

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

NEVRO CORP.,
Petitioner,

v.

BOSTON SCIENTIFIC NEUROMODULATION CORP.,
Patent Owner.

Case No. IPR2018-00148
Patent No. 8,646,172 B2

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

LORIN, *Administrative Patent Judge*.

DECISION
Denying Institution of *Inter Partes* Review
35 U.S.C. § 314

I. INTRODUCTION

A. Background

Nevro Corp. (“Petitioner”) filed a Petition requesting *inter partes* review of claims 1–11 of U.S. Patent No. 8,646,172 B2 (Ex. 1001, “the ’172 patent”) pursuant to 35 U.S.C. §§ 311–319. Paper 2 (“Pet.”). Boston Scientific Neuromodulation Corp. (“Patent Owner”) filed a Preliminary Response to the Petition (Paper 6, “Prelim. Resp.”).

We have authority under 35 U.S.C. § 314.

Upon consideration of the arguments and evidence presented by Petitioner and Patent Owner, we are not persuaded that Petitioner has demonstrated, under 35 U.S.C. § 314(a), a reasonable likelihood that it would prevail in showing the unpatentability of any of the challenged claims. Accordingly, we do not institute an *inter partes* review of any claim.

B. Related Proceedings

Petitioner notifies us that “[t]he ’172 patent is the subject of one civil action: *Boston Scientific Corporation et al. v. Nevro Corp.*, Case No. 1:16-cv-01163 (D. Del.), filed December 9, 2016.” Pet. 66; *see also* Paper 3, 2 (indicating the same).

C. The ’172 patent (Ex. 1001)

1. Effective Filing Date

Petitioner indicates that the earliest priority date of the ’172 patent is January 11, 2005. Pet. 5. This is in accord with the information recited on the cover of the ’172 patent. Ex. 1001, (60).

2. *Disclosure*

The '172 patent, titled "Electrode Array Assembly and Method of Making Same," discloses manufacturing a stimulation lead related to implantable leads for providing electrical stimulation used to treat a variety of maladies. Ex. 1001, (57), 1:15–24. According to the patent,

[i]n general, it is desirable to make the lead efficiently, with the fewest number of process steps, maximize the manufacturing yield, and hence reduce the cost of goods of building the leads. There is thus a continual need to improve the design of a percutaneous lead in order to improve its performance and to improve the method of manufacturing the lead.

Ex. 1001, 2:2–8.

In one embodiment, relevant to what is claimed, during manufacture, a void space in a part of a lead assembly is filled with nonconductive material (e.g., a monofilament) and "then placed into a heat." Ex. 1001, 6:17–20.

3. *Claims*

The '172 patent has 11 claims, all of which are challenged.

Independent claim 1 is illustrative.

1. A method of manufacturing a stimulation lead comprising:
providing a lead body comprising an insulation section, the insulation section defining a central lumen extending along the insulation section and a plurality of conductor lumens extending along the insulation section and arranged around, and external to, the central lumen, the lead body further comprising a plurality of conductive contacts located along an axial end of the lead body, and a plurality of conductor wires, wherein each of the conductor wires is disposed within one of the plurality of conductor lumens and each of the conductor lumens of the plurality of conductor lumens has at least one of the conductor

wires of the plurality of conductor wires disposed therein, wherein a portion of the conductor lumens is disposed radially beneath the conductive contacts;

after providing the lead body, conductively coupling at least one of the plurality of conductor wires to each of the conductive contacts; and

after providing the lead body, placing non-conductive material into a portion of at least one of the conductor lumens of the lead body, wherein at least a portion of the non-conductive material is disposed radially beneath the conductive contacts.

Claim 6 is also directed to “a method of manufacturing a stimulation lead.” Claims 1 and 6 parallel each other, except that claim 6 includes, after placing the non-conductive material into a portion of at least one of the conductor lumens of the lead body, heating the non-conductive material “to cause the non-conductive material to thermally reflow or melt.” *Compare* Ex. 1001, 8:20–44, *with id.* at 8:61–10:3.

Claims 2–5 depend from claim 1, and claims 7–11 depend from claim 6.

D. Asserted References

Petitioner relies on the following references:

Name	Reference	Ex. No.
Stolz	U.S. Patent Application Publication No. 2003/0199950 A1, published Oct. 23, 2003	1005
Ormsby	PCT Application Publication No. WO 00/35349, published June 22, 2000	1006
Black	U.S. Patent No. 6,216,045 B1, granted Apr. 10, 2001	1008
Modern Plastics Encyclopedia	Modern Plastics Encyclopedia, 1986–1987, published by McGraw-Hill, Inc., October 1986, Volume 63, Number 10A, pp. 3, 540	1010

E. Grounds Asserted

Petitioner contends that claims 1-11 of the '172 patent are unpatentable under the following two grounds:

Ground	Basis	Prior Art	Claims
I	§ 103	Stolz, Ormsby, and Black	1-5
II	§ 103	Stolz, Ormsby, Black, and Modern Plastics Encyclopedia	6-11

Pet. 6.

Petitioner also relies on the Declaration of Michael Plishka (Ex. 1003) as support for the various contentions.

II. ANALYSIS

A. Claim Construction

This Decision requires construing the claim phrase “radially beneath.” This is so because a major contention in this case is whether the cited prior art discloses “non-conductive material is disposed *radially beneath* the conductive contacts.” See Ex. 1001, claim 1 (similarly claim 6).

The '172 patent specification does not provide an express definition for “radially beneath.” The phrase is recited in the Abstract and in some of the claims, but is not otherwise mentioned. However, “radially” is commonly and ordinarily understood to mean like a radius. See *Webster's New World Dictionary, Third College Edition*, 1988, p. 1107 (defining RADIAL as “2 of or situated like a radius”). Given that a circle's radius extends from the circle's center to its circumference, it follows that any point along a radius that is below, for example, the circle's circumference is “radially beneath” the circumference. See *id.* (defining RADIUS as “any

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