

Paper No. \_\_\_\_  
Date Filed: July 23, 2019

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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3M COMPANY, MERCK & CO., INC., AND  
MERCK SHARP & DOHME CORP.,  
Petitioners,

v.

APTARFRANCE S.A.S.,  
Patent Owner.

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Case No.: IPR2018-01055  
Patent No. 9,370,631

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**PETITIONERS' SUR-SUR-REPLY**

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## **I. INTRODUCTION**

Mr. Clemens’s testimony in this case is inconsistent and unreliable because he applies a different level of ordinary skill in the art to suit different purposes. But Aptar should not be allowed to apply one level of ordinary skill to avoid invalidating their own patent for lack of enablement and a different level of ordinary skill to avoid the prior art. When applying the same (and appropriate) lens to both inquiries, there is only one conclusion: the Challenged Claims are unpatentable.

## **II. PETITIONERS’ REPLY RESPONDS DIRECTLY TO APTAR’S UNSUPPORTED ARGUMENTS**

### **A. Petitioners’ reply on Grounds 3 and 4 does not present new material**

Relying on Mr. Clemens’s view of a POSA interpreting the prior art, Aptar presented several alleged inoperability arguments in its Corrected Patent Owner Response (“Response”). Petitioners disagree that any of Aptar’s arguments reflect actual operability issues. Indeed, had Mr. Clemens applied to the Petition the same level of ordinary skill that he attributes to a POSA interpreting the disclosures of the ’631 patent, there would have been no issues to address. Petitioners’ only addressed these issues because of Aptar’s baseless attacks. *See In re Epstein*, 32 F.3d 1559, 1568 (Fed. Cir. 1994) (when an applicant “did not provide the type of detail in his specification that he now argues is necessary in prior art references, [this] supports

[a] finding that one skilled in the art would have known how to implement the features of the references.”).

In their reply, Petitioners point out that Mr. Clemens improperly analyzed different issues from different levels of ordinary skill in the art. Mr. Clemens’s testimony confirmed that he was conducting his analysis through two different lenses. Under Mr. Clemens’s framework, a POSA interpreting the disclosures of Aptar’s ’631 patent would have understood the relationships between the elements of the alleged invention. For example, Mr. Clemens testified that a POSA reading the patent would be able to make a commercial embodiment, even though “the patent doesn’t show . . . the connections that you might have to [make] in order to reduce it to practice.” Clemens Tr., Ex. 1077 at 99:13-100:16. In fact, Mr. Clemens concedes that certain components of the device are not shown in the figures altogether (i.e., a return spring), yet he testified that a POSA could have still reduced it to practice. *Id.* at 101:20-103:15. But when viewed through the lens of a POSA interpreting the prior art, Mr. Clemens views having to relocate that same return spring as an insurmountable obstacle. Clemens Decl., Ex. 2023 at ¶¶ 4, 8.

Pointing out this discrepancy is not, as Aptar argues, new, but rather is a directly responsive argument showing that Mr. Clemens’s inconsistent and unreliable testimony should be afforded no weight.

**B. Petitioners' reply on Ground 2 does not present new material**

In addressing the “second member limitation,” the Petition states that “*Marelli* teaches a rotating element 9 (second element). Rotating element 9 is integral with small flexible legs 16.” Pet. at 46. Petitioners' Reply explains that the “second member” limitation is met by rotating element 9, which is “integral with small flexible legs 16.” Reply at 5-6. Aptar asserts that identifying the legs as part of the rotating element is a new argument. Sur-Reply at 3. Yet its position is not only wrong, but also entirely unsupported by its own expert. Indeed, Petitioners pointed out in the Reply that Mr. Clemens also identified flexible legs 16 as being part of rotating element 9. Reply at 5-6. Mr. Clemens did not deny that this was his understanding based on the Petition, failing to even address the issue in his declaration in support of Aptar's Sur-Reply. Aptar's argument to the contrary should be rejected.

