

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 IPR2018-00148  
U.S. Patent No. 8,646,172

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**PETITIONER'S REQUEST FOR  
REHEARING OF INSTITUTION DECISION**

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

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Petitioner Nevro Corp. requests rehearing because at least two of the Board's material fact findings lack substantial evidentiary support, and because its legal analysis is flawed. Both are an abuse of the Panel's discretion.

Nevro also respectfully requests that an expanded panel reconsider the Panel's decision denying institution of *inter partes* review of U.S. Patent No. 8,646,172 to resolve inconsistencies in how individual Board panels treat expert testimony at the pre-trial phase where the Patent Owner chooses *not* to introduce competing testimony, as was the case here. *See* IPR2018-00148, Paper No. 7 (PTAB May 17, 2018). Standard Operating Procedure 1, Rev. 14 (May 8, 2015), Section III.C. Expanded panel review will improve uniformity and predictability in how the Board will evaluate evidence and arguments in the pre-trial phase of an IPR proceeding where a patent owner does not submit competing declaratory evidence.

**I. The '172 patent Claims are Broad – Broader Than the '747 and '085 Patents Already Reviewed by this Panel.**

The '172 patent is related to U.S. Patent Nos. 7,891,085 and 8,650,747. Both the '085 and '747 patents are involved in IPR proceedings before this Panel where it denied institution on similar facts and art.<sup>1</sup> Both patents are also narrower than

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<sup>1</sup> IPR2018-00143, Paper 7 ('085 patent) and IPR2018-00147, Paper 7 ('747 patent). Petitioner Nevro did not request rehearing for the '085 patent.

the '172 patent at issue for the key limitation at issue in each denial, as the chart below illustrates:

Patent No.	Key limitation at issue in each of the IPR denials
7,891,085	<i>inserting monofilament</i> into at least one portion of at least one of the conductor lumens of the lead body that is not occupied by the conductor wires.
8,650,747	a solid, non-conductive material disposed, <i>at least in part</i> , radially underneath the conductive contacts and <i>filling the unoccupied portion of at least one of the conductor lumens</i> .
8,646,172	placing non-conductive material <i>into</i> a portion of <i>at least one of the conductor lumens</i> of the lead body, <i>wherein at least a portion</i> of the non-conductive material <i>is</i> disposed <i>radially beneath the conductive contacts</i> .

The '085 patent narrowly requires *inserting monofilament* into at least one of the conductor lumens that is not occupied by conductor wires. The '747 and '172 patents, on the other hand, more broadly dispose “*non-conductive material*” in the conductor lumens, instead of monofilament. And the '747 and '172 patents both require that some portion of non-conductive material be disposed “*radially beneath [underneath] the conductive contacts*.”

But the '172 patent at issue here is broader than the '747 patent because the '172 patent claims do not require “*at least in part ... filling the unoccupied portion* of at least one of the conductor lumens.” Rather, the '172 patent only disposes non-conductive material *anywhere* in the conductor lumen, without restriction, so long as “at least a portion” of it is “disposed radially beneath the conductive contacts.”

## II. Standard of Review

As the party challenging the decision, Nevro bears the burden of showing that a prior decision should be modified. *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 rehearing request must specify 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).

## III. Argument

### A. The Panel’s dispositive fact findings for the Stolz and Black references lack substantial evidentiary support.

Nevro and its expert relied primarily on Stolz and Black to show at least partial filling of a conductor lumen radially beneath a conductive contact. *See, e.g.*, Pet. at 5, 11, 16–18, 22–27, 39–45; Ex. 1003, ¶¶112–157. The Panel provided no evidentiary support for its contrary findings, let alone the substantial evidentiary support required to avoid an abuse of discretion.

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