

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*.

ORDER

Conduct Of Proceeding  
*Modifying Institution Decision to Institute Inter Partes Review on  
All Challenged Claims and Grounds Presented in the Petition  
37 C.F.R. § 42.5*

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Edwards Lifesciences Corporation (“Petitioner”) filed a Petition (Paper 2, “Pet.”) requesting institution of *inter partes* review of claims 1–12, 14, 16, and 17 of U.S. Patent No. 7,828,767 B2 (Ex. 1001, “the ’767 patent”). On November 3, 2017, we instituted an *inter partes* review of claims 5, 6, 8–12, 14, 16, and 17. Paper 9 (“Institution Decision” or “Dec.”), 31. Patent Owner Boston Scientific Scimed, Inc., did not file a Patent Owner Response or Motion to Amend following the institution of *inter partes* review. During a conference call with the parties on February 21, 2018, we confirmed that Patent Owner had waived any arguments for patentability on the instituted grounds by not filing a Patent Owner Response or Motion to Amend the Patent. *See* Paper 10, 6 (stating that “[t]he patent owner is cautioned that any arguments for patentability not raised in the response will be deemed waived”).

On April 24, 2018, the Supreme Court held in *SAS Inst., Inc. v. Iancu* that a decision to institute under 35 U.S.C. § 314 may not institute on less than all claims challenged in the petition. 2018 WL 1914661, at \*10 (U.S. Apr. 24, 2018). In our Institution Decision, we determined that Petitioner demonstrated a reasonable likelihood that it would establish that at least one of the challenged claims of the ’767 patent is unpatentable. Dec. at 2. We modify our Institution Decision to institute on all of the claims and all of the grounds presented in the Petition.

Although Patent Owner elected not to file a Response or Motion to Amend following institution, this Order introduces challenged claims and grounds from the Petition into this proceeding that were not previously instituted. The parties are to meet and confer to discuss their positions with respect to the impact of *SAS* on this proceeding. The parties should discuss

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their proposals to accommodate the addition of claims and grounds into this proceeding and shall endeavor to reach agreement and develop a joint proposal, including any requested additional briefing and the length of such briefing. Furthermore, the parties should discuss a proposed revision to the Scheduling Order if needed to achieve the parties' proposals with the aim of concluding this proceeding within the twelve-month timeframe established by statute.

After conferring, the parties must, within seven (7) days of the date of this Order, submit a proposal (or, if the parties do not agree on a joint proposal, the parties must submit their respective proposals) in an email to the Board, in which the parties also request a conference call to discuss any additional briefing and modification of the schedule. The parties' email must include proposed times for such a call when both parties are available.

In consideration of the foregoing, it is hereby:

ORDERED that our Institution Decision is modified to include review of all challenged claims of the '767 patent on all grounds presented in the Petition, as follows:

References	Basis	Claims challenged
Dlugos <sup>1</sup> and Hijlkema <sup>2</sup>	§ 103	1, 2, 4, 5, and 8
Dlugos, Hijlkema, and Konstantino	§ 103	3
Dlugos, Hijlkema, and Forman <sup>3</sup>	§ 103	6, 14, and 16
Dlugos	§ 102	5
Dlugos	§ 103	5
Dlugos and Eskaros <sup>4</sup>	§ 103	5
Dlugos, Eskaros, and Konstantino <sup>5</sup>	§ 103	7
Dlugos, Eskaros, and Hijlkema	§ 103	8
Dlugos, Eskaros, and Forman	§ 103	6, 14, and 16
Dlugos, Eskaros, and Traxler <sup>6</sup>	§ 103	9, 10, and 12
Dlugos, Eskaros, Traxler, and Forman	§ 103	11
Dlugos, Eskaros, Forman, and Becker <sup>7</sup>	§ 103	17
Dlugos and Bampos <sup>8</sup>	§ 103	1

and,

FURTHER ORDERED that Petitioner and Patent Owner shall confer to determine any desired additional briefing and modification of the schedule and shall provide their proposals and request a conference call with the Board within seven (7) days of the date of this Order.

<sup>1</sup> WO 2007/020087 A1, published February 22, 2007 (Ex. 1008, “Dlugos”).

<sup>2</sup> U.S. Patent No. 5,853,389, issued Dec. 29, 1998 (Ex. 1009, “Hijlkema”).

<sup>3</sup> U.S. Patent No. 5,501,759, issued March 26, 1996 (Ex. 1012, “Forman”).

<sup>4</sup> U.S. Patent App. Pub. No. 2008/0097300 A1, published April 24, 2008 (Ex. 1011, “Eskaros”).

<sup>5</sup> U.S. Patent App. Pub. No. 2005/0177130 A1, published August 11, 2005 (Ex. 1010, “Konstantino”).

<sup>6</sup> U.S. Patent App. Pub. No. 2001/0047149 A1, published November 29, 2001 (Ex. 1013, “Traxler”).

<sup>7</sup> U.S. Patent No. 4,251,305, issued February 17, 1981 (Ex. 1014, “Becker”).

<sup>8</sup> U.S. Patent No. 6,013,055, issued January 11, 2000 (Ex. 1015, “Bampos”).

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