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Paper 7
Date: February 25, 2015

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

W. L. GORE & ASSOCIATES, INC.,
Petitioner,

v.

LIFEPORT SCIENCES LLC,
Patent Owner.

Case IPR2014-01321
Patent 5,716,365

Before JOSIAH C. COCKS, PHILLIP J. KAUFFMAN, and BENJAMIN D. M. WOOD, *Administrative Patent Judges.*

COCKS, *Administrative Patent Judge.*

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

I. INTRODUCTION

Petitioner, W. L. Gore & Associates, Inc., ("Petitioner") filed a Petition (Paper 1, "Pet.") requesting *inter partes* review of claims 1–24 of U.S. Patent No. 5,716,365 (Ex. 1001, "the '365 patent"). Patent Owner, LifePort Sciences LLC (" Patent Owner"), did not file a Preliminary Response. We have jurisdiction under 35 U.S.C. § 314.

To institute an *inter partes* review, we must determine that the information presented in the Petition shows "a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition." 35 U.S.C. § 314(a). For the reasons set forth below, we conclude that the information presented in the Petition establishes a reasonable likelihood that Petitioner will prevail in showing that claims 1–24 of the '365 patent are unpatentable. Pursuant to 35 U.S.C. § 314, we hereby authorize an *inter partes* review to be instituted as to claims 1–24.

Our factual findings and conclusions at this stage of the proceeding are based on the evidentiary record developed thus far (prior to Patent Owner's Response). This is not a final decision as to patentability of claims for which *inter partes* review is instituted. Our final decision will be based on the record, as fully developed during trial.

A. Related Matters

The '365 patent is the subject of litigation styled *LifePort Sciences LLC v. W.L. Gore & Associates, Inc.,* Case no. 12-cv-1792 (D. Del). Paper 6, 1; *see* Pet. 1.

B. The '365 Patent (Ex. 1001)

The '365 patent is titled "Bifurcated Endoluminal Prosthesis." Ex. 1001, Title. The invention is described as providing "a stent connecting means for connecting two intraluminal stents one to the other to define a continuous lumen through the two stents." *Id*. at 2:18–21. According to the '365 patent, prior art stents and prostheses are "generally satisfactory for the treatment of aneurysms, stenosis and other angeological diseases at sites in continuous unbifurcated portions of arteries or veins." *Id.* at 1:57–60. The '365 patent goes on to discount the prior art in situations "where the site of desired application of the stent of prosthesis is juxtaposed or extends across a bifurcation in an artery or vein such, for example, as the bifurcation in the mammalian aortic artery into the common iliac arteries." *Id*. at 1:61–66.

Figure 1A of the '365 patent illustrates "a front view of a bifurcated intraluminal stent in accordance with the present invention constituting part of an endoluminal prosthesis," and Figure 1B illustrates "a front view of another stent which is adapted to be connected to the bifurcated stent of FIG. 1*a*." *Id*. at 7:41-45. Those figures are reproduced below:

FIG. 1A

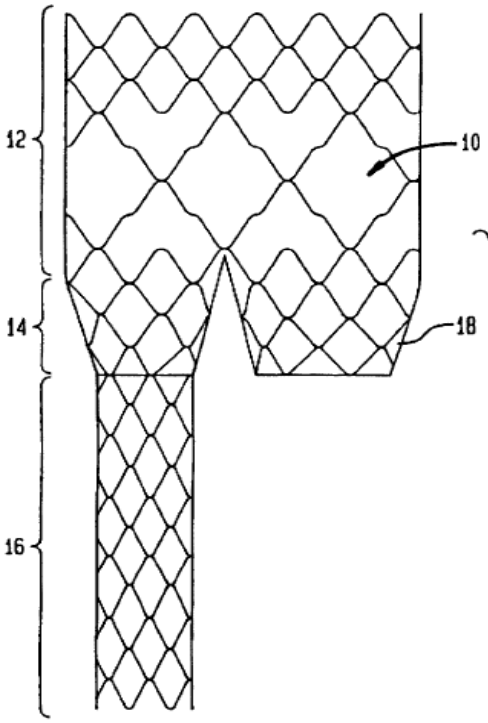
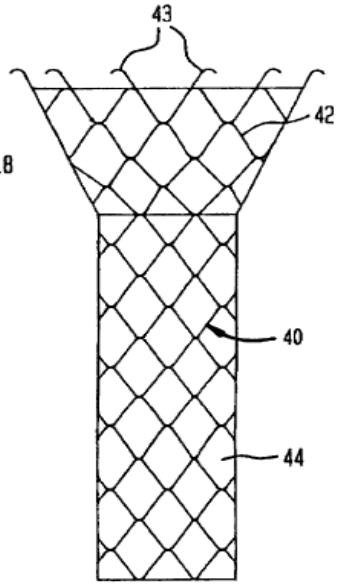


