

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MICROSURGICAL TECHNOLOGY, INC.,
Petitioner,

v.

THE REGENTS OF THE UNIVERSITY OF COLORADO,
Patent Owner.

PGR2021-00026
Patent 10,786,391 B2

Before LYNNE H. BROWNE, TIMOTHY J. GOODSON, and
JAMIE T. WISZ, *Administrative Patent Judges*.

WISZ, *Administrative Patent Judge*.

DECISION

Denying Petitioner's Request on Rehearing of Decision on Institution
37 C.F.R. § 42.71(d)

I. INTRODUCTION

MicroSurgical Technology, Inc. (“Petitioner”) requests rehearing of the Board’s Decision (Paper 12) (“Decision”) denying institution of post-grant review of claims 1–20 (“the challenged claims”) of U.S. Patent No. 10,786,391 B2 (Ex. 1001, “the ’391 patent”). Paper 13 (“Request for Rehearing” or “Req. Reh’g”). For the reasons that follow, Petitioner’s Request for Rehearing is *denied*.

II. ANALYSIS

Pursuant to 37 C.F.R. § 42.71(d):

A party dissatisfied with a decision may file a single request for rehearing without prior authorization from the Board. The burden of showing a decision should be modified lies with the party challenging the decision. The request must specifically identify all matters the party believes the Board misapprehended or overlooked, and the place where each matter was previously addressed in a motion, an opposition, or a reply.

When reconsidering a decision on institution, we review the decision for an abuse of discretion. 37 C.F.R. § 42.71(c). An abuse of discretion exists where a “decision [i]s based on an erroneous conclusion of law or clearly erroneous factual findings, or . . . a clear error of judgment.” *PPG Indus. Inc. v. Celanese Polymer Specialties Co.*, 840 F.2d 1565, 1567 (Fed. Cir. 1988). A rehearing request is not an opportunity for the requesting party to reargue its case or merely to express disagreement with the underlying decision. Nor is it an opportunity for the moving party to present new arguments that were not in its original submissions.

Petitioner contends that we (1) erred in according the challenged claims the benefit of the priority date of U.S. Provisional Application No. 61/637,611 (“the ’611 provisional”) and (2) improperly shifted the

burden to Petitioner in violation of *Dynamic Drinkware v. Nat'l Graphics, Inc.*, 800 F.3d 1375 (Fed. Cir. 2015). Req. Reh'g 1–11. We consider Petitioner's arguments below.

A. Priority Date of the Challenged Claims

According to Petitioner, our conclusion that claims 1–20 of the '391 patent have written description support in the '611 provisional should be reconsidered because “it depends solely on the clearly erroneous finding that a ‘line/border between the sides and top of the distal member’ (as the Board construed the term ‘edge’) extends rearward from the distal end of the tip of the device disclosed in the '611 Provisional.”” Req. Reh'g 1. Petitioner asserts that the “beveled platform 5 . . . does not embody a ‘line/border between the sides and top’ on either the right or left side of the device tip” because “[t]he beveled nature of these elements defies the identification of a singular line/border between the sides and top that runs contiguously rearward from the distalmost end of the ‘a first end/ beveled platform tip/ insertion blade tip 6.’” *Id.* at 4.

Petitioner further contends that we erroneously relied on figures provided by Patent Owner that masked the “true surfaces of the beveled tip and falsely portrays an ‘edge’ according to the Board’s construction” and that “[t]he figures in the '391 patent and '611 Provisional make clear that no singular ‘line/border between the sides and top’ may be found on either the right or left side that runs contiguously rearward from the distalmost end of the ‘first end/ beveled platform tip/ insertion blade tip 6.’” Req. Reh'g 4, 6. According to Petitioner, “[t]o the extent that the Board’s construction of the term ‘edge’ does not require a singular ‘line/border between the sides and top,’ then the beveled device tip as construed must manifest multiple edges,

which contravenes the recitations of ‘a right edge’ and ‘a left edge’ in the Challenged Claims.” *Id.* at 6.

