

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GATOR BIO, INC.,

Petitioner,

v.

SARTORIUS BIOANALYTICAL INSTRUMENTS, INC.,

Patent Owner.

IPR2023-00215

Patent 8,305,585 B2

Before THU A. DANG, GRACE KARAFFA OBERMANN,
and STACEY G. WHITE, *Administrative Patent Judges*.

OBERMANN, *Administrative Patent Judge*.

DECISION

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

I. INTRODUCTION

Gator Bio, Inc. (“Petitioner”) filed a Petition (Paper 1, “Pet.”) requesting *inter partes* review of claims 1–19 of US Patent No. 8,305,585 B2 (Ex. 1001, “the ’585 patent”). Sartorius BioAnalytical Instruments, Inc. (“Patent Owner”) filed a Preliminary Response. Paper 11 (“Prelim. Resp.”).¹

Petitioner filed a Reply (Paper 17) and Patent Owner filed a Sur-reply (Paper 18). These briefs address issues other than the one we find to be dispositive in this matter, namely, whether the Board should exercise its discretion and deny review under 35 U.S.C. § 325(d). *See* Ex. 3002 (Board’s email authorizing a Reply and Sur-reply on other issues).

We have authority to institute an *inter partes* review only where the information presented establishes “a reasonable likelihood that the petitioner would prevail with respect to at least [one] of the claims challenged in the petition.” 35 U.S.C. § 314(a). The Board also has discretion to deny review if “the same or substantially the same prior art or arguments previously were presented to the Office,” for example, during patent prosecution. 35 U.S.C. § 325(d). We exercise our discretion under § 325(d) and decline to institute an *inter partes* review of the ’585 patent without addressing whether Petitioner satisfies the evidentiary threshold for review under § 314(a).

The information presented in the Petition and Preliminary Response forms the basis for our findings of fact and conclusions of law, which we provide below for the sole purpose of explaining our reasons for exercising our discretion to deny institution of review under § 325(d).

¹ We refer to the publicly-filed version of the Preliminary Response (Paper 11), because the confidential information revealed in the version filed under seal (Paper 9) is not relevant to any issue addressed in this Decision.

A. Real Parties-in-Interest

The Petition indicates that “Gator Bio Inc. and Hong Tan” are Petitioner’s real parties-in-interest and, further, that Access Medical Systems, Ltd., is “the parent company of Gator Bio Inc.” Pet. 76. Patent Owner’s Mandatory Notice indicates that Sartorius BioAnalytical Instruments, Inc. is Patent Owner’s sole real party-in-interest. Paper 4, 1.

B. Related Matters

Both parties identify as related matters the district court litigation in *Sartorius BioAnalytical Instruments, Inc. v. Gator Bio, Inc. et al.*, No. 5:22-CV-01417 (N.D. Cal. March 4, 2022) and an administrative case, *In the Matter of Certain Bio-layer Interferometers and Components Thereof*, Docket No. 3652 (ITC Oct. 25, 2022). Pet. 76; Paper 4, 1.

II. BACKGROUND

A. The ’585 Patent (Ex. 1001)

The ’585 patent is titled “Fiber-Optic Assay Apparatus Based on Phase-Shift Interferometry.” Ex. 1001, code (54). The claimed apparatus is useful for “detecting the presence, amount, or rate of binding of one or more analytes in a sample” using a technique “based on fiber optic interferometry.” *Id.* at 1:25–28. The technique requires a biosensor where reflected beams of light from an optical fiber are directed to and from two reflecting surfaces of the biosensor and interfere when coupled back into the optical fiber. *Id.* at 1:25–28, 2:22–31. The biosensor “includes a layer of analyte binding molecules that is positioned so that the interference between the reflected beams varies as analyte binds to” that layer and, thereby, permits evaluation of the analytes in the sample. *Id.* at 2:31–34.

The biosensor of the claimed invention is “an optical element *removably attached to the tip* of the optical fiber.” *Id.* at 15:18–19 (Board’s emphasis) (claim 1, the sole independent claim). We reproduce below Figure 2 from the ’585 patent.

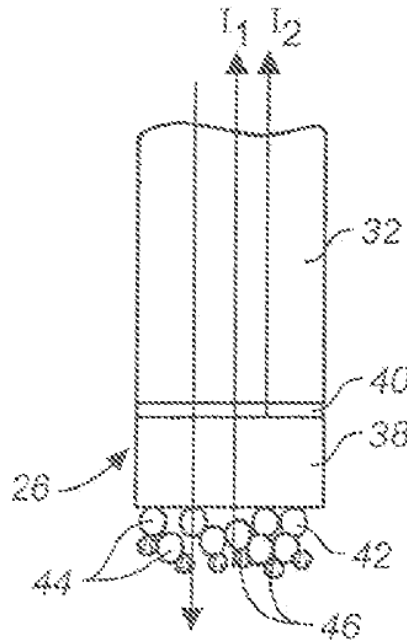


FIG. 2

Figure 2 illustrates an optical assembly formed according “to one embodiment of the invention.” *Id.* at 4:58–59. Figure 2 does not show “an optical element removably attached to the tip of the optical fiber” (*ibid.*), but rather, shows optical element 26 and “optical fiber 32 to which the optical assembly is *fixedly attached.*” *Id.* at 7:14–17 (Board’s emphasis). Patent Owner unambiguously admits that Figure 2 illustrates an “*unclaimed* embodiment” of the invention. Prelim. Resp. 54 (Patent Owner’s emphasis).