FIG. 1B



As shown in Figure 1A above, bifurcated stent 10 is composed of a wire skeleton that is constructed of four separate parts: proximal part 12, frustoconical part 14, first distal part 16, and second frustoconical part 18. *Id*. at 8:45–49. As depicted in Figure 1B, second stent 40 includes proximal frustoconical part 42 and distal part 44. *Id*. at 11:10–14. The '365 patent explains that, in use, stent 40 is "compressed radially inwards" and "frustoconical proximal part 42 is guided, in the radially compressed state, into the second frustoconical part 18 of the bifurcated stent 10." *Id*. at 11:27–32. Each of stent 10 and stent 40 may be made from "shape memory nitinol (nickel-titanium) wire," which, after deformation of a stent, allows for the stent to "remember[]," and return to, a particular configuration after undergoing a process involving heating and cooling. *Id*. at 3:38–45. After second stent 40 is positioned with respect to bifurcated stent 10, stent 40 is

allowed "to re-expand towards its remembered configuration, . . . and the outer surface of the frustoconical proximal part 42 engages the interior surface of the second frustoconical part 18 of the bifurcated stent 10." *Id*. at 11:33–37. The '365 also explains that barbs 43 operate to engage an inner wall of an artery. *Id*. at 39–44. The '365 patent further generally describes the following with respect to the connection of two stents:

> According to one aspect of the present invention there is provided a stent connecting means for connecting two intraluminal stent one to the other to define a continuous lumen through the two stents, the stent connecting means including a first stent including a male engaging portion which can be compressed radially inwardly, and a second stent including a female cooperating portion. The male engaging portion may be entered into the female cooperating portion in a radially compressed state and thereafter caused to allowed to expand in the female cooperating portion; the arrangement being such that in service the interengagement of the male engaging portion and the female cooperating portion serves to resist longitudinal separation of the two stents one the from the other.

Id. at 2:18–31.

The '365 patent also explains that a stent of the disclosed invention may carry a "fabric graft layer . . . for use as an endoluminal prosthesis e.g. in the infrarenal portion of a mammalian aorta in juxtaposition with the bifurcation of the common iliac arteries." *Id*. at 8:49–53; *see also* 11:14–18.

C. Illustrative Claims

Claims 1, 19, 20, 22, 23, and 24 are independent claims. Independent claims 1, 22, 23, and 24 are each drawn to a stent joining means, and describe the first and second endoluminal stents, each having male and female engaging portions. The male portions are configured to "be compressed radially inwardly," and, in claim 1, the material of the stents is

specifically a "shape memory material." Upon expansion of the male portion, the male and female portions enter into "frictional inter-engagement" (claims 1 and 22) or "inter-engagement" (claims 23 and 24). Independent claim 19 is drawn to a method of joining first and second edoluminal stents. Independent claim 20 is drawn to a method of forming an endoluminal stent within the vasculature of a body and includes the insertion of a first stent portion into a second stent portion. Both claims require that a first stent, or portion thereof, "expand by thermal transformation" such that the two stents engage one another.

Claims 2–18 ultimately depend from claim 1. Claim 21 depends from claims 20.

