

*United States Patent and Trademark Office*  
*Before the Patent Trial and Appeal Board*

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**3M Company, Merck & Co., Inc. and Merck Sharp & Dohme Corp.,  
(Petitioners)**

**v.**

**Aptar France S.A.S. and AptarGroup, Inc.  
(Patent Owner)**

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

**Patent Owner's Demonstrative Slides**

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- C. “so as to change a displayed dose value from among the plurality of displayable dose values”

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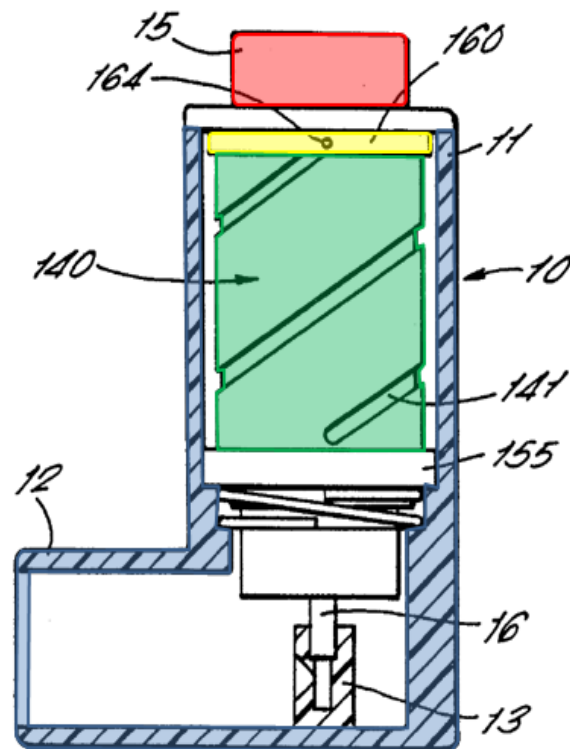
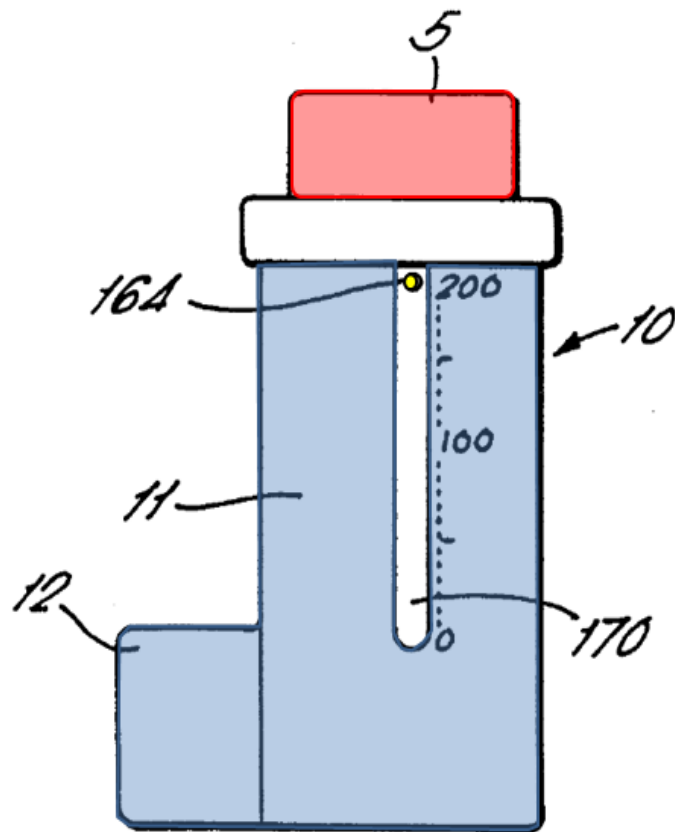
- A. “a second member that is displaceable axially and in rotation relative to said stationary body”

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- B. “a first member that is displaceable axially relative to said stationary body”
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- D. “so as to change a displayed dose value from among the plurality of displayable dose values”



Ex. 1006 at Figures 1, 3

Ground 1 – Allsop

“a first member that is displaceable axially relative to said stationary body”

# Allsop's “push-button cap” is not enabled

“Patent protection is granted in return for an enabling disclosure of an invention, not for vague intimations of general ideas that may or may not be workable.

...

It is the specification, not the knowledge of one skilled in the art, that must supply the novel aspects of an invention in order to constitute adequate enablement.”

*Genentech, Inc. v. Novo Nordisk A/S*, 108 F.3d 1361, 1366 (Fed.Cir.1997)

To be considered an anticipating reference, prior art “must enable that which it is asserted to anticipate.”

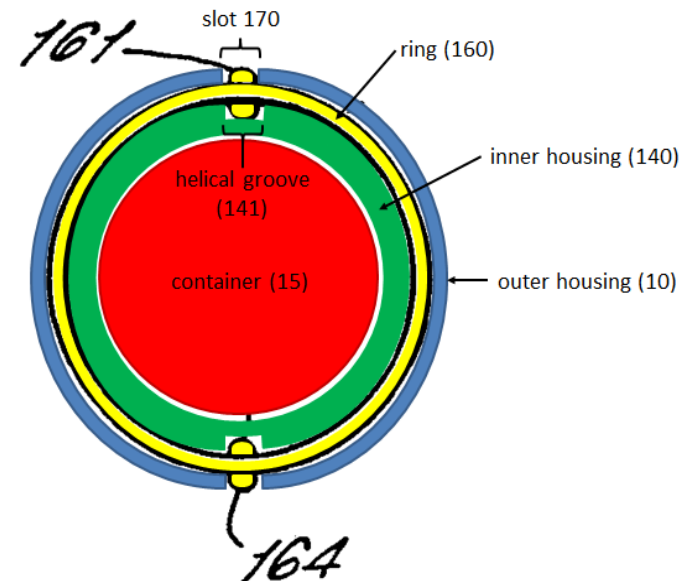
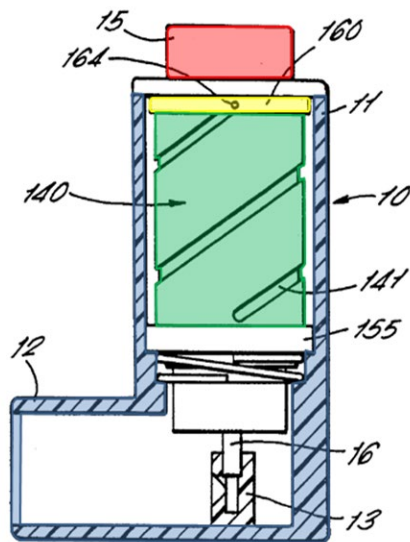
*Elan Pharm., Inc. v. Mayo Found. for Med. Educ. & Research*, 346 F.3d 1051, 1054 (Fed. Cir. 2003)

“To anticipate the reference must also enable one of skill in the art to make and use the claimed invention.”

*Bristol-Myers Squibb v. Ben Venue Laboratories, Inc.*, 246 F.3d 1368, 1374, 58 USPQ2d 1508, 1512 (Fed. Cir. 2001)

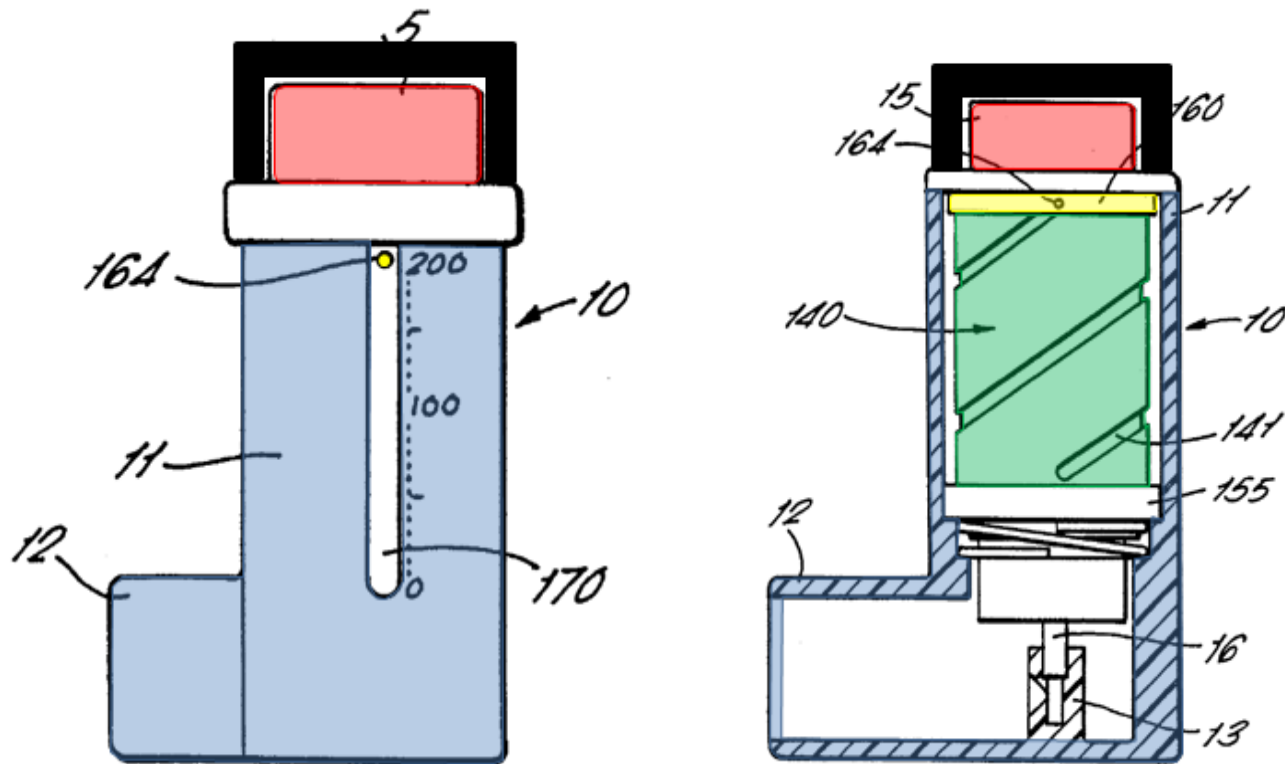
# Allsop's "push-button cap" is not enabled

A push-button cap (not shown) may be provided as part of the main housing 10 to cover the upper portion of the pressurised dispensing container 15. Advantageously, this prevents the ingress of dust, contaminants and moisture into the apparatus.



Ex. 1006 at 8:22-26; Petition at 37; Ex. 1006 at Figure 7

# Allsop's "push-button cap" is not displaceable axially



Ex. 1006 at Figure 1

Ground 1 – Allsop

“a second member that is displaceable axially and in rotation relative to said stationary body, said second member being engageable with said first member and said stationary body”



# Allsop's inner housing is not “engageable with” the push-button cap

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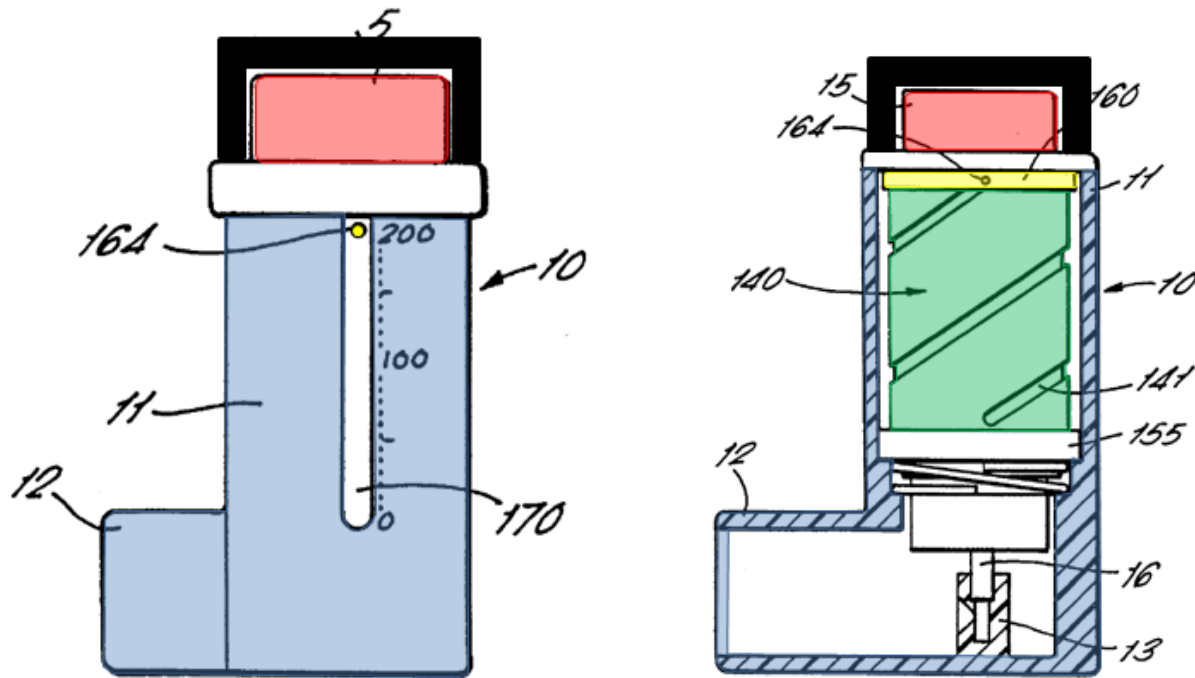
“Typically, testimony concerning anticipation must ... identify each claim element ... and explain in detail how each claim element is disclosed in the prior art reference.”

