

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

THE GILLETTE COMPANY LLC,
Petitioner,

v.

SPHERE USA, LLC,
Patent Owner.

PGR2022-00030
Patent 11,235,486 B2

Before HUBERT C. LORIN, HYUN J. JUNG and JAMES J. MAYBERRY,
Administrative Patent Judges.

MAYBERRY, *Administrative Patent Judge.*

DECISION
Granting Institution of Post-Grant Review
35 U.S.C. § 324

I. INTRODUCTION

The Gillette Company LLC (“Petitioner”) filed a Petition requesting a post-grant review of claims 1–20 (the “Challenged Claims”) of U.S. Patent No. 11,235,486 B2 (Ex. 1001, the “’486 patent”). Paper 1, 1 (“Pet.” or “Petition”). Sphere USA, LLC (“Patent Owner”) filed a Preliminary Response. Paper 7 (“Prelim. Resp.”).

We may not institute a post-grant review “unless . . . the information presented in the petition filed under section 321, if such information is not rebutted, would demonstrate that it is more likely than not that at least 1 of the claims challenged in the petition is unpatentable.” 35 U.S.C. § 324(a) (2011). Upon consideration of the arguments and evidence, we determine Petitioner has demonstrated that it is more likely than not that at least one of the Challenged Claims is unpatentable. Accordingly, we institute a post-grant review of the Challenged Claims of the ’486 patent.

A. Real Parties in Interest

Petitioner and Patent Owner state that they are the real parties-in-interest. Pet. 4; Paper 5, 1.

B. Related Matters

Petitioner and Patent Owner state that there are no related matters. Pet. 4; Paper 5, 1.

C. The ’486 Patent

The ’486 patent, titled “Razor with Cutting Blade Rotatable About Multiple Axes,” issued February 1, 2022, from U.S. Application 15/849,118 (the “’118 application”), filed December 20, 2017. Ex. 1001, codes (54), (45), (21), (22). The face of the patent indicates that the ’118 application is a continuation of U.S. Application 14/266,913 (the “’913 application” or

“parent application”), filed on May 1, 2014, now U.S. Patent 9,889,572, which itself is a continuation of U.S. Application 13/030,752 (the “’752 application” or “grandparent application”), filed February 18, 2011, now U.S. Patent 8,720,072. *Id.* at code (63). The face of the ’486 patent also indicates that the ’118 application claims priority to provisional application 61/372,662, filed August 11, 2010. *Id.* at code (60).

The '486 patent is directed “to a razor with blade holder that is pivotable around three axes.” Ex. 1001, 1:21–22. We reproduce Figure 1, below. *Id.* at 3:8–10.

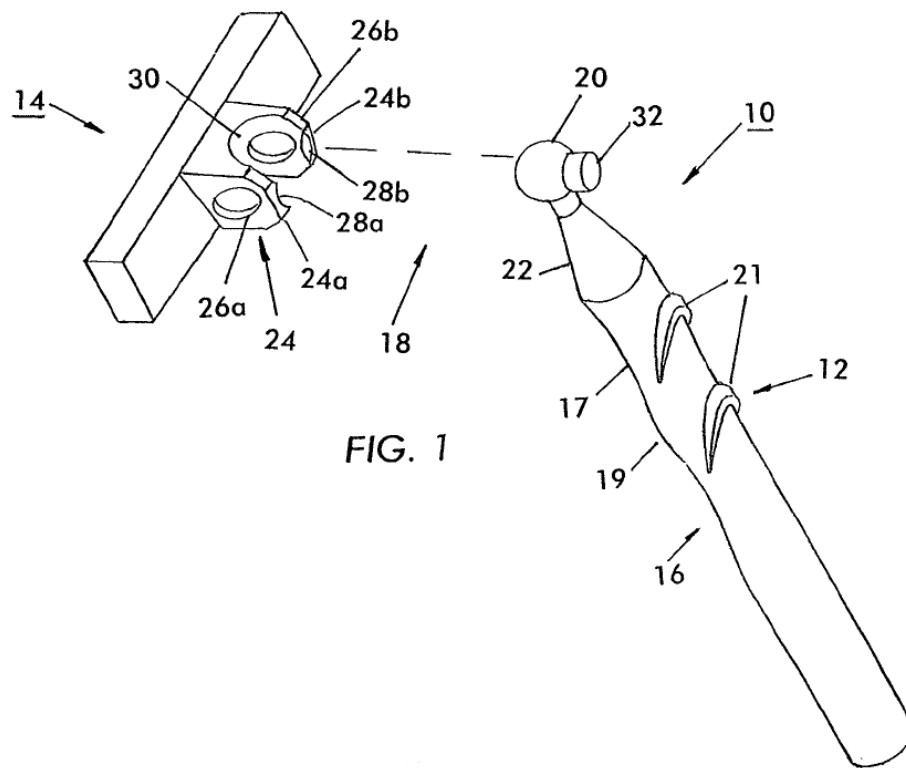


Figure 1 depicts an exploded assembly view of a razor according to an exemplary embodiment, in which a blade cartridge is separated from the handle along the phantom line. Ex. 1001, 2:64–67; 3:8–12. Razor 10 includes handle 12 having gripping portion 16, and blade cartridge 14

pivotally connected to handle 12. *Id.* at 3:11–13. A first end of handle 12 includes pivot sphere 20, which is secured to the handle or is part of the handle. *Id.* at 3:32–33. In the embodiment of Figure 1, pivot sphere 20 is mounted to handle 12 at the end of arm 22. *Id.* at 3:51–52. “One manner of mounting the arm 22 may be substantially perpendicular to the axis of the handle 12, approximating a ‘T’-shape between the handle 12 and the arm 22.” *Id.* at 3:65–67. “Other configurations, e.g., ‘C’, ‘J’, ‘L’, ‘Y’-shaped combinations of handle 12 and arm 22, are clearly conceivable within the scope of the instant disclosure.” *Id.* at 4:1–3.

Blade cartridge 14 includes clevis 24 for pivotably securing the blade cartridge to pivot sphere 20. *Id.* at 4:4–5. Clevis 24 has two opposed legs 24a, 24b, each having a respective hole 26a, 26b, which are depicted in Figure 1 as through holes. *Id.* at 4:6–8. Holes 26a, 26b are sized and spaced such that when clevis 24 is connected to pivot sphere 20, it is retained thereon so that cartridge 14 holds its orientation with respect to handle 12 at rest, yet pivots freely under any applied pressure. *Id.* at 4:10–20. Clevis 24 includes one or more relief portions 28a, 28b that are generally spherical sections, and guide and ease the interface between pivot sphere 20 and clevis 24 upon assembly. *Id.* at 4:48–54.

Although blade cartridge 14 freely moves around three axes of the handle, the ’486 patent discloses that it may be desirable to limit the range of motion of blade cartridge 14 to avoid extreme orientations by providing stop 32. *Id.* at 5:4–11. Stop 32 may be formed integrally with pivot sphere 20, or as a separate structure. *Id.* at 5:14–16. The ’486 patent explains that stop 32 largely inhibits the lateral rotation of blade cartridge

14, while also enabling blade cartridge 14 to rotate freely about its transverse axis, to “lift its head.” *Id.* at 5:30–32.

D. Challenged Claims

Petitioner challenges the patentability of claims 1–20 of the ’486 patent. Pet. 1, 6. Claims 1, 10, and 16 are independent. Ex. 1001, 5:60–7:23. Independent claim 1 is illustrative, and reproduced below.

1. A personal grooming apparatus, comprising:

a handle having a gripping portion and an attachment portion, the attachment portion including a pivot member having an at least partially spheroid portion; and

a cartridge supporting at least one cutting blade;

wherein rotation of the cartridge is enabled by retention of the pivot member between spaced-apart ends of two opposed legs, the pivot member of the attachment portion pivotably held between the spaced-apart ends of the two opposed legs; and

a stop extending outward from the at least partially spheroid portion of the pivot member and configured to limit rotation of the cartridge when the cartridge is mounted on the attachment portion;

wherein the stop is configured to limit rotation of the cartridge by interacting with a relief portion of at least one of the two opposed legs.

Id. at 5:60–6:9. Independent claim 10 differs from claim 1 in that it is directed to the razor handle, and recites “the pivot member capable of removably attaching a cartridge supporting at least one cutting blade.” *Id.* at 6:36–49. Independent claim 16 differs from claim 1 in that it recites “the attachment portion supporting a pivot member providing a removable attachment to the cartridge.” *Id.* at 6:66–7:13.

E. Asserted Grounds of Unpatentability

Petitioner asserts that the Challenged Claims are unpatentable on the following six grounds (Pet. 7):

Claim(s) Challenged	35 U.S.C. §	Reference(s)/Basis
1, 2, 4–16, 18–20	112	Written description
1, 2, 4–16, 18–20	112	Enablement
1, 2, 4–16, 18–20	102	Bucco ¹
1–3, 5–11, 14–17, 19, 20	102	Otten ²
4, 12, 13, 18	103	Otten, Metcalf, ³ Gray ⁴
5, 14, 19	103	Otten

In addition to other evidence, Petitioner relies on declaration testimony of Mr. Evan Pennell (Ex. 1002) in support of these grounds. In addition to other evidence, Patent Owner relies on declaration testimony of Dr. Glenn E. Vallee (Ex. 2009) to support its preliminary response.

