

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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EDWARDS LIFESCIENCES CORPORATION,  
Petitioner,

v.

BOSTON SCIENTIFIC SCIMED, INC.,  
Patent Owner.

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Case IPR2017-00072  
Patent 6,915,560 B2

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Before NEIL T. POWELL, JAMES A. TARTAL, and  
STACY B. MARGOLIES, *Administrative Patent Judges*.

TARTAL, *Administrative Patent Judge*.

DECISION

Denying Petitioner's Request for Rehearing  
*37 C.F.R. § 42.71(d)*

## I. INTRODUCTION

Petitioner, Edwards Lifesciences Corporation, filed a Petition requesting an *inter partes* review of claims 1, 2, 6, 8–11, 14, 15, 17–19, 23, 25–28, 31, 33–35, 37, 39, and 40 of U.S. Patent No. 6,916,560 B2 (Ex. 1001, “the ’560 patent”). Paper 1 (“Pet.”). Patent Owner, Boston Scientific Scimed, Inc., filed a Corrected Preliminary Response. Paper 7 (“Prelim. Resp.”). In our Decision dated April 21, 2017 (Paper 8, “Decision” or “Dec.”), we determined that the information presented in the Petition raised the same or substantially the same prior art or arguments as those previously presented to the Office, and exercised our discretion not to institute *inter partes* review of the ’560 patent on the grounds raised by Petitioner in this case.

Petitioner requests rehearing (Paper 9, “Req. Reh’g.”) of our Decision, and, specifically, reconsideration of our determination not to institute *inter partes* review based on Petitioner’s contention that challenged claims of the ’560 patent would have been obvious over alleged Applicant Admitted Prior Art (“AAPA”), in combination with either (1) Sabbaghian,<sup>1</sup> (2) Sabbaghian and Morales,<sup>2</sup> (3) Baker,<sup>3</sup> or (3) Baker and Morales. Req. Reh’g. 1, 6–13. For the reasons that follow, Petitioner’s request for rehearing is denied.

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<sup>1</sup> U.S. Patent No. 5,918,511, issued July 6, 1999 (Ex. 1006, “Sabbaghian”).

<sup>2</sup> U.S. Patent No. 5,893,852, issued April 13, 1999 (Ex. 1007, “Morales”).

<sup>3</sup> U.S. Patent No. 4,308,744, issued January 5, 1982 (Ex. 1008, “Baker”).

## II. ANALYSIS

The applicable standard for a request for rehearing is set forth in 37 C.F.R. § 42.71(d), which provides in relevant part:

A party dissatisfied with a decision may file a request for rehearing, without prior authorization from the Board. The burden of showing a decision should be modified lies with the party challenging the decision. The request must specifically identify all matters the party believes the Board misapprehended or overlooked, and the place where each matter was previously addressed in a motion, opposition, or a reply.

When reconsidering a decision on institution, we review the decision for an abuse of discretion. *See* 37 C.F.R. § 42.71(c). An abuse of discretion may be determined if a decision is based on an erroneous interpretation of law, if a factual finding is not supported by substantial evidence, or if the decision represents an unreasonable judgment in weighing relevant factors. *See Star Fruits S.N.C. v. United States*, 393 F.3d 1277, 1281 (Fed. Cir. 2005); *Arnold P'ship v. Dudas*, 362 F.3d 1338, 1340 (Fed. Cir. 2004); *In re Gartside*, 203 F.3d 1305, 1315–16 (Fed. Cir. 2000). The party requesting rehearing has the burden of showing the decision should be modified, which includes specifically identifying all matters the party believes we misapprehended or overlooked. *See* 37 C.F.R. § 42.71(d).

Petitioner contends that because “the Petition prior art combinations disclose claim limitations not disclosed by the Office prior art combinations,” our Decision to exercise discretion to deny the Petition was based on findings that “cannot be supported by substantial evidence and amount to an abuse of discretion.” Req. Reh’g. 1.

As explained in the Decision, “[a]ccording to Petitioner, ‘[t]he only distinction between the AAPA and the challenged claims is the shape and

arrangement of the blades that form the claimed ‘polygonal aperture.’”  
Dec. 7 (quoting Pet. 37 (citing Ex. 1011 ¶ 94)). Petitioner does not dispute that the alleged Applicant Admitted Prior Art and Morales were previously presented to the Office. *See* Dec. 9–10. With regard to Sabbaghian and Baker, the Decision further states:

Sabbaghian, disclosing an adjustable socket wrench, and Baker, disclosing a tube pointer, were not considered during prosecution. *See* Pet. 37, 41. Petitioner relies on Sabbaghian and Baker as disclosing dies arranged to form a variable-sized polygonal aperture, the only claimed feature Petitioner argues is missing from the alleged Applicant Admitted Prior Art. Pet. 3–4, 37–43. According to Petitioner, “the polygonal-shaped die configuration is nothing new,” and “[f]or more than a century, skilled artisans have used such a configuration.” *Id.* at 4. Petitioner concedes that “[t]he die configuration disclosed in Sabbaghian and Baker is not unique. Such a die configuration is common in the prior art.” *Id.* at 93 (under the heading “The Claimed Die Configuration Was Ubiquitous In The Prior Art”). Although Sabbaghian and Baker were not considered, Petitioner notes that during examination Whitesell was applied as disclosing a crimper with a “substantially regular polygonal shape.” Pet. 22. Similarly, Tuberman was considered during prosecution as teaching a device with “an aperture of a substantially regular polygonal shape.” *See* Prelim. Resp. 19 (quoting Ex. 1002, 45).

For the foregoing reasons we determine that the alleged Applicant Admitted Prior Art and Morales were previously presented to the Office. Additionally, the Petition further presents information from Sabbaghian and Baker, generally described by Petitioner as “ubiquitous” in the prior art, which we find to be the same or substantially the same as information considered during prosecution in the context of other references, including Whitesell and Tuberman.

*Id.* at 10–11. According to Petitioner, “[t]he only distinction between the AAPA and the challenged claims is the shape and arrangement of the blades that form the claimed ‘polygonal aperture.’” Pet. 37 (citing Ex. 1011 ¶ 94). Petitioner argues that Whitesell can be distinguished from the asserted prior art in this proceeding because it does not teach “the straight-sided die/polygonal aperture limitation.” Req. Reh’g. 7. However, Petitioner does not dispute that Tuberman discloses this feature. *See id.* at 7–8. Thus, Petitioner has not shown a substantial difference between the art previously considered by the Office and the alleged prior art asserted in the Petition. Instead, Petitioner argues that the Examiner did not apply Tuberman in combination with the alleged Applicant Admitted Prior Art. According to Petitioner, “the Examiner applied Tuberman individually as an anticipatory reference,” and “[i]t is irrelevant to speculate why the Examiner did not make a combination that is so readily apparent.” Req. Reh’g. 8, 11.

As we explained in the Decision:

In determining whether to institute *inter partes* review, we may “deny some or all grounds for unpatentability for some or all of the challenged claims.” 37 C.F.R. § 42.108(b); *see* 35 U.S.C. § 314(a). Our discretionary determination of whether to institute review is guided by 35 U.S.C. § 325(d), which states, in relevant part, that “[i]n determining whether to institute or order a proceeding under this chapter, chapter 30, or chapter 31, the Director may take into account whether, and reject the petition or request because, the same or *substantially the same* prior art or arguments previously were presented to the Office.” 35 U.S.C. § 325(d) (emphasis added).

Dec. 9. Our discretion under § 325(d) involves a balance between several competing interests. *See Neil Ziegman, N.P.Z., Inc. v. Stephens*, Case

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