

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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NEVRO CORP.,  
Petitioner,

v.

BOSTON SCIENTIFIC NEUROMODULATION CORP.,  
Patent Owner.

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Case IPR2018-00147  
Patent 8,650,747 B2

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Before HUBERT C. LORIN, MICHAEL W. KIM, and  
AMANDA F. WIEKER, *Administrative Patent Judges*.

LORIN, *Administrative Patent Judge*.

DECISION ON REQUEST FOR REHEARING  
*37 C.F.R. § 42.71*

## I. INTRODUCTION

Nevro Corp. (“Petitioner”) filed a Petition requesting an *inter partes* review of claims 1–19 (“the challenged claims”) of U.S. Patent No. 8,650,747 B2 (Ex. 1001, “the ’747 patent”). Paper 2 (“Pet.”). Boston Scientific Neuromodulation Corp. (“Patent Owner”) filed a Preliminary Response. Paper 6 (“Prelim. Resp.”). On May 3, 2018, the Board did not institute an *inter partes* review with respect to any of claims 1–19. Paper 7 (“Dec.”; “Decision”). On June 4, 2018, Petitioner filed a Request for Rehearing of the Decision. Paper 8 (“Req.”).

For the reasons that follow, the Request for Rehearing is *denied*.

## II. ANALYSIS

A request for rehearing must identify specifically all matters that the requesting party believes the Board misapprehended or overlooked. 37 C.F.R. § 42.71(d). When rehearing a decision on institution, the Board will review the decision for an abuse of discretion. 37 C.F.R. § 42.71(c).

The Request states that

[t]he 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 [three] subsidiary findings regarding the Stolz, Ormsby, and Black references that lack substantial evidence.

Req. 3. According to the Request, the Board’s “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” (Req. 1).

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.

Req. 1. And, “the Board used the wrong standard in considering obviousness.”

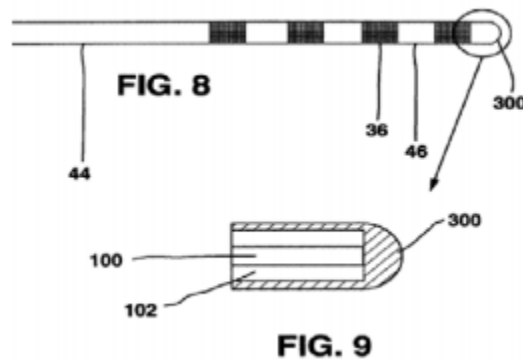
Req. 1.

**“A. The Board’s finding that Stolz does not fill an unoccupied portion of its conductor lumen is not supported by substantial evidence.”** Req. 3.

The issue was “whether it would have been obvious to one of ordinary skill in the art, at the time of the invention, to provide ‘a solid, nonconductive material disposed, at least in part, radially underneath [ ] conductive contacts and filling [an] unoccupied portion of at least one [ ] conductor lumen[ ]’ (claim 1), ‘wherein each conductor lumen comprises an occupied portion within which at least one [ ] conductor wire[ ] is disposed and an unoccupied portion in which none of the conductor wires is disposed, the unoccupied portion extending from an end of the conductor lumen’ (claim 1) over the combined disclosures of Stolz, Ormsby, and Black.” Dec. 8.

Before delving into the merits of Petitioner’s assertion, we summarize the analysis that went into arriving at our determination on the above issue. We begin with the Petition, which cites two disclosures in Stolz (Ex. 1005) for this issue.

The first Stolz disclosure centered on Figs. 8 and 9 of Stolz (Ex. 1005), reproduced below.



According to the Petition, “Stolz [ ] discloses solid, non-conductive [sic] disposed in a conductor lumen 102, e.g., to seal it. . . . Stolz thus fills, at least in part, an unoccupied portion of at least one of the conductor lumens.” Pet. 36. The Petition explained that “[t]his is accomplished when ‘[t]he heat conducted from the mold to the lead distal tip 300 melts the surrounding material into the conductor lumen 102 and into the stylet lumen 100, completely sealing them from the outside.’ *Id.*, [0036].” Pet. 36.

