

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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GLOBUS MEDICAL, INC.,  
Petitioner,

v.

DEPUY SYNTHES PRODUCTS, LLC,  
Patent Owner.

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Case IPR2015-00111  
U.S. Patent No. 8,623,057

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**Patent Owner's Response To Petitioner's Request For Rehearing**

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Pursuant to the Board's September 16, 2015 directive, Patent Owner files this brief responding to Petitioner's Request for Rehearing of the Board's Decision denying institution and addressing the relevance of the *Dyanmic Drinkware, LLC v. National Graphics, Inc.*, (Fed. Cir. September 4, 2015) decision.

# **I. The Board Properly Denied Globus' IPR Petition**

The Board properly denied Globus' IPR Petition. In its Petition, Globus failed to meet its burden of production to establish that US Patent 7,931,675 ("Panjabi") is effective prior art under 35 U.S.C. § 102(e) to US Patent 8,623,057 ("the Jahng '057 patent").

Initially, it is important to understand that Globus relies upon Panjabi under 35 U.S.C. § 102(e) as prior art not as of the filing date for the *Panjabi patent*, but rather as of the filing date of the *Panjabi provisional application*. Globus was so procedurally postured because it admitted the Jahng '057 patent has an effective filing date prior to the filing date for the Panjabi utility application (Decision at 3).

Thus, in its Petition, Globus had the initial burden of production to prove not only that Panjabi qualifies as prior art under § 102(e) based upon the Panjabi provisional application filing date, but also that the Panjabi provisional application contains the allegedly invalidating disclosure to the Jahng '057 patent and that such disclosure was carried over into Panjabi. Globus failed to make either of these showings. Furthermore, Globus failed to include the Panjabi provisional

application in its Petition to support its burden of production as required by 37 CFR § 42.104.

*Dynamic Drinkware* is important to the issues raised here, but not for the reasons Globus alleges. First, counter to Globus' arguments, *Dynamic Drinkware* holds that there is *no presumption* that a patent is entitled to the filing date of its provisional application for § 102(e) prior art purposes. Slip Op. at 8. Second, *Dynamic Drinkware* addresses the different burdens of production a petitioner must meet when advancing a § 102(e) patent reference that relies upon its filing date versus one that relies upon the filing date of a provisional application.

## **II. Globus Failed To Establish Panjabi As Effective Prior Art Under 35 U.S.C. § 102(e)**

In arguing for rehearing, and by attempting to rely upon the *Dynamic Drinkware* decision, Globus misapprehends the law concerning the different types of prior art under 35 U.S.C. § 102(e), and the different burdens of proof associated therewith in the context of *inter partes* reviews. That is, Globus fails to distinguish between a section 102(e) reference that is prior art based upon (1) its utility filing date, and (2) its provisional filing date.

With respect to the former, the prior art date for a patent under 35 U.S.C. § 102(e) is the filing date of the underlying utility application. *In re Bartfeld*, 925 F.2d 1450, 1451, n.4 (Fed. Cir. 1991). When the patent issues, the entire

disclosure is available as prior art under §§ 102 and 103 as of the filing date of the utility application because Patent Office delays in reviewing and allowing the application should not detract from the applicant's attempt to make his disclosure public. *See Hazeltine Research, Inc. v. Brenner*, 382 U.S. 252, 147 USPQ 429 (1965).

With respect to the latter, which Globus argues here, to establish that a patent is an effective prior art reference under 35 U.S.C. § 102(e) *as of the filing date for its provisional application*, the proponent of the reference must prove two separate requirements are met. First, the proponent must prove that the reference *qualifies* as prior art under § 102(e) as of the provisional filing date by showing that the disclosure of the *provisional application* provides written description support under 35 U.S.C. § 112 ¶ 1 for the invention claimed in the *patent*. Second, the proponent must also prove that the reference is *effective* prior art by showing that the alleged invalidating disclosure is found in the provisional application and was *carried over* into the utility patent. In its Petition, Globus failed to prove either of these requirements are met, much less both.