*Schumer v. Lab. Computer Sys., Inc.*, 308 F.3d 1304, 1315–16 (Fed. Cir. 2002)

“General and conclusory testimony . . . does not suffice as substantial evidence of invalidity.”

*Koito Mfg. Co. v. Turn-Key-Tech, LLC*, 381 F.3d 1142, 1152 (Fed. Cir. 2004)

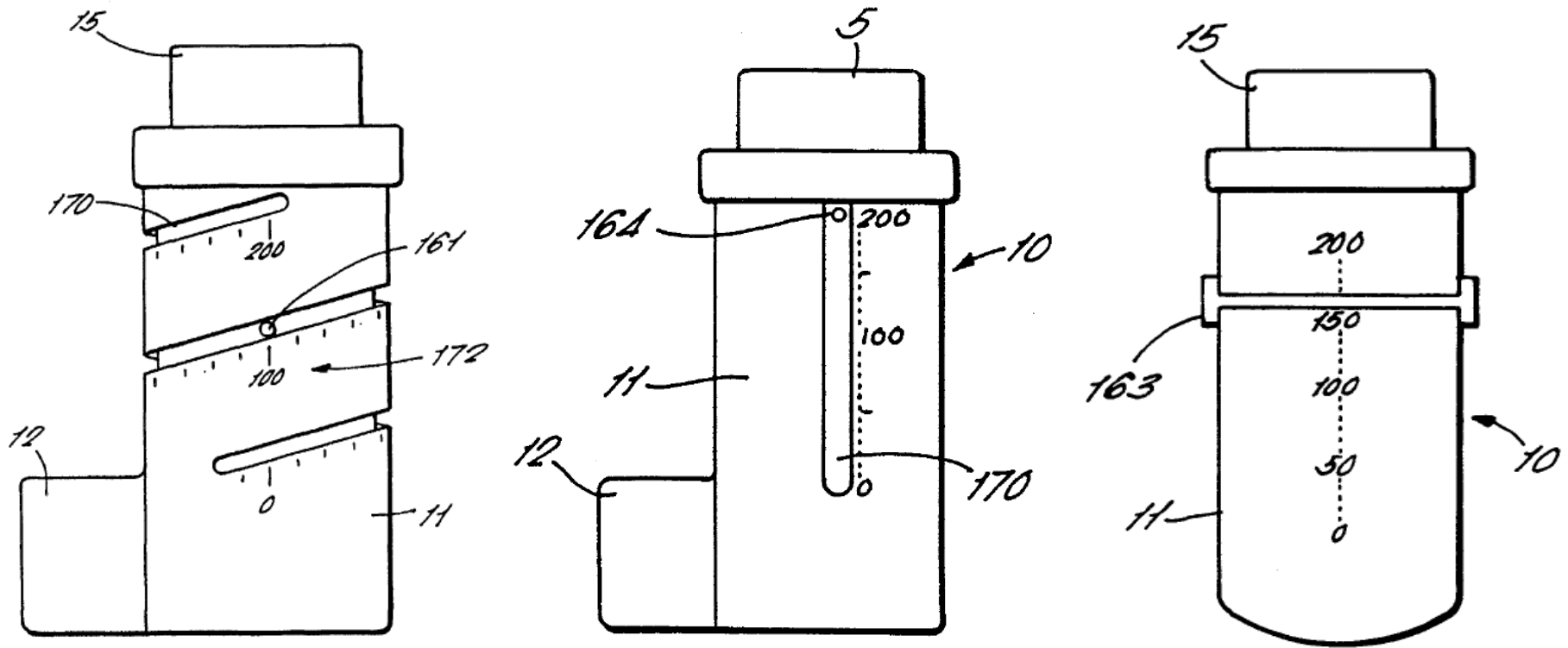
# Allsop's inner housing is not “engageable with” the push-button cap



Ex. 1006 at Figures 1, 3

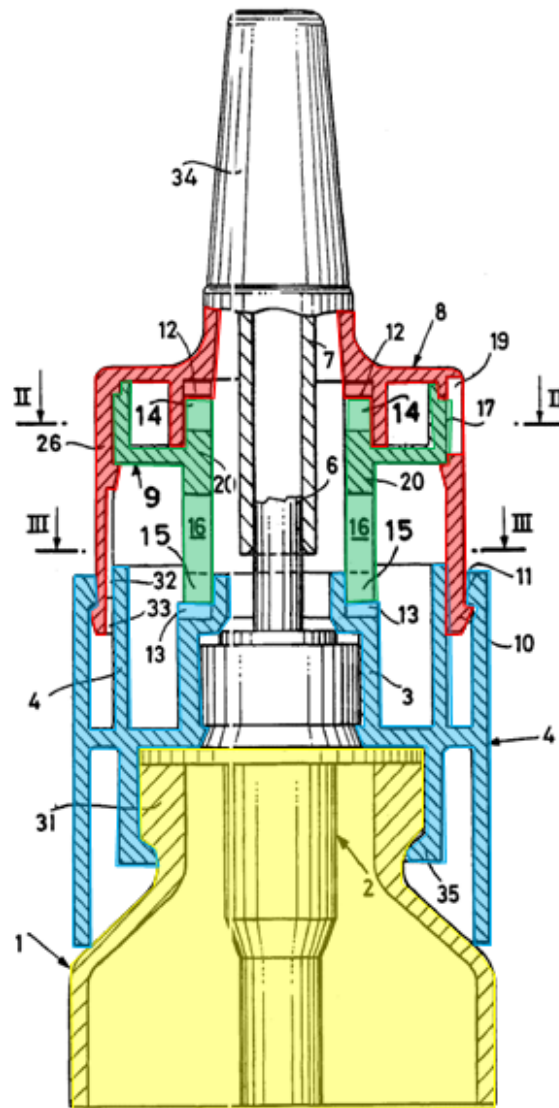
“wherein said first member displaces axially, the stationary body is configured to allow a fluid reservoir to be axially displaceable and permitted to rotate relative to said stationary body, so as to change a displayed dose value from among the plurality of displayable dose values”