We reproduce below Figure 5 from the ’585 patent.

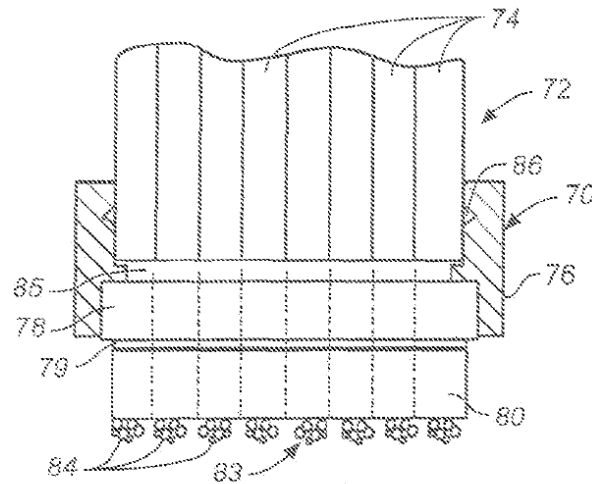


FIG. 5

Figure 5 illustrates “a disposable multi-analyte optical assembly having an analyte-binding array and constructed according to another embodiment of the invention.” *Id.* at 4:65–67. The optical “assembly is carried on the fiber bundle 72 by engagement between a pair of flexible support arm[s], such as arm 76 and an annual rim or detente 86 on the bundle.” *Id.* at 10:29–31.

B. Challenged Claims

Petitioner challenges claims 1–19 of the ’585 patent, of which claim 1 is the only independent claim. Pet. 4 (grounds chart). That claim, which we reproduce below, is representative of the subject matter at issue.

1. An optical assembly for use in detecting an analyte in a sample based on interference, comprising:
 - an optical fiber having a tip; and
 - an optical element removably attached to the tip of the optical fiber and configured for receiving a beam of light from the optical fiber,*said optical element comprising a transparent material, a first reflecting surface, and a second reflecting surface separated from the first reflecting surface by the transparent material,

said first and second reflecting surfaces separated by at least 50 nm,

wherein said first reflecting surface binds a layer of analyte binding molecules positioned so that interference between a beam of light reflected from the first reflecting surface into the optical fiber and a beam of light reflected from the second reflecting surface into the optical fiber varies as analyte binds to the layer of analyte binding molecules.

Ex. 1001, 15:16–33 (emphasis added). We refer to the emphasized requirement as the “removable attachment limitation.”

C. Asserted Grounds of Unpatentability

Petitioner asserts two grounds under 35 U.S.C. § 103², as follows:

Ground	Claims Challenged	References
1	1–19	Yang ³ , Yu ⁴
2	1–19	Sun ⁵ , Yu

² The Leahy-Smith America Invents Act (“AIA”), Pub. L. No. 112-29, 125 Stat. 284 (September 16, 2011), includes revisions to Section 103 that became effective on March 16, 2013. Because the ’585 patent issued prior to that effective date, we apply the pre-AIA statutory provisions in this case. Ex. 1001, code (45) (issued November 6, 2012).

³ Yuxiao Yang et al., *Direct monitoring of antigen-antibody interactions by optical fiber bioprobe*, PROCEEDINGS OF SPIE, THIRD INTERNATIONAL CONFERENCE ON PHOTONICS AND IMAGING IN BIOLOGY AND MEDICINE, 4245:431–436 (2003) (Ex. 1009).

⁴ Fang Yu et al., *Reflectometry Interference Spectroscopy in Detection of Hepatitis B Surface Antigen*, CLINICAL CHEMISTRY, 46(9):1489–1490 (Sept. 2000) (Ex. 1011).

⁵ Yan Sun et al., *Fiber Optic-Direct-Sensing Biosensor Applied in Detecting Biolayer Thickness of Nanometer Grade*, ACTA PHOTONICA SINICA, 31(6):657–661 (June 2022) (Ex. 1010) (certified English translation).

Pet. 4. The Petition is supported by the corrected Declaration of Dr. David Schaafsma. Ex. 1002.

