

Nos. 20-1806, 20-1808

**UNITED STATES COURT OF APPEALS
FOR THE FEDERAL CIRCUIT**

BAXTER CORPORATION ENGLEWOOD,

Appellant,

v.

BECTON, DICKINSON AND COMPANY,

Appellee.

Appeals from the United States Patent and Trademark Office, Patent Trial and Appeal Board in *Inter Partes* Review Nos. IPR2019-00120, IPR2019-00121

**PETITION FOR REHEARING EN BANC
BY APPELLANT BAXTER CORPORATION ENGLEWOOD**

GEORGE C. SUMMERFIELD
BENJAMIN E. WEED
KATHERINE L. ALLOR
K&L GATES LLP
70 West Madison Street
Suite 3100
Chicago, IL 60602-4207
T: (312) 372-1121
F: (312) 827-8000

MICHAEL I. COHEN
BAXTER
One Baxter Parkway
DF2-1E
Deerfield, IL 60015-4633
T: (224) 948-2868
F: (224) 948-3393

*Attorneys for Appellant
Baxter Corporation Englewood.*

April 7, 2021

CERTIFICATE OF INTEREST

Counsel for the Appellant Baxter Corporation Englewood certifies the following:

1. **Represented Entities.** Provide the full names of all entities represented by undersigned counsel in this case. Fed. Cir. R. 47.4(a)(1).

Baxter Corporation Englewood.

2. **Real Party in Interest.** Provide the full names of all real parties in interest for the entities. Do not list the real parties if they are the same as the entities. Fed. Cir. R. 47.4(a)(2).

Baxter Healthcare Corporation.

3. **Parent Corporations and Stockholders.** Provide the full names of all parent corporations for the entities and all publicly held companies that own 10% or more stock in the entities. Fed. Cir. R. 47.4(a)(3).

Baxter International, Inc.

4. **Legal Representatives.** List all law firms, partners, and associates that (a) appeared for the entities in the originating court or agency or (b) are expected to appear in this court for the entities. Do not include those who have already entered an appearance in this court. Fed. Cir. R. 47.4(a)(4).

None/Not Applicable.

5. **Related Cases.** Provide the case titles and numbers of any case known to be pending in this court or any other court or agency that will directly affect or be directly affected by this court's decision in the pending appeal. Do not include the originating case number(s) for this case. Fed. Cir. R. 47.4(a)(5). See also Fed. Cir. R. 47.5(b).

Becton, Dickinson and Company v. Baxter Corporation Englewood, No. 2020-1937 (Fed. Cir); and

Baxter Healthcare Corporation and Baxter Corporation Englewood v. Becton, Dickinson and Company, No. 3:17-cv-02186 (S.D. Cal.).

6. **Organizational Victims and Bankruptcy Cases.** Provide any information required under Fed. R. App. P. 26.1(b) (organizational victims in criminal cases) and 26.1(c) (bankruptcy case debtors and trustees). Fed. Cir. R. 47.4(a)(6).

None/Not Applicable.

April 7, 2021

/s/ George C. Summerfield

Signature of Counsel

George C. Summerfield

Printed Name of Counsel

TABLE OF CONTENTS

CERTIFICATE OF INTEREST i

I. INTRODUCTION1

II. DISCUSSION2

 A. The PTAB Proceedings2

 B. The PTAB is not at Liberty to Fashion Challenge Grounds
 Based on Prior Art Teachings Uncited in the Petition5

TABLE OF AUTHORITIES

	Page(s)
Cases	
<i>Apple Inc. v. Andrea Elecs. Corp.</i> , 949 F.3d 697 (Fed. Cir. 2020)	5
<i>Henny Penny Corp. v. Frymaster LLC</i> , 938 F.3d 1324 (Fed. Cir. 2019)	5
<i>Intelligent Bio-Systems, Inc. v. Illumina Cambridge Ltd.</i> , 821 F.3d 1359 (Fed. Cir. 2016)	5
<i>Koninklijke Philips N.V. v. Google LLC</i> , 948 F.3d 1330 (Fed. Cir. 2020)	5
<i>MModal LLC v. Nuance Commc'ns, Inc.</i> , No. 2020-1693, 2021 WL 688505 (Fed. Cir. Feb. 23, 2021).....	1, 5
<i>In re NuVasive, Inc. (II)</i> , 841 F.3d 966 (Fed. Cir. 2016)	6
<i>SAS Inst. Inc. v. Iancu</i> , 138 S. Ct. 1348 (2018).....	1, 5, 6
Statutes	
35 U.S.C. § 312(a)(3).....	1, 2, 6