The Petition acknowledged, however, that “[t]he solid distal tip 300 thus ‘penetrates the lumens 100, 102 of the lead body . . . [and] reaches no further into the lumens than making contact to the enclosed conductors.’ *Id.*, [0035].” Pet. 36. *See* Dec. 12–13.

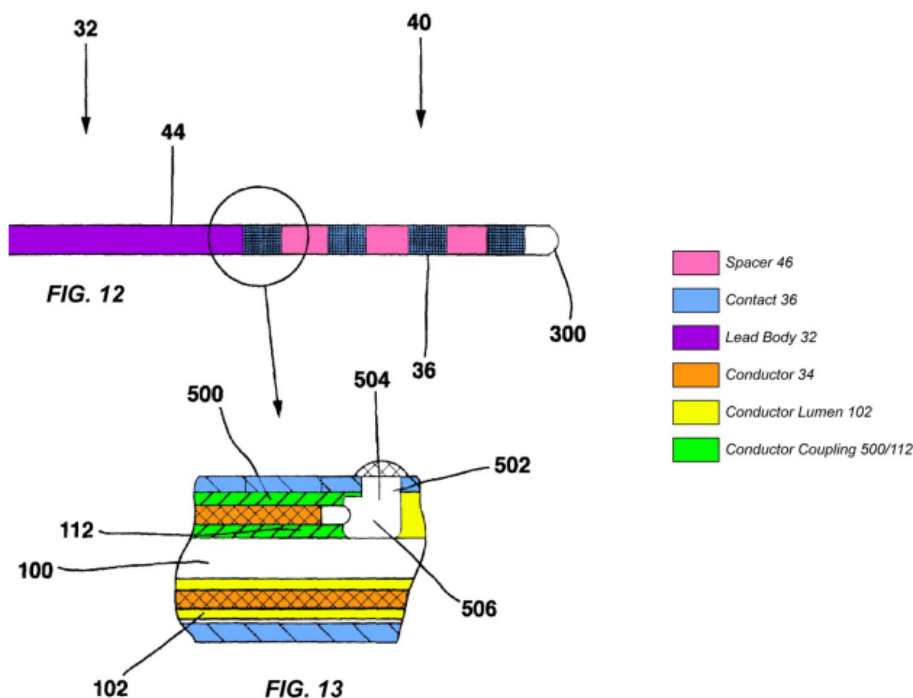
Stolz’s sealing the end of the implantable lead with its distal tip does have some potential disadvantages. Ex. 1003, ¶¶ 135-138. Specifically, the reflowed portion of Stolz’s distal tip may not penetrate very far into the stylet lumen or the conductor lumens. Specifically, Stolz teaches that the distal tip material “penetrates the most distal end of the stylet lumen 100 by about 0.15 cm (0.059 inch) into the stylet lumen 100 of the lead beginning from the most distal end of the hemispherical distal tip 300.” Ex. 1005, [0038]. Stolz discloses that the distal tip may make contact with the enclosed conductors *see, e.g., id.*, [0035]. But given the distance that the distal tip material penetrates the stylet lumen, some conductor lumens—e.g., especially those that service electrodes that are furthest from the distal tip—may still have a

long, unoccupied space between the distal tip and the conductor. *See* Ex. 1003, ¶ 139.

Pet. 38–39; *see also* Dec. 13.

Consistent with the Petitioner’s “acknowledge[ment] that ‘ . . . the reflowed portion of Stolz’s distal tip may not penetrate very far into the stylet lumen or the conductor lumens’” (Dec. 13, *quoting* Pet. 38)), the Board determined that “Stolz does not disclose a solid, non-conductive material filling an unoccupied portion of a conductor lumen as claimed.” Dec. 18–19.

The second disclosure centered on Figs. 12 and 13 of Stolz (Ex. 1005), reproduced below.



The Petition stated, in total, that “Stolz discloses that the isolation space 506 can include a ‘fill material’ (such as epoxy)—which a POSA would have understood to be nonconductive—further filling an unoccupied portion of the

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