

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ETHICON ENDO-SURGERY, INC.,
Petitioner,

v.

COVIDIEN AG,
Patent Owner.

Case IPR2016-00944
Patent 8,241,284 B2

Before JAMES A. TARTAL, ZHENYU YANG, and JAMES A. WORTH,
Administrative Patent Judges.

YANG, *Administrative Patent Judge.*

DECISION
Denying Institution of *Inter Partes* Review
37 C.F.R. § 42.108

INTRODUCTION

Ethicon Endo-Surgery, Inc. (“Petitioner”) filed a Petition (Paper 1 (“Pet.”)), seeking an *inter partes* review of claims 1 and 3–11 of U.S. Patent No. 8,241,284 B2 (“the ’284 patent,” Ex. 1001). Covidien AG (“Patent Owner”) timely filed a Preliminary Response. Paper 6 (“Prelim. Resp.”).

Upon consideration of the Petition and the specific facts of this case, we exercise our discretion under 35 U.S.C. §§ 314(a) and 325(d), and decline to institute an *inter partes* review of claims 1 and 3–11 of the ’284 patent.

Related Proceedings

Petitioner previously filed a petition in IPR2015-01275 (“1275 IPR”), seeking review of claims 1–18 of the ’284 patent. *Ethicon Endo-Surgery, Inc. v. Covidien AG*, 1275 IPR, Paper 1. The Board denied that petition. 1275 IPR, Paper 10.

The ’284 Patent

The ’284 patent relates to an endoscopic bipolar electrosurgical forceps for clamping, sealing and/or dividing tissue. Ex. 1001, 3:40–42. The forceps includes an elongated shaft having opposing jaw members. *Id.* at 3:42–43. At least one non-conductive and spaced-apart stop member is disposed on an inner-facing surface of at least one of the jaw members and is positioned to control the gap distance between the opposing jaw members when the tissue is held therebetween. *Id.* at 3:50–54. A longitudinally reciprocating knife severs the tissue proximate the sealing site once an effective seal is formed. *Id.* at 3:54–56.

Illustrative Claim

Claims 1 is the only challenged independent claim. It is reproduced below:

1. An endoscopic bipolar forceps, comprising:
an elongated shaft having opposing jaw members at a distal end thereof, the jaw members including a length and a periphery and movable relative to one another from a first position wherein the jaw members are disposed in spaced relation relative to one another to a second position wherein the jaw members cooperate to grasp tissue therebetween, the jaw members each including respective flat seal surfaces extending along a respective length thereof and adaptable to connect to a source of electrical energy such that the jaw members are capable of conducting energy through tissue held therebetween to effect a tissue seal;
a plurality of non-conductive stop members disposed along the length of at least one of the seal surfaces of at least one of the jaw members such that the plurality of non-conductive stop members are disposed along the same plane on the seal surface with respect to one another, the non-conductive stop members configured to maintain a uniform distance between the jaw members along the length thereof; and a knife disposed in operative communication with at least one of the jaw members and translatable to sever tissue disposed between jaw members.

Asserted Grounds of Unpatentability

Petitioner asserts the following grounds of unpatentability:

Claim(s)	Basis	References
1 and 3–11	§ 103	Kese, ¹ Fox, ² and Eggers '142 ³
11	§ 103	Kese, Fox, Eggers '142, and Slater ⁴

In support of its patentability challenge, Petitioner relies on the Declaration of David C. Yates. Ex. 1004.

ANALYSIS

Institution of *inter partes* review is discretionary. *See* 35 U.S.C. § 314(a); 37 C.F.R. § 42.108(a). In addition, under 35 U.S.C. § 325(d):

In determining whether to institute or order a proceeding under . . . chapter 31, the Director may take into account whether, and reject the petition or request because, the same or substantially the same prior art or arguments previously were presented to the Office.

Based on the totality of the facts in this case, we exercise our discretion and do not institute review of claims 1 and 3–11 of the '284 patent. *See* 35 U.S.C. §§ 314(a), 325(d).

In 1275 IPR, Petitioner challenged claims 1–18 of the '284 patent on numerous grounds, asserting, among others, that claims 1–11 would have

¹ Kese et al., U.S. Patent No. 6,024,744, issued February 15, 2000 (Ex. 1005, “Kese”).

² Fox et al., U.S. Patent No. 5,674,220, issued October 7, 1997 (Ex. 1006, “Fox”).

³ Eggers et al., U.S. Patent No. 5,891,142, issued April 6, 1999 (Ex. 1007, “Eggers '142”).

⁴ Slater et al., U.S. Patent No. 5,396,900, issued March 14, 1995 (Ex. 1011, “Slater”).

been obvious over the combination of Fox and Eggers '142, and that claim 11 also would have been obvious over the combination of Fox, Eggers '142, and Slater. *See* 1275 IPR, Paper 1, 11. Each challenged claim requires a plurality of non-conductive stop members “configured to maintain a uniform distance between the jaw members along the length thereof.” In that case, Petitioner argued the “island of insulation” in Fox is a non-conductive stop member that creates a uniform desired gap distance. *Id.* at 23. Petitioner also contended that the electrically insulative spacer regions 124a–124f and 126a–126f in Figures 8–10 of Eggers '142 are examples of the non-conductive stop members that provided for the claimed “uniform distance between the jaw members.” *Id.* at 21–23.

