

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

DEXCOM, INC.,

Petitioner,

v.

ABBOTT DIABETES CARE INC.,

Patent Owner.

IPR2024-00520

Patent 11,266,335 B2

Before JOHN G. NEW, RYAN H. FLAX, and CYNTHIA M. HARDMAN,
Administrative Patent Judges.

NEW, *Administrative Patent Judge.*

DECISION

Denying Institution of *Inter Partes* Review
35 U.S.C. § 314

I. INTRODUCTION

Petitioner Dexcom, Inc. (“Petitioner”) has filed a Petition (Paper 3, the “Petition” or “Pet.”) seeking *inter partes* review of claims 5–7 of U.S. Patent 11,266,335 B2 (Ex. 1001, the “’335 patent”). Patent Owner Abbott Diabetes Care Inc. (“Patent Owner”) timely filed a Preliminary Response. Paper 8 (the “Preliminary Response” or “Prelim. Resp.”). With our authorization, Petitioner filed a Reply to Patent Owner’s Preliminary Response (Paper 9, “Reply”) and Patent Owner in turn filed a Sur-reply (Paper 10, “Sur-Reply”).

Because the present Petition is one of three challenging the ’335 patent¹, Petitioner filed an Explanation of the Material Differences between the Petitions. Paper 2 (the “Explanation” or “Expl.”); *see* Patent Trial and Appeal Board *Consolidated Trial Practice Guide* (November 2019) (“CTPG”) at 59–60.² Patent Owner did not file a response to Petitioner’s Explanation.

Under 35 U.S.C. § 314, the Board “may not authorize an *inter partes* review to be instituted unless ... the information presented in the petition ... and any response ... shows that there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.” Upon consideration of the Petition, Patent Owner’s

¹ Petitioner sought *inter partes* review of claims 1–4, 8, 9, and 11–27 of the ’335 patent in *Dexcom, Inc. v. Abbott Diabetes Care Inc.*, IPR2023-01396 (filed October 6, 2023) and *Dexcom, Inc. v. Abbott Diabetes Care Inc.*, IPR2023-01397 (filed October 6, 2023). The Explanation addresses Petitioner’s reasons for seeking *inter partes* review of the same claims in separate Petitions, and claims 5–7 in the present Petition.

² *Available at*: <https://www.uspto.gov/TrialPracticeGuideConsolidated>.

Preliminary Response, Petitioner’s Reply, Patent Owner’s Sur-Reply, the Explanation, and the evidence of record as presently developed, we determine that the evidence presented fails to demonstrate a reasonable likelihood that Petitioner would ultimately prevail at trial in establishing the unpatentability of the challenged claims of the ’335 patent. We consequently deny institution of *inter partes* review.

II. BACKGROUND

A. *Real Parties-in-Interest*

Petitioner identifies Dexcom, Inc. as its sole real party-in-interest. Pet. ix. Patent Owner identifies Abbott Diabetes Care Inc. as its real party-in-interest. Paper 6, 1.

B. *Related Matters*

Patent Owner and Petitioner each identify as a related matter an infringement action filed by Patent Owner against Petitioner, *Abbott Diabetes Care Inc. et al. v. DexCom, Inc.*, No. 1:23-cv-00239 (D. Del.), filed March 3, 2023, asserting infringement of the ’335 patent. Pet. ix; Paper 6, 1.

The parties also identify as related proceedings two *inter partes* reviews challenging claims 1–4, 8, 9, and 11–27 of the ’335 patent, *Dexcom, Inc. v. Abbott Diabetes Care Inc.*, IPR2023-01396, filed October 6, 2023 (the “’01396 IPR”) and *Dexcom, Inc. v. Abbott Diabetes Care Inc.*, IPR2023-01397, filed October 6, 2023 (the “’01397 IPR”). Pet. ix; Paper 6, 1–2; *see supra* fn.1. On April 16, 2024, we denied institution in both the ’01396 IPR (*see* ’01396 IPR, Paper 13 (the “’01396 IPR Decision” or “Dec.”)) and the ’1397 IPR (*see* ’01397 IPR, Paper 13). Petitioner timely

filed a Request for Rehearing in the '01396 IPR on May 16, 2024. *See* '01396 IPR, Paper 14.

C. The Asserted Grounds of Unpatentability

Petitioner contends that claims 5–7 of the '335 patent are unpatentable, based upon the following grounds:

Ground	Claim(s) Challenged	35 U.S.C. §	Reference(s)/Basis
1	5–7	103(a) ³	Stafford ⁴ , Raymond ⁵
2	5–7	103(a)	Stafford, Raymond, Turner ⁶

Petitioner also relies upon the Third Declaration of Gary D. Fletcher, Ph.D. (Ex. 1268, the “Fletcher Declaration”).

³ The Leahy-Smith America Invents Act (“AIA”), Pub. L. No. 112–29, 125 Stat. 284 (2011), amended 35 U.S.C. § 103, effective March 16, 2013. Because the application from which the '335 patent issued has an effective filing date prior to that date, the pre-AIA version of § 103 applies. Our decision would not change regardless of which version of the statute was applied.

⁴ Stafford (US 2008/0097246 A1, April 24, 2008) (“Stafford”), Ex. 1009.

⁵ Raymond et al. (US 2009/0124979 A1, May 14, 2009) (“Raymond”), Ex. 1010.

⁶ Turner et al. (US 2007/0135774 A1, June 14, 2007) (“Turner”), Ex. 1011.

D. The '335 Patent

The '335 patent is directed to an apparatus for inserting a medical device in the skin of a subject, as well as methods of inserting such medical devices. Ex. 1001, Abstr. Specifically, the '335 patent discloses, in certain embodiments, an apparatus that includes: (1) a sheath defining a distal surface for placement on the skin of the subject; (2) a device support movable between a proximal and distal position, and adapted to support the medical device; (3) a sharp (e.g., a needle) support movable between a proximal and a distal position and adapted to support the sharp for inserting the medical device into the skin of the subject; (4) a device support comprising a first engagement member for releasably coupling the sharp support to the device support and a second engagement member for engaging the medical device; (5) a handle movable between a proximal position and a distal position relative to the sheath and adapted to urge the device support and the sharp support from a proximal to a distal position to insert the sharp into the skin of the subject; and (6) a driver for advancing the sharp support towards the proximal position when the sharp support reaches the distal position. Ex. 1001, cols. 2–3, ll. 62–12.

Figures 61 and 63 of the '335 patent illustrate an embodiment of the claimed medical insertion device, with medical device 122 and sharp 2404 in the proximal (Figure 61) and distal (Figure 63) positions:

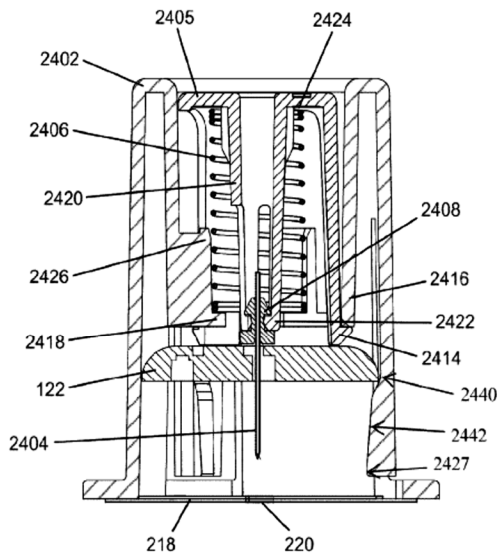


FIG. 61

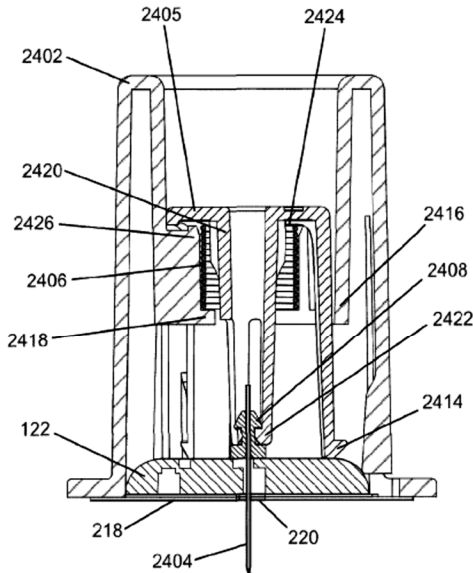


FIG. 63

Figures 61 and 63 of the '335 patent depict a cross-sectional view of the claimed medical insertion device with sharp 2404 and the base of the medical device 122 in the proximal (i.e., retracted) position (Figure 61) and in the distal (i.e., extended) position (Figure 63).

