative Patent Judge*.

DECISION
Granting Institution of *Inter Partes* Review
35 U.S.C. § 314, 37 C.F.R. § 42.4

I. INTRODUCTION

A. *Background and Summary*

Shenzen Chic Electrics Co., Ltd. (“Petitioner”) filed a petition for an *inter partes* review (Paper 2 (“Pet.”)) challenging claims 1–30 of U.S. Patent No. 11,376,971 B2 (Ex. 1001 (“the ’971 Patent”)). Pilot Inc. (“Patent Owner”) filed a Preliminary Response. Paper 6 (“Prelim. Resp.”).

We have authority to determine whether to institute an *inter partes* review. 35 U.S.C. § 314 (2018); 37 C.F.R. § 42.4(a) (2023). The standard for instituting an *inter partes* review is set forth in 35 U.S.C. § 314(a), which provides that an *inter partes* review may not be instituted “unless the Director determines . . . there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.”

For the reasons set forth below, we determine the information presented in the Petition establishes a reasonable likelihood that Petitioner would prevail with respect to at least one of the challenged claims. Accordingly, we institute an *inter partes* review.

B. *Related Matters*

The parties state that the ’971 patent is at issue in one district court litigation that is currently stayed: *Shenzhen Carku Technology Co., Ltd. v. Pilot, Inc.*, 2:22-cv-08471 (C.D. Cal.). Pet. 2; Paper 4, 2; Prelim. Resp. 2. The parties also identify seven IPR proceedings against six patents that are parents to or related to the ’971 patent:

1. *NOCO v. Pilot*, IPR2022-01237 on U.S. Pat. No. 11,124,077 (Pending);
2. *NOCO v. Pilot*, IPR2022-01417 on U.S. Pat. No. 11,104,236 (Pending);

3. *NOCO v. Pilot*, IPR2023-00167 on U.S. Pat. No. 11,235,673 (Pending);
4. *NOCO v. Pilot*, IPR2021-01235 on U.S. Pat. No. 10,328,806 (Final Written Decision issued January 9, 2023);
5. *NOCO v. Pilot*, IPR2021-00777 on U.S. Pat. No. 10,046,653 (Final Written Decision issued October 3, 2022; Federal Circuit appeal pending);
6. *Shenzhen Chic v. Pilot*, IPR2021-01232 on U.S. Pat. No. 10,046,653 (Final Written Decision issued January 9, 2023; Federal Circuit appeal pending);
7. *Winplus v. Pilot*, IPR2018-00488 on U.S. Pat. No. 9,525,297 (trial terminated due to settlement before Final Written Decision).

Pet. 2–3; Paper 4, 2–3.

C. The '971 Patent (Ex. 1001)

The '971 patent, titled “Automobile Charger,” issued July 5, 2022, and is directed to “a novel automobile charger with a safe power supply charging quickly.” Ex. 1001, codes (45), (54), 1:21–23. The '971 patent explains that prior art automobile charging devices, i.e., devices for jump starting vehicles, suffered from various problems, including an inability to automatically detect whether a load (e.g., an automobile storage battery) is connected, whether an automobile engine or storage battery has a reverse current, and whether the battery state is suitable for heavy power generation. Ex. 1001, 1:28–34. The '971 patent aims to solve these problems, and depicts one solution in Figure 1, reproduced below.

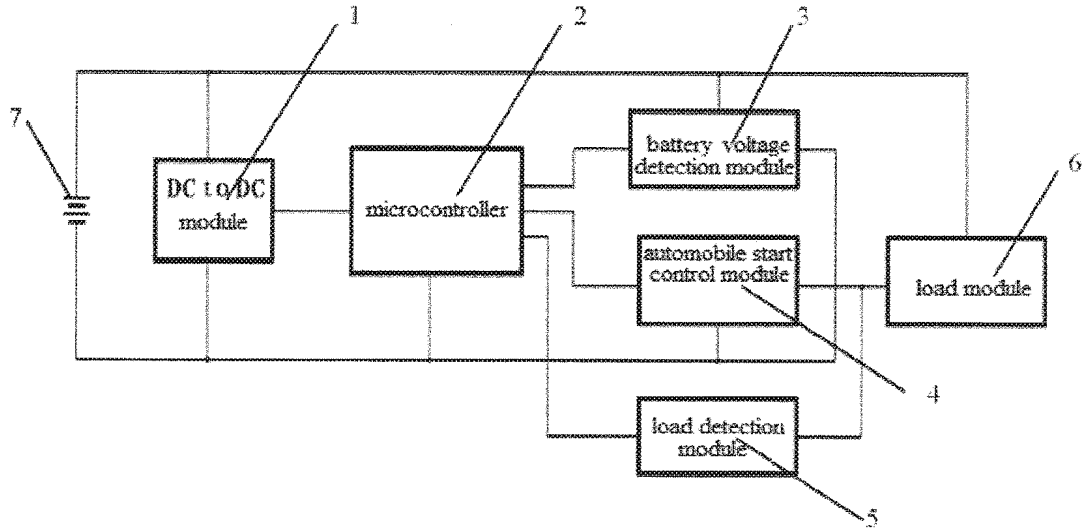


Figure 1 is a block diagram showing one embodiment of an automobile charger that includes DC to DC module 1, microcontroller 2, battery voltage detection module 3, automobile start control module 4, load detection module 5, load module 6, and direct current power supply 7 (the jump starter battery). Ex. 1001, 2:66–3:2. Although not shown in Figure 1, the '971 patent states that load module 6 “comprises the automobile storage battery and the automobile engine is located on the end of the load module.” Ex. 1001, 3:33–35.