Claims 1 and 19 are illustrative of the subject matter at issue, and are reproduced below:

> 1. A stent joining means for joining a first endoluminal stent to a second endoluminal stent to define a continuous lumen through the first and second endoluminal stents, said stent joining means comprising:
>
> a male engaging portion on said first endoluminal stent which has an outer surface and can be compressed radially inwardly; and
>
> a female portion on said second endoluminal stent cooperating with said male engaging portion, said female portion having an inner surface;
>
> wherein said first endoluminal stent and said second endoluminal stent consist of a shape memory alloy and the male engaging portion can be entered into the female portion in a radially compressed state and thereafter thermally induced to expand in the female portion and wherein a frictional inter-engagement between said outer surface of the male engaging

> portion and said inner surface of the female portion prevents longitudinal movement of the first endoluminal stent relative to the second endoluminal stent.
>
> 19. A method of joining a first endoluminal stent having an outer surface with a second endoluminal stent having an inner surface within the vasculature of a body comprising the steps of inserting an end of said first endoluminal stent at least partially into an end of said second endoluminal stent, and allowing said end of said first endoluminal stent to expand by thermal transformation and contact said end of said second endoluminal stent such that said outer surface of said first endoluminal stent frictionally engages said inner surface of said second endoluminal stent to prevent relative longitudinal movement of said first and second endoluminal stents.

D. References Relied Upon

The Petition relies on the following references:

Ryan	US 8,206,427 B1	June 26, 2012	Ex. 1002[1]
Martin	US 5,575,817	Nov. 19, 1996	Ex. 1003
Pinchuk	US 5,226,913	July 13, 1993	Ex. 1004

E. The Alleged Grounds of Unpatentability

Petitioner contends that claims 1–24 of the ’365 patent are unpatentable under 35 U.S.C. on the following grounds:

[1] Ex. 1002 as filed with the Petition on August 18, 2014 was entered into the Board’s electronic Patent Review Processing System as a corrupted file that could not be viewed. A corrected Exhibit 1002 was filed on February 3, 2015. References to Exhibit 1002 or Ex. 1002 are to that corrected exhibit.

References	Basis	Claims challenged
Ryan	§ 102(e)	1, 3–8, 10, 12–22, and 24
Martin and Ryan	§ 103	1–24
Martin, Ryan, and Pinchuk	§ 103	11 and 23
"Patent Owner Is Not Entitled to Claims that are Patentably Indistinct from the Claims Involved in [Interference No. 104,192]." Pet. 13.		

II. ANALYSIS

A. Claim Construction

1. Claim Construction of an Expired Patent

Petitioner contends that "the '365 Patent expires at the latest on February 10, 2015." Pet. 14. In particular, Petitioner represents that date "is the later of 20 years from the earliest priority date to which the '365 Patent can possibly claim priority (September 27, 1994) or 17 years from the issuance date (February 10, 1998)." *Id*. at 14 n.4. February 10, 2015 has passed. We agree that, based on the record before us, the '365 patent is now expired.

In an *inter partes* review, a claim in an *unexpired* patent is given its broadest reasonable construction in light of the specification of the patent in which it appears. 37 C.F.R. § 42.100(b). The Board's review of the claims of an *expired* patent, however, is similar to that of a district court's review. *In re Rambus, Inc.*, 753 F.3d 1253, 1255–1256 (Fed. Cir. 2014) (involving an *inter partes* reexamination of claims 26 and 28 of U.S. Patent No. 6,426,916) ("If, as is the case here, a reexamination involves claims of an expired patent, a patentee is unable to make claim amendments and the PTO

applies the claim construction principles outlined by this court in *Phillips v. AWH Corp.*, 415 F.3d 1303 (Fed.Cir.2005)"); *see also In re Rambus, Inc.*, 694 F.3d 42, 46 (Fed. Cir. 2012) (involving an *ex parte* reexamination of claim 18 of U.S. Patent No. 6,034,918) ("the Board's review of the claims of an expired patent is similar to that of a district court's review"). Accordingly, in this proceeding, the claims in the now expired '365 patent will be construed under the principles in *Phillips v. AWH Corp.*, 415 F.3d 1303, 1312–1313 (Fed. Cir. 2005) (en banc) (words of a claim "are generally given their ordinary and customary meaning" as understood by a person of ordinary skill in the art in question at the time of the invention).

We will not apply a rule of construction that claims should be construed to preserve their validity.[2] *See, e.g., Google Inc. and Yahoo! Inc. v. Createads LLC*, IPR2014-00200, Paper 19, p. 2, (PTAB July 16, 2014) ("[n]o presumption of validity is applied" to interpreting claims in an expired patent). The different standard we use in construing the claims in an expired patent does not change the statutory requirement in this proceeding that Petitioner has the burden of proving a proposition of unpatentability by a preponderance of the evidence. 35 U.S.C. § 316(e).

