

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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EDWARDS LIFESCIENCES CORPORATION AND EDWARDS  
LIFESCIENCES LLC,  
Petitioners

v.

COLIBRI HEART VALVE LLC,  
Patent Owner

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Patent No. 9,125,739

**PETITIONERS' NOTICE  
REGARDING MULTIPLE PETITIONS**

**TABLE OF CONTENTS**

|  | <b>Page</b> |
|--|-------------|
| I. INTRODUCTION .....  | 1           |
| II. RANKING .....  | 2           |
| III. DIFFERENCES BETWEEN THE PETITIONS, WHY THEY ARE<br>MATERIAL, AND WHY ALL SHOULD BE INSTITUTED ..... | 2           |
| IV. CONCLUSION.....  | 3           |

## I. INTRODUCTION

Edwards Lifesciences Corporation and Edwards Lifesciences LLC (“Petitioners” or “Edwards”) are filing herewith their second petition for *inter partes* review of Claims 1-5 of U.S. Patent No. 9,125,739 (“Edwards’ Second Petition”). As set forth in Edwards’ Motion for Joinder filed herewith, Edwards’ Second Petition substantially mirrors the petition filed in *Medtronic Corevalve LLC v. Colibri Heart Valve LLC*, IPR2020-01454 (“the Medtronic IPR”), which the Board instituted on March 10, 2021. Edwards previously filed IPR2020-01649 challenging Claims 1-5 of the ’739 Patent (“Edwards’ First Petition”), which was instituted on March 26, 2021. IPR2020-01649, Paper No. 8.

## II. RANKING

The PTAB Consolidated Trial Practice Guide (“TPG”) seeks notice of multiple petitions “[t]o aid the Board in determining” why “more than one petition is necessary.” *See* TPG at 59-60 (Nov. 2019). Here, both the Medtronic IPR and Edwards’ First Petition have already been instituted by the same panel. In instituting Edwards’ First Petition, the Board determined, after fully considering its discretionary denial authority under §§ 314(a) and 325(d), that the grounds set forth in Edwards’ First Petition and the Medtronic IPR (which Edwards’ Second Petition now mirrors) both warrant review. *See, e.g.*, IPR2020-01649, Paper No. 8 at 8-21. Thus, a ranking of Edwards’ First Petition and Edwards’ Second Petition is

unnecessary. Nonetheless, because Edwards is seeking to participate only passively in the Medtronic IPR upon joinder of Edwards' Second Petition to that proceeding and is actively participating in Edwards' First Petition, it wishes the Board to first consider the merits of Edwards' First Petition before Edwards' Second Petition.

### **III. DIFFERENCES BETWEEN THE PETITIONS, WHY THEY ARE MATERIAL, AND WHY ALL SHOULD BE INSTITUTED**

As indicated in Edwards' Second Petition, it is being submitted concurrently with a Motion for Joinder. Specifically, Edwards requests institution and joinder of Edwards' Second Petition with the Medtronic IPR, which the Board instituted on March 10, 2021. Edwards' Second Petition substantially mirrors the petition filed in the Medtronic IPR; it contains the same grounds (based on the same prior art combinations and supporting evidence) against the same claims (Claims 1-5). As to Edwards' First Petition, it was filed *after* the Medtronic IPR, and accounted for the distinctions between it and the Medtronic IPR in setting forth bases why Edwards' First Petition should be instituted separate and apart from the Medtronic IPR. *See* IPR2020-01649, Paper No. 2 at 70-75. The same panel is assigned to the Medtronic IPR and Edwards' First Petition, and, having considered the bases set forth by Edwards to decline the use of its discretionary authority, the Board instituted both the Medtronic IPR petition and Edwards' First Petition. *See, e.g., id.*, Paper No. 8 at 8-21. Thus, for the same reasons the Board did not exercise its discretionary authority to deny Edwards' First Petition in view of the Medtronic IPR, and for the

additional reasons set forth in Edwards' Motion for Joinder filed herewith, Edwards' Second Petition should be instituted. The facts here are consistent with the guidance in the consolidated TPG, which states that "the Board recognizes that there may be circumstances in which more than one petition may be necessary." *See* TPG at 59-60.

#### IV. CONCLUSION

For the reasons given above, the Board should institute Edwards' Second Petition, which is (1) distinct from Edwards' already instituted First Petition; and (2) substantially identical to the Medtronic IPR that has already been instituted and that Edwards' Second Petition seeks to join.

Respectfully submitted,

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