# Allsop's dose values are permanently displayed, not “displayable” as required by the claims



Ex. 1006 at Figures 1, 2, 13

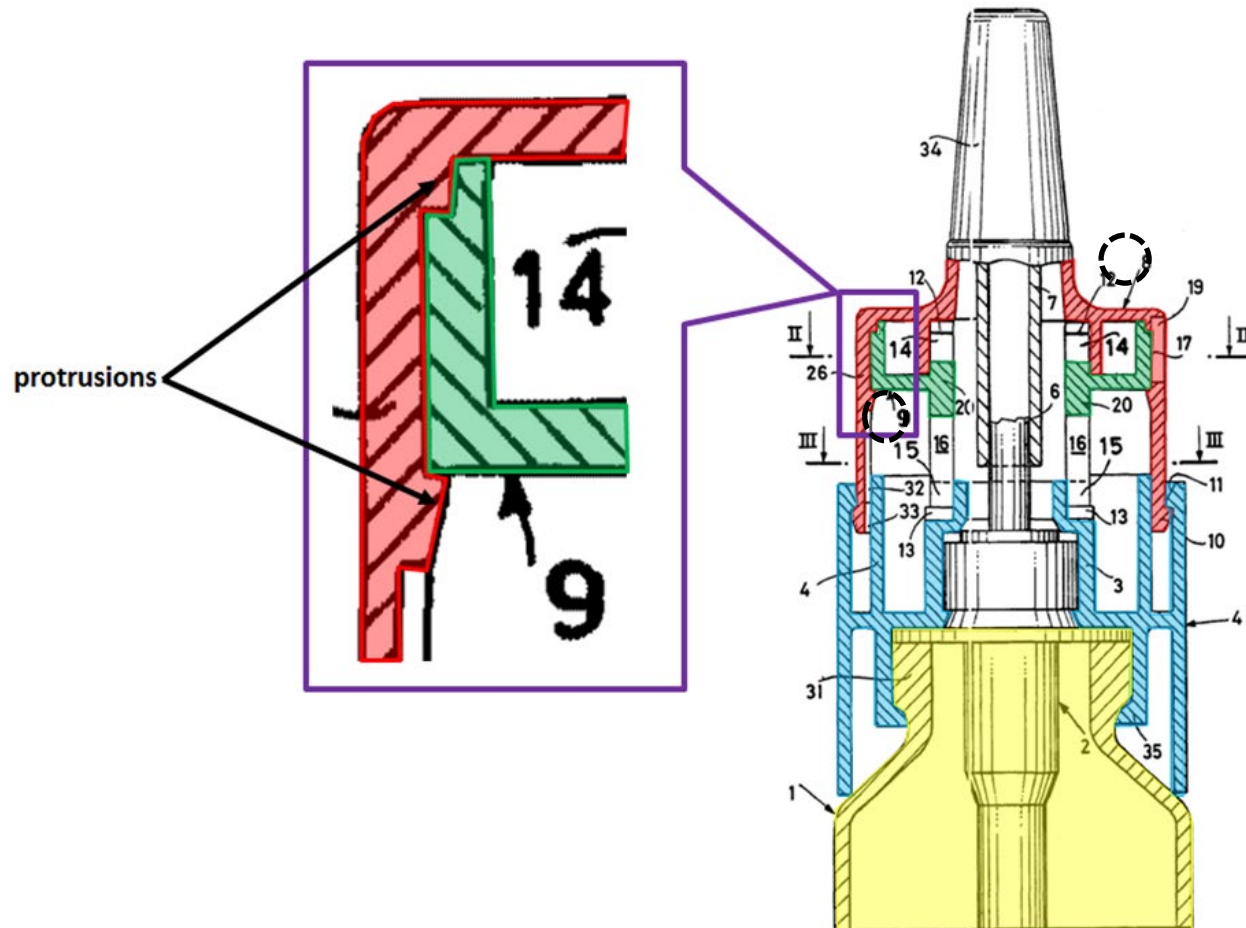
Ground 1 – Allsop



Ex. 1008 at Figure 1

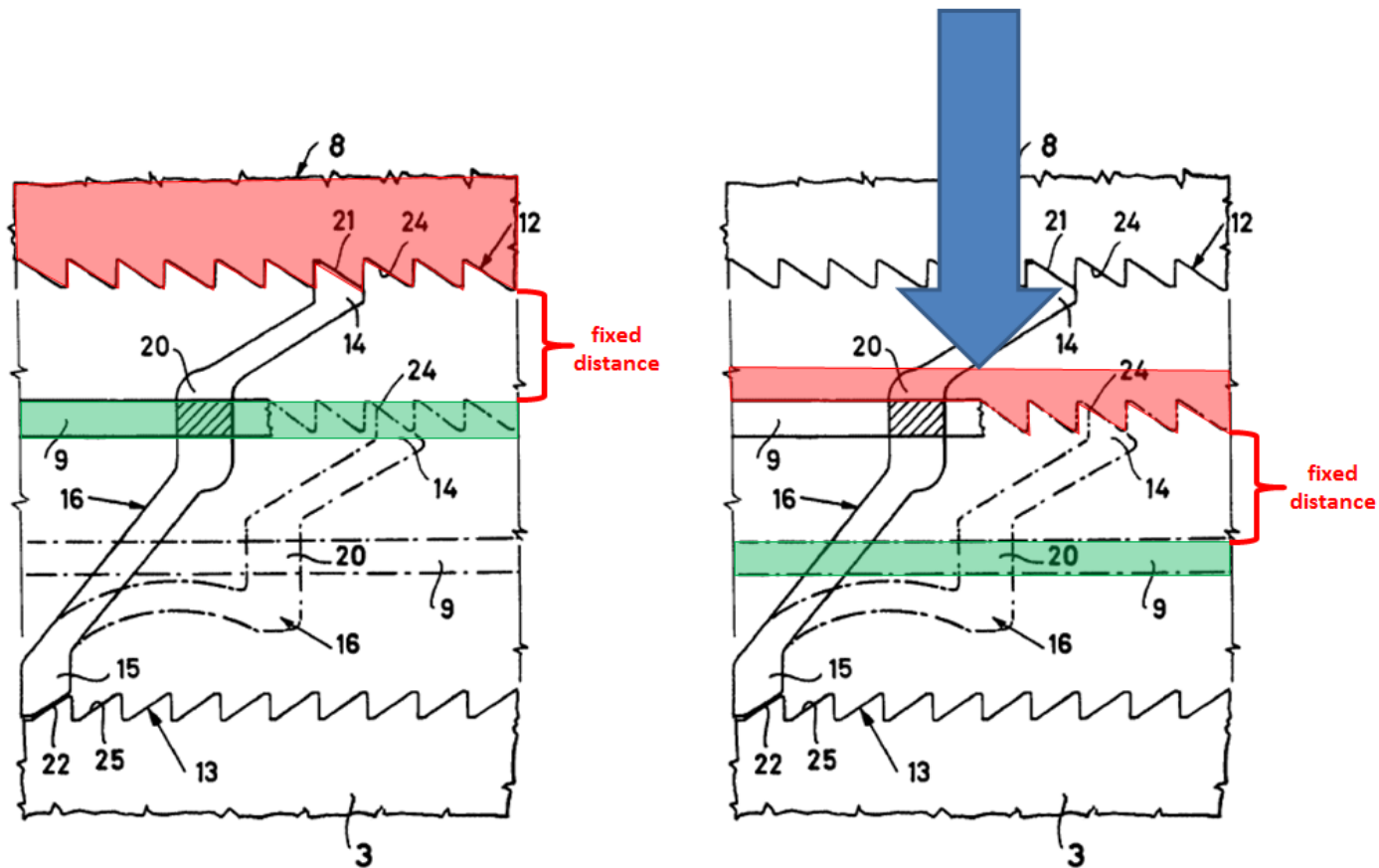
**“a second member that is displaceable axially and in rotation relative to said stationary body,**  
said second member being engageable with said first member and said stationary body”

# The spacing between element 9 and nasal 8 is always maintained at a fixed distance



Ex. 1008 at Figure 1

# The spacing between element 9 and nasal 8 is always maintained at a fixed distance

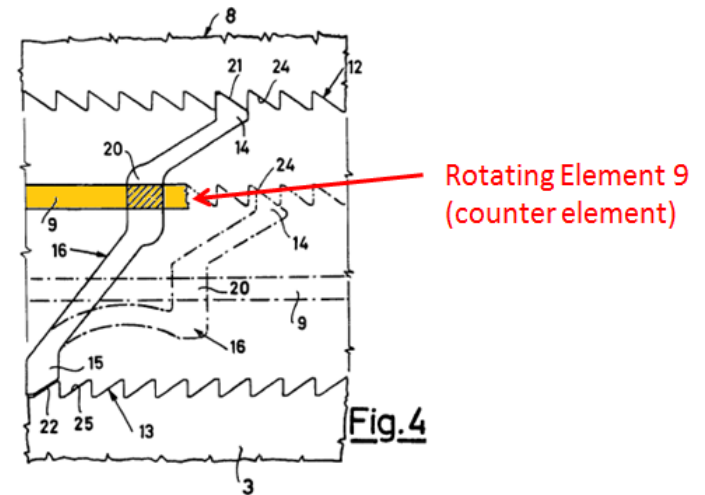
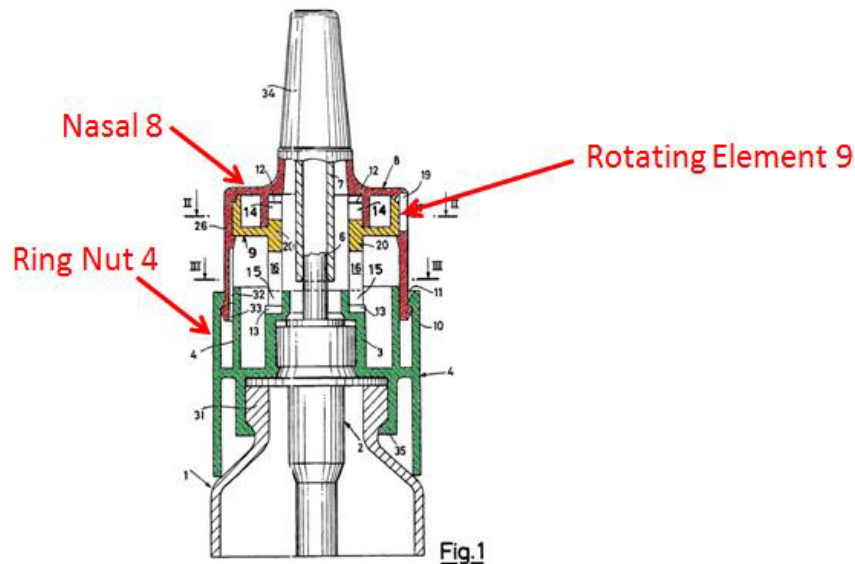


Ex. 1008 at Figure 4



# Petitioners identify “rotating element 9” as the second member that moves axially in the Petition

*Marelli teaches a rotating element 9 (second element).*



See Petition at 26-27, 44, 46-47; Ex. 1008 at Figure 1, 4

# Petitioners improperly advance a new theory of anticipation in their Reply

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Aptar correctly points out that individual component 9 itself moves axially with, not relative to, nasal 8. Response at 24. But the challenged claims broadly cover a “second member.” That second member here corresponds to rotating element 9 with its *integral*, flexible legs.

# Petitioners improperly advance a new theory of anticipation in their Reply

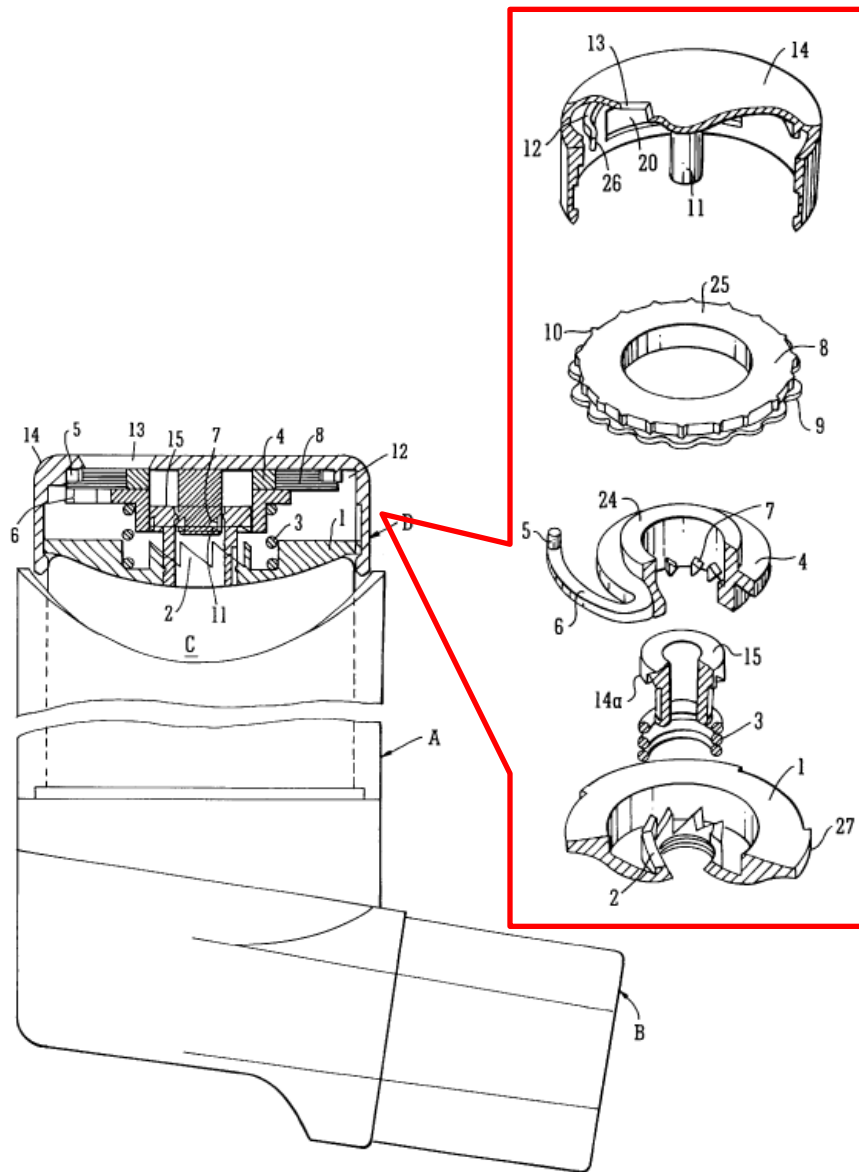
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“Petitioner may not submit new evidence or argument in reply that it could have presented earlier, e.g. to make out a prima facie case of unpatentability.”

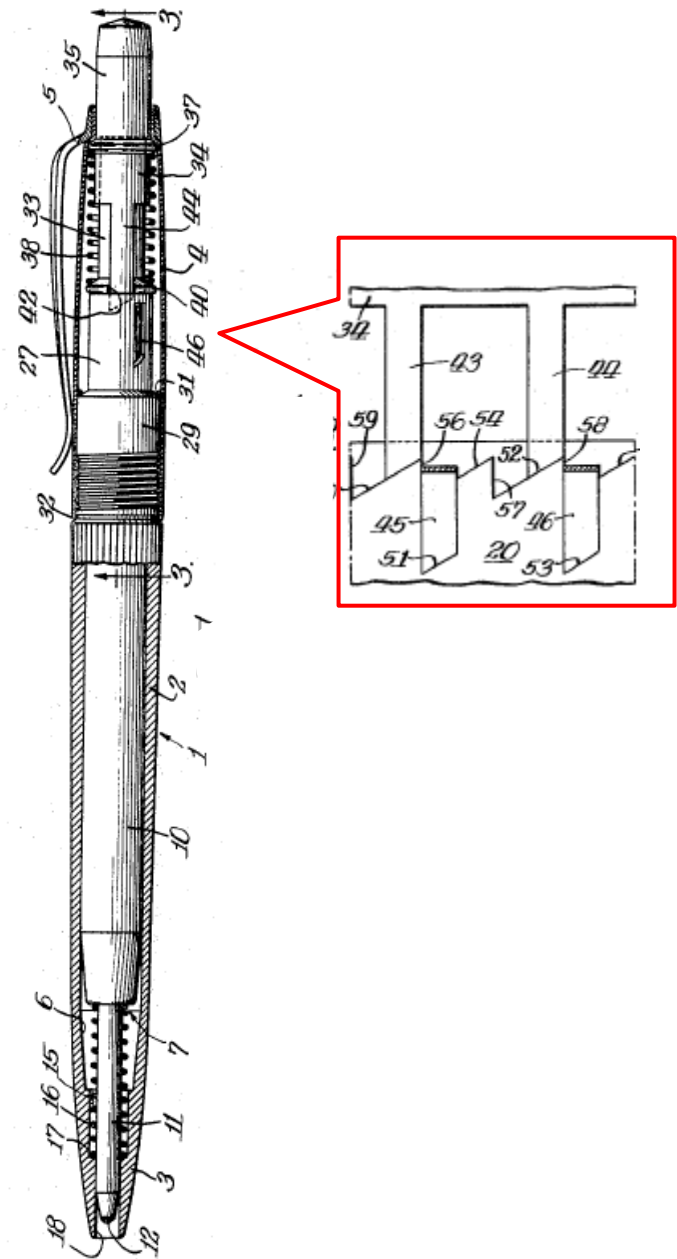
Office Patent Trial Practice Guide, August 2018 Update, 83 Fed. Reg. 39989 (Aug. 2018)

“It is of the utmost importance that petitioners in the IPR proceedings adhere to the requirement that the initial petition identify ‘with particularity’ the ‘evidence that supports the grounds for the challenge to each claim.’”