The '971 patent explains that the DC to DC module provides “the stable voltage for the microcontroller,” which “collects relevant data” and “determines whether the automobile storage battery is connected with the automobile engine through the load detection module.” Ex. 1001, 4:14–25. When the load is correctly connected, the automobile start control module (an electronic switch) is automatically activated, and the battery starts to supply power to the load module. Ex. 1001, 2:29–30, 4:26–28. If the load is not connected, or positive and negative polarities are reversed, the

automobile start control module is automatically deactivated, and the battery stops supplying power to the load module. Ex. 1001, 4:28–32.

The '971 patent explains that its automobile charger provides benefits over prior art devices, including, *inter alia*, (1) controlling the supply power for the load, which protects the product and reduces the product size and material cost, (2) providing low voltage protection to prevent damage caused by over-discharging the battery, (3) preventing improper operations by the user, such as reversed polarity, which can cause damage to the automobile or direct current power supply, and (4) employing voltage backflow protection for an abnormal load, wherein the automobile start line is closed to protect the battery when an abnormal voltage is detected. Ex. 1001, 2:31–47.

D. Illustrative Claims

Of the challenged claims, claims 1, 17, and 18 are independent claims. Claim 1 is illustrative and reproduced below.

1[Pre]. A jumpstarter comprising:

1[a] a battery connected to a voltage regulator, the battery capable of supplying power, via the voltage regulator, to at least one microcontroller, the battery also capable of supplying power to an automobile battery when the battery has at least one predetermined voltage;

1[b] a load detector circuit to detect when the jumpstarter is correctly connected to the automobile battery;

1[c] said at least one microcontroller generating, when the battery has said at least one predetermined voltage, an output signal; and

1[d] switching circuitry, including at least one switch, to operatively connect the battery to the automobile battery when said at least one microcontroller generates the output signal to supply a charging current to the automobile battery.

IPR2023-00810

Patent 11,376,971 B2

Ex. 1001, 5:11–26 (labels added to correspond with Petitioner’s designation of claim limitations (Ex. 1024)).

E. Asserted Unpatentability Challenges

Petitioner asserts that claims 1–30 are unpatentable based on the following challenges:

Claim(s) Challenged	35 U.S.C. §	Reference(s)/Basis
1–30	103	Baxter ¹
10	103	Baxter, Zhang ²
14, 15, 29	103	Baxter, Tracey ³
18–30	103	Baxter, Xinfang ⁴
29	103	Baxter, Xinfang, Tracey
1–4, 6, 7, 9–13, 16–28, 30	103	Krieger450 ⁵
5	103	Krieger450, Koebler ⁶
8, 10, 16, 30	103	Krieger450, Richardson ⁷
14, 15, 29	103	Krieger450, Morse ⁸
18–30	103	Krieger450, Krieger049 ⁹
29	103	Krieger450, Krieger049, Morse

Petitioner relies on the declaration of David Ricketts, Ph.D. (Ex. 1023).

¹ US 2010/0173182 A1, published July 8, 2010 (Ex. 1008).

² CN 202696190 U, published Jan. 23, 2013 (Ex. 1010).

³ WO 2012/080996 A1, published June 21, 2012 (Ex. 1012).

⁴ US 9,506,446 B2, issued Nov. 29, 2016 (Ex. 1013).

⁵ US 7,345,450 B2, issued Mar. 18, 2008 (Ex. 1009).

⁶ US 2013/0241498 A1, published Sept. 19, 2013 (Ex. 1011).

⁷ US 2013/0154543 A1, published June 20, 2013 (Ex. 1014).

⁸ US 5,820,407, issued Oct. 13, 1998 (Ex. 1022).

⁹ US 2007/0285049 A1, published Dec. 13, 2007 (Ex. 1020).

II. ANALYSIS

A. *Level of Ordinary Skill in the Art*

Petitioner asserts that a person of ordinary skill in the art would have had a “bachelor’s degree in electrical engineering or its equivalent and two years of experience in electrical engineering with some experience in design of power supply management systems, such as battery charging systems.”

Pet. 12. Petitioner also contends that “[a]dditional graduate education could substitute for professional experience, or significant experience in the field could substitute for formal education.” Pet. 12 (citing Ex. 1023 ¶¶ 44–48).

Patent Owner does not challenge Petitioner’s definition or offer its own. *See generally*, Prelim. Resp.

