



ARE PTAB Alert: PTAB Judges Deny Institution of IPRs and Reject Their Role as “Archeologists” of the Record

Author(s): Kenneth P. George, Brian A. Comack ,

On November 18, 2019, the Patent Trial and Appeal Board (the “PTAB”) denied institution of a series of *inter partes* review (“IPR”) proceedings brought by Petitioner Lifescan Global Corporation (“Petitioner”) against Patent Owner PHC Holdings Corporation’s (“Patent Owner”) biosensor patents: Patent Nos. 8,480,878 B2 (the “’878 patent”) and 8,349,157 B2 (the “’157 patent”). (IPR2019-01127, and -01128). ARE represented the Patent Owner in both proceedings.

Both the ’878 and ’157 Patents disclose particular arrangements of the specimen supply path, reagent layer, and electrodes formed using a simple manufacturing method to increase the accuracy of each biosensor.

Petitioner had raised 14 grounds of unpatentability based on alleged anticipation and/or obviousness. However, the PTAB’s Administrative Patent Judges determined that Petitioner failed to meet the low standard of establishing a reasonable likelihood that it would prevail with respect to at least one of the challenged claims.

The PTAB’s denial of Petitioner’s arguments for unpatentability of independent claim 1 of the ’878 Patent, and independent claim 16 of the ’157 Patent are discussed below.

Claim 1 of the ’878 Patent and claim 16 of the ’157 Patent require a biosensor comprised of a “spacer layer” that covers part of a reagent layer, where the spacer layer defines a supply path for bringing the sample liquid into contact with the reagent layer, and where the supply path formed by the spacer layer is narrower than the reagent layer.

Petitioner argued that the spacer layer limitation was anticipated by the cited Heller reference, and relied upon Figures 1 and 3 to support its conclusion. However, Figure 3



does not show the spacer covering the sensing layer. Instead, the PTAB found that Petitioner was relying on “***an imaginary adaption...of the figure.***” This imaginary adaptation was rejected because it was contradicted by an actual figure that was not addressed by Petitioner or its experts. Specifically, Petitioner failed to address Figure 4, which depicts an unexploded view of the sensor and shows that the spacer layer does not cover any part of the sensing layer.

Petitioner similarly alleged anticipation of the spacer layer limitation by the Ohara reference. Petitioner relied on Figure 5 of Ohara, another exploded view of a sensor.

The PTAB rejected Petitioner’s reliance on a “***visual inspection***” of the exploded view of the sensor in Figure 5 since “Petitioner does not direct us to an image of an assembled version of Ohara’s sensor that would allow us to determine whether spacer layer [] actually covers the reagent layer, as opposed to simply being arranged above it in an exploded view.”

Petitioner next argued that the claims were anticipated by the Liamos reference. The PTAB rejected this argument because the Petitioner did not point to any portion of the reference that “explicitly teaches, or otherwise anticipates, the spacer covers part of the reagent layer.” In addition, Petitioner had failed to demonstrate that the “dielectric or other insulating material deposited on an electrode” in Liamos can be the spacer layer.

Instead, the PTAB found that the spacer and the “dielectric or other insulating material” appear to “comprise two different components...that perform two different functions.” Thus, Petitioner did not adequately demonstrate that a ***single*** component in the reference satisfies ***both*** limitations.

Lastly, Petitioner argued that each element of the claims was obvious by the Blatt reference, in view of seven other listed references. This argument was rejected because Petitioner failed to follow the PTAB’s Trial Practice Guide’s admonition that parties should “avoid submitting a repository of all the information that a judge could possibly consider, and instead focus on concise, well-organized, easy-to-follow arguments supported by readily identifiable evidence of record.”

Petitioner failed to provide reasoning as to “how each of the eight references are to be combined or which teaching from each reference are relied upon to suggest each limitation of the claims.” Instead, Petitioner’s arguments amounted to an “invitation for [the PTAB] to ***cobble together arguments***, search for pertinent facts, and inject [the PTAB’s] own reasoning.” The PTAB concluded that this was not their “role”, as they are ***not*** “***archeologists***” of the record. Thus, Petitioner had again failed to show a reasonable



likelihood of demonstrating the claims were invalid.

* Kenneth George and Brian Comack are partners at Amster, Rothstein & Ebenstein LLP. They represented the Patent Owner in both proceedings. Their practice specializes in intellectual property issues, including litigating patent, trademark and other intellectual property disputes. They may be reached at kgeorge@arelaw.com and bcomack@arelaw.com.