

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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COOK GROUP INCORPORATED  
and  
COOK MEDICAL LLC,  
Petitioner,

v.

BOSTON SCIENTIFIC SCIMED, INC.,  
Patent Owner.

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Case IPR2017-00134  
Patent 8,709,027 B2

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Before JAMES T. MOORE, JAMES A. TARTAL,  
and ROBERT L. KINDER, *Administrative Patent Judges*.

MOORE, *Administrative Patent Judge*.

ORDER  
CONDUCT OF THE PROCEEDING  
*37 C.F.R. § 42.5*

## I. Background

The United States Court of Appeals for the Federal Circuit issued a decision in this case on April 30, 2020. *Cook Group Incorporated, Cook Medical LLC v. Boston Scientific Scimed, Inc.*, 809 F. App'x. 990 (Fed. Cir. 2020). That decision determined that we erred in our analysis of claims 4–6, 15, and 20, and therefore vacated our decision that Petitioner failed to demonstrate by a preponderance of the evidence that those claims were unpatentable. The court remanded the proceeding to us, *inter alia*, to analyze the claims. *Id.*, slip op. at 20.

The court specifically found it was error for us not to consider Malecki. U.S. Patent No. 5,626,607 (“Malecki”) Embodiment #2 when considering the patentability of claim 20. The court also specifically found we erred in not considering the precise language of claim 20. *Id.* at 13. The court thus remanded this proceeding to us (1) to consider whether Malecki Embodiment #2 anticipates claim 20. *Id.*

The court also specifically found we erred in not considering the impact of the admission contained within Patent Owner’s Preliminary Response. *Id.* at 17. The court vacated our finding that Sackier, U.S. Patent No. 5,749,881 (“Sackier”) and Nishioka, U.S. Patent No. 5,843,000 (“Nishioka”) do not render claims 4–6, 15, and 20 obvious, and remanded for us (2) to consider, in the first instance, Patent Owner’s admission and the impact of that admission on the balance of the evidence. *Id.*

### b. Conference Call

A conference call was conducted at 3:30 PM Eastern Time on Tuesday, June 30, 2020 in this proceeding.

Judges James T. Moore, James A. Tartal, and Robert L. Kinder were

present for the call. Mr. Jeffry Nichols was present as lead counsel for the Petitioner, and Mr. David Caine was present as lead counsel for the Patent Owner. A transcript of the conference call has been filed as Exhibit 1119. (“Tr.”).

The parties and the Board arranged the conference call to discuss post-remand procedures to be used in this proceeding and a related proceeding, IPR2017-00440 (IPR ’440).

Petitioner took the position that no new argument or evidence would be appropriate. Tr. 7–9. Petitioner’s view is that the scope of the remand is very narrow and focused on (1) whether Patent Owner’s admission concerning Sackier be given any weight, and (2) anticipation by Malecki. *Id.* at 11.

According to Petitioner, there is already adequate briefing on these issues, including various briefs directed to the issues raised on remand. *Id.*

Patent Owner agrees that no hearing is necessary on remand. Tr. 12–13. Patent Owner would prefer that we permit some briefing on the issue for context, especially in view of the Federal Circuit’s decision. Tr. 13. More specifically, Patent Owner feels that it could provide insight as to what constitutes an admission and how much weight we should give such. Tr. 15–16.

Patent Owner also is of the viewpoint that additional briefing on the issue of claim construction would be useful. Tr. 21. Patent Owner also contends that it should be permitted to submit additional evidence consisting of the preliminary patent owner response in a related *inter partes* review—IPR2017-00131, which also involves Petitioner and Patent Owner as parties. Tr. 16–18.

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Both parties agree no oral argument is needed.

We have carefully considered each of the parties' positions and agree that some very limited briefing on the issues discussed above would be beneficial. Accordingly, each party is authorized an Opening Brief on Remand of 10 pages, due August 3, 2020. Each party is also authorized a Responsive Brief of 5 pages, due August 13, 2020. No new evidence shall be submitted. The parties may, however, cite to one specific pleading - the preliminary Patent Owner Response from IPR2017-00131. No oral argument shall be scheduled.

## II. Order

In consideration of the foregoing, it is hereby:

ORDERED that Petitioner and Patent Owner may each submit an Opening Brief on Remand, limited to 10 pages, due August 3, 2020.

ORDERED that Petitioner and Patent Owner may each submit a Responsive Brief on Remand, limited to 5 pages, due August 13, 2020.

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