III. DENIAL UNDER § 325(d)

We have discretion to deny review when “the same or substantially the same prior art or arguments previously were presented to the Office.” 35 U.S.C. § 325(d). Patent Owner requests that we exercise our discretion and deny institution of review under § 325(d) based on the prosecution history. Prelim. Resp. 34–43. The Petition includes arguments against entry of a discretionary denial under § 325(d) based on the prosecution history. Pet. 74–76.

We resolve Patent Owner’s request under a two-part framework: First, we assess whether the Examiner considered the same or substantially the same prior art or arguments asserted in the Petition and, if so, we resolve whether Petitioner shows sufficiently that the Examiner erred in a manner material to the patentability of the challenged claims. *Advanced Bionics, LLC v. MED-EL Elektromedizinische Geräte GmbH*, IPR2019-01469, Paper 6 at 8 (PTAB Feb. 13, 2020) (precedential) (“*Advanced Bionics*”).

In applying the two-part framework articulated in *Advanced Bionics*, we consider several non-exclusive factors, including:

- (a) the similarities and material differences between the asserted art and the prior art involved during examination;
- (b) the cumulative nature of the asserted art and the prior art evaluated during examination;
- (c) the extent to which the asserted art was evaluated during examination, including whether the prior art was the basis for rejection;
- (d) the extent of the overlap between the arguments made during examination and the manner in which petitioner relies on the prior art or patent owner distinguishes the prior art;

(e) whether petitioner has pointed out sufficiently how the examiner erred in its evaluation of the asserted prior art; and

(f) the extent to which additional evidence and facts presented in the petition warrant reconsideration of the prior art or arguments.

Becton, Dickinson & Co. v. B. Braun Melsungen AG, IPR2017-01586, Paper 8 at 17–18 (PTAB Dec. 15, 2017) (precedential as to Section III.C.5, first paragraph) (“*Becton, Dickinson*”).

Becton, Dickinson factors (a), (b), and (d) relate to whether the art or arguments presented in the Petition are the same or substantially the same as those previously presented to the Office. *Advanced Bionics*, Paper 6 at 10. Factors (c), (e), and (f) “relate to whether the petitioner has demonstrated a material error by the Office” in its prior consideration of the prior art or arguments. *Id.* In general, only if the same or substantially the same art or arguments previously were presented to the Office, do we turn to whether Petitioner has established a material error. *Id.* “At bottom, this framework reflects a commitment to defer to previous Office evaluations of the evidence of record unless material error is shown.” *Id.* at 9.

We organize our analysis into five main sections, discussing, in turn, (A) the prior art asserted in Petitioner’s challenges; (B) the relevant prosecution history of the ’585 patent; (C) whether Petitioner raises the same or substantially the same prior art previously presented to the Office during prosecution; (D) whether Petitioner raises the same or substantially the same arguments presented to the Office during prosecution; and (E) whether Petitioner shows that a material error occurred during examination.

A. Overview of the Asserted Prior Art References

(1) Yang

Yang is titled “Direct monitoring of antigen-antibody interactions by optical fiber bioprobe.” Ex. 1008, 4. Petitioner directs us to Figure 3 of Yang, which we reproduce below.

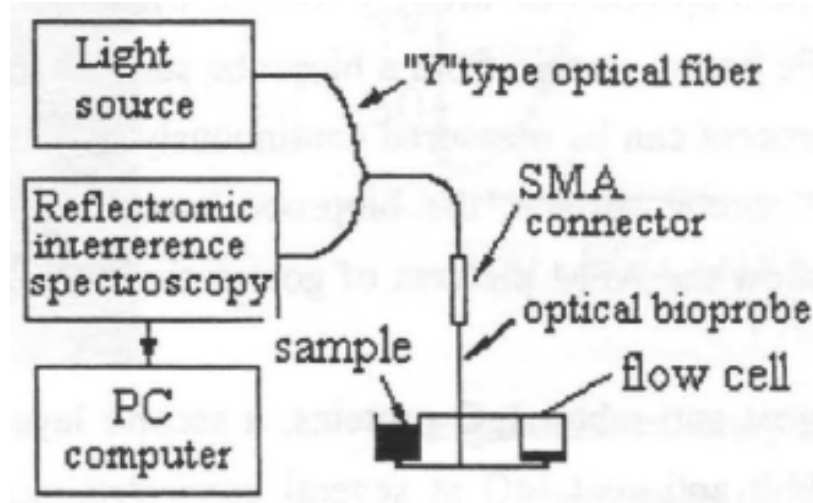


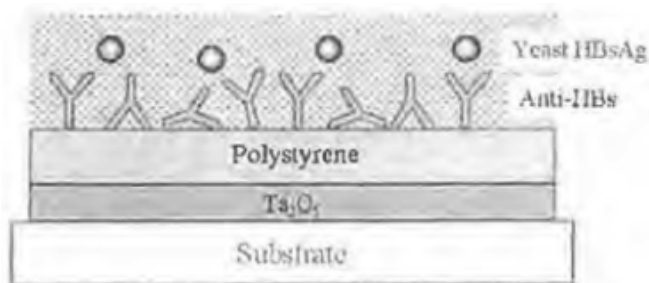
Fig 3 Sketch map of the Rifs testing system