2. Means Plus Function in the Preamble

As noted by Petitioner, claims 1–18 and 22–24 each recite "stent joining means for joining a first endoluminal stent . . . to a second endoluminal stent . . . comprising . . . ." Pet. 14. Petitioner urges that the

[2] "While we have acknowledged the maxim that claims should be construed to preserve their validity, we have not applied that principle broadly, and we have certainly not endorsed a regime in which validity analysis is a regular component of claim construction." *Phillips*, 415 F.3d at1327.

above-noted recitation, which appears in the preamble of each claim, does not invoke 35 U.S.C. 112, sixth paragraph. *Id*. On this record, we agree.

A claim limitation that uses the word "means" invokes a rebuttable presumption that § 112, sixth paragraph applies. *CCS Fitness, Inc. v. Brunswick Corp.*, 288 F.3d 1359, 1369 (Fed. Cir. 2002). That presumption is rebutted, however, if the claim also recites "'sufficiently definite structure'" in connection with the means. *Id*. (citation omitted). That is the case here. Although the preambles of the claims may not recite any corresponding structure, the bodies of the claims introduce numerous structural features that constitute part of the "stent joining means," and which remove the pertinent feature from the province of § 112, sixth paragraph.

3. Specific Terms

Petitioner also urges particular constructions for the claim terms "proximal," "distal," and "shape memory alloy." Pet. 15. The constructions as they are presented in the Petition are reproduced below:

Term	Proposed construction and support
"proximal" (Claims 2, 5, 7, 9, 24)	"nearest to the heart" Ex. 1001 at 2:15-16.
"distal" (Claims 5, 8, 10, 17, 18, 24)	"furthest from the heart" *Id.* at 2:16-17.
"shape memory alloy" (Claim 1)	"alloy that recovers original shape on being raised to a higher temperature" *Id.* at 3:35-63.

Id.

We observe that meanings proffered for "proximal" and "distal" are derived from explicit definitions appearing in the Specification of the '365 patent. *See* Ex. 1001, 2:15–17. The proposed meaning of "shape memory alloy" is consistent with the Specification, and, on this record, we understand it to be the ordinary and customary meaning of the term.

At this time, we do not discern any ambiguity in any claims terms whose meaning has not been made explicit above. All other claim terms have been given their ordinary and customary meaning, and we do not make explicit the meanings for purposes of this decision.

B. Discussion

1. Anticipation Based on Ryan

Petitioner contends that claims 1, 3–8, 10, 12–22, and 24 are anticipated by Ryan. Ryan is titled "Apparatus and Methods for Endoluminal Graft Placement." Ex. 1002, Title. A portion of Ryan's Abstract is reproduced below:

> A vascular graft comprises a perforate tubular compressible frame having a fabric liner disposed over at least a portion of the frames lumen. The graft may be used in combination with a base structure to form a bifurcated graft in situ. The base structure compresses a compressible frame having a fabric liner which defines a pair of divergent legs. The base structure is positioned within the aorta so that one leg enters each iliac. The tubular grafts can then be introduced into each leg to form the bifurcated structure.

Ryan also characterizes its disclosed invention as "systems for the in situ placement of bifurcated grafts for the treatment of aorto-iliac segments and other bifurcated lumens." Ex. 1002, 3:37–39. Ryan further describes the following with respect to the configuration of an inventive system:

> The system comprises a bifurcated base structure including a proximal anchor, typically a self-expanding frame, which defines a common flow lumen and a pair of connector legs that establish divergent flow lumens from the common flow lumen. The system also includes a first tubular graft which can be anchored within first of the connector legs to form a continuous extension of the first divergent flow lumen and a second tubular grate which can be anchored within a second of the connector legs to form a continuous extension of the second divergent flow lumen.

Id. at 3:39–49.

Thus, Ryan explains that first and second tubular grafts are anchored to first and second legs of a bifurcated base structure to create a bifurcated graft having a "common flow lumen" extending through those components. Ryan additionally explains that the tubular frame formed by the base structure and tubular grafts is one that is "radially compressible" and "composed of a resilient material, usually metal, often times a heat and/or *shape memory alloy*, such as nickel titanium alloys which are commercially available under the trade name Nitinol®." *Id*. at 6:47–51 (emphasis added).

