

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

IMPERATIVE CARE, INC.,
Petitioner,

v.

INARI MEDICAL INC.,
Patent Owner.

IPR2025-00728 (Patent 11,844,921 B2)
IPR2025-00989 (Patent 11,865,291 B2)

Record of Oral Hearing
Held: July 23, 2026

Before JEFFREY N. FREDMAN, ERIC C. JESCHKE, and
TIMOTHY G. MAJORS, *Administrative Patent Judges*.

IPR2025-00728 (Patent 11,844,921 B2)
IPR2025-00989 (Patent 11,865,291 B2)

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P R O C E E D I N G S

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9:00 a.m.

JUDGE MAJORS: Good morning. This is Judge Majors, and in the panel is Judges Jeschke and Fredman as well. We're here for a final oral hearing in these two proceedings. Those proceedings are IPR2025-00728 and that relates to Patent number 11,844,921, and also IPR 2025-00989 and that concerns Patent number 11,865,291. Our parties are Imperative Care, Inc., as Petitioner, and Patent Owner is Inari Medical, Inc. Our court reporter is present. She will be preparing a transcript, which will be entered into the record when it is available.

Petitioner's counsel, would you identify who is present and who's going to be doing your presentation today?

MR. STOWELL: Hello, Your Honors. Joshua Stowell of Knobbe Martenson on behalf of the petitioner, Imperative Care. I will be doing the argument today. Joining me at counsel's tables is my colleague, Brian Barnes.

JUDGE MAJORS: Welcome. And counsel for Patent Owner, please identify who's present and who's going to be doing your presentation today.

MR. HAMILTON: Good morning, Your Honors. This is Joseph Hamilton for Patent Owner. I will be doing the argument. On the public line is a representative from Stryker Corporation, Merle Elliott, senior IP counsel at Stryker.

JUDGE MAJORS: Okay. Welcome, Mr. Hamilton and Mr. Elliott. All right. As --

1 Now, as set forth in our July 7, 2026 order, each side has 60 minutes
2 to present its argument in these cases. The panel is going to do our best to
3 keep track of time. You can see that there's a timer up there behind the
4 panel. I would, however, suggest that the parties try to be mindful
5 themselves of the time.

6 Petitioner, as you bear the burden of proof, you're going to be
7 presenting your arguments first. Would you like to reserve any time for
8 rebuttal?

9 MR. STOWELL: Yes, Your Honor. Petitioner would like to reserve
10 15 minutes for rebuttal.

11 JUDGE MAJORS: Perfect. As you can see, we have 45 minutes
12 there, it looks like, on the clock, so --

13 MR. STOWELL: Judge Fredman anticipated my request.

14 JUDGE MAJORS: He does that sometimes.

15 Counsel for Patent Owner, would you like to reserve any time for
16 rebuttal?

17 MR. HAMILTON: Yes, Your Honors. Fifteen minutes as well.
18 Thank you.

19 JUDGE MAJORS: Thank you.

20 All right. This hearing is open to the public and we have a public line
21 open. I don't believe there's any confidential evidence that's been submitted
22 in this case. The panel has access to the record, including the
23 demonstratives. As you make your presentation today, please try to identify
24 the demonstrative that you're speaking to by its page number and we'll try to
25 follow along. We don't expect, unless absolutely necessary, that there will
26 be any interruptions in the other party's presentation of their arguments.

1 And lastly, if there's any technical problem that comes up today in the
2 hearing room, for example, if you see that -- since I'm appearing remotely, if
3 you see that my video freezes up or some audio issue comes up, please let
4 our staff there in the room know, and we'll try to get that fixed as soon as we
5 can.

6 So with that, Petitioner, you have 45 minutes on the clock. You can
7 certainly go into your rebuttal time if you'd like. And you may begin when
8 ready.

9 MR. STOWELL: Well, thank you, Your Honor. And may it please
10 the board. Joshua Stowell on behalf of the petitioner. Petitioner has
11 provided demonstratives that I'll refer to during the oral argument. Those
12 have been marked as Exhibit 1050 in both of the IPRs.

13 I'm going to begin at Page 2 of the demonstratives. And my argument
14 today is going to focus on the issues that are still disputed in this case that
15 have not been previously resolved by the board. And there are only two
16 disputed issues that have not been previously resolved in the prior IPRs.
17 The first is whether Schaffer plus Hartley or Eller render obvious the second
18 filament limitation in dependent Claim 10 of the '921 patent. The second
19 issue relates to the '291 patent, and it's whether Schaffer plus Hartley or Eller
20 disclose or render obvious an actuator having at least a first member
21 movably coupled to the support.

22 So I'll focus my presentation today on those issues. If we jump ahead
23 to slide 12 in Petitioner's demonstratives, we do have a district court
24 decision that is relevant to the patent that's being discussed today, the '921
25 patent. Before the district court, Inari had asserted Claims 1 and 10 of the
26 '921 patent in its preliminary injunction motion. That motion was denied by

1 the Court. And in denying that motion, the Court found that Petitioner had
2 raised a substantial question of validity regarding Claims 1 and 10 of the
3 '921 patent. And specifically with respect to Claim 10 of the '921 patent, the
4 district court had found that Patent Owner's arguments for validity were not
5 persuasive. And the patent or in the -- court specifically focused on Schaffer
6 and its disclosure of multiple actuating members. So that's a backdrop that
7 we have here.

8 If we turn to slide 14, I'll begin with the '921 patent and the arguments
9 regarding Claim 10. And again, the issue is whether Schaffer plus Hartley
10 or Eller disclose or render obvious the second filament required by Claim
11 10. Schaffer and Hartley render this claim obvious in two ways that I'll
12 discuss. Turning to slide 15, before we get into the specific ways, it's
13 helpful to look at this particular IPR from a macroscopic level. The board
14 has already held that using a single filament to constrict a tubular member in
15 a hemostasis valve is obvious. The question we're wrestling with today is
16 whether using now two filaments is obvious. And the prior art that we've
17 relied on in this case makes clear that the selection of the number of
18 filaments to be used was part of the routine optimization of these types of
19 valves. Eller teaches us that skilled artisans will be able to select a suitable
20 number of wires to include in a selective fluid barrier valve device according
21 to the embodiments and other aspects of the valve. So the prior art is telling
22 us that the selection of the number of filaments was part of the routine
23 optimization of these valves and well within the skill of a person of skill in
24 the art.

25 Turning to slide 16, we have the Hartley reference and Hartley
26 describes a string. And the board has already found that a person of ordinary

1 skill in the art would've found it obvious to combine Hartley's string or
2 Eller's wire member with Schaffer's valve. Hartley's string --

3 JUDGE FREDMAN: Did we affirm that Eller's wire member is a
4 flexible filament?

5 MR. STOWELL: Yes, Your Honor. That has been found. And so
6 Hartley's string and Eller's wire member both contain a first filament and a
7 second filament. So on slide 16, we have Hartley's disclosure of a string.
8 On slide 17, we see that there's no dispute that Hartley's string includes
9 multiple threads. The plain and ordinary meaning of a string includes
10 multiple threads. And in its surreply, Patent Owner has acknowledged that
11 it's not disputing that a single string will typically have multiple threads, and
12 a single wire member will include two or more strands.

13 JUDGE FREDMAN: Okay. That seems like an unreasonable
14 interpretation on your part to me. Right. Essentially, we're saying a
15 filament and the intent of the filament is to constrict the valve so that we can
16 close it. You're trying to read that single filament as multiple threads. And
17 sure, I suppose lots of ropes have multiple threads, but when you're thinking
18 about a filament to constrict something, you're not thinking about the
19 composition of the filament as being the multiple. So thinking about the
20 filament as being an item itself without so many -- not the components of the
21 filament.

22 MR. STOWELL: Well, I -- let's look at what the patent says about
23 that, because there is no requirement for separateness in the claims, which I
24 think is what you're getting at, right? If I have a first finger and a second
25 finger, if we just apply plain and ordinary meaning, if I cross those, I still
26 have a first finger and a second finger. So the plain and ordinary meaning --

1 JUDGE FREDMAN: But if you said the finger, not the fingers,
2 separate plural from the singular, right, you would be saying a single one,
3 right? That would be the understanding, I think, of an ordinary person. If I
4 held two fingers up, as you just did, and I said -- and you didn't cross them, I
5 said, I have the fingers are raised. I wouldn't say the finger is raised. I
6 mean, I would -- besides the inappropriateness, well, that's, you know, five
7 fingers. It's just -- it's not what a person would say or understand by the --
8 grammatically.

9 MR. STOWELL: Right. You've proven my point. I have a first
10 filament and I have a second filament. And if I cross them, I still have a first
11 filament and a second filament.

12 JUDGE FREDMAN: But doesn't the claim say the filament?

13 MR. STOWELL: Well, what the claim says is -- let me see if I have it
14 here. The claim says, "A valve wherein the actuator is the first actuator."
15 This is Claim 10. "Wherein the filament is a first filament." And then later
16 on, it says, "A second actuator coupled to the elongated member via a
17 second filament." So it says, the filament is a first filament. And then we
18 also have a second filament. And so --

19 JUDGE MAJORS: Mr. -- Mr. -- Mr. Stowell, let me interrupt you for
20 a moment.

21 MR. STOWELL: Sure.

22 JUDGE MAJORS: From my perspective, I think the bigger problem I
23 have with, I'll call it Petitioner's first theory on satisfaction of Claim 10, is
24 the language on Column 9. I'm sure you're familiar with it. In some
25 embodiments, that filament can comprise a single strand, et cetera, et cetera.
26 Or the filament can comprise a plurality of strands that can be twisted, et

1 cetera, et cetera. So it seems to me what that's telling us is that the filament
2 can have one strand, a monofilament. It can have multiple strands that are
3 twisted together, such as I understand in theory, forms the string apparently,
4 but it's still described here as the filament. It's not described as being a first
5 filament and a second filament. So maybe you could speak to that.

6 MR. STOWELL: Yeah. And why don't we go to slide 25 in Patent
7 Owner's materials? Because there, we have a description or we have that
8 portion that you're referring to from Column 9. And so we see there that it
9 says, "The filament can be nylon, stainless steel." And it goes on. "The
10 filament can comprise a single strand." So a single strand can be a filament,
11 such as, for example, a monofilament. So a monofilament by itself is just an
12 example. If Patent Owner's arguments were correct, that the only two things
13 that can be a filament are a monofilament, a filament by itself, or a bundle,
14 then we would not have, for example, in this sentence. The patent tells us
15 that the filament can comprise a single strand. It can also comprise, for
16 example, a plurality of strands. And then it goes on. The filament can
17 comprise one or several threads, lines, cords. One is enough.

18 And so in order for Patent Owner's argument to be correct, you would
19 need to rewrite the specification to eliminate that part about the
20 monofilament being merely exemplary. And you would have to add a
21 disclaimer to every time that the patent says, can comprise a single strand or
22 can comprise one thread. You would need to add a disclaimer that says,
23 except when that one thread is part of a larger bundle, in which case it's no
24 longer a filament.

25 JUDGE FREDMAN: I think -- isn't that -- isn't the ordinary reading
26 to an ordinary artisan here that the filament can comprise a single strand or it

1 can comprise one or more, or one or several threads, lines, cords, et cetera?
2 And consequently, the ordinary artisan would understand that to mean that
3 the filament can be composed of multiple threads, but those are not filaments
4 themselves. Because you're trying to read the subcomponents as the major
5 you're trying to read that into it. And there's no reason to read that into this
6 claim, right? You're trying to read into the claim when it isn't actually there.
7 What the spec really disclaimed, doesn't talk about it. The spec says, yeah,
8 you can have a -- if I said the rope, right, again, or the cord, right, I don't
9 mean -- the fact that the cord can comprise multiple subportions doesn't
10 mean those subportions are actually ropes themselves, right?

11 The fact that a cord can comprise multiple threads to make up a cord,
12 doesn't mean that the multiple cords is the same thing as multiple threads. I
13 don't think that that's a fair reading. I don't think that's what a person would
14 understand.

15 MR. STOWELL: Well, you know, I think you could argue that I am
16 importing a disclaimer, but there -- that's not true that -- the claims or the
17 specification says what it says. And here we have a patent owner that was
18 trying to describe filament as broadly as possible to encompass as much as
19 possible. And what we see is that it describes, okay, so one strand can be
20 your filament. Or if you want to refer to the bundle as a filament, that could
21 be a filament as well. It's trying to cover the waterfront.

22 JUDGE FREDMAN: Does it ever say a strand composed of multiple
23 filaments? Is there any teaching expressly in there that there's a single
24 filament composed of other filaments?

1 MR. STOWELL: Right. There's no express teaching that says a
2 single filament within a larger bundle of filaments qualify -- is a filament --
3 remains a filament.

4 JUDGE FREDMAN: Right. So essentially, what they're simply
5 defining a filament as composed -- as a thing, and it can be composed of
6 other things and those things are not themselves filaments.