In light of the record before us, and for purposes of this Decision, we adopt Petitioner’s proposal regarding the level of ordinary skill in the art. Based on our review of the ’971 patent and the prior art of record, we determine that the definition offered by Petitioner comports with the qualifications a person would have needed to understand and implement the teachings of the ’971 patent and the prior art. *See Okajima v. Bourdeau*, 261 F.3d 1350, 1355 (Fed. Cir. 2001) (explaining that specific findings regarding ordinary skill level are not required “where the prior art itself reflects an appropriate level and a need for testimony is not shown”) (quoting *Litton Indus. Prods., Inc. v. Solid State Sys. Corp.*, 755 F.2d 158, 163 (Fed. Cir. 1985)).

B. *Claim Construction*

In an *inter partes* review, we construe claim terms according to the standard set forth in *Phillips v. AWH Corp.*, 415 F.3d 1303, 1312–17 (Fed. Cir. 2005) (en banc). 37 C.F.R. § 42.100(b). Under *Phillips*, claim terms are afforded “their ordinary and customary meaning.” *Phillips*, 415 F.3d at

1312. “[T]he ordinary and customary meaning of a claim term is the meaning that the term would have to a person of ordinary skill in the art in question at the time of the invention.” *Id.* at 1313. “Importantly, the person of ordinary skill in the art is deemed to read the claim term not only in the context of the particular claim in which the disputed term appears, but in the context of the entire patent, including the specification.” *Id.*

Petitioner argues that the term “start control module” should be construed as “electronic switch.” Pet. 12 (citing Ex. 1023 ¶¶ 148–150). According to Petitioner, “the ‘971 Patent states that ‘the automobile start control module is the electronic switch.’” Pet. 13 (citing Ex. 1001, 2:29–30, 4:42–45, 4:26–28, 4:29–32). Patent Owner does not address claim construction in its Preliminary Response.

We determine that we do not need to expressly construe any terms for purposes of this Decision. *See Nidec Motor Corp. v. Zhongshan Broad Ocean Motor Co.*, 868 F.3d 1013, 1017 (Fed. Cir. 2017) (citing *Vivid Techs., Inc. v. Am. Sci. & Eng’g, Inc.*, 200 F.3d 795, 803 (Fed. Cir. 1999) (“[O]nly those terms need be construed that are in controversy, and only to the extent necessary to resolve the controversy.”)).

C. Claims 1–30 – Alleged Obviousness in view of Baxter

Petitioner contends claims 1–30 of the ‘971 patent are unpatentable as obvious in view of Baxter. Pet. 14–54.

1. Baxter (Ex. 1008)

Baxter is a U.S. patent application publication titled “Low-Voltage Connection with Safety Circuit and Method for Determining Proper Connection Polarity,” filed on March 24, 2010, and published on July 8, 2010. Ex. 1008, codes (12), (22), (43), (54). Baxter states that the invention

relates to “a battery integrated connection between a battery and a low-voltage system that includes a safety circuit.” Ex. 1008 ¶ 8.

Baxter explains that jumper cables “commonly used to connect two low-voltage (e.g. battery-powered) systems temporarily” may “result in personal injury and equipment damage.” Ex. 1008 ¶ 5. For example, when “jump starting a car with” a depleted battery “using a car with a good battery,” a “spark may be created.” Ex. 1008 ¶ 5. If “the spark is in the vicinity of hydrogen gas commonly generated by car batteries, the spark can ignite the hydrogen gas to explosive effect.” Ex. 1008 ¶ 5. Further, “connecting a jumper cable set backward (i.e. with polarity of one of the battery connections reversed) can also cause injury or damage.” Ex. 1008 ¶ 5.

To address those issues, Baxter discloses “a safety circuit for use in low-voltage systems that improves safety.” Ex. 1008 ¶¶ 7, 25, code (57). The safety circuit “leaves the battery disconnected from the low-voltage system until it determines that it is safe to make a connection.” Ex. 1008 ¶¶ 7, 25, code (57). The safety circuit may implement a method for detecting the “proper polarity of the connections between the battery and the low-voltage system.” Ex. 1008 ¶¶ 7, 25, code (57). Figure 2 of Baxter, reproduced below, provides a diagram illustrating the components in one embodiment of Baxter’s safety circuit. Ex. 1008 ¶ 44.

