

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

INSTRUMENTATION LABORATORY COMPANY,
Petitioner,

v.

HEMOSONICS LLC,
Patent Owner.

PGR2019-00033
Patent 9,977,039 B2

Before JO-ANNE M. KOKOSKI, KRISTINA M. KALAN, and
JEFFREY W. ABRAHAM, *Administrative Patent Judges*.

ABRAHAM, *Administrative Patent Judge*.

DECISION
Denying Petitioner's Request for Rehearing
37 C.F.R. § 42.71(d)

I. INTRODUCTION

Instrumentation Laboratory Company (“Petitioner”) filed a Petition requesting post-grant review of claims 1, 4, 26, 36, 51, 52, and 55 of U.S. Patent No. 9,977,039 B2 (“the ’039 patent,” Ex. 1001). Paper 1 (“Pet.”). HemoSonics LLC (“Patent Owner”) filed a Patent Owner Preliminary Response to the Petition. Paper 7 (“Prelim. Resp.”). On August 23, 2019, we issued a Decision denying institution of *inter partes* review. Paper 8 (“Dec.”).

Petitioner filed a Request for Rehearing and Request to Enter New Exhibits in response to our Decision denying institution of *inter partes* review. Paper 9 (“Rehearing Request” or “Req. Reh’g”). For the reasons that follow, Petitioner’s Rehearing Request is *denied*.

II. STANDARD OF REVIEW

The party challenging a decision in a request for rehearing bears the burden of showing the decision should be modified. 37 C.F.R. § 42.71(d) (2019). A request for rehearing “must specifically identify all matters the party believes the Board misapprehended or overlooked, and the place where each matter was previously addressed.” *Id.* When rehearing a decision on a petition, the decision will be reviewed for an abuse of discretion. *Id.* at § 42.71(c).

III. DISCUSSION

a. Evidence Regarding Written Description Support for Claims 4, 36, and 55

Claims 4, 36, and 55 depend from claims 1, 26, and 52, respectively, and require that a portion of the thermally conductive wall recited in the independent claims comprises “a thermally conductive polymer that has a thermal conductivity that exceeds 0.123 W/m °K.” Ex. 1001, 4:21–24

(claim 4), 23:30–33 (claim 36), 26:19–22 (claim 55). Petitioner contends that we “manifestly misapprehended” Petitioner’s evidence that claims 4, 36, and 55 lack support in the ’039 patent specification. Req. Reh’g 2–3. The evidence in question is the following statement by Dr. LaDuca, Petitioner’s declarant, which Petitioner quoted in the Petition:

92. . . . there is no mention of such a measure in the ’039 patent specification, much less any disclosure of a specific value or range of thermal conductivity. Any given plastic, including those disclosed in the ’039 patent specification, exhibits a wide variability of thermal conductivity in final form based on the injection molding or extrusion thereof. (Hansen D., Bernier G; Thermal conductivity of polyethylene: The effects of crystal size, density and orientation on thermal conductivity. Polymer Engineering and Science, 1972).

Req. Reh’g 2–3 (emphases omitted); Pet. 63 (quoting Ex. 1002 ¶ 92).

Petitioner presents two reasons why we purportedly misapprehended this evidence.

Petitioner first argues that we made our determination “on the assumption that Petitioner’s only argument was that the claims did not recite the claimed invention *in haec verba*.” Req. Reh’g 3. We disagree that we made any such assumption in our Decision. In our Decision, we addressed not only Petitioner’s argument that claims 4, 36, and 55 “state a threshold nowhere stated in the ’039 patent specification,” but also Petitioner’s argument that “the ’039 patent specification does not clearly disclose to a [person of ordinary skill in the art] that the inventors considered the claimed range to be part of their invention.” Pet. 62. In response to the latter argument, we referred to the disclosure of Styron 666 and E1201 in the ’039 patent, as well as a statement by Dr. LaDuca acknowledging that a person of ordinary skill in the art would have understood that there were many

polymers that may meet the claimed range of thermal conductivity. Dec. 15 (citing Ex. 1001, 8:5–54; Ex. 2015 ¶¶ 56–58; Ex. 1002 ¶ 90).

Petitioner next argues that we misapprehended Petitioner’s evidence because we “concluded that Petitioner ‘overlooked the disclosure of specific materials.’” Req. Reh’g 3. Petitioner argues that it did not “overlook” the disclosure of Styron 666 and E1201 in the ’039 patent specification based on the sentence in paragraph 92 of Dr. LaDuca’s Declaration that begins with “Any given plastic, including those disclosed in the ’039 patent” Req. Reh’g 2.