Ryan's Figures 7–12 "illustrate placement of a bifurcated aortic graft using the bifurcated graft placement system of the present invention." *Id*. at 4:59–61. Figures 8, 9, 11, and 12 are representative of the placement process and are reproduced below:

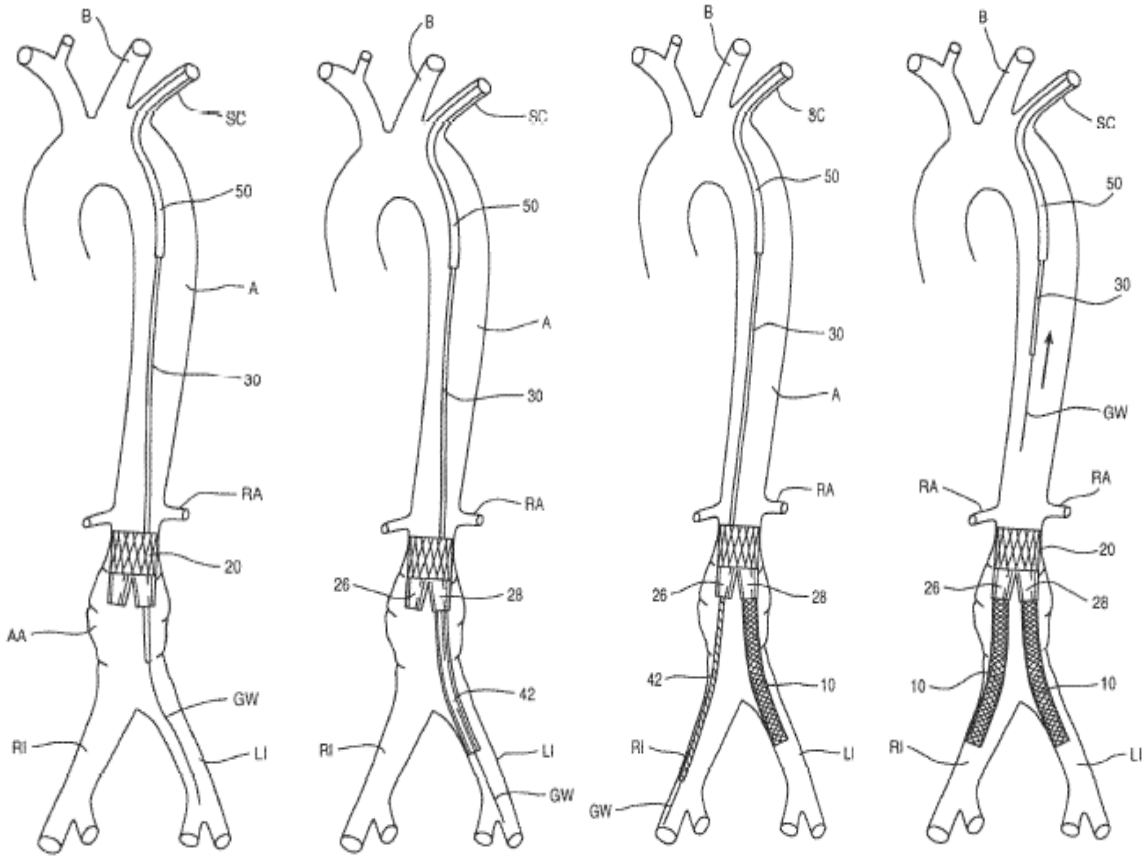


FIG. 8 FIG. 9 FIG. 11 FIG. 12

Figures 8, 9, 11, and 12 depict that bifurcated base structure 20 is inserted into an abdominal aortic aneurysm AA of a patient via delivery catheter 30. *Id*. at 10:23–28. Although not illustrated in those figures, bifurcated base structure 20 initially is maintained radially compressed within sheath 42, and after withdrawal of sheath 42, the base structure expands to assume the configuration illustrated in Figure 8. *Id*. at 10:28–32. Vascular graft 10 is then introduced into leg 28 of bifurcated base structure 20 in a compressed state within sheath 42 via catheter 30. *Id*. at 10:33–36; Fig. 9. Upon withdrawal of sheath 42 vascular graft 10 expands within leg 28 and also left iliac LI. *Id*. at 10:37–39; Fig. 10. The process is then

repeated for second vascular graft 10 for expansion within leg 26 of bifurcated base structure 20 and right iliac RI. *Id*. at 10:39–50; Figs. 11, 12.