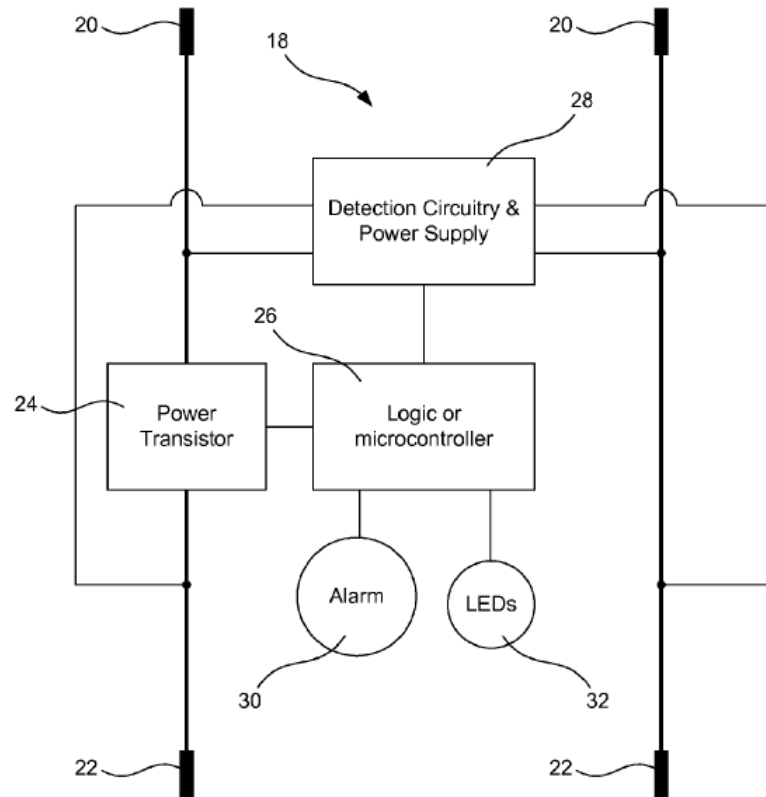


Figure 2 shows safety circuit 18 comprising input terminals 20, output terminals 22, power transistor 24, logic circuit or microcontroller 26, detection circuit and power supply 28, alarm 30, and LEDs 32. Ex. 1008 ¶¶ 44–45.

Baxter’s Figure 7 (reproduced below) depicts a representative circuit diagram for use in embodiments of Baxter’s safety circuit:

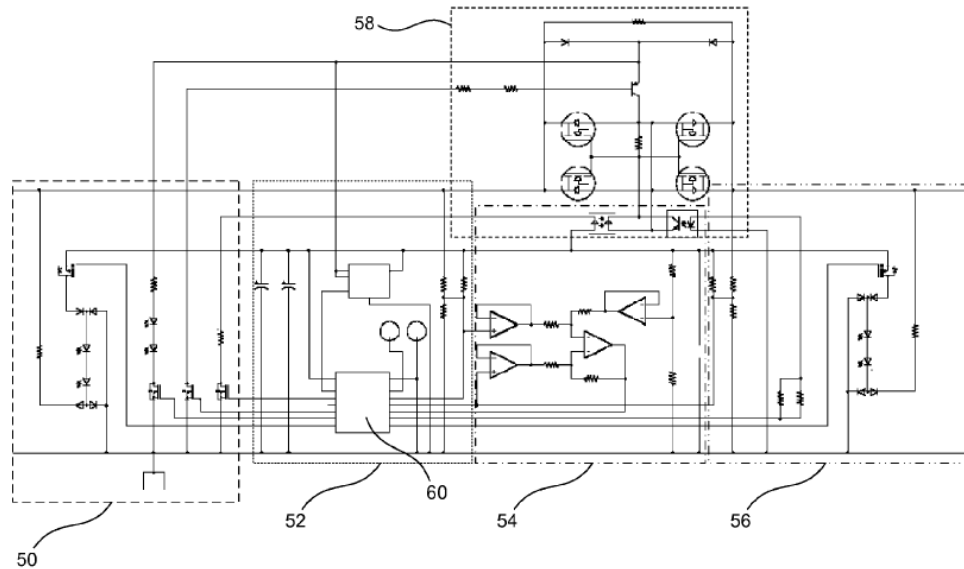


Figure 7 illustrates a safety circuit comprising microcontroller 60 and other components arranged in various areas as follows:

- area 50 depicted in more detail in Figure 8;
- area 52 depicted in more detail in Figure 9;
- area 54 depicted in more detail in Figure 10;
- area 56 depicted in more detail in Figure 11; and
- area 58 depicted in more detail in Figure 12.

Ex. 1008 ¶¶ 18–19, 58, Figs. 7–12.

Baxter's Figure 9 (reproduced below) depicts in more detail area 52 in Figure 7's safety circuit:

