

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

EDWARDS LIFESCIENCES CORPORATION,
Petitioner,

v.

BOSTON SCIENTIFIC SCIMED, INC.,
Patent Owner.

Case IPR2017-00444
Patent 6,915,560 B2

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

TARTAL, *Administrative Patent Judge*.

ORDER

Conduct of Proceeding
37 C.F.R. § 42.5

Edwards Lifesciences Corporation (“Petitioner”) filed a Petition (Paper 1, “Pet.”) requesting institution of *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. 6,915,560 B2 (Ex. 1101, “the ’560 patent”). On June 29, 2017, we instituted an *inter partes* review of all claims challenged in the Petition. Paper 9 (“Institution Decision” or “Dec.”), 31. We determined that Petitioner demonstrated a reasonable likelihood that it would establish that at least one of the challenged claims of the ’560 patent is unpatentable. *Id.* at 2.

Petitioner characterized its arguments as two grounds in the Petition: (1) claims 1, 2, 6, 8–10, 14, 15, 18, 23, 25, 27, 28, 31, 33, 37, and 40 as obvious under 35 U.S.C. § 103 over Yasumi in view of the AAPA; and claims 11, 17, 19, 26, 34, 35, and 39 as obvious under 35 U.S.C. § 103 over Yasumi in view of the AAPA and further in view of Morales. Pet. 30. In our Institution Decision we determined that Petitioner’s arguments encompassed a wider range of grounds and instituted review of: (1) claims 1, 2, 6, 8–11, 14, 15, 17–19, 23, 25–28, 31, 33–35, 37, 39, and 40 as obvious under 35 U.S.C. § 103(a) over Yasumi, as taught in the embodiment of Figure 8; and (2) claims 11, 17, 19, 26, 34, 35, and 39 as obvious under 35 U.S.C. § 103(a) over Yasumi, as taught in the embodiment of Figure 8, and Morales. Dec. 7–8, 25.

Boston Scientific Scimed, Inc. filed its Patent Owner Response on September 22, 2017. Paper 15. All other briefing was completed, and the oral hearing in the case was held on March 15, 2018. *See* Paper 37.

On April 24, 2018, the Supreme Court held in *SAS Inst., Inc. v. Iancu* that a decision to institute under 35 U.S.C. § 314 may not institute on less

IPR2017-00444
Patent 6,915,560 B2

than all claims challenged in the petition. 2018 WL 1914661, at *10 (U.S. Apr. 24, 2018). As noted above, we instituted review on all challenged claims. Dec. at 31. The parties are to meet and confer to discuss their positions with respect to the impact, if any, of SAS on this proceeding. The parties should discuss whether they seek to include the institution of additional grounds from the Petition into this proceeding and shall endeavor to reach agreement and, if additional briefing is requested, develop a joint proposal with the aim of concluding this proceeding within the twelve-month timeframe established by statute.

After conferring, the parties must, within seven (7) days of the date of this Order, submit a proposal (or, if the parties do not agree on a joint proposal, the parties must submit their respective proposals) in an email to the Board, in which the parties also request a conference call to discuss any additional briefing and modification of the schedule. The parties' email must include proposed times for such a call when both parties are available.

In consideration of the foregoing, it is hereby:

ORDERED that Petitioner and Patent Owner shall confer to determine any desired additional briefing and modification of the schedule and shall provide their proposals and request a conference call with the Board within seven (7) days of the date of this Order.

IPR2017-00444
Patent 6,915,560 B2

PETITIONER:

Craig Summers
Brenton Babcock
Christy Lea
Cheryl Burgess
KNOBBE, MARTENS, OLSON & BEAR, LLP
2css@knobbe.com
2brb@knobbe.com
2cgl@knobbe.com
2ctb@knobbe.com

PATENT OWNER:

Wallace Wu
Jennifer Sklenar
Nicholas Nyemah
ARNOLD & PORTER KAYE SCHOLER LLP
wallace.wu@apks.com
jennifer.sklenar@apks.com
nicholas.nyemah@aporter.com