

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*.

DECISION

Denying Authorization to File a Reply to the
Patent Owner Preliminary Response
37 C.F.R. §§ 42.23, 42.108

I. INTRODUCTION

Boston Scientific Scimed, Inc. (“Patent Owner”) filed a Preliminary Response (Paper 7) on April 4, 2017. On May 5, 2017, Edwards Lifesciences Corporation (“Petitioner”) emailed the Board to request a conference call to seek authorization to file a Reply to the Patent Owner Preliminary Response to address Patent Owner’s statement that the prior art and arguments in the Petition are the same, or substantially the same, as those previously raised during prosecution. On May 19, 2017, a conference call was held between counsel for the parties and the Board. For the reasons that follow, Petitioner’s request for authorization is denied for lack of good cause.

II. DISCUSSION

Petitioner may seek authorization to file a reply to the preliminary response, but “must make a showing of good cause.” *See* 37 C.F.R. § 42.108(c) (revised April 1, 2016). In considering whether good cause has been shown in this case, our discretionary determination of whether to institute *inter partes* review is explicitly guided by 35 U.S.C. § 325(d), which provides, in relevant part, that consideration may be given to “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).

During the teleconference Petitioner contended that good cause in this case was shown because the requested reply would address factual inaccuracies in the Patent Owner Preliminary Response that Petitioner could not have anticipated concerning the prosecution history, and, relatedly, whether the prior art or arguments presented in the Petition (Paper 1, “Pet.”)

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are the same, or substantially the same, as those previously raised during prosecution. Petitioner also indicated that the timing of its request, coming a month after the filing of the Patent Owner Preliminary Response, was prompted by a decision of the Board denying a petition filed by Petitioner against the same patent in an earlier proceeding.

In consideration of the arguments advanced during the teleconference by both parties, we determine good cause for authorization to file the requested reply has not been shown. First, whether there are factual inaccuracies in Patent Owner's Preliminary Response concerning the prosecution history is an issue the Board is typically capable of evaluating without further briefing from Petitioner. Second, Petitioner was on notice prior to filing its Petition that, by statute, consideration may be given to whether the prior art or arguments presented in the Petition are the same, or substantially the same, as those previously raised during prosecution. Accordingly, Petitioner had the opportunity to address the issue in the Petition, and, given the limits on the length of a Petition, may not neglect to address an issue with the expectation that additional briefing will be permitted in reply. Further, in this case Petitioner does not appear to have neglected to address the prosecution history, which it discussed at length in the Petition. Pet. 23–30. Thus, there is no indication that the Board lacks sufficient information to scrutinize Patent Owner's contentions regarding the prosecution history. Finally, the timing of Petitioner's request does not support a showing of good cause. Petitioner waited a month after Patent Owner's Preliminary Response was filed to request authorization to file a reply, and we are not persuaded that the timing of issuance of a decision in a related proceeding is sufficient reason for such a delay.

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III. ORDER

In consideration of the foregoing, it is hereby:
ORDERED that Petitioner's request for authorization to file a reply to
Patent Owner's Preliminary Response is DENIED.

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