7 MR. STOWELL: Yeah. I guess, I should take that back a little bit on
8 my description too, to your point. There is a portion of the specification that
9 specifically says a filament can comprise multiple filaments.

10 JUDGE FREDMAN: Where is that?

11 MR. STOWELL: That's at -- my colleague, Mr. Barnes, will find it. I
12 think we may have it somewhere in our slides, but Mr. Barnes will find that.
13 But that is an express disclosure in the patent.

14 JUDGE FREDMAN: Okay.

15 MR. STOWELL: And we can see the problem with Patent Owner's
16 argument. If we turn to slide 22 of Patent Owner's -- of Petitioner's
17 demonstratives, right? Patent Owner is trying to import this separate
18 limitation into the claims.

19 JUDGE FREDMAN: Yeah. I found it. Judge Majors had marked it.

20 MR. STOWELL: And so --

21 JUDGE FREDMAN: On Column 5, Lines 54 to 57.

22 MR. STOWELL: Right. And so there we do have a disclosure that a
23 filament can be comprised of multiple filaments.

24 JUDGE MAJORS: Doesn't -- Mr. Stowell, isn't that getting to --
25 when we start to look at the figures 6 through 9, we have Figure 6 as the --
26 I'll just call it a single filament. And then we have the Figures 7 through 9,

1 which describe multiple, if you will, distinct threads, I'll just call it, for
2 simplicity's sake, that are cooperating in some way. And then that collective
3 arrangement is being described as the filament. But I -- I'm still struggling
4 with the idea that any one of those things, if it is comprised of multiple
5 strands that happen to be fused or twisted together, would be understood by
6 the skilled artisan as itself being a first filament and a second filament.

7 And at the risk of carrying on for just one more moment, I'll grant you
8 it's a little bit odd because one could envision you take a single string. Let's
9 just say it was comprised of two threads, sub-threads. You pulled them
10 apart, you deaggregated them, and then you used them separately. I could
11 understand, okay, well, that might be a first and second filament according
12 to the claim. But it seems to me, when I read this patent, they're saying
13 when you stick them together in one cohesive structure, that's one thing. It's
14 not two things.

15 JUDGE FREDMAN: And if I can just add one thing to that, I'm
16 looking at the -- Schaffer is the only person, I think, that uses the term
17 multiple filaments, which refers to Figures 7 through 9. Looking at Figures
18 7, 8, and 9, in each of those cases, the separate filaments are not formed
19 together into a single filament. They're simply used together, right, to close
20 the valves together. They're not actually integrated into a single filament,
21 right? So in fact, even in the one place where you're -- that you could point
22 to where they do refer to multiple filaments, it doesn't actually integrate
23 them into a single strand. It simply uses them as separate strands as separate
24 filaments. They're not actually integrated.

25 MR. STOWELL: Well, and you have pointed to the exemplary
26 embodiments in the patent. So in order to -- what Patent Owner is doing,

1 and I think what the board is articulating is that in order to introduce this
2 separate requirement into the claims, right, that the first and second
3 filaments somehow need to be some degree of separated or not integrated,
4 you would need to import limitations from the preferred embodiment. And
5 you would need to ignore the express text of the patent, which says multiple
6 -- a filament can be made of multiple filaments.

7 JUDGE FREDMAN: That -- that's an exemplary one. So in fact,
8 that's not really -- the spec doesn't really say that. The spec says that a
9 filament can be made of multiple threads, cords, whatever. It doesn't say
10 multiple filaments except at Column 12. And there, it's particularly focusing
11 on Figure 7 through 9, which show multiple filaments, but they're not
12 integrated into a single filament quite clearly, I think.

13 MR. STOWELL: Right. And it makes it clear that that's exemplary,
14 right? It says, "In some embodiments, the filament can comprise multiple" -
15 -

16 JUDGE FREDMAN: So that's the only place where it says it can
17 comprise multiple filaments. It doesn't say that anywhere else, right; is that
18 true?

19 MR. STOWELL: Well, the -- yeah. The other disclosure is that a
20 strand can be a filament or a thread can be a filament.

21 One thread.

22 JUDGE FREDMAN: I don't think it says it's either.

23 MR. STOWELL: One thread. Okay. Well, I think where we're
24 headed on this argument is that -- and our position is very clear that in order
25 to introduce this separate requirement that is not in the claim, separate is not

1 used in the patent, no prosecution history, no disclaimer, and no
2 lexicography has been argued.

3 JUDGE FREDMAN: Sure.

4 MR. STOWELL: You would have to improperly import or invent a
5 disclaimer or import a limitation from the preferred embodiment. So there
6 would be an error as a matter of law on claim construction. Now, if we go to
7 -- there's a second reason that the combination of Hartley and Eller with
8 Schaffer render the claims invalid. And that argument starts -- we'll start
9 that argument on slide 27. We have a determination by the board already
10 that Schaffer, which is pictured on slide 27, has rigid U-shaped actuating
11 members. And Petitioner has been consistent throughout all the IPRs that a
12 person of ordinary skill in the art would've found it obvious to modify the
13 material, to use a different material for those actuating members that is
14 flexible, such as the string in Hartley, or the wire member in Eller.

15 Schaffer itself recognizes that different materials can be used for the
16 actuating members. It specifically talks about metals or plastics. If we turn
17 to slide 28, Hartley also recognizes multiple materials could be used for the
18 flexible member that it discloses. It could be a string, a suture, a band, or
19 other suitable material. If we look at slide 29, we also see that Eller
20 discloses that its members, wire members, could be made of suitable
21 materials, including flexible materials. So there's no dispute that selecting
22 the material for the actuating member or the filament in the device was
23 within a person of ordinary skill and the art of skill.

24 And if we turn to slide 30, Petitioner has identified a whole range of
25 motivations to combine or to alter, change, modify the U-shaped actuating
26 members with a flexible member, a string, or wire member. And the list is

1 numerous, and none of these have been disputed by Patent Owner. Hartley
2 and Eller suggests that a string or wire member may constrict the tube. They
3 have the durability, the strength to do that. Hartley and Eller specifically
4 disclosed that these flexible materials can close around different shaped
5 instruments. There's a finite number of predictable materials. Nobody has
6 argued that strings or wire members are not predictable. And there's a
7 substitution of one known element, a string or wire member, or the rigid
8 plastic, and metal members.

9 JUDGE FREDMAN: When you substitute, though, would you
10 substitute the way that Schaffer does or would you substitute the way that
11 the other prior art? In other words, in Schaffer, I think it's pulling the sort of
12 two strands that we're pulling apart from each other to close the valve. In
13 another reference, the string is sort of being pulled tightened -- tautened. I
14 don't know if that's the right word. It's pulled taut, yeah, to close the valve.
15 Those aren't quite the same. They're not operating in the same way, right?
16 So is your argument that you would have two strings that would pull taut, or
17 that somehow you would have Schaffer strings together separately pulling
18 until they would pull it closed?

19 MR. STOWELL: Yeah. In this IPR, our argument is that you would
20 just replace each U-shaped member and Schaffer with a different material, a
21 string or a wire member.

22 JUDGE FREDMAN: Okay. So you're arguing that that's all you're
23 doing. So you're not arguing that you put two strings in as in the Eller?

24 MR. STOWELL: Correct. That's not the argument in this IPR.

25 JUDGE MAJORS: That theory comes up in a later case, right?

26 MR. STOWELL: It does.

1 JUDGE MAJORS: Where you kind of -- I suppose you'd say
2 duplicate or replicate the arrangement that's been cited in the demonstrative
3 in many of the cases already, where you got one string, it's got respective
4 ends attached to the opposite buttons, and then you duplicate that. So just to
5 be clear, that -- that's not the theory that's being advanced here in this case.
6 You're saying you have one string that's just, kind of, literally replacing in
7 more of a U-shaped fashion, the Schaffer actuator buttons?

8 MR. STOWELL: Correct. That's the argument in this case.

9 JUDGE MAJORS: Actuators. I'm sorry. Not buttons.

10 MR. STOWELL: Correct. That's the argument in this case.

11 JUDGE FREDMAN: So can you -- is there expert testimony or
12 something that explains that this would work or that -- can you point to that
13 for me?

14 MR. STOWELL: Yeah, there is. So on Paragraph 79 of Mr.
15 Thornton's declaration, it's Exhibit 1003. He explains, "A person of ordinary
16 skill in the art would've understood that Schaffer's U-shaped actuating
17 members would've preferably been formed from a thin flexible material.
18 Such a material would've permitted the actuating members to conform as
19 much as possible to the outer surface of the seal module and tool inserted
20 through the valve. For example, not all tools inserted through the valve
21 would have a circular profile. In those cases, U-shaped actuating members
22 having some flexibility would better seal around the irregular shapes." And
23 Patent Owner, in its surreply, raised a new argument for the first time that
24 Petitioner has somehow been inconsistent in its arguments or that it's made
25 contradictory arguments. That is not true. Petitioner has been consistent
26 throughout this case that there are multiple obvious ways to improve

1 Schaffer's valve, and that those obvious improvements would've been
2 obvious to a person's skill in the art at the relevant time period.

3 And we have a continuum. On one end of the continuum, we have
4 Schaffer with its rigid U-shaped members. Mr. Thornton has been on record
5 throughout every IPR that U-shaped rigid members is the least desirable
6 structure. The U-shaped members, if they're rigid, they cannot adapt to the
7 tool being inserted. So that's at one end. In the middle of the spectrum, we
8 have flexible U-shaped members. And I just read the portion of Mr.
9 Thornton's declaration where he explains why flexible is better than rigid.
10 And Patent Owner hasn't really disputed that flexible is better than rigid.
11 Patent Owner has said, "Well, flexible wouldn't be necessary because
12 Schaffer's valve works perfectly." And the Court has already rejected that
13 argument. But there's no dispute that flexible would be better than a rigid U-
14 shaped member. And then at the other end of the spectrum, we have a
15 flexible filament that encircles the central tubular member.

16 And that's the best option because that will capture the most tools
17 inserted through the device. It's not that the middle option, flexible U-
18 shaped members, is not suitable. It's just not the optimal solution. And one
19 mistake that we've seen Patent Owner make repeatedly throughout these
20 IPRs is to argue or start with the premise that the obvious solution is
21 singular, there's only one obvious solution and that it must be the best
22 option. And the Court has repeatedly --

23 JUDGE MAJORS: So Mr. -- Mr. Stowell, if I can interrupt you for a
24 moment. So the argument as it goes from Patent Owner is, if they pick up
25 on Petitioner's theory, where you're replacing the two strings for the two
26 actuating members is that you're still going to get some gap formation and

1 some leakage. You're not disputing that Petitioner has argued that in other
2 cases, right?

3 MR. STOWELL: Correct. And that's why that is the middle option,
4 because what Petitioner -- and Petitioner has been very specific. It's not that
5 flexible U-shaped actuator -- actuating members don't work or aren't
6 suitable. In very specific circumstances where the diameter of the tool that's
7 inserted through the valve is smaller than the distance between the ends of
8 the U-shaped actuating members, you still may get leakage. And that's why
9 the -- it would be obvious also to have a thread or a filament that encircles
10 the tubular member, because that's an additional improvement to this very
11 simple mechanical structure.

12 JUDGE MAJORS: Isn't it a problem for Petitioner that when Mr.
13 Thornton was asked about this a week or so after his declaration, he had no
14 recollection of opining on the substitution of two strings?

15 MR. STOWELL: No, that's not a problem because he was being
16 deposed in the 011 patent IPR, and he was being asked about his declaration
17 in that case. And he was 100 percent correct that he did not opine on two
18 strings in the 011 patent IPR. The only opinions in that IPR are related to
19 one string that encircles the tubular member. So there was no inconsistency
20 in that testimony. What we've seen Patent Owner try to do is try to piece
21 together deposition clips from different depositions focused on different
22 declarations and try to act as if, oh, Mr. Thornton made these admissions in
23 this IPR. But as Patent Owner has conceded, that was a deposition regarding
24 an entirely different IPR, an entirely different declaration.

25 If we turn to slide 31 with respect to the two strings, again, the
26 motivations to combine that have been raised by the petitioner have not been

1 disputed. Patent Owner's only argument for why a person of skill in the art
2 would not have been motivated to modify Schaffer's rigid U-shaped
3 members with a more flexible member is that -- it's on Page 31 -- that the
4 wire members might interfere, that they might move underneath the other,
5 and that they could increase cost and complexity. Now, this is the sum total
6 of the opinion. If you look at Mr. Zalesky's declaration, there's no more
7 support there. He just writes the exact same words that are in the patent
8 owner's response. There's no explanation for why this might cause a
9 problem, this alleged interference. And we should be particularly skeptical
10 of this argument because if we go to slide 32, the '921 patent describes,
11 allegedly, flexible U-shaped actuating members, which actually do overlap
12 with each other. They interlock. They cross each other. They could
13 interfere with each other. And yet there's no description in the patent of how
14 to solve that alleged problem. And so Patent Owner is trying to distinguish
15 the prior art based on issues it never raised in its own patent.