It is true that in the Decision we stated “Petitioner *appears* to have overlooked the disclosure of specific materials in the ’039 patent specification that the inventors considered acceptable for use in practicing the claimed invention, namely Styron 666 and E1201.” Dec. 15 (emphasis added). We included that statement based on Petitioner’s failure to address thermal conductivity values of the commercially available plastics identified by name in the ’039 patent specification, including Styron 666 and E1201. In paragraph 92 of his declaration, Dr. LaDuca did not include a citation to the ’039 patent specification, so it was not clear what the general reference to “[a]ny given plastic, including those disclosed in the ’039 patent” included. This is especially true considering the ’039 patent refers to “plastics” in general (*e.g.*, Ex. 1001, 12:11–12), and provides several specific examples of suitable plastics (*e.g.*, Ex. 1001, 8:5–30, 9:51–56).

Nevertheless, we did not misapprehend Dr. LaDuca’s broader statement that “[a]ny given plastic . . . exhibits a wide variability of thermal conductivity in final form based on the injection molding or extrusion thereof.” Pet. 63. Since that statement includes all plastics, the conclusion

Dr. LaDuca and Petitioner draw from it, and our consideration of it, necessarily included the specific plastics expressly disclosed in the '039 patent. Although we considered this statement, we did not find it to be persuasive evidence that there was a lack of written description support for claims 4, 36, and 55.

As we stated in our Decision, Petitioner had the burden of proving that at least one of these claims failed to satisfy the written description requirement of 35 U.S.C. § 112(a). Dec. 8. The only argument and evidence Petitioner presents, other than the lack of an express disclosure of a thermal conductivity value, is Dr. LaDuca's statement that thermal conductivity of a plastic can vary widely. As we noted in the Decision, however, Dr. LaDuca also states that "[t]here are many polymers that may meet the open-ended range of thermal conductivity which may be suitable or unsuitable for molding (e.g., depending on the selected interrogation means)." Ex. 1002 ¶ 90. Given the broad range disclosed in the claims—a thermal conductivity exceeding 0.123 W/m °K—we determined that Dr. LaDuca's statement that thermal conductivity values can vary widely, along with the statement that many polymers may meet the claimed range of thermal conductivity, did not provide adequate support for Petitioner's assertion that there is no written description support for claims 4, 36, and 55 in the '039 patent specification. As such, we did not misapprehend Petitioner's evidence. Rather, in view of the lack of sufficient evidence from Petitioner, we determined that Petitioner failed to show sufficiently that claims 4, 36, and 55 lack written description support in the '039 patent.

In addition to its argument that we misapprehended Petitioner's evidence, Petitioner also allocates several pages toward discrediting Patent

Owner's evidence regarding the thermal conductivity value of Styron 666. Req. Reh'g 4–7. In particular, Petitioner argues that Exhibit 2017 is “unreliable on its face and unacceptable to support” Patent Owner's arguments. Req. Reh'g 4. Petitioner also argues that to the extent Exhibit 2017 creates a genuine issue of material fact, we must resolve that issue in favor of Petitioner. Req. Reh'g 4–5.

Petitioner's arguments here are unavailing. First, Petitioner's Rehearing Request is premised on our alleged misapprehension of *Petitioner's* evidence. Req. Reh'g 2. Because Exhibit 2017 is not part of Petitioner's evidence, it is not relevant to our inquiry of whether we misapprehended Petitioner's evidence, and, therefore, whether we should grant Petitioner's Rehearing Request. Second, we did not rely on Exhibit 2017 in our Decision, so Petitioner's arguments are moot.

Patent Owner also seeks to introduce new rebuttal exhibits and arguments addressing the thermal conductivity of Styron 666. Req. Reh'g 7–9. The rule governing a rehearing request permits “[a] party dissatisfied with a decision . . . [to] file *a single request for rehearing* without prior authorization from the Board.” 37 C.F.R. § 42.71(d) (emphasis added). This rule does not address explicitly whether the requesting party also may file new evidence with its rehearing request. The *Office Patent Trial Practice Guide*, 77 Fed. Reg. 48,756 (Aug. 14, 2012) (“*Practice Guide*”), however, is instructive on this matter. When discussing general procedures applicable to rehearing requests, the *Practice Guide* states that “[e]vidence not already of record at the time of the decision will not be admitted absent a showing of *good cause*.” *Id.* at 48,768 (emphasis added). A party may argue good cause exists in the rehearing request itself.

