

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

EXCELSIOR MEDICAL CORPORATION
Petitioner

v.

ROBERT F. LAKE, JR. AND JEFFREY S. TENNANT
Patent Owner

Case IPR2013-00494
Patent 7,282,186

Before GRACE K. OBERMANN, SHERIDAN K. SNEDDEN, and
CHRISTOPHER L. CRUMBLY, *Administrative Patent Judges*.

SNEDDEN, *Administrative Patent Judge*.

DECISION

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

I. INTRODUCTION

Excelsior Medical Corporation (“Petitioner”) filed a request for rehearing (Paper 11) of the Board’s decision, dated February 6, 2014 (“Decision”) (Paper 10), which denied the petition for *inter partes* review and declined to institute trial on any of the asserted grounds as to any of the challenged claims of US 7,282,186 (Ex. 1001; “the ’186 patent”). Petitioner contends that the Board should institute *inter partes* review of the ’186 patent.

For the reasons stated below, Petitioner’s request is denied.

II. STANDARD OF REVIEW

Under 37 C.F.R. § 42.71(c), “[w]hen rehearing a decision on petition, a panel will review the decision for an abuse of discretion.” An abuse of discretion occurs when a “decision was based on an erroneous conclusion of law or clearly erroneous factual findings, or . . . a clear error of judgment.” *PPG Indus. Inc. v. Celanese Polymer Specialties Co. Inc.*, 840 F.2d 1565, 1567 (Fed. Cir. 1988). *See also* 37 C.F.R. § 42.71(d) (“The request must specifically identify all matters the party believes the Board misapprehended or overlooked”).

III. DISCUSSION

1. Obviousness of claims 1-19 over the combination of Sigler and Briggs

Petitioner contends that the Board erred in concluding that arguments based on a combination of Sigler and Briggs were considered previously by the Office because new information was presented in the Petition regarding these references. Rehearing Req., 2-3. For example, Petitioner argues that the Office did not expressly articulate any consideration with regard to the combination of Sigler’s disclosure that preventing the drying of liquid is desirable and Briggs’ disclosure that the diaphragm can seal against the egress of cleaning agent. *Id.*

We are not persuaded that Petitioner has shown that the Decision was based on an abuse of discretion in this regard. Our review of the prosecution history indicated that the Office gave considerable substantive consideration to these references and, in particular, to the combination of Sigler's interlocking slit with Briggs' iris structure for engaging a medical apparatus. As noted in our Decision, Petitioner failed to direct the Board to any new evidence establishing a reasonable likelihood of prevailing with respect to obviousness over the combination of Sigler and Briggs. Decision, 20. Accordingly, we deny Petitioner's request to reconsider the patentability of claims 1-19 over the combination of Sigler and Briggs.

2. Anticipation of Claims 1, 2, and 5 by Genatempo

Petitioner contends that "the Board appears to have relied on the properties of the threads, without considering the explicit disclosure in Genatempo et al. regarding the material of the cap and Excelsior Exhibit 1004." Rehearing Req., 6-7. In our Decision, we acknowledged that Genatempo's threads are made of Hytrel 5556 polyester, but found that Petitioner failed to identify any objective evidence that supports the position that Genatempo's threads could function as threads and still possess the property of being flexible with the ability to substantially return to their normal shape after they are deformed. Decision, 8. That is, Petitioner failed to provide a sufficient evidentiary basis to conclude that a thread made of Hytrel 5556 polyester would be considered by a person of ordinary skill in the art to necessarily be elastically deformable. Petitioner has shown no abuse of discretion in the Decision in this regard and may not use a Request for Rehearing to augment its prior, unsuccessful, arguments.

3. Obviousness of claims 1, 10, and 13 over the combination of Genatempo and Plourde

Petitioner contends that the proposed modification of the cap of Genatempo with the tabs of Plourde would have been an obvious improvement. Rehearing Req., 7. Petitioner, however, does not set forth any persuasive rationale as to why the Board's decision was based on an erroneous conclusion of law or clearly erroneous factual findings. Accordingly, Petitioner has shown no abuse of discretion.

4. Anticipation of Claims 1 and 2 by White

Petitioner contends that the peripheral ridge is not relied upon to be elastically deformable, rather the lower end of the protective cap elastically deforms to fit over the peripheral ridge. Rehearing Req., 11. In its Petition, however, Petitioner makes no assertion that the lower end of the protective cap elastically deforms to fit over the peripheral ridge. The Board could not have misapprehended or overlooked something not presented sufficiently in the Petition. Petitioner has otherwise shown no abuse of discretion in the Decision.

5. Anticipation of Claims 1, 2, and 5 by Miyahara

Petitioner contends that that Miyahara clearly discloses an elastically deformable inwardly directed protrusion on the cap. Rehearing Req., 11-12. Petitioner, however, does not set forth any clear rationale as to why the Board's decision was based on an erroneous conclusion of law or clearly erroneous factual findings. Accordingly, Petitioner has shown no abuse of discretion.

IV. ORDER

Accordingly, it is hereby

ORDERED that Petitioner's request for rehearing is *denied*.

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Patent 7,282,186

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