**III. MR CLEMENS'S ARGUMENTS THAT THE BASON/ALLSOP AND BASON/RHOADES DEVICES DO NOT DISCLOSE THE CLAIMED “SECOND MEMBER” LIMITATION ARE BASED ON THE WRONG LEVEL OF SKILL IN THE ART**

In its Response and again in its Sur-Reply, Aptar seeks to hold Petitioners to an exacting standard that requires Petitioners to build a functioning prototype. But this is not the appropriate standard, as this Board has recognized: “The question before [the Board], however, is not whether [Petitioner] did the engineering necessary to combine the prior art into a functional prototype, but whether doing so

would have been within the ability of a [POSA].” *Permobil v. Pride Mobility Prods. Corp.*, IPR2013-00407, Paper 53, 18. Applying the same lens that Mr. Clemens attributed to a POSA viewing Aptar’s ’631 patent the answer to that question is undoubtedly, “yes.”

In the context of the ’631 patent, Mr. Clemens’s POSA is highly skilled. That POSA has a wealth of knowledge gleaned from “over 50 years of development of metered-dose fluid-dispensing devices.” Clemens Tr., Ex. 1077 at 43:23-44:16. Mr. Clemens admitted that the drawings in the ’631 patent are “highly simplified diagrams which do not show the fluid dispenser in detail.” *Id.* at 99:1-10. He also admitted that the ’631 patent does not explain how all of the claimed components connect, including those connections that one would have to make if reducing the patent to practice. 99:13-100:16. And some necessary components, such as a return spring, are not disclosed in the figures at all. *Id.* at 102:1-12. Despite this lacking disclosure, Mr. Clemens testified that a POSA would be aware of “many options that could possibly work, and the skilled artisan would latch onto one of those.” *Id.* at 102:13-103:15.<sup>1</sup>

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<sup>1</sup> Mr. Clemens took a similar position during his first deposition. *See* Ex. 1057 at 104:24-105:17 (suggesting that Aptar’s patents were broadly written so as not to limit them to one approach).

But the level of skill of a POSA viewing the prior art, according to Mr. Clemens, is much lower. Notably, this version of a POSA has less ability even though the art Mr. Clemens rejects provides *more* detail than Aptar's '631 patent.

For example, both the Ground 3 and 4 combinations disclose a return spring — the same return spring that the figures of the '631 patent fail to disclose. Bason, Ex. 1007 at 2:23-24, Fig. 2 (disclosing coil spring 3). But in the context of the IPRs, Mr. Clemens stated that certain teeth cannot connect because they are separated “by the presence of a spring.” Clemens Decl., Ex. 2023 at ¶¶ 4, 8. Mr. Clemens's version of a POSA analyzing the prior art is devoid of any creativity, seemingly limited to bodily incorporating the components from one prior art reference into another. Not only is this approach fundamentally inconsistent, it is also wrong — a POSA is someone of “ordinary creativity, not an automaton.” *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 420–21 (2007); *MCM Portfolio LLC v. Hewlett-Packard Co.*, 812 F.3d 1284, 1294 (Fed. Cir. 2015) (“[T]he test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference.” (quotation marks omitted)).

Just as Mr. Clemens asserted that a POSA would know how to connect and arrange the components of the claimed device based on the limited disclosure of the '631 patent, so too would a POSA be able to connect the components of the devices

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resulting from a combination of the teachings of the prior art identified in Grounds  
3 and 4. *In re Epstein*, 32 F.3d at 1568.

Respectfully submitted,

Date: July 23, 2019

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**CERTIFICATE OF SERVICE**

The undersigned hereby certifies that a copy of the foregoing Petitioners' Sur-Sur-Reply was served on counsel of record on July 23, 2019, by filing this document through the End-to-End System, as well as delivering a copy via electronic mail to the counsel of record for Patent Owner at the following address:

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