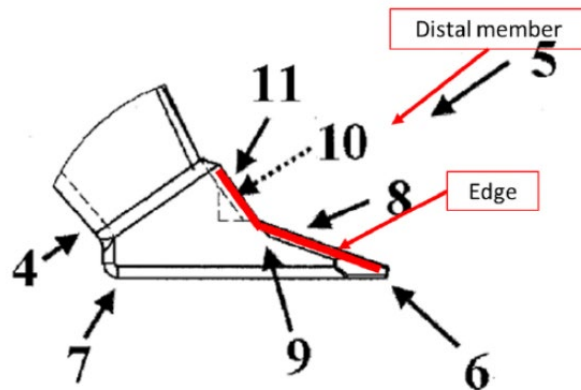
Petitioner also argues that there is no support in the ’611 provisional for the limitation that the width between the right and left edges increases as they extend rearward. Req. Reh’g 6. According to Petitioner, Patent Owner’s arguments regarding the width “are based on the same faulty annotated drawings that mask the fact that the tip of the distal member is beveled and thus has no ‘edge.’” *Id.* at 7.

We find these argument unpersuasive in showing an abuse of discretion. We construed the term “edge” to mean “the line/border between the sides and top of the distal member.” Decision 9–13. As stated in our Decision, this construction is consistent with the Specification and claims of the ’391 patent which require that the “right edge” and “left edge” “extend[] towards the rearward end from the tip.” *Id.* at 11 (citing Ex. 1001, 3:58–60, 25:35–36, 26:43–44).

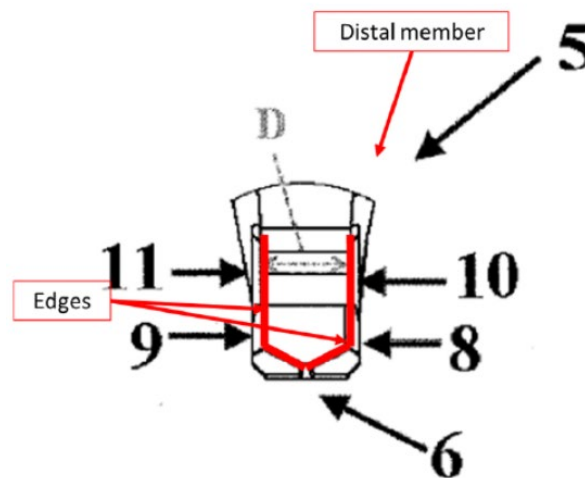
Petitioner has not shown that we erred in finding that a singular line/border (and thus an edge) runs rearward from the distalmost end of the “first end/ beveled platform tip/ insertion blade tip 6.” As our Decision states, although the adopted claim construction of “edge” “requires edges that encompass two different portions of the distal member (i.e., the lateral elements/cutting blades and the ramp), as Petitioner acknowledged, ‘the ’391 Patent figures all consistently show the tip, ramp and lateral elements sequentially adjoined along the lateral direction,’” thus forming a line/border between the sides and top of the distal member. Decision 13 (citing Pet. 17 (citing Ex. 1001, Figs. 4, 8–19)).

Further, as discussed in our Decision, we found support for such edges in the '611 provisional application:

The '611 provisional application discloses a first side (8) and a second side (9) of the beveled platform (5)/distal member wherein the first lateral blade (10) and the second lateral blade (11) are “along the sides of said beveled platform.” Ex. 1007, 38. As shown in the annotated figures below, the '611 provisional application depicts right and left edges, which are the lines/borders between the sides (8, 9) and top of the distal member, wherein these edges extend towards the rearward end from the tip (6).



Ex.1007 ('611 provisional), Fig. 1 (enlarged, annotated)

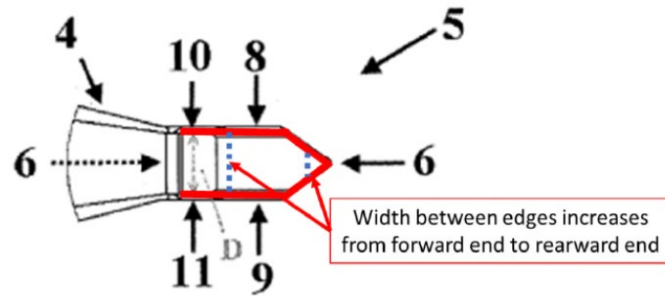


Ex.1007 ('611 provisional), Fig. 3 (enlarged, annotated)

Decision 39–40 (citing Prelim. Resp. 21, 45–46 (citing Ex. 1007, Figs. 1, 3)). Annotated Figures 1 and 3 include added lines and labels indicating the edges of the distal member.

Petitioner’s argument appears to hinge on the contention that the beveled nature of the platform prevents it from being an edge. *See* Req. Reh’g 4, 6. However, Petitioner provides no persuasive arguments or evidence for this contention. We understand that Petitioner disagrees with the Board’s assessment, but simple disagreement is not effective to demonstrate an abuse of discretion.