The '335 patent teaches that, when the sharp is in the proximal position, both prior to, and after, insertion of the medical device into the skin, the needle is retracted inside the device to prevent any accidental touching of the needle by the user. Ex. 1001, col. 40, ll. 50–51, Fig. 106.

Of particular relevance to our inquiry in this Decision is the '335 patent's disclosure relating to independent claim 1's recited limitation:

[A]n on body electronics unit housing comprising a plurality of recesses disposed on a periphery of the on body electronics unit housing, wherein the plurality of recesses comprises a first recess in a spaced relation to a second recess, and wherein the plurality of recesses is detachably engaged with the inserter; the glucose sensor.

Ex. 1001, col. 48, ll. 58–65.

Figure 125 of the '335 patent depicts on-body electronics unit housing 322, with one of the plurality of peripheral recesses 3766 visible in this perspective view:

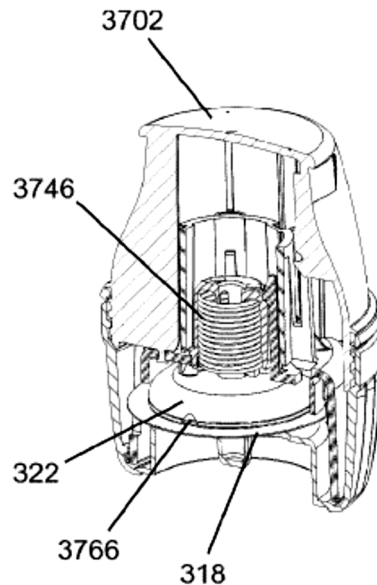


FIG. 125

Figure 125 of the '335 patent is a perspective, cutaway view of an embodiment of the claimed medical insertion device, depicting the on-body electronics unit housing 322 with one of the plurality of peripheral recesses 3766 visible in this view.

Figure 124 of the '335 patent is a similar view to Figure 125, depicting the medical device carrier 3730 extending over, and detachably engaging, the recesses of on-body electronics unit housing 322 (not visible in this view). Figure 124 is reproduced below:

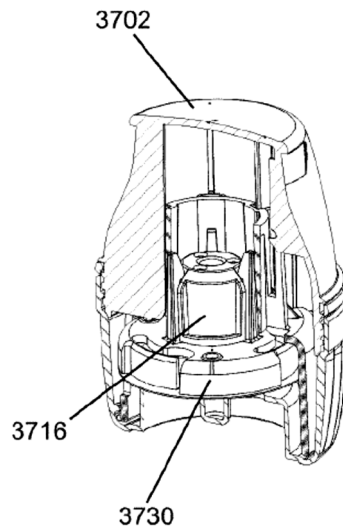


FIG. 124

Figure 124 of the '335 patent is a perspective, cutaway view of an embodiment of the claimed medical insertion device, depicting the medical device carrier 3730 engaging the electronics unit housing 322.

An enlarged view of medical device carrier 3730 is depicted in Figure 122 of the '335 patent, which is reproduced below:

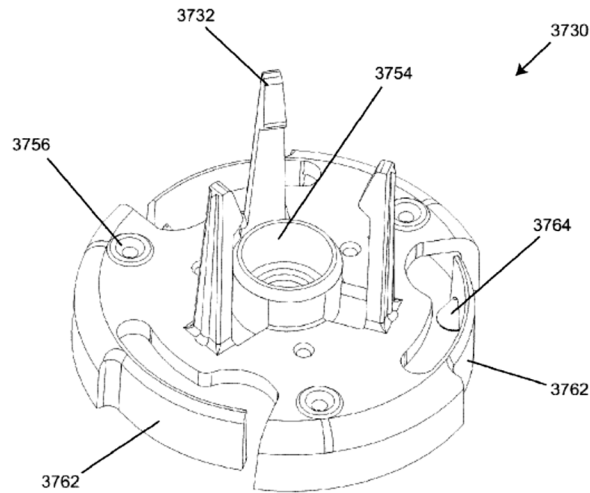


FIG. 122

Figure 122 of the '335 patent depicts a perspective view of the medical device carrier 3730.

As shown in Figure 122, the medical device carrier has a plurality of housing gripping arms 3762 (three are depicted in Figure 122) which detachably hold the on-body electronics unit housing 322 in place. Ex. 1001, col. 44, ll. 6–12. The housing gripping arms 3762 are each provided with engagement boss 3764, configured to engage with corresponding recesses 3766 provided on the side walls of the on-body electronic unit housing 322. *Id.*

E. Representative Claim

Challenged claims 5–7 indirectly depend from claim 1. Claim 1 is the sole independent claim of the '335 patent and recites:

1. A glucose monitoring assembly, the assembly comprising:
 - (1) an inserter comprising
 - a sharp configured to insert a portion of a glucose sensor into a subject; and

(2) an on body electronics unit, comprising:

an on body electronics unit housing comprising a plurality of recesses disposed on a periphery of the on body electronics unit housing, wherein the plurality of recesses comprises a first recess in a spaced relation to a second recess, and wherein the plurality of recesses is detachably engaged with the inserter;

the glucose sensor; and

on body electronics coupled with the glucose sensor, wherein the on body electronics is disposed within the on body electronics unit housing, and wherein the on body electronics includes a processor, memory, a power supply, and wireless communication circuitry configured to wirelessly communicate data indicative of a glucose level,

wherein the inserter is configured to advance the on body electronics unit and the sharp from a proximal position entirely within the inserter to a distal position, and

wherein the inserter is further configured to retract the sharp from the distal position to a retracted position entirely within the inserter.

Ex. 1001, cols. 48–49, ll. 53–12.

Challenged claims 5–7 recite:

5. The glucose monitoring assembly of claim 2, wherein the inserter further comprises a plurality of interior surfaces, wherein each interior surface of the plurality of interior surfaces is configured to hold a corresponding gripping arm of the plurality of gripping arms against a corresponding recess of the plurality of recesses of the on body electronics unit housing when the on body electronics unit is in the proximal position.

6. The glucose monitoring assembly of claim 5, wherein the inserter is further configured such that the each interior surface of the plurality of interior surfaces is not in contact with the

corresponding gripping arm of the plurality of gripping arms when the on body electronics unit is in the distal position.

7. The glucose monitoring assembly of claim 6, wherein the corresponding gripping arm of the plurality of gripping arms is configured to deflect in a radially outward direction when the each interior surface of the plurality of interior surfaces is not in contact with the corresponding gripping arm of the plurality of gripping arms.

Id., col. 49, ll. 27–46.

F. Priority History of the '335 Patent

The '335 patent issued from U.S. Application Ser. No. 17/019,110, filed on September 11, 2020 (Ex. 1001, codes (21), (22)), and claims priority through a series of continuation applications to an application that was filed on March 24, 2011, and also claims the priority benefit of US Provisional Application Ser. No. 61/317,243, which was filed on Mar. 24, 2010. *Id.* at code (60). The '335 patent issued on March 8, 2022. *Id.* at code (45).

III. CLAIM CONSTRUCTION AND LEVEL OF ORDINARY SKILL IN THE ART

A. Claim Construction

The Board applies the same claim construction standard here that would be used to construe claim language in a civil action under 35 U.S.C. § 282(b). *See* 37 C.F.R. § 100(b) (2020). Under that standard, claim terms “are generally given their ordinary and customary meaning” as understood by a person of ordinary skill in the art at the time of the invention. *Phillips v. AWH Corp.*, 415 F.3d 1303, 1312–13 (Fed. Cir. 2005) (en banc). “In determining the meaning of the disputed claim limitation, we look

principally to the intrinsic evidence of record, examining the claim language itself, the written description, and the prosecution history, if in evidence.”

