

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Gator Bio, Inc.,
Petitioner,

v.

Sartorius BioAnalytical Instruments, Inc.,
Patent Owner.

Case IPR2023-00215
Patent 8,305,585

PATENT OWNER'S PRELIMINARY SUR-REPLY

available to conference attendees in June 2003 conference; or (ii) that attendees were free to disclose publicly what they learned at the conference. Petitioner should have anticipated that PO would raise this argument.

Third, Petitioner incorrectly states that PO relies on “an obviousness argument” to establish entitlement to the November 6, 2003 filing date of Application No. 60/518,068 (“’068 provisional”). PR at 4. To the contrary, PO pointed to specific disclosures that demonstrate that the ’068 provisional actually discloses the “removably attached” limitation. POPR at 29-30.

IV. Petitioner’s Grounds 1 and 2 Do Not Teach “an optical element removably attached to the tip of the optical fiber” and Patent Owner’s Preliminary Response Does Not Contradict Patent Owner’s ITC Arguments

Without basis and contrary to the clear language of the POPR, Petitioner asserts that PO “concedes (as it must) that Yang (Ground 1) and Sun (Ground 2) each teach a probe that is removably connected to the distal end of a Y-shaped optical fiber via a standard SMA connector.” PR at 1. PO made no such concession. Rather, PO repeatedly explained how neither of Petitioner’s Grounds disclose “an optical element removably attached to the tip of the optical fiber” as recited by the independent claims of the ’585 patent. POPR at 43-54. For example, PO made clear that a POSA reading Yang or Sun with Yu “would have understood that the optical element [was] not removably attached to the tip of the optical fiber.” POPR at 47, 51. PO also made clear that “Petitioner’s own

depiction of Yang” and Sun do “not even attempt to demonstrate removability.”

POPR at 50, 54. In other words, neither Yang, Sun, nor Yu disclose any removable mechanism relating to an optical element.

Petitioner misunderstands PO’s arguments with respect to claim element 1[B], which recites “an optical element removably attached to the tip of the optical fiber.” *See* Petition at 59. Specifically, Petitioner mistakenly interprets PO’s arguments as asserting that “the term ‘optical element’ [has] a negative limitation that would exclude an optical fiber.” PR at 1. However, PO does not assert that an optical fiber cannot be a component of an optical element, as that term is used in claim 1 of the ’585 patent. Rather, PO contends that Petitioner has not shown that the alleged prior art discloses claim 1 as a whole, including that the optical element be removably attached to the tip of the optical fiber.

To clarify, PO does not take the position that an optical fiber cannot be a component of an optical element. Rather, PO contends that Petitioner has not shown that the optical fiber of Yang or Sun constitutes an optical element in the context of claim 1 of the ’585 patent, which describes the optical element as including, for example, first and second reflecting surfaces separated by a minimum distance, wherein the first reflecting surface includes a layer of analyte binding molecules. Hence, PO further explained in its POPR that “[e]ven if the optical element could be composed of optical fiber,” neither Yang, Sun, nor Yu

disclose the “removably attached” limitation of claim element 1[B]. POPR at 49-50, 53-54. PO’s position is consistent with its assertions in the related ITC action.

V. IPRs Are Unconstitutional

As explained before, PO recognizes that the Federal Circuit has already ruled on the constitutional arguments made in the POPR. PO therefore is making the arguments for preservation purposes only, given that the Federal Circuit has—on occasion—required patent owners to present these constitutional arguments to the PTO first. Despite Petitioner’s recognition that the Board “lacks the authority to set aside controlling law or otherwise decide PO’s challenge to the constitutionality of IPRs” (PR at 7), Petitioner nevertheless faults PO for not repeating in detail all of the arguments raised in *Enzo*. PR at 7 n.3. Indeed, with no sense of irony, Petitioner states—in a footnote—that PO has forfeited these arguments. Such a contention, raised only in a footnote, is itself forfeited. *See, e.g., Google LLC v. Jenam Tech, LLC*, 2022 WL 16579487, at *3 (PTAB Nov. 1, 2022) (finding that “conclusory statements raised only in footnotes and not further developed [are] forfeited”).

VI. Conclusion

For the foregoing reasons, and for the reasons explained in the POPR, the petition for *inter partes* review should be denied.

Date: April 25, 2023

Respectfully Submitted,

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