**A. First, Globus Failed To Prove Panjabi Qualifies As Prior Art Under 35 U.S.C. § 102(e) Based Upon Its Provisional Filing Date**

First, Globus failed to prove that Panjabi qualifies as prior art under 35 U.S.C. § 102(e) based upon Panjabi's provisional filing date.

**1. Panjabi qualifies as prior art under § 102(e) if the requirements of 35 U.S.C. § 119(e) are met**

Although a United States patent has a prior art date as of its filing date under 35 U.S.C. § 102(e), for the patent to gain priority to an earlier filing date based upon an underlying provisional application it must satisfy 35 U.S.C. § 119(e)(1).

*Dynamic Drinkware*, Slip Op. at 4. Section 119(e)(1)<sup>1</sup> provides:

An application for patent filed under section 111(a) ...  
*for an invention disclosed in the manner provided by the*  
*first paragraph of section 112 of this title in a*  
*provisional application* filed under section 111(b)...  
*shall have the same effect, as to such invention, as*  
*though filed on the date of the provisional application ...*

(emphases added). “In other words, the specification of the *provisional* must ‘contain a written description of the invention and the manner and process of making and using it, in such a full, clear, concise, and exact terms,’ 35 U.S.C. § 112 ¶ 1, to enable an ordinary skilled artisan to practice the invention *claimed* in the *non-provisional* application.” *Dynamic Drinkware*, Slip Op. at 4 (emphases in original); *quoting New Railhead Mfg., L.L.C. v. Vermeer Mfg. Co.*, 298 F.3d 1290, 1294 (Fed. Cir. 2002).

Thus, the legal requirement for a patent to be prior art under 35 U.S.C. § 102(e) as of an earlier-filed provisional application is that the *provisional application* must provide section 112, first paragraph, support for a claim in the

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<sup>1</sup> The pre-AIA version of Title 35 U.S.C. applies to the Jahng ’057 patent.

*issued patent*. As stated by the Federal Circuit: “A reference patent is only entitled to claim the benefit of the filing date of its provisional application if the disclosure of the provisional application provides support for the claims in the reference patent in compliance with § 112, ¶ 1.” *Dynamic Drinkware*, Slip. Op. 11.

This requirement stems from *In re Wertheim*, 646 F.2d 527 (CCPA 1981). *Wertheim* dealt with the situation where a series of CIP applications led to a patent, and the question was whether certain disclosure found in the original application, and carried forward through each of the later applications and into the issued patent, constitutes prior art under section 102(e) as of the filing date for the original application. *Id.* at 533. Judge Rich, writing for the CCPA, analyzed the case by way of an analogy: assuming application I discloses A, application II discloses AB, and applications III and IV (the patent issued from application IV) both disclose ABC, is the disclosure of A prior art under § 102(e) as of the filing date for application I if the patent that ultimately issued claims invention ABC? *Id.* at 536.

In making its determination, the *Wertheim* court looked to the *Alexander Milburn Co. v. Davis-Bournonville Co.*, 270 U.S. 390 (1926) decision, which was later codified as 35 U.S.C. § 102(e). 646 F.2d at 532. Critical to the *Milburn* analysis is whether the *application as-filed* properly supports the *claims that ultimately issued* such that the patent could have theoretically issued on the day it was filed, but for delays within the Patent Office. *Id.* at 538-39. Applying

*Milburn*, the *Wertheim* court held that the issued patent did not serve as a § 102(e) reference for the disclosure of A in application I because application I did not provide § 112 ¶ 1 support for the invention ABC claimed in the issued patent. *Id.* at 539. The *Wertheim* court summed up this rule of law:

. . . the application, the filing date of which is needed to make a rejection, must disclose, pursuant to §§ 120/112, the invention claimed in the reference patent.

*Id.*<sup>2</sup>

**2. Globus failed to prove the requirements of 35 U.S.C. § 119(e) are met for Panjabi**

In its Petition, Globus failed to prove that under 35 U.S.C. § 102(e) Panjabi is entitled to the filing date of the Panjabi provisional application. Specifically, Globus failed to meet its burden of production to prove, pursuant to 35 U.S.C. § 119(e)(1), the Panjabi provisional application provided § 112, ¶ 1 support for the invention claimed in Panjabi.<sup>3</sup> Thus, Globus failed to prove in its Petition that Panjabi is prior art to the Jahng '057 patent under § 102(e).