The following subsections provide a brief description of the asserted prior art references.

1. Bucco

Bucco is titled “Razor with Three-Axis Multi-Position Capability,” published June 16, 2011, from the ’752 application, and is the grandparent of the ’486 patent. Ex. 1003, codes (54), (43), (21). According to Patent Owner, “[t]he content of the ’752 Application and the ’486 Patent contain the same specification and drawings, except for the title and the priority

¹ US Pub. 2011/0138637 A1, published June 16, 2011 (Ex. 1003, “Bucco”).

² DE 20 2006 011 254 U1, published January 11, 2007 (Ex. 1004). We refer to the certified English translation (Ex. 1005, “Otten”).

³ US 5,890,296, issued April 6, 1999 (Ex. 1006, “Metcalf”).

⁴ US D444,267 S, issued June 26, 2001 (Ex. 1007, “Gray”).

claim.” Prelim. Resp. 54 (citing Ex. 2001, 159, 169–176). Petitioner agrees that “[t]he ’486 patent shares the same disclosure as Bucco.” Pet. 58.

2. Otten

Otten is titled “Wet Shaving System.” Ex. 1005, code (54). Otten relates to “a safety razor system comprising a handle and a replaceable blade block.” *Id.* ¶ 1. Otten discloses that the blade block is pivotally mounted “in order to better follow the contours of the skin during shaving.” *Id.* ¶ 2. We reproduce Otten’s Figure 2, below.

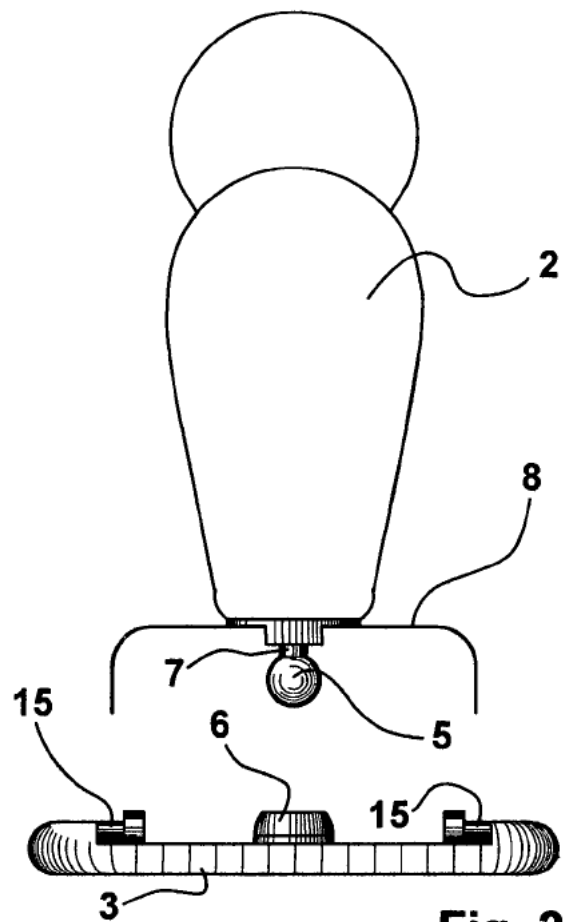


Figure 2 depicts a front view of a safety shaving system in an unassembled state. Ex. 1005 ¶ 6. Otten’s shaving apparatus includes handle 2 and blade block 3, which are connected to one another by a ball

joint having joint ball 5, which is part of handle 2, and joint socket 6, which is part of blade block 3. *Id.* ¶ 12. As depicted in Figure 2, joint ball 5 is connected to the handle 2 by cylindrical connecting element 7. A more detailed view of blade block 3 is depicted in Figure 4, reproduced below.

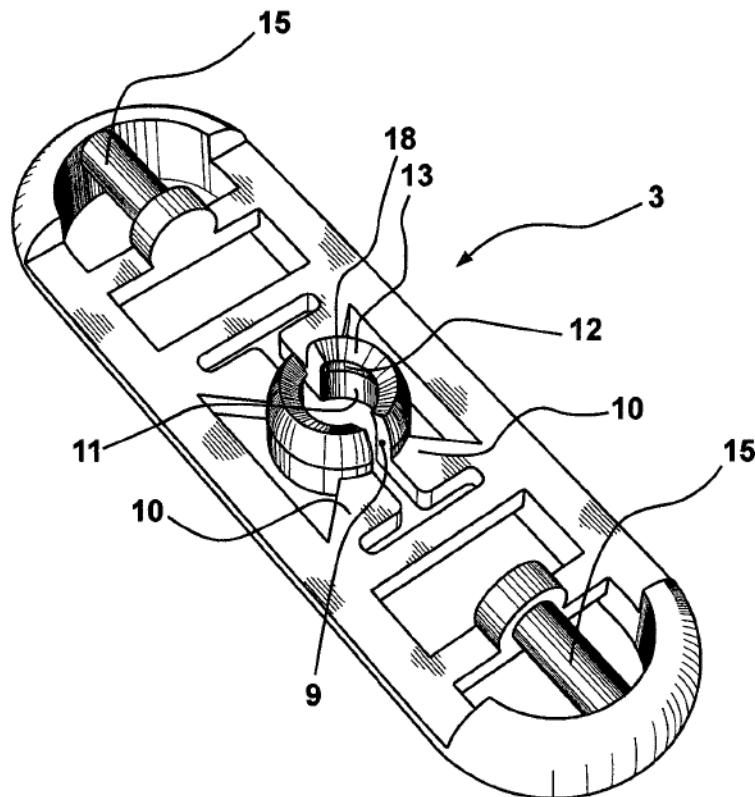


Fig. 4

Figure 4 is a perspective view of the blade block from above.
Ex. 1005 ¶ 8. As depicted in Figure 4, the wall of joint socket 6 has two slots 9 that divide the joint socket into two parts which are each flexibly connected to blade block 3 by two arms 10. *Id.* ¶ 12. The inner wall of joint socket 6 has cylindrical lower part 11, and spherically shaped upper part 12, which has a diameter slightly larger than that of the joint ball. *Id.* Otten explains that assembly of the shaving apparatus includes pressing joint ball 5

of the handle into funnel-shaped part 13 of joint socket 6, which causes the two halves of joint socket 6 to diverge. *Id.* ¶ 14. After joint ball 5 passes upper opening 18 of the joint socket, the two halves of joint socket 6 spring back and enclose the joint ball. *Id.*

3. Metcalf

Metcalf is titled “Razor Handle,” and is directed to “shaving razors having handles and replaceable cartridges.” Ex. 1006, code (54), 1:9–10. Relevant to Petitioner’s unpatentability contentions, Metcalf discloses features of the handle depicted, for example, in Figure 3, reproduced below.

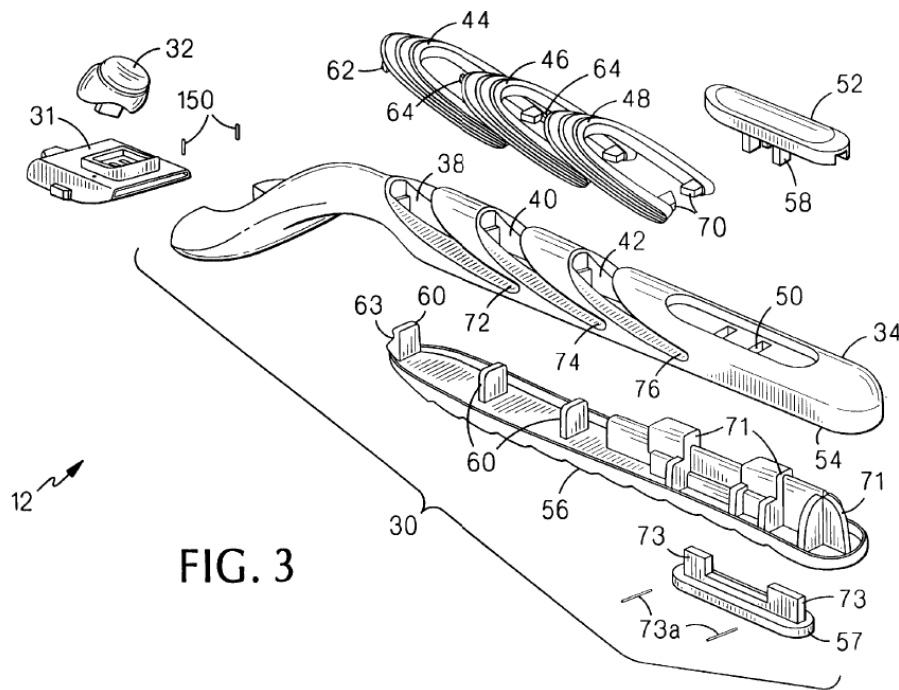


Figure 3 depicts an exploded view of the components of the handle. *Id.* at 3:42–43. Metcalf discloses that handle 12 is part of shaving razor 10 that also includes replaceable shaving cartridge 14. *Id.* at 4:9–10. Handle 12 includes elongated hand gripping structure 30 that connects to

cartridge 14 via connecting subassembly 31 and button 32. *Id.* at 4:30–33. Elongated hand gripping structure 30 has metal frame 34, which includes upper, crescent-shaped gripping pads 44, 46, 48 and lower gripping pad 56. *Id.* at 4:33–44. The upper and lower gripping pads provide a hand-gripping structure that is “made of an elastomeric plastic outer gripping layer (e.g., thermoplastic elastomer) and a nonelastomeric plastic support layer (e.g., of polypropylene or acrylonitrile butadiene styrene) thereunder made by two-color molding.” *Id.* at 4:46–51.

