

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

HOLOGIC, INC.
Requester, Respondent

v.

SMITH & NEPHEW, INC.
Patent Owner, Appellant

Appeal 2015-007845
Inter partes Reexamination Control 95/001,933
Patent US 7,226,459 B2¹
Technology Center 3900

Before STEVEN D.A. McCARTHY, JEFFREY B. ROBERTSON and
DANIEL S. SONG, *Administrative Patent Judges*.

SONG, *Administrative Patent Judge*.

DECISION ON REQUEST FOR REHEARING

¹ Patent US 7,226,459 B2 (hereinafter “the ’459 patent”) issued June 5, 2007 to Cesarini et al.

Appeal 2015-007845
Reexamination Control 95/001,933
Patent US 7,226,459 B2

In the Request for Rehearing (hereinafter “Rehr’g Req.”), the Patent Owner requests reconsideration under 37 C.F.R. § 41.79 of our Decision mailed January 20, 2016 (hereinafter “Original Decision” or “Orig. Dec.”), affirming the Examiner’s rejection of claims 1–16, 19–22, and 25–33. The Patent Owner asserts that the Board misapprehended or overlooked various issues in the Original Decision, and requests the modification thereof. In opposing the Request for Rehearing, the Requester relies on its Opposition to Request for Rehearing Under 37 C.F.R. § 41.79 (hereinafter “Opposition”).

We grant the Request to the extent that we consider the Patent Owner’s arguments *infra*, but DENY the request to modify the Original Decision.

Issue 1

The Patent Owner notes that because the Supreme Court granted the petitions for *certiorari* in *In re Cuozzo Speed Technologies, LLC*, 137 L. Ed. 2d 783 (U.S. 2016), “whether the ‘broadest reasonable interpretation’ standard will apply in post-grant proceedings under the AIA is now an open question.” (Rehr’g Req. 5). Arguing that the present *inter partes* reexamination is similar to a validity trial, the Patent Owner argues that “if ‘broadest reasonable interpretation’ is no longer deemed to be the correct claim construction standard in IPRs [*Inter Partes* Reviews], Appellant should also be entitled to have its issued claims construed under the same standard for infringement as they are for validity.” (*Id.* at 6). The Patent Owner reiterates its arguments (*id.* at 6–11) to argue that only its

Appeal 2015-007845
Reexamination Control 95/001,933
Patent US 7,226,459 B2

interpretation of the claim limitation “simultaneously rotate, translate, and reciprocate the cutting member” meets the legal standard for claim construction applied by the district courts (*id.* at 12). Accordingly, the Patent Owner argues that the Original Decision, which uses the broadest reasonable interpretation standard for claim construction, must be reversed.

This argument is not persuasive. The present appeal pertains to *inter partes* reexamination, not an IPR. Moreover, the Court recently rendered its decision in *Cuozzo Speed Tech., LLC v. Lee*, and held that the broadest reasonable interpretation is the applicable standard for claim construction even in IPRs. *Cuozzo*, 136 S.Ct. 2131, 2144–46 (2016).

Issue 2

The Patent Owner asserts that even under the broadest reasonable interpretation standard, the Examiner erred by applying an unreasonable claim construction of the limitation “simultaneously rotate, translate, and reciprocate the cutting member.” (Rehr’g Req. 12). The Patent Owner’s arguments in the Request for Rehearing as to claim construction are generally repetitive of the arguments submitted in its briefs (*id.* at 12–14), these arguments having been already addressed by the Board (*see* Orig. Dec. 9–18). We nonetheless briefly elaborate on the Original Decision *infra* for emphasis in view of the Request for Rehearing.

Firstly, the Patent Owner again premises its assertion of error by arguing that, in the claim interpretation of the Examiner, “translation” and “reciprocation” describe “the exact same motion.” (Rehr’g Req. 12). However, as already explained, that is not the position of the Examiner or the Board (Orig. Dec. 12). Specifically, “the Patent Owner mischaracterizes

Appeal 2015-007845
Reexamination Control 95/001,933
Patent US 7,226,459 B2

the position of the Examiner and overlooks the fact that these terms [translation and reciprocation] are not mutually exclusive of one another, and are not redundant to each other.” (*Id.* at 13; *see also id.* at 15).

Translation speaks to movement from one place (e.g., point A) to another (e.g., point B) (*see* Opposition 7; Orig. Dec. 11). Reciprocation means “to move forward and backward alternately.” (Orig. Dec. 11). Translation does not speak to continued movement in alternating directions, and reciprocation is not simply translation. Hence, these terms are not the same, and are not interpreted to be the same in the Original Decision.

We again note that the Specification of the ’459 patent states that a feature may be included wherein “translating is reciprocating.” (Orig. Dec. 6–7; FF 1A, 1B). The Patent Owner has also conceded that reciprocation includes a translation component (Orig. Br. 13; Hearing Transcript, pg. 13, l. 20–pg. 14, l. 6; pg. 51, l. 18–pg. 52, l. 6). Thus, the Specification of the ’459 patent supports the Examiner’s construction which is “entirely consistent and makes sense,” whereas Patent Owner’s claim construction is problematic, and is not the broadest reasonable interpretation consistent with the Specification of the ’459 (Orig. Dec. 15–16).