*Intelligent Bio-Sys., Inc. v. Illumina Cambridge Ltd.*, 821 F.3d 1359, 1369 (Fed. Cir. 2016) (citing 35 U.S.C. §312(a))



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Ex. 1007 at Figures 1, 3; Ex. 1009 at Figure 1

# Petitioners propose many structural changes to Bason in view of Rhoades

## The Petition

- (1) “slightly extend[] Bason’s inhaler body;”
- (2) “integrat[e] the stationary gear (tooth 2) of Bason into the inhaler body just as the stationary gears (stop members) of Rhoades are integrated directly on the Rhoades body;”
- (3) “the rest of the components could be connected in the same way they are connected in Bason;”
- (4) “all of the components would retain their same functions—depressing the Bason cap would depress rings 4 and 8; teeth 7 of ring 4 would interact with stationary teeth 2 (now formed directly on the device housing) and rotate ring 4 to change the dose value the same way they do in Bason.”

## Petitioners’ Reply

- (5) Bason’s cap would be “slightly widen[ed] . . . so that its outer edge fits over the outside of the housing;”
- (6) “a rib ... would [be] added to the outside of the housing ... to prevent unintentional removal of the cap;” and
- (7) “the diameter of ring 4 [would be extended] so that teeth 7 interact with teeth 2.”

Petition at 55-56; Reply at 10, 11, 15

# Petitioners cannot advance a new theory of obviousness in their Reply

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Petitioners cannot use their Reply to belatedly “craft a new obviousness challenge by piggybacking on the one that was clearly wanting.”

*Yamaha Golf Car Co. v. Club Car, LLC*, 2019 WL 1473077 \*13 (Patent Tr. & App. Bd. April 2, 2019)

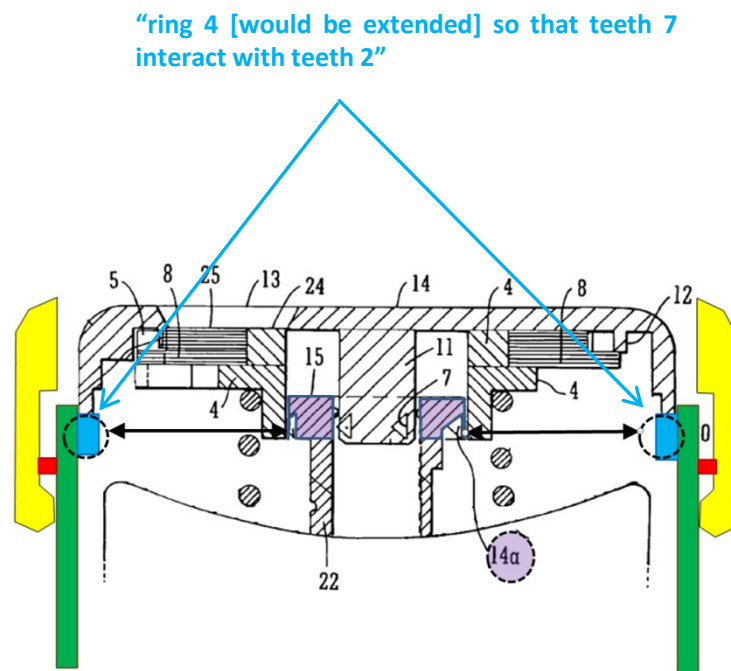
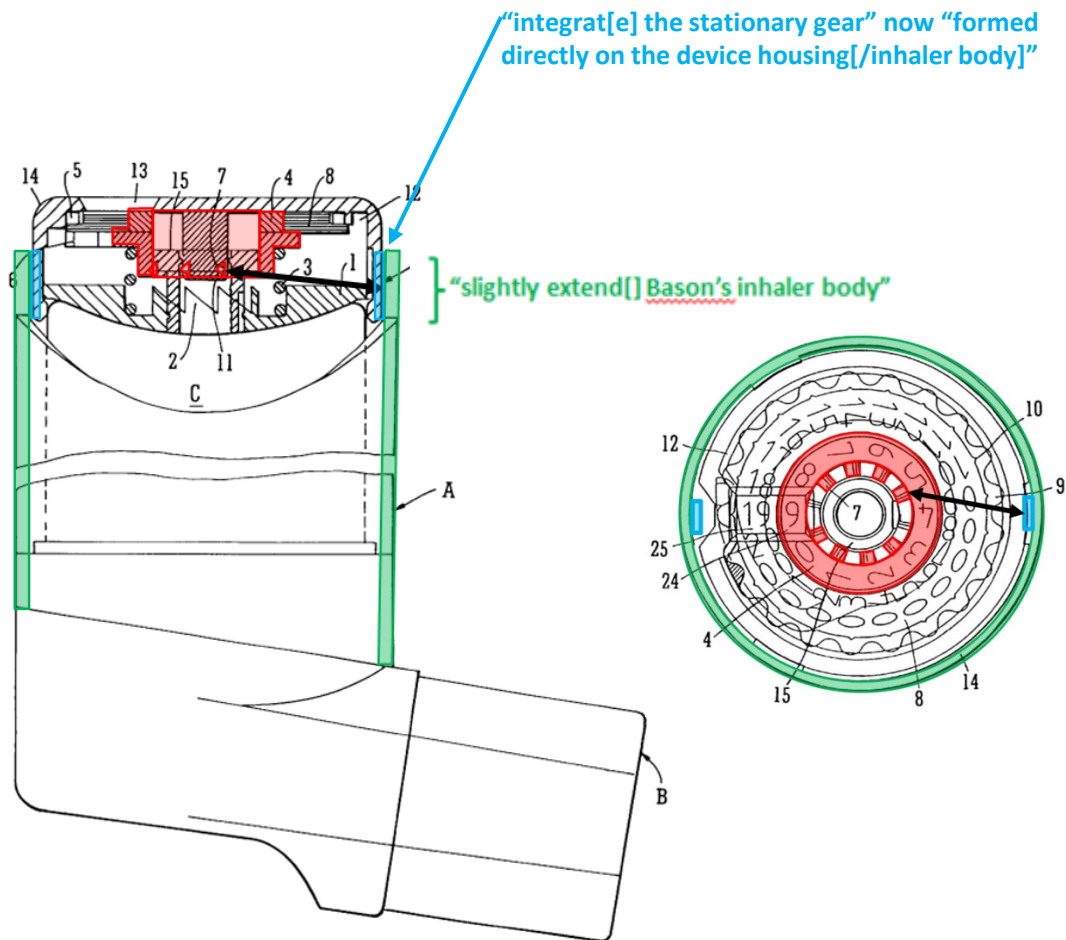
Nor is it permissible for Petitioners to retroactively “fill in the gaps of the Petition by showing, for the very first time, how the prior art of record describes a claim element that was not accounted for previously .”

*Allsteel Inc. v. Dirtt Environmental Solutions, LTD.*, 2018 WL 4488938 \*1 (Patent Tr. & App. Bd., Sept. 17, 2018)

“Shifting arguments in this fashion is foreclosed by statute, our precedent, and Board guidelines.”

*Wasica Fin. GmbH v. Cont’l Auto. Sys., Inc.*, 853 F.3d 1272, 1286–87 (Fed. Cir. 2017)

# Petitioners' proposed modifications render the combination inoperable

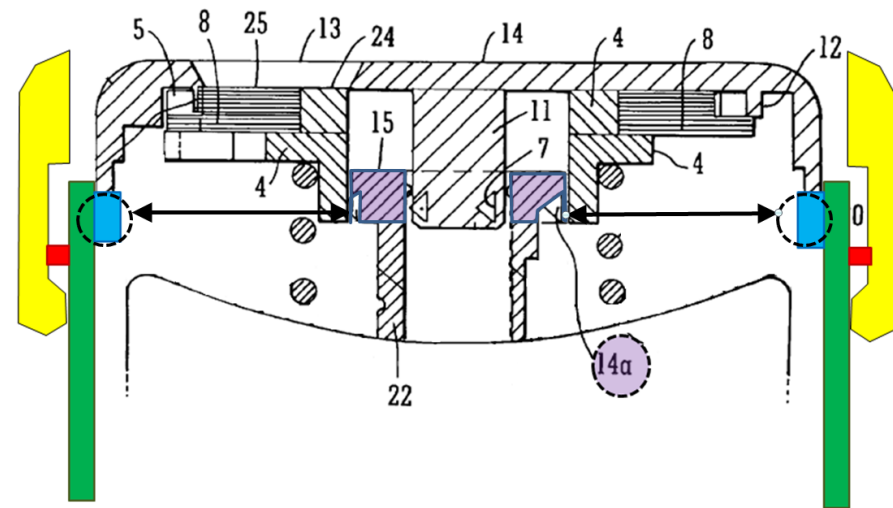
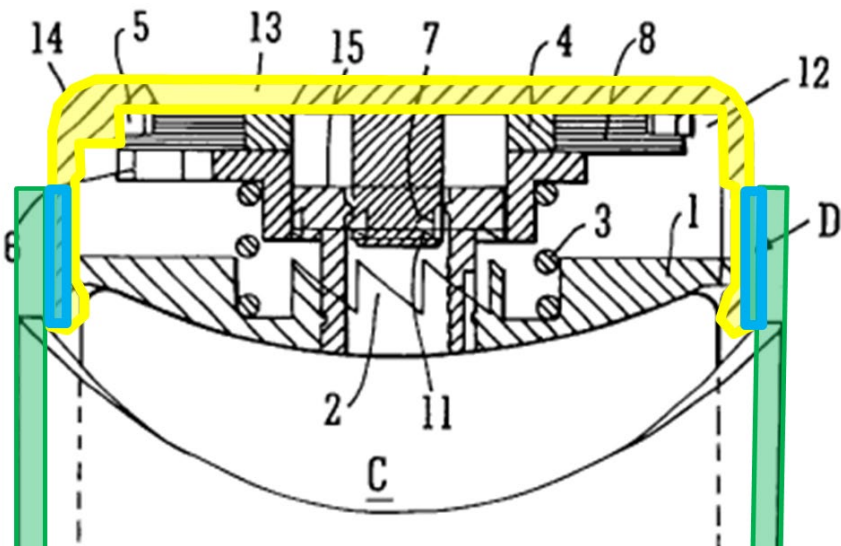


Ex. 1007 at Figures 1, 4, 2

“a first member that is displaceable axially  
relative to said stationary body”



# Bason's cap is not displaceable axially



Ex. 1007 at Figures 1, 2

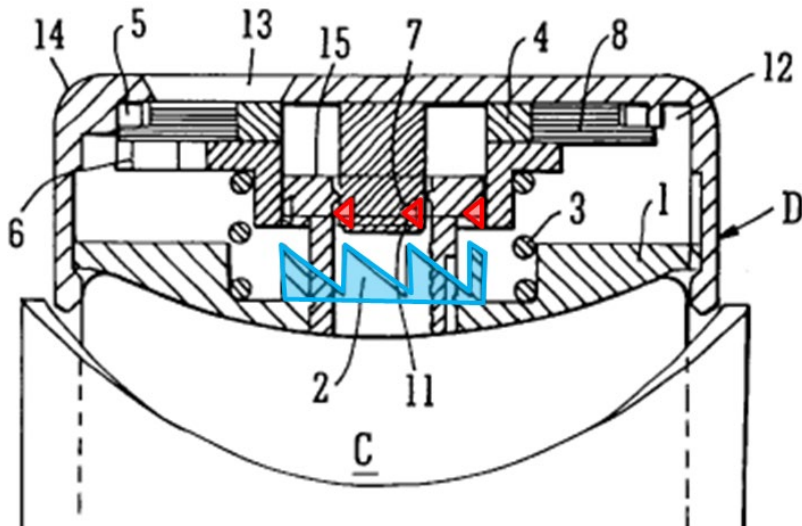
“when said first member displaces axially, said second member is caused to be displaced axially and permitted to rotate relative to said stationary body, so as to change a displayed dose value from among the plurality of displayable dose values”