4. *Gray*

Gray is titled “Razor Handle,” and relates to the “ornamental design for a razor handle.” Ex. 1007, codes (54), (57). Figures 4 and 8 of Gray are reproduced below.

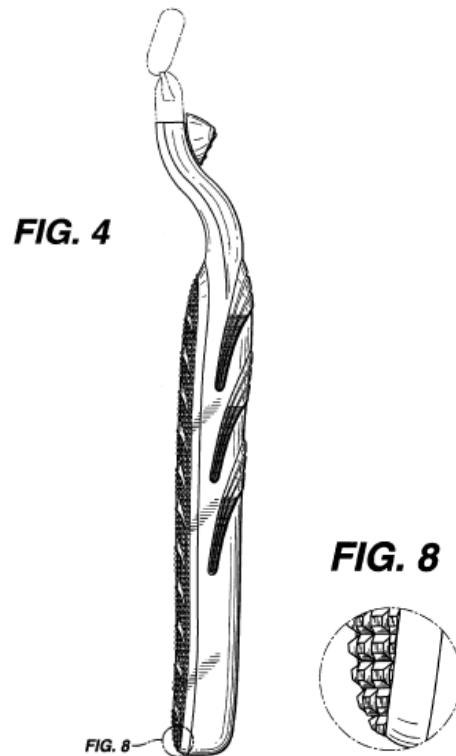


Figure 4 is a left side elevational view of Gray’s design for a razor handle and Figure 8 is a side view of the portion of the design identified in

Figure 4 shown separately and on an enlarged scale for clarity of illustration.
Ex. 1007, 1.

II. POST-GRANT REVIEW ELIGIBILITY

As a threshold issue, we must determine if the '486 patent is eligible for post-grant review. The post-grant review provisions of the America Invents Act (AIA) apply to a patent that contains a claim with an effective filing date on or after March 16, 2013. *See* AIA, Pub. L. No. 112-29, 125 Stat. 284 (2011), §§ 3(n)(1), 6(f)(2)(A). The statute defines the “effective filing date” as

(A) if subparagraph (B) does not apply, the actual filing date of the patent or the application for the patent containing a claim to the invention; or

(B) the filing date of the earliest application for which the patent is entitled, as to such invention, to a right of priority under section 119, 365(a), 365(b), 386(a), or 386(b) or to the benefit of an earlier filing date under section 120, 121, 365(c), or 386(c).

35 U.S.C. § 100(i)(1).

Determining whether a patent is subject to the first-inventor-to-file provisions of the AIA, and therefore eligible for post-grant review, is straightforward when the patentee filed the application from which the patent issued on or after March 16, 2013, without any priority claim to an application filed prior to March 16, 2013. Here, however, the application that matured into the '486 patent makes a priority claim to an application filed February 18, 2011, the grandparent application. Ex. 1001, code (63). In addition, the '486 patent claims priority to a provisional application filed on August 11, 2010. *Id.* at code (60). Accordingly, the effective filing date

of the '486 patent may be as early as August 11, 2010, which brings the eligibility for post-grant review into question.⁵

As a further requirement, “[a] petition for a post-grant review may only be filed not later than the date that is 9 months after the date of the grant of the patent.” 35 U.S.C. § 321(c). The '486 patent issued February 1, 2022, and the Petition was accorded a filing date of March 24, 2022, less than two months after the grant of the '486 patent. Ex. 1001, code (45); Paper 4, 1. Accordingly, Petitioner timely filed the Petition.

A. Written Description Support for Claims 1, 2, 4–16, and 18–20 in the Grandparent Application

Petitioner asserts that the '486 patent's grandparent application does not provide adequate written description support for claims 1, 2, 4–16, and 18–20, and that these claims are entitled to an effective filing date of no earlier than December 20, 2017, the filing date of the '118 application. Pet. 29. And, because at least one claim of the '486 patent has an effective filing date after March 16, 2013, Petitioner contends that the '486 patent is eligible for post-grant review. *Id.* at 6.

The written description inquiry is a question of fact, is context-specific, and must be determined on a case-by-case basis. *Ariad Pharm.*,

⁵ We need not address whether the claims of the '486 patent have written description support in the provisional application filed on August 11, 2010. If the grandparent application provides adequate written description support for all of the claims of the '486 patent, then the '486 patent is not eligible for a post-grant review. If the grandparent application does not provide adequate written description support for any claim of the '486 patent, then the provisional application could not cure the inadequacy, even if the provisional application provided adequate disclosure. In that scenario, the grandparent application would have broken the chain of disclosure.

Inc. v. Eli Lilly & Co., 598 F.3d 1336, 1351 (Fed. Cir. 2010) (en banc). The test for sufficiency of support is whether the disclosure of the application relied upon “reasonably conveys to the artisan that the inventor had possession at that time of the later claimed subject matter.” *Vas-Cath Inc. v. Mahurkar*, 935 F.2d 1555, 1563 (Fed. Cir. 1991). “One shows that one is ‘in possession’ of *the invention* by describing *the invention*, with all its claimed limitations.” *Lockwood v. Am. Airlines, Inc.*, 107 F.3d 1565, 1572 (Fed. Cir. 1997). Of course, in some instances, a patentee can rely on information that is well known in the art to satisfy the written description requirement. *Ariad Pharm.*, 598 F.3d at 1351 (“[T]he level of detail required to satisfy the written description requirement varies depending on the nature and scope of the claims and on the complexity and predictability of the relevant technology.”). Also, “drawings alone *may* be sufficient to provide the ‘written description of the invention’ required by § 112.” *Vas-Cath Inc.*, 935 F.2d at 1564. Still, “the test requires an objective inquiry into the four corners of the specification from the perspective of a person of ordinary skill in the art. Based on that inquiry, the specification must describe an invention understandable to that skilled artisan and show that the inventor actually invented the invention claimed.” *Ariad Pharms.*, 598 F.3d at 1351.

To assess the priority claim of the ’486 patent, we must first construe the relevant claim terms. *See X2Y Attenuators, LLC v. Int’l Trade Comm’n*, 757 F.3d 1358, 1365 (Fed. Cir. 2014) (“Where the claims have not been properly construed, the full scope of the claim is unknown, thereby rendering baseless any determination of written support in an earlier patent.”). Once we construe the relevant claim terms (and determine the

relevant level of ordinary skill), we must next determine if the grandparent application disclosure “describ[es] *the invention*, with all its claimed limitations,” *Lockwood*, 107 F.3d at 1572, to show “possession of the claimed subject matter as of the filing date,” *Ariad Pharm.*, 598 F.3d at 1351.

1. Level of Ordinary Skill in the Art

The level of skill in the art is “a prism or lens” through which we view the prior art and the claimed invention. *Okajima v. Bourdeau*, 261 F.3d 1350, 1355 (Fed. Cir. 2001). Petitioner contends a person of ordinary skill in the art “as of the grandparent application’s filing date (February 18, 2011), through the filing date of the ’486 patent claims (December 20, 2017), possessed at least an undergraduate degree in mechanical engineering and about two years of industry experience, or equivalent experience.” Pet. 21–22 (referencing Ex. 1002 ¶ 51). Petitioner asserts that the relevant field is “razors and personal grooming devices.” *Id.* at 21 (referencing Ex. 1002 ¶ 51).

Patent Owner offers a similar definition and states that “a person of ordinary skill in the art (‘POSA’) in 2010–2011 would have a bachelor’s degree in mechanical engineering, or its equivalent, with approximately two years of design experience in the field of consumer products.” Prelim. Resp. 5 (citing Ex. 2009 ¶ 31). As such, Patent Owner’s definition differs from Petitioner’s definition in what constitutes the relevant field of the ’486 patent.

For the purposes of this Decision, we adopt Petitioner’s proposed level of ordinary skill in the art. We determine that Petitioner’s definition is more consistent with the prior art of record, and the skill reflected in the

Specification of the '486 patent, based on our review of the limited record. Specifically, we preliminarily find that the field of “consumer products,” as proposed by Patent Owner, is too broad, based on our review of the limited record before us, including the prior art of record, which is directed to razors and personal grooming devices. *See* Exs. 1003; 1005–1007; 1010; 1011; 2003–2007; 2010–2015.

We note, however, that our conclusions in this Decision would not change if we applied Patent Owner’s definition of the level of ordinary skill.