Figure 3 is a sketch of the RIFS⁶ testing system of Yang. *Id.* at 6. Figure 3 shows a testing system that includes, among other features, a Y-shaped “optical fiber,” an “SMA connector,” and an “optical bioprobe.” *Id.* Yang explains, “All section [sic] connected with standard SMA905 connector.” *Id.*

(2) Yu

Yu is titled “Reflectometry Interference Spectroscopy in Detection of Hepatitis B Surface Antigen.” Ex. 1011, 12. Petitioner directs us to Figure 1(A) from Yu (Pet. 27), which we reproduce below.

⁶ “RIFS” refers to reflectometric interference spectroscopy. *See* Ex. 1008, 4; Ex. 1011, 12.



Ex. 1011, 12. Figure 1(A) is a “[s]chematic of [an RI-FS] transducer.” *Id.* The schematic illustrates a “Ta₂O₅ film” that is “deposited on [a] glass substrate.” *Id.* Polystyrene is “spin-coated on the chip” to produce “[a] transparent polystyrene layer” that functions as both an “interference film and the hydrophobic surface for immobilization of antibodies.” *Id.* “The change of optical thickness caused by interfacial binding can be probed with a spectrometer, using white-light interference.” *Id.* In particular, as shown in Figure 1(A), “yeast hepatitis B surface antigen (HBsAg) and its monoclonal antibodies (anti-HBs) were chosen as a model system.” *Id.*

Petitioner directs the Board to no disclosure in Yu of an “optical element removably attached to the tip of [an] optical fiber,” and Patent Owner avers that Yu contains no relevant disclosure on that point. Ex. 1001, 15:18–19 (claim 1); *see* Pet. 59–62 (identifying no disclosure in Yu that suggests that feature of claim 1); Prelim. Resp. 15 (“Yu offers no specifics of any kind about what the apparatus as a whole would look like,” and “there is no suggestion in Yu that the transducer shown in” Figure 1(A) “is removable, or that it is removably attached to the tip of the optic fiber.”).

(3) Sun

Sun is titled “Fiber Optic Direct-Sensing Biosensor Applied in Detecting Biolayer Thickness of Nanometer Grade.” Ex. 1010, 2. Petitioner directs us to Figure 3 from Sun (Pet. 49), which we reproduce below.

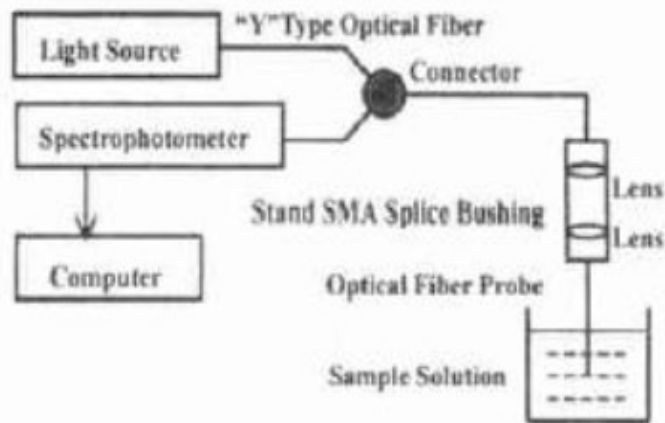


Figure 3 Detecting system structure

Ex. 1010, Fig. 3. Figure 3 is labeled “Detecting system structure” and illustrates a Y-shaped optical fiber in Sun’s device that, according to Petitioner, is connected to “an ‘optical fiber’ portion” by virtue of “a ‘standard SMA connector,’ which again is a common screw-type mechanical coupling with male and female components that removably engage one another.” Pet. 49–50 (reproducing Ex. 1010, Fig. 3) (citing Ex. 1002 ¶ 126; Ex. 1010, Figs. 1, 3, 657–658; Ex. 1033, 310-1–310-2; Ex. 1034, 266).

B. Examination History

As explained on the face of Exhibit 1001, U.S. Application No. 12/790, 736, which issued as the ’585 patent, is a continuation of U.S. Application No. 12/099,751 (“parent application”). Ex. 1001, code (60).⁷ Petitioner and Patent Owner both direct our attention to the file history of the parent application. *See* Pet. 18–21; Prelim. Resp. 6–8 (both parties detailing

⁷ Petitioner submits that the ’585 patent application and the parent application were examined by two different Examiners. Pet. 21. Patent Owner disagrees, arguing the same examiner reviewed the claims of both applications. Prelim. Resp. 9. We decline to resolve that dispute because its resolution is not necessary to this Decision. We refer to “the Examiner” only for convenience and not to indicate agreement with Patent Owner’s position.

the history of the parent application). Where neither party objects to relying on the record of prosecution associated with the parent application and, moreover, both parties cite and discuss that history in their briefs, we likewise consider the prosecution history of the parent application when assessing whether to exercise our discretion and deny the Petition under § 325(d). That is particularly appropriate here, where the applicant filed a terminal disclaimer of the challenged claims in view of the claims that issued from the parent application. *See* Ex. 1007, 241.