16 Additionally, if we turn to slide --

17 JUDGE MAJORS: And so --

18 MR. STOWELL: Yeah.

19 JUDGE MAJORS: -- did Mr. Thornton offer any rebuttal testimony
20 specific to the downsides to this two-string arrangement as Dr. Zalesky sees
21 them?

22 MR. STOWELL: Dr. -- Mr. Thornton did not offer a rebuttal
23 specifically to this interference other than to point to the disclosures in his
24 opening report in Eller and in Schaffer, which describe using multiple
25 strings and that there's no friction or overlapping or any concern identified in
26 those references for having multiple strings. If we go, for example, to slide

1 33, Eller expressly describes using multiple filaments. Those filaments
2 cross each other, they have the potential to interfere. And yet Eller doesn't
3 identify any problems with that or any reason that that would discourage a
4 person skilled in the art. There's simply no hook, no basis for this concern
5 that this interference would so overwhelm the advantages of a flexible
6 element.

7 And, you know, this board has made clear in its prior decisions that
8 obviousness is not limited to the best or simple solution. The board cited the
9 Intel's decision. That's correct. The board has cited In re Mouttet, stating
10 that combinations that may be inferior for certain purposes may still be
11 obvious. That's correct. The board has also cited In re Fulton. Our case law
12 does not require that a particular combination must be the preferred or the
13 most desirable combination described in the prior art in order to provide a
14 motivation for the current invention.

15 And so there are two bases why Schaffer plus Hartley or Eller render
16 the claims obvious. One is that a person of skill in the art would've
17 understood that Schaffer's string or the wire members include a first and
18 second filament. And also that a person of skill would've found it obvious to
19 replace the rigid U-shaped actuating members with a flexible string or a
20 flexible wire member.

21 We'll now transition to --

22 JUDGE MAJORS: Mr. -- Mr. Stowell, if I could interrupt you one
23 more time.

24 MR. STOWELL: Sure.

25 JUDGE MAJORS: Before we move off of this patent, and I'm going
26 to ask a similar question to Patent Owner, somewhat more of a housekeeping

1 point. But as I think everyone does, we have multiple final written decisions
2 that have already been entered in these cases. And I'm not trying to
3 pigeonhole the parties or suggest that there's any waiver. I just would like to
4 know for this particular patent and for the next one that we're going to talk
5 about, is there some other aspect that -- of the areas that you're not arguing
6 about today where the record is different, where you think the board -- the
7 board's decision from the finals should be different, even though you might
8 disagree with it? Perhaps that's not as clear. I'm just trying to get a sense of
9 is there's some other nuance here beyond what you're talking about today in
10 these cases that you feel the board needs to sort of reassess?

11 MR. STOWELL: I don't think there's anything that's directly
12 inconsistent. There are some statements by the board when it responds to
13 the obviousness based on Schaffer alone of replacing Schaffer's rigid U-
14 shaped actuating members with flexible members. That is not the
15 combination that's being asserted in this case for that -- for the substitution
16 of Schaffer's U-shaped -- rigid U-shaped actuating members. Schaffer is --
17 or in this case, Petitioner is relying on Schaffer plus Hartley or plus Eller.
18 So it's not a one-to-one comparison. And so that is an issue.

19 I can see the judges smiling so you probably thought of that issue
20 earlier. So I don't think there's going to be any inconsistency necessarily if
21 the board here finds that Schaffer plus Hartley or Eller render the claims
22 obvious because a person of skill in the art would've found a substitution of
23 a flexible member for a rigid member obvious. Okay. So --

24 JUDGE MAJORS: Right. And I guess maybe more directly, you
25 know, so let's take our prior finding of Schaffer discloses rigid actuating

1 members. I know you disagree with that, but is there any difference in the
2 record here that would require the board to revisit that issue?

3 MR. STOWELL: No. I don't believe there's a difference in the record
4 regarding whether Schaffer itself discloses rigid actuating members. As you
5 say, we presented evidence. We don't think that's correct, but we recognize
6 that the board has already ruled on that issue and absent some other finding
7 by the board or by an appellate court, that -- that's the law of this case.

8 JUDGE MAJORS: Got it. And just to cut to the chase, I -- you
9 probably see where I'm going, I just I'm trying to get the board to zero in, in
10 these cases, on the issues that are different rather than rehashing and
11 retreading old ground that's already decided that absent some change in
12 material argument or material evidence that would cause us to go back and
13 say, oh, well, now we need to consider this anew. I'm not sure we would do
14 that. So that's really what I'm getting at. And sorry to ask it in such a
15 roundabout way.

16 MR. STOWELL: No. I appreciate that. And that's something
17 obviously we thought about and looked at closely. And here the arguments
18 are different because the ground that's been asserted is Schaffer plus Hartley
19 or Eller, not Schaffer alone.

20 Well, thank you for that, Judge Majors. I -- I'll transition now to the
21 '291 patent and the argument regarding the first member movably coupled to
22 the support. Schaffer discloses this limitation and we'll work through why
23 that is. If we turn to slide 36, there's no dispute that Schaffer discloses a
24 support. Schaffer has a housing. We've identified that as the support, and
25 there's been no dispute that that is the case. So Schaffer has a support.

1 On slide 37, we then see the descriptions of how the button is joined
2 or coupled to the support. The button is inserted into the opening within the
3 support. It is coupled to a spring. It is also coupled to a U-shaped actuating
4 member, which wraps around the seal module. The housing has flanges that
5 prevent the button from impacting or sliding too far inward and crushing the
6 seal module. The patent explains that the actuators are configured
7 cylindrically to slide along the cylindrical interior wall of the housing from a
8 first position to a second position. And there's no dispute in this case that
9 the buttons cannot be uncoupled from the housing, right? You can't take the
10 buttons out unless you break the whole device. So there's no dispute that the
11 actuator buttons can't be uncoupled.

12 JUDGE FREDMAN: So possibly to anticipate Patent Owner's
13 argument, it says coupled to the support. It doesn't want to say coupled to
14 the housing, right? What does coupled here mean?

15 MR. STOWELL: Yeah, that's a good question. And so just to be
16 clear, coupled -- the housing is the support in this patent. There's no dispute
17 about that. So coupled to the support or the housing, right? And -- so what
18 does coupled mean in this patent? That's a good question. We believe
19 coupled should have its plain and ordinary meaning. Coupled can mean
20 directly or indirectly coupled. If we go to slide 40, we have submitted in our
21 briefing a number -- we've highlighted a number of Federal Circuit cases
22 where the Federal Circuit has found that the plain and ordinary meaning of
23 coupled means coupled directly or indirectly.

24 And if we look at the '291 patent specification that appears on slide
25 40, the patent uses the term coupled in that same way. It says, "The
26 reinforcement structure, 320, can be coupled to the elongate member via one

1 or several other components of the valve." So it's using coupled in this case
2 to refer to either direct coupling or indirect coupling.

3 JUDGE JESCHKE: But doesn't it require some sort of operational
4 connectivity, right? Because I mean, you're kind of defining coupling by
5 just -- with using the word itself. So I -- I'm trying to understand what
6 coupling means in that second part where it says, "To mean direct or indirect
7 coupling." It requires still some, I assume, operational connectivity so that,
8 you know, a functionality of the first in the chain impacts the end. Is that
9 correct or no?

10 MR. STOWELL: Well, I think neither party has offered an express
11 definition for coupled. So I'm trying to be true to the record.

12 JUDGE JESCHKE: No, I understand.

13 MR. STOWELL: But if something isn't coupled, then it has to be
14 uncoupled. And none of us would argue that the button is not -- is movably
15 uncoupled from the housing, right? The button slides within the housing.
16 And it does that because it's not only confined or restrained by the circular
17 opening in the housing that it's positioned within, right, it can't kind of
18 wiggle around, but it's also confined because it's attached to the housing
19 through the U-shaped actuating member, which is attached to the seal
20 module, which is attached to the housing. It's carried by the housing, as
21 we've made clear in other parts of --

22 JUDGE FREDMAN: I guess I'm trying to distinguish between two
23 sorts of couplings. And I'm going to use two examples that I think are
24 reasonably close. One would be, like, a syringe in its body. But the syringe
25 is, you might say, coupled, you might not. But it can be pulled out where
26 you can take the plunger of the syringe and hold it separately from the

1 syringe body. So they're coupled, but they're not coupled in a way that it's
2 not removable.

3 Anyway, think about, like, an umbrella that, you know, the
4 telescoping portion, right in the middle or at the end even, that it's coupled,
5 right? The telescope couples into you could open and close it, but that it
6 isn't removable, right? I think what Patent Owner might be saying, and
7 maybe I don't -- they don't need to agree with this, is that for a coupled, it
8 has to be more like the umbrella situation than the syringe situation. So if
9 you speak to that a little bit maybe.

10 MR. STOWELL: Well, sure. If using those analogies, this is like the
11 umbrella situation. The button cannot be uncoupled, right? Like the
12 syringe. It can't be pulled out of the device. You have to break --

13 JUDGE FREDMAN: So we're actually pulling it out of -- because --
14 but is it just the fact that it's attached to the spring or is it actually coupled to
15 the housing directly?

16 MR. STOWELL: It's because it's coupled -- well, it's --

17 JUDGE FREDMAN: Which would be indirectly coupled. You
18 would argue to the housing, but it's not directly coupled to the housing, I
19 believe you're saying?

20 MR. STOWELL: Well, it is directly coupled to the housing in that it's
21 slid within the opening of the housing. Just as in your example, the syringe
22 is coupled to -- the plunger is coupled to the syringe body because it's slid
23 within the housing of the syringe body. Now, it's also coupled to the
24 housing indirectly through the U-shaped actuating members, the seal
25 module, which is attached to the housing. So there it -- it's coupled. It's not

1 uncoupled from the housing. And so I think under both of your examples, it
2 meets the definition. And what --

3 JUDGE MAJORS: Mr. Stowell, I -- and I'm forecasting a question
4 for Patent Owner, but I was a little confused initially by their arguments
5 because it seemed as though Patent Owner was initially saying that indirect
6 coupling was not encompassed by the claim. But then they came back in
7 surreply and they said, well, no, indirect coupling is encompassed. But they
8 -- the caveat seemed, in their view, to be, it has to -- it can only be one
9 intervening component that can do the coupling. And I -- I'm struggling to
10 see why that would be a supportable interpretation of the claim.

11 MR. STOWELL: I'll be honest. We struggled with following the
12 argument as well a little bit. But with respect to that indirect coupling
13 argument, I think the portion of the '291 patent specification that we have on
14 slide 40 really kind of puts the dagger in that argument that if you only have
15 one intervening structure, you're not coupled. The patent makes clear that
16 devices can be coupled via one or several other components. So it's using
17 the term coupled to refer to an indirect coupling through several
18 components. And so coupled is being used consistent with the plain and
19 ordinary, meaning that the Federal Circuit has found in the other cases that
20 coupling means a direct coupling or it means an indirect coupling.

21 When we look at Patent Owners' arguments, which we have on slide
22 39, what Patent Owner is really trying to do here is they're trying to import
23 the retention features into the claim. They're saying, well, the retention
24 features, they can retain the actuator and/or they can couple the actuator to
25 the housing. But the retention features are not claimed and are optional. If
26 we turn to slide 41, we see that it says, "The housing can further include one

1 or several retention features." Can further include. The one or several
2 retention features, "Can engage with and retain all or portions of the
3 constricting mechanism. The one or several retention features can retain the
4 actuator and/or can couple the actuator to the housing."

5 So because the retention features are not claimed, they're not part, and
6 because they're optional, they're not a requirement of the claim. So movably
7 coupled cannot mean retention -- has retention features. That can't be what
8 the meaning of movably coupled means. And as we've shown, movably
9 coupled can't mean there must be some sort of direct connection necessarily,
10 because that is not consistent with the plain and ordinary meaning of the
11 term. And there's no other lexicography in the patent that Patent Owner
12 could rely on to further narrow the term beyond its plain and ordinary
13 meaning. In fact, the term movably coupled doesn't appear in the patent
14 specification, that phrase.

15 And so we're left with the situation where the buttons can't be
16 uncoupled from the housing. The buttons move within the housing. They
17 are inserted into an opening in the housing and they are coupled to the
18 housing by that insertion into an opening and also by the spring actuating
19 members and seal module. And so because the patent uses coupled to mean
20 direct and indirect coupling, Schaffer discloses this limitation. At this point,
21 unless there are any questions, I'll reserve the remainder of my time for
22 rebuttal.

23 MR. HAMILTON: Good morning, Your Honor. If I could just have
24 a moment to get set up.

25 JUDGE FREDMAN: Sure.

26 MR. HAMILTON: All right. I'm ready anytime you're ready.

1 JUDGE FREDMAN: I'm ready.

2 MR. HAMILTON: All right. Great. So I'm just going to hit the same
3 two points that Petitioner hit. I just want to give you kind of a little bit of a
4 lay of the land on the different grounds and why this matters. So I have up
5 slide 2. This is for the '921 patent. There's five grounds. There are several
6 claims that aren't challenged. And then for Ground 5, the combination of
7 Hartley and Eller, there are additional claims that are challenged. Patent --
8 excuse me. The petition lists that Claim 10 is challenged, that's the claim
9 with the two filaments, there's no substantive argument that's noted in the
10 institution decision. So Ground 5 does not actually challenge Claim 10.
11 That's the claim I'm going to focus on with respect to the '921 patent.