2. *Claim Construction*

In post-grant reviews, we interpret a claim “using the same claim construction standard that would be used to construe the claim in a civil action under 35 U.S.C. 282(b).” 37 C.F.R. § 42.200(b) (2022). Under this standard, we construe the claim “in accordance with the ordinary and customary meaning of such claim as understood by one of ordinary skill in the art and the prosecution history pertaining to the patent.” *Id.*

Petitioner provides express constructions for two claim terms: 1) the terms in each of the independent claims reciting the relationship between the pivot member and two opposed legs,⁶ (the “pivot member placement” terms) and 2) the term “holes,” which appears in claim 7. Pet. 23–29. Patent Owner provides express constructions for the terms in each of the

⁶ Claim 1 includes the recitation “the pivot member of the attachment portion pivotably held between the spaced-apart ends of the two opposed legs.” Ex. 1001, 5:67–6:2. Claim 10 includes the recitation “wherein the pivot member includes an at least partially spheroid portion configured to be held between spaced-apart ends of two opposed legs.” *Id.* at 6:41–43. Claim 16 similarly recites “wherein the pivot member includes an at least partially spheroid portion that is configured to be held between spaced-apart ends of two opposed legs.” *Id.* at 7:5–7.

independent claims reciting the relationship between the pivot member and two opposed legs, and the term “cartridge.”

The pivot member placement terms are central to our written description analysis. *See* Pet. 30; Prelim. Resp. 33. Petitioner proposes that we construe the pivot member placement terms to mean “that the handle can include ***not only*** the pivot member ***but also*** the two opposed legs.” Pet. 28; *see also id.* at 24–28 (providing Petitioner’s contentions with respect to this construction). That is, Petitioner contends that the terms are broad enough to encompass structure where the two opposed legs are not on the cartridge. *See id.* at 24–28.

Patent Owner proposes that we construe the pivot member placement terms to mean “[t]he interface between the handle and cartridge frame includes a pivot member retained/held between spaced-apart ends of two opposed legs.” Prelim. Resp. 11. Patent Owner contends that the ’486 patent discloses that the pivot member and two opposed legs are connected at an interface, with the pivot member and two opposed legs forming the structural portions of the interface. *Id.* at 12.

Regardless of the parties’ proposed constructions, the parties do not dispute that the pivot member placement terms encompass embodiments beyond the embodiment illustrated in Figure 1 of the ’486 patent. *See, e.g.,* Pet. 30–31 (“All . . . claims [other than claims 3 and 17] are necessarily broad enough to encompass a handle that includes the two opposed legs.”); Prelim. Resp. 49 (depicting embodiment where the two opposing legs are on a clevis attached to the handle).

“The Board is required to construe ‘only those terms . . . that are in controversy, and only to the extent necessary to resolve the controversy.’”

Realtime Data, LLC v. Iancu, 912 F.3d 1368, 1375 (Fed. Cir. 2019) (quoting *Vivid Techs., Inc. v. Am. Sci. & Eng’g, Inc.*, 200 F.3d 795, 803 (Fed. Cir. 1999)). Accordingly, for the purposes of this Decision, we construe the pivot member placement terms to encompass embodiments beyond the embodiment illustrated in Figure 1 of the ’486 patent.

We also determine, on the current record, that we need not construe any other claim term to resolve the parties’ dispute at this stage of the proceeding. *See Realtime Data, LLC*, 912 F.3d at 1375.

3. *Petitioner’s Contentions – Written Description Support for Claims 1, 2, 4–16, and 18–20 in the Grandparent Application*

Petitioner contends that “except for a few dependent claims, the ’486 patent claims encompass subject matter neither described in earlier applications nor possessed by the inventor any earlier than the December 20, 2017, filing date of the ’118 application.” Pet. 30. Petitioner contends that the grandparent application does not “suggest to a person of ordinary skill in the art that the inventor had possession of a razor whose handle includes both the two opposed legs *and* the pivot sphere.” *Id.* at 31 (referencing Ex. 1002 ¶ 67). As such, the inventor did not possess the full scope of claims 1, 2, 4–16, and 18–20. *Id.*

First, Petitioner contends that all of the claims require the pivot member to be on the handle, and that, in such a case, the written description supports only the two opposed legs on the cartridge. Pet. 31–32 (referencing independent claim language and Ex. 1002 ¶ 68).

Next, Petitioner contends that the specification of the grandparent application describes the pivot member on the handle and the opposed legs on the cartridge, and that the connection between the handle and cartridge is

essential to permit rotational movement around at least two axes. Pet. 32–33 (referencing Ex. 1003 ¶¶ 7, 23, 25; Ex. 1002 ¶ 69).

Next, Petitioner contends that the specification from the grandparent application describes the two opposed legs as part of a clevis, and the claims do not recite a clevis. Pet. 33 (referencing Ex. 1002 ¶ 70). Petitioner asserts that a person having ordinary skill in the art reading the specification from the grandparent application “would have understood that the inventors were only in possession of a grooming apparatus in which a pivot member is held by two opposed legs of a clevis (or a clevis-like) U-shaped structure.” *Id.*

Next, Petitioner contends that the grandparent application describes a stop member on the pivot sphere, and that this member interacts with the cartridge’s legs to limit rotation. Pet. 33–34 (referencing Ex. 1003 ¶¶ 29, 31, and code (57) (Abstract); Ex. 1002 ¶ 71). Petitioner directs us to Figure 2 of the grandparent application, “which merely shows a handle’s pivot member formed by ‘deforming a spherical section into a plane,’ permitting stops to replace the removed sections of the sphere.” *Id.* at 34 (quoting Ex. 1003 ¶ 31).

Finally, Petitioner directs us to three Federal Circuit cases with facts that Petitioner contends “closely parallel” the facts in this proceeding. Pet. 35–37 (discussing *D Three Enterprises LLC v. SunModo Corp.*, 890 F.3d 1042 (Fed. Cir. 2018); *Gentry Gallery, Inc. v. Berkline Corp.*, 134 F.3d 1473 (Fed. Cir. 1998); *Tronzo v. Biomet, Inc.*, 156 F.3d 1154 (Fed. Cir. 1998)). Petitioner concludes that, “[a]s was true in these Federal Circuit cases, Mr. Bucco’s grandparent application discloses only one, non-generic embodiment of an invention—a handle’s pivot member attaching to two opposed legs of a cartridge’s clevis.” *Id.* at 37 (referencing Ex. 1002 ¶ 72).

Petitioner adds that a “person having ordinary skill in the art would not conclude that Mr. Bucco possessed, or that his grandparent application disclosed, an embodiment whereby the legs and the pivot member are both on the handle, and the cartridge is attached by some undisclosed means,” and that these three cases compel such a conclusion. *Id.*

4. *Patent Owner’s Contentions – Written Description Support for Claims 1, 2, 4–16, and 18–20 in the Grandparent Application*

Patent Owner responds that the disclosure in the grandparent application⁷ supports the full scope of claims 1, 2, 4–16, and 18–20. Prelim. Resp. 34. First, Patent Owner argues that *in haec verba* support for the claims is not required. *Id.* at 34–35. Patent Owner argues that a specification need not describe “every conceivable and possible future embodiment of [the] invention.” *Id.* at 34 (quoting *Cordis Corp. v. Medtronic AVE, Inc.*, 339 F.3d 1352, 1365 (Fed. Cir. 2003)). Patent Owner argues that, contrary to Petitioner’s urging, “[l]iteral and express description of every possible permutation encompassed by the claims . . . is not the correct standard for written description.” *Id.* at 35. Patent Owner argues that Petitioner treats a person having ordinary skill in the art as an automaton. *Id.*

Next, Patent Owner argues that a person having ordinary skill in the art is a person of ordinary creativity, and that “common practices require

⁷ Throughout Patent Owner’s arguments, Patent Owner often refers to the ’486 patent Specification describing certain aspects of the invention, or arguing what a person having ordinary skill in the art would have understood from a description in the ’486 patent, without reference to the grandparent application. We understand, however, Patent Owner to argue that these descriptions are present in the grandparent application, which is the relevant disclosure for our eligibility inquiry.

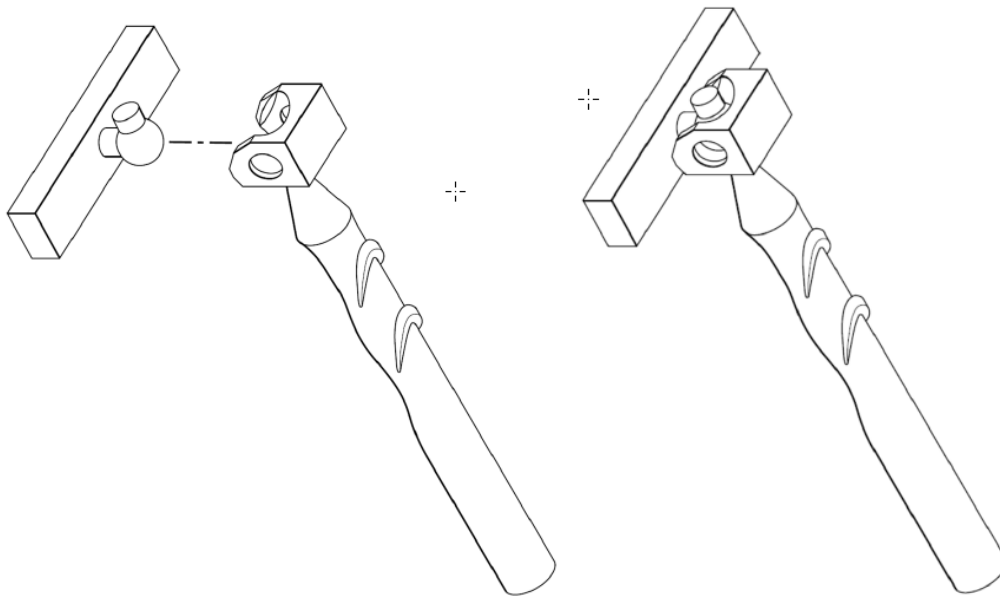
only ordinary skill in the art, and are considered routine design expedients.” Prelim. Resp. 38 (citing MPEP § 2144.04). Patent Owner argues that “[s]uch practices are intrinsic to the disclosure, and inform the understanding of what a disclosure conveys to the skilled artisan, for purposes of written description.” *Id.* (citing *In re Wallach*, 378 F.3d 1330, 1334 (Fed. Cir. 2004)).

