UNITED STATES PATENT AND TRADEMARK OFFICE BEFORE THE PATENT TRIAL AND APPEAL BOARD BECTON, DICKINSON AND COMPANY Petitioner, v. B. BRAUN MELSUNGEN AG Patent Owner. Case IPR2017-01585 Patent 8,337,463

Patent Owner's Preliminary Response

Table of Contents

I.	INT	TRODUCTION1
II.	LE	VEL OF ORDINARY SKILL IN THE ART4
III.	CL	AIM CONSTRUCTION5
	A.	Background and Overview of the Law5
	В.	"Needle Protective Device" is Synonymous with "Needle Guard Element"6
	<i>C</i> .	"Needle Protective Device" a.k.a. "Needle Guard Element" is Not a Means-Plus-Function Term9
		1. The '463 Patent Discloses "Needle Protective Device" is A Structure
		2. The Prosecution History Teaches "Needle Protective Device" is A Structure
		3. "Needle Protective Device" is a Class of Structures Well-Known to a POSITA
		4. Surrounding Claim Language Indicates "Needle Protective Device" is Structural and Not Limited to Spring Clips16
IV.	STA	ANDARD FOR INSTITUTING INTER PARTES REVIEW18
V.	BE(SUI	E BOARD SHOULD DENY INSTITUTION OF GROUND 1 CAUSE IT IS BASED ON THE SAME PRIOR ART AND BSTANTIALLY THE SAME ARGUMENTS ALREADY NSIDERED BY THE OFFICE
	<i>A</i> .	The Office has already determined it would not be obvious for a POSITA to incorporate a valve into the Woehr-108 catheters23
	В.	The Office already determined it would not be obvious to incorporate the valve assembly of Tauschinski into a catheter hub 26



	<i>C</i> .	Petitioner's proposed combination of Woehr-108 and Tauschinski adds nothing beyond what was already considered by the Office2	28
	D.	Arnett adds nothing beyond what is already disclosed in Tauschinski	30
	<i>E</i> .	Petitioner merely concludes, without supporting evidence, that it would be obvious to include Tauschinski's disc 3 and member 10 in the catheter hub of Woehr-108	35
	F.	Patent Owner's Australian expert never stated there were "no design concerns" with incorporating a valve into the catheter hub of Woehr-108	37
VI.	BEC SUC INTO MAI	BOARD SHOULD DENY INSTITUTION OF GROUND 1 AUSE PETITIONER FAILS TO SHOW HOW TO CESSFULLY INCORPORATE A VALVE AND ACTUATOR D THE CATHETER HUB OF WOEHR-108 WHILE NTAINING THE FUNCTIONALITY OF THE WOEHR-108 HETER	39
	<i>A</i> .	Significant design challenges exist for a POSITA considering incorporating a valve and actuator into the Woehr-108 catheter hub	10
	В.	Petitioner never adequately explains how a POSITA would overcome the design challenges4	15
	<i>C</i> .	There is no reason to modify the Tauschinski actuator4	18
VII.	BEC WIT THE	BOARD SHOULD DENY INSTITUTION ON GROUND 2 AUSE VAN HEUGTEN DOES NOT DISCLOSE A VALVE H SLITS, AND BECAUSE THERE IS NO REASON TO USE ACTUATOR OF ARNETT WITH THE VALVE OF VAN GTEN	51
	<i>A</i> .	Van Heugten fails to disclose a valve with slits, as required by all	52
	В.	There is no reason to modify the already existing actuator of Van Heugten based on Arnett	54



VIII.	SECONDARY CONSIDERATIONS	58
IX.	CONCLUSION	59

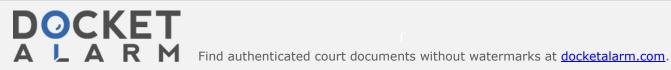


TABLE OF AUTHORITIES

Cases	Page(s)
ActiveVideo Networks, Inc. v. Verizon Communs., Inc., 694 F.3d 1312 (Fed. Cir. 2012)	34, 36
In re Am. Acad. Of Sci. Tech. Ctr., 367 F.3d 1359 (Fed. Cir. 2004)	5
<i>Apex Inc. v. Raritan Comp., Inc.,</i> 325 F.3d 1364 (Fed. Cir. 2003)	6
Belden Inc. v. Berk-Tek LLC, 805 F.3d 1064 (Fed. Cir. 2015)	34
Cuozzo Speed Techs. v. Lee, 136 S. Ct. 2131 (2016)	5
Front Row Technologies, LLC v. MLB Advanced Media, L.P., IPR2015-01932, Paper 7 (Mar. 24, 2016)	20
Fujunon Corp. v. Motorola, Inc., 2009 U.S. Dist. LEXIS 83088 (D. Del. Sept. 11, 2009)	9
Graham v. John Deere Co., 383 U.S. 1 (1966)	19
Inventio AG v. ThyssenKrupp Elevator Am. Corp., 649 F.3d 1350 (Fed. Cir. 2011)	17
KSR Int'l Co. v. Teleflex Inc., 550 U.S. 398 (2007)	20
Lighting World, Inc. v. Birchwood Lighting, Inc., 382 F.3d 1354 (Fed. Cir. 2004)	6, 13, 15
In re Magnum Oil Tools Int'l, Ltd., 829 F.3d 1364 (Fed. Cir. 2016)	18, 19, 20, 52
Pfizer, Inc. v. Apotex, Inc., 480 F. 3d 1348 (Fed. Cir. 2007)	57



DOCKET

Explore Litigation Insights



Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

Real-Time Litigation Alerts



Keep your litigation team up-to-date with **real-time** alerts and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

Advanced Docket Research



With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

Analytics At Your Fingertips



Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

LAW FIRMS

Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

FINANCIAL INSTITUTIONS

Litigation and bankruptcy checks for companies and debtors.

E-DISCOVERY AND LEGAL VENDORS

Sync your system to PACER to automate legal marketing.