STATEMENT PURSUANT TO FED. CIR. R. 35(b)(2)

Based on my professional judgment, I believe the panel decision is contrary to the following decision of the Supreme Court of the United States:

SAS Inst. Inc. v. Iancu, — U.S. —, 138 S. Ct. 1348 (2018)

April 7, 2021

/s/ George C. Summerfield
Signature of Counsel

George C. Summerfield
Printed Name of Counsel

I. INTRODUCTION

The Patent Statute specifies that a petition for *inter partes* review (“IPR”) “may be considered only if . . . the petition identifies, in writing and with particularity, each claim challenged, the grounds on which the challenge to each claim is based, and the evidence that supports the grounds for the challenge to each claim.” 35 U.S.C. § 312(a)(3); *see also MModal LLC v. Nuance Commc’ns, Inc.*, No. 2020-1693, 2021 WL 688505, at *6 (Fed. Cir. Feb. 23, 2021) (“A petitioner generally must provide in the petition an understandable explanation of the element-by-element specifics of the unpatentability challenges, including the particular portions of prior art supporting those challenges.”). The Supreme Court has made clear that, in light of this provision, the Patent Trial and Appeal Board (“PTAB”) does not “enjoy[] a license to depart from the petition and institute a *different* *inter partes* review of [its] own design.” *SAS Inst. Inc. v. Iancu*, 138 S. Ct. 1348, 1356 (2018) (emphasis in original). To ensure the integrity of IPR proceedings, and to satisfy the statutory requirement of section 312(a)(3), this prohibition against altering the grounds set forth in a petition must be invariably enforced. This includes supplementing the portions of prior art references cited in the Petition.

Unfortunately, the PTAB ignored that prohibition here, cherry picking an uncited figure from U.S. Appl. Pub. No. 2011/0191121 (“Fioravanti”) and making that figure the centerpiece of both its decision to institute the subject IPR, and then

finding all challenged claims of U.S. Patent No. 9,662,273 (“the ‘273 Patent”) invalid. In affirming the PTAB’s judgment, the Panel perpetuated the problem. Because the prohibition against fashioning new challenge grounds set forth in section 312(a)(3) is not discretionary, this Court should exercise *en banc* review and reverse such judgment.

II. DISCUSSION

A. The PTAB Proceedings

Claim 1, the sole independent claim of the ‘273 Patent, requires, *inter alia*:

a memory in operative communication with the processor, wherein a weight and a medical dose preparation image of at least one medication receptacle supported on the support platform within the medication preparation staging region are associatively stored in the memory.

Appx224, col. 26, lines 23-27 (the “associatively stored” limitation).

The Petition said the following regarding Fioravanti’s teaching of this limitation:

Fioravanti teaches that “medical prescriptions” for each drug stored in the database in “memory device 15” include:

The dose, i.e., the **weight** or amount of each active principle; the different types of syringes that can be used during preparation ...; the different types of vials containing the same active principle... The memory device 15 moreover contains, for each type of syringe, a **syringe sample image** and, for each type of vial, a **vial sample image**.

(Ex. 1006 at 0037-38.) Fioravanti also teaches that the processing system uses the image and weight data in association with each other to determine whether the steps of preparing a medication dose have been followed correctly. (*See, e.g., id.* at 0059-61, 0073-74, 0080-85, 0089-95.)

A POSITA would have understood from the teachings of Fioravanti that the processing system performs these comparisons of weight and image data for the steps of filling a particular prescription by storing and retrieving the data associated with the prescription from the database in memory device 15. (*See Ex. 1004, ¶¶ 34-36, 49.*)

Appx312-313 (emphasis in original).