DePuy Spine, Inc. v. Medtronic Sofamor Danek, Inc., 469 F.3d 1005, 1014 (Fed. Cir. 2006) (citing *Phillips*, 415 F.3d at 1312–17). Extrinsic evidence may also be consulted, but is “less significant than the intrinsic record in determining ‘the legally operative meaning of claim language.’” *Phillips*, 415 F.3d at 1317 (quoting *C.R. Bard, Inc. v. U.S. Surgical Corp.*, 388 F.3d 858, 862 (Fed. Cir. 2004)).

Neither Petitioner nor Patent Owner offers any express construction of any of the claim terms of the ’335 patent, but both argue, rather, that the plain and ordinary meaning of all claim terms should be applied. Pet. 18; Prelim. Resp. 33.

Petitioner contends Patent Owner implicitly construes “the ‘recesses disposed on a periphery’ of claim 1 to exclude Turner’s recesses as not being on *the peripheral edge*.” Reply 4–5 (emphasis in original). According to Petitioner, we agreed with Patent Owner’s implied construction in the ’01396 IPR. *Id.* We disagree with Petitioner, as we explain in Section IV.C.2.b below.

Petitioner also contends Patent Owner “reads into the claims a requirement that the recesses ‘secure’ the OBU [on-body unit]⁷ to the inserter.” Reply 7. According to Petitioner, we “accepted that requirement in the parallel IPR proceeding [i.e., the ’01396 IPR].” *Id.* We reject

⁷ E.g., challenged claim 1’s “an on body electronics unit, comprising: ... on body electronics coupled with the glucose sensor, wherein the on body electronics is disposed within the on body electronics unit housing.” Ex. 1001, cols. 48–49, ll. 55–1.

Petitioner’s contention that we “accepted the requirement” that the recesses “‘secure’ the OBU to the inserter.” Nowhere in the ’01396 IPR Decision, and particularly not in the portion of the Decision cited by Petitioner (Paper 13, 48–49), do we make any such construction, nor do we expressly or implicitly require any such “securing” function into any of the challenged claims of the ’335 patent. We address this argument in more detail in Section IV.C.2.b below. Petitioner’s claim construction argument in this respect lacks foundation and is without merit.

We determine that no express construction of any claim term beyond the ordinary and customary meaning, as understood by a person of ordinary skill in the art at the time of the invention, is necessary for the purpose of rendering this Decision. *Nidec Motor Corp. v. Zhongshan Broad Ocean Motor Co.*, 868 F.3d 1013, 1017 (Fed. Cir. 2017).

B. The Person of Ordinary Skill in the Art

Petitioner contends that the person of ordinary skill in the art at the time of invention would have had a bachelor’s degree in bioengineering, mechanical engineering, electrical engineering, or a related subject, and one or more years of experience researching, developing, and/or designing insertable medical devices, including, e.g., systems for implanting wearable medical devices such as cannulas, infusion sets, and analyte sensors, or equivalent experience. Pet. 13–14. Petitioner also proposes that less work experience could be compensated by a higher level of education, such as a master’s degree, and *vice versa*. *Id.* (citing Ex. 1268 ¶ 24). Patent Owner does not dispute Petitioner’s definition of the person of ordinary skill in the art. Prelim. Resp. 32–33.

Petitioner’s proposed definition of the level of ordinary skill in the art appears to be consistent with the level of skill presented in the cited prior art. *See, e.g.*, Exs. 1268, Exs. 1009–1011; *see also Okajima v. Bourdeau*, 261 F.3d 1350, 1355 (Fed. Cir. 2001) (the prior art itself may reflect an appropriate level of skill in the art). For the purposes of this Decision, then, we adopt Petitioner’s proposed definition as the definition of the person of ordinary skill in the art.

IV. ANALYSIS

A. *Principles of Law*

1. Burden of Proof

“In an [*inter partes* review], the petitioner has the burden from the onset to show with particularity why the patent it challenges is unpatentable.” *Harmonic Inc. v. Avid Tech., Inc.*, 815 F.3d 1356, 1363 (Fed. Cir. 2016 (citing 35 U.S.C. § 312(a)(3) (requiring *inter partes* review petitions to identify “with particularity ... the evidence that supports the grounds for the challenge to each claim”))). Therefore, in an *inter partes* review, the burden of proof is on the Petitioner to show that the challenged claims are unpatentable; that burden never shifts to the patentee. *See* 35 U.S.C. § 316(e); *In re Magnum Oil Tools Int’l, Ltd.*, 829 F.3d 1364, 1375 (Fed. Cir. 2016) (citing *Dynamic Drinkware, LLC v. Nat’l Graphics, Inc.*, 800 F.3d 1375, 1378 (Fed. Cir. 2015)). At the institution stage, Petitioner must show a reasonable likelihood that it would prevail with respect to at least one of the claims challenged in the petition. 35 U.S.C. § 314.

2. Obviousness

To ultimately prevail in its challenge to Patent Owner’s patent claims, Petitioner must demonstrate by a preponderance of the evidence⁸ that the claims are unpatentable. 35 U.S.C. § 316(e); 37 C.F.R. § 42.1(d). A patent claim is unpatentable under pre-AIA 35 U.S.C. § 103 if the differences between the claimed subject matter and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. 35 U.S.C. § 103(a) (2006); *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 406 (2007). The question of obviousness is resolved on the basis of underlying factual determinations including: (1) the scope and content of the prior art; (2) any differences between the claimed subject matter and the prior art; (3) the level of ordinary skill in the art; and (4) objective evidence of obviousness or nonobviousness. *Graham v. John Deere Co.*, 383 U.S. 1, 17–18 (1966).

In determining obviousness when all elements of a claim are found in various pieces of prior art, “the factfinder must further consider the factual questions of whether a person of ordinary skill in the art would be motivated to combine those references, and whether in making that combination, a person of ordinary skill would have had a reasonable expectation of success.” *Dome Patent L.P. v. Lee*, 799 F.3d 1372, 1380 (Fed. Cir. 2015); *see also WMS Gaming, Inc. v. Int’l Game Tech.*, 184 F.3d 1339, 1355 (Fed.

⁸ The burden of showing something by a preponderance of the evidence requires the trier of fact to believe that the existence of a fact is more probable than its nonexistence before the trier of fact may find in favor of the party who carries the burden. *Concrete Pipe & Prods. of Cal., Inc. v. Constr. Laborers Pension Tr. for S. Cal.*, 508 U.S. 602, 622 (1993).

Cir. 1999) (“When an obviousness determination relies on the combination of two or more references, there must be some suggestion or motivation to combine the references.”). “Both the suggestion and the expectation of success must be founded in the prior art, not in the applicant’s disclosure.” *In re Dow Chemical Co.*, 837 F.2d 469, 473 (Fed. Cir. 1988); *see also In re Magnum Oil Tools*, 829 F.3d at 1381 (finding a party that petitions the Board for a determination of unpatentability based on obviousness must show that “a skilled artisan would have been motivated to combine the teachings of the prior art references to achieve the claimed invention, and that the skilled artisan would have had a reasonable expectation of success in doing so”).

An obviousness analysis “need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ.” *KSR*, 550 U.S. at 418; *see also In re Translogic Tech., Inc.*, 504 F.3d 1249, 1259 (Fed. Cir. 2007). In *KSR*, the Supreme Court also stated that an invention may be found obvious if trying a course of conduct would have been obvious to a person of ordinary skill in the art:

When there is a design need or market pressure to solve a problem and there are a finite number of identified, predictable solutions, a person of ordinary skill has good reason to pursue the known options within his or her technical grasp. If this leads to the anticipated success, it is likely the product not of innovation but of ordinary skill and common sense. In that instance the fact that a combination was obvious to try might show that it was obvious under § 103.

550 U.S. at 421. “*KSR* affirmed the logical inverse of this statement by stating that § 103 bars patentability unless ‘the improvement is more than

the predictable use of prior art elements according to their established functions.” *In re Kubin*, 561 F.3d 1351, 1359–60 (Fed. Cir. 2009) (citing *KSR*, 550 U.S. at 417).

We analyze the asserted grounds of unpatentability in accordance with the above-stated principles.

