



## **PTAB Designates Two Decisions as Precedential and One Decision as Informative, Clarifying Its Exercise of Discretion on Institution Under 35 U.S.C. § 325(d)**

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### **Advanced Bionics LLC v. MED-EL Elektromedizinische Geräte GmbH, IPR2019-01469, Paper 6 (Feb. 13, 2020) (Precedential)**

In *Advanced Bionics*, the claims were directed to magnetic elements in implantable medical devices that allow for magnetic resonance imaging. The petitioner asserted two obviousness grounds that relied on Zimmerling, a reference that had been the basis for rejections during prosecution, combined with other new references. In its preliminary response, the patent owner argued that the examiner had already considered Zimmerling and the petitioner's arguments during prosecution.

The Board agreed with the patent owner and explained the two-part framework it uses in applying the factors set forth in *Becton, Dickinson & Co. v. B. Braun Melsungen AG*, IPR2017-01586, Paper 8 (Dec. 15, 2017) (precedential in relevant part), to decide whether to institute review under 35 U.S.C. § 325(d). The Board asks:

- Whether the same or substantially the same art previously was presented to the Office or whether the same or substantially the same arguments were previously presented to the Office [*Becton, Dickinson* factors (a), (b) and (d)].
- If either condition of the first part of the framework is satisfied, whether the petitioner has demonstrated that the Office erred in a manner material to the patentability of challenged claims [*Becton, Dickinson* factors (c), (e) and (f)].

In finding the first prong satisfied, the Board determined that, although the new references were not cited during prosecution, the petitioner relied on the new references in substantially the same way the examiner had already considered Zimmerling during prosecution. The petitioner admitted that Zimmerling and the new references disclose “a similar system” and the Board found that Zimmerling and the new references disclose “substantially the same magnet shape and configuration.” The Board also found that the petitioner relied on the new references in the same manner as the examiner relied on Zimmerling.

Turning to the second prong, the Board explained that during prosecution the applicant distinguished Zimmerling because it did not disclose “an implantable magnet having a dipole moment that remains parallel to the coil housing and the patient’s skin *as the magnet rotates*.” The petitioner, however, did not argue that the additional references cure Zimmerling’s deficiency related to magnet rotation. Accordingly, the Board was not persuaded that the examiner materially erred in deciding patentability, and the Board declined to institute review.

**Practice Tip:** When combining a new reference with a reference cited during prosecution, IPR petitioners should articulate how the new reference is materially different from the cited reference and how those material differences disclose any limitations added during prosecution to overcome the cited reference. If the new reference discloses substantially the same information as the cited reference, IPR petitioners should explain how the examiner erred by allowing the challenged claims.

*Puma N. Am., Inc. v. Nike, Inc.*, IPR 2019-01042, Paper 10 (Oct. 31, 2019) (Informative)

In *Puma*, the claims were directed to articles of footwear with a base plate having certain specific structures (e.g., a cleated soccer shoe). The petitioner alleged that six claims were unpatentable as obvious over a combination of two references. The patent owner argued the Board should decline to institute review pursuant to 35 U.S.C. § 325(d) because the examiner considered that same combination of references during prosecution. The petitioner agreed that this combination was considered during prosecution but stressed that its petition presents new evidence and argument not considered during prosecution.

In declining institution under § 325(d), the Board applied the six *Becton, Dickinson* factors. The examiner twice rejected the challenged claims based on the same combination of references during prosecution, and, thus, factors (a), (b) and (c) weighed in favor of denying institution. Under factor (d), the Board found there was a high degree of overlap between the

petition and arguments made during prosecution. Both proposed the same references for the same limitations, the same modification of the references and the same rationale for this modification. Under factor (e), the Board disagreed that petitioner had shown that the examiner erred. According to the Board, the petitioner's argument about a motivation to combine the references was really directed to whether the references were analogous art, and the new expert testimony that the petitioner relied on was unsupported and merely rehashed arguments considered by the examiner. Finally, under factor (f), the parties agreed that the petitioner's expert testimony was new, but the Board discounted it for the reasons explained under factor (e). Because all the *Becton, Dickinson* factors weighed against institution, the Board declined to institute an IPR.

**Practice Tip:** If the same combination of references asserted in an IPR was already considered during prosecution, IPR petitioners should articulate how the asserted combination is modified differently in the IPR or how the rationale for modification is different in the IPR. IPR petitioners should also present new evidence, such as expert testimony with fact-based reasoning, that supports these new modifications and rationales. Unsupported expert testimony that repeats arguments made during prosecution may be discounted by the Board.

*Oticon Med, AB, et al. v. Cochlear Ltd.*, IPR 2019-00975, Paper 15 (Oct. 16, 2019) (Precedential)

In *Oticon*, the claims were directed to anchoring elements for bone anchored hearing devices. The petitioner asserted four grounds of obviousness, each including the Choi reference combined with other references. Although the other references had been considered during prosecution, Choi had not. The patent owner argued that the Board should decline to institute review under 35 U.S.C. § 325(d), because the Office had already considered art cumulative to Choi and the petitioner's arguments overlapped with the arguments made during prosecution.

The Board disagreed based on application of the *Becton, Dickinson* factors. Under factors (a) and (b), the Board found that Choi was not cumulative because the feature that the petitioner relied on in Choi was structurally and functionally different from the features in the references cited during prosecution. Choi also provided an advantage that petitioner relied on to provide a motivation to combine the references. For the same reasons, factors (c) and (d) also cut against denying institution under § 325(d). Specifically, the petitioner relied on teachings in Choi that were not considered by the examiner. Finally, in considering factors (e) and (f), the Board concluded that the examiner had erred by not considering Choi, the

teachings of which were noncumulative and would have been considered by one of skill in the art at the time of the invention. Accordingly, the Board instituted review.

**Practice Tip:** In an IPR petition, when relying on a new reference in combination with references considered during prosecution, petitioners should explain why the features in the new reference are structurally different from the features of the references cited during prosecution. If possible, petitioner should also explain why the features in the new reference are functionality different (e.g., it serves a different purpose) and how they provide different advantages than features of the references cited during prosecution.

## Categories

Patent Trial & Appeal Board

Inter Partes Review

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