

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

INSTRUMENTATION LABORATORY COMPANY,
Petitioner,

v.

HEMOSONICS LLC,
Patent Owner.

Case IPR2017-00852
Patent 9,272,280 B2

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

ABRAHAM, *Administrative Patent Judge*

DECISION

Granting Patent Owner's Motion to Submit Supplemental Information
Pursuant to 37 C.F.R. § 42.123(b)

I. INTRODUCTION

On September 1, 2017, we instituted trial with respect to the question of whether Baugh¹ anticipates claims 1 and 2 of U.S. Patent No. 9,272,280 B2 (“the ’280 patent,” Ex. 1001). Paper 14 (“Inst. Dec.”), 12. On April 26, 2018, we modified our institution decision to include review of “all challenged claims and all of the grounds presented in the Petition,” including the question of whether claims 1 and 2 are anticipated by Schubert.² Paper 26, 2.

On May 15, 2018, we authorized Instrumentation Laboratory Company (“Petitioner”) to file a motion to submit supplemental information pursuant to 37 C.F.R. § 42.123(b),³ and also authorized Hemosonics LLC (“Patent Owner”) to file an opposition to the motion. Subsequently, Petitioner filed its Motion to Submit Supplemental Information Pursuant to

¹ Baugh et al., U.S. Patent No. 6,221,672 B1, issued Apr. 24, 2001 (“Baugh,” Ex. 1005).

² Schubert et al., U.S. Pub. No. 2010/0154520 A1, published June 24, 2010 (“Schubert,” Ex. 1006).

³ Patent Owner argues that the supplemental materials are “submitted within one month of the institution of the grounds to which they relate under 37 C.F.R. § 42.123(a).” Mot. 4–5, n.i. We disagree, and maintain the position stated in our May 14, 2018, email to the parties, wherein we authorized briefing under 37 C.F.R. § 42.123(b), and notified the parties that § 42.123(a) does not apply in this proceeding because the trial for this *inter partes* review was instituted on September 1, 2017. Section 42.123(a) refers to the date the trial is instituted, not the date a ground is instituted. *See* 37 C.F.R. § 42.123(a) (“Once a *trial* has been instituted, a party may file a motion to submit supplemental information in accordance with the following requirements: (1) A request for the authorization to file a motion to submit supplemental information is made within one month of the date the *trial* is instituted.”) (emphasis added).

37 C.F.R. § 42.123 (“Mot.,” Paper 28), and Patent Owner filed an Opposition (“Opp.,” Paper 29).

II. BACKGROUND

Independent claim 1 of the ’280 patent recites a device having first and second chambers that include an “activator of coagulation.” Ex. 1001, 19:4–19. In the Petition, Petitioner argued Schubert discloses the use of coagulation activators, and directed us to paragraph 83 of Schubert, which refers to “tests for intrinsic and extrinsic activation of a blood sample (INTEMTM or EXTEMTM respectively).” Paper 2 (“Pet.”), 21–23 (citing Ex. 1006 ¶ 83).

In its Preliminary Response, Patent Owner asserted that Petitioner failed to demonstrate how Schubert discloses using an activator of coagulation. Paper 6 (“Prelim. Resp.”), 20–24. Specifically, Patent Owner argued that

[Schubert] mentions the EXTEM and INTEM tests as tests for intrinsic and extrinsic activation of a blood sample. Ex. 1006 ¶ [0083]. However, [Schubert] does not explicitly state that these tests include, as a reagent, an activator of coagulation. In particular, although the leading sentence of Paragraph 83 mentions reagents, the only reagent explicitly disclosed in that paragraph is cytochalasin D, . . . which is not an activator of coagulation. *Id.*

Id. at 21. Patent Owner also argued that Petitioner cannot rely on what would have been “apparent to a person of ordinary skill in the art” regarding the aforementioned tests to “close the gap” in Schubert and satisfy its burden of proving Schubert discloses an activator of coagulation. *Id.*

III. THE SUPPLEMENTAL INFORMATION

Petitioner seeks to submit information from IPR2018-00950 (“the 950 IPR”), which Patent Owner filed on April 20, 2018. In the 950 IPR, Patent

Owner challenges the patentability of U.S. Patent No. 9,915,671 (“the ’671 patent”), which is a continuation of Schubert.⁴ According to Petitioner, the information it seeks to enter involves “admissions relating to” the ’671 patent, “and characterizations of technical terms and prior art relating to [Schubert] by both Patent Owner and Patent Owner’s expert Dr. Diamond.” Mot. 2. The information Petitioner seeks to submit includes (1) portions of Patent Owner’s petition from the 950 IPR, (2) portions of the Declaration filed by Dr. Diamond in the 950 IPR (the “Diamond Declaration”), (3) a copy of the ’671 patent, and (4) a copy of an article referred to as Lang 2006.⁵ *Id.* at 1. Petitioner submitted copies of these documents with its Motion as Exhibits 1065–1068, respectively.

IV. ANALYSIS

Pursuant to 37 C.F.R. § 42.123(b), a motion to submit supplemental information filed more than one month after the trial date is instituted must show why the supplemental information reasonably could not have been obtained earlier, and that consideration of the supplemental information would be in the interests of justice.

Petitioner contends that the admissions and characterizations from the 950 IPR it seeks to submit in this proceeding are relevant to the challenges in the present proceeding based on Schubert, and directly contradict positions taken by Patent Owner in this proceeding. Mot. 2. Petitioner contends the information could not have been entered earlier, as Patent

⁴ Petitioner contends, and Patent Owner does not dispute, that the disclosure of the ’671 patent and Schubert are identical. Mot. 3.

⁵ Lang T. and von Depka M., *Possibilities and Limitations of Thromboelastometry/-graph*, *Hämostaseologie*, 2006; 26 (Suppl. 1): S20–S29.

Owner only recently filed the petition in the 950 IPR, and the information only became relevant after we modified our Institution Decision to include challenges based on Schubert. *Id.* Petitioner asserts that consideration of the supplemental information would be in the interests of justice because “[i]t would be prejudicial to Petitioner not to hold Patent Owner to its own assertions, especially where such assertions (1) involve the same disclosure relied on as a primary reference for invalidity grounds in the present proceeding and (2) resolve a critical issue of material fact.” *Id.*

Patent Owner argues that Petitioner misrepresents the arguments Patent Owner made in its Preliminary Response in an attempt to “manufacture a purported inconsistency.” Opp. 2. Patent Owner argues that it responded to Petitioner’s arguments that Schubert anticipated certain claims of the ’280 patent by arguing that Schubert does not explicitly state that EXTEM and INTEM tests include, as a reagent, an activator of coagulation. *Id.* (citing Prelim. Resp. 21). Patent Owner also argued that Petitioner failed to provide evidence supporting its assertion concerning the meaning of terms that appear in Schubert. *Id.* Thus, rather than making arguments about the meaning of EXTEM and INTEM, Patent Owner sought to “hold [Petitioner] to its obligation of establishing through evidence the disclosure of the prior art.” *Id.* at 2–3. According to Patent Owner, the arguments made in the Preliminary Response are not inconsistent with those presented in the 950 IPR.

Patent Owner also argues that Petitioner does not explain why it could not have submitted Lang 2006 when it filed its Petition, and that Petitioner is seeking to “remedy fatal defects in its petition.” *Id.* at 1–2. Additionally, Patent Owner argues Petitioner fails to justify the need for submitting 54

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