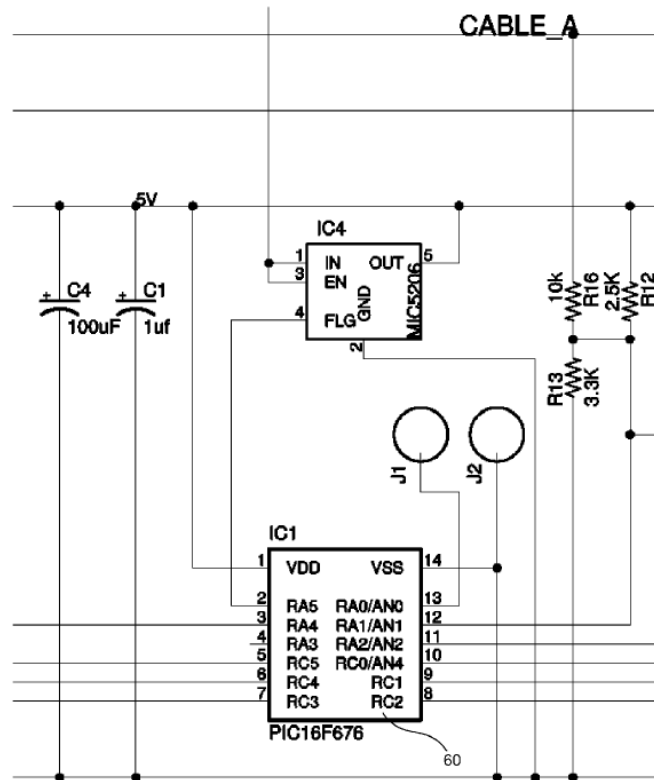


Figure 9 illustrates area 52 encompassing microcontroller 60 (also labeled as IC1), as well as the following components: IC4, C1, C4, R12, R13, R16, J1, and J2. Ex. 1008 ¶ 58, Fig. 9. Baxter also provides flow charts demonstrating processes that may be implemented using the circuitry shown in Figures 7–12. Ex. 1008 ¶¶ 59–75, Figs. 13–17.

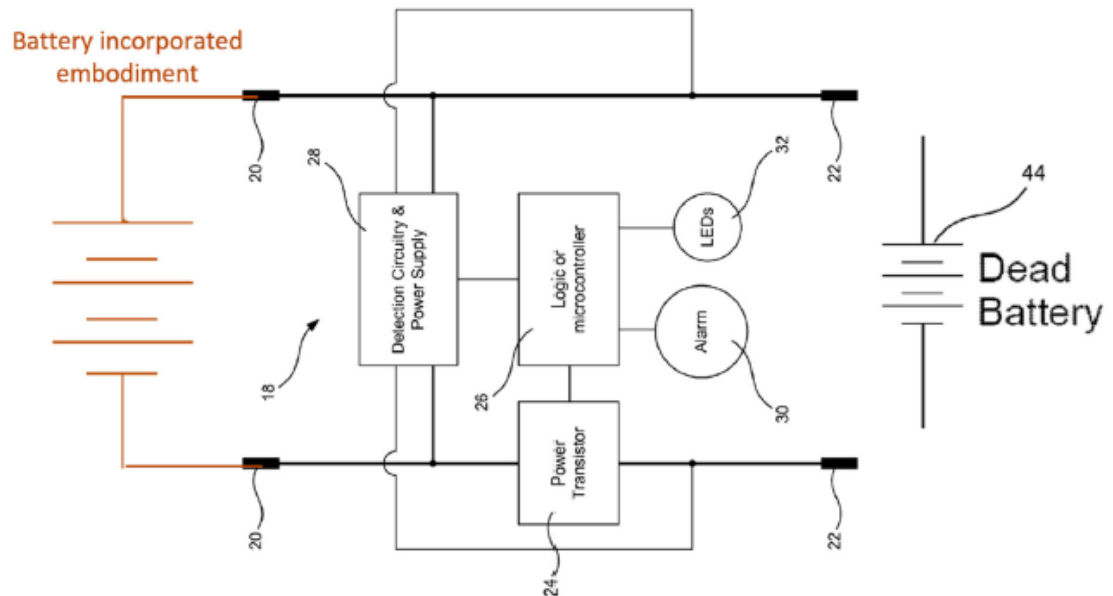
2. Analysis

a. Claim 1

Petitioner contends Baxter discloses a jumpstarter, as recited in the preamble of claim 1. Pet. 16–17. Petitioner directs us to Baxter’s disclosure of integrating its safety circuit into a “booster box” or battery charger that connects to an automobile. Pet. 16–17 (citing Ex. 1008 ¶¶ 7, 26, 38, 40, 43, 49, 51–53, 77; Ex. 1023 ¶ 211). According to Dr. Ricketts, a person of ordinary skill in the art “would understand that a ‘booster box’ would refer

to an apparatus with integrated battery and cables to connect to a vehicle battery.” Ex. 1023 ¶ 211.

Petitioner next contends that Baxter discloses limitation 1[a], which recites “a battery connected to a voltage regulator, the battery capable of supplying power, via the voltage regulator, to at least one microcontroller, the battery also capable of supplying power to an automobile battery when the battery has at least one predetermined voltage.” Ex. 1001, 5:12–16. According to Petitioner, Baxter’s safety circuit can be connected to a battery, for example through input terminals 20 shown in Figure 2, or Positive Cable A/Negative Cable A shown in Figure 8. Pet. 18–19. Petitioner provides an annotated version of Baxter Figure 2, reproduced below, showing how Baxter’s safety circuit can be connected to a power source and a dead battery. Pet. 19.



Petitioner’s annotations of Baxter’s Figure 2 show input terminals 20 connected to a power source (depicted in brown), such as the battery of a

booster box, and output terminals 22 connected to a dead battery, such as an automobile battery that needs to be jumpstarted. Pet. 18–19.

Petitioner contends that “Detection Circuitry and Power Supply” 28 in Figure 2 contains a voltage regulator, and “Logic or microcontroller” 26 corresponds to the microcontroller recited in claim 1. Pet. 20. Petitioner argues that Figure 2 shows how the battery (through input terminals 20) is connected to the voltage regulator (in Detection Circuitry and Power Supply 28), and that microcontroller 26 has one power connection through the voltage regulator. Pet. 20 (citing Ex. 1008 ¶ 44; Ex. 1023 ¶ 219).

