

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE OFFICE OF THE UNDER SECRETARY AND
DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK
OFFICE

MED-EL ELEKTROMEDIZINISCHE GERÄTE GES.M.B.H.,
Petitioner,

v.

ADVANCED BIONICS AG,
Patent Owner.

IPR2020-01016
IPR2021-00044
Patent 8,155,746 B2¹

Before KATHERINE K. VIDAL, *Under Secretary of Commerce for
Intellectual Property and Director of the United States Patent and
Trademark Office.*

DECISION

Granting Rehearing, Vacating the Final Written Decision, and Remanding to
the PTAB Panel for Further Proceedings

¹ The Board issued a combined Final Written Decision addressing the issues raised in both proceedings.

I. BACKGROUND

On March 31, 2022, the Patent Trial and Appeal Board (“Board”) issued a combined Final Written Decision (Paper 42, “Decision” or “Dec.”)² in IPR2020-01016 and IPR2021-00044. The Decision determined that claims 1–24 of U.S. Patent No. 8,155,746 B2 (“the ’746 patent,” Ex. 1001) are unpatentable under 35 U.S.C. § 103(a) as obvious. Dec. 139.

In the Decision, the Board further addressed the reliance on Applicant Admitted Prior Art (“AAPA”) by MED-EL Elektromedizinische Geräte Ges.m.b.H. (“Petitioner”) in combination with Petersen³ to challenge claims 1–24 of the ’746 patent as obvious under 35 U.S.C. § 103(a).⁴ Dec. 9–10. In considering Petitioner’s challenge, the Board applied the 2020 AAPA Guidance⁵ setting forth “the USPTO’s interpretation of § 311(b)” with respect to “statements in the specification of the challenged patent,” often referred to as “applicant admitted prior art” or “AAPA.” *Id.* at 38–47.

Applying the 2020 AAPA Guidance, the Board determined that “Petitioner improperly relies on AAPA as the ‘basis’ of this ground, contrary to the interpretation of § 311(b) in the [2020] AAPA Guidance.” Dec. 44.

² Unless otherwise noted, citations are to papers and exhibits in IPR2020-01016.

³ WO 97/04619, published Feb. 6, 1997 (Ex. 1017).

⁴ The Board did not address the proposed ground based on AAPA, Zilberman, and Saaski because the Board determined that another ground based on Zilberman and Saaski alone, without AAPA, was dispositive as to the same claims. Dec. 82–83.

⁵ *Memorandum on the Treatment of Statements of the Applicant in the Challenged Patent in Inter Partes Reviews under § 311* (issued Aug. 18, 2020), available at <https://go.usa.gov/xAEJ> (“2020 AAPA Guidance”).

On June 1, 2022, in view of the U.S. Court of Appeals for the Federal Circuit’s decision in *Qualcomm Inc. v. Apple Inc.*, 24 F.4th 1367 (Fed. Cir. 2022), I initiated Director review *sua sponte* to “clarify the Office’s guidance on the treatment of statements of the applicant in the challenged patents in *inter partes* reviews under § 311.” Paper 43, 4–5; *see also Interim process for Director review* §§ 13, 22 (providing for *sua sponte* Director review and explaining that “the parties to the proceeding will be given notice” if Director review is initiated *sua sponte*).⁶

On June 9, 2022, I issued updated guidance that provided clarification on the treatment of AAPA and superseded the 2020 AAPA Guidance.⁷

Applying the 2022 AAPA Guidance, as detailed below, I determine that Petitioner’s reliance on AAPA is not improper. I remand these proceedings to the Board to issue a new final written decision consistent with my determination.

II. ANALYSIS

Petitioner contends that claims 1–24 are unpatentable as obvious over AAPA and Petersen, and claims 10–17 and 24 are unpatentable as obvious over Zilberman and Saaski, with or without AAPA. Pet. 4, 23–47. In general, Petitioner presents the grounds relying on AAPA as combining a cochlear implant system with typical cochlear implant features, as described in the AAPA, with the concept of a “permanently and integrally housed” battery that is recharged *in situ* through

⁶ Available at <https://go.usa.gov/xuHwP>.

⁷ *Updated Guidance on the Treatment of Statements of the Applicant in the Challenged Patent in Inter Partes Reviews under § 311* (issued June 9, 2022), available at <https://go.usa.gov/xSbGF> (“2022 AAPA Guidance”).

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either direct electrical contacts on the device's surface or inductive charging, as described in Petersen.

Id. at 44–45. Petitioner asserts that “[a]ll of the recited power management features in the claims of [the ’746 patent] are described in, and taught by, Zilberman, Petersen and/or Saaski,” and “[t]he claimed cochlear implant features unrelated to power management are admitted to be prior art in [the ’746 patent] itself.” *Id.* at 2.

The 2022 AAPA Guidance provides that

Board panels should determine whether the petition relies on admissions in the specification in combination with reliance on at least one prior art patent or printed publication. *Qualcomm*, 24 F.4th at 1377. If an IPR petition relies on admissions in combination with reliance on one or more prior art patents or printed publications, those admissions do not form “the basis” of the ground and must be considered by the Board in its patentability analysis. *Id.*

2022 AAPA Guidance 4. As discussed above, the Petition relies on AAPA in combination with either Petersen, Zilberman and/or Saaski. Accordingly, AAPA “do[es] not form ‘the basis’ of the ground and must be considered by the Board in its patentability analysis.” *Id.* I remand these proceedings to the Board for further analysis consistent with my determination.

IV. ORDER

Accordingly, based on the foregoing, it is:

ORDERED that the Board’s Final Written Decisions (IPR2020-01016, Paper 42; IPR2021-00044, Paper 40) are vacated; and

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FURTHER ORDERED that these proceedings are remanded to the Board, and the Board shall issue a new final written decision consistent with the above determination that the Petition did not improperly rely on AAPA.

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