12 Grounds 1 and 2, Schaffer anticipation or obviousness. Patent Owner
13 agrees with the institution decision that Schaffer doesn't anticipate or obviate
14 the claims for the reasons set forth therein. And then I'm going to focus on
15 Grounds 3 and 4 with respect to the first filament and the second filament.
16 And then for the '291 patent, again, there are claims -- now I'm on slide 3.
17 Claims 9 through 11 and 20 are not challenged in the petition. Grounds 1
18 and 2, Schaffer alone, institution decision found that Petitioner hadn't met its
19 burden there. Patent Owner agrees. I'm not going to argue that here.

20 Grounds -- ground 5 is essentially the same. It cites Garrison for an
21 additional limitation in Claim 18. There are separate arguments made with
22 respect to Garrison. I'm not going to argue those here, but Patent Owner still
23 asserts those. And I'm going to focus on Grounds 3 and 4 and Grounds 6
24 and 7. And specifically the issue with respect to two filaments in those
25 grounds. Garrison doesn't -- isn't cited for affecting that issue in any way.

1 So it's really about the combination with Schaffer and Hartley or Schaffer
2 with -- and Eller.

3 And since we ended on the '291, I'm going to start with the '291 here.
4 So as explained in the patent owner response, that's Paper 15 at 36 through
5 39, Petitioner has failed to meet its burden to demonstrate obviousness for
6 any claim, because the proposed combination of Schaffer with Hartley or
7 Eller or Garrison fails to disclose the limitation of first member movably
8 coupled to the support. The sole argument by Petitioner in the petition is
9 that actually, in petition and reply is that Schaffer alone discloses that
10 limitation. Petitioner makes no argument that any other reference discloses
11 the limitation or that it would be obvious to modify Schaffer to include the
12 limitation. But I'll drill down on this in a minute.

13 What Petitioner argues is the rigid U-shaped members of Schaffer
14 hold the buttons in place. Petitioner's proposed combination eliminates
15 those rigid U-shaped members. They're pointing to the feature that they say
16 would not be retained in the proposed combination. That cannot render --
17 disclose that limitation in Schaffer. It's actually eliminated from the
18 proposed combination.

19 JUDGE FREDMAN: You're arguing that they would replace the -- as
20 I understand it, and you can correct me if you think I'm wrong. They're
21 arguing they would replace the rigid U-shaped members with the flexible
22 member, correct?

23 MR. HAMILTON: That is correct.

24 JUDGE FREDMAN: So would the flexible member then not have at
25 least some ability to then hold indirectly, not directly, the button inside the
26 unit by itself?

1 MR. HAMILTON: So -- and specifically, the proposed combination
2 is a single stringer wire from one button wrapped around the lumen to a
3 second button. That's the proposed combination.

4 JUDGE FREDMAN: They're not holding each other (inaudible).

5 MR. HAMILTON: And if you look at the claim, the claim requires
6 two things specifically. One, a filament formed in a loop around the tubular
7 side wall that extends to the member. So that aspect is expressly set forth in
8 the claim. The claim also requires that the first member is movably coupled
9 to the support. And there's a very important reason why the claim has both
10 those limitations. They mean different things. And I'll just point out while I
11 have the claim up here, we're on slide 9. Movably coupled. The claim also
12 says a lumen is carried by the support. So movably coupled has some other,
13 meaning they're just simply contacting or being carried by the support.
14 Now, there's the there's a very important reason why the claim has those two
15 limitations separately. And I'm going to go to slide 11. If you look at Figure
16 two on slide 11, you can see with a filament that if one button is depressed,
17 the filament loosens, and the other button would simply fall out of the valve,
18 unless there is some other feature that movably couples the button to the
19 housing of the valve.

20 And that's why, going back to Claim 11, there are two separate
21 limitations. One is the filament wrapped around the lumen. And then
22 additionally, the claim requires a first member movably coupled to the
23 support. So the filament itself cannot movably couple the member to the
24 support.

25 JUDGE MAJORS: Counsel, I don't recall any of this being in your
26 papers.

1 MR. HAMILTON: Well, what the papers say is the button would fall
2 out without the --

3 JUDGE MAJORS: Yes.

4 MR. HAMILTON: -- rigid U-shaped member.

5 JUDGE MAJORS: Yes. Yes. But there was no discussion around if
6 you replace the actuating members with a string, that the string wouldn't
7 suffice for the same purpose, essentially, as the actuating members in
8 keeping the buttons in place.

9 MR. HAMILTON: What the paper said is, excuse me, Petitioner
10 asserts that the rigid U-shaped members would hold the buttons in place.
11 Actually, in fact, the petitioner doesn't assert that. That -- that's what Patent
12 Owner explained would hold the buttons in place in Schaffer. Petitioner's
13 only argument is the buttons move. And I'm -- I'll show you.

14 JUDGE MAJORS: What's -- Mr. Hamilton, what's Patent Owner's
15 construction of this phrase, movably coupled?

16 MR. HAMILTON: Okay. So movably coupled requires, of course,
17 that it's movable. That's pretty simple. It requires no construction. Coupled
18 also requires no construction. But if you -- if the board --

19 JUDGE FREDMAN: Wait. So movably. So you're agreeing that
20 these are movable? There's no dispute there?

21 MR. HAMILTON: Absolutely.

22 JUDGE FREDMAN: Okay.

23 MR. HAMILTON: Absolutely. Movable. The buttons have to move.
24 In Schaffer, the buttons move.

25 JUDGE FREDMAN: Yeah.

1 MR. HAMILTON: And let me go to -- oh, excuse me. This is the
2 entire argument in the petition. This is -- and now I'm on slide 14. This is
3 Petitioner's expert. This is what he says. He says, "Because the actuator's
4 50," that's the buttons, "are configured to cylindrically slide along the
5 cylindrical interior wall of the housing from a first position to a second
6 position, therefore, the actuator buttons are movably coupled to Schaffer's
7 housing." The entire argument is they move, therefore they're movably
8 coupled. There's nothing in the petition regarding coupled.

9 JUDGE MAJORS: And why is that not enough? I mean, it says they
10 cylindrically slide along the internal wall. That implies to me that there's
11 some contact, even if it be sliding, between the outer portion of the button
12 and the inner portion of the wall that's defining the pathway in which that
13 button moves. Why is that not movably coupled?

14 MR. HAMILTON: Okay. So a couple reasons, but let's just start
15 with the plain ordinary meaning of coupled. Petitioner has put in a couple
16 cases, several cases. Different use of the word coupled. You could adopt
17 any one of those meanings for coupled if the board finds that necessary.
18 Indirect or direct attachment. And I'll get to direct or indirect because that
19 doesn't matter. That's from the Bradford case. This is all in the reply at
20 Page 8.

21 Another one is directly or indirectly connected to. And then that's the
22 Mizuho case. And then the AllMed (phonetic) Systems case says, joined or
23 connected to. There has to be some sort of connection that holds the button
24 to the housing. Now, the patent itself uses a different word. It uses the word
25 retain -- retention member. And the patent says the retention member
26 couples the button or the member to the housing.

1 JUDGE FREDMAN: The claim doesn't have a retention member
2 though, does it?

3 MR. HAMILTON: The claim does not. The claim has movably
4 coupled. And the only example in the patent of movably coupled and the
5 only description of the patent that connects any feature with how it's coupled
6 is the retention -- is the retention.

7 JUDGE FREDMAN: So let me go to my same question that I asked
8 Petitioner, which is about a syringe versus an umbrella. So would you
9 dispute that an umbrella -- the telescoping parts of an umbrella, the bottom
10 essentially to the part that you open up that covers you, is -- they're movably
11 coupled?

12 MR. HAMILTON: No. No. They are -- they are movably coupled.
13 They can't be separated in the context of an umbrella.

14 JUDGE FREDMAN: Right.

15 MR. HAMILTON: This is a different context and I'll go to --

16 JUDGE FREDMAN: I understand that. Now, syringe. That's the
17 more relevant one for your --

18 MR. HAMILTON: Now, syringe, I guess it depends on the context of
19 the syringe. The syringe, if the part is intended to be pulled out and -- but
20 when it's in, there's a friction fit or something that's holding it in place, that
21 could be movably coupled in that context. Here, in the context, says it's
22 valid.

23 JUDGE FREDMAN: So the -- so a friction fit, you would argue
24 would be movably coupled?

25 MR. HAMILTON: A friction fit could be movably coupled. Sure.

26 JUDGE FREDMAN: Well, could be movably.

1 MR. HAMILTON: Yeah.

2 JUDGE FREDMAN: So if there was no friction fit, they're not
3 coupled though, then? That's what you're trying to make the argument?

4 MR. HAMILTON: Well --

5 JUDGE FREDMAN: If they slide in and out, but they're not actually
6 -- essentially you're going to slide them in between each other, right?
7 They're not coupled?

8 MR. HAMILTON: Couple-- coupling requires something other than
9 contact between the pieces or some interaction.

10 JUDGE FREDMAN: You think it's supposed to be more than that?

11 MR. HAMILTON: More than that. That's right. That's right. And
12 the patent says exactly what that is. It says, retain. The retention members
13 retain or couple the button, and in fact, the entire actuator to the housing.

14 JUDGE FREDMAN: Can you tell us where in the patent it says that?

15 MR. HAMILTON: So I'm going to go to slide 11. And here, I've got
16 a phrase from the patent that talks about these retention members. The first
17 says, "Retention features," sorry, not members, "features 140, the housing
18 can include these features." And then it goes on to say that those features
19 couple the actuator 142 to the housing 128. And then the actuator, of course,
20 includes the first button.

21 JUDGE JESCHKE: So Counsel, what do we do with this? So I'm
22 looking at your slide 11 here.

23 MR. HAMILTON: Yes.

24 JUDGE JESCHKE: It's, like, six lines down. There's an and/or. To
25 me, you're saying that the word couple means to retain, but then what do we
26 do with the fact that it says, "Retain the actuator 142 and/or can couple the

1 actuator 142 to the housing"? That and/or, to me, I would read that as to
2 say, couple and retain don't mean the same thing because why would you
3 have and/or there? Because that means that those are -- it's like a Venn
4 diagram. They're kind of potentially overlapping. Maybe not. So what do
5 we do? How do we -- how do you explain that and/or if couple means
6 retained?

7 MR. HAMILTON: So if couple just needs touching, then indirect or
8 direct makes no sense. Couple is not just contact.

9 JUDGE JESCHKE: I understand that. That's a different --

10 MR. HAMILTON: It has to imply something more than that.

11 JUDGE JESCHKE: Okay.

12 MR. HAMILTON: That it is held in place. It doesn't have to be the
13 word retained. In Petitioner's cases, it's connected to or joined or attached. I
14 think those are the words that are used in those cases. It's the plain meaning
15 of couple. It's more than just contacting. And what that means is it is -- it
16 can't fall out. That's the point of movably coupling the buttons to the
17 housing.

18 JUDGE JESCHKE: Okay. So now are you backing away from --
19 okay. I hear, I guess, two different things. A couple of minutes ago, it
20 sounded like you were saying coupled means retained. Now you say, well,
21 it doesn't have to mean retained. It just has to mean more than to contact.
22 So --

23 MR. HAMILTON: Well, no. What I said is coupled has attached,
24 connected, joined. Any of those words are the same. Retained is the word
25 that's used in the patent. You don't have to adopt the word retained.
26 Coupled has a plain and ordinary meaning that it is connected, held in place

1 somehow to the housing, not just simply touching the housing, because it's
2 indirect or direct. It doesn't even have to touch the housing.

3 JUDGE JESCHKE: Okay.

4 MR. HAMILTON: Now, what's important here is this patent's -- the
5 same paragraph says, and I'll go to the next slide, 12. So now I've
6 highlighted just another little portion right up at the beginning, that that
7 retention feature, "Retains all or portions of the constricting mechanism
8 141." And then what is the constricting mechanism 141? If you look at the
9 paragraph that's shown to the right on the top, the constricting mechanism
10 includes the actuators, that's the buttons, and the filament.

11 It is the retention features that hold the buttons and the filament in
12 place. The filament does not hold the button to the housing or in the device
13 as expressly set forth in the patent. It can't. Because I -- as I explained
14 before, if you push one button in, if there's not something else movably
15 coupling the button to the housing, the button simply falls out. Now, in the
16 context of the syringe, maybe that's fine. In the context of a hemostasis
17 valve with buttons, you can't have the buttons falling out if you push one and
18 not the other. So it can't be that in this context.