Despite the Petition's omission of any reference to Fioravanti's Figure 10 relating to the "associatively stored" limitation, the PTAB, in instituting the proceeding below, stated that such figure shows "a current image of the hypodermic syringe in association with its current and target weight." Appx491. And, the PTAB invoked Appellant's lack of prescience in failing to "explain how [Fioravanti's] system could use the image data in association with the weight data without, at some point, having that data associatively stored in memory," given what appears in Figure 10, thereby shifting the burden to Appellant of preemptively showing what is *not* taught by that figure. Appx491.

The PTAB repeated these statements regarding Figure 10 in its Final Written Decision finding the challenged claims of the '273 Patent obvious. Appx25; Appx29. The PTAB referenced that figure with regard to the "associatively stored" limitation, explicitly or implicitly, for the three challenge grounds upon which

Appellee prevailed below. *See* Appx36 (Ground 2 – “Fioravanti already teaches to store in memory, at least temporarily for the real-time display, associated images and weight related to medication dose preparation. *See, e.g.,* Ex. 1006, Fig. 10”); Appx55 (Ground 3 – “Patent Owner argues that Petitioner has not shown that either Fioravanti or Alexander teaches or suggests that weight and image data are associatively stored in the memory as required by Elements [1g]/[1h]. PO Resp. 64–67. For at least the reasons discussed above in section II(E)(1), above, we do not find this argument persuasive in light of Fioravanti alone”); and Appx63 (Ground 4 – “As set forth in section II(E)(1), above, Petitioner reasonably relies on Fioravanti for the associatively stored in memory limitation of Elements [1g]/[1h]”).

In short, despite the Petition’s complete omission of any reference to Fioravanti’s Figure 10 with regard to the “associatively stored” limitation, the PTAB relied upon that figure in finding all challenged claims of the ‘273 Patent unpatentable. Despite the Appellant having raised the impropriety of the PTAB having cited Figure 10 below without any corresponding citation from Appellee in its Petition, the PTAB gave no explanation for having done so. Appellant also raised this impropriety on appeal. Baxter Opening Br. at 47–48. Nonetheless, the Panel affirmed the PTAB’s judgment without opinion. For the reasons set forth below, it was improper for the PTAB to have found the challenged claims obvious based upon a ground it newly fashioned.

B. The PTAB is not at Liberty to Fashion Challenge Grounds Based on Prior Art Teachings Uncited in the Petition

As noted above in the Introduction section, section 312(a)(3) of the Patent Statute requires that an IPR petition identifies “the grounds on which the challenge to each claim is based,” which the Supreme Court has clarified precludes a departure from the “petition and institut[ion of] a *different* inter partes review of [its] own design.” *SAS*, 138 S. Ct. at 1356 (emphasis in original); *see also Koninklijke Philips N.V. v. Google LLC*, 948 F.3d 1330, 1336 (Fed. Cir. 2020). This Court has made clear that adhering to this statutory requirement “is of the utmost importance.” *Intelligent Bio-Systems, Inc. v. Illumina Cambridge Ltd.*, 821 F.3d 1359, 1369 (Fed. Cir. 2016).

Here, the PTAB indisputably cited to a portion of the Fioravanti reference (Figure 10) omitted from the Petition with regard to the “associatively stored” limitation, with no explanation for it having done so. It is certainly important to distinguish an impermissible new ground not sufficiently made in the Petition from a permissible explanation and defense of a point already sufficiently made, in substance, in the Petition. *See MModal*, 2021 WL 688505 at *6 (citations omitted). However, a citation to “previously unidentified portions of a prior-art reference to make a meaningfully distinct contention” falls into the impermissible category. *See Apple Inc. v. Andrea Elecs. Corp.*, 949 F.3d 697, 706 (Fed. Cir. 2020). This same impermissibility label applies to an “entirely new rationale for why a claim would

have been obvious” (*Henny Penny Corp. v. Frymaster LLC*, 938 F.3d 1324, 1330–31 (Fed. Cir. 2019)), as well as to a changed thrust of a rejection, “even when the new ground involved the same prior art as earlier asserted grounds of invalidity.” (*In re NuVasive, Inc. (II)*, 841 F.3d 966, 972 (Fed. Cir. 2016)).

