

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*.

FINAL WRITTEN DECISION  
*35 U.S.C. § 318(a) and 37 C.F.R. § 42.73*

## I. INTRODUCTION

Edwards Lifesciences Corporation (“Petitioner”) challenges the patentability of claims 1–12, 14, 16, and 17 of U.S. Patent No. 7,828,767 B2 (Ex. 1001, “the ’767 patent”), owned by Boston Scientific Scimed, Inc. (“Patent Owner”). We have jurisdiction under 35 U.S.C. § 6(c) to hear this *inter partes* review instituted pursuant to 35 U.S.C. § 314. In this Final Written Decision, issued pursuant to 35 U.S.C. § 318(a) and 37 C.F.R. § 42.73, we find on the record before us that Petitioner has shown by a preponderance of the evidence that claims 5, 6, 8–12, 14, 16 and 17 of the ’767 patent are unpatentable for the reasons discussed below. *See* 35 U.S.C. § 316(e).

### A. PROCEDURAL HISTORY

Petitioner filed a Petition requesting institution of *inter partes* review of claims 1–12, 14, 16, and 17 of the ’767 patent. Paper 2 (“Pet.”). Patent Owner filed a Preliminary Response. Paper 8 (“Prelim. Resp.”). We initially instituted review only of challenged claims 5, 6, 8–12, 14, 16, and 17, because we determined the Petition showed a reasonable likelihood that Petitioner would prevail as to those challenged claims on the following grounds (the “First Set of Grounds”):

Reference(s)	Basis	Claim(s) Challenged
Dlugos <sup>1</sup>	§ 102	5
Dlugos and Eskaros <sup>2</sup>	§ 103	5
Dlugos, Eskaros, and Hijlkema <sup>3</sup>	§ 103	8
Dlugos, Eskaros, and Forman <sup>4</sup>	§ 103	6, 14, and 16
Dlugos, Eskaros, and Traxler <sup>5</sup>	§ 103	9, 10, and 12
Dlugos, Eskaros, Traxler, and Forman	§ 103	11
Dlugos, Eskaros, Forman, and Becker <sup>6</sup>	§ 103	17

Paper 9 (“Inst. Dec.”); *see also* 35 U.S.C. § 314. Our Case Management and Scheduling Order set a deadline for Patent Owner to file a response to the instituted grounds of the Petition and cautioned Patent Owner that “any arguments for patentability not raised in the response will be deemed waived.” Paper 10, 6. Patent Owner did not file a response. We subsequently confirmed during a conference call with the parties on February 21, 2018, that, by not filing a response, Patent Owner waived any arguments for patentability with regard to the grounds instituted.

Paper 13, 3.

Prior to the scheduled oral argument in this case, 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 fewer than all claims challenged in the

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

<sup>2</sup> U.S. Patent App. Pub. No. 2008/0097300 A1, pub. Apr. 24, 2008 (Ex. 1011, “Eskaros”).

<sup>3</sup> U.S. Patent No. 5,853,389, iss. Dec. 29, 1998 (Ex. 1009, “Hijlkema”).

<sup>4</sup> U.S. Patent No. 5,501,759, iss. Mar. 26, 1996 (Ex. 1012, “Forman”).

<sup>5</sup> U.S. Patent App. Pub. No. 2001/0047149 A1, pub. Nov. 29, 2001 (Ex. 1013, “Traxler”).

<sup>6</sup> U.S. Patent No. 4,251,305, iss. Feb. 17, 1981 (Ex. 1014, “Becker”).

petition. 138 S. Ct. 1348, 1359–60 (2018). As explained above, prior to *SAS Inst.*, we had not instituted review on all of the challenged claims in this case. *See* Inst. Dec. 31. In accordance with *SAS Inst.*, we modified the Institution Decision to include review of all challenged claims on all grounds asserted in the Petition. Paper 15, 3–4. In particular, we further instituted review on the following additional grounds asserted in the Petition (the “Second Set of Grounds”):

Reference(s)	Basis	Claim(s) Challenged
Dlugos and Hijlkema	§ 103	1, 2, 4, 5, and 8
Dlugos, Hijlkema, and Konstantino <sup>7</sup>	§ 103	3
Dlugos, Hijlkema, and Forman	§ 103	6, 14, and 16
Dlugos	§ 103	5
Dlugos, Eskaros, and Konstantino	§ 103	7
Dlugos and Bampos <sup>8</sup>	§ 103	1

*Id.* at 4. We also permitted the parties to seek additional briefing with regard to the Second Set of Grounds. *Id.* Based upon the parties’ requests, we authorized Patent Owner to rely on the arguments it raised in its Preliminary Response as to the Second Set of Grounds in place of filing a Patent Owner response and we authorized Petitioner to file a reply only to issues raised in either the Institution Decision or Patent Owner’s Preliminary Response and only with respect to the Second Set of Grounds. Paper 16, 3. Petitioner filed a Reply in accordance with our prior authorization. Paper 17 (“Reply”). Oral argument was held before the Board on August 7, 2018. Paper 20 (“Tr.”).

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<sup>7</sup> U.S. Patent App. Pub. No. 2005/0177130 A1, pub. Aug. 11, 2005 (Ex. 1010, “Konstantino”).

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

## B. RELATED MATTERS

According to the parties, the '767 patent is asserted in the United States District Court for the Central District of California, in a case captioned *Boston Scientific Corp. and Boston Scientific Scimed, Inc. v. Edwards Lifesciences Corp.*, Civil Action No. 8:16-cv-0730 (C.D. Cal.). Pet. 72; Paper 3, 2.

## C. REAL PARTIES IN INTEREST

Petitioner identifies only itself as a real party in interest. Pet. 72. Patent Owner identifies itself and Boston Scientific Corp. as real parties in interest. Paper 3, 2.

## II. BACKGROUND

The '767 patent, titled “Balloon Design and Weld Design to Increase Ease of Re-Wrapping and Decrease Withdrawal Force,” issued November 9, 2010, from U.S. Application No. 12/129,380, filed May 29, 2008. Ex. 1001. As background information, below we provide a summary of the '767 patent and two illustrative claims from the '767 patent and we identify the proffered expert testimony.

### A. SUMMARY OF THE '767 PATENT

The '767 patent generally relates “to a balloon catheter where a balloon cylinder is folded to form pleats and then is welded directly to the catheter,” and a method of making the same. *Id.* at 2:18–24.

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