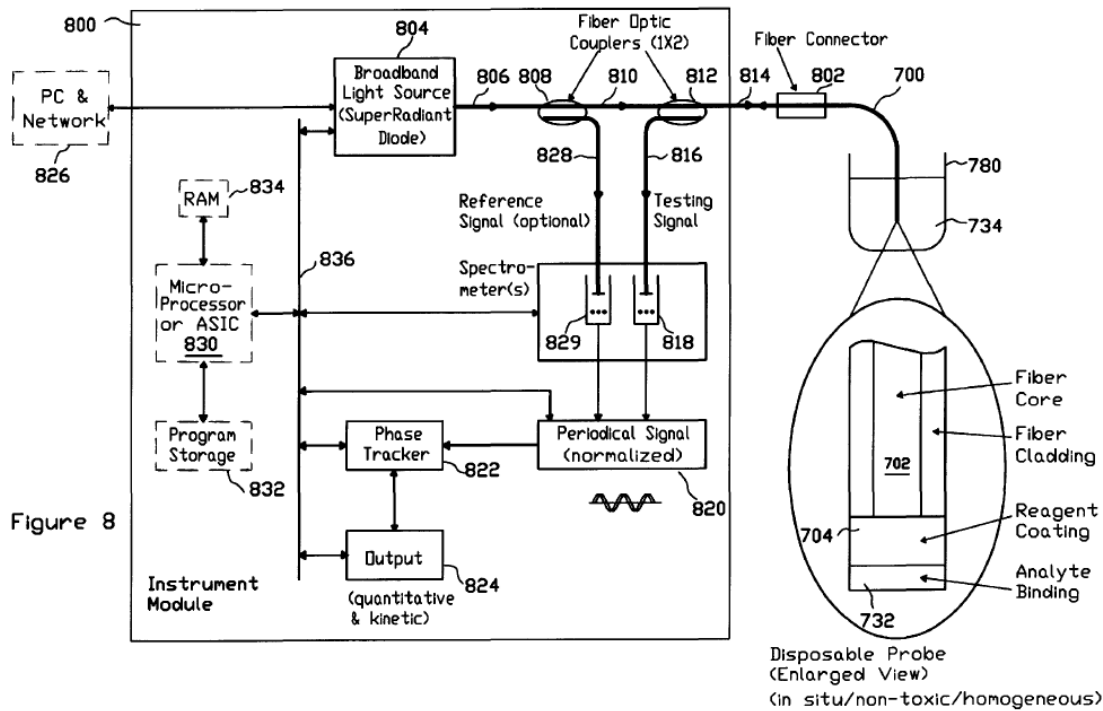
On this record, we determine that the prosecution histories of the '585 patent and its parent application are intertwined. As Patent Owner observes, Yang and Chen⁸ were applied extensively during examination of the parent application. Prelim. Resp. 7 (and citations therein to Exhibit 1006)⁹ (the record of examination of the parent application). In particular, the Examiner rejected claims in the parent application based on Yang (Ex. 1008), Chen (Ex. 1012), and Brecht 1997 (Ex. 1017)¹⁰.

Like Yang and Sun, Chen discloses a standard fiber connector, which is element 802 in Chen's Figure 8, which we reproduce below.

⁸ US Patent No. 5,804,453, issued Sept. 8, 1998 (Ex. 1012).

⁹ Petitioner and Patent Owner entered separate exhibits as the record of examination for the parent application. *See* Ex. 1006; Ex. 2008. Where neither party explains any material difference between these exhibits, we confine our citations to Petitioner's Exhibit 1006.

¹⁰ Andreas Brecht et al., *Recent developments in optical transducers for chemical or biochemical applications*, SENSORS AND ACTUATORS B, 38–39:1–7 (1997) (Ex. 1017).



Ex. 1012, Fig. 8. Figure 8 is a schematic drawing of a biosensor according to Chen. *Id.* at 8:59–60. Figure 8 illustrates the placement of disposable bioprobe 700, which “is optically coupled with” optical waveguide 814 via fiber connector 802. *Id.* at 11:19–21.

During prosecution of the parent application, the Examiner advanced “Chen as teaching ‘a fiber connector (Fig. 8, 802) which removably attaches the optical assembly (Fig. 8, 700) to the fiber tip (Fig. 8, the tip of fiber 814).” Prelim. Resp. 7 (quoting Ex. 1006, 65). In response, the applicant amended the claims of the parent application to specify “flexible gripping arms that slide over and grip the optical fiber to removably attach” the optical fiber to the optical assembly. *Id.* at 7–8 (quoting Ex. 1006, 92, 95).