Noting that the Original Decision does not discuss the modifying term “simultaneously” in detail, the Patent Owner also argues that under the Examiner’s interpretation:

the cutting member claimed in the ’459 Patent is “translating” and “reciprocating” *at the exact same time*. In other words, at least as the Examiner and Board applied the claim language to prior art such as Middle, there is never a time [] when the claimed cutting member is translating when it is not also in the process of reciprocating, and there is never a time [] when the

Appeal 2015-007845
Reexamination Control 95/001,933
Patent US 7,226,459 B2

claimed cutting member is reciprocating when it is not also in the process of translating.
(Rehr'g Req. 12).

According to the Patent Owner, the applied interpretation of “simultaneously” is the narrowest possible interpretation rather than the broadest, which would be “at the same time or almost the same time.” (Rehr'g Req. 12–13). Thus, the Patent Owner argues that by applying the broader interpretation of “simultaneously,” the claim limitation at issue can be interpreted to give weight to each of the recited elements and to avoid rendering a limitation superfluous (*id.*).

However, this argument is also essentially premised on the Patent Owner's assertion that the Examiner's interpretation renders the terms translation and reciprocation exactly the same. As explained, the terms translation and reciprocation are not mutually exclusive or redundant, and are not interpreted to be the same by the Examiner or the Board. In addition, simultaneous translation and reciprocation is what the claim calls for when it recites “a drive coupled to the cutting member to simultaneously rotate, translate, and reciprocate the cutting member.” (App. Br., Claims App'x). This claim recitation is entirely consistent with the claim construction applied by the Examiner, and the Specification of the '459 patent (Orig. Dec. 15). As already explained, it is the Patent Owner's claim construction that is strained and unsupported by the Specification of the '459 patent which is:

silent as to [] a specific meaning [of reciprocate and translate]; does not disclose where translation ends and reciprocation begins, or vice versa; and is silent as to how such determination is made.
(Orig. Dec. 16).

Appeal 2015-007845
Reexamination Control 95/001,933
Patent US 7,226,459 B2

Indeed, as pointed out by the Requester, the Patent Owner's argument based on the term "simultaneously" is essentially that this term must be interpreted to *exclude* "at the same time" so as to preclude "translate, and reciprocate" from occurring at the same time (Opposition 10). There is no basis to interpret the limitations at issue in the requested manner, which is contrary to the plain and ordinary meaning. The Patent Owner's construction would require having to ignore the explicit claim language, plain and ordinary meanings of the terms, contrary statements in the Specification, as well as concessions of the Patent Owner, all of which are consistent with the Specification of the '459 patent, and the claim construction applied by the Examiner. The Patent Owner is essentially requesting that the Board construe the claim limitation at issue so as to preserve the validity of the '459 patent even though there is no basis to do so. *See In re Am. Acad. of Sci. Tech. Ctr.*, 367 F.3d at 1369 (stating giving broad construction to claim terms is not unreasonable during examination because the applicant can amend the claims, and further stating that "it is error for the Board to 'appl[y] the mode of claim interpretation that is used by courts in litigation, when interpreting the claims of issued patents in connection with determination of infringement and validity'" (citing *In re Zletz*, 893 F.2d 319 (Fed. Cir. 1989))).

Finally, as to this issue of claim construction, we further observe that in the Request for Rehearing, the Patent Owner makes general arguments for finding error, but does not specifically request reconsideration of a particular rejection. In this regard, as also pointed out by the Requester (Opposition 11–12), the Original Decision further states:

Appeal 2015-007845
Reexamination Control 95/001,933
Patent US 7,226,459 B2

We further agree with the Examiner that even using the Patent Owner's narrow claim interpretation, Middle still anticipates claims 32 and 33 because Middle discloses nearly straight portions in the cam groove that would correspond to the Patent Owner's interpretation of a translation portion (RAN 42, *quoting* Third Party Requester's Response filed November 20, 2013, pgs. 14–15; *see also* annotated Figure 3 of Middle).

(Orig. Dec. 20).

In view of the above, the Patent Owner's arguments based on claim construction are unpersuasive.

Issue 3

The Patent Owner argues that the Board misapprehended what Middle actually discloses (Rehr'g Req. 14). In addition to arguments already addressed (Rehr'g Req. 14; Orig. Dec. 20–24), the Patent Owner argues that the Original Decision's finding that “a similar mechanism already disclosed in Middle, which utilizes a collar with J-groove and a lock pin, can be used” (Orig. Dec. 24) does not make sense because it is this “quick release system that Mr. Erdman opines would not readily work with a helical groove.” (Rehr'g Req. 15). However, the point being made by the Board was that a similar mechanism could be used, and that the assertion of the declarant Mr. Erdman that “it is not clear” how this can be implemented was not persuasive (Orig. Dec. 24).