19 JUDGE MAJORS: Can you go back to my question, Mr. Hamilton?

20 MR. HAMILTON: Sure.

21 JUDGE MAJORS: Why -- if the housing defines a cylindrical recess,
22 and I think you would probably agree that the walls of the housing are
23 forming that recess that holds the button, right, and then there's this flange at
24 the bottom, too, that limits the absolute interior movement of the button.
25 Why is that not movably coupled? Let's assume for the moment that the
26 button could fall out. But I just don't understand why having a button that's

1 sliding in or out of a cylindrical recess that defines that access in which it
2 can move, why is that not enough to meet the language of movably coupled?

3 MR. HAMILTON: So let's -- let me first just come back to the claim.
4 So the claim requires not just movably coupled and the filament. It also
5 requires a spring, a biasing, something to bias the button away from the
6 housing, to bias the button so that the lumen is closed, okay? And so the
7 spring and this flange that you just referred to serve the purpose of
8 decoupling the button from the housing. They don't serve the purpose of
9 movably coupling the button to the housing. They may help with movable,
10 they do not -- and they do not contribute to coupling the button to the
11 housing. Did that address your question? I just want to show Schaffer to
12 finish that off.

13 JUDGE MAJORS: I guess. I -- I'm just struggling with the idea that
14 coupling in a mechanical engineering sense requires some sort of fixed
15 attachment. I don't see any support for that in the specification or anywhere
16 else in the record. You pointed to the retention features, but as we were just
17 talking about, the claim doesn't say retention features. So that's what I'm
18 struggling with.

19 MR. HAMILTON: It doesn't say retention features. The spec says
20 the retention features retain and/or movably -- and/or couple the button to
21 the housing, the actuator and the filament to the housing. That's what the --
22 that's what the spec says. Not in that context, the retention member doesn't
23 contribute at all to the movable portion of the button. That's the connection
24 part, the coupling part. That's what the retention member is for.

25 JUDGE MAJORS: Okay.

1 MR. HAMILTON: That means -- coupling doesn't just mean
2 contacting, and indirect and direct doesn't mean just contacting.

3 JUDGE MAJORS: If I look at the figure that you have here on slide
4 11 and it's the retention feature of 140, it's kind of ambiguous whether that's
5 pointing to that little lip that juts out the top, that interfaces with the other
6 portion of the button, or whether it's referring to the vertically oriented, I'll
7 call it, portions of the housing. So one reading of it is, by retaining, which I
8 would agree that as depicted here, this would retain the button within the
9 actual cylindrical recess. But why is it -- why is the broader and/or couple,
10 why is that not referring to the cylindrical recess itself, coupling the button
11 to the entire apparatus?

12 MR. HAMILTON: The cylindrical recess contacts the button,
13 certainly. And as Petitioner has argued, coupling doesn't mean contact it
14 could be indirect or directly coupling. There's something more to coupling
15 than simply contacting. It does not -- the cylindrical portion of the housing
16 there doesn't couple the button to anything. The cylindrical portion guides
17 the direction maybe that the button moves, but it doesn't hold the button in
18 place, it doesn't retain the button, it doesn't couple the button. Coupling is
19 not simply contacting or sliding along, that's the movable part of movably
20 coupled.

21 Now if you look at Schaffer, as I said in the petition, the only
22 argument Petitioner made was that the button slides, that's movable, not
23 coupled. There's a complete failure of proof uncoupled. In response,
24 Petitioner points to a couple of things. First, they say a friction fit. There is
25 no evidence in the patent, in Schaffer whatsoever about a friction fit, the
26 word doesn't come up. Petitioner presents no evidence from its expert or

1 anywhere else, just simply a term -- attorney argument that that might be a
2 friction fit. In fact, a friction fit --

3 JUDGE MAJORS: There's got to be some friction -- there's got to be
4 some friction between the button and the walls, they're sliding along it,
5 right?

6 MR. HAMILTON: There would be some friction, but it's designed to
7 slide freely along the walls, so that it can be pushed in and out. And a -- if a
8 friction fit held that button in place against that spring, it would hold it in
9 place when you push it in as well. That just doesn't make any sense that a
10 friction fit could possibly retain that button in Schaffer. The second --

11 JUDGE MAJORS: You agree that -- you agree this friction is not
12 sufficient to hold the button from falling out?

13 MR. HAMILTON: Well, any two surfaces, the contact will have, yes,
14 some amount of friction. There is nothing in the patent or in any of the
15 evidence, no -- nothing from Petitioner's expert regarding friction at all. So
16 Petitioner has not met any kind of burden to show that a friction fit couples
17 the member -- the button to --

18 JUDGE FREDMAN: And you're reading coupling is requiring that it
19 can't fall out, which isn't actually in the claim either. I mean, it would be
20 undesirable, there's no dispute there. But I'm just saying, but there's no
21 statement in the patent that cut -- that it has to remain inside and they are
22 connected presumably to the springs too, should also help resist falling out.

23 MR. HAMILTON: Okay. So it doesn't say -- the patent -- the --
24 excuse me. The claim doesn't say retain, it says couples. The patent spec
25 says retention members retain or coupled, that indicates that coupling is not
26 simply contacting. And the fact that coupling can mean indirect or direct,

1 cannot mean simply contacting. There's more to it than that, it has to be
2 attached and in this context --

3 JUDGE FREDMAN: And the attachment to the spring is insufficient.

4 MR. HAMILTON: Okay. So let -- let's -- I'll get to that, but --

5 JUDGE FREDMAN: I'm assuming they're attached. Is that true or
6 not?

7 MR. HAMILTON: It is not -- it is not attached. What Schaffer says
8 is the button abuts the spring and I'll give you a cite for that in just a sec. Let
9 me -- let me hit a couple of their -- the other arguments. So one is the
10 friction fit, the other one is the flange. This is all on reply. So in the
11 petition, Petitioner simply argues it's movable, complete failure of proof on
12 coupled. In reply, Petitioner comes up with the friction fit unsupported by
13 any evidence. And then the flange in Schaffer, which is down here, which
14 serves to decouple the button in conjunction with the spring from the
15 housing in Schaffer. That does not couple the -- this -- the button --
16 movably couple the button to the housing.

17 Now let me give you this cite for abut. So you can look in the reply at
18 Page 7, where Petitioner says, "The resilient members," that's the springs,
19 "abut the end of the buttons." And they give you a cite right there in
20 Schaffer, where it says the springs abut the buttons. And if you further look
21 in that same section where the assembly of the device is described, it talks
22 about inserting the spring and the buttons and pushing them in so that they're
23 held in place by the rigid U-shape members. The springs don't hold the
24 buttons in place, the springs push the buttons out. The flange doesn't hold
25 the buttons in place, the flange, in conjunction with the spring, pushes the
26 buttons out and that's exactly what patent owner's expert testified to.

1 And then as I explained before, Petitioner did make this argument in
2 the petition, but the only thing that holds the buttons in place in Schaffer are
3 these rigid U-shaped members. But the claim requires and Petitioner says,
4 take those out when you -- in their proposed combination. So that can't --
5 that can't be used in the combination to meet this limitation and it makes
6 sense. A rigid U-shape would couple those buttons in, because you know
7 exactly where it is. You push one button, the other one can't move the entire
8 length of the push of the other button.

9 But when you go to -- now I'm back on slide 12. When you have a
10 filament that spans between two buttons, pushing in one button would cause
11 the other button to fall out of the device that can't be movably coupled. I
12 want to just touch on the fact that the retention features are optional in the
13 patent. The patent discloses lots of different embodiments, the claim
14 expressly requires movably coupled. The proposed combination has to
15 disclose that limitation. Petitioner has pointed to a feature that is eliminated
16 in the proposed combination as movably coupling the buttons in Schaffer.
17 And then Petitioner's arguments relate to things that either serve to decouple
18 the button or don't hold the button in place at all.

19 And then I just want to go back to, again, I'm on slide 12. Just want to
20 reiterate this point, that the retention features retain all or portions of the
21 constricting mechanism. The constricting mechanism includes the actuator
22 of the buttons, example of which is buttons, and the filament. The retention
23 members hold both of those in place, the filament does not hold the buttons
24 in place and that's exactly what's set forth in the claim, in both independent
25 claims. There is a limitation for the filament in a -- around the lumen that's -

1 - that extends to the member. And then there is another limitation to the first
2 member movably coupled to the support.

3 There's a very important reason why those two limitations are both in
4 there. If movably coupled simply meant that you have a filament that loops
5 around the lumen and extends to the member, then there would be no need to
6 further say a first member movably coupled to the support. Petitioner has a
7 complete lack of proof on this limitation in the petition and even if the
8 arguments on the reply here, the unsupported attorney arguments on reply
9 are expected.

10 The rigid U-shaped members in Schaffer that hold the button in place
11 are eliminated in the proposed combination. The friction -- there's no
12 evidence of any kind of friction fit that wouldn't make any sense in the
13 context of having a button that moves. The flange contributes with the
14 spring to push the button out. The spring doesn't hold it in, the spring
15 pushes the button out, which abuts the spring. And because of that, Claims
16 one and 18 and all the claims that depend therefrom, Petitioner has failed to
17 meet its burden under any grounds in the petition.

18 JUDGE MAJORS: Mr. Hamilton, I have one more quick question on
19 this. From an interpretation standpoint, I was curious in looking through the
20 other references that are cited here. And I will grant you, this is not in the
21 party's paper, but I'd like you to comment on it if you could. If you go to
22 Garrison and Paragraph 123, they talk about having two catheters. I'm sure
23 you're familiar with Garrison, it comes up in a lot of these cases. You have
24 two catheters that slide within each other and it describes those catheters as
25 being in this Paragraph 123, as building being "telescopically coupled."

1 So it made me think that coupled has a broader meaning in the
2 mechanical arts relevant here than this idea that they have to somehow be
3 affixed or held permanently within the device itself. I don't know if you'd
4 like to comment on that. Again, I will grant you this did not come up in the
5 party's papers. But as an interpretive matter, I'm struggling to see why
6 coupled has this narrower meaning that you're arguing.

7 MR. HAMILTON: So of course it depends on the context and I -- I'm
8 not familiar off the top of my head with that particular passage in Garrison,
9 but there is an embodiment that I believe has a catheter that extends out by
10 telescopically. You know, you pull it out and the different pieces are all
11 connected together, but they don't -- they can't be removed. That is -- that is
12 one embodiment in Garrison. I don't know if that's the embodiment you're
13 referring to.

14 In terms of, if you're referring to just putting two catheters between
15 each other, of course, one inside the other. Of course, in that context, you
16 want to be able to remove the catheter, that's how those devices function. So
17 that has no bearing on what movably coupled means in the context of these
18 other patents to a hemostasis valve. Garrison's directed doesn't disclose any
19 aspects of a hemostasis valve, it just says you would use one, that's it. That's
20 all it says.

21 JUDGE FREDMAN: There's just another example. Like the syringe
22 are two things that where they're coupled, right? In the case of the catheters,
23 they're -- you know, they're connected due to the -- in a non-structural way.
24 They're not, you know, held together, there's no retention mechanism, but
25 they are movable within each other, where you can put one catheter into the

1 other one. And at least in that case, they did use the word coupled in
2 Garrison.

3 MR. HAMILTON: So for the syringe, I'll just go back to that again.
4 The syringe is intended to have this friction fit and keep the plunger within
5 the syringe.

6 JUDGE FREDMAN: We have the catheter, which doesn't have a --
7 which clearly doesn't have a friction fit. So it's more like the argument that
8 they would be making.

9 MR. HAMILTON: So comparing that to the syringe, the syringe is
10 designed in a particular way for what it is used for and I think some
11 syringes, you can't pull out the plunger, some syringes you can, it depends if
12 it's intended to be pulled out. In the context of two catheters, speaking off
13 the top of my head with not knowing which passage and what telescope is
14 being referred to, just putting one catheter -- if it's referring to just putting
15 one catheter in another one, the point is to be able to remove those. In that
16 context, of course, that's not what it means.

17 In the context of a hemostasis valve with buttons, movably coupled
18 must mean that it is retained. That's exactly what it says in the patent,
19 "retained and/or movably coupled." It's held in place by the retention
20 features. Retention features aren't required in the claim, but something that
21 movably couples the button to the housing is required in the claim. Whether
22 it's direct, indirect, it doesn't matter. The features that Petitioner points to
23 relate to movably, not coupled, or they relate to decoupling the button from
24 the housing in Schaffer, or they're eliminated in Petitioner's proposed
25 combination.

1 There's simply a failure of proof that the proposed combination of
2 Schaffer with Hartley or Eller discloses the limitation, a member movably
3 coupled to the support. And I just want to be clear. I don't think I
4 mentioned it at the beginning. Here, Petitioner doesn't dispute, doesn't
5 challenge whether housing is a support, we dispute that those terms are
6 synonymous, but for the purposes here, it -- it's the housing in both
7 references.

8 May I move on to the next one? Okay. So let's go to the '921. And
9 I'm not going to address the first theory about a -- I won't spend a lot of time
10 on it. A single -- a first and second filament can be satisfied by a single
11 filament that has multiple strands. I think the board's questions make clear,
12 patent the claim has two separate limitations, the first filament, the second
13 filament.

