

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ACCLARENT, INC.,
Petitioner,

v.

FORD ALBRITTON, IV,
Patent Owner.

Case IPR2018-00268
Patent 9,011,412 B2

Before JOSIAH C. COCKS, BEVERLY M. BUNTING, and
RICHARD H. MARSCHALL, *Administrative Patent Judges*.

MARSCHALL, *Administrative Patent Judge*.

DECISION
Denying Petitioner's Request for Rehearing
37 C.F.R. § 42.71

INTRODUCTION

Acclarent, Inc. (“Petitioner”) timely filed a Request for Rehearing (Paper 11, “Reh’g Req.”) of our Decision denying institution of *inter partes* review (Paper 10, “Decision” or “Dec.”) of claims 8–13 of U.S. Patent No. 9,011,412 B2 (Ex. 1001, “the ’412 patent”). Petitioner’s stated basis for rehearing is that we “made both a legal error by applying an incorrect standard for obviousness, and a factual error by overlooking and misapprehending Petitioner’s evidence.” Reh’g Req. 1. We deny Petitioner’s Request for Rehearing for the reasons set forth below.

STANDARD OF REVIEW

When reconsidering a decision on institution, the Board reviews the decision for an abuse of discretion. 37 C.F.R. § 42.71(c). “The burden of showing a decision should be modified lies with the party challenging the decision.” 37 C.F.R. § 42.71(d). In its request for rehearing, the dissatisfied party “must specifically identify all matters the party believes the Board misapprehended or overlooked, and the place where each matter was previously addressed.” *Id.* We address Petitioner’s arguments with these principles in mind.

ANALYSIS

Arguments Regarding Ressemann¹ and Goldfarb²

In our Decision, we denied institution with respect to Petitioner’s Ground 1, which alleged that claims 8 and 11–13 are unpatentable based on

¹ U.S. Patent Pub. No. 2007/0250105 A1 issued to Ressemann et al. (“Ressemann”) (Ex. 1006).

² U.S. Patent No. 8,747,389 B2 issued to Goldfarb et al. (“Goldfarb”) (Ex. 1007).

Ressemann and Goldfarb under 35 U.S.C. § 103(a). Dec. 11–17. We found that the Petition did not establish “sufficiently how Ressemann and Goldfarb would have been combined to arrive at the claimed invention, and why one of skill in the art would have made the combination in a manner that renders the claimed method obvious.”³ *Id.* at 13. We focused on two limitations of claim 8, “coupling a source of suction to the lumen through the handle” and “controlling . . . the guide catheter . . . while substantially simultaneously controlling, by one of the thumb or index finger, an amount of suction.” *Id.* Petitioner raises arguments regarding both limitations, which we address in turn below.

As to the “coupling a source of suction to the lumen through the handle” limitation, Petitioner asserts two arguments. First, Petitioner argues that we were improperly “led to attempt to bodily incorporate the structure of Goldfarb into Ressemann,” as evidenced by our statement that “it is not apparent how Petitioner proposes to add Goldfarb’s suction tube 54 to Ressemann’s structure.” *Reh’g Req.* 4–5; Dec. 14. Petitioner argues that “[t]he fact that the precise location of the suction hole and technique for coupling a source of suction to the lumen are not provided in the Petition does not give rise to patentability” and that “the expectation of success need only be reasonable.” *Reh’g Req.* 5.

³ For purposes of our Decision, we adopted Petitioner’s proposed level of ordinary skill in the art, namely, as having “at least a bachelor’s degree in either electrical engineering or mechanical engineering, or equivalent, with at least four years’ experience designing surgical instruments, or a doctor of medicine (M.D.) and at least 2 years of experience with laparoscopic or endoscopic surgical procedures.” Dec. 6 (citing Pet. 13).

Petitioner's argument does not persuade us that we misapprehend or overlooked any evidence. In the Petition, Petitioner recognizes that Ressemann does not teach the use of suction, arguing that "it would have been obvious to modify Ressemann in view of Goldfarb to couple a source of suction to the lumen through the handle for suctioning fluid through the lumen of the guide catheter." Pet. 26. Our statement regarding Goldfarb's suction tube 54 was an example of the lack of explanation in the Petition, along with the absence of any teaching regarding the proposed suction hole location, in Petitioner's proposed combination. Dec. 14. As we noted in our Decision, Goldfarb does not disclose the location the hole in its drawings, and the Petition fails to specify the location of the suction hole in the modified version of Ressemann as well as the suction tube 54 of Goldfarb. *Id.* Our statements regarding the lack of teaching in the Petition do not amount to a mandate to bodily incorporate Goldfarb's suction tube; they merely point out the lack of detail provided in the Petition itself regarding the proposed combination, given that the Petition expressly relies on Goldfarb's suction tube when addressing this limitation. *See* Pet. 26, 28.

Second, Petitioner argues that we were improperly led to overlook "explicit teachings of the references." Reh'g Req. 5. Petitioner alleges that "Ressemann's disclosure of a hub 22 is akin to head 44 of Figure 3 of Goldfarb" and that "[a]dding a suction sidearm to such a hub was common, as evidenced by hub 14 and sidearm 16 in Figs. 4, 6A, and 7A of Ressemann." *Id.* Petitioner also alleges that we overlooked Goldfarb's teachings and use of its hub 22 when coupling suction. *Id.* Similarly, Petitioner argues that we overlooked expert testimony regarding methods of

adding suction to Ressemann, primarily focusing on the use of sidearms. *Id.* at 6–8.

We are not persuaded that we overlooked these teachings, because we could not have overlooked these explanations when they were not included in the Petition. Petitioner provides no citations to the Petition or expert reports explaining the similarities between Ressemann’s hub 22 and Goldfarb’s head 44, or that adding a suction sidearm was common, or referencing the use of Ressemann’s sidearm 16 in any way in the proposed combination. Reh’g Req. 5. It appears that the Petition contains no reference at all to these teachings. *See* Pet. 26–31. The portions of the Petition that Petitioner cites in its Request merely refer to Goldfarb’s suction hole and suction tube and related structures in isolation, not as part of a modified version of Ressemann. Reh’g Req. 5 (citing 26–28). Similarly, we did not overlook the analogous nature of Ressemann’s hub 22 with Goldfarb’s head 44, or the possibility of adding suction via Ressemann’s sidearm 16, because these allegations were never made in the Petition. Moreover, the cited portions of the expert submissions do not appear to reference “sidearms” by name at all. At most, Petitioner’s expert established that using suction ports or vents to control suction was well known, but this fact does not establish where and how one would have added such a port to Ressemann, which impacts the ability of the proposed combination to carry out the claimed method. *See* Ex. 1005 ¶¶ 51–54. Although several of the prior art references in the record may disclose sidearms, the Board is not required to be an archeologist of the record in search of pertinent facts, including structures that may be modified in a manner that results in a structure that might be capable of performing the claimed method, when that

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