

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE OFFICE OF THE UNDER SECRETARY OF COMMERCE
FOR INTELLECTUAL PROPERTY AND DIRECTOR OF THE
UNITED STATES PATENT AND TRADEMARK OFFICE

EMBODY, INC. and ZIMMER BIOMET HOLDINGS, INC.,
Petitioner,

v.

LIFENET HEALTH,
Patent Owner.

IPR2025-00248 (Patent 10,137,223 B2)
IPR2025-00249 (Patent 11,318,227 B2)

Before COKE MORGAN STEWART, *Acting Under Secretary of
Commerce for Intellectual Property and Acting Director of the United States
Patent and Trademark Office.*

DECISION
Denying Patent Owner's Request for Discretionary Denial

LifeNet Health (“Patent Owner”) filed a request for discretionary denial (Paper 8, “DD Req.”) in the above-captioned cases, and Embody, Inc. and Zimmer Biomet Holdings, Inc. (collectively, “Petitioner”) filed an opposition (Paper 10, “DD Opp.”).¹ With authorization, Patent Owner filed a Reply (Paper 11, “DD Reply”), and Petitioner filed a Sur-reply (Paper 12, “DD Sur-reply”).

After considering the parties’ arguments and the record, and in view of all relevant considerations, discretionary denial of institution is not appropriate in these proceedings. This determination is based on the totality of the evidence and arguments the parties have presented.

In particular, Petitioner provides persuasive reasoning, supported by evidence, that discretionary denial under 35 U.S.C. § 325(d) is not appropriate. Petitioner explains sufficiently that during prosecution of the challenged patent, “Patent Owner argued that the prior art failed to disclose a scaffold containing electrospun fibers comprising collagen, where the fibers show peaks 180° apart by what is referred to as a fast Fourier... transform analysis, and Patent Owner amended the claims to require that the electrospun fibers contain collagen.” DD Opp. 1. Petitioner sufficiently demonstrates, for purposes of this Decision, that two separate references, which were not previously considered by the Office, disclose electrospun fibers comprising collagen containing the requisite peaks recited in the claims. *Id.* As such, Petitioner’s argument that the art cited in the Petition is not cumulative of art previously considered is persuasive. *Id.* at 1–2. Furthermore, one of the challenged patents has not been in force for a

¹ Citations are to papers in IPR2025-00248. The parties filed similar papers in IPR2025-00249.

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significant period of time (issued in 2022) and the other patent is a parent of the first. Accordingly, Patent Owner has not developed strong settled expectations that favor discretionary denial as to the first patent, and it is an efficient use of Board resources to address the related patent.

Although certain arguments are highlighted above, the determination not to exercise discretion to deny institution is based on a holistic assessment of all of the evidence and arguments presented. Accordingly, the Petitions are referred to the Board to handle the case in the normal course, including by issuing a decision on institution addressing the merits and other non-discretionary considerations, as appropriate.

In consideration of the foregoing, it is:

ORDERED that Patent Owner's request for discretionary denial is *denied*;

FURTHER ORDERED that the Petitions are referred to the Board;
and

FURTHER ORDERED that neither party shall file a request for rehearing or Director Review of this decision until the Board issues a decision on institution.

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