## For ring 4 to rotate, teeth 7 must contact teeth 2

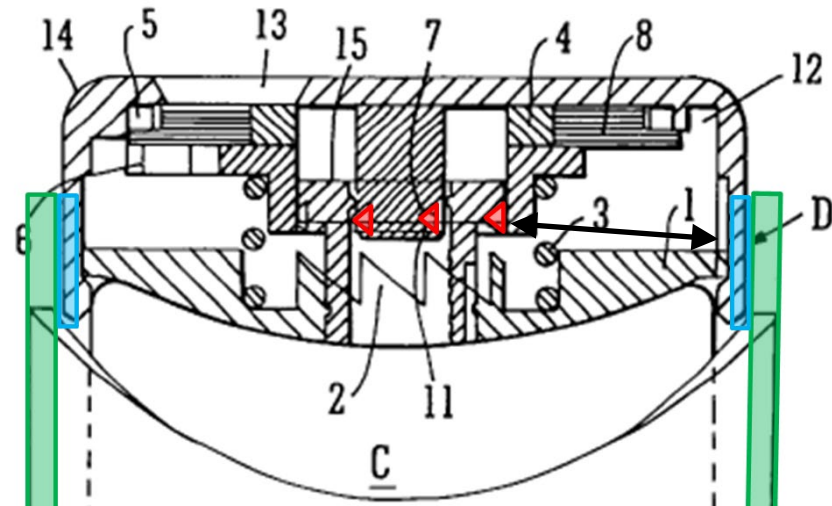
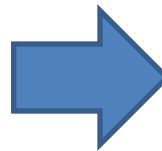
When ring 4 is assembled with central bush 15, the triangular teeth 7 are movable therewith between the teeth 2 and the teeth 14a for a purpose to be described.

Upon depression of the cap 14 with respect to the base 1, the rings 4 and 8 are also depressed linearly causing, upon each depression, the teeth 7 to engage the lower fixed set of teeth 2. Owing to the triangular formation of the teeth 7 and 2 this causes the ring 4 to be indexed in rotation, (See FIG. 5) and upon return or release of the cap, the teeth 7 then engage the upper teeth 14a causing a further rotational movement of the ring 4.

# Teeth 7 never contact teeth 2 in Bason + Rhoades



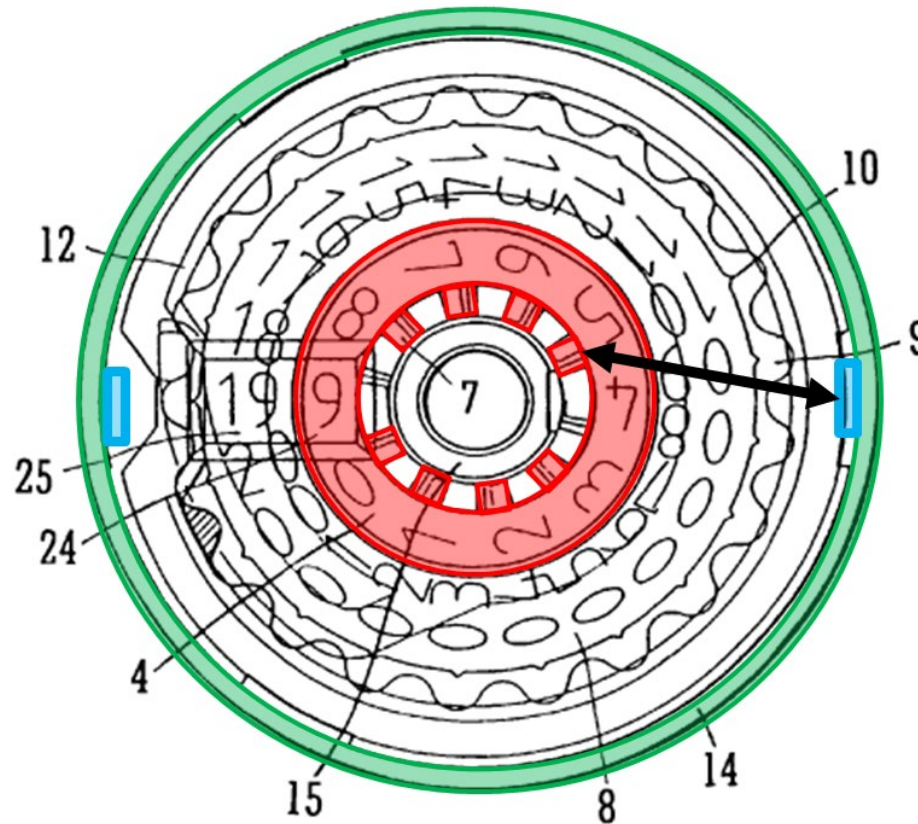
**BASON**



**BASON + RHOADES**

Ex. 1007 at Figure 1

# Teeth 7 never contact teeth 2 in Bason + Rhoades

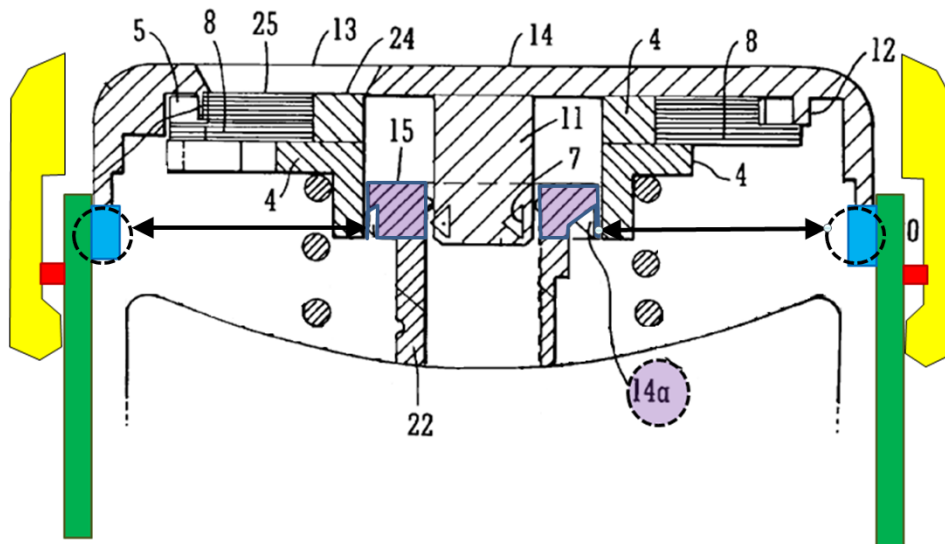


Ex. 1007 at Figure 4

**Ground 3 – Bason + Rhoades**

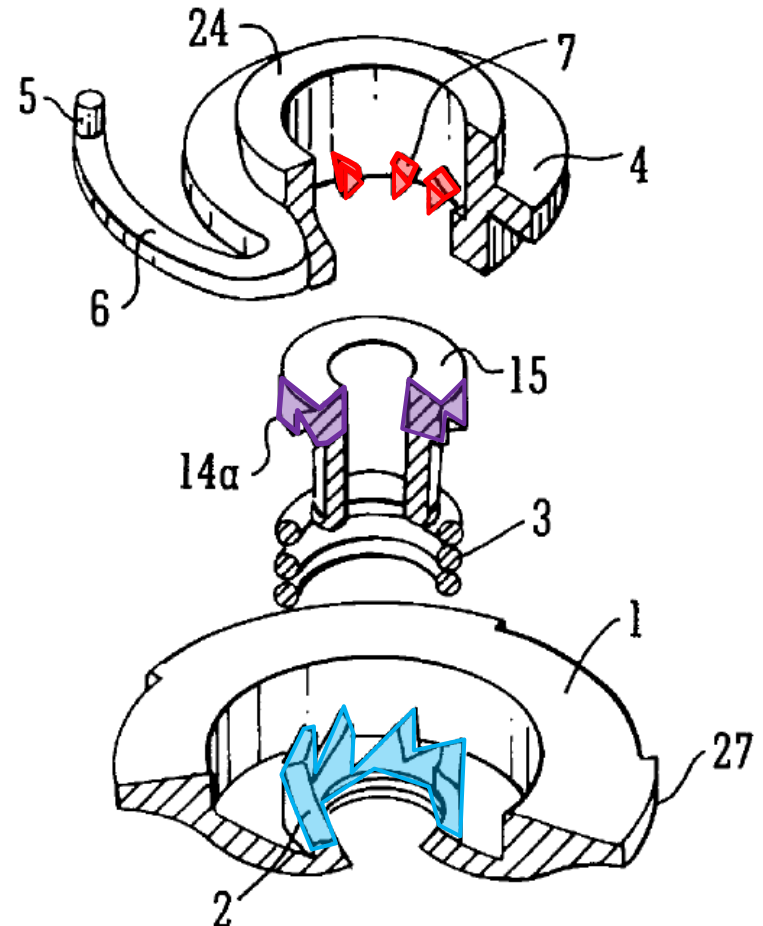
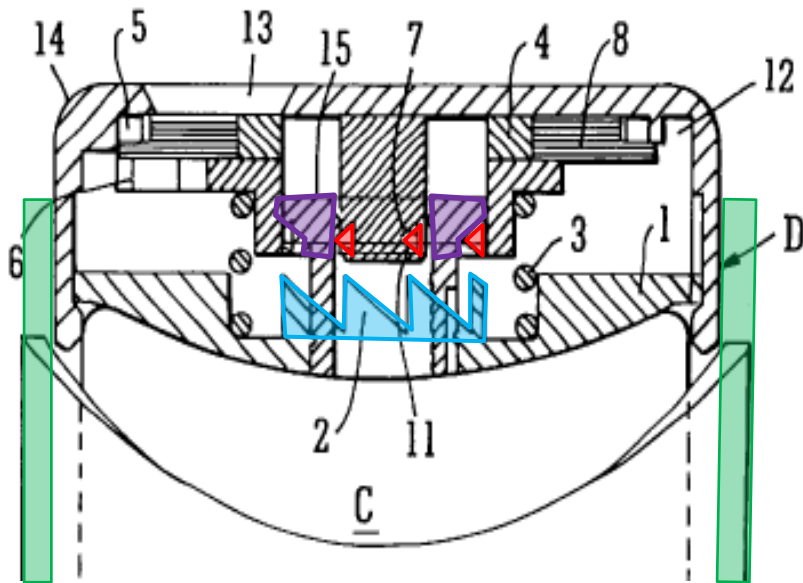
# Teeth 7 never contact teeth 14a in the Revised Bason + Rhoades

Owing to the triangular formation of the teeth 7 and 2 this causes the ring 4 to be indexed in rotation, (See FIG. 5) and upon return or release of the cap, the teeth 7 then engage the upper teeth 14a causing a further rotational movement of the ring 4.