14 The specification is clear that when the patent refers to a first and
15 second filament, and that's on slide six in the paragraph on the middle right,
16 the patent expressly refers to the first and second filaments. Those are the
17 terms in the claim and you see that there are distinct pieces, whether or not
18 those components are made up of woven strands or any other configuration.
19 That's what's required by the claims.

20 So let's talk about the other one. Whether a person with skill in the art
21 would replace Schaffer's two rigid actuating members, each with a string or
22 a wire. Now for three IPRs now, Petitioner's got off here and explained that
23 a -- that -- the -- that a person of skill in the art would put a single filament
24 that spans between the two buttons and Petitioner's part of that motivation to
25 do that was what's shown on slide seven.

1 What Petitioner says is in Schaffer, you have these members that
2 Petitioner says are flexible and whether they're -- regardless of the item that's
3 put through the lumen in Schaffer, it would not seal. So you can see right
4 there on slide seven, this is straight from Petitioner's, I believe, surreply
5 Paper 18 in IPR 2024-01157 at Pages 23 and 24. Whether here, no matter
6 what tool or item is put through the lumen, Schaffer will not seal with the
7 flexible U-shaped actuating members. You can see it's labeled, flexible on
8 top.

9 JUDGE FREDMAN: I think what they're saying here is that gaps will
10 form, they won't seal completely?

11 MR. HAMILTON: That's right. Gaps will form.

12 JUDGE FREDMAN: And the question is, why isn't that obvious? It's
13 a simple substitution. Sure, not as good as if you can fully seal and there are
14 no gaps. I think there's no dispute there, I hope there's not. But their
15 argument is simply that you or is -- sorry, simply. Is a simple substitution
16 that you could substitute from, might not be the ideal solution, but it would
17 function.

18 MR. HAMILTON: Would I -- I'm sorry. Are you saying that a
19 person of skill in the art would modify Schaffer that it doesn't seal in any
20 situation or doesn't seal completely?

21 JUDGE FREDMAN: Well, I mean, I think the argument and they'll
22 correct me, I'm sure if I'm wrong, is that they're simply substituting a
23 flexible member for the rigid member. It will still seal, it just won't seal
24 quite as well. It will seal maybe just as well as the rigid member, it will only
25 seal as well as the flexible member that could be, you know, looped around
26 in a form of a circle. In other words, whether you actually -- your example

1 does it, you know, you're working examples in Figure seven, for example,
2 you know, that would fully seal, but that -- the claim doesn't require that.

3 MR. HAMILTON: Well, I think that's a little bit unfair to say fully
4 seal or partially seal, that -- that's a huge spectrum. What Petitioner said is it
5 would not seal and that's the motivation for including a single string
6 wrapped around from one button to a -- to another and that's shown in the
7 top figure, which shows a flexible --

8 JUDGE FREDMAN: But 1157 are different claims. I mean, they're
9 not the same claims, so they're not addressing the same obvious, you know,
10 considerations.

11 MR. HAMILTON: That's right. That's exactly right, they're not.
12 And what those claims required was something akin to the one button
13 wrapped around to the other button.

14 JUDGE FREDMAN: Yes. Right.

15 MR. HAMILTON: And Petitioner had to come up with some reason
16 why one would select that combination versus another substitution --

17 JUDGE FREDMAN: I think the board found that that was an obvious
18 substitution.

19 MR. HAMILTON: And the board found that it was. And what
20 Petitioner said, as a person of ordinary skill in the art would understand that
21 the gaps would be formed and because of those gaps, one would be
22 motivated to make that specific modification.

23 JUDGE FREDMAN: Right. And so one would motivate to make lots
24 of modification. Why wouldn't the slightly less effective modification also
25 be obvious? Or somewhat, I have no idea because there's no measurement
26 here, but some -- something at least to some degree less. In other words, we

1 often have substitutions, right? I mean, and examiners do this all the time
2 where there's a simple substitution of one part for another. And as they
3 point to (inaudible) and other cases tell us that it can be less effective. That's
4 not a requirement that it be as effective, that it's just or -- and Fulton says the
5 same thing. That's a pretty common case. It doesn't have to be as good as, it
6 just has to be an obvious alternative.

7 MR. HAMILTON: So the less effective argument that's been made
8 and in the previous IPRs was not that it seals just enough or, you know, it
9 would seal better. The less effective was what's put through the lumen. And
10 what I believe the board argued or the board said and what Petitioner's
11 argued is it would work in some -- it would seal in some circumstances and
12 it wouldn't. There wasn't this issue of degree of sealing and of course,
13 nothing's perfect. One skilled in the art would understand, you know, and be
14 able to figure out how much it needs to be sealed.

15 What Petitioner said is, when it's flexible, if it's two U's, regardless of
16 what you put through, it forms gaps and therefore would not seal. And then
17 -- so one would be motivated to use the particular arrangement that was
18 advocated for in the previous IPRs, a single string between two different
19 buttons. That's what Petitioner's argued. That's the only -- there -- there's
20 been no argument regarding, well, it would seal good enough. It was that it
21 would seal in enough situations, not that the degree of sealing would be
22 good enough in different situations. That was the issue.

23 And as shown right here, it doesn't matter what the situation is.
24 Petitioner said if it's flexible, it would not seal and therefore you would have
25 to -- and Petitioner's actually said the same thing. One skilled in the art
26 would be motivated to do a single string between two buttons. And now in

1 this IPR for the first time, Petitioner is saying, well, actually, forget what we
2 said, forget what our expert said. This is exactly what a POSA would be
3 motivated to do, make a configuration that Petitioner said would form gaps
4 and therefore would not seal.

5 JUDGE FREDMAN: Are petitioners required to be consistent
6 between different claims and different IPRs?

7 MR. HAMILTON: Well, consistent between different claims, I don't
8 know. They should be consistent on what a person of ordinary skill in the
9 art would understand --

10 JUDGE FREDMAN: Could a person of skill understand multiple
11 things at once?

12 MR. HAMILTON: And what they understood was a person of
13 ordinary skill in the art would not include two flexible U's, because neither
14 of them would seal in any situation in Schaffer. That's what Petitioner's
15 expert was --

16 JUDGE FREDMAN: Did they actually say they wouldn't seal or they
17 wouldn't seal completely?

18 MR. HAMILTON: They would both form gaps. It's the exact same
19 argument in both.

20 JUDGE FREDMAN: Right. I mean, but gaps doesn't imply there's
21 no sealing, it implies that there's less sealing?

22 MR. HAMILTON: With all due respect, that's the whole point of
23 Petitioner's argument, that gaps would be formed. If the gaps don't matter,
24 then why are we even changing Schaffer in the first place? I mean, that is
25 the point.

26 JUDGE FREDMAN: That's the reason.

1 MR. HAMILTON: That's the --

2 JUDGE FREDMAN: The reason they used in the other case is we'd
3 like to have fewer gaps, less gaps. We always have gaps, that I think you
4 already acknowledged, right? Then you're having gaps. The question is,
5 how much of gaps are you going to have? And so there are certain things
6 that will give you fewer gaps, certain things that will give you more gaps.
7 And so the question is, how optimized do you need to be for this?

8 MR. HAMILTON: If I said there'd always be gaps, I misspoke and I
9 apologize. That is not what I meant. At some --

10 JUDGE FREDMAN: Are you saying that there --

11 MR. HAMILTON: -- at some microscopic level, there will be some
12 space between the filaments and the things. And sealing and gaps and the
13 idea of gaps, a person of skill in the art would know what needs to be done
14 to make the device work. Petitioner has not put in any of the evidence that
15 there is some degree, that this would be okay in some situations and not in
16 others. Petitioner said, when there's gaps, you're motivated to do something
17 else. That is the point of Petitioner's arguments in the previous IPRs and
18 Petitioner's expert, not some degree of gaps.

19 And as you can see right here, what Petitioner says is, in slide seven,
20 is gaps are going to form whether they're rigid or whether they're flexible if
21 you use the U's and this is the motivation to do a different configuration.
22 Now Petitioner and its expert are coming back here and saying, arguing,
23 well, actually, forget that. This is exactly what one skilled in the art would
24 do to modify Schaffer.

25 Now I just want to touch briefly on the point Petitioner made about
26 Eller, that says you could use whatever number of wires you want.

1 Petitioner doesn't allege that Eller discloses this particular configuration,
2 Eller just says you can use more wires. The patent owner's response and
3 reply explains what Eller meant by that. And if a person of ordinary skill in
4 the art thought that this configuration would form gaps, a person of ordinary
5 skill in the art, despite Eller saying you could use whatever wires you want
6 to use, would not go to this configuration.

7 But you could -- all you got to do is listen to Petitioner's own expert
8 and Petitioner's arguments in the petition. A person of ordinary skill in the
9 art would not modify Schaffer to simply replace the two flexible members
10 with a -- excuse me, the two -- Schaffer's two members with a string or a
11 wire.

12 Now I know I said I wouldn't re-argue the final written decision, but
13 this demonstrates, you know, a couple of things. As explained in the prior
14 oral argument, as explained in the patent owner response 62 and surreply at
15 seven, here, Petitioner's expert used the claims as a roadmap. Petitioner's
16 expert started with the claim and then went back and looked at the references
17 and figured out how to get to the claim. Whatever the claim said, he comes
18 up with a position to find the claims unpatentable.

19 He's testified to that several times. For example, in IPR 2025-00156,
20 that's the IPR regarding the 012 Patent. And the exhibit, his deposition is in
21 the -- in an exhibit here, Exhibit 2034 here, Page 41, Line 17 to 42, Line 5,
22 that's where he said, "I didn't consider any other option." I think as Judge
23 Majors pointed out, he testified in another deposition, "I never considered" --
24 shortly after putting in his declarations here in this case, he never considered
25 replacing each U-shaped member with a string or a wire. He looked at the

1 claims and then found some reason why that claim was unpatentable. That -
2 - and that is starting with the claims that's classic hindsight.

3 And second, he said in the other IPRs, that a person of skill in the art
4 would understand that two flexible U's would form gaps no matter what
5 device is put through those two flexible components and then here he asserts
6 that's exactly what an opposer would do. That demonstrates two things.
7 One, not only hindsight, but two, that he's just simply not credible on this
8 issue, he's going to say whatever he needs to say to come up with the claim
9 configuration.

10 So for the '921, all you need to do is take petitioner and its expert at its
11 own word, a person of ordinary skill in the art would not simply replace the
12 U's to come up in two filament -- two filaments. And then for the '291
13 patent, a member movably coupled to a support has a particular meaning in
14 that claim, it doesn't mean that the filament can movably couple the member
15 to the support. Petitioner's complete failure of proof on that issue.

16 JUDGE FREDMAN: Can I just go back to one of the things you're
17 talking about? Just the simple substitution, the evidence for that. There is a
18 statement in Dr. or Mr. Thornton's testimony at Paragraph, I think it's 79,
19 towards the end of the last paragraph. And he does say that not all tools
20 inserted through that will have a circular profile. In those cases, U-shape
21 actuating members having some flexibility with better seal around the
22 irregular shapes. So he is giving a reason why you might want to have
23 flexible string, even in the context of just replacing the rigid U-shape
24 members with a flexible string.

25 MR. HAMILTON: So I -- I'm not sure --

26 JUDGE FREDMAN: There is some evidence there.

1 MR. HAMILTON: Yeah. Exactly what you're citing. But what he
2 said in that supplemental declaration, that Petitioner's trying to bring into
3 this case and in those other IPRs, is the flexible U-shape would form gaps
4 regardless of what instrument is put through and you can see that on slide
5 seven. The easiest situation to seal is when the -- whatever's put through the
6 lumen is essentially the same size as the lumen. Gaps will be formed with a
7 flexible member and then gaps will also be formed with a smaller member.
8 And as patent owner pointed out, if two are put through, gaps will be formed
9 as well.

10 Schaffer is fundamentally different. And you had asked about, you
11 know, is there any other issue in the previous IPRs? Of course, patent owner
12 still disagrees that one would substitute a flexible member in the particular
13 claim configuration of those IPRs into Schaffer, because Schaffer seals via a
14 completely different route. It has an internal highly compliant member that
15 conforms to whatever's put through the lumen and it's compressed by a hard
16 member. That's the fundamental principle of Schaffer.

17 A person of ordinary skill in the art would not go and substitute
18 something flexible that wouldn't seal in any situation, as Petitioner's pointed
19 out here, let alone in any particular claim configuration that's not shown in
20 any reference. Attaching a single string to two buttons and, you know, for
21 one reason that matters is because then the buttons will fall out, it's not
22 movably coupled. One would -- one --

23 JUDGE FREDMAN: They actually have a discussion, I think,
24 important that you could actually push the flexible member all the way
25 through the buttons and tie them off at the end and that put all them on.

1 MR. HAMILTON: If the string goes between the two buttons, as I
2 explained with the '291 patent, you push one button in. Even if the string's
3 attached, the buttons will fall out, unless there is something --

4 JUDGE FREDMAN: Does that not depend on the length of the
5 string? I mean, I think that -- that's in the length of the channel. I don't think
6 that's a guaranteed statement. That's speculation by the attorney, that's not
7 evidence. Do you have evidence that it would fall out?