Thus, under *SAS* and its progeny, it was improper for the PTAB to identify *sua sponte* Fioravanti’s Figure 10 as contributing to the obviousness of the challenged claims, especially when accompanied by *no* explanation for it having done so. And, anticipating the response that Appellant had the opportunity to address Figure 10 in the context of the “associatively stored” limitation, that is not the point. As a legal matter, *SAS* did not turn on a party’s opportunity to address issues—rather, that decision discussed a statutory *prohibition* against fashioning grounds not set forth in a petition. As a practical matter, by the time the PTAB had determined to institute based upon, *inter alia*, newly cited Figure 10, Appellant was fighting an uphill battle to convince the PTAB it was wrong.

The Panel’s affirmance of the PTAB’s judgment, given the PTAB’s improper reliance on Fioravanti’s Figure 10, was contrary to the prohibition set forth in section 312(a)(3), as clarified by the decision in *SAS*. To ensure conformity with that decision and the subject statutory prohibition, Appellant respectfully requests that the Court exercise its discretion to review the Panel decision *en banc*, and reverse that decision.

Dated: April 7, 2021

Respectfully submitted,

/s/ George C. Summerfield

George C. Summerfield

Benjamin E. Weed

Katherine L. Allor

K&L GATES LLP

70 W. Madison St., Suite 3300

Chicago, Illinois 60602

(312) 372-1121

Michael I. Cohen

Baxter International Inc.

One Baxter Parkway, DF2-1E

Deerfield, Illinois 60015-4633

*Attorneys for Appellant Baxter Corporation
Englewood*

ADDENDUM

NOTE: This disposition is nonprecedential.

**United States Court of Appeals
for the Federal Circuit**

BAXTER CORPORATION ENGLEWOOD,
Appellant

v.

BECTON, DICKINSON AND COMPANY,
Appellee

2020-1806, 2020-1808

Appeals from the United States Patent and Trademark Office, Patent Trial and Appeal Board in Nos. IPR2019-00120, IPR2019-00121.

JUDGMENT

GEORGE C. SUMMERFIELD, JR., K & L Gates LLP, Chicago, IL, argued for appellant. Also represented by KATHERINE ALLOR, BENJAMIN EDWARD WEED; MICHAEL IRA COHEN, Baxter International Inc., Deerfield, IL.

THOMAS SAUNDERS, Wilmer Cutler Pickering Hale and Dorr LLP, Washington, DC, argued for appellee. Also represented by OMAR KHAN, New York, NY; CRISTINA SALCEDO, Los Angeles, CA.

THIS CAUSE having been heard and considered, it is

ORDERED and ADJUDGED:

PER CURIAM (PROST, *Chief Judge*, MAYER and WALLACH, *Circuit Judges*).

AFFIRMED. See Fed. Cir. R. 36.

ENTERED BY ORDER OF THE COURT

March 8, 2021
Date

/s/ Peter R. Marksteiner
Peter R. Marksteiner
Clerk of Court

**CERTIFICATE OF COMPLIANCE WITH TYPE-VOLUME
LIMITATIONS**

1. The foregoing Petition complies with the type-volume limitation of Federal Rule of Appellate Procedure 35(b)(2)(A) because it contains 1,445 words, excluding the parts of the Petition exempted by Federal Circuit Rule 32(b)(2).

2. This brief complies with the type-face requirements and type-style requirements of Federal Rules of Appellate Procedure 32(a)(5) and 32(a)(6) because it has been prepared in a proportionally spaced typeface using Microsoft Word 2010 in Times New Roman 14-point font.

Dated: April 7, 2021

Respectfully submitted,

/s/ George C. Summerfield

George C. Summerfield

*Attorney for Appellant Baxter
Corporation Englewood*

CERTIFICATE OF SERVICE

I hereby certify that on April 7, 2021, a true and correct copy of the foregoing **PETITION FOR REHEARING EN BANC BY APPELLANT BAXTER CORPORATION ENGLEWOOD** was filed with the Clerk of the United States Court of Appeals for the Federal Circuit via the CM/ECF system, which will send notice of such filing to all registered CM/ECF users.

/s/ George C. Summerfield

George C. Summerfield