Additionally, Petitioner contends that IC4 and IC1 in Baxter Figure 9 correspond, respectively, to the voltage regulator and microcontroller recited in claim 1. Pet. 18–19; *see also* Pet. 23 (citing Ex. 1023 ¶¶ 224–225 and Ex. 1017 to support Petitioner’s contention that IC4 is a microcontroller). Petitioner provides an annotated version of Baxter’s Figure 9, reproduced below, to illustrate the connections between these components.

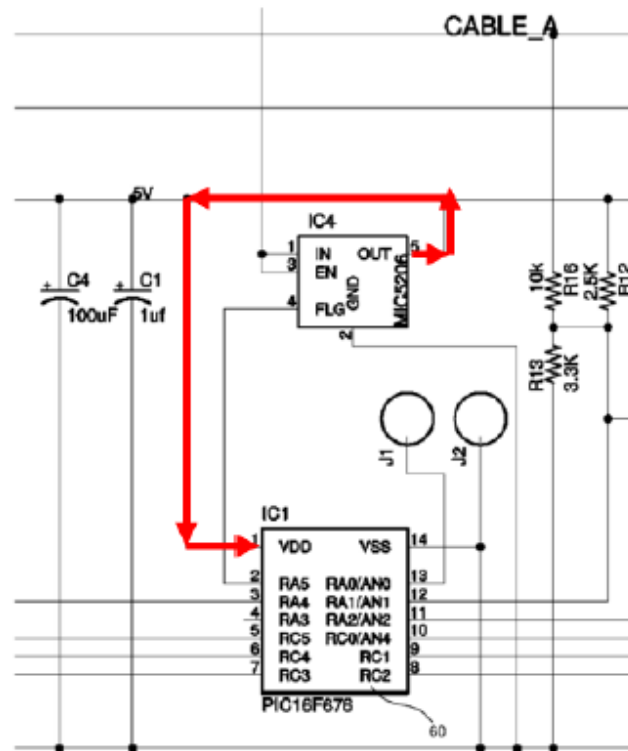


FIG. 9

Petitioner's annotations in red show how the output (OUT) of voltage regulator IC4 connects to the VDD input of microcontroller IC1. Pet. 24 (citing Ex. 1023 ¶¶ 226–227). Petitioner contends that a battery, such as an internal booster box battery, could be connected to the system shown in Figure 9, and would supply power to IC4 and IC1 through “Cable A.” Pet. 20–22 (citing Ex. 1008 ¶¶ 40, 59, Figs. 7, 8, 13; Ex. 1023 ¶ 223).

Petitioner also contends that a battery connected to Baxter's safety circuit is capable of supplying power to an automobile battery when the battery has at least one predetermined voltage, as recited in limitation 1[a]. Pet. 25–29. In particular, Petitioner directs us to Baxter's statement that “the safety circuit refuses to make a connection to the low-voltage system while an unsafe condition exists.” Pet. 26 (quoting Ex. 1008 ¶ 8). According to

Petitioner, Baxter discloses that measuring a voltage is one way to determine an unsafe condition. Pet. 26 (citing Ex. 1008 ¶¶ 53, 63). Petitioner also directs us to the flowchart shown in Figure 13, and argues that it shows “how the voltage measurement operation on the supply side battery is used to determine whether to close the switch” to provide power to the automobile battery. Pet. 27–28. In particular, Petitioner asserts that Baxter’s safety circuit will only connect the power systems (per step 72) when the voltage in the batteries connected to the system, including the internal booster box battery, is greater than 2.5V (per step 68). Pet. 29.

For limitation 1[b], which recites “a load detector circuit to detect when the jumpstarter is correctly connected to the automobile battery” (Ex. 1001, 5:17–18), Petitioner contends that Baxter discloses “a load detector in various implementations so switch closure occurs only when no unsafe conditions are detected.” Pet. 30 (emphasis omitted) (citing Ex. 1008 ¶¶ 8, 29, 32–33, 38; Ex. 1023 ¶¶ 238–239). As one example, Petitioner asserts that Figure 5 shows a current sensor that detects connection and polarity by detecting a change in voltage. Pet. 30 (citing Ex. 1008 ¶ 56; Fig. 5). According to Petitioner, “[t]he measured voltage would not increase past the required threshold when a battery is not connected or connected with reverse polarity.” Pet. 30 (citing Ex. 1023 ¶ 242).

Petitioner next argues that Baxter discloses limitation 1[c], which recites “said at least one microcontroller generating, when the battery has said at least one predetermined voltage, an output signal.” Ex. 1001, 5:19–21. According to Petitioner, Baxter discloses that microcontroller 26 generates an output signal to power transistor 24, such that the operation of power transistor 24 is under the control of microcontroller 26. Pet. 33 (citing Ex. 1008 ¶¶ 44, 46, 48, Fig. 2; Ex. 1023 ¶ 252). Additionally,

Petitioner contends that Baxter's microcontroller IC1 controls a series-parallel MOSFET switch by sending signals to turn the FET switch on or off. Pet. 33–36 (citing Ex. 1008 ¶¶ 62, 71; Ex. 1023 ¶¶ 253–258). Petitioner further contends Baxter's microcontrollers generate output signals when the battery has at least one predetermined voltage, as limitation 1[c] requires, because

[Baxter's] power switch (the series-parallel transistors in Fig. 7, also power transistor 24 in Fig. 2) is turned on (at step 72 of Fig. 13) when the voltage at the input (wires labeled Positive Cable A, Negative Cable A in Fig. 8, also input terminals 20 in Fig. 2) of the safety circuit 18 is at least 2.5 volts (a test performed in Fig. 13, reference 68).

