Trials@uspto.gov
571-272-7822

Paper No. 22
Date: May 6, 2020

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SANDBOX MEDICAL, LLC,
Petitioner,

v.

NEOTECH PRODUCTS, INC.,
Patent Owner.

Case IPR2019-00246
Patent 6,958,050 B1

Before BENJAMIN D. M. WOOD, RICHARD H. MARSCHALL, and JASON W. MELVIN, *Administrative Patent Judges*.

WOOD, Administrative Patent Judge.

JUDGMENT
Final Written Decision
Determining All Challenged Claims Unpatentable
35 U.S.C. § 318(a)

I. INTRODUCTION

A. Background

Sandbox Medical, LLC ("Petitioner") filed a Petition (Paper 3, "Pet.") requesting *inter partes* review of claims 1–10 of U.S. Patent No. 6,958,050 B1 (Ex. 1001, "the '050 patent") on the following grounds (Pet. 6–7):

No.	Reference[s]	Basis	Claim[s] Challenged
1	Jackson,[1] Kerwin,[2] Behrstock,[3] Penny,[4] and Halligan[5]	§ 103	1–6 and 8–10
2	Jackson, Kerwin, Behrstock, Penny, Halligan, and Shedlock[6]	§ 103	7
3	Jackson, Kerwin, Behrstock, Penny, Halligan, and Perla[7]	§ 103	10
4	Jackson "in view [of] the Common Knowledge of the POSA [person of ordinary skill in the art]"	§ 103	1–10

[1] U.S. Pat. No. 3,595,234 (iss. July 27, 1971) (Ex. 1003).

[2] U.S. Pat. No. 4,813,926 (iss. Mar. 21, 1989) (Ex. 1004).

[3] U.S. Pat. No. 4,699,138 (iss. Oct. 13, 1987) (Ex. 1006).

[4] U.S. Pat. No. 3,965,901 (iss. June 29, 1976) (Ex. 1009).

[5] U.S. Pat. No. 3,319,628 (iss. May 16, 1967) (Ex. 1005).

[6] U.S. Pat. No. 5,114,415 (iss. May 19, 1992) (Ex. 1007).

[7] U.S. Pat. No. 5,496,268 (iss. Mar. 5, 1996) (Ex. 1010).

Neotech Products, Inc. ("Patent Owner") did not file a Preliminary Response.

On May 10, 2019, we instituted *inter partes* review. Paper 9 ("Dec."). Patent Owner subsequently filed a Patent Owner Response (Paper 13, "PO Resp."), Petitioner filed a Reply to the Patent Owner Response (Paper 15, "Pet. Reply"), and Patent Owner filed a Sur-reply (Paper 17, "PO Sur-reply"). A hearing was held on February 6, 2020, and a transcript of the hearing is included in the record. Paper 21 ("Tr.").

We have jurisdiction under 35 U.S.C. § 6. Petitioner bears the burden of proving unpatentability of the challenged claims, and the burden of persuasion never shifts to Patent Owner. *See Dynamic Drinkware LLC v. Nat'l Graphics, Inc.*, 800 F.3d 1375, 1378 (Fed. Cir. 2015) (discussing burdens of proof in *inter partes* reviews). To prevail, Petitioner must prove unpatentability by a preponderance of the evidence. *See* 35 U.S.C. § 316(e) (2012); 37 C.F.R. § 42.1(d) (2018). This decision is a Final Written Decision under 35 U.S.C. § 318(a). For the reasons discussed below, we hold that Petitioner has demonstrated by a preponderance of the evidence that claims 1–10 of the '050 patent are unpatentable under 35 U.S.C. § 103(a).

B. Related Proceedings

Petitioner states that Patent Owner filed a patent infringement action asserting the '050 patent against Petitioner in the Central District of California, but voluntarily dismissed the action prior to service. Pet. 4 (citing Ex. 1012 ¶ 8). The parties indicate that Patent Owner filed a new action in the District of Delaware, which was transferred to the District of Massachusetts. *Id.* (citing Ex. 1012 ¶ 8); Paper 6, 2. Petitioner disputes that

it has been served, but states that Patent Owner alleges that it effected service on November 14, 2017. Pet. 4 (citing Ex. 1012 ¶ 8). Petitioner informed us at the oral argument that the district-court action has been stayed pending the outcome of this proceeding. Tr. 6:10–12.