During prosecution of the application that issued as the ’585 patent, the Examiner entered a rejection “for double patenting over the claims of the” patent that issued from the parent application. Prelim. Resp. 8 (citing

Ex. 1007, 208)¹¹. The applicant overcame this rejection by submitting a terminal disclaimer and, on that basis, the challenged claims issued without amendment. Pet. 22 (citing Ex. 1007, 202–209, 241).

C. Same or Substantially the Same Prior Art

The Petition sets forth two grounds; one asserts Yang and Yu, and the other asserts Sun and Yu. Pet. 4 (grounds chart). There is agreement that the Examiner relied on Yang during prosecution of the parent application and, further, that Yang was presented to the Examiner during prosecution of the application that issued as the '585 patent. Pet. 75; Prelim. Resp. 35–36. Petitioner offers no argument that Yang was not presented to the Office during examination. *See* Pet. 74 (limiting argument as to substantial similarity of the asserted prior art to a discussion of Sun and Yu). On this record, we determine that Yang previously was presented to the Office.

Turning to Sun, we agree with Petitioner that this reference was not previously presented to the Office during examination. Pet. 74. As Patent Owner correctly observes, however, Sun teaches little, if anything, more relevant to Petitioner's obviousness challenge than Chen, which was a focus of the examination of the parent application. Prelim. Resp. 36–37. For reasons well-stated by Patent Owner, we determine that Sun is cumulative of Chen. *Id.* (citing Ex. 1010, 3–4 (Sun); Ex. 1012, 5:3–7; 8:9–11 (Chen)). In particular, Sun does not disclose an optical element, removably attached to the tip of an optical fiber, with any more precision or clarity than does Chen.

¹¹ Here again, Patent Owner and Petitioner filed separate exhibits corresponding to the record of examination. *See* Ex. 1007; Ex. 2009. For simplicity, and because neither party argues that the exhibits differ in any material respect, we confine our citations to Petitioner's Exhibit 1007.

Compare Ex. 1012, Fig. 8 (reproduced *supra* 13, showing location of Chen’s fiber connector 802), *with* Ex. 1008, Fig. 3, 657–658 (reproduced *supra* 11, showing location of Sun’s standard SMA connector).

Petitioner also advances Yu in the challenges at hand. Pet. 4 (grounds chart, asserting Yang combined with Yu, and Sun combined with Yu). When mapping the limitations of independent claim 1 to disclosures in Yang and Yu, however, Petitioner cites almost exclusively to Yang. *See* Pet. 31–41 (repeatedly asserting that Yang “alone or in combination with Yu” renders obvious the features of claim 1, but repeatedly citing exclusively to disclosures in Yang). Petitioner, in fact, cites only to Yang with two exceptions. *Id.* First, Petitioner advances Yu to bolster Petitioner’s argument that Yang discloses a transparent interference layer. *Id.* at 36. Second, Petitioner argues, “Although Yang does not show the Ta₂O₅ layer in Figure 1a, Yu shows the Ta₂O₅ layer as sandwiched between” a substrate and “the polystyrene layer.” *Id.* at 37.

Similarly, when mapping the limitations of independent claim 1 to disclosures in Sun and Yu, Petitioner cites almost exclusively to Sun. *See* Pet. 57–41 (repeatedly asserting that Sun “alone or in combination with Yu” renders obvious the features of claim 1, but repeatedly citing exclusively to disclosures in Yang). Petitioner cites only to Sun with two exceptions. *Id.* First, Petitioner cites Yu to argue that an ordinarily skilled artisan would have substituted Sun’s “polystyrene” layer with Yu’s “transparent polystyrene layer.” *Id.* at 59, 64. Second, Petitioner advances a disclosure in Yu to argue that it would have been obvious to incorporate Yu’s “thin layer of tantalum pentoxide” as a “second reflecting surface” in Sun’s device

(Pet. 63), which, according to Petitioner, would have been routinely optimized to a thickness necessary to meet the claim limitation that requires “first and second reflecting layers separated by at least 50 nm” (Ex. 1001, 15:24–25; Pet. 64).

Patent Owner argues that “Yu is cumulative of the work done by Brecht in the 1990s,” namely, papers published by Brecht that were a focus of the examination of the parent application. *See* Prelim. Resp. 16 (including citations to the record relating to references described as Brecht 1992, Brecht 1993, and Brecht 1997). That argument is not without merit, where Yu acknowledges “that RIfS ‘has been systematically developed and investigated by Brecht et al.’” Prelim. Resp. 16 (quoting Ex. 1001, 12).

