

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 REPLY IN SUPPORT OF ITS MOTION TO
EXCLUDE EVIDENCE**

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Petitioner raises three arguments in opposition to Patent Owner's Motion to Exclude, none of which justifies the untimeliness and prejudicial effect of the new issues raised in Mr. Sheehan's Supplemental Declaration and Petitioner's Reply.

A. Petitioner's Procedural Challenge Is Unavailing

While citing certain non-precedential decisions supporting its procedural challenge to Patent Owner's Motion To Exclude (*see* Opp'n (Paper 31) at 1-2), Petitioner simply ignores the authorities relied on by Patent Owner supporting its Motion To Exclude. (*See* Mot. (Paper 25) at 3 citing *Intelligent Bio-Sys., Inc. v. Illumina Cambridge, Ltd.*, 821 F.3d 1359, 1369 (Fed. Cir. 2016) ("*IBS*") and *Scotts Co. v. Encap, LLC.*, IPR2013-00110, Paper 79 (PTAB June 24, 2014) ("*Scotts*").) Specifically, in the IPR proceeding underlying the Federal Circuit decision in *IBS*, the patent owner filed a motion to exclude a reply expert declaration and a reply brief that included new issues raised for the first time. IPR2013-00517, Paper 62 at 6 ("...Dr. Branchaud raises a new invalidity theory..."); *id.* at 8 ("Dr. Branchaud's new invalidity theory"); Paper 74 at 4 (new argument improper under "37 C.F.R. § 42.23(b)"). In the final written decision of the *IBS* IPR, the Board held that the petitioner raised new issues in the reply expert declaration and reply brief. Paper 87 at 14-16. In light of that ruling, the Board deemed the patent owner's motion to exclude moot. *Id.* at 23. The Federal Circuit affirmed the Board's decision and held that "the Board did not abuse its discretion in excluding

those documents.” *IBS*, 821 F.3d at 1370. At no point did the Board or the Federal Circuit suggest any impropriety of the patent owner’s motion to exclude based on violations of 37 C.F.R. § 42.23(b).

Similarly, in the final written decision of *Scotts* IPR, the Board specifically granted a motion to exclude an expert declaration for violating 37 C.F.R. § 42.23(b). *Scotts*, Paper 79 at 6-7 (citing 37 C.F.R. § 42.23(b)). While a different panel may set forth a different practice guidance, there are ample authorities—including from the Federal Circuit—that support the filing of Patent Owner’s Motion to Exclude based on Petitioner’s violation of 37 C.F.R. § 42.23(b).

B. Patent Owner Did Not Propose Any “New Claim Constructions”

Petitioner next alleges that “new claim constructions” in Patent Owner’s Response justify the new claim constructions in Petitioner’s Reply. (Opp’n at 2.) Yet, Petitioner fails to point to any actual “new claim constructions” raised by Patent Owner in its Response. (*Id.* at 2-7.) The portions of Dr. Solar’s Declaration (Ex. 2016 at ¶¶ 47-48, 51) and Patent Owner’s Response (Paper 15 at 27) that Petitioner cites merely demonstrate—without invoking any claim construction issues—that there is no evidence showing that the movable pieces of Yasumi are operatively engaged to a side plate at all. In other words, contrary to Petitioner’s suggestion, neither Patent Owner nor Dr. Solar proposed that “operatively engaged” should be construed to mean “fixed,” “affixed,” or “not moving relative

to.” Nor did Patent Owner or Dr. Solar propose any construction for “distinct connection locations.” Not surprisingly, Petitioner never filed any objections to or motion to exclude any alleged new claim constructions raised by Patent Owner or Dr. Solar. Indeed, Petitioner’s Reply itself never indicated or suggested that Patent Owner or Dr. Solar raised any new claim constructions for “operatively engaged” or “distinct connection locations.” (Paper 17 at 9-15.)

Further, Petitioner claims that Mr. Sheehan, in his Supplemental Declaration, merely explained the same “ordinary and customary meaning” that he applied in his original declaration. (Opp’n at 5.) However, Mr. Sheehan’s statement in his original declaration that he “analyzed each claim term in accordance with its plain and ordinary meaning under the required broadest reasonable interpretation”—under the “Legal Standards” section—merely acknowledged his understanding of the correct legal standards. (See Opp’n at 5-6 (citing Ex. 1105 at ¶ 20).) Mr. Sheehan set forth a separate “Claim Construction” section in his original declaration, stating that he had “reviewed the claims and specification of the ’560 patent in order to determine the broadest reasonable construction of the claims in view of the patent’s specification.” (Ex. 1105 at ¶ 68.) He then proposed constructions for “a stent crimper comprising,” “dies”/“blades,” and “stationary end-walls”/“stationary plates” terms (the “Three Claim Terms”) under the broadest reasonable interpretation and opined, for more

than three pages, on the reasons why intrinsic evidence allegedly supported his proposals. (Ex. 1105 at ¶¶ 69-79.) Nowhere in this extensive discussion of claim construction issues did Mr. Sheehan propose or discuss any constructions for “operatively engaged” or “distinct connection locations.” In his Supplemental Declaration, however, he proposed—for the first time—constructions for “operatively engaged” and “distinct connection locations” and opined—for the first time—his invalidity theory based on the newly proposed constructions of “operatively engaged” and “distinct connection locations.” (See Mot. at 4-5 (citing Ex. 1127 at ¶¶ 32-26, 45).)

Had Mr. Sheehan proposed the constructions for “operatively engaged” and “distinct connection locations” in his original declaration, Patent Owner could have responded to them in its Preliminary Response (as it did for the Three Claim Terms); the Board could have ruled on them in the Institution Decision (as it did for the Three Claim Terms); and Patent Owner could have challenged or applied the Board’s claim construction rulings in its Response (as it did for the Three Claim Terms). (See Paper 7 at 27-31; Paper 9 at 9-11; Paper 15 at 17-24.)

C. Petitioner’s New Arguments Are The Newly Proposed Claim Constructions And The New Invalidity Theory Based Thereon

Petitioner’s argument that it did not raise any new arguments in its Reply and its attempt to distinguish *IBS* and *Scotts* on that basis lack merit. Petitioner’s new arguments are the newly proposed claim constructions of “operatively engaged” and “distinct connection locations” and the new invalidity theory based

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