C. The '050 Patent

The '050 patent issued October 25, 2005 from an application filed June 18, 2002, and is titled "Nasal/Oral Aspiration Device." Ex. 1001, codes (45), (22), (54). Figure 1, reproduced below, depicts a side elevation view of a preferred embodiment:

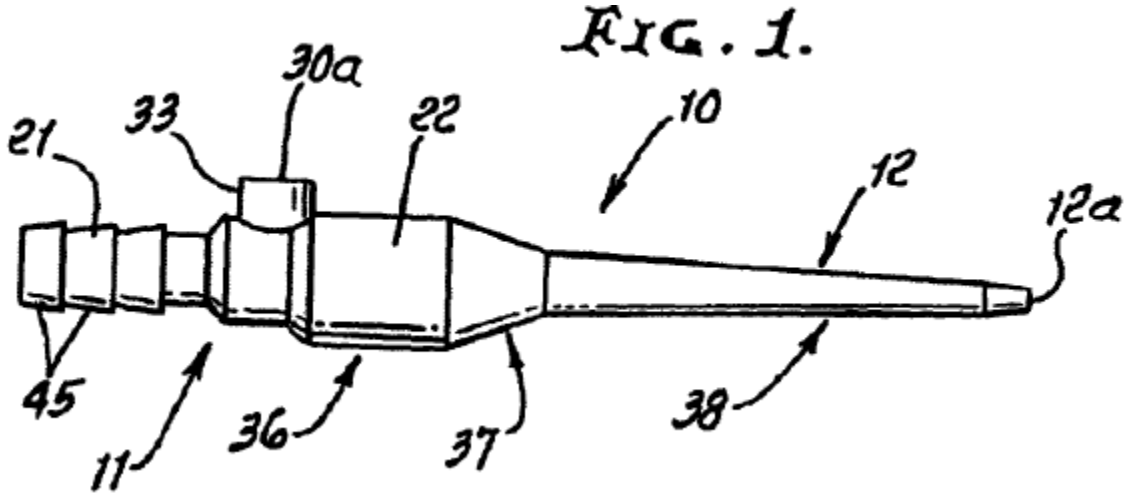

Figure 1 depicts two-part suctioning device 10 comprising first tubular body portion 11 connected end-to-end with second tubular portion 12. *Id.* at 2:31–34. First portion 11 is made from a "relatively hard non-deformable plastic material," whereas second portion 12 is "flexibly and resiliently yieldably deformable, sidewardly." *Id.* at 2:45–48. Flexible tapered tip 12a, located at the end of second portion 12, "flexes easily and helps provide better access to nasal and oral cavities." *Id.* at 2:38–40, Fig. 4.

D. The Challenged Claims

Petitioner challenges claims 1–10. Pet. 1. Claim 1 is the sole independent claim, and is reproduced below:

> 1. A multi-purpose medical suctioning device, comprising:
> a) a one piece first tubular body portion,
> b) a one piece second tubular portion operatively connected to said first tubular body portion,
> c) said second tubular portion having a flexible tip portion which is relatively soft and pliable and has an entrance of reduced area, said second tubular portion being easily maneuverable as by bending,
> d) there being a side inlet associated with at least one of said first and second portions, to be manually blocked and unblocked to control suctioning of fluid from said tip portion entrance and through said second and first tubular portions,
> e) and wherein said first tubular body portion consists of relatively hard plastic material, and said second tubular portion consists of relatively soft plastic material, the tip being maneuverable as by one hand of the user, while the user's other hand controls said side inlet,
> f) said second tubular portion having primary secondary and tertiary [sic] lengthwise extending sections, said primary section fitting telescopically to said first tubular body portion, and with friction, said tertiary section being flexible and tapering toward said tip at a relatively lesser taper angle, and said secondary section extending between said primary and tertiary section, at a relatively greater taper angle, said primary section fitting over said first tubular body portion to define a device maximum diameter proximate the entrance of said side inlet and between said inlet and said flexible tip portion, for finger control of the device including finger control of said inlet and control of said primary section to control tip portion bending,

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