UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

EDWARDS LIFESCIENCES CORPORATION, EDWARDS LIFESCIENCES LLC, AND EDWARDS LIFESCIENCES AG
Petitioners

v.

BOSTON SCIENTIFIC SCIMED, INC.
Patent Owner

Case IPR2017-01293
Patent 8,992,608

PETITIONER'S REPLY IN SUPPORT OF MOTION FOR JOINDER PURSUANT TO 35 U.S.C. § 315(c) AND 37 C.F.R. § 42.122(b)

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Joinder of this Petition to IPR2017-00060 furthers the goals of "just, speedy, and inexpensive resolution." § 42.1(b).[1] This Petition was filed before the § 315(b) one-year bar (Pap. 3 at 6 n.1), and so would be timely even absent joinder, but if it is instituted and not joined there will be needless duplication of efforts.

The decision to grant joinder is discretionary (§ 315(c); § 42.122(a)), and motions for joinder are evaluated on a case-by-case basis. *See Samsung Elecs. Co. v. Va. Innovations Scis., Inc.*, IPR2014-00557, Pap. 10 at 15-16 (June 13, 2014); Pap. 7 at 3. Under the facts and circumstances here, joinder will reduce the burdens on all involved.

I. This Is Not a "Second Bite at the Apple"

Joinder may be denied where a second petition merely "use[s a previous] Decision to Institute . . . as a guide to remedy deficiencies in the earlier filed petition, i.e., a 'second bite at the apple.'" *Samsung Elecs. Co. v. Affinity Labs of Texas, LLC*, IPR2015-00820, Pap. 12 at 4 (May 15, 2015). Here, however, this Petition asserts two ***new*** grounds based entirely on art not asserted in IPR2017-00060 and addresses additional claims not at issue there (Claims 5-9).[2] By definition, this

[1] Section citations are to 37 C.F.R. or 35 U.S.C. as the context indicates.

[2] Because the argument for Claims 5-9 in Ground 1 of the instant petition is the same for Claims 1-4, it is efficient to consider all claims here.

is not a "second bite at the apple," as Patent Owner ("PO") implicitly acknowledges: "There is absolutely no overlap between Petitioner's arguments or the art asserted." *Contrast* Pap. 7 at 9 & *id.* at 2 *with* § 325(d) (may consider whether "substantially the same prior art or arguments" previously presented).

Further, this Petition is not time-barred, so Petitioner is not precluded from separately pursuing both petitions (*see* §§ 315(d), 325(d)), unlike in the cases PO cites to argue joinder should be denied if art could have been included in an earlier petition (Pap. 7 at 6).

II. Joinder Will Not Prejudice Patent Owner

PO complains of "undu[e] prejudice" from joinder because there are "two new grounds of unpatentability" based on "four [new] references" and "challenges [to] ***five*** new claims." Pap. 7 at 9 (emph. orig.); *id.* at 10. But joining these two petitions would clearly be *more efficient than pursuing them both in parallel* (the alternative here): PO ignores that denying joinder would actually *increase* the work required. And PO's suggestion that granting joinder would set bad precedent (*id.* at 13) ignores both the actual circumstances here and that joinder motions are decided case-by-case. Finally, PO's suggestion that any joinder motion can be defeated just by showing a joined proceeding would involve more grounds (and thus more effort) proves too much: *any* joinder of non-identical petitions has this result.

A. Patent Owner Overstates the Impact on Discovery

First, as noted above, PO ignores that this timely-filed Petition could pro-

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