B. Ground 1: Obviousness Under 35 U.S.C. § 103(a) of Challenged Claims 5–7 over Stafford (Ex. 1009) and Raymond (Ex. 1010)

1. Overview of the Prior Art

a. Stafford

Stafford is US Appl. 2008/0097246 A1, published on April 24, 2008, and qualifies as prior art to the ’335 patent. Ex. 1009, codes (10), (43).

Stafford is directed to “[m]ethods and apparatus for providing an integrated analyte sensor and data processing unit assembly.” Ex. 1009, Abstr. Specifically, Stafford teaches an integrated assembly, including: (1) a housing; (2) a data processing unit disposed within the housing; (3) an introducer removably coupled to the housing; (4) at least a portion of the introducer disposed within the housing; and (5) an analyte sensor coupled to the housing. *Id.* ¶ 6. Stafford further teaches that a first portion of the analyte sensor is configured for subcutaneous placement, and, when placed, is in fluid contact with an interstitial fluid of the subject. *Id.* Stafford teaches that a second portion of the analyte sensor is disposed within the housing and is in electrical communication with the data processing unit. *Id.*

Figure 4A of Stafford depicts an exemplary embodiment of such an apparatus and is reproduced below:

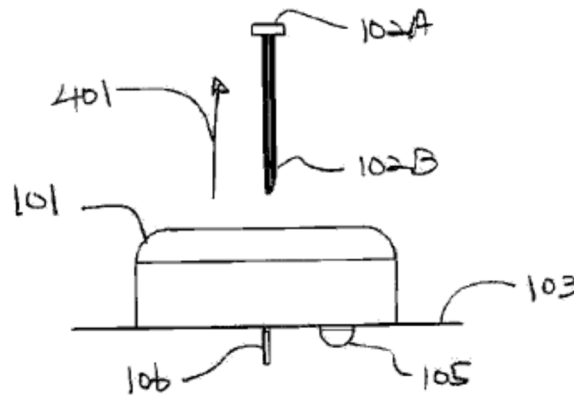


FIGURE 4A

Figure 4A is a schematic diagram of an integrated analyte sensor delivery and data processing unit with introducer 102 removed and the first portion of analyte sensor 106 implanted.

Stafford teaches that the first portion of its introducer 102B has a sharp tip that pierces the subject's skin 103 to deliver the sensor subcutaneously. Ex. 1009 ¶¶ 21, 24, Figs. 4A, 5B–5C. Specifically, Stafford teaches that the inserter is configured to pierce through the skin of the patient and concurrently guide the sensor through the patient's skin so as to place at least a portion of the sensor in fluid contact with the target biological fluid of the subject. *Id.* ¶ 2. Stafford explains that once sensor 106 is accurately positioned, inserter 102 is removed and discarded, and that doing so “requires a level of care” to avoid injury from the introducer's sharp tip. *Id.* ¶ 3. Stafford cautions that “particular precautions” should be taken to avoid contact with the tip (e.g., the first portion 102B), after contact with the subject's biological fluids. *Id.*

Stafford also teaches that its data processing unit 101 includes electronics, e.g., a processor, a power supply, and an RF transceiver for wirelessly transmitting sensor data. Ex. 1009 ¶¶ 40, 52, Fig. 7.

b. Raymond

Raymond is US Appl. US 2009/0124979 A1, published on May 14, 2009, and qualifies as prior art to the '335 patent. Ex. 1010, codes (10), (43).

Raymond is directed to “[a]n insertion device for inserting an infusion device at least partially into skin for subcutaneous infusion.” Ex. 1010, Abstr. Specifically, Raymond teaches an inserter for placing an infusion device comprising: (1) a sleeve; (2) a carriage; (3) at least at first biasing member; (4) a hub; (5) a needle; (6) at least a second biasing member; and (7) an actuator. *Id.* ¶ 15.

Figures 29 and 30, reproduced below, depict a relevant embodiment of Raymond:

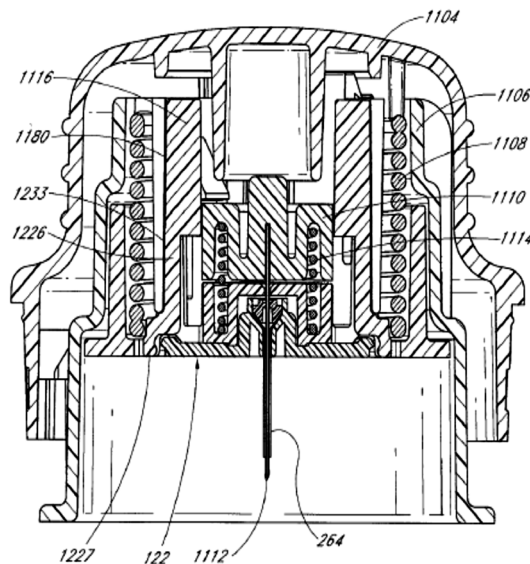


FIG. 29

Figure 29 of Raymond depicts a cross-sectional view of an insertion device with sharp 1112, cannula 264 and base 122 in the proximal position.

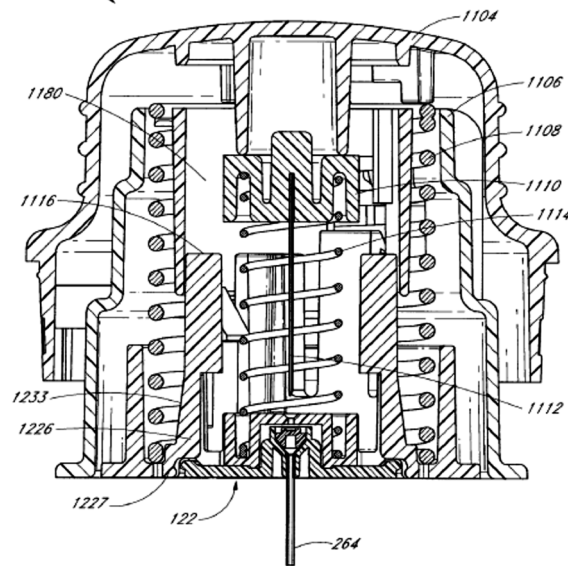


FIG. 30

Figure 30 of Raymond depicts a cross-sectional view of an insertion device with cannula 264 and base 122 in the distal position.

As pictured above, Figure 29 of Raymond depicts the insertion device with needle 1112 and cannula 264, and the base of infusion device 122 in a proximal (retracted) position prior to injection and insertion through the skin of the subject (at the base of the device). Raymond's Figure 30 depicts cannula 264 and the base of infusion device 122 in a distal (extended) position subsequent to injection and insertion through the skin. Raymond further teaches that base 122 is held in position in the proximal position by base-retaining arms 1226.

Raymond teaches several advantages of its insertion device, including positioning the needle within the insertion device before insertion and retracting the needle within the insertion device after insertion to prevent accidental injury to the user. Ex. 1010 ¶¶ 8, 104, 109, 127.

2. Analysis

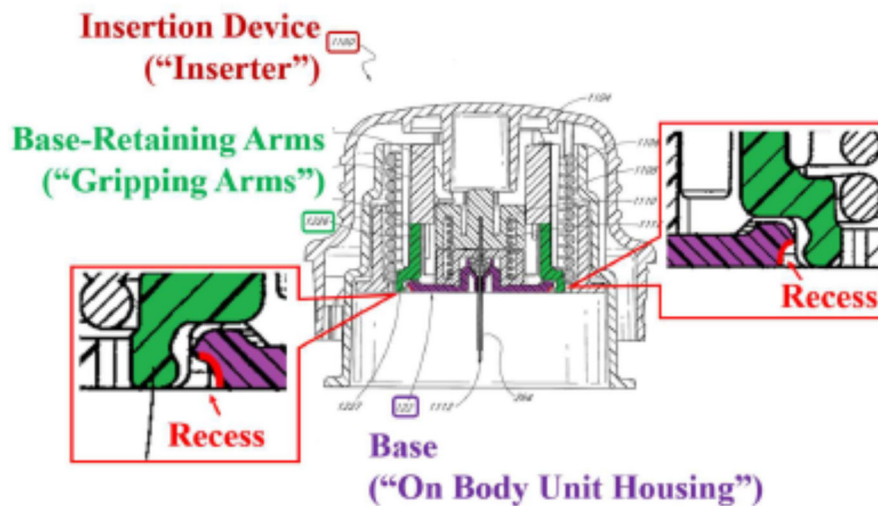
a. Claim 1

Although independent claim 1 is not directly challenged in the present Petition, challenged claims 5–7 depend, directly or indirectly, from claim 1, which is the sole independent claim of the '335 patent. Challenged claims 5–7 thus incorporate all of the limitations of the claim(s) from which they depend. *See Monsanto Co. v. Syngenta Seeds, Inc.*, 503 F.3d 1352, 1357 (Fed. Cir. 2007) (holding that “[a] claim in dependent form shall be construed to incorporate by reference all the limitations of the claim to which it refers” (quoting 35 U.S.C § 112, ¶ 4 (2000))).