In any event, even if we accept Petitioner’s view that Yu is not cumulative of any reference cited during examination, we do not view Yu, as asserted in the challenges, as moving the needle much in favor of instituting review. Petitioner relies primarily on Yang and Sun to make out all, or nearly all, of the limitations of the sole independent challenged claim. Pet. 31–41, 57–66 (mapping substantially all limitations of claim 1 to disclosures in Yang and Sun). For example, when directing the Board to evidence that the removable attachment limitation would have been obvious, Petitioner cites exclusively to disclosures in Yang or Sun. *Id.* at 34–35, 61. Importantly, on this record, the only dispute on the merits is whether Petitioner shows sufficiently that the modified apparatus of Yang or Sun would have included that limitation. *See* Prelim. Resp. 43–54 (confining Patent Owner’s discussion of the merits to that issue).

For these reasons, we determine that Petitioner’s challenges raise substantially the same prior art previously presented to the Office. That

determination, standing alone, warrants our assessment of the second part of the two-part framework articulated in *Advanced Bionics*, namely, whether Petitioner directs us to evidence sufficient to demonstrate a material Examiner error. *See Advanced Bionics*, Paper 6 at 8.

Before turning to that question, however, we address in the next section whether, and to what extent, Petitioner raises the same or substantially arguments previously presented to the Office. Our resolution of that question provides an alternative rationale that independently warrants consideration of the adequacy of Petitioner’s information pertaining to error.

D. Same or Substantially the Same Arguments

The inquiry under § 325(d) focuses on “the extent of the overlap between the arguments made during examination and the manner in which” Petitioner relies on the prior art in the Petition. *Advanced Bionics*, Paper 6 at 9 n.10. Petitioner does not assess the extent of this overlap. *See Pet.* 74–76 (limiting its discussion to only whether the prior art is substantially the same and whether the Office materially erred during the patent examination).

Patent Owner, by contrast, assesses the overlap between arguments in an analysis that stands uncontested on this record. *See Prelim. Resp.* 40, 42 (citing *Pet.* 34–35, 50, 61, for arguments in the Petition that, according to Patent Owner, overlap with arguments considered by the Examiner). We find significant that Petitioner requested, and we granted, permission to file a reply brief to address issues in the Preliminary Response that do not include the instant issue. *See Ex.* 3002 (email request and Board’s authorization). Against that backdrop, on this record, we accept Patent Owner’s un rebutted contentions that arguments considered by the Examiner, directed to Chen’s disclosures relating to the removable attachment limitation, are “nearly

identical” to arguments raised in the Petition directed to the disclosures of Yang and Sun. Prelim. Resp. 40.

For example, “Petitioner argues that ‘the optical-fiber portion of Yang’s probe is removably attached to the tip of a ‘Y’ type (Y-shaped) optical fiber via a ‘standard SMA 905 connection,’ a common screw-type coaxial coupling mechanism with male and female components that removably attach to one another.” *Id.* (citing Pet. 61). In addition, Petitioner asserts that Sun’s “common screw-type mechanical coupling with male and female components” facilitates the removable attachment of an optical element to the tip of an optical fiber. *Id.* at 41–42 (citing Pet. 34–35, 50).

The Examiner similarly “argued that ‘Chen teaches a fiber connector (Fig. 8, 802) which removably attaches the optical assembly (Fig. 7, 700) to the fiber tip (Fig. 8, the tip of fiber 814).” *Id.* at 40 (citing Ex. 1006, 65). Petitioner does not address any differences, much less explain any material difference, between the arguments raised in the Petition, pertaining to the standard connectors disclosed in Yang and Sun, and the arguments considered by the Examiner, regarding Chen’s fiber connector 802. Pet. 74.

In our view, some explanation is necessary, where Yang was cited along with Chen in that very same Office Action, and Yang was discussed again in the Examiner’s Notice of Allowance. Ex. 1006, 66, 68. Some explanation is necessary, moreover, where Sun, on this record, does not disclose an optical element, removably attached to the tip of an optical fiber, with any more precision or clarity than does Chen. *Compare* Ex. 1012, Fig. 8 (reproduced *supra* 13, showing location of Chen’s fiber connector 802), *with* Ex. 1010, Fig. 3, 657–658 (reproduced *supra* 11, showing location of Sun’s standard SMA connector).

Based on the information presented, therefore, we determine that the arguments made in the Petition significantly overlap with those previously considered by the Office. Prelim. Resp. 39–42. That determination represents an alternative rationale that independently warrants our consideration of the adequacy of Petitioner’s information pertaining to Examiner error, which we turn to next.

E. Petitioner’s Showing as to Examiner Error

Petitioner directs us to two allegedly material Examiner errors, namely, failure to consider Yang and failure to consider new evidence asserted in the Petition. Pet. 83–84. We address each asserted error in turn.