The Board did not err in placing the initial burden of production on Globus to prove in its Petition that Panjabi is prior art under § 102(e) as of Panjabi's provisional filing date. This burden of production requirement is explained in the *Dynamic Drinkware* decision where the Federal Circuit held if a petitioner must

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<sup>2</sup> Wertheim dealt with § 120 (utility applications), the counterpart to § 119.

<sup>3</sup> Globus did not provide a claim chart mapping Panjabi's claims to its provisional.



rely upon the provisional filing date to support a section 102(e) reference – at whatever stage in an *inter partes* review proceeding (either at the petition stage or during the trial) – it is the petitioner’s burden to establish the requirements of section 119(e)(1) have been satisfied. *Dynamic Drinkware*, Slip. Op. at 5, 7, 11.

A review of how the *Dynamic Drinkware* case unfolded is helpful to understand a petitioner’s burdens when relying upon section 102(e) prior art. In *Dynamic Drinkware*, the petitioner argued that the Raymond patent was prior art under § 102(e) to the challenged ’196 patent. The Federal Circuit noted that the petitioner had both the burden of persuasion to prove unpatentability under 35 U.S.C. § 316(e), and also the “initial burden of production” to present evidence to establish its case. Slip Op. at 5-7. The Federal Circuit found that petitioner had met its initial burden of production by submitting the Raymond patent because the Raymond patent had a *utility* application filing date *prior* to the earliest effective filing date for the ’196 patent. Slip Op. at 7. Therefore, the IPR trial was properly initiated based upon these representations in the petition.

The burden of production, however, returned to the petitioner after the patent owner demonstrated that the invention claimed in the ’196 patent was reduced to practice prior to the utility filing date for the Raymond patent. Slip Op. at 8. It was at this point that the petitioner failed to meet its burden of production to establish that the Raymond patent was entitled to the benefit of the filing date of its

provisional application, which would have pre-dated the reduction to practice date and re-established Raymond as prior art under § 102(e). Slip Op. at 8.

Specifically, the Federal Circuit found that the petitioner failed to prove that the Raymond *provisional application* supported the claims of the Raymond *patent* under § 112, ¶ 1. Slip Op. at 11. Thus, the Court held:

Nowhere, however, does [Petitioner] demonstrate support in the Raymond provisional application for the claims of the Raymond patent. That was [Petitioner's] burden. A provisional application's effectiveness as prior art depends on its written description support for the claims of the issued patent of which it was a provisional. [Petitioner] did not make that showing.

Slip Op. at 11. Thus, the Federal Circuit approved the Board's requirement that if the petitioner needed to rely upon the filing date for the Raymond provisional application to establish Raymond as prior art under § 102(e), the petitioner had the burden of production to establish that the Raymond provisional application supported the Raymond patent claims under § 112, ¶ 1. Slip Op. at 8, 11.

This burden of production requirement was properly enforced upon Globus for its Petition. Globus admits the Jahng '057 patent has an effective filing date prior to the filing date for the Panjabi utility application (Pet. 3). Thus, when Globus filed its Petition, Globus stood in the same procedural posture as the petitioner in *Dynamic Drinkware* after the patent owner antedated the Raymond utility application filing date – the reference patent could only be prior art under §

102(e) based upon the filing date for its underlying provisional application.

Consequently, like the petitioner in *Dynamic Drinkware*, Globus had the burden of production to prove that the Panjabi provisional application supports the claims in the Panjabi patent under § 112, ¶ 1. And like the petitioner in *Dynamic Drinkware*, Globus failed to do so. Accordingly, the Board properly denied Globus' Petition.

