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Paper 10
Entered: January 21, 2021

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

BALT USA, LLC,
Petitioner,

v.

MICROVENTION, INC.,
Patent Owner.

IPR2020-01259
Patent 10,076,338 B2

Before MITCHELL G. WEATHERLY, SUSAN L. C. MITCHELL, and JAMIE T. WISZ, *Administrative Patent Judges.*

MITCHELL, *Administrative Patent Judge*.

DECISION
Denying Institution of *Inter Partes* Review
35 U.S.C. §§ 314, 325(d)

I. INTRODUCTION

A. Background

On July 8, 2020, Balt USA, LLC ("Petitioner") filed a Petition (Paper 2, "Pet.") requesting an *inter partes* review of claims 1 through 10 (the "challenged claims") of U.S. Patent No. 10,076,338 B2 (Ex. 1001, "the '338 patent"). *See* 35 U.S.C. §§ 311–319. On October 23, 2020, MicroVention, Inc. ("Patent Owner") filed a Preliminary Response to the Petition. Paper 7 ("Prelim. Resp."). On December 4, 2020, Petitioner filed an authorized Reply addressing discretionary denial under 35 U.S.C. § 314(a). Paper 8; Ex. 1034. On December 11, 2020, Patent Owner filed an authorized Sur-Reply responding to Petitioner's arguments concerning discretionary denial. Paper 9; Ex. 1034.

We have the authority and discretion to determine whether to institute an *inter partes* review. 35 U.S.C. § 314; 37 C.F.R. § 42.4. We may not institute an *inter partes* review "unless . . . there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition." 35 U.S.C. § 314(a). After considering the Petition, Patent Owner's Preliminary Response, and associated evidence, we exercise our discretion to deny institution of *inter partes* review under 35 U.S.C. §325(d).

B. Real Parties in Interest

Petitioner identifies itself, a wholly owned subsidiary of Balt Incorporated, as the real party-in-interest for Petitioner. Pet. 67. Patent Owner identifies itself, a subsidiary of Terumo Americas Holding, Inc., as the real party-in-interest for Patent Owner. Paper 5, 1.

C. Related Proceedings

The parties identify that the '338 patent is the subject of the following related matter: *MicroVention, Inc. v. Balt USA, LLC*, Case No. 8:19-cv-01335-JLS-KES (C.D. Cal.). Pet. 68; Paper 5, 1.

D. The '338 Patent (Ex. 1001)

The '338 patent issued on September 18, 2018, and is titled "Detachable Coil Incorporating Stretch Resistance." Ex. 1001, codes (45), (54). The named inventors are Matthew J. Fitz, Cathy Lei, Joseph Gulachenski, Maricruz Castaneda, and Gary Currie. *Id*. at code (72). The '338 patent claims priority to Application No. 12/180,834, the prosecution of which will be extensively discussed below in relation to our analysis under 35 U.S.C. § 325(d). *See infra* Section II.A.

The subject matter of the '338 patent involves "[a]n implantable embolic device having a stretch-resistant member passing therethrough that also serves as a tether for connecting the device to a delivery system." *Id*. at code (57). Such implantable devices include coils, stents, and filters that may be placed in a body cavity such as blood vessels, fallopian tubes, malformations such as fistula and aneurysms, heart defects, and other luminal organs. *Id*. at 2:1–5. When the implant is a coil, the stretch-resistant member may be a tether, such as a monofilament, that runs through the inside of the lumen of the coil and be attached to the distal end of the coil. *Id*. at 2:23–27, 46–48. "This design not only joins the implant to the pusher [or delivery catheter], but also imparts stretch resistance to the coil without the use of a secondary stretch resistant member." *Id*. at 2:6–7, 48–51.

The ’338 patent also describes an implant delivery and detachment system to deliver the implantable embolic device such as the claimed microcoil. Figure 4 set forth below shows an example of such a system.

FIG. 4

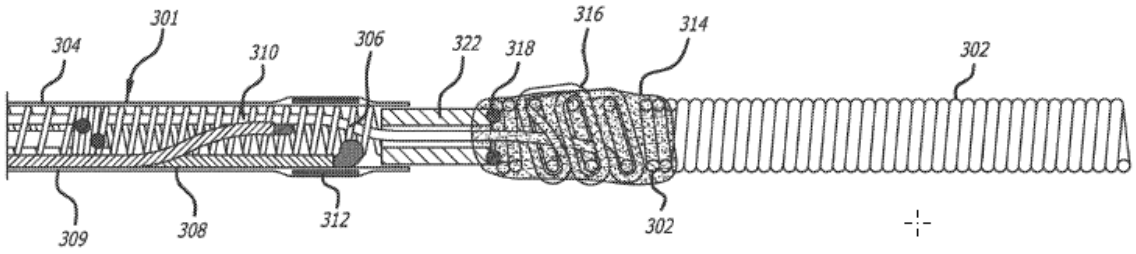

Figure 4 is described as a cross-sectional side view of a preferred embodiment of the detachment system. *Id*. at 5:57–59, 9:4–5. In Figure 4, detachment system 300 is shown to include delivery pusher 301 containing heater 306 that detaches implant device 302 and tether 310 that is disposed in proximity to heater 306 with a proximal end fixed within the delivery pusher 301 and a distal end coupled to implant device 302. *Id*. at 9:7–21. When current is applied through wires 308 and 309, heater 306 heats up until tether 310 breaks and releases implant device 302. *Id*. at 9:21–23.

The Specification of the ’338 patent further describes enhancing the attachment of tether 310 to implant device 302 using collar member 322 welded to implant device 302 at weld 318 and sized to fit within the outer reinforced circumference 312 of delivery pusher 301. *Id*. at 9:37–41. Tether 310 is also tied around the proximal end of implant device 302 to form knot 316, and adhesive 314 around knot 316 prevents untying or unwanted decoupling. *Id*. at 9:41–45.

The Specification of the ’338 patent further describes that tether 310 may be axially pre-tensioned during assembly to assist in detachment of implant device 302. *Id*. at 9:46–50. With specific reference to the

embodiment shown in Figure 4 above, the Specification provides that after attachment of tether 310 near the proximal end of implant device 302 as described above:

> The free end of the tether 310 is threaded through a distal portion of the delivery pusher 301 until it reaches an exit point (not shown) of the delivery pusher 301. Tension is applied to the tether 310 in order to store energy in the form of elastic deformation within the tether material by, for example, placing a pre-determined force on the free end of the tether 310 or moving the taut tether 310 a pre-determined displacement. The free end of the tether 310 is then joined to the delivery pusher 301 by, for example, tying a knot, applying adhesive, or similar methods known in the art.
>
> When present, the release of potential energy stored in the system operates to apply additional pressure to separate the implant device 302, and the portion of the tether 310 to which the implant device 302 is coupled, away from the heater 306 when the implant device 302 is deployed. This advantageously lowers the required detachment time and temperature by causing the tether 310 to sever and break.

Id. at 9:53–10:2.

Figure 9 shown below depicts a side elevation view of an implant device "having a stretch-resistant member passing therethrough." *See id*. at 6:4–5, 15:59–64.

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