In Ground 1 of the '01396 IPR, claims 1–4, 8, 9, and 11–27 of the '335 patent were challenged by Petitioner as being obvious over the same combination of references, Stafford and Raymond, that are used to challenge dependent claims 5–7 of the same patent in Ground 1 of the present Petition. *See* '01396 IPR, Paper 2, 4.

In the '01396 IPR Decision, we concluded that Petitioner had not met its burden of demonstrating a reasonable likelihood of prevailing at trial in demonstrating that claim 1 of the '335 patent would have been obvious over the combination of Stafford and Raymond, the same references that are the basis of Ground 1 in the present Petition. Briefly, we found that Petitioner relied upon Raymond as teaching the limitations of challenged claim 1 reciting a “plurality of recesses comprises a first recess in a spaced relation to a second recess,” “disposed on a periphery of the on body electronics unit housing.” Dec. 27–28. In particular, we noted that Petitioner relied upon portions of its annotated Figure 29 of Raymond, arguing that a skilled artisan would have recognized that the portions of base 122 indicated in red on

either side of base 122 constitute the plurality of recesses located on the periphery of the on-body electronics housing unit. Dec. 29 (citing Pet. 29). Petitioner’s annotated version of Raymond’s Figure 29—which it relies on again in the present Petition (*see* Pet. 37)—is reproduced below:



As shown in Figure 18, base 122 of Raymond's device comprises a circular disk, with an annular ring on the proximal side. This view is consistent with the cross-sectional view of base 122 in Raymond's Figure 29.

Dec. 29. We concluded that:

The annular ring of base 122, as depicted in Raymond's Figures 18 and 29 thus comprises, at most, a single recess encircling base 122 beneath the annular ring at the periphery of the base. As such, it neither teaches nor suggests "a plurality of recesses disposed on a periphery of the on-body electronics unit housing, wherein the plurality of recesses comprises a first recess in a spaced relation to a second recess," as required by challenged claim 1 of the '335 patent.

Dec. 30.

We also noted that other prior art references cited by Petitioner⁹, relied upon as ostensibly teaching that "feet/protrusions like those taught by Raymond, were regularly designed to engage corresponding recesses or notches on associated components, in order to retain the components in relative position to one another," were similarly not persuasive, because none of these references taught a plurality of recesses. Dec. 31–35 (quoting Pet. 30). We therefore concluded that Petitioner had not demonstrated a reasonable likelihood of success in demonstrating at trial that challenged claim 1 would have been obvious over the combination of Stafford and Raymond. *Id.* at 36.

We adopt the same reasoning here. Ground 1 of the present Petition relies upon the same references as Ground 1 of the '01396 IPR Petition, and Petitioner's arguments, which are substantially the same as those in the '01396 IPR Petition, fail to persuade us that Petitioner has shown a

⁹ See Dec. 31–35 (reviewing Exhibits 1018, 1040, 1042, and 1057).

reasonable likelihood of success in demonstrating that challenged claim 1 is unpatentable as obvious over the cited prior art.¹⁰

b. Claims 5–7

Challenged claims 5–7 of the '335 patent all ultimately depend from claim 1, which is the sole independent claim. As such, each of claims 5–7 incorporate by reference the limitation of claim 1 reciting:

[A]n on body electronics unit housing comprising ***a plurality of recesses disposed on a periphery of the on body electronics unit housing***, wherein the plurality of recesses comprises a first recess in a spaced relation to a second recess, and wherein the plurality of recesses is detachably engaged with the inserter.

See Monsanto, 503 F.3d at 1357.

Because Petitioner has failed to demonstrate a reasonable likelihood of success in demonstrating at trial that claim 1 is unpatentable on Ground 1, Petitioner similarly fails to meet the same burden with respect to challenged dependent claims 5–7.

C. *Ground 2: Obviousness Under 35 U.S.C. § 103(a) of Challenged Claims 5–7 over Stafford (Ex. 1009), Raymond (Ex. 1010), and Turner (Ex. 1011)*

1. Overview of the Prior Art

a. Turner

Turner is U.S. Appl. 2007/0135774 A1, published on June 14, 2007, and qualifies as prior art to the '335 patent. Ex. 1011, codes (10), (43).

¹⁰ We note that, in its Request for Rehearing of the '01396 IPR Decision, Petitioner does not directly contest our conclusion with respect to Ground 1.

Turner is directed to: “Fluid delivery devices, systems, and methods.”

Ex. 1011, Abstr. Specifically, Turner teaches that its invention:

[M]ay be used to deliver fluid such as insulin to users such as people with diabetes. Some embodiments of the present fluid delivery devices may be configured to be worn for an extended period of time (e.g., multiple days) and allow a user to inject a fluid (such as a physician-prescribed drug) into the user’s body without the need to repeatedly puncture the user’s skin with a needle.

Ex. 1011 ¶ 6. Turner teaches that certain embodiments of its invention include, broadly, a body, a cannula, a needle guide, and a septum, and that the body may be made from one or more pieces. *Id.* ¶ 7.

Figure 9 of Turner depicts the base of an embodiment of the fluid delivery system of Turner, and is reproduced below:

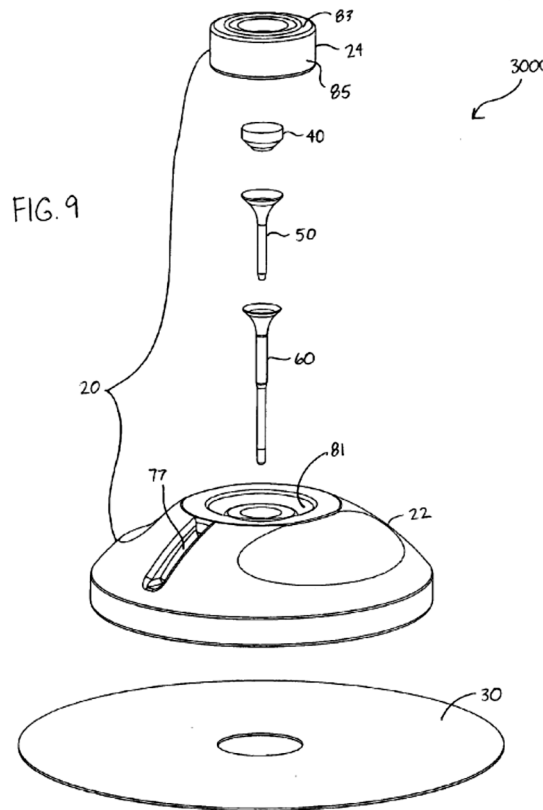
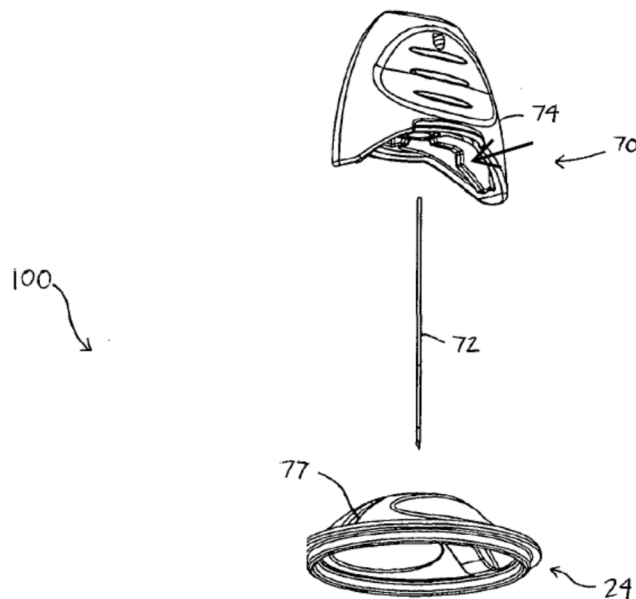


Figure 9 of Turner is a perspective, exploded view of its fluid delivery system including body 20.