8 MR. HAMILTON: The evidence is right there in the '291 patent
9 specification. First, all you need to do is look at that picture and you can see
10 that if the button is pushed in, that length of the button would fall out on the
11 other end. The second is the patent --

12 JUDGE FREDMAN: I don't see the -- I don't see that. It depends on
13 the length of the string and it depends on the other material. That -- that's
14 simply argument. There is no evidence and that figure doesn't show
15 anything.

16 MR. HAMILTON: If you look at the specification right there in the
17 paragraph --

18 JUDGE FREDMAN: That's not your position to take, sir.

19 MR. HAMILTON: Sorry. If you look at the figure in or the
20 paragraph right above the figure, it says that the retention members retain
21 both the filament and the buttons. The filament does not retain the buttons
22 in --

23 JUDGE FREDMAN: I'm talking about in the Thornton declaration,
24 he gives an example where the filament itself is stretched through the button
25 to the other end, and the filament itself is holding them together, right?

1 That's something in his declaration that he shows. So that's what I'm talking
2 about, not some filament that's not fully attached.

3 MR. HAMILTON: Not some filament that's not fully attached. I --
4 I'm sorry, I'm not following. The filament's always going to be attached to
5 the button, Your Honor, in every embodiment. In this embodiment it's
6 attached to the button.

7 JUDGE FREDMAN: But in -- I think this is at Paragraph 90 of
8 Thornton. He shows an example where there's a knot that secures the string
9 on the external side of the buttons, clearly whether you would touch them.
10 So it goes through all -- through the buttons and then it doesn't seem to me
11 that even if the -- it was the entire size of the -- in that drawing that he
12 provides, the entire size of the lumen or the catheter, that it would slide out.
13 The buttons would not be able to be removed.

14 MR. HAMILTON: So in that paragraph, I suspect he's not talking
15 about movably coupled. He doesn't say anything about movably coupled.
16 It's still another --

17 JUDGE FREDMAN: It's not, but it shows something that would be
18 movably coupled and that would not be able to fall and that is connected
19 indirectly to the channels.

20 MR. HAMILTON: What he says about movably coupled is it slides.
21 He has zero -- no testimony whatsoever on coupling versus movably
22 coupling. That's what he says about that limitation.

23 JUDGE FREDMAN: Okay.

24 MR. HAMILTON: And what the patent owner says, all those features
25 don't couple the button at all. And in fact, they decouple the button or
26 they're omitted from Patent Owner's proposed combination.

1 JUDGE FREDMAN: You don't want to take all your rebuttal time in
2 case you want to save some of it.

3 MR. HAMILTON: I will save the rest. Thanks.

4 JUDGE FREDMAN: Okay.

5 JUDGE MAJORS: Well, I have a question, Mr. Hamilton.

6 JUDGE FREDMAN: Sure.

7 JUDGE MAJORS: We'll give you a little bit more time.

8 JUDGE FREDMAN: Sure. Sorry.

9 JUDGE MAJORS: Is there any evidence in the record that in a two-
10 button configuration, whether it be Schaffer or whether it be the claims here,
11 that the way these are actually operated is you only push one button in at a
12 time?

13 MR. HAMILTON: That would not be how they're operated. They --
14 they're not supposed to be operated in that manner, but that doesn't prevent
15 that from happening. This is a device that is used for a medical procedure.
16 It's very critical that the device is reliable. Doctors are using it. Lots of
17 things are going on. That could happen.

18 The claim requires the filament and movably coupled to prevent the
19 device from falling apart during an operation. That could easily happen.
20 And the fact that it's not intended that -- perfectly operating device, that
21 wouldn't happen. But you could imagine pushing two buttons that are
22 independently operatable, you're never going to push them exactly the same.
23 You could easily push one more than the other and not push one at all.
24 That's the issue with attaching a single string to two separate buttons. That's
25 why that's not a simple substitution or that -- that's why it's not obvious to do
26 that.

1 There's more to it than that. You can't just say, well, strings are
2 known and buttons are known. So now you're going to put it in this
3 configuration. There's lots of issues that can happen in that instance.

4 Did I address your question, Judge Majors?

5 JUDGE MAJORS: Yes. Thank you.

6 JUDGE FREDMAN: Whenever we go to, we'll give you eleven
7 minutes, if Judge Majors is okay with that.

8 MR. HAMILTON: I -- may I just say one more thing? And that the
9 evidence is right there on slide 12 in that paragraph. The retention features
10 retain the filament and the buttons. That's what demonstrates that the
11 filament does not hold the buttons in the device. It says it right there in the
12 patent.

13 JUDGE FREDMAN: Okay. Thank you.

14 MR. STOWELL: Thank you, Your Honor. So I -- I'll start with the
15 '291 arguments because that's where my colleague began as well.

16 And Judge Majors, as you pointed out, we were confronted with a
17 brand new argument during Patent Owner's presentation that if the U-shaped
18 actuating members are replaced with the string, that somehow the buttons
19 will fall out. And Judge Fredman, you took the point that I was going to
20 offer, which is there is no evidence in the record because this argument was
21 just introduced here at oral argument that the buttons would fall out if the U-
22 shaped members were replaced by a string. And Judge Fredman, you
23 correctly pointed out that the string in our embodiment is tied off on one end
24 of the buttons. Also, when you push in a button, those central lumen
25 expands so that encircling of the lumen gets larger and therefore the string

1 doesn't -- the button doesn't necessarily fall out the other side, I guess, would
2 be my point.

3 And so there's no evidence of that. I thought -- I heard Mr. Hamilton
4 say repeatedly that movably coupled requires retaining, means retaining.
5 And Judge Jeschke, I thought you made a good point.

6 Brian, if we could go to their slide 11, Patent Owner's slide 11.

7 As you pointed out, the patent uses the term retained and coupled
8 separately there in that -- on the description on slide 11, roughly six lines
9 down where it says that -- how the retention features of the housing can
10 retain the actuator and/or can couple the actuator. So coupled does not mean
11 retained.

12 If we jump ahead to slide 13, I really like this figure for a couple of
13 reasons. First, on the right-hand side, we have the Schaffer reference. Here,
14 Schaffer's in its first position, which means that the buttons are not
15 depressed. As you can see, even in this configuration, the buttons are still
16 housed within the opening of the housing. They're still positioned with it.
17 They're not popping out of the housing. They're in their undepressed
18 configuration. And what we also see is -- looks a lot like the preferred
19 embodiment in the '291 patent, particularly if we were to think of removing
20 those optional retention features.

21 And I didn't hear Mr. Hamilton dispute that the patent describes the
22 retention features as optional. In fact, if we eliminated the retention features
23 on the '291 patent, it would have even less structure to movably couple the
24 button to the device. And so I like this picture because it illustrates that if
25 these optional retention features are removed, that Schaffer would work at
26 least as well, if not better, than whatever is described in the '291 patent.

1 I also am going to read actually the positions that Petitioner has raised
2 with respect to Patent Owner's slide 7. I heard Patent Owner say that
3 Petitioner's argument has been that if the U-shaped actuating members were
4 flexible, it would not work in any circumstances. He said that we've asked
5 you to forget what our expert said. That is not correct. I don't want you to
6 forget anything that our expert said.

7 In Exhibit 1039, Paragraph 34, where we discuss or Mr. Thornton
8 discusses this configuration, he explains that there's this arrangement where
9 the ends of the U-shaped actuating member are fixed to the button. He says,
10 "Because of this arrangement, even when the U-shaped actuating members
11 or bites are relatively flexible, the fix -- the fixed attachment points to the
12 actuator buttons may prevent the U-shaped actuating members from
13 completely conforming to the exterior of a tool with a smaller diameter than
14 the distance between the attachment points as I've illustrated below." And
15 he includes that picture.

16 So he's focusing and he's saying, in the very specific circumstance
17 where we have a smaller diameter tool, that's where maybe the flexible U-
18 shaped actuating members aren't going to seal completely and where a string
19 that encircles the tubular member is even more beneficial. Both of these
20 solutions and improvements to Schaffer would've been obvious. And
21 Petitioner has consistently made that argument.

22 I'm also just going to briefly touch on this. The -- our first argument
23 regarding the first and second filament, that the string or the wire member
24 included the first and second filament. And what I would ask the Board to
25 consider is if we're importing this separate limitation into the claim, a first

1 filament and a second filament need to be separate. What exactly does that
2 mean?

3 Does the embodiment have to look exactly like Figures 7 through 9 in
4 the '921 patent? And I think those are shown in our slides at Page 24. So is
5 that all that's embodied by first and second filament? It has to look exactly
6 like Figure 7 or Figure 9? We're importing the exact embodiment. Or does
7 it mean that the -- that we would have to wind together the filaments? Is that
8 what's separate -- is that what separate would exclude, winding together?

9 If we look at our slide 26, we see some testimony from Patent Owner's
10 expert where he's trying to explain when two separate filaments become one
11 filament. And he explains. He's first asked whether, when they are wound
12 together, would they be a single filament rather than separate filaments?
13 And he says, as soon as they're integrated into a single outside diameter. So
14 now we have a diameter that's been imported into the claims. It's not
15 discussed in the specification.

16 We say, okay. Well, what constitutes an integrated single outer
17 diameter string? And he says, two or more threads with the characteristics
18 we just described wound around one another. Okay, so now we're limiting it
19 to winding. Let's go to the right-hand side. And what constitutes integrated
20 is when it's two or more threads that are wound around each other, right?
21 Now he backs off and he says, well, wound or otherwise fashioned in a point
22 so that their constitution leads to a single filament observed with a specific
23 outside diameter.

24 So now I'm even more confused. I'm not sure when two separate
25 filaments become one filament. And when we get to the bottom of his
26 testimony, he essentially says, I know it when I see it. That's -- I -- I'll tell

1 you when you have one filament and I'll tell you when you have two
2 filaments, but I can't really define it.

3 And this is on top of his testimony that appears at slide 20 of our
4 materials where he was asked, would each of the threads within the string be
5 a filament? And he says, each thread, if it had those characteristics, so
6 tensile strength, ability to withstand force, could be an individual filament.
7 Oh, great. He then realizes he's made a mistake. And he's asked a follow-up
8 question. And he says, well, if they're wound within or around each other,
9 they constitute a single filament. But then he concedes that each thread in
10 that on its own would be a filament.

11 So the question is, when do two filaments become one filament?
12 What if I have two filaments and they just cross each other? Now do I just
13 have one filament? What if they're wound around each other? What if they
14 lie parallel to each other? Now are they just one filament? I could certainly
15 probably make one diameter if I wanted to, right? Now are -- now do I just
16 have one filament?

17 What if I take my two parallel filaments that touch and I tie them off
18 at the end around a button? Now are they only one filament because they're
19 tied together and they overlap? When does two threads, which we all agree
20 are two -- are filaments, when do they become a single filament? That is not
21 spelled out anywhere in the patent specification. All the patent says is, one
22 or more threads or strands can be a filament.

23 And so we have this real problem if the Board is going to import this
24 separate requirement into the claims of defining the bounds of the claim.
25 That is our problem with a separate argument.

26 JUDGE MAJORS: Mr. Stowell --

1 MR. STOWELL: Yes.

2 JUDGE MAJORS: What do you make of the disclosure in Eller on
3 Column 15 that--you could go there-- but in a nutshell, it talks about having
4 strands or fibers that can be twisted together to form a wire member. And
5 there, I might say much like the patents here, they still speak about it being
6 one wire member, not multiple wire members.

7 So to your point that you were just making that maybe there's some
8 ambiguity, that seems to be the type of thing that skilled people do know it
9 when they see it as evidenced by Eller, one might say.

10 MR. STOWELL: Yeah. And what Eller says, I don't have the portion
11 up in front of me, but what it says is that each wire member can be made of
12 one or more strands. And so we've already agreed in this case, we already
13 have a claim construction that a strand -- one strand is a filament. So Eller is
14 confirming that our wire members can be made of one or more filaments.
15 You can put them all together. You can have five filaments in one wire
16 member. You can have one filament.

17 Oh, here we go. Brian did a great job, right? So and this is all
18 exemplary. And what the -- what Eller really explains is that the person of
19 skill can select the number of strands or filaments that make up the
20 embodiment, that make up the device. That's well within the knowledge of a
21 person of ordinary skill in the art.

22 And it -- and what it says is it can include any suitable number of
23 strands and/or fibers. So clearly it's counting multiple fibers. Each one is a
24 fiber. Each one is a strand, right? Each filament is a filament or is a strand.
25 So I think Eller is entirely consistent with Petitioner's position in this case.

1 And lastly, I just addressed the argument that Patent Owner raised that
2 Schaffer is fundamentally different in its operation than Hartley or Eller.
3 The Board has addressed that argument already several times. I think it was
4 the methods of operation or the principles of operation. The Board has
5 already found that the principles of operation are not changed by introducing
6 a flexible element into Schaffer's valve. The principles of operation are the
7 same. You push the buttons to release tension. You release the buttons to
8 add tension to the tubular member. Those are the principles of (inaudible).