Ex. 1007 at Figure 4

# Bush 15 permits teeth 7 to interact with teeth 2 and teeth 14a

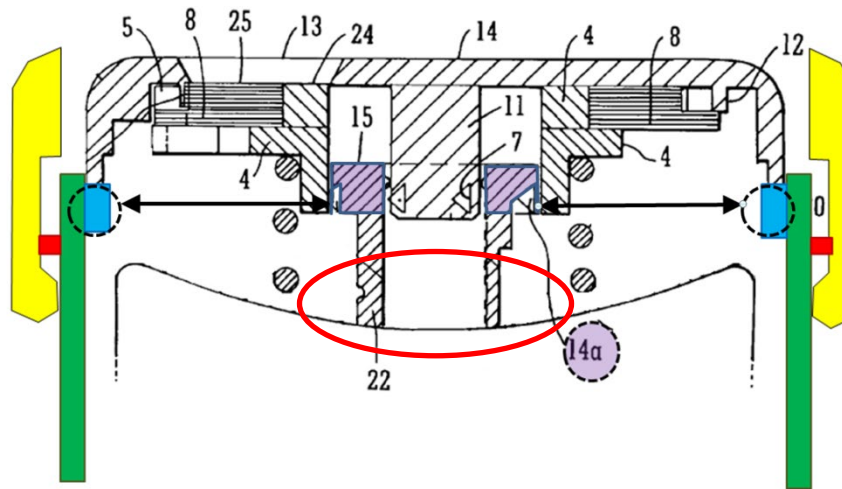


Ex. 1007 at Figures 1, 4



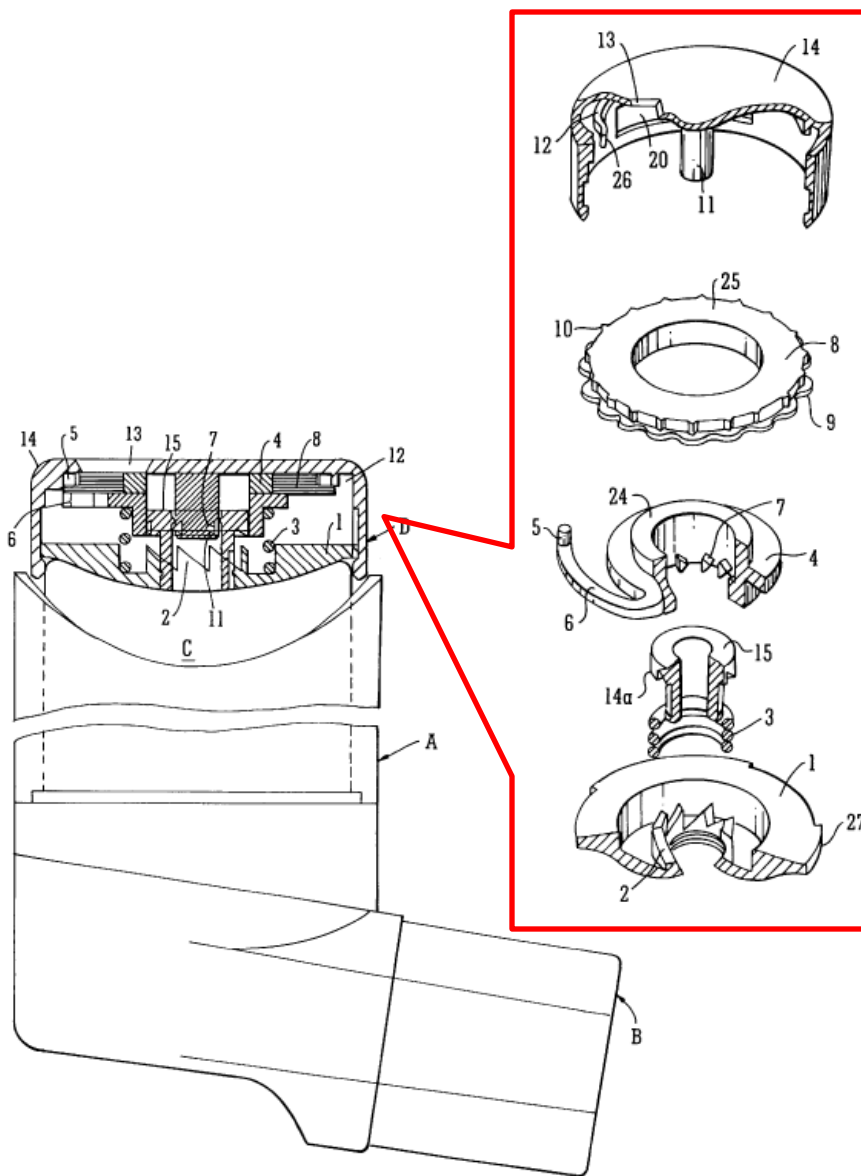
# Bush 15 is no longer mounted in a “non-moveable position” in Petitioners’ combination

Disposed in fixed position on the base 1 is a central bush 15 which in assembly of the device has a part 22 located on the base 1 by of a key way 23 and is thus non-movably attached thereto. The base 1 defines an annular cavity 1a downwardly directed teeth 14a. When ring 4 is assembled with central bush 15, the triangular teeth 7 are movable therewith between the teeth 2 and the teeth 14a for a purpose to be described.

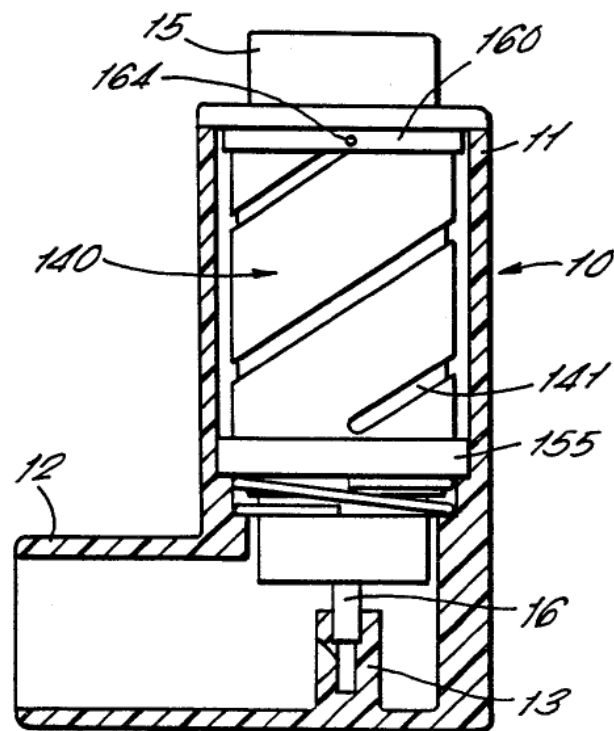


Ex. 1007 at 2:20-24, 35-38 , Figure 1





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Ex. 1007 at Figures 1, 3; Ex. 1006 at Figure 3

# Petitioners propose many structural changes to Bason in view of Allsop

## The Petition

- (1) “move the Bason dose counter below the Bason canister;”
- (2) “mold the base 1 with stationary gear teeth 2 . . . directly into the wall of the Bason inhaler;”
- (3) “all of the components would retain their same functions—depressing the canister of Bason would depress the cap it would now be sitting on top of. The cap would depress rings 4 and 8, causing teeth 7 of ring 4 to interact with stationary teeth 2 and rotate ring 4 to change the dose value the same way they do in Bason . . . . [t]he valve would extend through the counting mechanism just as it does in Allsop.”

## Petitioners’ Reply

- (4) Bason’s cap would be designed “with slots through which teeth 2 [] would protrude;”
- (5) the slots would be “slightly taller than the height of the teeth, allowing the cap to move up and down upon operation of the MDI;”
- (6) teeth 2 would be tapered “narrower at the top, wider at the bottom,” to allow the cap to “slide into position;”
- (7) “the diameter of ring 4 [would be extended] so that teeth 7 interact with teeth 2;” and
- (8) window 13 would “be made on the side of the device.”

Petition at 66-68; Reply at 12, 13, 15

# Petitioners should have disclosed the technical details of their combination in the Petition

“Petitioner may not submit new evidence or argument in reply that it could have presented earlier, e.g. to make out a prima facie case of unpatentability.”

Office Patent Trial Practice Guide, August 2018 Update, 83 Fed. Reg. 39989 (Aug. 2018)

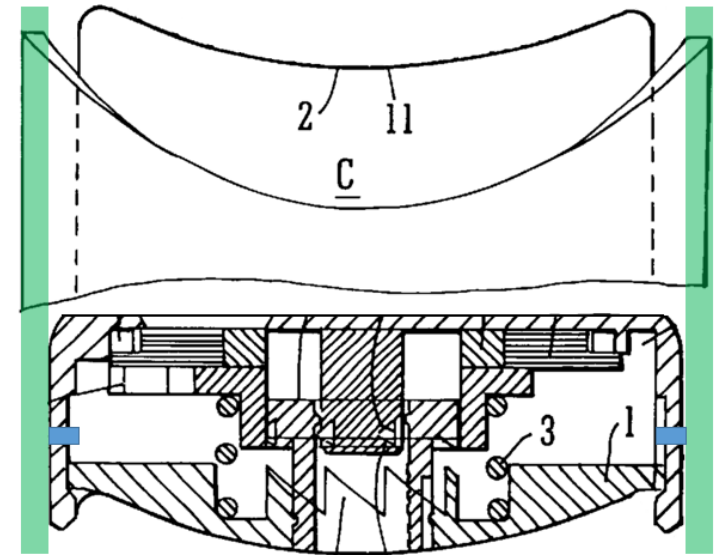
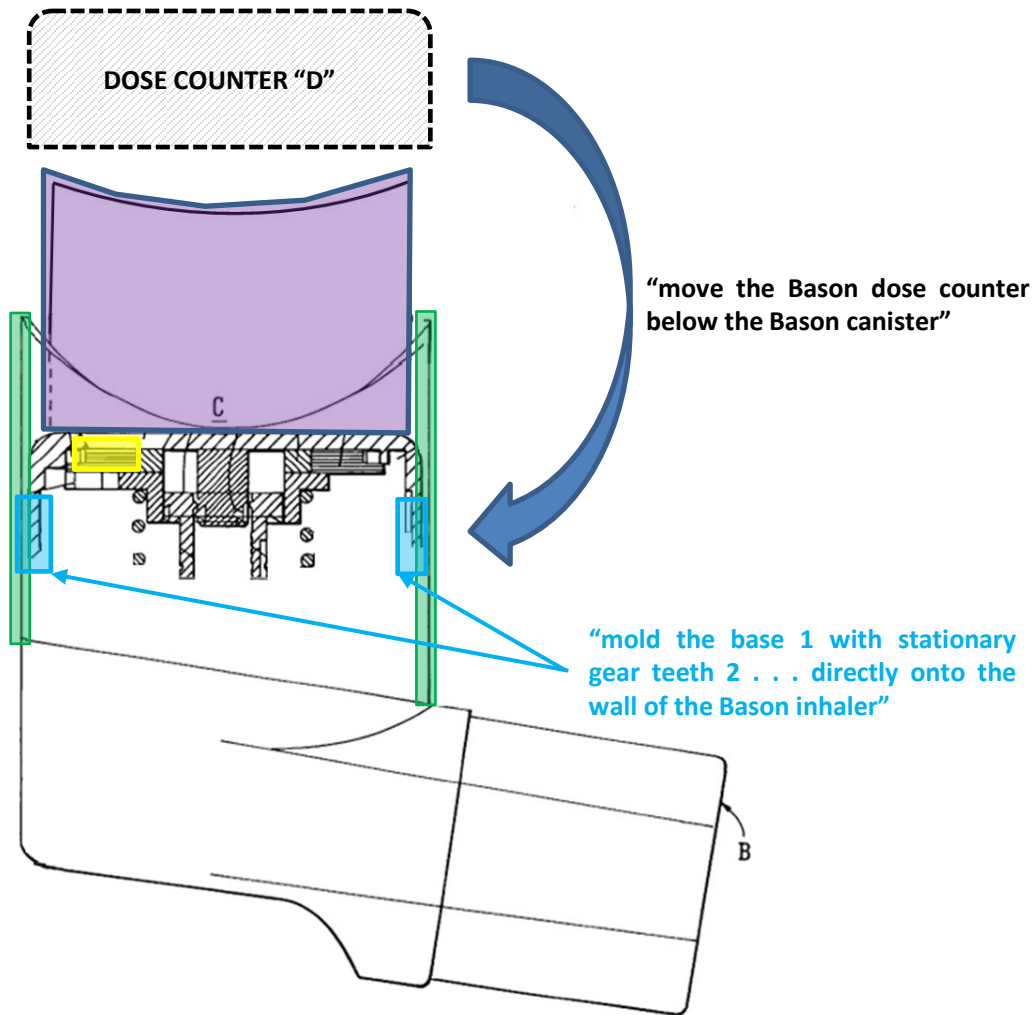
Petitioners cannot use their Reply to belatedly “craft a new obviousness challenge by piggybacking on the one that was clearly wanting.”

*Yamaha Golf Car Co. v. Club Car, LLC*, 2019 WL 1473077 \*13 (Patent Tr. & App. Bd. April 2, 2019)

“Shifting arguments in this fashion is foreclosed by statute, our precedent, and Board guidelines.”