To elaborate, the device of Middle utilizes a collar 62 that is displaceable via lock pin 70 and J-groove 72 to release the replaceable tool with its drive piston 30 (Middle, col. 6, ll. 17–28; col. 9, ll. 17–34; Fig. 2). Cam groove 38 on the drive piston is engaged by cam follower balls 40 that

Appeal 2015-007845
Reexamination Control 95/001,933
Patent US 7,226,459 B2

are mounted via sleeve 64, which is separate from the collar (*id.*; col. 5, ll. 34–40). Middle further discloses the use of a pin as a cam follower instead of follower balls (Orig. Dec. 24–25; FF 2E; Middle, col. 5, ll. 37–40). We see no reason why a similar collar release mechanism already disclosed in Middle cannot be used in a modified device wherein a helical groove is provided on the piston instead of a cam groove, and a cam follower is mounted to the sleeve. As stated, extension of the piston may be required to accommodate the helical groove (Orig. Dec. 24), which in turn, may necessitate further modifications to device of Middle to accommodate the extended piston. However, nothing in the record indicates that such modification would have been beyond the ordinary skill of those in the art. Thus, the opinion of Mr. Erdman that “it is not clear” as to how such modified device would work is not credible or persuasive (Orig. Dec. 24).

The Patent Owner also argues that the Board erred in assuming that the pin disclosed in Middle would work in a modified Middle device with helical groove because the Middle does not describe the disclosed pin in any detail, and thus, would have the same “lack of directionality problem as the Middle follower balls.” (Rehr’g Req. 15–16). This line of argument is also unpersuasive.

Firstly, as noted by the Requester (Opposition 12), the assertion that balls cannot be used with helical groove appears to contradict Mr. Erdman’s testimony that balls can be used to engage a helical groove (Erdman Deposition of December 7, 2011, pgs. 174–175).

Secondly, regardless of Mr. Erdman’s testimony, we observe that the Patent Owner argues Middle separately. Non-obviousness cannot be

Appeal 2015-007845
Reexamination Control 95/001,933
Patent US 7,226,459 B2

established by attacking references individually where the rejection is based upon the teachings of a combination of references. *In re Merck*, 800 F.2d 1091, 1097 (Fed. Cir. 1986); *In re Keller*, 642 F.2d 413, 425 (CCPA 1981). The Patent Owner fails to recognize that most of the claims stand rejected based on the combination of Middle and another secondary reference such as Kaplan, Saadat, or Galloway (*see* Rejections 3–5), these secondary references specifically disclosing a helical groove, and include a follower suitable for use therewith.

For example, with respect to Rejection 3, which reaches the majority of the claims on appeal, Kaplan discloses a biopsy device for extracting tissue that provides reciprocating and rotational motion of a needle, one embodiment thereof including a helical groove, and further discloses “suitable means for tracking within the helical groove 234 . . . to effect reciprocal motion.” (Kaplan, col. 13, ll. 51–57; *see also* Orig. Dec. FF 3A, 3C). In this regard, with respect to Rejection 3, the Examiner stated:

the rejection above clearly details the modification of Middle with Kaplan specifically, the incorporation of a helical groove with follower from the teaching of Kaplan’s embodiment of figure 8 as a substitute for the groove of Middle. This incorporation is not picking and choosing elements from a reference but rather substituting one mechanism with another to achieve the same predictable function, i.e. reciprocation. The substitution of the helical groove would then allow for a slower reciprocation and a longer translation motion of the cutting element.

(RAN 48).

We see no reason why a collar release mechanism already disclosed in Middle cannot be used in a device modified to incorporate a helical groove

Appeal 2015-007845
Reexamination Control 95/001,933
Patent US 7,226,459 B2

and follower of one of the secondary references Kaplan, Saadat, or Galloway, which would be mounted to the sleeve. As noted above, nothing in the record indicates that such modification would have been beyond the ordinary skill of those in the art.

Moreover, the Patent Owner also appears to overlook the fact that many of the same claims also stand rejected based on the combination of Kaplan and Galloway, which does not rely on Middle (Orig. Dec. 31–32).

Therefore, the Patent Owner’s argument that the follower of Middle does not provide directionality for use in a helical groove is not persuasive.

DECISION

While we have considered the Original Decision in light of the Request for Rehearing, and have elaborated on certain aspects of it, we decline to modify the Original Decision in any respect.

DENIED

Pursuant to 37 C.F.R. § 41.79(d), this decision is final for the purpose of judicial review. A party seeking judicial review must timely serve notice on the Director of the United States Patent and Trademark Office. *See* 37 C.F.R. §§ 90.1 and 1.983.

Appeal 2015-007845
Reexamination Control 95/001,933
Patent US 7,226,459 B2

Third Party Requester:

ARNOLD & PORTER LLP
ATTN: IP DOCKETING DEPT.
555 TWELFTH STREET, N.W.
WASHINGTON, DC 20004-1206

Patent Owner:

SMITH & NEPHEW, INC.
NIXON PEABODY LLP
150 MINUTEMAN ROAD
ANDOVER, MA 01810