We denied the petition in 1275 IPR. There, we construed the term “a uniform distance between the jaw members along the length thereof” to mean that, when tissue is held between the opposing jaw members, the distance between the jaw members is the same along the entire length thereof. *See* 1275 IPR, Paper 10, 8. Based on that construction, we concluded that Petitioner did not, in the petition of 1275 IPR, point to sufficient evidence or present persuasive argument to show that either Fox or Eggers '142 teaches non-conductive stop members “configured to maintain a uniform distance between the jaw members along the length thereof.” *Id.* at 16.

More than four months after we denied the petition in 1275 IPR, Petitioner filed this second Petition, challenging claims 1 and 3–11 of the '284 patent. In addition to the same prior art Petitioner previously relied on in 1275 IPR (i.e., Fox, Eggers '142, and Slater), Petitioner adds another prior

art reference Kese. Kese, a U.S. patent assigned to Petitioner (Ex. 1005, [73]), is cited on the face of the challenged '284 patent (Ex. 1001, page 4). According to Petitioner, “[a]nalysis of new art was required” to address the “unforeseeable and unexpected” claim construction in 1275 IPR. Pet. 1, 54–58. We are not persuaded.

First, our claim construction requiring uniform distance between the jaw members when tissue is held between the opposing jaw members was not “unforeseeable and unexpected” to Petitioner. Indeed, in the petition of 1275 IPR, Petitioner argued that “to the extent the claimed stop members must define, in part, the distance between sealing surfaces *when tissue is grasped therebetween*, Figs. 8–9 of *Eggers '142* illustrate the requisite uniform distance.” 1275 IPR, Paper 1, 25 (emphasis added).

Second, as the Petition suggests, the teachings of Kese are substantially the same as those of Fox. For example, according to Petitioner, Kese teaches insulating coating 28 as “an example of a single non-conductive stop member” that maintains an insulating gap (Pet. 33–34 (citing Ex. 1005, 7:36–38, 8:32–38), and Fox “likewise discloses a single stop member by discussing an ‘island of insulation’ to establish an insulative gap” (*id.* at 34 (citing Ex. 1006, 4:25–29)). *See also* Ex. 1004 ¶ 50 (stating the disclosure of Kese is “akin to” the disclosure in Fox).

In addition, the Petition relies on Kese to support substantially the same arguments as presented in 1275 IPR. Indeed, Petitioner argues that Kese and Fox “each discloses a non-conductive stop member that maintains a gap distance.” Pet. 42. As a result, Petitioner contends, “when *Kese's* teaching of an insulating coating 28 and/or *Fox's* teaching of an island of

insulation is modified per *Eggers '142*, the resulting plurality of non-conductive stop members are configured to maintain a uniform distance (*i.e.*, gap distance) between the jaw members along a length thereof.” *Id.* at 39.

Third, contrary to Petitioner’s representation that “it does not use the Board’s prior decision as a blue print to plug holes in its prior filing” (*see id.* at 19), the instant Petition repeatedly addresses deficiencies in the 1275 IPR. In fact, according to Petitioner, “This Petition Addresses the Unforeseeable, Unexpected Conclusions of the 1275 IPR Decision.” *Id.* at 54.

For example, Petitioner states that Kese “is necessary to remedy th[e] partially-found deficiency” in 1275 IPR. *Id.* at 56. In addition, Petitioner contends that “Figures 25 and 26 of *Eggers '142* demonstrate the ‘uniform distance’ required by the Board’s construction.” *Id.* at 38. Petitioner states that “Figures 25 and 26 were not relied on in the 1275 IPR because their illustration of tissue between jaws was not needed until the unforeseeable claim construction in the Decision in the 1275 IPR.” *Id.* at 22 n.9.

Statements like this not only contradict Petitioner’s recognition of uniform distance as “the distance between sealing surfaces when tissue is grasped therebetween” in 1275 IPR (1275 IPR, Paper 1, 25), but also reveal Petitioner’s attempt to use our decision in 1275 IPR as a guide to formulate the arguments in this Petition.

The America Invents Act was enacted to provide a speedy and inexpensive alternative to challenging patent validity in district courts. It does not, however, sanction repeated administrative attacks on the patentability of a claim. *See, e.g.*, H.R. Rep. No. 112-98, pt.1, at 48 (2011). Here, because Petitioner relies on substantially the same prior art and

IPR2016-00944
Patent 8,241,284 B2

arguments as in 1275 IPR, and because this Petition uses our previous decision as a roadmap to remedy the deficiency in 1275 IPR, we exercise our discretion and deny the Petition under 35 U.S.C. §§ 314(a) and 325(d).

ORDER

Accordingly, it is

ORDERED that the Petitioner's request for an *inter partes* review is *denied* and no trial is instituted for claims 1 and 3–11 of the '284 patent.

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