*Wasica Fin. GmbH v. Cont’l Auto. Sys., Inc.*, 853 F.3d 1272, 1286 (Fed. Cir. 2017)

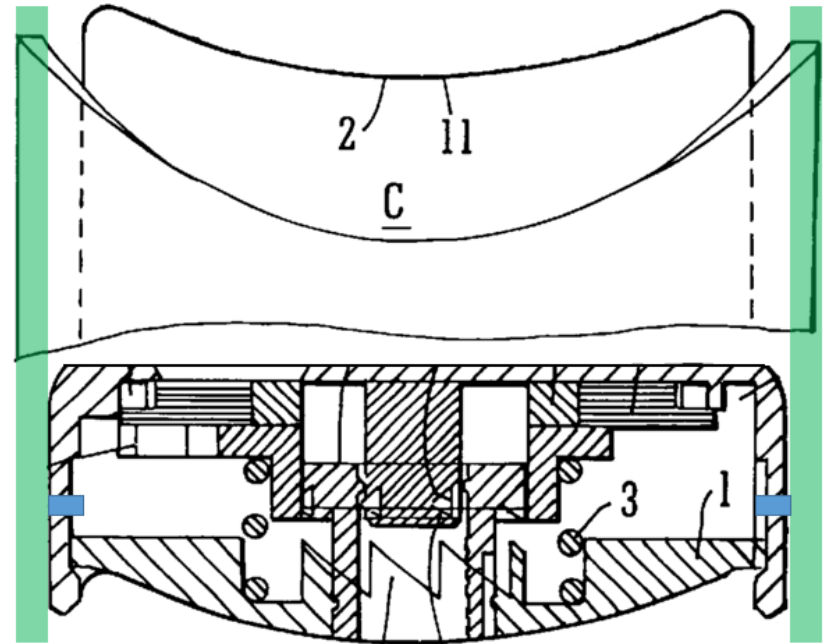
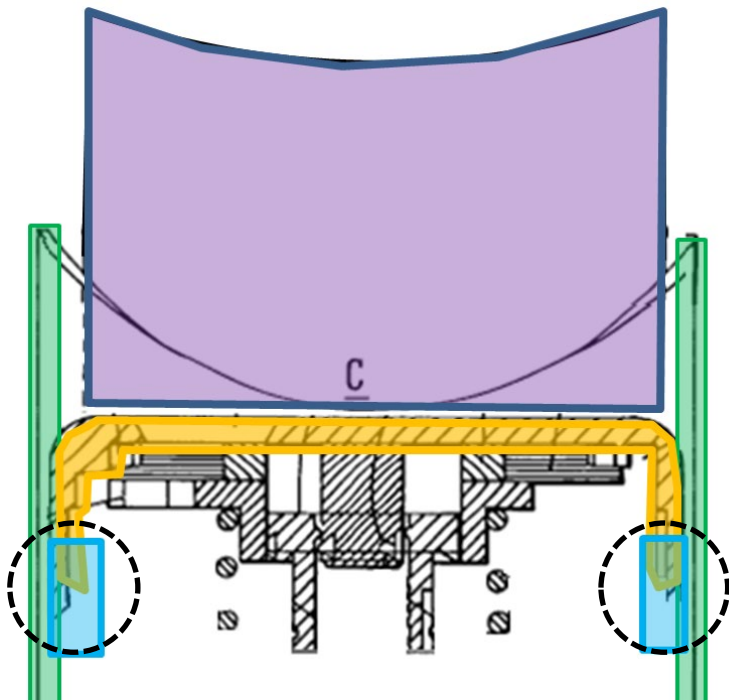
# Petitioners' proposed modifications render the combination inoperable



Ex. 1007 at Figure 1

“a first member that is displaceable axially relative to said stationary body”

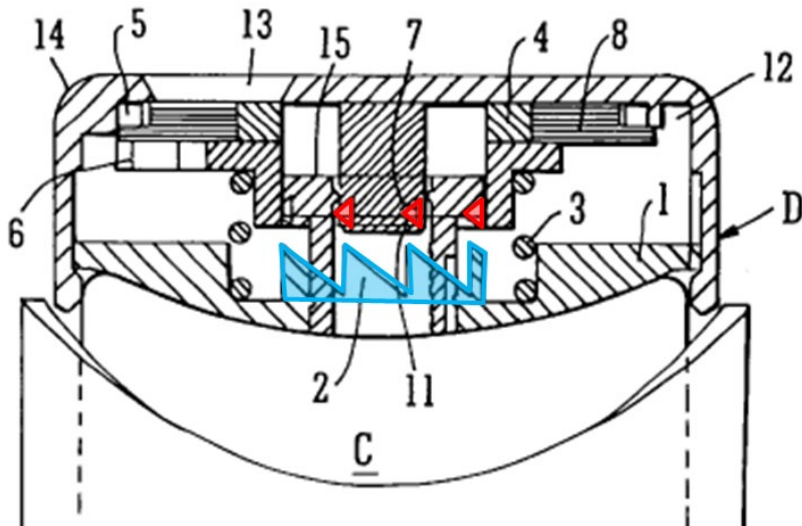
# Bason's cap is not displaceable axially



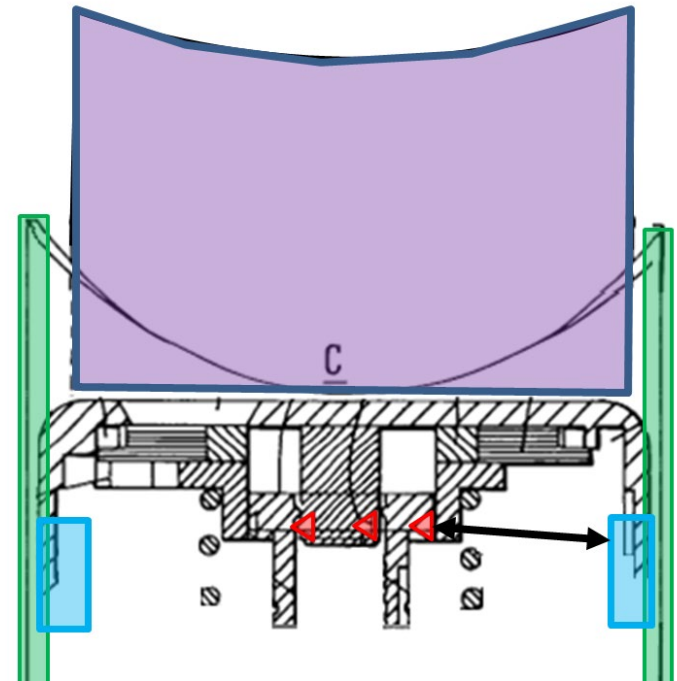
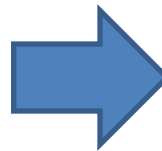
Ex. 1007 at Figure 1

“when said first member displaces axially, said second member is caused to be displaced axially and permitted to rotate relative to said stationary body, so as to change a displayed dose value from among the plurality of displayable dose values”

# Teeth 7 never contact teeth 2 in Bason + Allsop



**BASON**



**BASON + ALLSOP**

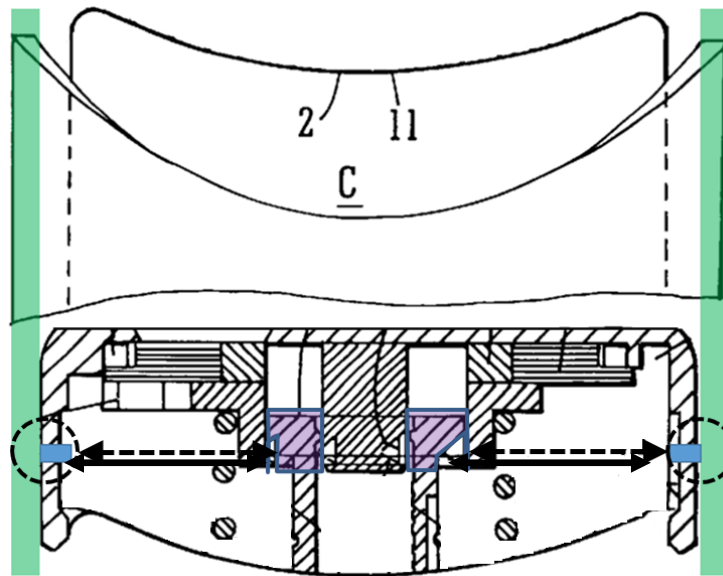
Ex. 1007 at Figure 1

**Ground 4 – Bason + Allsop**



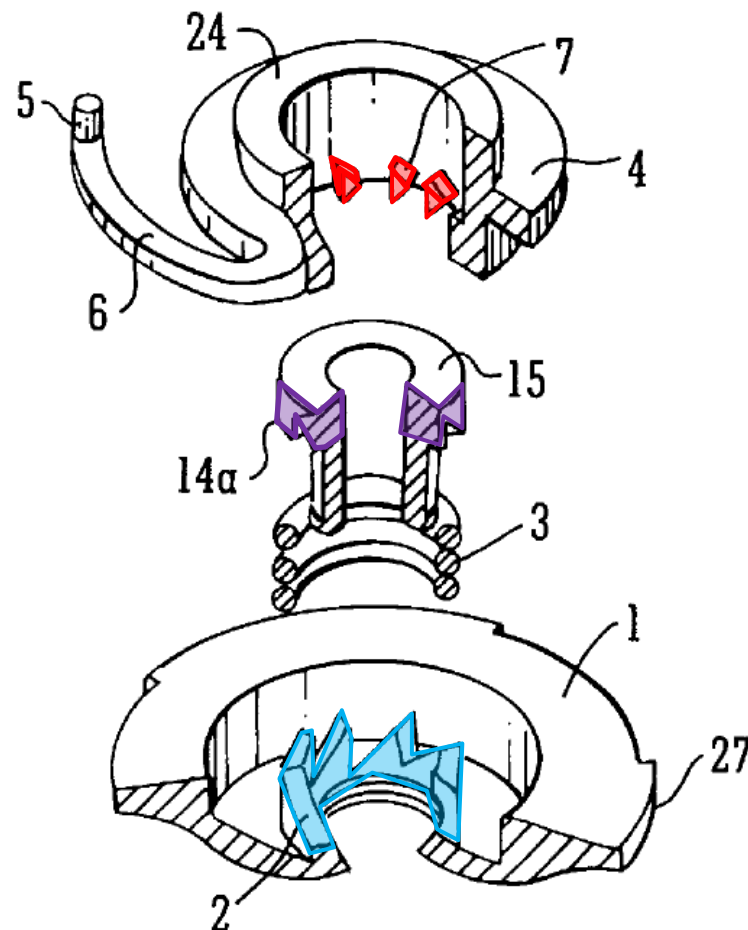
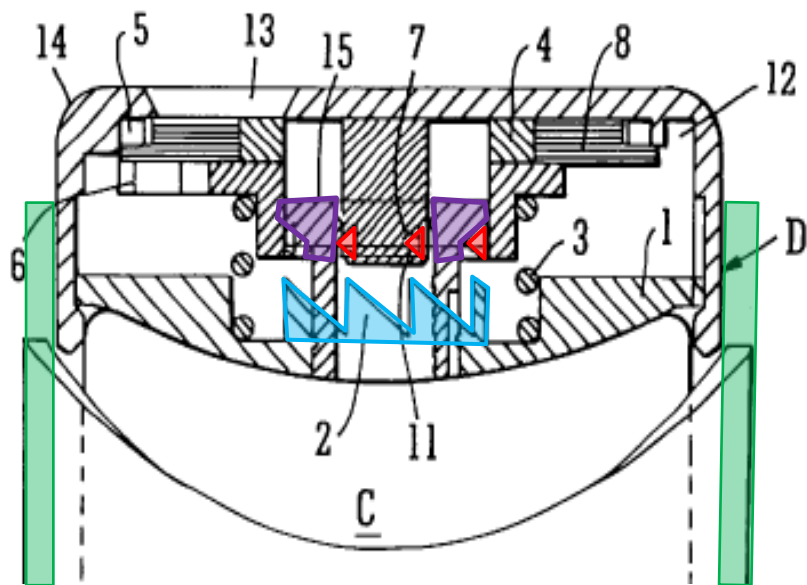
# Teeth 7 never contact teeth 14a in the Revised Bason + Allsop

Owing to the triangular formation of the teeth 7 and 2 this causes the ring 4 to be indexed in rotation, (See FIG. 5) and upon return or release of the cap, the teeth 7 then engage the upper teeth 14a causing a further rotational movement of the ring 4.