Turner discloses that, in this embodiment, body 20 includes rotation-restricting recesses 77. Ex. 1011 ¶ 102. Figure 2B of Turner (reproduced below) illustrates how:

Body **20** and insertion device **70** may be configured such that insertion device **70** cannot rotate with respect to body **20** when fully inserted in body **20**. One manner of achieving this configuration comprises providing hub **74** with rotation-restricting protrusions **71**^[11], which extend in a downstream or downward direction from the main portion of insertion device hub **74**, and by providing cap element **24** of body **20** with rotation-restricting recesses **77**.

Id. ¶ 69.



Annotated detail of Figure 2B of Turner showing rotation-restricting protrusions (unlabeled arrow) and rotation restricting recesses 77

¹¹ Rotation restriction protrusions 71 are not labeled in Turner's Figure 2B, but are indicated by the unlabeled arrow.

Figure 3 of Turner illustrates how rotation-restricting protrusions 71 and rotation restricting recesses 77 fit together to prevent relative rotation of insertion device 70 and body 20 (*see* Figure 9 above):

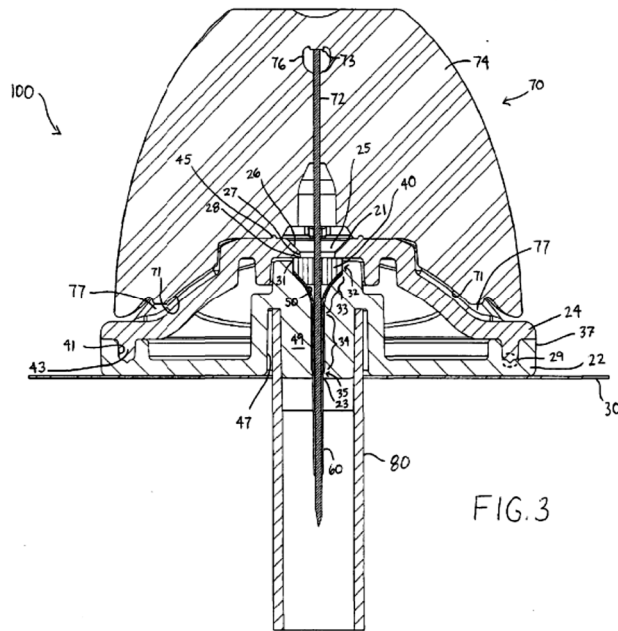


Figure 3 of Turner is a cross sectional view depicting rotation-restricting protrusions 71 and rotation restricting recesses 77 fitted together.

See also Ex. 1011 ¶¶ 69–71.

2. Analysis

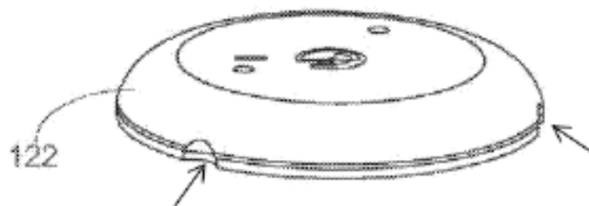
a. Claim 1

As with Ground 1, discussed above, Ground 2 of the present Petition challenges dependent claims 5–7 with the same references that were relied upon to challenge claims 1–4, 8, 9, and 11–27 of the '335 patent in Ground 2 of the '01396 IPR Petition. *See* '01396 IPR, Paper 2, 4. And, again, challenged claims 5–7 incorporate by reference all of the limitations of

independent claim 1, from which they ultimately depend. *Monsanto*, 503 F.3d at 1357.

In the '01396 IPR, we concluded that Petitioner had failed to demonstrate a reasonable likelihood of success in demonstrating that challenged claim 1 of the '335 patent would have been obvious over the combination of Stafford, Raymond, and Turner. Briefly, we repeated our conclusion with respect to Ground 1 that the combination of Stafford and Raymond failed to teach or suggest the limitation of claim 1 reciting “a plurality of recesses disposed on a periphery of the on body electronics unit housing, wherein the plurality of recesses comprises a first recess in a spaced relation to a second recess, and wherein the plurality of recesses is detachably engaged with the inserter.” Dec. 46. We consequently turned to the question of whether the teachings of Turner were sufficient to cure this deficit. *Id.*

We found that Figure 17 of the '335 patent, among others, depicts recesses disposed on a periphery of an on-body electronics housing unit, as claimed. Dec. 46. Figure 17, annotated by the Board, is reproduced below:



Annotated Figure 17 (detail) of the '335 patent, indicating with arrows the plurality of recesses on a periphery of the on-body electronics housing unit 122

We also noted that the Specification of the '335 patent further describes the peripheral recesses of the on-body electronics housing unit:

[G]ripping arms **3762** [of medical device carrier **3730**] are provided with engagement boss **3764** which are configured to engage with *corresponding recesses 3766 provided on the side walls of the on body housing 322*. Such engagement of the recesses **3766** with the gripping arms **3762** maintains the proper height location of the on body housing **322**.

Dec. 47 (quoting Ex. 1001, col. 44, ll. 9–14 (emphasis added)).

We found that both the text and Figures of the '335 patent's Specification illustrated claim 1's limitation reciting "recesses disposed on a periphery of the on body electronics unit housing." Ex. 1001, col. 44, ll. 60–61. We further found that these peripheral recesses, mounted on the circumference of the on-body housing, are substantially different from what is disclosed in the prior art combination cited by Petitioner and, furthermore, serve an entirely different purpose. Dec. 48.

Specifically, we found that Turner's rotation-resisting recesses 77 are not located on a periphery of its body 20, such that they can be engaged to hold the on-body housing properly positioned within the device, but are rather disclosed as being located upon an upper surface of body 20, between its central axis and its edge. Dec. 48–49. We further found that Turner's recesses 77 are configured to receive rotation-resisting protrusions 71 of insertion device 70, as depicted in Figure 9, which is reproduced again below:

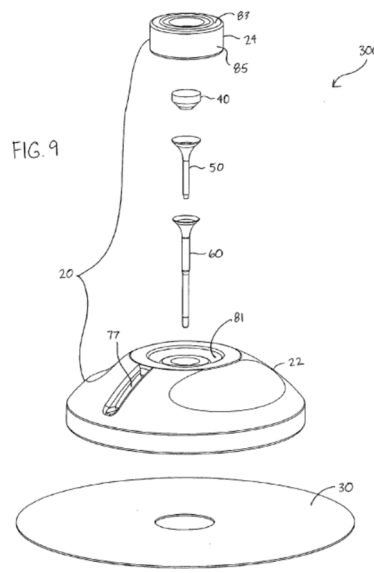


Figure 9 of Turner is a perspective, exploded view of its fluid delivery system including body 20 and rotation-restricting recesses 77

Dec. 49. We therefore concluded that Turner does not teach or suggest the limitation of challenged claim 1 reciting “an on body electronics unit housing comprising a plurality of recesses disposed on a periphery of the on body electronics unit housing.” *Id.*

We further concluded that Petitioner had provided no persuasive reason why a person of ordinary skill in the art would have been motivated to alter the location of Turner’s rotation-resisting recesses 77 from the upper surface of body 20 to the periphery of body 20, because Turner and the ’335 patent teach that their respective recesses serve different functions, i.e., prevention of rotation of body 20 (Turner), versus “maintaining the proper height location of the on body housing 322” within the interior of its insertion device (the ’335 patent). Dec. 48–50 (citing Ex. 1101 ¶ 69, and quoting Ex. 1001, col. 44, ll. 13–14).

