

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

CORPAK MEDSYSTEMS, INC. and HALYARD HEALTH, INC.,
Petitioner,

v.

KIRN MEDICAL DESIGN, L.L.C.,
Patent Owner.

Case IPR2017-01990
Patent 6,631,715 B2

PATENT OWNER'S SUR-REPLY TO PETITIONER'S REPLY
TO PATENT OWNER'S PRELIMINARY RESPONSE

TABLE OF AUTHORITIES

Cases

General Plastic Industrial Co. v. Canon Kabushiki Kaisha, Case IPR2016-01357,
(P.T.A.B. Sept. 6, 2017) (Paper 19) (Section II.B.4.i designated
precedential) 1

Statutes

35 U.S.C. § 314(a) 1, 4

Other Authorities

37 C.F.R. § 42.108(a) 1
37 C.F.R. § 42.65(a)..... 2

Petitioner was granted leave to file a Reply in response to Patent Owner's argument that the Board should exercise its discretion to decline institution of the follow-on Petition in this case pursuant to 35 U.S.C. § 314(a) and 37 C.F.R. § 42.108(a) in view of *General Plastic Industrial Co. v. Canon Kabushiki Kaisha*, Case IPR2016-01357, slip op. at 15 (P.T.A.B. Sept. 6, 2017) (Paper 19) (Section II.B.4.i designated precedential). Petitioner requested leave because Section II.B.4.i of *General Plastic* was designated precedential on October 18, 2017, after Petitioner filed its follow-on Petition. Petitioner's Reply is a last-minute attempt by Petitioner to address § 314(a) and the factors considered by the Board, which Petitioner failed to do in its follow-on Petition. Yet the arguments presented by Petitioner in its Reply merely confirm that Petitioner's follow-on Petition falls squarely in the class of petitions that should be denied under § 314(a).

Despite being given an extra opportunity to adequately explain why its follow-on Petition should be instituted in view of the unreasonable deficiency of its previous Petition, Petitioner again fails to provide an adequate explanation. The Board has applied an objective standard in determining whether a particular claim construction by the Board should have been expected by a petitioner. *See General Plastic*, at 21. Petitioner's previous Petition was fatally flawed because it effectively ignored that claim 18 requires **snapping a tube into a channel**, not snapping two pieces of a clip together. Petitioner now attempts to excuse its prior

failure to find the new secondary references of its follow-on Petition by saying that it had not searched for this art until the Board had issued its Decision Denying Institution of the previous Petition, with Petitioner explaining that, “[s]upported by its expert, Petitioner had reasonably interpreted ‘snapping the at least one tube into a channel formed in a receiver’ to refer to ‘snapping’ the ends of the nasal bridle and tube into a ‘receiver.’” Reply at 4 (citing Ex. 1018, ¶ 52).

But Petitioner merely points to the same unsupported reasoning that the Board rejected in Petitioner’s previous Petition. “Expert testimony that does not disclose the underlying facts or data on which the opinion is based is entitled to little or no weight.” 37 C.F.R. § 42.65(a). The expert’s testimony relied upon by Petitioner was not supported by underlying facts or data. Instead, the expert’s testimony was an opinion that merely cited Ballantyne’s disclosure of an anchoring clip that comprises two pieces which are snap-fitted together upon the ends of a bridle and perhaps also upon a tube. *Compare* Ex. 1018, ¶ 52, *with* Ex. 1002 at col. 8, ll. 6-17. Petitioner does not provide any other explanation or support in its Reply for how its interpretation could have been reasonable. This is not an adequate explanation.

In addressing factor 2 of *General Plastic* (whether a “petitioner knew of the prior art asserted in the second petition or *should have known of it*”), Petitioner contends that it engaged an “accomplished prior art search firm” for the previous

Petition, and that the search firm exercised “reasonable diligence” and conducted a “reasonable search.” Reply at 2. As provided in Patent Owner’s Preliminary Response to the previous Petition, and affirmed in the Board’s decision to deny institution of the previous Petition, “snapping the at least one tube into a channel formed in a receiver’ means that snapping occurs with respect to a tube and a channel, **based on the express language.**” Ex. 1013 at 8 (emphasis added). In its Reply, Petitioner focuses on explaining the apparent difficulty that the search firm faced in finding the new references of Simmons and Izumi. *See* Reply at 2. Not mentioned is whether Petitioner actually instructed the search firm to search for the limitation. Thus, Petitioner also has not adequately explained whether it should have known of these references, and if not, why.

In addressing factor 5, Petitioner states that it “sacrificed” over seven of the twelve months that it had to file its previous Petition because it filed the previous Petition within five months of being served with the Complaint. Reply at 4. Of course Petitioner also waited until the end of the twelve months to file its follow-on Petition. Petitioner provides no meaningful explanation for the delay in filing its follow-on Petition, other than that Petitioner did not look for the new references until after the Board had issued its Decision Denying Institution of the previous Petition. Reply at 1-2, 4. Specifically, Petitioner waited until the Board issued its Decision on July 26, 2017 to look for new references, *see* Reply at 1, 4, and

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