UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

NEVRO CORP.,
Petitioner

v.

BOSTON SCIENTIFIC NEUROMODULATION CORP.,
Patent Owner.

Case IPR2018-00147
U.S. Patent No. 8,650,747

PETITIONER'S REQUEST FOR REHEARING OF INSTITUTION DECISION

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U.S. Patent & Trademark Office
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I. Introduction

The Board denied institution because, in its view, the Petition did not sufficiently show that a particular claimed feature—namely, a "solid, non-conductive material…filling [an] *unoccupied* portion of at least one [ ] conductor lumen[ ]"—would have been obvious over the cited art, accompanying expert declaration, and arguments presented in the Petition. Inst. Dec. at 11, quoting the '747 patent, claim 1 (emphasis Board's).[1] The denial is predicated on three subsidiary factual findings for which there is no substantial evidence, combined with legal error in the Board's evaluation of obviousness.

First, the Board's finding that "Stolz does not disclose filling an 'unoccupied portion' of the conductor lumen, as claimed" lacks substantial evidence. Second, the Board's rejection of Nevro's motivation to modify Stolz lacks substantial evidence. Third, the Board's finding that Black does not disclose filling an unoccupied portion of the conductor lumen when it melts its oversized spacers into unoccupied portions of the lumen lacks substantial evidence.

Finally, the Board used the wrong standard in considering obviousness. Specifically, the Board seeks to find in a single reference a disclosure of the feature at issue, and individually attacks the references without considering what their teachings—taken as a whole—would have suggested to a POSA. But the absence

[1] *See also* Inst. Dec. at 20, quoting language from the '747 patent's independent claim 11.

of a single express teaching of a particular feature does not make impossible a sound *prima facie* case of obviousness. And an obviousness analysis "need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ." *See KSR Intern. Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1741 (2007).

With a correct understanding of the argument set forth in the Petition and accompanying declaration, and because there is no evidence to the contrary, Petitioner has demonstrated a reasonable likelihood that this feature, and the challenged claims as a whole, are obvious. The Board should thus reconsider its institution denial.

II. Relief Requested

Petitioner Nevro Corp. respectfully requests that the Board reconsider its decision denying institution of *inter partes* review of U.S. Patent No. 8,650,747. *See* IPR2018-00147, Paper No. 7 (PTAB May 3, 2018).

III. Standard of Review

The burden of showing that a prior decision should be modified lies with Petitioner Nevro, the party challenging the decision. *See* 37 C.F.R. § 42.71(d). When rehearing a decision on petition, the Board will review the decision for an abuse of discretion. 37 C.F.R. § 42.71(c). An abuse of discretion occurs if the

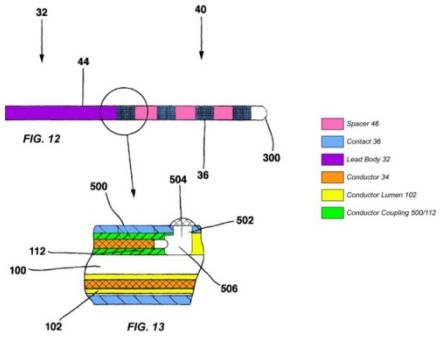
decision is "based on an erroneous interpretation of law, if a factual finding is not supported by substantial evidence, or if the decision represents an unreasonable judgment in weighing relevant factors." *Arnold P'ship v. Dudas*, 362 F.3d 1338, 1340 (Fed. Cir. 2004). A request for rehearing must identify specifically all matters the party believes the Board misapprehended or overlooked, and the place where each matter was addressed previously in a motion, an opposition, or a reply. 37 C.F.R. § 42.71(d).

IV. Argument

The Board denied institution because it concluded that Nevro did not sufficiently prove that it would have been obvious to modify Stolz to fill the "*unoccupied portions*" of its conductor lumens. Inst. Dec. at 18–20. That conclusion was based on subsidiary findings regarding the Stolz, Ormsby, and Black references that lack substantial evidence.

A. The Board's finding that Stolz does not fill an unoccupied portion of its conductor lumen is not supported by substantial evidence.

In one embodiment, described by Stolz's FIG. 13, "the coupling 112 has a conductor coupling 500 and a contact coupling 502." Ex. 1005, [0045].



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