Globus, like the petitioner in *Dynamic Drinkware*, erroneously argues its actions should be excused because under § 102(e) there is a *presumption* that a patent has an effective prior art date back to the filing date for the patent's underlying provisional application (compare Reh. Req. at 3-4 and 12 with *Dynamic Drinkware*, Slip Op. at 5). But in *Dynamic Drinkware*, the Federal Circuit specifically considered this issue and ***unequivocally held there is no such presumption under § 102(e)***. Slip Op. at 8-10. The Federal Circuit based its decision on the Patent Office's practice not to examine priority claims to provisional applications under MPEP § 211.05(I)(A). Slip Op. at 8 ("In contrast, [Petitioner's] proffered approach would create a presumption that a patent is entitled to the benefit of the filing date of its provisional precursor, but that would be unsound because the PTO does not examine provisional applications as a matter of course; such a presumption is therefore not justified."). The Federal Circuit thus found "the Board has no basis to presume that a reference patent is necessarily entitled to the filing date of its provisional application." *Id.*

Globus' reliance upon *In re Giacomini*, 612 F.3d 1380 (Fed. Cir. 2010) to argue for such a presumption is also misplaced (Req. Reh'g at 4-8). This argument was presented, and rejected, in *Dynamic Drinkware*. Slip Op. at 9-10. The *Dynamic Drinkware* panel ruled that *Giacomini* cannot be cited as support for such a presumption because the issue was never reached in *Giacomini*. *Id.*

Globus' next argument – that the Board's decision in *Ex parte Yamaguchi*, 88 USPQ2d 1606 (BPAI 2008) supports such a presumption (Req. Reh'g at 9-12) – also misses the mark in view of the *Dynamic Drinkware* decision.

Finally, Globus misrepresents that the Patent Office has determined that the Panjabi provisional application supports the invention claimed in Panjabi under § 112 ¶ 1 (Req. Reh'g at 14-15). First, procedurally, the file history Globus cites was not part of its Petition and cannot be used to support its Petition. *See, e.g., Mitsubishi Plastics, Inc. v. Celgard, LLC*, IPR2014-00524, Paper 30 at 5 (Nov. 28, 2014) (denying entry of exhibits that should have been part of petition and would change the evidence relied upon for the petition). Second, substantively, there is no indication that the *examiner* made any independent determination whether Panjabi's claim for support back to the provisional application was proper. Furthermore, Globus fails to advise the Board the Panjabi file history reflects that *after* the February 23, 2010 Response relied upon by Globus, *another* amendment was filed on June 16, 2010 *where each independent claim was amended to add*

*further claim limitations*; Panjabi never argued, and the Patent Office never determined, whether these amended claims that finally issued are supported under § 112 ¶ 1 by the Panjabi provisional application.

Accordingly, Globus failed to prove in its Petition that Panjabi qualifies as prior art under § 102(e) based upon its provisional filing date under § 119(e)(1).

**B. Second, Globus Failed To Prove That The Alleged Invalidating Disclosure In Panjabi Was Carried Over From The Panjabi Provisional Application**

As correctly found by the Board, Globus also failed to prove that the subject matter Globus relies upon in Panjabi to allegedly invalidate the Jahng '057 patent claims was *carried over* properly from the Panjabi provisional application (Decision at 2-3). Thus, Globus failed to prove this second requirement for a § 102(e) reference that relies upon a provisional application filing date was met.

To meet this “carried over” requirement, the proponent of a § 102(e) patent reference that relies upon a filing date of an earlier application must prove that the allegedly invalidating disclosure is found in the earlier application and was carried over into the issued patent. *Wertheim*, 646 F.2d at 533-34.

The genesis for the “carried over” requirement comes from *In re Lund*, 376 F.2d 982 (CCPA 1967). *Lund* dealt with the situation where the § 102(e) reference patent issued as a continuation-in-part from a prior application. The prior application disclosed a potentially invalidating Example 2, but that disclosure was

not carried over into the issued patent. The *Lund* court held that the Example 2 disclosure was not prior art under § 102(e) because under the *Milburn* logic, the patent must issue with the desired disclosure. *Id.* at 633. The *Lund* court summarized the rule:

It is well settled that where a patent purports on its face to be a ‘continuation-in-part’ of a prior application, the continuation-in-part application is entitled to the filing date of the parent application as to all subject matter *carried over* into it from the parent application, whether for purposes of obtaining a patent or subsequently utilizing the *patent* disclosure as evidence to defeat another’s right to a patent.