Next, Patent Owner argues that the handle body, pivot member, and two opposed legs represent a sub-combination that achieves the purpose of the ’486 patent. Prelim. Resp. 46. Patent Owner argues that “[p]ossession of that sub-combination by the inventor is apparent from the” grandparent application disclosure. *Id.* (referencing Ex. 1002 ¶ 85). Patent Owner argues that the central purpose of the structures disclosed in the grandparent application is to “provid[e] ‘a pivot [member] upon which the [detachable] blade cartridge is rotatably mounted, with freedom to pivot around [multiple] axes of the handle, and otherwise hold[] its orientation relative to the handle.’” *Id.* at 47 (citing *Scriptpro, LLC v. Innovation Assocs., Inc.*, 762 F.3d 1355 (Fed. Cir. 2014)). Patent Owner argues that an artisan of ordinary skill would have “immediately discern[ed] that mounting the opposed legs on the cartridge is merely ancillary to that purpose.” *Id.* (referencing Ex. 1002 ¶ 88). Patent Owner adds that, when assembled, the opposed legs 24a, 24b, are on the handle in the embodiment of Figure 1. *Id.* at 48 (referencing Ex. 1002 ¶ 84).

Patent Owner argues that the disclosure of the specification also indicates that the inventor was in possession of more than the embodiment of Figure 1. Prelim. Resp. 48. Patent Owner argues that the embodiment of Figure 1 is “exemplary.” *Id.* Patent Owner’s declarant opines that a person

having ordinary skill in the art “can readily envision [variants of Figure 1] without specific details in the specification regarding the variants of the interface as depicted.” *Id.* (quoting Ex. 2009 ¶ 85).

Next, Patent Owner identifies reversing the interface is one variant that is not expressly disclosed but which constitutes a “routine practice requiring only ordinary skill,” thus conveying possession of the embodiment. Prelim. Resp. 49 (referencing Ex. 2009 ¶¶ 85, 88–90). We reproduce Patent Owner’s two depictions of this embodiment below.



Id. at 49–50. The image at the left depicts a razor similar to that of Figure 1 of the grandparent application, except that the pivot member is mounted to the cartridge and the clevis, with two opposed legs, is mounted on the handle, with a phantom line showing that the pivot member fits into the clevis between the opposed legs. As such, the locations of the pivot member and clevis are reversed from their positions in Figure 1 of the grandparent application. The image at the right depicts the pivot member within the clevis between the opposed legs. Patent Owner argues that “[i]n this variant,

as with the exemplary embodiment of F[igure] 1, both the pivot member and the opposed legs are ‘on’ the handle when the razor is assembled.” *Id.* at 50.

Patent Owner argues that “reversal of parts is a generally common practice requiring only ordinary skill, and a routine design expedient.” Prelim. Resp. 51 (citing MPEP § 2144.04(VI)(A)). Patent Owner argues that the written description requirement of 35 U.S.C. § 112 “‘does not require a description of all of the variations which might suggest themselves to one versed in the art,’ such as ‘mere reversal of parts.’” *Id.* (quoting *Sears, Roebuck & Co. v. Jones*, 308 F.2d 705 (10th Cir. 1962)).

Patent Owner argues that the disclosure of “T-shaped” and “Y-shaped” configurations between handle 12 and arm 22 supports a finding that the grandparent application discloses the reversal embodiment. Prelim. Resp. 51–52 (referencing Ex. 1001, 3:65–4:3; Ex. 2009 ¶ 87). Patent Owner argues that these “shapes evoke, for one skilled in the art, the structure resulting if the clevis 24 is mounted on the end of the handle 12, instead of the pivot member 20.” *Id.* at 52; *see also id.* (showing images of a clevis mounted at the end of the handle).

Patent Owner also argues that reversing the pivot member and opposed legs represents a “design choice” that “is regularly considered as part of evaluating a design in the relevant art.” Prelim. Resp. 53 (referencing Ex. 2009 ¶¶ 90, 105). Patent Owner directs us to disclosure in Otten, that describes that the position of its joint socket and joint ball can be switched between the handle and cartridge. *Id.* at 53–54; *see also id.* at 54 (identifying prior art that depicts a ball on the razor head and socket on the handle, which is reverse from other prior art razors).

Next, Patent Owner argues that the specification of the grandparent application conveys possession of an embodiment where the cartridge is separable from the opposed legs. Prelim. Resp. 55–56. Patent Owner directs us to language in the specification, which states that the advantages of the exemplary embodiment of Figure 1 “does not exclude an additional point of separation . . . in connection with blade cartridge 14.” *Id.* at 55 (quoting Ex. 1001, 4:60–63); *see id.* at 56 (providing a depiction of an embodiment (not depicted in the grandparent application) with a cartridge separable from the clevis).

Next, Patent Owner argues that including the two opposed legs as part of a clevis is not critical to the invention. Prelim. Resp. 56–60. Patent Owner argues that the specification does not indicate that the clevis is a critical component. *Id.* at 55. Patent Owner also argues that the specification describes that the opposed legs can be formed by injection molding integrally with the frame of the cartridge. *Id.* at 59; *see also id.* at 60 (depicting Patent Owner’s conception of opposed legs formed in the cartridge without a clevis).

Finally, Patent Owner distinguishes the three cases upon which Petitioner relies. Prelim. Resp. 39–45.

5. *Analysis*

For the reasons discussed below, we determine, on the current record, that the grandparent application does not provide written description support for the full scope of at least one claim of the ’486 patent. Specifically, we preliminarily find that the reversal embodiment encompassed in the scope of the pivot member placement limitations is not adequately described in the

grandparent application to convey to a person having ordinary skill in the art that the inventor was in possession of this embodiment.

We find the facts in *D Three Enterprises LLC v. SunModo Corp.*, which Petitioner cites, closely parallel the facts in this proceeding. *See* Pet. 35. In *SunModo*, two separate written description issues arose, one associated with “washerless claims” and one associated with “washer claims.” *SunModo*, 890 F.3d at 1047–52. The washerless claims recited an “attachment bracket” broadly. *Id.* at 1047–48. The court found that the priority application at issue disclosed one embodiment that was washerless. *Id.* at 1050. The court then agreed with the district court that only one attachment bracket—a bracket with W-shaped prongs—was disclosed in the patent, and that the specification did not provide adequate written description support for the more broadly claimed attachment bracket. *Id.*

For the washer claims, the court found that the claims covered configurations with the washer below the flashing or either above or below the flashing. *SunModo*, 890 F.3d at 1052. The court agreed with the district court that the specification did not provide written description support for these claims, as the specification supported only a configuration with the washer above the flashing. *Id.*

Like in *SunModo*, the grandparent application expressly discloses the opposed legs attached to the cartridge and the pivot member attached to the arm of the handle only. The grandparent application does not describe the opposed legs as part of the handle. Nor does the application state that the position of the opposed legs and pivot member are flexible, such that they could be reversed. On the limited record before us, the lack of any disclosure in support of Patent Owner’s reversal of parts embodiment is fatal

to Patent Owner's position. *Cf. SunModo*, 890 F.3d at 1052 ("The lack of any disclosure of an assembly with a washer below the flashing, or statement on the flexibility of the position of the washer, is fatal to D Three's argument.").

We have considered Patent Owner's arguments and determine, on the current record, that they do not demonstrate a deficiency in Petitioner's position. First, Patent Owner's argument that reversal of parts is generally common practice within the level of ordinary skill goes to the obviousness of rearranging parts to reach what is now claimed, rather than the adequacy of the written description of what is now claimed. *Cf. Lockwood*, 107 F.3d at 1572:

The question is not whether a claimed invention is an obvious variant of that which is disclosed in the specification. Rather, a prior application itself must describe an invention, and do so in sufficient detail that one skilled in the art can clearly conclude that the inventor invented the claimed invention as of the filing date sought. . . . One shows that one is "in possession" of the invention by describing the *invention*, with all its claimed limitations, not that which makes it obvious.

