

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.

Case IPR2017-00435
Patent 9,271,731 B2

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

KINDER, *Administrative Patent Judge*.

FINAL WRITTEN DECISION AND
ORDER ON MOTION TO AMEND

Inter Partes Review
35 U.S.C. §§ 316(d), 318(a) and 37 C.F.R. §§ 42.73, 42.121

Cook Group Incorporated and Cook Medical LLC (“Petitioner”) filed a Petition (Paper 1, “Pet.”) to institute an *inter partes* review of claims 1–20 of U.S. Patent No. 9,271,731 B2 (Ex. 1033, “the ’731 patent”). Boston Scientific Scimed, Incorporated (“Patent Owner” or “BSSI”) filed a Preliminary Response (Paper 7, “Prelim. Resp.”).

Applying the standard set forth in 35 U.S.C. § 314(a), which requires demonstration of a reasonable likelihood that Petitioner would prevail with respect to at least one challenged claim, we issued a Decision to Institute an *inter partes* review of claims 1–4, 6–18, and 20 of the ’731 patent, but not under all challenged claims or grounds. Paper 8, 20 (“Dec.”).

Patent Owner subsequently filed a Patent Owner Response (Paper 18, “PO Resp.”) and Petitioner filed a Reply (Paper 31, “Pet. Reply”).

Patent Owner also filed a Contingent Motion to Amend (Paper 17, “Amend Mot.”), subsequently followed by a Supplemental Brief in Support of Patent Owner’s Contingent Motion to Amend (Paper 21). Petitioner filed an opposition (Paper 32, “Amend Opp.”), to which Patent Owner replied (Paper 45, “Reply to Opp.”). Petitioner then filed a Sur-Reply in Support of the Opposition to Patent Owner’s Motion to Amend (Paper 52, “Amend. Sur-Reply”).

Patent Owner filed a Motion to Exclude (Paper 48) certain evidence submitted by Petitioner, to which Petitioner filed an Opposition (Paper 56), and Patent Owner filed a Reply (Paper 61).

Petitioner also filed a Motion to Exclude (Paper 64) certain evidence submitted by Patent Owner, to which Patent Owner filed an Opposition (Paper 69).

A combined oral hearing with Case IPR2017-00440 was held April 19, 2018, and a transcript of the hearing is included in the record (Paper 72, “Tr.”). A second oral hearing was conducted on September 17, 2018 (Paper 93, Tr. 2”).

On April 24, 2018, the Supreme Court held that a decision to institute under 35 U.S.C. § 314 may not institute on fewer than all claims challenged in the petition. *SAS Inst. Inc. v. Iancu*, 138 S.Ct. 1348, 1359–60 (2018). On April 26, 2018, the Office issued Guidance on the Impact of SAS on AIA Trial Proceedings, which states that “if the PTAB institutes a trial, the PTAB will institute on all challenges raised in the petition.”¹ Subsequently, on May 7, 2018, we issued an Order modifying the Decision on Institution “to institute on all of the challenged claims and all of the grounds presented in the Petition.” Paper 71, 1.

Pursuant to our authorization, the parties thereafter filed a “Joint Motion to Limit the Proceeding” (Paper 77), requesting that we limit the proceeding to a subset of the instituted grounds and claims in the Petition, as identified in the motion. Paper 77, 1–2. On June 15, 2018, we issued a Decision (Paper 78), accepting the Parties’ joint proposal to limit the proceeding “to those claims and grounds as set forth in Paper 77, 1–2.” Paper 78, 2. The “Asserted Grounds” section below reflects the claims and grounds agreed upon by the parties and addressed in our Decision to Limit the Proceeding.

Based on the addition of grounds and claims to the proceeding, we authorized additional briefing. Paper 76 (also recognizing six month

¹ Available at: <https://www.uspto.gov/patents-application-process/patent-trial-and-appeal-board/trials/guidance-impact-sas-aia-trial>.

extension under 37 C.F.R. § 42.100(c)). On June 29, 2018, Patent Owner filed a Supplemental Response. Paper 80 (“Supp. Resp.”). Petitioner filed a Supplemental Reply. Paper 81 (“Supp. Reply”). Patent Owner then filed a Sur-Reply. Paper 90 (“Supp. Sur-Reply”).

Patent Owner also filed a second Motion to Exclude (Paper 83), which sought to exclude certain evidence submitted by Petitioner, to which Petitioner filed an Opposition (Paper 87), and Patent Owner thereafter filed a Reply (Paper 88).

We have jurisdiction under 35 U.S.C. § 6. This Final Written Decision is issued pursuant to 35 U.S.C. § 318(a). For the reasons that follow, we determine that Petitioner has not shown by a preponderance of the evidence that claims 1–4, 6–18, and 20 are unpatentable in this proceeding.

We address the Parties’ motions to exclude as set forth below. Additionally, we deny Patent Owner’s Contingent Motion to Amend as moot.

I. BACKGROUND

A. *The ’731 Patent (Ex. 1033)*

The ’731 patent is titled “Device and Method for Through the Scope Endoscopic Hemostatic Clipping,” and claims an apparatus and method for capturing tissue. Ex. 1033, [54], 15:36–17:15. The claimed “invention relates to compression clips, and more specifically, to compression clips used to cause hemostasis of blood vessels located along the gastrointestinal tract delivered to a target site through an endoscope.” *Id.* at 1:24–27. As explained by the ’731 patent, the clips stop internal bleeding by clamping

together the edge of a wound to achieve “hemostasis.” *Id.* at 2:62–66. Embodiments of the invention include “a clip” with “clip arms,” and a “control wire” for moving the clip between open and closed configurations. *Id.* at 16:24–42. In addition, the medical device claims describe an “opening element” for urging the clip arms into the open configuration, and the method claim describes use of the control wire to “move the first and second clip arms away from one another to the open tissue receiving configuration.” *Id.* at 15:37–17:15.

The ’731 patent describes “an arrangement for closing the clip and for reversing the closing process to reopen the clip after closure has begun.” *Id.* at 2:64–66. As described, certain

[e]mbodiments of the invention may 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,” as well as other elements to help “close and lock the clip and to uncouple the control wire from the clip.

Id. at 2:66–3:7. One advantage mentioned in the Specification is that “[t]he device’s ability to repeatedly open and close the clip until the desired tissue pinching is accomplished will lead to a quicker procedure, requiring less clips to be deployed, with a higher success rate.” *Id.* at 3:9–13.

B. Illustrative Claim

Claims 1 and 20 are illustrative of the claims at issue:

1. A medical device, comprising:

a clip including first and second clip arms, the clip being movable between an open tissue receiving configuration in which the first and second arms are separated from one another by a distance selected to receive tissue therebetween and a closed

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