The Petition in the present proceeding employs substantially the same arguments as those presented in the ’01396 IPR Petition. *See* ’01396 IPR

Dec. 20–26, 40–42. We consequently adopt the same reasoning that we explained in the ’01396 IPR Decision, and conclude that the arguments set forth by Petitioner in the present Petition fail to demonstrate a reasonable likelihood of success in demonstrating at trial that claim 1 of the ’335 Petition are obvious over the combination of Stafford, Raymond, and Turner.

b. Petitioner’s additional arguments

In its Reply Brief in the present proceeding, which was filed after entry of our ’01396 IPR Decision, Petitioner makes several arguments in addition to those filed in the ’01396 IPR Petition and in its present Petition. We now address these additional arguments.

First, Petitioner argues that Turner provides motivation to use recesses to resist rotation. Reply 3. According to Petitioner, a person of ordinary skill in the art “would have been motivated to implement similar plural rotation-restricting recesses on the periphery of the housing ... to prevent rotation between the housing as taught by Stafford and the inserter as taught by Raymond.” *Id.* (quoting Pet. 39–40; and citing Ex. 1268 ¶ 88).

Petitioner further argues that implementing a Stafford-like housing with sidewall recesses to engage the arms of a Raymond-like inserter was an obvious design choice, with an anti-rotation benefit. Reply 3. Petitioner reminds us that “[a]n obvious design choice need not be an ‘improvement’ or reduce complexity. Rather, it need only be a ‘suitable option.’” *Id.* at 4 (quoting *Intel Corp. v. PACT XPP Schweiz AG*, 61 F.4th 1373, 1380–81 (Fed. Cir. 2023)). Petitioner contends that the use of two recesses would be an improvement, as they provide an anti-rotation benefit. *Id.* (citing ’01396

IPR Dec. 37–40; Prelim. Resp. 31–32; Pet. 33, 39–43). Petitioner argues that even if using two recesses would have added complexity, no record evidence suggests a skilled artisan would have foregone the anti-rotation benefits taught by Turner to limit unintended rotation between the OBU and the inserter. *Id.* (citing *KSR*, 550 U.S. at 421 (solutions may be obvious to try “[w]hen there is a design need ... to solve a problem and there are a finite number of identified, predictable solutions”)).

Petitioner also notes that Patent Owner offered no evidence that a person of skill in the art would have considered any other designs beyond the two options discussed above for engaging a Stafford-like housing with Raymond-like arms designed to engage at the side of an OBU. *Id.*

We do not find these arguments persuasive. It may be so that Turner teaches that its recesses 77 receive rotation-restricting protrusions 71, which “extend[] into each recess 77 such that the recess side walls interfere with the protrusions to prevent rotation of the insertion device relative to body 20.” Ex. 1011 ¶ 69. And, it may also be so that Turner teaches this assembly as an advantage in that it prevents rotation of body 20. *Id.*

However, Petitioner did not present this “design choice” theory of obviousness in the Petition. Petitioner first raises its “obvious design choice” argument with respect to Turner and Ground 2 in its Reply Brief; it is not to be found in its Petition.¹² Petitioner cannot raise an argument in its

¹² The Petition makes a design choice argument with respect to the teachings of Raymond on Ground 1, contending that “it would have been an obvious design choice to implement two spaced-apart plural recesses on the housing—one to engage the protrusions on each of the two arms taught by Raymond.” Pet. 38. However, Petitioner adduced no prior art teaching or evidence of record of “spaced-apart plural recesses on the housing” that

Reply Brief if that argument could first have been raised in its Petition. 37 C.F.R. § 42.23(b); *see also* *L'Oréal USA, Inc. v. Univ. of Massachusetts*, 2018 WL 4278992, *5 n.4 (PTAB Sept. 7, 2018); *Matterport, Inc. v. Appliance Comp. III, Inc.*, 2021 WL 6340164, *9–10 (PTAB Nov. 19, 2021).

Furthermore, Petitioner's arguments fail on the merits. As we specifically stated in the '01396 IPR Decision:

We further conclude that Petitioner provides no persuasive reason why a person of ordinary skill in the art would have been motivated to alter the location of Turner's rotation-resisting recesses 77 from the upper surface of body 20 to the periphery of body 20, because Turner and the '335 patent teach that their respective recesses serve different functions.

Dec. 49–50. In other words, in the preceding case we found that, whereas Turner expressly teaches that its rotation-resisting recesses 77 and the corresponding rotation-resistant protrusions 71 “prevent rotation of the insertion device relative to body 20,” the '335 patent discloses that its recesses 3766 are configured to engage with engagement bosses 3764 of gripping arms 3762 to “maintain[] the proper height location of the on body housing 322” within the interior of its insertion device. '01396 IPR Dec. 50–51 (quoting Ex. 1011 ¶ 69; Ex. 1001, col. 44, ll. 13–14). Consequently, we concluded that, because Turner's and the '335 patent's respective recesses serve different functions, Petitioner needed to provide a reason, supported by evidence of record, why a person of ordinary skill in the art

would have been known to those of skill in the art and would have formed the basis of a design choice for a skilled artisan. *KSR*, 550 U.S. at 421. That is not the argument Petitioner makes with respect to Turner in its Reply Brief and which we address here.

would have been motivated to alter the location of Turner’s recesses to serve a different function. We concluded that Petitioner had failed to meet this burden.

Petitioner’s reliance on *KSR* is misplaced. The Decision in *KSR* holds that:

When there is a design need or market pressure to solve a problem and there are a finite number of identified, predictable solutions, a person of ordinary skill has good reason to pursue the known options within his or her technical grasp. If this leads to the anticipated success, it is likely the product not of innovation but of ordinary skill and common sense. In that instance the fact that a combination was obvious to try might show that it was obvious under § 103.

KSR, 550 U.S. at 421 (emphasis added).

Our reviewing court has repeatedly held that when alternative methods of solving *the same problem* are known to those of skill in the art, substitution of one method for the other constitutes an obvious design choice. *See Uber Techs., Inc. v. X One*, 957 F.3d 1334, 1340 (Fed. Cir. 2020); *Wyers v. Master Lock Co.*, 616 F.3d 1231, 1238 (Fed. Cir. 2010) (holding that a motivation to combine and a reasonable expectation of success exist when “it is simply a matter of common sense” to combine known elements of the prior art to solve a known problem).

As we explained in the ’01396 IPR Decision, countering the rotation tendencies of the OBU and “maintain[ing] the proper height location of the on body housing 322” within the interior of the insertion device, are different problems that are addressed differently by the disclosures of Turner and the ’335 patent. Dec. 49–51. Petitioner does not provide any evidence of record that a person of skill in the art would have recognized that the

structures taught by Turner for preventing OBU rotation and those of the '335 patent for holding the OBU at its proper height within the insertion device are equivalent methods for solving a common problem. *See Uber Techs.*, 957 F.3d at 1340 (holding that a person of ordinary skill in the art, faced with two predictable choices for when to perform the *same specific task*, would have an obvious design choice to make).

Raymond does not assist Petitioner's argument. Raymond teaches that its:

[A]rms **1226** can include base-retaining feet **1227**, to clamp, grasp, or otherwise engage the base **122** and secure it to the shuttle **1116**. ... [and] can include sleeve-engagement surfaces **1233** positioned for engagement by the cam surface **1180** of the sleeve **1106** to urge the base-retaining feet **1227** toward the base **122** to impede unintentional disengagement of the infusion device **102** from the shuttle **1116**.

Ex. 1010 ¶ 123. In other words, Raymond teaches that its base-retaining feet 1227 engage with the OBU to maintain its position in the sleeve of the device and prevent unintentional disengagement.

Petitioner does not provide any persuasive evidence of record that a person of ordinary skill in the art would have recognized that the structures taught by Turner for preventing OBU rotation and those of Raymond and the '335 patent for holding the OBU in its proper position within the insertion device and preventing disengagement from the device are equivalent methods for solving a common problem. *See Uber Techs.*, 957 F.3d at 1340 (holding that a person of ordinary skill in the art, faced with two predictable choices for when to perform the *same specific task*, would have an obvious design choice to make). Consequently, Petitioner's arguments in this respect are both untimely and fail on the merits.