Tellingly, Patent Owner relies, at least in part, on MPEP Section 2144.04. But this section is part of the MPEP directed to obviousness, not written description. *See* MPEP § 2144 ("Supporting a Rejection Under 35 U.S.C. 103"). Patent Owner's reliance on the MPEP's examining guidelines for written description is also unavailing. *See* Prelim. Resp. 50–51 (citing MPEP § 2163(II)(A)(3)(a), and quoting "If a skilled artisan would have understood the inventor to be in possession of the claimed invention at the time of filing, even if every nuance of the claims is not explicitly described in the specification, then the adequate description requirement is met."). We preliminarily find that reversing the locations of

the pivot member and opposed legs from those locations disclosed in the only embodiment described in detail in the specification represents more than a “nuance” of the claims. Instead, it represents a departure from the disclosed embodiment of Figure 1, a departure with no support in the actual written description in the grandparent application.

Patent Owner’s reliance on *Sears, Roebuck* is also unavailing. *See* Prelim. Resp. 51 (citing *Sears, Roebuck & Co. v. Jones*, 308 F.2d 705, 707–708 (10th Cir. 1962)). The appellate court⁸ affirmed the district court’s finding that reversing parts constituted an equivalence under the doctrine of equivalence aspect of patent infringement. *See Sears, Roebuck*, 308 F.2d at 707. The appellate court then affirmed the district court’s finding that a broad claim that covers an embodiment not expressly disclosed in the patent was still adequately supported, based, at least in part, on the affirmance of the equivalence of the reversed parts. *Id.* at 707–708. “[D]etermining whether a patent complies with the written description requirement,” however, “will necessarily vary depending on the context.” *Ariad Pharms.*, 598 F.3d at 1351. The level of detail required in one instance may be insufficient in another.

In *Sears, Roebuck*, for example, the claim at issue (claim 5) was part of the originally-filed application. *See Jones v. Sears, Roebuck & Co.*, 187 F. Supp. 293, 297 (D. Colo. 1960), *aff’d*, 308 F.2d 705 (10th Cir. 1962) (“It is apparent from the file history of the Jones patent in suit that Jones’ present claim 5 was originally claim 26 of the Jones’ patent application.”). As such,

⁸ *Sears, Roebuck* is from the U.S. Court of Appeals for the 10th Circuit, as the decision is prior to the advent of the U.S. Court of Appeals for the Federal Circuit.

the claim itself was part of the disclosure, which the district court found captured what the inventor had earlier conceived and reduced to practice. *See id.*; *see also id.* (explaining that a manufacturer took a license covering the alleged unsupported embodiment). Our record does not indicate that the language of the challenged independent claims was present in the grandparent application as filed, or provide any other persuasive evidence that the reversed orientation of the pivot member and two opposed legs was recognized by persons having ordinary skill in the art. These factual distinctions make the decision in *Sears, Roebuck* inapposite, given our current record.

On the current record, Patent Owner’s reliance on the specification’s disclosure of “T” and “Y” shaped arms does not demonstrate a deficiency in Petitioner’s position with respect to the reversal embodiment. The specification of the grandparent application clearly states that the “T” and “Y” shapes represent the configuration between handle 12 and arm 22. Ex. 1003 ¶ 22. In contrast, Patent Owner and its declarant argue that the structure that would receive the pivot member—the two opposed legs—form a “T” or “Y” shape *with the end of the arm*. Prelim. Resp. 52; Ex. 2009 ¶¶ 86–87. Also, Patent Owner argues that the “T” or “Y” shape “evokes” a structure where the clevis is at the end of arm 22 of handle 12. Prelim. Resp. 52. Dr. Vallee declares that the disclosure “suggests” reversal of parts. Ex. 2009 ¶ 86. Again, these arguments sound more in obviousness than in adequacy of written description. *Cf. In re Bell*, 991 F.2d 781, 783 (Fed. Cir. 1993) (“A prima facie case of obviousness is established when the teachings from the prior art itself would appear to have suggested the

claimed subject matter to a person of ordinary skill in the art.” (quoting *In re Rinehart*, 531 F.2d 1048, 1051, 189 USPQ 143, 147 (CCPA 1976)).

Equally unavailing is Patent Owner’s argument that “[t]hose skilled in the art would consider reversal of the interface an intrinsic design choice for the disclosure of the” grandparent application. Prelim. Resp. 53. Again, design choice is an obviousness concept. *Cf. Uber Techs., Inc. v. X One, Inc.*, 957 F.3d 1334, 1338–40 (Fed. Cir. 2020) (considering design choice in support of an obviousness argument).

Patent Owner’s reliance on the prior art, particularly Otten, showing reversal of ball and socket interfaces fails to demonstrate a deficiency in Petitioner’s position. Tellingly, as Patent Owner recognizes, Otten *expressly* discloses that its ball and socket interface can be reversed between the cartridge and handle. *See* Prelim. Resp. 54 (referencing Ex. 1005, 3 (¶ 20)). The grandparent application at issue here makes no such express disclosure. *See Lockwood*, 107 F.3d at 1572 (“[It] is not sufficient for purposes of the written description requirement of §112 that the disclosure, when combined with the knowledge in the art, would lead one to speculate as to modifications that the inventor might have envisioned, but failed to disclose.”). Otten’s express disclosure at least suggests, on the current record, that a person having ordinary skill in the art would not have appreciated that disclosing a ball on a handle and socket on a cartridge of a razor discloses the reverse configuration.

Finally, Patent Owner’s attempt to distinguish *SunModo* is unavailing. Patent Owner argues that the priority application at issue in *SunModo*

explicitly stated the criticality of placing a washer above the flashing.⁹ *See* Prelim. Resp. 40–42. Patent Owner reads too much into the priority application’s disclosure. Although the application states that placing the washer between core 1908 and flashing 1903 “helps to prevent water from getting under flashing 1902,” the disclosure does not state that placing the washer under the flashing would not prevent water from getting under the flashing. *See id.* at 42 (quoting Ex. 2008, 41). Tellingly, the Federal Circuit did not rely on the criticality of the position of the washer in reaching its decision. *See SunModo*, 890 F.3d at 1052 (“The lack of any disclosure of an assembly with a washer below the flashing, or statement on the flexibility of the position of the washer, is fatal to D Three’s argument.”).¹⁰

6. *Conclusions*

For the reasons discussed above, we find, on the current record, that the grandparent application does not provide adequate written description of the full scope of at least one of the claims of the ’486 patent, that is, embodiments beyond the embodiment depicted in Figure 1 of the ’486 patent. Specifically, we preliminarily find that the grandparent application does not provide adequate written description of the reversal embodiment, encompassed in the scope of the pivot member placement limitations.

⁹ Patent Owner, like Petitioner, only addresses *SunModo*’s treatment of the “washer claims.” *See* Pet. 35; Prelim. Resp. 40–42.

¹⁰ Although the district court in the underlying case did note the priority application’s “emphasis on the soft washer for waterproofing,” nowhere did the decision state that the application disclosed that the location of the washer was critical. *See D Three Enterprises, LLC v. Rillito River Solar LLC*, 2017 WL 1023389, at *12 (D. Colo. Mar. 15, 2017), *aff’d sub nom. D Three Enterprises, LLC v. SunModo Corp.*, 890 F.3d 1042 (Fed. Cir. 2018).

Because we find that the reversal embodiment is not adequately disclosed, we need not determine if the embodiment where the cartridge is separable from the opposed legs is adequately disclosed at this time, or if a clevis attached to the cartridge is a critical feature of the invention. *See* Prelim. Resp. 55–56, 56–60.

B. Enablement for Claims 1, 2, 4–16, and 18–20 in the Grandparent Application

For purposes of eligibility of post-grant review, Petitioner argues that the grandparent application does not enable claims 1, 2, 4–16, and 18–20. Pet. 38. Because we find that at least one claim of the '486 patent does not have adequate written description support in the grandparent application, we need not address whether the grandparent application enables claims 1, 2, 4–16, and 18–20.

III. PATENTABILITY ANALYSIS

A. Applicable Law

Petitioner's asserted grounds of unpatentability are based on anticipation under 35 U.S.C. § 102, obviousness under 35 U.S.C. § 103, and the requirements for a specification, under 35 U.S.C. § 112. Pet. 7.

A “prior art reference—in order to anticipate under 35 U.S.C. § 102—must not only disclose all elements of the claim within the four corners of the document, but must also disclose those elements ‘arranged as in the claim.’” *Net MoneyIN, Inc. v. VeriSign, Inc.*, 545 F.3d 1359, 1369 (Fed. Cir. 2008) (quoting *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 1548 (Fed. Cir. 1983)).

For obviousness under 35 U.S.C. § 103,

A patent for a claimed invention may not be obtained, notwithstanding that the claimed invention is not identically disclosed as set forth in section 102, if the differences between the claimed invention and the prior art are such that the claimed invention as a whole would have been obvious before the effective filing date of the claimed invention to a person having ordinary skill in the art to which the claimed invention pertains. Patentability shall not be negated by the manner in which the invention was made.

35 U.S.C. § 103 (2011). The question of obviousness is resolved on the basis of underlying factual determinations, including: (1) the scope and content of the prior art; (2) any differences between the claimed subject matter and the prior art; (3) the level of ordinary skill in the art; and (4) when available, objective evidence, such as commercial success, long felt but unsolved needs, and failure of others.¹¹ *Graham v. John Deere Co.*, 383 U.S. 1, 17–18 (1966).

