

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

EDWARDS LIFESCIENCES CORPORATION,
Petitioner,

v.

BOSTON SCIENTIFIC SCIMED, INC.,
Patent Owner.

Case IPR2017-01281
Patent 7,828,767 B2

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

TARTAL, *Administrative Patent Judge*.

ORDER

Conduct Of Proceeding
Authorizing Additional Briefing
37 C.F.R. § 42.5

On May 4, 2018, we issued an order modifying our Institution Decision (Paper 9) to include review of all challenged claims of U.S. Patent No. 7,828,767 B2 (Ex. 1001, “the ’767 patent”) on all grounds presented in the Petition. Paper 15, 3–4. We also requested that the parties meet and confer to determine whether they desired any changes to the schedule or briefing in the proceeding. *Id.* at 4. In response, Edwards Lifesciences Corporation (“Petitioner”) informed the Board on its behalf and on behalf of Patent Owner Boston Scientific Scimed, Inc., that:

- (1) Petitioner seeks leave to submit a reply brief to address the newly instituted claims and grounds; and
- (2) Patent Owner opposes Petitioner’s request to submit a reply brief, but if a reply brief is authorized, Patent Owner seeks to adopt its Preliminary Response with respect to the newly instituted claims and grounds as its Patent Owner Response.

Ex. 3001.

Typically, “[a]rguments must not be incorporated by reference from one document into another document.” 37 C.F.R. § 42.6(a)(3). Notwithstanding this provision, however, the Supreme Court’s decision in *SAS Inst., Inc. v. Iancu*, 2018 WL 1914661 (U.S. Apr. 24, 2018) has created an unusual circumstance, especially because this proceeding is at a fairly late stage. Therefore, considering the facts before us and our need to secure the just, speedy, and inexpensive resolution of this proceeding (37 C.F.R. §§ 42.1(a), 42.100(c)), we determine that it is appropriate to waive 37 C.F.R. § 42.6(a)(3) to allow this incorporation by reference. Our determination in this regard applies *only* to the newly-added challenges. *See* Paper 15.

Additionally, considering the facts before us, we determine that it is appropriate for Petitioner to be permitted to file a reply to respond to the newly-added challenges with respect to the Decision on Institution and to the arguments and evidence provided in Patent Owner's Preliminary Response, as adopted and incorporated as Patent Owner's Response with our authorization. The provisions of 37 C.F.R. § 42.23 otherwise apply. *See, e.g.,* 37 C.F.R. § 42.23(b) ("A reply may only respond to arguments made in the corresponding . . . patent owner response.").

In consideration of the foregoing, it is hereby:

ORDERED that we waive 37 C.F.R. § 42.6(a)(3) such that the arguments and evidence provided in Patent Owner's Preliminary Response (Paper 8) directed to challenges instituted on May 4, 2018 (Paper 15) are adopted and incorporated as Patent Owner's Response only as to those challenges; and,

FURTHER ORDERED that Petitioner may file a reply in response only to issues raised in either the Institution Decision (Paper 9) or Patent Owner's Preliminary Response (Paper 8) and only with respect to challenges instituted on May 4, 2018 (Paper 15), not to exceed fifteen (15) pages and due on or before June 8, 2018.

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