

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

COOK GROUP INCORPORATED
and
COOK MEDICAL LLC,
Petitioner,

v.

BOSTON SCIENTIFIC SCIMED, INC.,
Patent Owner.

IPR2017-00134
Patent 8,709,027 B2

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

MOORE, *Administrative Patent Judge*.

FINAL WRITTEN DECISION ON REMAND
35 U.S.C. §§ 144, 318(a)

I. Introduction

We address this case on remand after a decision by the United States Court of Appeals for the Federal Circuit in *Cook Group Incorporated, Cook Medical LLC v. Boston Scientific Scimed, Inc.*, 809 F. App'x 990 (Fed. Cir. 2020) (“*Cook Group I*”).¹

In our Final Written Decision of November 3, 2018, we determined that Cook Group Incorporated and Cook Medical LLC (“Petitioner”) had shown by a preponderance of the evidence that claims 1–3, 7–14, and 16–19 of U.S. Patent No. 8,709,027 B2 (“the ’027 patent”) are unpatentable, but had not shown by a preponderance of the evidence that claims 4–6, 15, and 20 of the ’027 patent are unpatentable. Paper 92, 3.

Cook Group Incorporated and Cook Medical LLC (“Petitioner”) and Boston Scientific Scimed, Inc. (“Patent Owner”) each filed notices of appeal of our Final Written Decision. Papers 93 and 94.

In *Cook Group I*, the Federal Circuit found the following:

- (1) affirmed our determination that Petitioner has not shown by a preponderance of the evidence that the ’027 patent claims 1, 3–6, 13–15, 17, and 20 are unpatentable as anticipated under § 102 by Sackier²; *Cook Group I*, 20.
- (2) affirmed our determination that Petitioner has shown by a preponderance of the evidence that the ’027 patent claims 1–3, 7–14, and 16–19 are unpatentable as obvious over Sackier and

¹ References herein are to the slip opinion, No. 19-1370 (Fed. Cir. Apr. 30, 2020).

² U.S. Patent No. 5,749,881, filed on October 20, 1994, and issued May 12, 1998 (“Sackier”) (Ex. 1008).

Nishioka³; *id.* at 20,

- (3) vacated our determination that Petitioner has not shown by a preponderance of the evidence that the '027 patent claims 4–6, 15, and 20 are unpatentable as obvious over Sackier and Nishioka, and remanded to the Board to consider, in the first instance, the weight to be afforded an admission by Patent Owner in its Preliminary Response related to the operation of Sackier; *id.* at 17,
- (4) affirmed³ our determination that Petitioner has not shown by a preponderance of the evidence that the '027 patent claims 1 and 3–11 are unpatentable as anticipated under § 102 by Malecki or as obvious under under § 103 over Malecki; *id.* at 20, and,
- (5) vacated our determination that Petitioner has not shown by a preponderance of the evidence that the '027 patent claim 20 is unpatentable as anticipated under § 102 by Malecki, and remanded to consider whether Embodiment #2 of Malecki anticipates claim 20 of the '027 patent.⁴ *id.* at 13.

Cook Group I, passim.

On June 30, 2020, we conducted a conference call with the parties to discuss post-remand procedures for this proceeding and a related proceeding on remand between the same parties, IPR2017-00440 (“IPR ’440”). *See* Ex. 1119 (transcript of June 30, 2020 conference call).

³ U.S. Patent No. 5,843,000, filed on May 7, 1996, and issued on December 1, 1998 (“Nishioka”) (Ex. 1005).

⁴ U.S. Patent No. 5,626,607, filed on February 1, 1996, and issued on May 6, 1997 (“Malecki”) (Ex. 1003).