“[W]hether a patent satisfies the enablement requirement is a question of law based on underlying factual findings.” *Pac. Biosciences of California, Inc. v. Oxford Nanopore Techs., Inc.*, 996 F.3d 1342, 1350 (Fed. Cir. 2021) (citing *McRO, Inc. v. Bandai Namco Games America Inc.*, 959 F.3d 1091, 1096 (Fed. Cir. 2020)). “A claim is not enabled if . . . a relevant artisan would not be able to practice the claimed invention ‘without undue experimentation,’ a determination typically guided by” the so-called *Wands* factors. *Id.* (citing *In re Wands*, 858 F.2d 731, 736–737 (Fed. Cir. 1988)).

¹¹ The parties do not direct us to any objective evidence of non-obviousness in the current record.

B. Ground 3: Claims 1, 2, 4–16, and 18–20 as Anticipated by Bucco

Petitioner contends that claims 1, 2, 4–16, and 18–20 are unpatentable under 35 U.S.C. § 102(a)(1) as anticipated by Bucco, the published version of the grandparent application to the application that matured into the '486 patent. Pet. 7, 57–60. The parties do not dispute that Bucco shares a common specification with the '486 patent, and that the specification discloses the embodiment of Figure 1 of the '486 patent, one of the embodiments encompassed by the Challenged Claims.¹² See Pet. 57; Prelim. Resp. 32. And, we have reviewed Petitioner's contentions with respect to how Bucco anticipates claims 1, 2, 4–16, and 18–20 and determine, on the current record, that Petitioner makes a sufficient showing, at this stage of the proceeding, that these claims are anticipated by Bucco.

Patent Owner argues that Petitioner's position that Bucco anticipates claims 1, 2, 4–16, and 18–20 is inconsistent with its position that the grandparent application does not enable these claims. Prelim. Resp. 72. Patent Owner argues that, in order for a reference to anticipate a claim, that reference must enable the anticipated subject matter. *Id.* (citing *Elan Pharmaceuticals, Inc. v. Mayo Foundation for Medical Educ. and Research*, 346 F.3d 1051 (Fed. Cir. 2003)); see also *id.* at 73–76 (distinguishing

¹² Although the parties do not dispute that Bucco also discloses the subject matter of claims 3 and 17, these two claims have written description support in the grandparent application. See Pet. 30. As such, these two claims are entitled to an effective filing of at least as early as the filing date of the grandparent application and, as such, Bucco is not prior art to these two claims. See *Lucent Techs., Inc. v. Gateway, Inc.*, 543 F.3d 710, 718 (Fed. Cir. 2008) ("Patent claims are awarded priority on a claim-by-claim basis based on the disclosure in the priority applications.").

Petitioner’s reliance on *Chester v. Miller*, 906 F.2d 1574 (Fed Cir 1990), and *In re Lukach*, 442 F.2d 967 (CCPA 1971)).

We have considered Patent Owner’s arguments and determine, on the current record, that these arguments do not demonstrate a deficiency in Petitioner’s position. We agree with Petitioner that a reference may anticipate a claim, even if that reference does not enable the full scope of the claim.¹³

“To anticipate a claim, a reference must disclose every element of the challenged claim and enable one skilled in the art to make *the anticipating subject matter*.” *PPG Indus., Inc. v. Guardian Indus. Corp.*, 75 F.3d 1558, 1566 (Fed. Cir. 1996) (emphasis added); *see, e.g., In re Morsa*, 803 F.3d 1374, 1377 (Fed. Cir. 2015) (“For a prior-art reference to be enabling, it need not enable the claim in its entirety, but instead the reference need only enable a single embodiment of the claim.”). The parties do not dispute that Bucco describes and enables the embodiment depicted in Figure 1 of Bucco (and the ’486 patent), the anticipating subject matter. *See, e.g.,* Pet. 48–50 (framing enablement issue on the broad scope of the independent claims), 57 (“[T]he 2011 publication of the grandparent application (Bucco) nevertheless anticipates because it discloses one embodiment of the claimed genus.”); Prelim. Resp. 31 (“[T]he full scope of the claims of the ’486 [p]atent is described and enabled by” Bucco.). The enablement issue asserted by Petitioner turns on whether Bucco enables the *full scope* of the claims—that is, embodiments that may not be expressly disclosed in Bucco,

¹³ Although we do not decide the issue here, we note that Patent Owner contends that the grandfather application (published as Bucco) does enable the Challenged Claims. *See* Prelim. Resp. 60–71.

but yet are encompassed by the claim scope. Still, because the embodiment that is disclosed and enabled in Bucco also falls within the scope of the independent claims, then Bucco anticipates those claims.

Patent Owner attempts to distinguish *Chester* and *Lukach*, upon which Petitioner relies, arguing that neither of these cases involves a previous application with an identical disclosure, as is the case in this proceeding. Prelim. Resp. 75–76. This distinction, however, focuses on the wrong issue. For example, the fact that the application at issue in *Lukach* was a continuation-in-part, which itself provided written description¹⁴ for the disputed subject matter recited in the claims (“a Mw/Mn¹⁵ ratio of at least 2.0 and less than 3.0”), was not relevant to whether the grandparent application, which disclosed only one example with an inherent Mw/Mn ratio of 2.6, provided adequate written description support for the claims. *See In re Lukach*, 442 F.2d at 968–970. The court determined that the grandparent did not provide written description support. *Id.* at 969. As such, a published British counterpart to the grandparent application, which included the example with the inherent Mw/Mn ratio of 2.6, anticipated the claim, as it disclosed a single embodiment that was encompassed by the broader claimed range. *Id.*

¹⁴ *Lukach* concerns written description, not enablement. *In re Lukach*, 442 F.2d at 968 (“From the board’s language it is apparently the description requirement, rather than the enablement provisions or best mode provision, of the first paragraph of § 112, which was considered not to have been met.”). Regardless, the fact that the application at issue was a continuation-in-part did not play a role in the decision. *Id.* at 968–970.

¹⁵ “Mw stan[d]s for weight-average molecular weight, and Mn stands for number-average molecular weight.” *In re Lukach*, 442 F.2d at 968.

Similarly, in *Chester*, the fact that the claims at issue were in a continuation-in-part application was not, in and of itself, determinative. Instead, the Federal Circuit held that in situations as the one presented in *Chester*, where the later continuation-in-part claimed a genus and the parent application described only a species, it was not inconsistent to find that the parent application did not enable the genus, yet the species anticipated the genus. *Chester*, 906 F.2d at 1576–77.

For the reasons provided above, we find, on the current record, that the information in the Petition demonstrates, by a preponderance of the evidence, that Bucco anticipates claims 1, 2, 4–16, and 18–20.

C. Ground 1: Claims 1, 2, 4–16, and 18–20 as Unpatentable for Failing to Satisfy the Written Description Requirement of 35 U.S.C. § 112(a)

Petitioner contends that the application that matured into the ’486 patent, as filed, fails to provide adequate written description support for claims 1, 2, 4–16, and 18–20. Pet. 7, 39–48.¹⁶ As we discuss above, in connection with our analysis of Ground 3, Petitioner has sufficiently demonstrated that at least one claim is unpatentable, and, so, we institute on all challenges raised in the Petition. *See SAS Inst., Inc. v. Iancu*, 138 S. Ct. 1348, 1354, 1359–60 (2018); *see also PGS Geophysical AS v. Iancu*, 891 F.3d 1354, 1360 (Fed. Cir. 2018) (interpreting the statute to require “a simple yes-or-no institution choice respecting a petition, embracing all challenges included in the petition”); Patent Trial and Appeal Board Consolidated Trial Practice Guide 64 (Nov. 2019) (“The Board will not

¹⁶ We address Patent Owner’s written description arguments in our analysis of whether the ’486 patent is eligible for post-grant review. *See, e.g.*, Prelim. Resp. 30–31 (referencing its arguments for Ground 1 in arguing against eligibility of the ’486 patent for post-grant review).

institute on fewer than all claims or all challenges in a petition.”), *available at* <https://www.uspto.gov/TrialPracticeGuideConsolidated> (“CTPG”). So, we need not further analyze Ground 1.

We take this opportunity to make one point. Petitioner’s analysis of Ground 1 often references its written description analysis of the grandparent application for the purposes of post-grant review eligibility. *See, e.g.*, Pet. 42 (“For these reasons and those described above in Section VI.A (on page 29), claim 1 is unpatentable for failing to comply with the written description requirement.”). We note, however, that the challenged independent claims were originally filed with the application that matured into the ’486 patent. *See* Ex. 1008, 34. In this way, the application that matured into the ’486 patent differs from the grandparent application. The claims, as filed, are part of the specification and must be considered in evaluating whether claims 1, 2, 4–16, and 18–20 have adequate written description support.

We emphasize that this ground is part of the trial and we will evaluate it on the complete trial record.