Petitioner next argues that Patent Owner’s “implied claim constructions are incorrect.” Reply 4. Petitioner argues that the ’335 patent does not use the word “periphery” outside of claim 1, but acknowledges that the ’335 Specification discloses only embodiments showing recesses on the side wall or edge. *Id.* at 4–5. Nevertheless, argues Petitioner, nothing expressly limits the language “on a periphery” in claim 1 to mean being on a side wall or on the peripheral edge. *Id.* at 5. Petitioner notes that claim 12 of the ’335 patent (not challenged in the present proceeding) adds the requirement that the recesses are “disposed on a side wall” of the OBU, and argues that the doctrine of claim differentiation suggests claim 1 is broader and does not require recesses to be on a side wall, let alone on the peripheral edge of the OBU. *Id.* at 6.

Petitioner then points to a dictionary definition of “periphery,” contending that the term is not limited to the outermost circumferential edge, but means “1: the perimeter ... 2: the external boundary or surface of a body ... 3a: the outward bounds of something as distinguished from its internal regions or center.” Reply 6 (quoting “Periphery,” Merriam-Webster Dictionary, *available at*: www.merriam-webster.com/dictionary/periphery (last visited July 29, 2024)). Petitioner notes that its declarant, Dr. Fletcher, opines that “[e]ach protrusion [i.e., rotation-resistant protrusions 71] is configured to engage a corresponding one of a plurality of rotation-restricting recesses disposed on the periphery of the fluid delivery device’s body.” *Id.* (quoting Ex. 1268 ¶ 49). Petitioner also asserts that Turner contrasts an outer perimeter, e.g., “outer perimeter 37 of body 20” at the bottom, with other perimeters or peripheries, e.g., the smaller “perimeter 39 at top 12,” and that Turner’s Figure 11 illustrates two planes, P1 and P2,

each described as containing a perimeter. *Id.* (citing Ex. 1011, ¶¶ 71, 104, Figs. 3, 11).

Finally, Petitioner argues that Patent Owner allegedly reads into the claims a requirement that the recesses “secure” the OBU to the inserter, and, Petitioner contends, the Board accepted that requirement in its ’01396 IPR Decision. Reply 7 (citing Prelim. Resp. 14–16, 20; Dec. 48–49).

We do not find Petitioner’s arguments persuasive. As an initial matter, and as we stated in Section III.A above, we reject Petitioner’s contention that we “accepted the requirement” that the recesses “‘secure’ the OBU to the inserter.” Nowhere in the ’01396 IPR Decision, and particularly not in the portion of the Decision cited by Petitioner (Paper 13, 48–49), do we make any such construction, nor do we expressly or implicitly require any such “securing” function into any of the challenged claims of the ’335 patent. Rather, the cited portion of the ’01396 IPR Decision’s analysis concluded that:

Petitioner provides no persuasive reason why a person of ordinary skill in the art would have been motivated to alter the location of Turner’s rotation-resisting recesses 77 from the upper surface of body 20 to the periphery of body 20, because Turner and the ’335 patent teach that their respective recesses serve different functions.

Dec. 49. This portion of the analysis thus looked to whether a skilled artisan would have been motivated to combine the teachings of Stafford, Raymond, and Turner, based upon the different functions of the recesses, and does not read additional functional limitations into the claim, as Petitioner contends.

Furthermore, Petitioner offers no claim construction for the claim term “periphery” in its Petition, other than “the ordinary meaning that the terms would have to a POSITA at the time of the invention, in view of the

specification and file history.” *See* Pet. 18 (citing 83 Fed. Reg. 51340; *Phillips*, 415 F.3d at 1312–12). As we stated in Section III.A above, we apply that standard in the present Decision. Additionally, Petitioner’s declarant, Dr. Fletcher, adduces no evidence of record to support his contention that “[e]ach protrusion [i.e., rotation-resistant protrusions 71] is configured to engage a corresponding one of a plurality of rotation-restricting recesses disposed on the periphery of the fluid delivery device’s body.” Ex. 1268 ¶ 49.

In its Reply, Petitioner now proposes a new construction of the claim term “periphery.” Petitioner adopts a selectively-edited dictionary definition of the term “periphery.” The complete Merriam-Webster dictionary definition of periphery reads:

- 1** : the perimeter of a circle or other closed curve also : the perimeter of a polygon
- 2** : the external boundary or surface of a body
- 3** **a** : the outward bounds of something as distinguished from its internal regions or center : CONFINES
b : an area lying beyond the strict limits of a thing.

“Periphery,” Merriam-Webster Dictionary, *available at*: www.merriam-webster.com/dictionary/periphery (last visited July 29, 2024).

In each of the ’335 Specification, Stafford, Raymond, and Turner, the OBU is universally depicted as having a circular perimeter oriented around a longitudinal axis, and possessing either a cylindrical shape (’335 patent, Stafford, Raymond) or a roughly domed shape, with a circular, circumferential collar. *See, e.g.*, Ex. 1001, Figs. 8, 17, 52, 54; Ex. 1009, Figs 3A–C, 4A; Ex. 1010, Figs. 14–16, Ex. 1011, Figs. 2A–B, 5G, 7A–B, 9, 11, 13A–B, 14, 15, 19, 20, 21, 25, 29, 30, 37, 38. Moreover, in each

description of the location of recesses 3766 in the '335 Specification, the recesses are described as being located “on the side walls” of the OBU. *See* Ex. 1001, col. 44, ll. 8–12; col. 45, ll. 61–64. Given the circular perimeter of all of these embodiments of the disclosures of the '335 Specification, the teachings of Petitioner’s cited references, the dictionary definition of “periphery” as being “the perimeter of a circle or other closed curve,” and the ordinary meaning that the terms would have had to a skilled artisan at the time of the invention, in view of the '335 Specification and file history” (*Phillips*, 415 F.3d at 1312–13), we conclude that a person of ordinary skill in the art would understand that the “plurality of recesses disposed on a periphery of the on body electronics unit housing” would be located “on the circumference of the on-body housing,” as we concluded in the '01396 IPR Decision. *See* Dec. 48; *see also* Ex. 1001, col. 44, ll. 9–14 (stating that “gripping arms 3762 [of medical device carrier 3730] are provided with engagement boss 3764 which are configured to engage with corresponding recesses 3766 provided on the side walls of the on body housing 322”).

Because we do not find Petitioner’s additional arguments timely or persuasive, we conclude that Petitioner has not demonstrated a reasonable likelihood of success in demonstrating that claim 1 is unpatentable as obvious over the prior art cited in Ground 2 of the Petition.

3. Claims 5–7

Challenged claims 5–7 of the '335 patent all ultimately depend from claim 1, which is the sole independent claim.

Because Petitioner has failed to demonstrate a reasonable likelihood of success in demonstrating at trial that claim 1 is unpatentable on Ground 2,

Petitioner similarly fails to meet the same burden with respect to challenged dependent claims 5–7.

V. CONCLUSION

For the reasons we have explained, we conclude that Petitioner has failed to meet its burden of demonstrating a reasonable likelihood of prevailing in demonstrating that challenged claims 5–7 of the '335 patent are unpatentable under Grounds 1 or 2.

V. ORDER

In consideration of the foregoing, it is hereby:

ORDERED, pursuant to 35 U.S.C. § 314(a), that the Petition for *inter partes* review of the challenged claims of U.S. Patent 11,266,335 B2 is DENIED with respect to all grounds in the Petition; and

FURTHER ORDERED that no *inter partes* review is instituted.

IPR2024-00520
Patent 11,266,335 B2

For PETITIONER:

Andrew M. Mason
Alexa M. Johnston
Michael J. Loy
Todd M. Siegel
Derrick W. Toddy
John D. Vandenberg
KLARQUIST SPARKMAN, LLP
andrew.mason@klarquist.com
alexa.johnston@klarquist.com
michael.loy@klarquist.com
todd.siegel@klarquist.com
derrick.toddy@klarquist.com
john.vandenberg@klarquist.com

For PATENT OWNER:

Peter J. McAndrews
David Z. Petty
Michael J. Carrozza
MCANDREWS, HELD & MALLOY, LTD.
pmcandrews@mcandrews-ip.com
dpetty@mcandrews-ip.com
mcarrozza@mcandrews-ip.com