9 JUDGE FREDMAN: I think actually Figure 8 that's on slide 24 that
10 you have kind of does show that part. And that looks very much like
11 Schaffer's rigid members replaced with flexible numbers.

12 MR. STOWELL: Figure -- sorry, which --

13 JUDGE FREDMAN: Figure 8 -- figure 8 of the patents. That's
14 what's --

15 MR. STOWELL: Figure 8 of the patent on slide 24?

16 JUDGE FREDMAN: Yeah.

17 JUDGE JESCHKE: I think it's slide 24.

18 MR. STOWELL: So Judge Fredman, what was your -- what was the
19 question?

20 JUDGE FREDMAN: I was just commenting that that -- that's flexible
21 members that are like U-shaped, right?

22 MR. STOWELL: Correct.

23 JUDGE FREDMAN: It's U-shaped.

24 MR. STOWELL: Correct.

25 JUDGE FREDMAN: I still don't find the filament argument
26 persuasive though, I'm sorry. I think that that's just not a reasonable

1 understanding by an ordinary person. It's like you wouldn't say, you know,
2 thread is a rope, right? To say that they're the same is just inconsistent with
3 the ordinary understanding, I think, of the term.

4 MR. STOWELL: But if I had --

5 JUDGE FREDMAN: I hear what you're saying. I -- it's saying I don't
6 think I agree.

7 MR. STOWELL: But if I had a definition for you that said a rope can
8 be one thread or multiple threads. Oh, now we have a different
9 conversation, right? Which is what the patent says. A filament can be one
10 thread or multiple threads.

11 JUDGE FREDMAN: I hear you. I just -- it just doesn't -- I don't
12 know. (inaudible). Go ahead.

13 MR. STOWELL: I'm trying to be consistent with the '921 patent
14 specification. I'm trying to give meaning to the words that are there. And I
15 think we've done that in our argument. But to your point, there is the
16 additional argument that a person of skill would've found it obvious to
17 replace the material, the rigid material of the U-shaped actuating members
18 with a flexible material, like the string in Hartley or the wired members in
19 Eller.

20 With that, I will rest, unless there are any further questions.

21 JUDGE MAJORS: Okay. Mr. Stowell, before you sit down, before I
22 forget, did you have an occasion to talk with Patent Owner's counsel about
23 the -- in follow-up to the call that we had earlier? Was it this week?

24 MR. STOWELL: It was this week. Time flies, right? Yes. We did
25 have an opportunity. We have not -- we were not -- unable to reach
26 agreement on the exhibits.

1 JUDGE MAJORS: Okay.

2 MR. STOWELL: So -- and if the Board would like additional
3 argument on that, I see I have five minutes left. I'm happy to provide
4 additional argument. We already had a lengthy phone call in it. But what I
5 would -- I mean, a couple of the points I would make is that the -- this isn't
6 really critical to this IPR. Due to the spacing of when the different
7 declarations were filed by Mr. Thornton, his original declaration in this IPR,
8 Exhibit 1003, addresses almost all of the arguments that are addressed in the
9 1039 exhibit or the 1030 exhibit.

10 For example, at Paragraph 77, 86, 87, he addresses their obviousness
11 arguments. It prebuts (sic) them. Same with Paragraphs 104 to 106. In
12 Paragraphs 52 to 53, 79, 81, and 148, he addresses their claim construction
13 arguments that they raise. And so the arguments that are raised in that
14 supplemental declaration, the vast majority of them are in his original
15 declaration.

16 What's a little ironic is that the argument that they are relying on to try
17 to say that we are inconsistent, the argument that appears in their slide where
18 they show the flexible -- their slide 7, that is in the supplemental declaration.
19 And it's really the only argument kind of that's unique in that supplemental
20 declaration. So they're trying to exclude the exhibit that forms the basis for
21 their argument in this case, which is a little ironic.

22 I think it also undercuts dramatically their argument that they weren't
23 given an opportunity to respond to that supplemental declaration. They've
24 built their whole argument around responding to the supplemental
25 declaration. So those are the points that I would make on that, in addition to

1 the points that I raised at our hearing, but there's really no prejudice here.
2 But happy to answer any further questions.

3 JUDGE JESCHKE: None from me. Thank you.

4 JUDGE FREDMAN: Thank you.

5 MR. STOWELL: Thank you, Your Honors.

6 JUDGE MAJORS: And Mr. Hamilton, you can tackle that issue at
7 the end if you'd like. We all used that to take up your argument time.

8 MR. HAMILTON: Thank you, Your Honor.

9 Okay. Thank you for the time. Quickly, I'm just going to hit the
10 reference to coupling in Garrison that Your Honor referred to. It is the
11 embodiment I recall. It is telescoping catheters that are connected to each
12 other. It -- that statement specifically refers to this Figure 31. You can see
13 there's a catheter that's telescoped through this catheter, and then it ends here
14 and it's connected here so that it doesn't further move out of this catheter.

15 If you look at the other figures that relate to this, it shows how it can
16 be connected. You can put nodules on there to connect it. You can put
17 barbs on there to connect it. It is held -- the internal catheter that is
18 telescopically coupled to the external catheter is held in place by some
19 feature. That's exactly what Garrison refers to. That's exactly how the term
20 is used in the '291 patent. And that's exactly what the claim requires. And
21 that argument was never made by Petitioner.

22 Quickly, I want to go to the two slides that Petitioner just put up about
23 Patent Owner's expert's testimony. Patent Owner's expert is extremely clear
24 on what constitutes a filament versus the individual threads. You're able to
25 pull them apart. They might be a filament. When they're put together,
26 they're treated as a single unit. It's right there in that highlighted answer on

1 Petitioner's slide number 26. It's visually and mechanically a single
2 component. That's what happens when you have a woven thread.

3 And actually, if you look at the -- on -- still on slide -- Petitioner's
4 slide 26, the next sentence explains the constitution can involve two or more
5 threads that are counterwound, but its function and form are as a single
6 element. That's the difference between a filament and then the individual
7 pieces that make up the filament. Petitioner's expert's testimony is clear on
8 that point.

9 I want to talk about the issue about is there evidence that the buttons
10 will fall out or are they held in place by a filament? Number one, Petitioner
11 in -- nowhere in its initial paper, the petition or the Reply argues that the
12 filament in the proposed combination holds the buttons, couples the buttons
13 to the device, to the housing. What Petitioner says is -- in the petition that
14 the buttons are movable. That's it. On reply, Petitioner says, friction in
15 Schaffer. The flange in Schaffer, neither of those are -- hold the button in
16 place. There's no evidence of either. And then Petitioner says --

17 JUDGE FREDMAN: But essentially this is an argument you raised,
18 right? The idea that they'll fall out. That's not an argument they originally
19 were dealing with. So that's why they don't address it until you raised it.
20 And when you raised it, you know, one of the things that I was thinking
21 about as we were talking is if you wrap a filament around a tube, right,
22 because that's essentially what's happening here, and you're compressing the
23 tube, then when it's in that initial position where the tube is closed, right --

24 MR. HAMILTON: Uh-huh.

25 JUDGE FREDMAN: -- that's not what -- the picture that you have
26 there. But in the initial button where the -- yeah, that one. Or that -- where

1 it's closed, right, it's held closed when it's -- when they're pulled apart and
2 then it's opened when you close it, right? When you push the buttons
3 together, it opens, right? The tube itself is resilient to some degree, and it's
4 going to also hold it in place.

5 So in other words, as you -- if you push in one button, right,
6 presumably making the tube open, as the tube opened and the string was
7 either around it or fully around it, depending on which form you want to do,
8 the tube itself would hold the suction button in place, right? Because the
9 tube would then be opened, which would then pull that string down, holding
10 it in place.

11 So even without a retention member, it seems like it should be held in
12 place just by the tube itself while it's in there. If you did it without a tube in
13 there, I suppose, but then why would you have them there?

14 MR. HAMILTON: So number one, it's Petitioner's burden to show
15 that the prior art discloses as the modified prior art discloses the claim
16 limitation. The Petition says nothing about couple that says movable. Not --
17 doesn't allege one thing in the petition. The Reply still doesn't allege that the
18 filament couples in the proposed combination, the buttons to the housing.

19 What Petitioner says is that the rigid U-shaped members hold the
20 button in the housing in Schaffer, and Petitioner eliminates those rigid U-
21 shaped members in its proposed combination. It's a complete failure of
22 proof. First in the petition, it's -- there's nothing. And then in Reply,
23 Petitioner doesn't argue that the filament holds it in place. And if you need
24 evidence on -- that the filament does not hold the buttons -- movably couple
25 the buttons to the housing, you can look right here. Again, I've got slide 12
26 up.

1 That's the paragraph on the right top. And that's from the patent.
2 Column 8, Lines 8 through 12. The retention members retain both the
3 buttons and the filament. The filament does not hold the buttons in place.
4 That's your evidence on -- that the filament cannot --

5 JUDGE FREDMAN: It doesn't say it cannot. It says that's what you
6 add a retention feature to ensure it. That -- that's not the same thing.

7 MR. HAMILTON: Well, it said -- it says this is what does it, and it
8 doesn't disclose any other feature that doesn't. There is no evidence.
9 Petitioner hasn't even alleged that the filament holds the buttons in place.

10 And the only evidence in the record is this. First, Patent Owner's
11 expert saying that the buttons aren't held in place in Schaffer. And second,
12 that what retains the buttons in the '291 patent are these retention members,
13 not the filament, because the retention members retain both.

14 The fact that the retention member is optional is irrelevant to what the
15 claim means. The claim says -- first, this does -- these paragraphs don't say
16 the retention member is optional. It says it does say it can include a --
17 further include a retention member. There are many embodiments in the
18 patent. The claim expressly requires movably coupled. The only disclosure
19 in the patent of something that couples the button to the housing is right
20 here. It's the retention members. So it's irrelevant if the retention member is
21 optional or not. The claim expressly requires moveably coupled. That must
22 be found in the proposed combination.

23 The only feature that Petitioner has argued to this day that retains the
24 buttons in Schaffer are the -- is the U-shaped members that Petitioner
25 eliminates from the proposed combination. It's a complete lack of proof on
26 this limitation.

1 I want to -- I want to quickly address this issue on slide 7 the
2 petitioner just argued. Petitioner just confirmed in that argument, the
3 argument here is about the size of the tool that goes in, not the fact that it's --
4 the degree of sealant. That's not the issue that Petitioner had argued in the
5 previous IPRs. And you can see right there in that figure repeated from
6 Petitioner's -- on Paper 18 from IPR 2024-01157, the two U-shapes on top
7 and the two U-shapes on bottom are flexible and both gaps are formed. Both
8 motivate, regardless of the size of the tool, a person of skill in the art,
9 according to Petitioner and its expert in those previous IPRs, to choose a
10 particular configuration of a filament in the proposed combination.

11 Now here, Petitioner says, actually, you would do exactly what we
12 said would form gaps in the previous IPRs. It's not a question of optimizing
13 in all circumstances, which was the issue in the previous IPRs. It is, would a
14 person of ordinary skill in the art replace Schaffer's U-shaped members with
15 something flexible? Petitioner here tells you why they wouldn't. And this is
16 what Petitioner relied on in the previous IPRs.

17 Patent Owner maintains its objections to the other document. The --
18 to the Exhibit 230 -- 2030, 2039, and the two IPRs. The prejudice isn't that
19 we didn't have a chance to respond to it. The prejudice is, we didn't have a
20 chance to ask their expert about it. Petitioner tried to introduce that
21 document in the first deposition at the end, clearly beyond the scope of
22 direct examination. They hadn't made any arguments about the document at
23 that point. Patent Owner had no opportunity to depose the expert on it. And
24 then Petitioner didn't file the document with its reply. Again, we couldn't do
25 anything with the -- questioning the petitioner on it.

1 The irony that Petitioner is pointing out that we're relying on this
2 document, we're relying on the arguments made in the previous petitions.
3 You could take that from the document if you want or not. The issue is that
4 document includes 30 pages of testimony on all kinds of issues. And Patent
5 Owner was not presented with an opportunity to depose the expert on any of
6 that. The petitioner should not be allowed to rely on it now here in this
7 deposition, it's prejudice. Thank you.

8 JUDGE MAJORS: Okay. Thank you.

9 All right. Thank you both for your presentations today. And I will
10 just say thank you for your professionalism through this family of cases.
11 The panel has appreciated the presentations today, the arguments that you've
12 made. We're going to take them under advisement and we will issue final
13 written decisions in due course.

14 I would ask Counsel to briefly hang behind and help our court reporter
15 if they have any questions about spellings or any missed words.

16 And with all that, we're adjourned.

17 (Whereupon, the above-entitled matter went off the record at 11:06
18 a.m.)

IPR2025-00728 (Patent 11,844,921 B2)
IPR2025-00989 (Patent 11,865,291 B2)

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