Although Petitioner does not expressly state that good cause exists in its Rehearing Request, Petitioner does reference its prior request for leave to file a reply to Patent Owner's Preliminary Response, as well as Exhibits 1014 and 1015. In Exhibit 1015,¹ Petitioner argued good cause exists for allowing Petitioner to submit a reply brief addressing, *inter alia*, whether claims 4, 36, and 55 lack enablement and written description support in general, and, more specifically, addressing Exhibit 2017 and the thermal conductivity of Styron 666. Ex. 1015, 1–2. In both Exhibit 1015 and its Rehearing Request, Petitioner raises similar arguments regarding why good cause exists to allow Petitioner to address these issues. For example, in both documents, Petitioner argues that if a genuine issue of material fact is created by testimonial evidence, the issue will be resolved in favor of Petitioner, and that Exhibit 2017 is unreliable and inadmissible. *Compare* Ex. 1015, 2 with Req. Reh'g 4–5.

We are not persuaded that good cause exists to allow Petitioner to supplement the record at this point with new arguments and evidence regarding a lack of written description support for claims 4, 36, and 55, the thermal conductivity of Styron 666, or the reliability and admissibility of Exhibit 2017. As noted above, we did not rely on Exhibit 2017 in our Decision, so there is no need for additional evidence or arguments addressing that exhibit. Further, we determined that Petitioner had the burden to establish that claims 4, 36, and 55 lack written description support, and failed to provide evidence sufficient to meet that burden in the Petition. We view Petitioner's request to introduce new evidence in its Rehearing

¹ Ex. 1015 is an email chain that includes the email submitted as Ex. 1014. Therefore, we refer only to Ex. 1015.

Request as an attempt to supplement the written description analysis presented in the Petition.² A request for rehearing is not a supplemental petition. Nor is it an opportunity to present new arguments or evidence that could have been presented and developed in the first instance in the Petition. For example, Petitioner had the opportunity in the Petition to present evidence regarding the thermal conductivity value of Styron 666, but chose not to.³ Consequently, we deny Petitioner's request to submit rebuttal exhibits, and we exercise our authority under 37 C.F.R. § 42.7(a) to expunge Exhibits 1016–1023.

² We denied Petitioner's request to file a reply to Patent Owner's Preliminary Response for the same reason. In contesting Petitioner's request for a reply, Patent Owner argued that "Petitioner included a perfunctory analysis concerning written description and enablement spanning a few pages in its Petition. Petitioner apparently seeks a reply to supplement its analysis in an attempt to bolster its Petition." Ex. 1015, 2. We generally agreed with Patent Owner, and denied Petitioner's request. Ex. 1015, 1. We did so without conducting a telephone conference because both Petitioner and Patent Owner indicated that no call was necessary to address whether Petitioner had shown good cause for allowing Petitioner to file a reply. Ex. 1015, 1–2.

³ Notably, Petitioner acknowledges that "data sourced from C-MOLD *circa* 1992 and DOW *circa* 1993 teaches a thermal conductivity of 0.15 W/m °K" for Styron 666D. Req. Reh'g 8. Although Petitioner presents this evidence as contradicting Exhibit 2017 (because it is "**not 0.123 W/m °K**"), claims 4, 36, and 55 require a polymer with a thermal conductivity that *exceeds* 0.123 W/m °K. Req. Reh'g 8; *see, e.g.*, Ex. 1001, 20:21–24 (claim 4). Thus, the evidence Petitioner seeks to introduce suggests that a person of ordinary skill in the art would have known that Styron 666D had a thermal conductivity exceeding 0.123 W/m °K, thereby undermining Petitioner's argument that these claims lack written description support in the '039 patent specification.

*b. Alleged Erroneous Interpretation of the Law
in Evaluating Written Description*

Petitioner argues that we “misconstrued the law relative to disclosure of non-acoustic methods of interrogation applied to the structure recited in the claims” of the ’039 patent. Req. Reh’g 1. We disagree for the reasons discussed below.

Petitioner asserts that our reasoning in the Decision “represents an erroneous interpretation of the law” because we purportedly made “assertions that the chamber in the ’039 patent could hypothetically accommodate various testing techniques.” Req. Reh’g 9–10. Petitioner’s characterization that our Decision was based on what the chamber in the ’039 patent “could hypothetically accommodate” or what a person of skill in the art “might be able to construct” from the teachings of the patent is incorrect. To the contrary, our Decision discussed and cited to portions of the ’039 patent specification disclosing features and tests that convey to a person of ordinary skill in the art that “the inventors had possession of test chambers designed for more than just acoustic interrogation.” Dec. 13. Contrary to Petitioner’s assertion, our determination that the chambers in the ’039 patent specification are designed for more than just acoustic interrogation was not hypothetical.