(1) Alleged Failure to Consider Yang

Petitioner bears the burden of showing that the Examiner erred, for example, by “misapprehending or overlooking specific teachings of the relevant prior art whose teachings impact patentability of the challenged claims.” *Advanced Bionics*, Paper 6 at 8. On that point, Petitioner argues that the Examiner of the application that issued as the ’585 patent overlooked or failed to appreciate the full scope of the disclosures in Yang. Pet. 74–75.

To be clear, in Petitioner’s view, the Office allowed claims to issue from the parent application “only after” the applicant amended the claims “to require a specific attachment mechanism comprising ‘flexible gripping arms,’” corresponding, for example, to the embodiment of the invention illustrated in Figure 5, reproduced *supra* 5. Pet. 75 (quoting Ex. 1006, 42–43, 92–93, 95, 127) (Petitioner’s emphasis omitted). Petitioner argues that the “exact same claims,” which required amendment during examination of the parent application, issued without “any prior art rejections or requiring

any amendments” from the application that issued as the ’585 patent. *Id.* (quoting Ex. 1007, 42–43, 208–209, 241) (Petitioner’s emphasis omitted).

We find this history insufficient to establish that the Office “did not appreciate the relevant scope of Yang” when examining the application that issued as the ’585 patent. To the contrary, by advancing a double patenting rejection, the Examiner acknowledged that the challenged claims, including the removable attachment limitation, are not patentably distinct from the claims that issued from the parent application, namely, claims that specify an attachment mechanism that includes “flexible gripping arms.” Ex. 1006, 92. Significantly, to overcome the double patenting rejection, the applicant submitted a terminal disclaimer, which represents an admission that the challenged claims are not patentably distinct from the claims that issued from the parent application. *Id.* at 127.

That admission during the patent examination comports with Patent Owner’s admission in the Preliminary Response that the challenged claims are not broad enough to embrace the embodiment depicted in Figure 2 of the ’585 patent. Prelim. Resp. 54. We see no meaningful difference, and Petitioner identifies none, between the embodiment shown in Figure 2 and the apparatus of Yang or Sun as modified by Yu, upon which Petitioner’s instant challenge is based. *See supra* 4 (reproducing Figure 2).

Significantly, in that regard, Petitioner consistently and repeatedly directs us to Yang’s Figure 1b, without explaining adequately, if at all, how that figure is distinguishable from the “unclaimed embodiment” shown in Figure 2 of the ’585 patent. Prelim. Resp. 54; *see* Pet. 25, 31, 34, 43 (reliance on Yang’s Figure 1b). Petitioner relies on a similar, if not identical, configuration in Sun without any analysis of how the modified device of Sun

differs from the “unclaimed embodiment” of Figure 2. Prelim. Resp. 54; *see* Pet. 50–51 (explaining features of Sun’s device). Patent Owner, by contrast, advances significant information that details how and why the disclosures in Yang and Sun, upon which Petitioner relies to make out the removable attachment limitation of the challenged claims, correspond to the unclaimed embodiment of Figure 2 in the ’538 patent. Prelim. Resp. 51–54.

Accordingly, on this record, we determine that Petitioner does not show sufficiently a material error during prosecution based on the Examiner’s asserted failure to appreciate the full scope of Yang.

(2) Failure to Consider Petition Evidence

Alternatively, in a single sentence, Petitioner argues that the Board should decline to exercise its discretion to deny review under § 325(d) because the Petition advances “additional evidence in the form of an expert declaration and supporting exhibits showing how the combinations in each ground teach every element of the challenged claims” and why an ordinarily skilled artisan would have pursued the proposed combination. Pet. 75–76.

This argument is conclusory because it is unsupported by any analysis tethered to the particular facts at hand. *See id.* Petitioner avers to the existence of a declaration, which does nothing to distinguish this Petition from the bulk of others that come before the Board. *See id.* Consequently, under the particular and unique circumstances presented on this record, we find this argument insufficient to show “the extent to which additional evidence and facts presented in the petition warrant reconsideration of the prior art or arguments.” *Becton, Dickinson, Paper 8* at 18.

IV. CONCLUSION

Taking a holistic view of the totality of information presented, we determine that the challenges set forth in the Petition are based on the same or substantially the same prior art or arguments previously presented to the Office during patent examination. Petitioner directs us to information insufficient to establish a material Examiner error. Accordingly, we exercise our discretion under § 325(d) and do not institute an *inter partes* review.

V. ORDER

It is
ORDERED that the Petition is *denied* and no *inter partes* review is instituted.

IPR2023-00215
Patent 8,305,585 B2

For PETITIONER:

Hariharan Santhanam
James Valentine
PERKINS COIE LLP
santhanam-ptab@perkinscoie.com
valentine-ptab@perkinscoie.com

For PATENT OWNER:

Jonathan Herstoff
HAUG PARTNERS LLP
jherstoff@haugpartners.com