

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

INSTRUMENTATION LABORATORY COMPANY,
Petitioner,

v.

HEMOSONICS LLC,
Patent Owner.

Case IPR2017-00855
Patent 9,410,971 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 seeking *inter partes* review of claims 1–20 of U.S. Patent No. 9,410,971 B2 (“the ’971 patent,” Ex. 1002). Paper 2 (“Pet.”). HemoSonics LLC (“Patent Owner”) filed a Patent Owner Preliminary Response to the Petition. Paper 8 (“Prelim. Resp.”). On September 1, 2017, we issued a Decision instituting *inter partes* review with respect to the question of whether Baugh¹ anticipates claims 1, 2, 6, 7, 15, and 16. Paper 14 (“Dec.”), 26. In the Decision, we also determined that Petitioner did not establish a reasonable likelihood of prevailing on its assertions that claims 3–5, 8–14, and 17–20 are unpatentable as obvious under 35 U.S.C § 103. *Id.*

Petitioner filed a Request for Rehearing of the portion of our Decision denying institution of *inter partes* review of claims 3–5, 8–14, and 17–20 with respect to the question of whether the subject matter of these claims would have been obvious to a person of ordinary skill in the art in view of the combined teachings of Baugh and various other references. Paper 16 (“Req. Reh’g”).²

For the reasons that follow, Petitioner’s Request for Rehearing is *denied*.

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

² On September 19, 2017, counsel for Patent Owner contacted the Board via e-mail regarding authorization to file a response to Petitioner’s Request for Rehearing. In view of our decision to deny Petitioner’s Request for Rehearing, we consider Patent Owner’s request to be moot.

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). 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.* Upon a request for rehearing, the decision on a petition will be reviewed for an abuse of discretion. *Id.* at § 42.71(c).

III. DISCUSSION

a. Incorporation by Reference

Petitioner contends that “the Petition sets forth evidentiary citations to the Mize Declaration in support of obviousness that should have been considered substantively, but that were overlooked in misapprehension of the rule against improper incorporation by reference.” Req. Reh’g 2. In arguing that we misapprehended the legal standard for finding improper incorporation by reference, Petitioner attempts to distinguish the facts in the present proceeding from those in prior Board decisions addressing incorporation by reference. *Id.* at 3–4. In that regard, Petitioner contends “the instant Petitioner’s citations to the Mize Declaration in the subject Petition are limited to specific sections of pertinent evidentiary support for respective arguments in the Petition.” *Id.* at 5.

We are not persuaded that we misapprehended the legal standard for finding improper incorporation by reference or that we overlooked evidentiary citations that support arguments in the Petition. The rule against incorporation by reference is clear: “Arguments must not be incorporated by reference from one document into another document.” 37 C.F.R.

§ 42.6(a)(3). In the Decision, we noted that Petitioner failed to present any arguments, discussion, or analysis regarding why a person of ordinary skill in the art would have combined the elements disclosed in the prior art in the same fashion as recited in the claims of the '971 patent. Dec. 14. In the Request for Rehearing, Petitioner does not direct us to any location in the Petition where we overlooked or misapprehended arguments regarding reasons for combining the elements disclosed in the art. We, therefore, disagree with Petitioner's assertion that the Mize declaration provides support for "respective arguments *in the Petition*," as no such arguments—at least with respect to a reason to combine the elements disclosed in the art—appear in the Petition. Req. Reh'g 5 (emphasis added).

Petitioner's contention that the Mize Declaration contains "explicit evidence supporting a reason for combining the respective references" does not change the fact that the Petition itself contains no arguments, discussion, or analysis of whether a person of ordinary skill in the art would have had reason to combine the teachings provided by cited prior art references. *Id.* at 6. Thus, it is unclear exactly what in the Petition the Mize Declaration evidence allegedly supports. To the extent Petitioner seeks to have us consider the cited portions of the Mize Declaration as its arguments that a person of ordinary skill in the art would have had reason to combine the cited references, we decline to do so. Considering such information to be arguments presented in the Petition would require us to contravene our own rule on incorporation by reference, which would be improper.

b. Obviousness in view of Baugh and Viola

Petitioner also contends we overlooked evidence in the Petition that demonstrates claims 17–20 are unpatentable as obvious in view of the

combined teachings of Baugh and Viola.³ Req. Reh’g 2–3, 7–9 (referring to Ground 13).

According to Petitioner, the Petition includes detailed citations to Viola that support “the conclusion that Viola teaches a known technique for detecting viscoelasticity through the coagulation process in a test chamber.” *Id.* at 8. Petitioner further contends that evidence in the Petition “establishes that [Viola] explicitly teaches a viable and predictable technique for detecting coagulation for a test sample in a chamber. Thus, on this basis, the claim chart concludes that ‘[i]t would have therefore been obvious to interrogate each of the chambers in [Baugh] using the techniques described in [Viola].’” *Id.* at 8–9.

We did not overlook the information provided in Petitioner’s claim charts. To the contrary, we explicitly recognized in the Decision that “Petitioner identifies certain parts of Viola that disclose limitations in claims 17–20.” Dec. 19. Ultimately, however, we determined that Petitioner failed to present evidence or arguments explaining why it would have been obvious to a person of ordinary skill in the art to use the techniques described in Viola to interrogate the chambers in Baugh, or why a person of ordinary skill in the art would have had a reasonable expectation of successfully doing so. *Id.* at 18–19.

In the Request for Rehearing, Petitioner argues that Viola teaches a “viable and predictable technique for detecting coagulation for a test sample in a chamber,” which supports a conclusion of obviousness. Req. Reh’g 8

³ Viola et al., *A novel ultrasound-based method to evaluate hemostatic function of whole blood*, CLINICAL CHIMICA ACTA. 411, 106–13 (2010) (“Viola,” Ex. 1012).

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