*Id.* at 630-631 (emphasis original);<sup>4</sup> *see also In re Klesper*, 397 F.2d 882 (CCPA 1968).

Globus failed to prove that the “carried over” requirement was met for Panjabi. As correctly noted by the Board, although Globus cited to certain disclosure in Panjabi to support its Petition, Globus failed to show that such disclosure is also found in the Panjabi provisional application and was properly carried over into Panjabi (Decision at 3).

Again, Globus cannot satisfy its burden of production on this issue by arguing there is a presumption that the Panjabi provisional discloses what Globus

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<sup>4</sup> *Wertheim* modified this *Lund* “carried over” requirement to further require the prior application to provide § 112 ¶ 1 support to the patent. 646 F.2d at 539.

relies upon in Panjabi in its attempt to invalidate the Jahng '057 patent. Following the logic in *Dynamic Drinkware*, because the Patent Office certainly had no reason to review Panjabi to determine if its disclosure that Globus argues is relevant *to the Jahng '057 patent* was also present in the Panjabi provisional application, there can be no such presumption. *Dynamic Drinkware*, slip op. at 8-9.

Consequently, the Board properly denied Globus' Petition because Globus failed to meet this second requirement under § 102(e) for Panjabi.

### **III. Globus' Rehearing Request Exhibits Should Be Expunged**

Globus improperly seeks to submit Exhibits 1017-1022, without prior authorization by the Board, as part of its Rehearing Request. These exhibits should be expunged.

Exhibit 1020, the Panjabi provisional application, was required to be filed along with Globus' Petition with accompanying argument to support Globus' burden of production that Panjabi is prior art under § 102(e). *See LG Display Co., Ltd. v. Delaware Display Group LLC*, IPR2015-00506, Paper 8 at 10-11 (July 6, 2015) (Board refused to consider a published application as prior art under § 102(b) where petitioner failed to include it as an exhibit to petition); *Amazon.com, Inc. v. Personalized Media Communications, LLC*, IPR2014-01533, Paper 16 at 5-7 (April 20, 2015) (Denying rehearing request and finding that petitioner failed to meet its burden to establish alleged § 102(e) patent was entitled to earlier filing

date of a priority application because petitioner did not develop § 112, ¶ 1 support argument in petition, and that “Petitioner should not expect the Board to search the record and cull together the evidence necessary to support Petitioner’s arguments.”).

Exhibits 1021-1022, which include the Panjabi file history, if necessary to Globus’ Petition, should have been filed along with the Petition. 37 CFR § 42.104. Exhibits 1017-1019, which are filings related to *Giacomini* and *Yamaguchi*, are irrelevant in view of the holding in *Dynamic Drinkware* that there is no presumption under § 102(e) that a patent is entitled to the filing date of a prior application for prior art purposes.

#### **IV. Other Reasons To Deny Globus’ Request For Rehearing**

Globus’ request for rehearing should be denied for other reasons as well.

First, Globus’ request should be denied because Globus failed to include the Panjabi provisional application as an exhibit to its Petition. Because the provisional application is central to Panjabi qualifying as prior art under § 102(e), Globus was required to provide it with its Petition. 37 CFR § 42.104; *LG Display*, IPR2015-00506, Paper 8 at 10-11.

Second, as explained in Patent Owner’s Preliminary Response at 13-15, Globus failed to establish that the effective filing date for the Jahng ’057 patent is not earlier than March 3, 2005. Specifically, the Jahng ’057 patent issued from a



series of prior applications (Ex. 1001), and Globus failed to properly first raise the issue as to which claim limitations lack § 112 support from those ancestral applications. *See, e.g., Polaris Wireless, Inc. v. TruePosition, Inc.*, IPR2013-00323, Paper No. 9 (Nov. 15, 2103). Thus, Globus further failed to prove that even if Panjabi were entitled to its provisional filing date it would be prior art to the Jahng '057 patent.

Date: October 19, 2015

Respectfully submitted,

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**CERTIFICATE OF SERVICE**

I, Edward King, hereby certify that on this 19th day of October, 2015, the foregoing **Patent Owner's Response To Petitioner's Request For Rehearing** was served on the following by email:

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