In light of the teachings of Ryan, including those discussed above, Petitioner contends that Ryan discloses all the elements required by claims 1, 3–8, 10, 12–22, and 24. Pet. 16–28. Petitioner also points to the Declaration testimony of Dr. Enrique Craido (Ex. 1017) in support of that contention. For instance, with respect to the limitation of the claims requiring that the segments enjoy "frictional" engagement, Petitioner directs our attention to Dr. Craido's Declaration at paragraphs 48–50 and 66. *Id*. at 20. In that respect, Dr. Craido testifies that the overlapping engagement between vascular grafts 10 and the left and right legs of bifurcated base structure 20 would be understood as establishing frictional engagement between those structures. Ex. 1017 ¶ 66.

Also, by way of example, beyond the required claim features discussed above, Petitioner urges that:

> Ryan further discloses that such joining of stents to prevent longitudinal movement can be performed in a bifurcated blood vessel using a bifurcated base structure having two connector legs, such that the proximal end of the bifurcated base structure will be disposed proximally of the bifurcation and a first tubular graft will be disposed in one branched vessel via one connector leg, and a second tubular graft can then be introduced into into [sic] the bifurcated base structure through the other connector leg and extend into the second blood vessel. *E.g.*, *id.* at 3:37-66; 10:23-50; 11:14-32; 12:7-20; FIGS. 5, 11-12. Ryan thus discloses all of the features of claims 5, 17, and 18 of the '365 Patent. Ex. 1017 ¶ 94.
>
> Ryan further discloses all of the features of the identified claims of the '365 Patent. For example, Ryan discloses that the bifurcated base structure and tubular grafts may comprise a sinuous wire stent(s) (including nitinol) and inner and/or outer

> liner(s) that may fold over, as recited in claims 3, 4, 6, 21, 22, and 24. *E.g.*, Ex.1002 at 2:31-59; 3:16-66; 5:19-33; 6:3-31; 6:47-61, 8:35-39; 9:29-49; 11:23-32; Ex. 1017 ¶ 95. A person of ordinary skill in the art would further understand that Ryan's disclosure of a liner folded over to the external surface of the stent, *e.g.*,Ex. 1002 at 8:35-39, FIG. 1A, would form an inner seal that contacts with the graft layer disposed externally on the engaging portion of the male stent to form a substantially blood-tight seal and resists longitudinal separation of the stents, as recited in claim 24 of the '365 Patent. Ex. 1017 ¶ 95.

Id. at 22.

We have considered the Petition, and conclude that, on the record before us, Petitioner has demonstrated a reasonable likelihood of prevailing in its assertions that claims 1, 3–8, 10, 12–22, and 24 are unpatentable over Ryan.

2. Obviousness Over Martin and Ryan

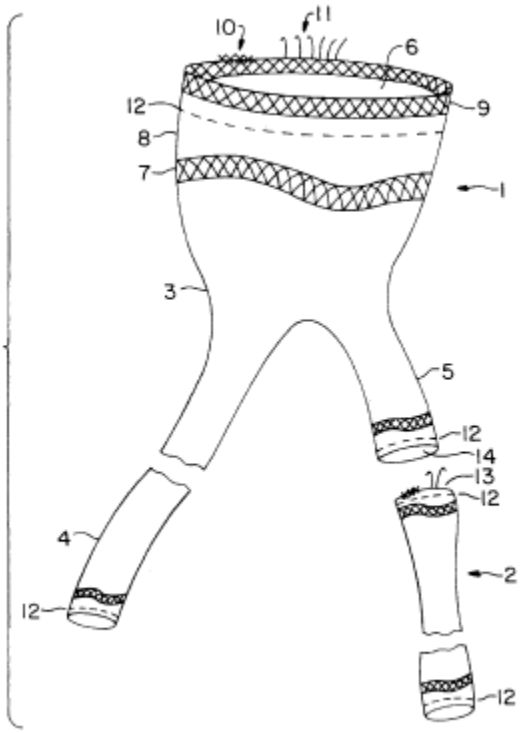
Petitioner contends that claims 1–24 are unpatentable over Martin and Ryan. Pet. 28–45. Martin is titled "Aorto Femoral Bifurcation Graft and Method of Implantation." Ex. 1003, Title. Martin summarizes its invention as follows:

> According to the invention, an inverted Y graft is provided which is comprised of two sections. The first section of the inverted Y graft is comprised of the upper limb, the first lower limb, and a partial length of the second lower limb of the inverted Y. The second section of the inverted Y graft is comprised of the remainder of the second lower limb of the inverted Y. The inverted Y graft according to the invention may be placed in a patient in two consecutive stages, each stage requiring the insertion by catheter of a segment of the inverted Y graft.

Ex. 1003, 1:45–54.

Martin's Figure 1 depicts a preferred embodiment of the inverted Y graft prostheses according to its invention, and is reproduced below:

FIG. 1



As shown in Figure 1 above, an inverted Y-graft may be formed in a bifurcating lumen through attachment of first section 1 with second section 2. Ex. 1003, 2:51-52, 2:65–3:2. First section 1 is hollow, made of "suitable material," and may be attached to compressible expanding mesh support 2, which may be a "stent or similar structure." *Id*. at 3:2–14. Second section also is hollow, and made of the same material as the first section. *Id*. at 3:23–24. As with Ryan, Martin explains that the first and second sections are inserted into a bifurcated lumen in a compressed state and allowed to expand. *Id*. at 3:46–4:26. Martin also discloses the following with respect to connection of first section 1 and second section 2:

> The upper end 13 of the second section 2 is slightly larger in diameter than the corresponding diameter 14 of the partial length of the second lower limb 5 of the first section 1. This allows for a friction fit of the two sections when the second section 2 expands within the first section 1.

Id. at 3:29–34.

Martin further describes the use of barbs 10 or outwardly facing hooks 11 to fasten the stent to the inside of the lumen. *Id*. at 3:17–19.

Petitioner contends the following:

> Martin thus discloses every claim limitation of the '365 Patent with the possible exception of explicitly disclosing (1) a shape memory alloy that is thermally induced to expand or a stent that expands by thermal transformation, as required by claims 1–20;[footnote omitted] (2) that the stent of the two sections may comprise a sinuous wire formed into a tubular configuration, as required by claim 3; (3) that the partial length of the second lower limb may comprise a frustoconical wall tapering radially inwardly towards a longitudinal extremity, as required by claims 12 and 23; and (4) that the graft layer on the exterior of the first section may fold over the distal end of the partial section of the second lower limb to form an inner sleeve, as required by claim 24. Ex. 1017, ¶ 104.

Pet. 38–39.

Petitioner points to teachings of Ryan that it contends correspond to the above-noted features urged as absent from Martin. For instance, Petitioner relies on Ryan's teachings of a "shape memory alloy (such as Nitinol) that is induced to expand from radially compressed state by an increase in temperature from room temperature to body temperature (Ex. 1002 at 6:47–59)," in accounting for the shape memory alloy that expands thermal transformations aspects of the claims of the '365 patent. Pet. 39. Petitioner also reasons that all of the features absent from Martin were well-

known in the art as evidenced by Ryan, and that the features would function in the same manner when employed in Martin's device and method. *Id*. at 39–40. Petitioner also relies on the Declaration testimony of Dr. Craido in that respect. *Id*. (citing Ex. 1017 ¶¶ 105–109).

We are mindful of the guidance provided by the Supreme Court that: "[t]he combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results." *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 416 (2007). Furthermore, "if a technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve similar devices in the same way, using the technique is obvious unless its actual application is beyond his or her skill." *Id.* at 417. Here, in considering the record before us, we are satisfied that the information presented in the Petition establishes a reasonable likelihood that the Petitioner will prevail in its contention that claims 1–24 would have been obvious in light of Martin and Ryan.

3. Obviousness Over Martin, Ryan, and Pinchuk

Petitioner contends that claims 11 and 23 are unpatentable over Martin, Ryan and Pinchuk. Claim 11 depends from claim 1, and claim 23 is independent. Claim 11 adds the feature: "wherein the male engaging portion comprises a frustoconical wall flaring outwardly towards a longitudinal extremity." Claim 23 includes the feature: "a male engaging portion on said male portion end of said first endoluminal stent, defining a first frustoconical wall which is flared radially outwardly towards said male portion end." Petitioner contends that, to the extent the above-noted features are

considered absent from Ryan and Martin, Pinchuk so accounts for them. Pet. 46–47.

