

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

AVANOS MEDICAL, INC.,
Petitioner,

v.
STRATUS MEDICAL, LLC,
Patent Owner.

Case IPR2024-01210 *and* IPR2014-01211
Patent 10,736,688

PETITIONER'S NOTICE RANKING PETITIONS

(in accordance with November 2019 Consolidated Trial Practice Guide)

In accordance with the November 2019 Consolidated Trial Practice Guide (TPG), Petitioner Avanos Medical, Inc. (Petitioner) submits this paper ranking the two petitions filed against U.S. Patent No. 10,736,688 (the '688 patent) in the order Petitioner wishes the Board to consider the merits, explaining the differences between the petitions, and explaining why the Board should exercise its discretion to institute both petitions.

Simply put, the '688 patent has seventy-four (74) claims. Petitioner is challenging all 74 claims, with each claim challenged in only one petition. Aside from the different claims in each, the petitions otherwise present generally similar Grounds based on the same basic combinations of references (with some differences based on the particular features recited in the claims).

While a “vast majority of cases” may not require multiple petitions by a petitioner, a “large number of claims” is a circumstance that the Trial Practice Guide indicates justifies two petitions. The Board should not exercise its discretion to deny either petition based on the parallel nature under 35 U.S.C. § 314(a). Further, to the extent the USPTO adopts the currently proposed rules for discretionary denial of “parallel petitions,” *see generally* 89 Fed. Reg. 28,693 (PTO-P-2023-0048, Apr. 19, 2024), the sheer multiplicity of claims in the patent meets the “good cause” standard under the proposed Rule 42.108(d).

Nevertheless, and in accord with the current Trial Practice Guide, Petitioner presents the following ranking of the petitions and identifies which claims are challenged in each one.

- **Petition One:** IPR2024-01210 (the 1210 IPR), challenges 22 claims:
 - independent claim 1 and its dependent claims 2-17 and 48-50; and
 - independent claim 51 and its (only) dependent claim 52
- **Petition Two:** IPR2024-01211 (the 1211 IPR) challenges 52 claims:
 - dependent claims 18-47, which all ultimately depend from claim 1;¹
 - independent claim 53 and its dependent claims 54-55; and
 - independent claim 56 and its dependent claims 57-74.

As identified above, each of the 74 claims is challenged by only one petition; the differences between the petitions is essentially the identity of claims challenged. Many of the 74 claims are themselves prolix. The claim language alone totals over 3,500 words; claim 1 alone is 352 words. Thus, there is good cause to

¹ While the 1211 IPR does not “challenge” claim 1, the grounds challenging claim 1’s dependent claims *include* the corresponding, identical arguments and evidence as the 1210 IPR for claim 1. The 1211 IPR thus specifies “where each element of” these claims—including elements of their base claim—are “found in the prior art ... relied upon.” *See* 37 C.F.R. § 42.104(b)(4).

consider the merits of both petitions, and the Board should not discretionarily deny these necessarily parallel petitions.

Respectfully submitted,

/Christopher B. Kelly/

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CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. §§ 42.6(e) and 42.105(a), the undersigned certifies that on July 26, 2024, a copy of the foregoing was served by FedEx Priority Overnight on the correspondence address of record indicated in the Patent Office's public Patent Center system for U.S. Patent No. 10,736,688:

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