

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

EDWARDS LIFESCIENCES CORP.,

Petitioner,

v.

BOSTON SCIENTIFIC SCIMED, INC.,

Patent Owner.

Case IPR2017-00444

Patent 6,915,560

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

PATENT OWNER'S MOTION TO EXCLUDE EVIDENCE

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I. Introduction

Pursuant to 37 C.F.R. §§ 42.23(b) and 42.64, Boston Scientific Scimed, Inc. (“Patent Owner”) respectfully requests that the Board exclude Petitioner Edwards Lifesciences Corp.’s (“Petitioner’s”) Exhibit 1127 (“Sheehan’s Supplemental Declaration”)¹ and Petitioner’s Reply (Paper Nos. 17 (sealed) and 18 (public)) for including new claim construction issues and arguments raised for the first time in the Petitioner’s reply.

Patent Owner timely objected to Petitioner’s Reply and Sheehan’s Supplemental Declaration in Patent Owner’s Second Set of Objections. (Paper No. 20 at 1 (“new claim construction arguments and analyses relating thereto (*e.g.*, ¶¶ 32-36 (“operatively engaged”), ¶ 45 (“distinct connection locations”)....”).) Petitioner elected not to provide supplemental evidence in response to Patent Owner’s objections.

II. Argument

In an IPR proceeding, a petitioner is required to identify “with particularity” the “evidence that supports the grounds for the challenge to each claim” in its initial petition. 35 U.S.C. § 312(a)(3). Specifically, the petitioner must “provide a claim construction for the challenged claims” in its initial petition. Office Patent Trial

¹ Petitioner filed a corrected Exhibit 1127 on January 19, 2018 (which adds an under-the-penalty-of-perjury statement at the end).

Practice Guide, 77 Fed. Reg. 48,756, 48,763 (Aug. 14, 2012). The petitioner's reply is limited to arguments raised in the patent owner's response. 37 C.F.R. § 42.23(b). Pursuant to these rules, the Board has excluded new issues raised for the first time in a petitioner's reply brief and expert declaration. *See, e.g., Intelligent Bio-Sys., Inc. v. Illumina Cambridge, Ltd.*, 821 F.3d 1359, 1369 (Fed. Cir. 2016) (affirming the Board's exclusion of new arguments raised for the first time in the Petitioner's reply brief and expert declaration); *Scotts Co. v. Encap, LLC.*, IPR2013-00110, Paper 79 at 5-6 (PTAB June 24, 2014) (granting motion to exclude materials that were outside of the proper scope of a reply, including claim construction related analyses). Further, "[o]nce the Board identifies new issues presented for the first time in reply, neither this court nor the Board must parse the reply brief to determine which, if any, parts of that brief are responsive and which are improper." *Intelligent Bio-Sys.*, 821 F.3d at 1369; *see also* Office Patent Trial Practice Guide, 77 Fed. Reg. at 48,767 (The Board "will not attempt to sort proper from improper portions of the reply."); *Scotts Co. v. Encap, LLC.*, IPR2013-00110, Paper 79 at 6, fn. 3 ("The fact that two declarations may contain some material appropriate for a response does not require our consideration of them, as the Board will not attempt to sort the proper from the improper portions [citing Office Patent Trial Practice Guide, 77 Fed. Reg. at 48,767].").

Here, Sheehan’s Supplemental Declaration includes two new claim construction issues raised for the first time in Petitioner’s Reply, namely the proposed constructions of the terms (1) “operatively engaged” (in claims 1-2, 6, 8-9, 18-19, 23, 25-26, 37, and 40 of U.S. Patent No. 6,915,560 (“the ’560 patent”)) and (2) “distinct connection locations” (in claims 1, 2, 6, and 8-9 of the ’560 patent). (*See* Ex. 1127 at ¶ 32 (“Operatively engaged simply means engaged in a way that furthers the operation, or that the engagement produces the intended effect.”); at ¶ 45 (“Claim 1 and its dependents require ‘. . . at distinct connection locations.’ Thus, the recited ‘distinct connection locations’ are on the dies, not on the stationary end-walls.”)² Based on these new (and overly broad) claim

² During his deposition, Mr. Sheehan readily admitted that he construed the term “operatively engaged” under the broadest reasonable interpretation standard in his supplemental declaration. (Ex. 2052 at 72:9-24 (using broadest reasonable interpretation to construe “operatively engaged”); *see also id.* at 72:25-75:7 (scope of “operatively engaged” under Mr. Sheehan’s new construction). He also readily admitted that the only issue he disputes, with respect to whether the claim element “distinct connection locations” is found in prior art, is with respect to the construction of “distinct connection locations”. (*Id.* at 75:11-77:11 (“I’m reading it [“distinct connection locations”] correctly;” agreeing that it is a “purely claim

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construction positions, Mr. Sheehan and Petitioner make new arguments on how the elements of the instituted claims of the ‘560 patent are found in the prior art reference. (Ex. 1127 at ¶¶ 33-36 (arguments and analyses based on the new construction of “operatively engaged”); Petitioner’s Reply at 9-12 (same); at 14-15 (arguments and analyses based on the new construction of “distinct connection locations”).)

Mr. Sheehan and Petitioner should have raised the claim construction issues and arguments relating to the “operatively engaged” and “distinct connection locations” terms in its initial Petition. Indeed, Mr. Sheehan and Petitioner raised three different claim construction issues (“a stent crimper comprising,” “dies and blades,” and “stationary end-walls”/“stationary plates”) in the initial Petition. (Ex. 1105 at ¶¶ 68-79; Petition, Paper 1 at 31-34.) Nowhere in its initial Petition did Mr. Sheehan or Petitioner propose claim constructions for the terms “operatively engaged” and “distinct connection locations.” (*Id.*; *see also* Ex. 1105 at ¶ 122, 68-69; Paper 1 at 55-56.) By waiting to raise the new claim construction issues and arguments relating to the terms “operatively engaged” and “distinct connection

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construction issue); *see also id.* 77:12-81:3 (scope of “distinct connection locations” under Mr. Sheehan’s new construction).)

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