Pet. 36 (citing Ex. 1023 ¶ 261).

Petitioner relies on similar disclosures in Baxter to demonstrate that Baxter satisfies limitation 1[d], which recites “switching circuitry, including at least one switch, to operatively connect the battery to the automobile battery when said at least one microcontroller generates the output signal to supply a charging current to the automobile battery.” Ex. 1001, 5:22–26. According to Petitioner, Baxter contains numerous disclosures of “the transistor switching circuitry and connections between a first voltage system -- the battery at the input (the battery in the booster box) and a second voltage system -- the battery at the output (automobile battery).” Pet. 38–39 (citing Ex. 1008 ¶¶ 10, 28, 36, 46, 48, 56; Ex. 1023 ¶ 266).

At this stage of the proceeding, Patent Owner provides a conclusory statement that “[n]one of the above references render obvious the Challenged Claims of the ‘971 patent,” but otherwise does not substantively dispute that Baxter discloses or suggests the limitations in claim 1. Prelim. Resp. 4. After reviewing the evidence and arguments Petitioner presents in

the Petition regarding claim 1, including the relevant portions of the supporting Ricketts Declaration, we determine Petitioner has demonstrated sufficiently for purposes of institution that Baxter discloses or suggests the limitations of claim 1. As a result, we are persuaded Petitioner has established a reasonable likelihood of prevailing on its obviousness challenge with respect to claim 1.

b. Claims 2–30

Claims 2–16 depend directly or indirectly from claim 1. Claims 17 and 18 are independent, and claims 19–30 depend directly or indirectly from claim 18. Petitioner directs us to portions of Baxter that disclose or suggest the limitations in these claims. Pet. 39–54. At this stage of the proceeding, Patent Owner does not meaningfully dispute that Baxter discloses or suggests the limitations in claims 2–30.

After reviewing the evidence and arguments Petitioner presents in the Petition, including the relevant portions of the supporting Ricketts Declaration, we are persuaded Petitioner has established a reasonable likelihood of prevailing on its obviousness challenge with respect to these claims.

3. Conclusion

For all of the foregoing reasons, we determine Petitioner has demonstrated a reasonable likelihood of prevailing with respect to its argument that claims 1–30 are unpatentable as obvious in view of Baxter.

D. Discretionary Denial Under 35 U.S.C. § 325

Patent Owner argues that we should exercise our discretion under 35 U.S.C. § 325(d) to deny institution because “the Petition does not raise new issues not considered by the Examiner during the examination process. The Examiner was provided with and considered references cited by

Petitioner and similar, if not the same, analysis of these references by the same expert and others.” Prelim. Resp. 1.¹⁰

Petitioner contends that “the prior art in this Petition was not evaluated on record in” an Office action, and, as a result, “[t]he first-action allowance of Claims 1–30 is an error or oversight by the Patent Office by not specifically addressing any prior art made of record in the ‘971 and prior art references relied upon by the PTAB in 4 different PTAB proceedings prior to issuance of the ‘971.” Pet. 10–11 (referring to IPR2018-00488, IPR2021-00777, IPR2021-01232, and IPR2021-01235).

Institution of *inter partes* review is discretionary. See 35 U.S.C. § 314(a); *Cuozzo Speed Techs., LLC v. Lee*, 136 S. Ct. 2131, 2140 (2016) (the AIA does not impose a “mandate to institute review”). One of the guideposts for our discretion is 35 U.S.C. § 325(d), which provides, in relevant part:

MULTIPLE PROCEEDINGS -- . . . In determining whether to institute or order a proceeding under this chapter, chapter 30, or chapter 31, the Director may take into account whether, and reject the petition or request because, the same or substantially the same prior art or arguments previously were presented to the Office.

Thus, 35 U.S.C. § 325(d) identifies two separate issues that the Director may consider in exercising discretion to deny institution of review: whether the petition presents to the Office the same or substantially the same

¹⁰ Patent Owner also argues that we should deny institution because any new issues of patentability raised by the Petition “would be more efficiently and directly addressed by the petition for reexamination that has been or will shortly be filed by Patent Owner.” Prelim. Resp. 1. On October 16, 2023, however, Patent Owner notified the Board that it decided not to file a Reexamination Request. Ex. 3001.

art previously presented to the Office; and whether the petition presents to the Office the same or substantially the same arguments previously presented to the Office. *Advanced Bionics, LLC v. MED-EL Elektromedizinische Geräte GmbH*, IPR2019-01469, Paper 6 at 7 (PTAB Feb. 13, 2020) (designated precedential March 24, 2020) (“*Advanced Bionics*”). We consider multiple factors when determining whether to exercise our discretion under § 325(d), including:

(a) the similarities and material differences between the asserted art and the prior art involved during examination; (b) the cumulative nature of the asserted art and the prior art evaluated during examination; (c) the extent to which the asserted art was evaluated during examination, including whether the prior art was the basis for rejection; (d) the extent of the overlap between the arguments made during examination and the manner in which Petitioner relies on the prior art or Patent Owner distinguishes the prior art; (e) whether Petitioner has pointed out sufficiently how the Examiner erred in its evaluation of the asserted prior art; and (f) the extent to which additional evidence and facts presented in the Petition warrant reconsideration of the prior art or arguments.

Becton, Dickinson & Co. v. B. Braun Melsungen AG, IPR2017-01586, Paper 8 at 17–18 (PTAB Dec. 15, 2017) (informative; precedential as to § III.C.5, first paragraph). We apply a two-part framework in deciding discretionary denial under § 325(d), first considering *Becton, Dickinson* factors (a), (b), and (d) to determine whether the same or substantially the same art or arguments were previously presented to the Office, and if so, evaluating *Becton, Dickinson* factors (c), (e), and (f) to determine whether the petitioner has demonstrated that the Office erred in a manner material to the patentability of challenged claims. *Advanced Bionics*, 7–11.

With respect to the first part of the *Advanced Bionics* framework, it is undisputed that Baxter (as well as other references relied upon in the

Petition) was previously presented to the Office. Pet. 10; Prelim. Resp. 2–3; Ex. 1002, 81–85 (IDS listing Baxter and stating “All references considered except where lined through”); *Advanced Bionics*, 7–8 (stating that “[p]reviously presented art includes . . . art provided to the Office, such as on an Information Disclosure Statement (IDS)”).

With respect to the second part of the *Advanced Bionics* framework, we conclude Petitioner has adequately shown that the Office erred in a manner material to the patentability of the challenged claims. Petitioner correctly notes that the record does not reflect any substantive evaluation of Baxter in an Office action during prosecution of the ’971 patent. *See* Pet. 10; *see generally* Ex. 1002. Further, as discussed in detail above, Petitioner has demonstrated sufficiently for purposes of this Decision that Baxter teaches or suggests all of the limitations of the challenged claims, and that the challenged claims would have been obvious in view of Baxter. Accordingly, we agree with Petitioner that, at least with respect to Baxter, “[t]he first-action allowance of Claims 1–30 is an error or oversight by the Patent Office.” Pet. 10.

For all of the foregoing reasons, we decline to exercise our discretion under 35 U.S.C. § 325(d) not to institute an *inter partes* review.¹¹

¹¹ We recognize that Patent Owner’s § 325(d) arguments are not limited to Baxter. *See, e.g.*, Prelim. Resp. 2–3 (asserting that Tracey, Zhang, Richardson, Xinfang, and Krieger450 were also previously presented to the Office). In view of our determination regarding Baxter, however, we decline to consider Patent Owner’s additional § 325(d) arguments because Petitioner’s challenges based on Baxter alone address all challenged claims. Accordingly, § 325(d) is not sufficiently implicated under the present facts such that institution on all challenges would undermine the statutory purpose of § 325(d).

III. CONCLUSION

Because Petitioner has demonstrated a reasonable likelihood that at least one challenged claim of the '971 patent is unpatentable over the prior art of record, we institute an *inter partes* review. And because we find some grounds sufficient for institution, we institute on all grounds in the petition. *See SAS Inst., Inc. v. Iancu*, 138 S. Ct. 1348, 1353 (2018) (“The agency cannot curate the claims at issue but must decide them all.”); *PGS Geophysical AS v. Iancu*, 891 F.3d 1354, 1360 (Fed. Cir. 2018) (interpreting the statute as requiring “a simple yes-or-no institution choice respecting a petition, embracing all challenges included in the petition”).

At this stage of the proceeding, we have not made a final determination with respect to the patentability of any challenged claim or any underlying factual or legal issue.

IV. ORDER

For the reasons given, it is:

ORDERED that, pursuant to 35 U.S.C. § 314(a), an *inter partes* review of claims 1–30 of the '971 patent is instituted with respect to all grounds of unpatentability asserted in the Petition, commencing on the entry date of this Decision; and

FURTHER ORDERED that, pursuant to 35 U.S.C. § 314(c) and 37 C.F.R. § 42.4, notice is hereby given of the institution of trial.

IPR2023-00810
Patent 11,376,971 B2
FOR PETITIONER:

Kevin Patariu
Bing Ai
John Esterhay
John Schnurer
PERKINS COIE
patariu-ptab@perkinscoie.com
ai-ptab@perkinscoie.com
esterhay-ptab@perkinscoie.com
schnurer-ptab@perkinscoie.com

FOR PATENT OWNER:

Robert R. Brunelli
Jason H. Vick
SHERIDAN ROSS P.C.
rbrunelli@sheridanross.com
jvick@sheridanross.com