Ex. 1007 at Figure 1

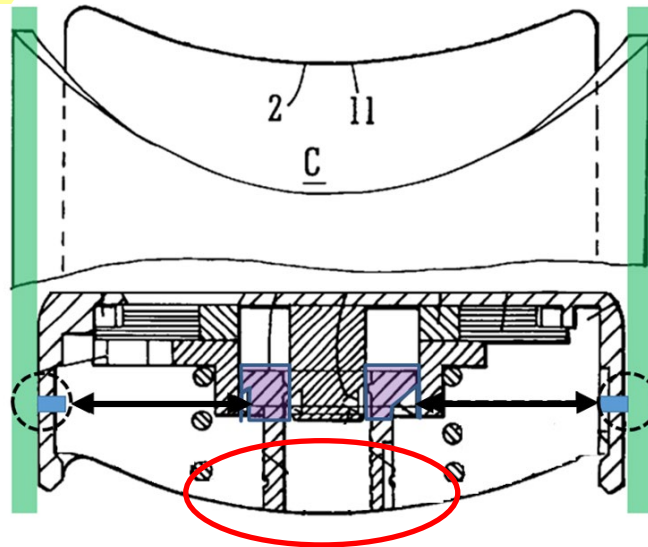
# Bush 15 permits teeth 7 to interact with teeth 2 and teeth 14a



Ex. 1007 at Figures 1, 4

# Bush 15 is no longer mounted in a “non-moveable position” in Petitioners’ combination

Disposed in fixed position on the base 1 is a central bush 15 which in assembly of the device has a part 22 located on the base 1 by of a key way 23 and is thus non-movably attached thereto. The base 1 defines an annular cavity 1a downwardly directed teeth 14a. When ring 4 is assembled with central bush 15, the triangular teeth 7 are movable therewith between the teeth 2 and the teeth 14a for a purpose to be described.

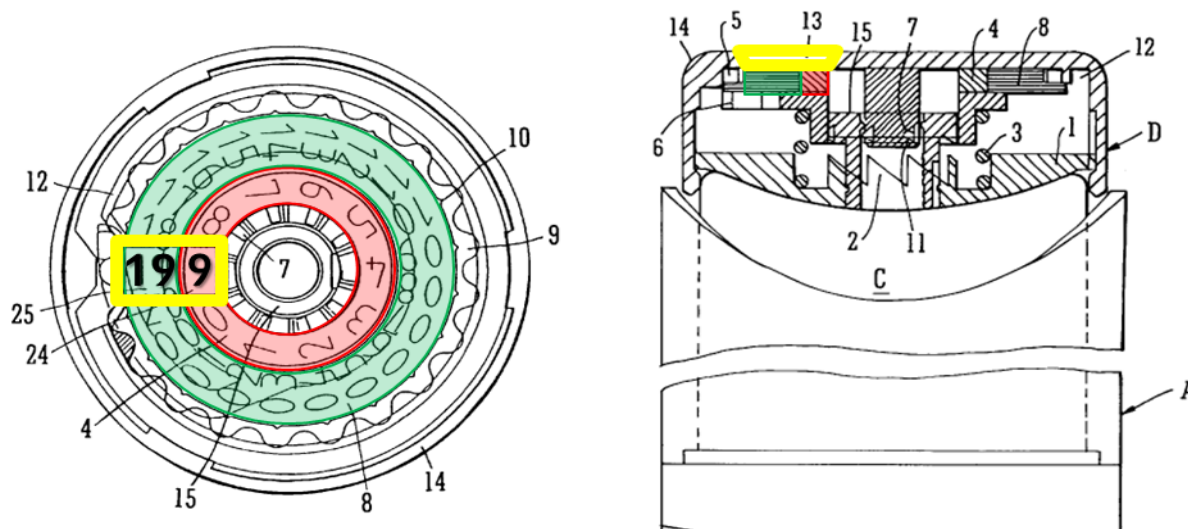


Ex. 1007 at 2:20-24, 35-38, Figure 1

“when said first member displaces axially, said second member is caused to be displaced axially and permitted to rotate relative to said stationary body, so as to change a displayed dose value from among the plurality of displayable dose values”

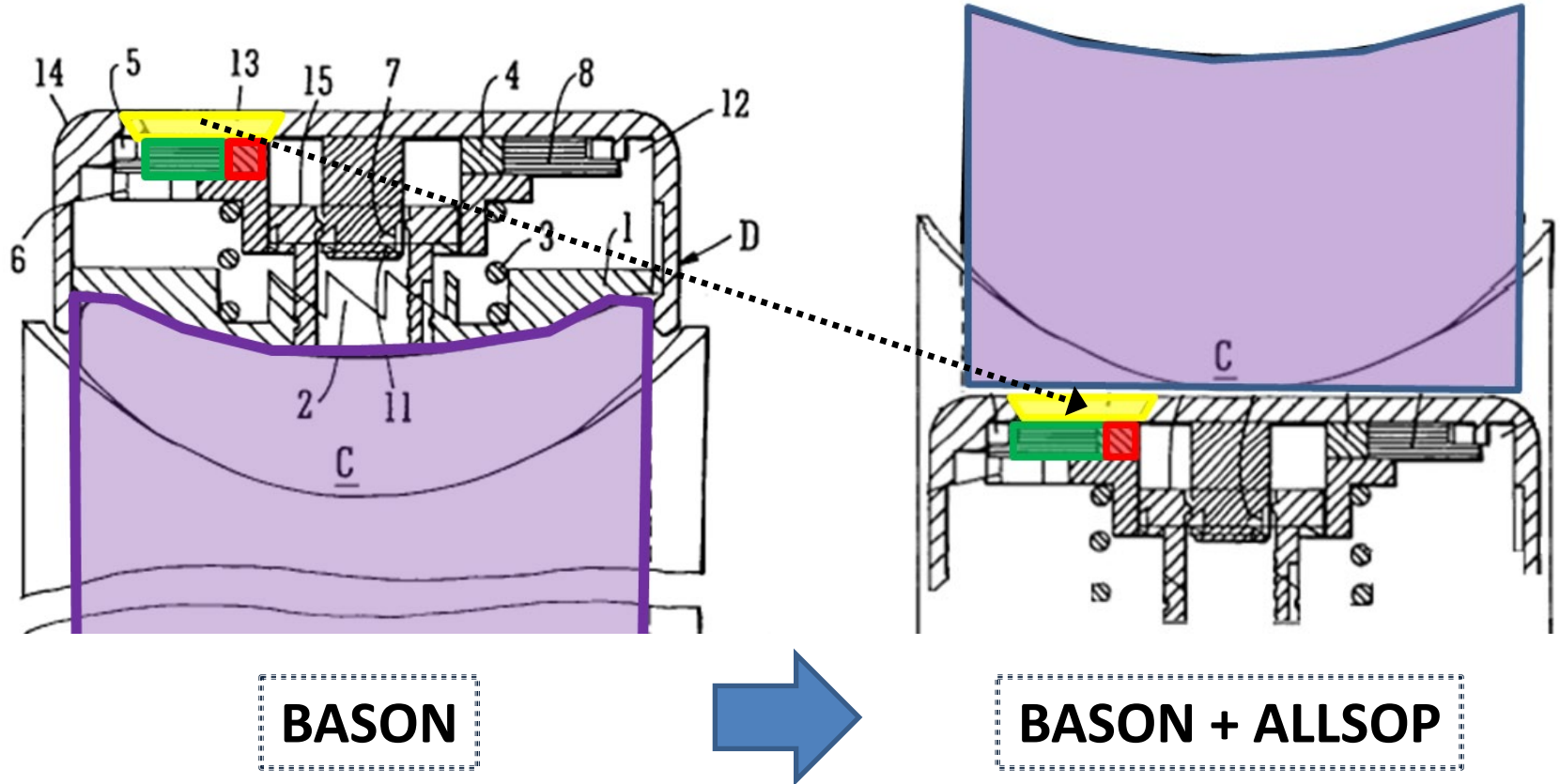
# Bason's dose values appear in window 13

When the entire device is assembled there is visible through the window 13 one radial location of the upper faces 24 and 25 respectively of the rotational rings 4 and 8. These faces carry respectively two numeric series such that face 24 carries the series 0 to 9 while face 25 carries the series 00 to 20. Thus, through the window 13 there may be visible progressively the numbers 000 to 200.



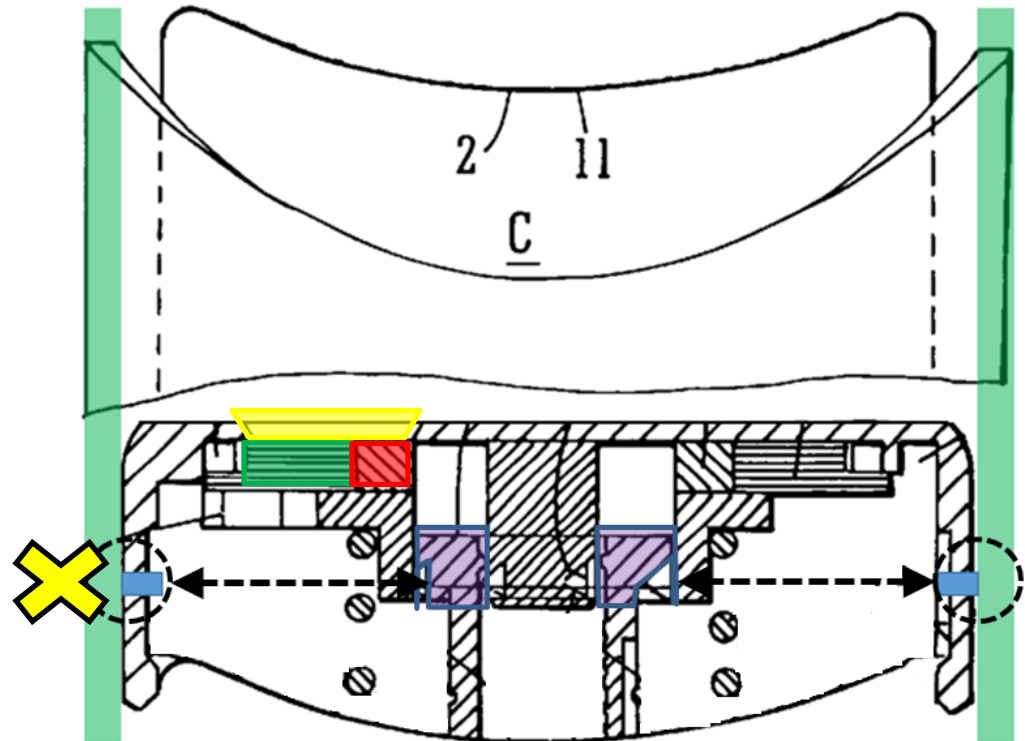
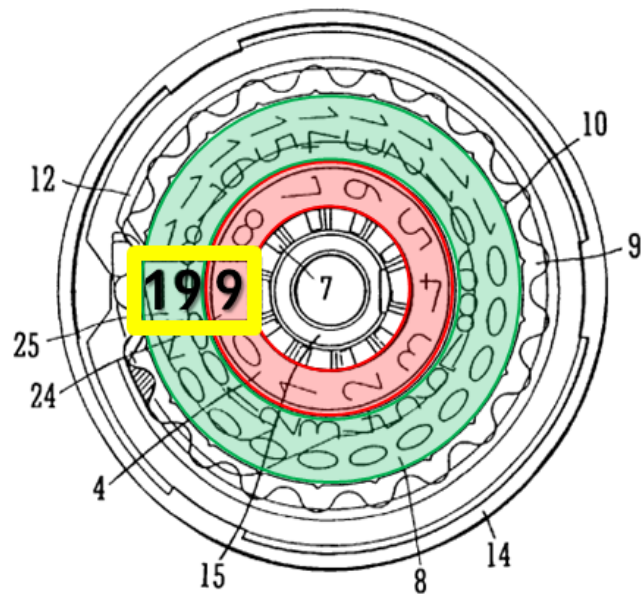
Ex. 1007 at 2:66-3:05, Figures 4, 1

# Window 13 is obscured in Bason + Allsop



Ex. 1007 at Figure 1

# Window 13 cannot be moved to the side of the device



Ex. 1007 at Figures 4, 1