Pinchuk describes its disclosed invention as a "radially expandable axially extending endoprosthesis or stent." Ex. 1004, 4:51–52. Pinchuk further conveys that the stents of its invention need not be "uniformly shaped," and can be formed as "tapered, truncated cone-shaped stents." *Id*. at 6:51–57. Petitioner, and declarant Dr. Craido, submit that the Pinchuk's teachings constitute disclosure of the particular frustoconical shape required by claims 11 and 23. Pet. 46; Ex, 1017 ¶ 82. Petitioner also reasons that it would have been obvious to one of ordinary skill in the art to apply that shape to the stents of Ryan and Martin in the manner taught by Pinchuk. To that end, Petitioner contends:

> Martin discloses that the upper end (13) [of] the second section (2) may comprise a frusotconical shape flared radially outwardly. E.g., Ex. 1003, FIG. 1; Ex. 1017, ¶ 103. Martin also discloses that the upper end may have "other means of attachment" than hooks or barbs. *Id*., 3:29–37. It would have been obvious to a person of ordinary skill in the art to use Pinchuk's frustoconical design as other means of attaching the second section to the first section of Martin while employing [a] stent comprising a memory shape alloy, as disclosed by Ryan. Ex. 1017, ¶ 108.

Id. at 47.

On the record before us, we are satisfied that Petitioner has established a reasonable likelihood of prevailing on its challenge that claims 11 and 23 are unpatentable over Martin, Ryan, and Pinchuk.

4. Ground 4

Petitioner proposes a ground of unpatentability styled as follows: "Patent Owner Is Not Entitled to Claims that are Patentably Indistinct from

the Claims Involved in [Interference No. 104,192]." Pet. 13. Thus, the proposed ground is premised essentially on the position that the Patent Owner forfeited rights to claims of the '365 patent due to the outcome of an interference proceeding.

By statute, the scope of an *inter partes* review is limited. In that regard, 35 U.S.C. § 311(b) sets forth the following:

> **(b) Scope**.—A petitioner in an inter partes review may request to cancel as unpatentable 1 or more claims of a patent only on a ground that could be raised under section 102 or 103 and only on the basis of prior art consisting of patents or printed publications.

The above-noted ground that Petitioner proposes is neither one that is raised under 35 U.S.C. §§ 102 or 103, nor one based on prior art consisting of patents or printed publications. That ground is not raised appropriately in the context of an *inter partes* review.

In any event, there is no requirement that an *inter partes* review proceeding must proceed on all grounds of unpatentability asserted by a petition. *See* 37 C.F.R. § 42.108(a) ("When instituting inter pares review, the Board may authorize the review to proceed on all or some of the challenged claims and on all or some of the grounds of unpatentability asserted for each claim"). Here, we do not proceed on the proposed ground of unpatentability asserted by Petitioner stemming from the outcome of Interference No. 104,192.

III. CONCLUSION

For the foregoing reasons, we determine that the information presented in the Petition establishes a reasonable likelihood that Petitioner

would prevail in showing that claims 1–24 are unpatentable. We have not made a final determination with respect to the patentability of claims 1–24, or the construction of any claim term.

IV. ORDERS

After due consideration of the record before us, it is:

ORDERED that pursuant to 35 U.S.C. § 314(a), an *inter partes* review is hereby instituted on the grounds that:

A. Claims 1, 3–8, 10, 12–22, and 24 are anticipated under 35 U.S.C. § 102 by Ryan;

B. Claims 1–24 are unpatentable under 35 U.S.C. § 103(a) over Ryan and Matthew; and

C. Claims 11 and 23 are unpatentable under 35 U.S.C. § 103(a) over Ryan, Matthew, and Pinchuk;

FURTHER ORDERED that no other grounds are authorized for this *inter partes* review as to claims; and

FURTHER ORDERED that pursuant to 35 U.S.C. § 314(c) and 37 C.F.R. § 42.4, notice is hereby given of the institution of a trial. The trial will commence on the entry date of this Decision.

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