

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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EDWARDS LIFESCIENCES CORPORATION,  
Petitioner,

v.

BOSTON SCIENTIFIC SCIMED, INC.,  
Patent Owner.

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Case IPR2017-01281  
Patent 7,828,767 B2

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Before NEIL T. POWELL, JAMES A. TARTAL, and  
STACY B. MARGOLIES, *Administrative Patent Judges*.

TARTAL, *Administrative Patent Judge*.

CONDUCT OF PROCEEDING

*Denying Request for Reply and Amending Due Dates 4–6*  
*37 C.F.R. § 42.5*

A conference call was conducted on February 21, 2018, between Edwards Lifesciences Corporation (“Petitioner”), Boston Scientific Scimed, Inc. (“Patent Owner”), and Judges Powell, Tartal, and Margolies. We instituted trial on claims 5, 6, 8–12, 14, 16, and 17 of U.S. Patent No. 7,828,767 B2 (“the ’767 patent”) on November 3, 2017. Paper 9. As required by our Case Management and Scheduling Order, Patent Owner requested the conference call to discuss the impact on this proceeding of Patent Owner’s decision not to file a Patent Owner Response or Motion to Amend the Patent, which had been due on February 9, 2018. *See* Paper 10, 6, 8.

We confirmed that Patent Owner had waived any arguments for patentability by not filing a Patent Owner Response or Motion to Amend the Patent. *See id.* at 6 (stating that “[t]he patent owner is cautioned that any arguments for patentability not raised in the response will be deemed waived”). We also explained that in our Institution Decision we determined the information presented in the Petition showed a reasonable likelihood that Petitioner would prevail with respect to at least 1 of the claims challenged in the Petition. *See* Paper 9; *see also* 35 U.S.C. § 314(a). We did not determine in the Institution Decision whether Petitioner had demonstrated by a preponderance of the evidence that claims 5, 6, 8–12, 14, 16, and 17 were unpatentable. That determination, as we explained, would be made in a final written decision. *See* 35 U.S.C. § 318(a); 37 C.F.R. § 42.73.

We asked Patent Owner if it intended to file a request for adverse judgment under 37 C.F.R. § 42.5. Patent Owner responded that it did not have such an intent at this time, but would take it under consideration. We request that Patent Owner promptly inform the Board if it determines that it

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will request adverse judgment in this proceeding or will elect to file a disclaimer disclaiming one or more of claims 5, 6, 8–12, 14, 16, and 17 of the '767 patent.

Petitioner requested the opportunity to file a reply to address the Institution Decision, notwithstanding the absence of a Patent Owner Response. We have considered Patent Owner's request, and it is denied. "A reply may only respond to arguments raised in the corresponding opposition, patent owner preliminary response, or patent owner response." 37 C.F.R. § 42.23(b). Further, because Patent Owner has waived any argument in favor of patentability, there is no issue raised by Patent Owner to which Petitioner can respond to in a reply. We understand Petitioner's interest in addressing before the Panel the Petition and the Institution Decision in light of the standard applied for purposes of a final written decision, and Petitioner may have the opportunity to do so during oral argument, if requested.

With the goal of expediting this proceeding in the absence of a Patent Owner Response or Motion to Amend the Patent, we amend Due Date 4 to require that any motion to exclude evidence or any request for oral argument be filed no later than March 16, 2018. Due Date 5 is amended to require that an opposition to any motion to exclude may be filed no later than March 30, 2018. Due Date 6 is amended to require that a reply to an opposition to any motion to exclude may be filed no later than April 6, 2018. We anticipate that the date of the oral argument also will be amended in coordination with the parties. As result, the parties may stipulate to different dates for amended Due Dates 4 and 5 (earlier or later, but no later than

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amended Due Date 6). Any notice of such stipulation, specifically identifying the changed due dates, must be promptly filed.

It is hereby:

ORDERED that Petitioner's request for leave to file a Reply in the absence of a Patent Owner Response is *denied*,

FURTHER ORDERED that Due Date 4 is amended to require that any motion to exclude evidence or any request for oral argument may be filed no later than March 16, 2018,

FURTHER ORDERED that Due Date 5 is amended to require that an opposition to any motion to exclude may be filed no later than March 30, 2018,

FURTHER ORDERED that Due Date 6 is amended to require that a reply to an opposition to any motion to exclude may be filed no later than April 6, 2018, and

FURTHER ORDERED that an amendment of DUE Date 7 shall be determined by the Board upon receipt of a request for oral hearing.

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