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Subject: IPR2024-00493 - Request for Director Review
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Attachments: [08 2024-09-18 Petitioner's Request for Rehearing IPR2024-00493.pdf](#)

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Dear Director Vidal,

Pursuant to 37 C.F.R. § 42.71(d) and the Revised Interim Director Review Process, Petitioner Honeywell International Inc. respectfully notifies the parties and the USPTO of the attached Request for Rehearing by the Director (“Request”), Paper 8, of the decision by the Board denying institution (Paper 7) in IPR2024-00493.

The Request presents the following issues, listed below in order of priority, for which Petitioner seeks review (Petitioner notes that the order is different in the Request, as reflected by the below page numbers):

1. Whether the Board abused its discretion by erroneously finding a product-by-process limitation was entitled to patentable weight despite the Board’s failure to analyze the cited prior art to determine whether the limitation imparted “structural and functional difference” that distinguished the claimed product from the prior art (Request, pages 3-6).
2. Whether the Board abused its discretion by erroneously applying the “reasonable expectation of success” analysis to require absolute success in an unclaimed FDA certification process (Request, pages 11-15).
3. Whether the Board abused its discretion by erroneously rewriting Petitioner’s proposed combination (Request, pages 6-9).
4. Whether the Board abused its discretion by failing to provide the requisite analysis of the record evidence with respect to Petitioner’s obvious to try rationale (Request, pages 9-11).

The first issue is important as it violates the exception that was laid out in *Amgen* providing that, in order to be limiting, a product-by-process limitation must impart “structural and functional differences” that ***distinguish the claimed product from the prior art***. *Amgen Inc. v. F. Hoffman-La Roche Ltd.*, 580 F.3d 1340 (Fed. Cir. 2009). The requirement to consider the prior art is of particular importance in this case given that Patent Owner never argued a missing limitation in the POPR, and the purported feature imparted by “obtained by gel spinning”, i.e., high tensile strength, was also a feature of the gel spun filaments of the prior art.

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The second issue is important because, despite at least five rationales set forth in the petition, the Board clearly erred by applying not only a *higher* standard than is required for showing the likelihood of success, i.e., that the POSITA would be absolutely successful in the proposed combination, but also success in something that is irrelevant to the inquiry—whether the POSITA would have had a reasonable expectation in achieving FDA certification. The Board’s abuse of discretion in this instance permeates each asserted ground set forth in the Petition such that the Board’s denial to institute trial on any ground is erroneous.

The third issue is important because the Petition outlined a combination that relied on a primary reference (Simmelink) that disclosed the use of a colorant in a gel spinning process and a secondary reference (Section 73.1015) that disclosed the claimed pigment. In misinterpreting the secondary reference and Petitioner’s proposed combination, the Board required all elements of an unclaimed FDA certification instead of the disclosed pigment alone.

The fourth issue is important because, without sufficient analysis, the Board disregards Petitioner’s evidence of a design need for a colored suture made from UHMWPE and the finite number of solutions to color a UHMWPE fiber.

For these reasons, Petitioner respectfully requests Director review.

Respectfully submitted,

Ben Pleune

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