

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 IPR2017-01301

Patent 6,915,560

---

**PATENT OWNER'S PRELIMINARY RESPONSE**

Mail Stop PATENT BOARD  
Patent Trial and Appeal Board  
U.S. Patent & Trademark Office  
P.O. Box 1450  
Alexandria, VA 22313-1450

**TABLE OF CONTENTS**

	<u>Page</u>
I. STATEMENT OF RELIEF REQUESTED .....	1
II. INTRODUCTION .....	1
III. RELATED PROCEEDINGS .....	2
IV. THE PETITION SHOULD BE DENIED PURSUANT TO THE ESTOPPEL PROVISION OF 35 U.S.C. § 351(e)(1) .....	5
V. THE PETITION SHOULD BE DENIED PURSUANT TO THE BOARD'S DISCRETION UNDER 35 U.S.C. § 325(d) .....	6
VI. ADDITIONAL FACTORS COMPEL DENIAL OF THE PETITION .....	11
VII. CONCLUSION.....	18

## TABLE OF AUTHORITIES

	<u>Page(s)</u>
<b>CASES</b>	
<i>Alarm.com Inc. v. Vivint, Inc.</i> , IPR2016-01091, Paper 11 at 13 (P.T.A.B. Nov. 23, 2016).....	18
<i>Blue Coat Sys. LLC v. Finjan, Inc.</i> , IPR2016-01443, Paper 13 at 8–10 (P.T.A.B. Jan. 23, 2017) .....	13, 14, 17
<i>Butamax Advanced Biofuels LLC v. Gevo, Inc.</i> , IPR2014-00581, Paper 8 at 12–13 (P.T.A.B. Oct. 14, 2014).....	17
<i>Conopco, Inc. v. Proctor &amp; Gamble Co.</i> , IPR2014-00506, Paper 17 at 6 (P.T.A.B. July 7, 2014).....	12, 15
<i>Conopco, Inc. v. Proctor &amp; Gamble Co.</i> , IPR2014-00506, Paper 25 at 4 (P.T.A.B. Dec. 10, 2014) .....	12
<i>Conopco, Inc. v. Proctor &amp; Gamble Co.</i> , IPR2014-00628, Paper 21 at 11 (P.T.A.B. Oct. 20, 2014).....	12, 15, 16
<i>Conopco, Inc. v. Proctor &amp; Gamble Co.</i> , IPR2014-00628, Paper 21 at 12 (P.T.A.B. Oct. 20, 2014).....	18
<i>Duncan Parking Techs., Inc., v. IPS Grp. Inc.</i> , IPR2016-01144, Paper 9 at 10–11 (P.T.A.B. Nov. 21, 2016).....	15
<i>Edwards Lifesciences Corp. v. Boston Scientific Scimed, Inc.</i> , IPR2017-00072, Paper 1 (P.T.A.B. Oct. 14, 2016).....	2
<i>Edwards Lifesciences Corp. v. Boston Scientific Scimed, Inc.</i> , IPR2017-00072, Paper 7 at 7–25 (P.T.A.B. Jan. 25, 2017) .....	3
<i>Edwards Lifesciences Corp. v. Boston Scientific Scimed, Inc.</i> , IPR2017-00072, Paper 8 at 11 (P.T.A.B. Apr. 21, 2017) .....	5
<i>Edwards Lifesciences Corp. v. Boston Scientific Scimed, Inc.</i> , IPR2017-00444, Paper 1(P.T.A.B. Dec. 7, 2016) .....	3

<i>Edwards Lifesciences Corp. v. Boston Scientific Scimed, Inc.</i> , IPR2017-00444, Paper 7 at 8–12, 27–29 (P.T.A.B. Apr. 4, 2017).....	4
<i>Edwards Lifesciences Corp. v. Boston Scientific Scimed, Inc.</i> , IPR2017-00444, Paper 9 at 7 (P.T.A.B. June 29, 2017) .....	5, 8
<i>LG Elecs. Inc. v. Core Wireless Licensing S.A.R.L.</i> , IPR2016-00986, Paper 12 at 6–7 (P.T.A.B. Aug. 22, 2016).....	13
<i>Medtronic, Inc. v. Nuvasive, Inc.</i> , IPR2014-00487, Paper 8 at 5–7 (P.T.A.B. Sept. 11, 2014) .....	11
<i>NVIDIA Corp. v. Samsung Elec. Co.</i> , IPR2016-00134, Paper 9 at 6–7 (P.T.A.B. May 4, 2016) .....	13
<i>Toyota Motor Corp. v. Cellport Sys., Inc.</i> , IPR2015-01423, Paper 7 at 8 (P.T.A.B. Oct. 28, 2015).....	12, 15, 17, 18
<i>Unified Patents, Inc. v. PersonalWeb Techs., LLC</i> , IPR2014-00702, Paper 13 at 7–9 (P.T.A.B. July 24, 2014).....	14
<i>ZTE Corp. v. ContentGuard Holdings, Inc.</i> , IPR2013-00454, Paper 12 at 5–6 (P.T.A.B. Sept. 25, 2013) .....	17

## **STATUTES, RULES AND REGULATIONS**

35 U.S.C. § 314(a) .....	11
35 U.S.C. § 316(a)(11).....	11
35 U.S.C. § 325(d) .....	4, 6, 13
35 U.S.C. § 351(e)(1).....	5
37 C.F.R. § 42.107(a).....	1
37 C.F.R. § 42.108 .....	11
81 Fed. Reg. 18750, 18759 (Apr. 1, 2016) .....	14

**OTHER AUTHORITIES**

H.R. Rep. No. 112-98, pt. 1, at 48 (2011).....17

# Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

## Real-Time Litigation Alerts



Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

## Advanced Docket Research



With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

## Analytics At Your Fingertips



Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

## API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

## LAW FIRMS

Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

## FINANCIAL INSTITUTIONS

Litigation and bankruptcy checks for companies and debtors.

## E-DISCOVERY AND LEGAL VENDORS

Sync your system to PACER to automate legal marketing.