

Patent Owner's Preliminary Reply
U.S. Patent No. 12,377,204

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

TERUMO BCT, INC.,

Petitioner

v.

HAEMONETICS CORP.,

Patent Owner

Case No. PGR2026-00006

U.S. Patent No. 12,377,204

PATENT OWNER'S PRELIMINARY REPLY

List of Exhibits

| Exhibit No. | Description of Document |
|--------------------|---|
| 2017 | Joint Disputed Claim Terms Chart, <i>Haemonetics Corp. v. Terumo BCT, Inc.</i> (D. Colo. Feb. 3, 2026), D.I. 77 |

Petitioner's inconsistent claim construction positions warrant denial of institution. The Petition fails to comply with 37 C.F.R. § 42.204(b)(3), which requires a petitioner to state “[h]ow the challenged claim is to be construed” and, where a limitation is governed by 35 U.S.C. § 112(f), to identify the corresponding structure in the specification. This defect goes to Petition sufficiency at the threshold, not to competing merits arguments.

Petitioner argued that the claims “should be construed in accordance with the ordinary and customary meaning” and relied on that plain-and-ordinary-meaning construction to map the prior art to the “controller [is/further] configured to” limitations. Pet. at 19, 25-31, 37-39, 44-47, 49-51, 54-56. Although Petitioner raised other § 112 issues in its PGR Petition, including indefiniteness, it did not contend that the “controller” limitations are means-plus-function terms or indefinite under § 112(f). The Petition is silent as to any such construction.

In the district court litigation, however, Petitioner took the opposite position. Petitioner argued that the same “controller [is/further] configured to” language is governed by § 112(f) and is indefinite for lack of corresponding structure. EX2017 at 21–42. Petitioner proposed this construction and indefiniteness on that basis.

Petitioner cannot maintain, without explanation, that the same claim language is indefinite in district court yet sufficiently definite and structurally understood to support detailed prior art mappings before the Board—particularly in

post-grant review, where indefiniteness challenges are expressly available. *See* 35 U.S.C. § 321(b). The Petition stands on the premise that a person of ordinary skill would understand the controller limitations under their plain meaning; Petitioner's district court position repudiates that premise.

The Board and Director have repeatedly held that such unexplained inconsistencies justify denial of institution. In *Revvo Technologies v. Cerebrum Sensor Technologies*, the Director made clear that when a petitioner takes alternative claim construction positions before the Board and a district court, it must, "at a minimum, explain why alternative positions are warranted." IPR2025-00632, Paper 20 at 3–4 (Nov. 3, 2025) (precedential); *see also id.*, Paper 36 at 3 (Jan. 26, 2026) ("you can't have it both ways and certainly not without a sufficient explanation."). In *Tesla v. Intellectual Ventures II*, the Board denied institution where a petitioner argued plain and ordinary meaning in its petition while asserting indefiniteness in district court, holding that "petitioner is required to explain" the differing positions. IPR2025-00340, Paper 18 at 2–4 (Nov. 5, 2025) (informative). The Director has since applied the same reasoning to vacate or deny institution in similar circumstances. *See Generac Power Sys., Inc. v. Champion Power Equip., Inc.*, IPR2025-00805, IPR2025-00951, Paper 40 at 4 (Feb. 3, 2026); *Revvo Technologies, Inc. v. Tire Stickers LLC*, IPR2025-00631, Paper 34 (Feb. 3, 2026).

This case presents the same defect—and an additional one. Section 42.204(b)(3) requires a petitioner to address § 112(f) constructions in the petition itself. The Board has denied institution where a petitioner advocates plain and ordinary meaning before the Board but asserts a means-plus-function construction in district court without addressing § 112(f) in the petition. *See Revvo*, IPR2025-00632, Paper 36 at 2; *Cambridge Mobile Telematics, Inc. v. Sfara, Inc.*, IPR2024-00952, Paper 12 at 8 (informative); *10X Genomics, Inc. v. President & Fellows of Harvard College*, IPR2023-01299, Paper 15 at 13; *Orthopediatrics Corp. v. K2M, Inc.*, IPR2018-01546, Paper 10 at 10–12.

Petitioner's attempt to characterize this as an “outer bounds” dispute is misplaced. This is not about whether the Board must construe “controller” to resolve the prior art analysis, but about petition sufficiency. Having affirmatively invoked § 112(f) and asserted lack of corresponding structure in district court, Petitioner was required under § 42.204(b)(3) to address that construction in the Petition itself. *Revvo* and *Tesla* do not hinge on whether a district court position is broader or narrower, or whether a term is “in controversy” for prior art mapping purposes, but on whether materially different positions are advanced without explanation. Here, none was provided. Petitioner affirmatively invoked § 112(f) in district court yet omitted any § 112(f) analysis in the Petition, despite the rule's express requirement. Institution should be denied.

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Respectfully submitted,

/Erik B. Milch/

Erik B. Milch (Reg. No. 42,887)
Proskauer Rose LLP
1001 Pennsylvania Ave., NW
Suite 600
Washington, DC 20004
Tel: (202) 416-6800
emilch@proskauer.com

Dated: February 23, 2026

Attorney for Patent Owner

CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.6(e), I hereby certify that on February 23, 2026, I caused a complete copy of Patent Owner's Preliminary Reply regarding U.S. Patent No. 12,377,204 and all exhibits, to be served on the Petitioner as follows:

Via and Electronic Mail to Petitioner's attorneys of record:

John M. Caracappa, Reg. No. 43,532
jcaracappa@steptoe.com

Katherine D. Cappaert, Reg. No. 71,639
kcappaert@steptoe.com

Matthew Y. Sim, Reg. No. 77,422
msim@steptoe.com

Scott Chappell, Reg. No. 76,333
schappell@steptoe.com

STEPTOE LLP
1330 Connecticut Avenue N.W.
Washington, D.C. 20036
Tel: (202) 429-3000
Fax: (202) 429-3902

/Erik B. Milch/
Erik B. Milch (Reg. No. 42,887)