We authorized each party to file in this case an opening brief on Remand and a Responsive Brief on Remand, without new evidence. Petitioner submitted an opening brief setting forth the issues for us to decide and its arguments on those issues. Paper 104 (“Pet. Remand Br.”). Patent Owner also filed an opening brief. Paper 103 (“PO Remand Br.”). Petitioner filed a responsive brief. Paper 106 (“Pet. Remand Resp.”). Petitioner also filed a responsive brief. Paper 105 (“PO Remand Resp.”).

We have jurisdiction under 35 U.S.C. § 6, and we issue this Final Written Decision pursuant to 35 U.S.C. § 318(a) and 37 C.F.R. § 42.73. For the reasons discussed below, we conclude that Petitioner has established by a preponderance of the evidence that the ’027 patent claims 4–6, 15, and 20 are unpatentable as obvious over Sackier and Nishioka and that Petitioner has not established by a preponderance of the evidence that the ’027 patent claim 20 is anticipated by Malecki.

II. Related Matters

This Decision on Remand is issued concurrently with a Decision on Remand in IPR ’440. The ’027 patent is also the subject of *Boston Scientific Corp. v. Cook Group Inc.*, Civil Action No. 1:15-cv-00980-LPS-CJB (D. Del). Pet. 1; Paper 3, 2. .

III. Anticipation of Claim 20 by Malecki Embodiment #2

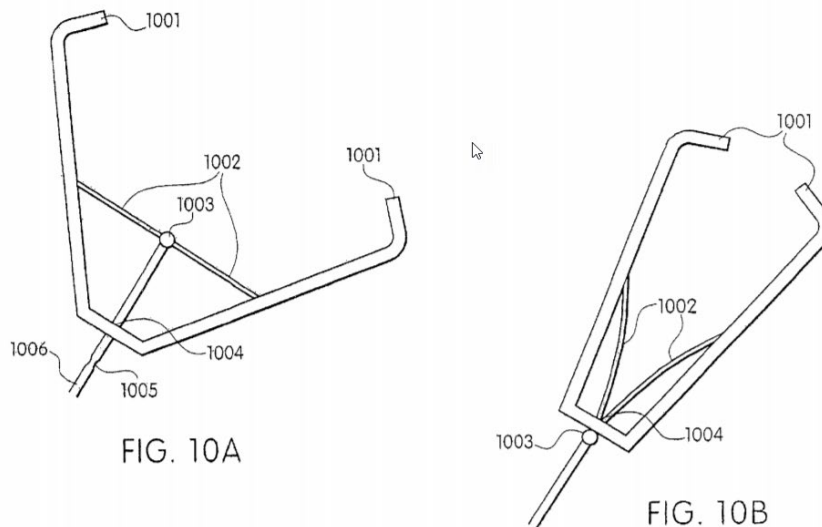
A. *The ’027 Patent*

The ’027 patent is titled “Device and Method for Through the Scope Endoscopic Hemostatic Clipping,” and is directed towards devices and methods of causing hemostasis of a blood vessel through an endoscope. Ex. 1001, code (52). A focus of the invention is to provide medical devices for causing the hemostasis of blood vessels along the gastrointestinal tract.

Id. at 2:51–53. The basic device and method include a compression clip used to cause hemostasis of blood vessels and a mechanism for deploying the clip. *Id.* at 2:59–61.

Various embodiments of the invention include a lock arrangement for locking the clip closed; a control wire connected to the clip and able to be disconnected from the clip; an axially rigid sheath enclosing the control wire and communicating a compressive force opposing a tensile force of the control wire; a handle connected to the axially rigid sheath; and/or a trigger enclosed within the handle and engaging the control wire to close and lock the clip, and to uncouple the control wire from the clip. *Id.* at 2:63–3:5.

Figures 10A and 10B from the '027 patent are reproduced below.



Figures 10A and 10B are cross-sectional views of a compressive clip in an opened and a closed position. *Id.* at 9:4–6.

B. Claim 20

Claim 20, a method claim of the '027 patent, reads as follows:

20. A method, comprising:
inserting into a body a medical device comprising a clip
having a first clip leg having a first inner surface and a

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