Because there was no clear error in our finding that the ’611 provisional application discloses a continuous edge that runs rearward from the distalmost end of the “first end/ beveled platform tip/ insertion blade tip 6,” there is also no clear error in finding that the ’611 provisional application supports the width limitations. As stated in our Decision, the edges shown in the annotated figure below have a width between them that increases as they extend rearward.



Ex.1007 ('611 provisional), Fig. 6 (enlarged, annotated)

Decision 40 (citing Prelim. Resp. 22, 52 (citing Ex. 1007, Fig. 6)). The annotated figure above includes added lines demarcating the edges and a label indicating that the width between the edges increases from the forward end to the rearward end. Petitioner contends that Patent Owner only argued that the ramp, and not the tip, increases in width. *See* Req. Reh’g 7 (citing Prelim. Resp. 51). However, the ramp is part of the distal member so an increase in width of the ramp provides evidence of an increase in width between the right and left edges as they extend rearward.

Thus, Petitioner has not demonstrated that we erred in finding that claims 1–2, 4–9, 11–14, 16–17, and 19–20¹ of the ’391 patent have written description support in the ’611 provisional.

B. Burden Shifting

Petitioner also contends that “[t]he Board’s denial of institution was also based on an erroneous conclusion of law that misapprehended the two different burdens of proof—persuasion and production—in a post grant review that a petitioner and a patent owner must satisfy.” Req. Reh’g 8

¹ Our Decision found that at least one of disclaimed claims 3, 10, 15, or 18 cannot claim priority to the ’611 provisional. Decision 24.

(citing *Dynamic Drinkware*, 800 F.3d 1375). According to Petitioner, “Petitioner satisfied its burden of production by coming forward with Baerveldt, whose February 16, 2017 priority date predates the November 8, 2019 filing date of the ’391 patent.” *Id.* at 9. Petitioner contends that the “burden then should have shifted to Patent Owner to establish whether the ’391 patent can claim priority to the ’611 provisional.” *Id.* at 10 (citing *Dynamic Drinkware*, 800 F.3d at 1379–80; *In re NTP, Inc.*, 654 F.3d 1268, 1276 (Fed. Cir. 2011)).

Petitioner further argues that “Patent Owner failed to establish that it could actually claim priority to the ’611 provisional, or any other priority application, and thus the burden never shifted back to Petitioner.” Req. Reh’g 10. According to Petitioner:

Patent Owner focused only on three claim terms (only the terms raised by Petitioner) and only contended that these terms were supported by the ’391 patent disclosure and offered certain conclusory remarks that disclosures in certain prior applications—other than the ’611 Provisional application—when viewed “in combination with” the new matter that was added late during prosecution of the ’391 patent also provide support.

Id. at 10–11 (citing Prelim. Resp. 60–66). Petitioner concludes that “Patent Owner thus failed to demonstrate that the Challenged Claims find support in the ’611 Provisional or any other priority application” and that “the Board effectively presumed priority and erroneously shifted the burden with respect to the effective filing date of the ’391 patent to Petitioner.” *Id.* at 11.

We are not persuaded by Petitioner’s arguments. Contrary to Petitioner’s assertions, Patent Owner’s arguments regarding the claim terms raised by Petitioner were not limited to only showing support in the ’391 patent. In fact, Patent Owner’s Preliminary Response discusses in detail

where these claim terms are supported in the '611 provisional application. *See* Prelim. Resp. 12–24, 39–41, 43–59.

We also disagree with Petitioner's contention that Patent Owner only provided "conclusory remarks" that the challenged claims were supported by priority applications other than the '611 provisional. Req. Reh'g 11. For example, the Preliminary Response discusses how the challenged claim terms are supported by U.S. Patent No. 15/207,329 ("the '329 application"). *See* Prelim. Resp. 24–27, 61, 63–64. Further, as noted in our Decision, Patent Owner also submitted a claim chart providing exemplary excerpts from the '611 provisional, the '329 application, and the '391 patent to establish support for all elements of several exemplary challenged claims. *See* Decision 26 n.4 (citing Prelim. Resp., Appx. A).

Petitioner has not demonstrated that we improperly shifted the burden to Petitioner. Instead, we concluded that the record before us supported Patent Owner's contention that the non-disclaimed '391 patent claims should receive priority to the '611 provisional application. Decision 42.

III. CONCLUSION

For the reasons given, Petitioner has not demonstrated that we abused our discretion in denying institution of a post-grant review of claims 1–20 of the '391 patent.

IV. ORDER

Accordingly, it is

ORDERED that Petitioner's Request for Rehearing is *denied*.

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