D. Ground 2: Claims 1, 2, 4–16, and 18–20 as Unpatentable for Failing to Satisfy the Enablement Requirement of 35 U.S.C. § 112(a)

Petitioner contends that the application that matured into the ’486 patent, as filed, does not enable claims 1, 2, 4–16, and 18–20. Pet. 7, 48–57. Patent Owner responded. Prelim. Resp. 60–71. As we discuss above, Petitioner has sufficiently demonstrated that at least one claim is unpatentable, and, so, we institute on all challenges raised in the Petition. *See SAS Inst., Inc.*, 138 S. Ct. at 1354, 1359–60. As such, we do not analyze

this ground. We emphasize that this ground is part of the trial and will be evaluated on the complete trial record.

We note, however, that enablement is a highly factual inquiry that will benefit from a complete trial record, including the depositions of the parties' declarants. *See, e.g., In re Wands*, 858 F.2d at 737 (“[I]t is well established that enablement requires that the specification teach those in the art to make and use the invention without undue experimentation. Whether undue experimentation is needed is not a single, simple factual determination, but rather is a conclusion reached by weighing many factual considerations.”).

E. Grounds 4–6: Otten Grounds

Petitioner contends that claims 1–20 are unpatentable, either as anticipated by Otten or obvious over Otten, alone or in combination with Metcalf or Gray. Pet. 7, 61–82. Because we determine that the information in the Petition adequately supports Ground 3, we do not reach Petitioner's grounds based on Otten at this stage of the proceeding. We emphasize that these grounds are part of the trial and will be evaluated on the complete trial record.

IV. DISCRETIONARY DENIAL UNDER 35 U.S.C. § 325(D)

Patent Owner contends that we should exercise our discretion under 35 U.S.C. § 325(d) to deny the Petition, applying our precedential decisions in *Advanced Bionics, LLC v. MED-EL Elektromedizinische Geräte GmbH*, IPR2019-01469, Paper 6 (PTAB Feb. 13, 2020) (precedential) (“*Advanced Bionics*”) and *Becton, Dickinson & Co. v. B. Braun Melsungen AG*, IPR2017-01586, Paper 8 (PTAB Dec. 15, 2017) (precedential as to § III.C.5, first paragraph) (“*Becton, Dickinson*”). Prelim. Resp. 19–30. For the

reasons provided below, we decline to exercise our discretion to deny institution under § 325(d).

A. Applicable Framework

Section 325(d) provides that, in determining whether to institute a post-grant review, “the Director may take into account whether, and reject the petition or request because, the same or substantially the same prior art or arguments previously were presented to the Office.” 35 U.S.C. § 325(d) (2018). The Board uses a two-part framework in determining whether to exercise its discretion under § 325(d), specifically:

(1) whether the same or substantially the same art previously was presented to the Office or whether the same or substantially the same arguments previously were presented to the Office; and (2) if either condition of [the] first part of the framework is satisfied, whether the petitioner has demonstrated that the Office erred in a manner material to the patentability of challenged claims.

Advanced Bionics, Paper 6 at 8.

In applying the two-part framework, we consider several non-exclusive factors from *Becton, Dickinson*, which provide “useful insight into how to apply the framework” (*Advanced Bionics*, Paper 6 at 9): (a) the similarities and material differences between the asserted art and the prior art involved during examination; (b) the cumulative nature of the asserted art and the prior art evaluated during examination; (c) the extent to which the asserted art was evaluated during examination, including whether the prior art was the basis for rejection; (d) the extent of the overlap between the arguments made during examination and the manner in which Petitioner relies on the prior art or Patent Owner distinguishes the prior art; (e) whether Petitioner has pointed out sufficiently how the examiner erred in its evaluation of the asserted prior art; and (f) the extent to which additional

evidence and facts presented in the Petition warrant reconsideration of the prior art or arguments. *Becton, Dickinson*, Paper 8 at 17–18. If, after review of factors (a), (b), and (d), we determine that the same or substantially the same art or arguments previously were presented to the Office, we then review factors (c), (e), and (f), which relate to whether the petitioner demonstrates that the Office erred in a manner material to the patentability of the challenged claims. *Advanced Bionics*, Paper 6 at 10.

B. Petitioner’s Assertions

Petitioner asserts that the “[P]etition presents challenges under 35 U.S.C. § 112, ¶ 1, and challenges to the priority claims (under 35 U.S.C. § 120) that were not considered during prosecution.” Pet. 82. According to Petitioner, “the examiner did not issue any written description or enablement rejections, and the patent issued without an assessment as to whether the claims are entitled to a filing date earlier than the actual filing date.” *Id.* Petitioner further asserts that the “[P]etition relies on printed publication prior art either not identified (Bucco, Metcalf, and Gray) or not applied (Otten) during prosecution.” *Id.* at 83. Petitioner therefore concludes that “the Board should not deny institution under section 325(d).” *Id.* Petitioner effectively argues that the same arguments were not considered by the Office, ending the analysis at step one of the *Advanced Bionics* framework.

C. Patent Owner’s Arguments

Patent Owner argues that we should “exercise discretion and deny institution on all grounds” under 35 U.S.C. § 325(d) because “[P]etitioner asserts arguments under one Section 112 requirement that previously were considered by the Office under the same or different Section 112 requirement(s).” Prelim. Resp. 19–22 (citing *Pharmacosmos A/S v.*

American Regent, Inc., PGR2020-00009, Paper 17, 12, 29 (PTAB Aug. 14, 2020)). Specifically, Patent Owner argues, under step one of the *Advanced Bionics* framework, that the indefiniteness rejection by the Office and Petitioner’s written description and enablement arguments implicate the same underlying facts. *See* Prelim. Resp. 23–25. Patent Owner also argues that ball-and-socket interfaces, such as those disclosed in Otten, were considered by the Office. *Id.* at 25.

Patent Owner argues, under step two of the *Advanced Bionics* framework, that Petitioner “has made no showing that the Office erred in ways material to patentability.” Prelim. Resp. 19.

D. Analysis

Patent Owner’s § 325(d) arguments implicate two separate inquiries in this proceeding—post-grant review eligibility and patentability. Petitioner’s written description analysis underpins its eligibility contentions. For the purposes of our analysis here, we are going to assume, without deciding, that the factual overlap between the Office’s indefiniteness rejection and Petitioner’s written description and enablement arguments are sufficient to show that the same or substantially the same arguments were before the Office during the prosecution of the application that matured into the ’486 patent. As such, we move to step two of the *Advanced Bionics* framework. We note, however, that Bucco itself was not considered as prior art to the claims by the Office for the purposes of patentability. As such, substantially the same prior art was not in front of the Office.

Moving to step two of the *Advanced Bionics* framework, we determine that Petitioner sufficiently demonstrates that the Office erred, to the extent that the Office assumed that the claims were entitled to a priority

date as claimed in the application that matured into the '486 application. *See* Pet. 82–83; *see also id.* at 29–38 (analyzing effective filing date of claims 1, 2, 4–16, and 18–20). As we discuss above in connection with our analysis of the eligibility of the '486 patent for post-grant review, we find, on the current record, that at least one of claims 1, 2, 4–16, and 18–20 is not entitled to priority to the grandparent application (published as Bucco), as the grandparent application fails to provide adequate written description support for the full scope of these claims. By failing to make a similar determination during prosecution, the Office erred in not considering Bucco as prior art.

We do not agree with Patent Owner that Petitioner “made no showing that the Office erred in ways material to patentability.” *See* Prelim. Resp. 19. The Petition includes analyses of how claims 1, 2, 4–16, and 18–20 lack written description support in the grandparent application, and how Bucco anticipates these claims. *See* Pet. 29–38, 57–60.

Pharmacosmos A/S v. American Regent, Inc., PGR2020-00009, Paper 17, a non-precedential decision upon which Patent Owner relies, is distinguishable. In *Pharmacosmos*, the Board found that the same or substantially the same arguments or art were considered by the Office as made for seven of eight grounds in the petition, with no showing of Office error. *See Pharmacosmos A/S v. American Regent, Inc.*, PGR2020-00009, Paper 17 at 28. With only one remaining ground, the Board determined that institution would not be an efficient use of resources. *Id.* at 29. Relevant to our analysis here, for the one ground that the panel determined *did not implicate* § 325(d), the panel did find overlap in the petitioner’s written description argument and the examiner’s enablement and indefiniteness

arguments made during prosecution. *See id.* That is, this overlap was not determinative of whether to exercise discretion under § 325(d). Instead, it was the inefficient use of resources given that only a single ground supported institution that lead to the discretionary denial. *See id.*

For the reasons above, we do not exercise our discretion under § 325(d) to deny the Petition.

V. CONCLUSION

After considering the evidence and arguments presently before us, we determine Petitioner has demonstrated that it is more likely than not that at least one of the Claims Challenged is unpatentable. Accordingly, we institute a post-grant review.

VI. ORDER

In consideration of the foregoing, it is:

ORDERED that, pursuant to 35 U.S.C. § 324(d), a post-grant review is instituted as to claims 1–20 of U.S. Patent No. 11,235,486 B2; and

FURTHER ORDERED that pursuant to 35 U.S.C. § 324(d) and 37 C.F.R. § 42.4, notice is hereby given of the institution of a trial, which commences on the entry date of this Order.

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Patent 11,235,486 B2

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