Petitioner also argues that we “overlooked the Petition where it recited viscoelastic methods (*i.e.*, TEG and ROTEM) as an example which ‘require[s] experimentation and creativity beyond a POSA’s abilities.’” Req. Reh’g 10 (citing Pet. 61–62). Petitioner is incorrect. First, Petitioner’s argument is based on an incomplete quote taken from the Petition and Dr. LaDuca’s declaration. The full quote from Dr. LaDuca is “the design of a cartridge device and test chambers for a particular interrogation technique

may require experimentation and creativity beyond a POSAs abilities.” Pet. 61 (emphasis added). Second, although Petitioner relies upon this quote for arguments regarding written description in the Rehearing Request, Petitioner originally presented the quote in the Petition in support of Petitioner’s arguments regarding enablement. Pet. 61. Finally, we directly addressed this language in the Decision on pages 20 and 21, citing the aforementioned sentence and noting that Dr. LaDuca’s opinions “do not allow us to determine exactly what kind of experimentation would be necessary, whether it would be routine, or whether it would be extensive, and if so, how extensive.” Dec. 21.

Additionally, in the Request for Rehearing, Petitioner presents new arguments under the guise that we erroneously interpreted the law. For example, Petitioner argues that “the ‘039 patent specification both criticizes and distinguishes over TEG and ROTEM techniques thereby evidencing a lack of possession.” Req. Reh’g 10 (citing *Anascape, Ltd. v. Nintendo of Am., Inc.*, 601 F.3d 1333 (Fed. Cir. 2010); *Tronzo v. Biomet, Inc.*, 156 F.3d 1154 (Fed. Cir. 1998)). Petitioner does not direct us to where this argument appears in the Petition, and we were unable to find any mention of *Anascape* or *Tronzo* in the Petition. In view of this, we could not have overlooked or misapprehended the holding in these cases or Petitioner’s argument regarding TEG and ROTEM techniques. See 37 C.F.R. § 42.71(d).

Petitioner also argues for the first time in the Rehearing Request that the challenged claims “rely on functional language to claim a genus” and that “the ‘039 patent specification does not disclose a representative number of species nor does the specification teach structural features common to the

members of the genus.” Req. Reh’g 11–12. Although Petitioner refers to “functional claiming” frequently in the Petition, and argues the challenged claims are broad, we were unable to find any argument in the Petition that the claims are genus claims or that the ’039 patent fails to disclose a representative number of species. Nor has Petitioner directed us to such arguments in the Petition.

Moreover, in the Rehearing Request, Petitioner cites to language in *Ariad Pharmaceuticals, Inc. v. Eli Lilly and Co.*, 598 F.3d 1336, 1349–1350 (Fed. Cir. 2010) that is not cited or expressly relied upon in the Petition. Instead, Petitioner improperly attempts to use our citation to *Ariad* in the Decision (for general legal principles regarding written description) as an opportunity to present new arguments on the issue of genus/species claims. See Req. Reh’g 10–11 (citing only Dec. 9–10 in the discussion of our purported failure to correctly apply *Ariad*). As we stated above, a request for rehearing is not an opportunity to present new arguments or evidence that could have been presented and developed in the first instance in the Petition.

Petitioner also argues that we overlooked certain arguments in the Petition, which, “if considered under *Ariad Pharmaceuticals*, support a finding of a lack of Written Description support.” Req. Reh’g 11–12. These arguments include Petitioner’s contention that the ’039 patent specification discloses only a chamber specifically structured for acoustic interrogation, and, as a result, its contention that the claims are invalid because they expand beyond Patent Owner’s contribution of an acoustically-interrogated multiple-assay cartridge. Req. Reh’g 12.

Contrary to Petitioner's assertions, we did not overlook these arguments. In fact, we addressed directly Petitioner's arguments that the claims are overly broad because the '039 patent fails to disclose a chamber structured for anything other than acoustic interrogation (Dec. 10), and presented our reasons why we determined Petitioner's arguments were not persuasive (Dec. 12–13).

c. Conclusion

For all of the foregoing reasons, we are not persuaded that we misapprehended Petitioner's evidence that claims 4, 36, and 55 lack support in the '039 patent specification, or that we have misconstrued the law relative to the disclosure of non-acoustic methods of interrogation applied to the structure recited in the claims of the '039 patent.

IV. ORDER

Accordingly, it is

ORDERED that Petitioner's Request for Rehearing is *denied*, and
FURTHER ORDERED that Exhibits 1016–1023 are expunged.

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