Trials@uspto.gov
571.272.7822

Paper No. 12
Filed: March 25, 2019

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 IPR2017-01294
Patent 6,371,962 B1

Before JAMES T. MOORE, JAMES A. TARTAL,
and AMANDA F. WIEKER, *Administrative Patent Judges*.

MOORE, *Administrative Patent Judge*.

DECISION ON REHEARING
37 C.F.R. § 42.71

A. Background

Edwards Lifesciences Corporation ("Petitioner") filed a corrected Petition requesting an *inter partes* review of claims 1–3, 6–13, 20–22, 25–30, 35, and 36 ("the challenged claims") of U.S. Patent No. 6,371,962 B1 (Ex. 1001, "the '962 patent"). Paper 8 ("Pet"), 1. Boston Scientific Scimed, Inc. ("Patent Owner") filed a Preliminary Response. Paper 9 ("Prelim. Resp."). We denied institution October 25, 2017. Paper 10 ("Dec."). Petitioner timely filed a request for rehearing. Paper 11.

B. The Request for Rehearing

Petitioner requests partial reconsideration of the Board's decision to deny institution. Paper 11, 3. Specifically, Petitioner asserts that the Board overlooked corresponding structure for the means plus function limitation of claim 20. *Id.*

C. Standard for Rehearing

When reconsidering a decision on institution, the Board reviews the decision for an abuse of discretion. *See* 37 C.F.R § 42.71(c). An abuse of discretion occurs if a decision is based on an erroneous interpretation of law, if a factual finding is not supported by substantial evidence, or if the decision represents an unreasonable judgment in weighing relevant factors. *See Star Fruits S.N.C. v. United States*, 393 F.3d 1277, 1281 (Fed. Cir. 2005); *Arnold P'ship v. Dudas*, 362 F.3d 1338, 1340 (Fed. Cir. 2004); *In re Gartside*, 203 F.3d 1305, 1315–16 (Fed. Cir. 2000). "The burden of showing a decision should be modified lies with the party challenging the decision." 37 C.F.R § 42.71(d); *accord* Office Patent Trial Practice Guide, 77 Fed. Reg. 48,756, 48,768 (Aug. 14, 2012).

In its request for rehearing, the dissatisfied party must, in relevant part, "specifically identify all matters the party believes the Board misapprehended or overlooked, and the place where each matter was previously addressed." 37 C.F.R. § 42.71(d); Office Patent Trial Practice Guide, 77 Fed. Reg. at 48,768. We address Petitioner's arguments with these principles in mind.

D. Analysis

Claim 20 reads as follows:

> 20. A balloon catheter for intraluminal delivery of a stent, the catheter comprising a shaft having a diameter, a balloon associated with a distal portion of the shaft for receiving a stent, the stent having a first end and a second end and a contracted state and an expanded state, and ***means for inflating the balloon,*** the shaft including at least one mounting body radially carried on the shaft inside the balloon, whereby the diameter of the shaft is increased inside the balloon to facilitate mounting and retaining of a stent to the catheter over the balloon, the at least one mounting body being positioned on the shaft such that when the stent is loaded onto the ***inflatable means*** and the shaft in the stent's contracted state at least a portion of the at least one mounting body is under the stent and between the first and second ends of the stent, the at least one mounting body having a length and an outer surface diameter, wherein the outer surface diameter is substantially constant along the length.

Ex. 1001 6:14–30 (emphases added).

Petitioner is of the view that only the first emphasized means recited is a "means plus function" element – the "means for inflating the balloon." Paper 11, 3. Contained in a footnote is the argument that:

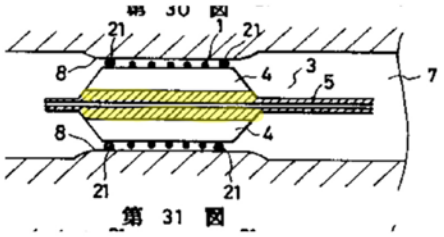
> [w]hile claim 20 does recite an "inflatable means," this appears to be a claim drafting error. There is no antecedent basis for the "inflatable means" in the claim language. Instead, in the context of the preceding claim language referencing "a balloon … for receiving the stent," it is obvious that 'inflatable means' should read 'balloon.' *See, e.g., CBT Flint Partners, LLC v. Return Path, Inc.*, 654 F.3d 1353, 1358 (Fed. Cir. 2011) (holding under the *Phillips* standard 'a district court may correct an obvious error in a patent claim'). Taken in context, this limitation should therefore read "when the stent is loaded onto the [balloon]," which should be given its plain and ordinary meaning.

Paper 11, 5 fn. 2.

Petitioner does not inform us where this argument was made or this position was previously asserted. In an abundance of caution, we have carefully reviewed the Petition for this argument, and find it to be absent.

For example, at page 46, dealing with this precise term, the Petition merely says "*See* 1.3." Paper 8, 46. At 1.3, the following argument is made, and reproduced in its entirety:

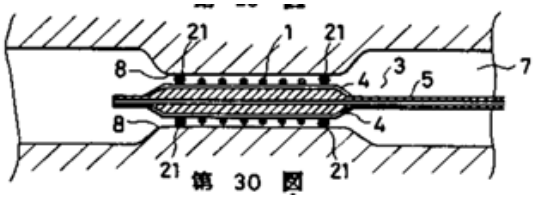
> As seen in annotated Figure 31 below, Olympus's has a length and an outer surface diameter, increasing the diameter of the shaft at the distal part for facilitating the mounting and retaining of the stent. *See* Ex. 1015 (Olympus) at 7.



第 31 図

> As seen in Figure 30 below, Olympus discloses that a majority of the mounting body is located under the stent, and between the stent and the shaft. *See* Ex. 1015 (Olympus) at 7. The compacted stent is mounted directly against the mounting body for delivery to the treatment site. (*See id.* at 7.) This allows the stent to be secured with less crimping, and therefore less risk of deformation, as well as

allowing for a reduced diameter of the remainder of the catheter shaft, thereby improving the overall trackability and flexibility of the delivery system. Ex. 1003 (Trotta Decl.), ¶¶51, 54, 122



第 30 図

To the extent that "carried on the shaft" requires the mounting body to be a separate component rather than integral with the shaft, this configuration was a well known design choice in catheter construction. Ex. 1003 (Trotta Decl.), ¶¶ 115-117. Furthermore, Burton expressly teaches that a mounting body surrounding the catheter shaft may be made as a separate sleeve or as an integral piece. *See* Ex. 1014 (Burton) at 2:21-23 ("[S]aid grip member being an integral portion of the core *or* a sleeve or coating attached around the periphery of the core."), claim 7. Although Olympus does not expressly name the mounting body structure, a POSITA would understand the purpose of this structure as aiding in the securement of the stent. As seen in Figure 30 below, the compacted stent is mounted directly against the mounting body for delivery to the treatment site. *See* Ex. 1015 (Olympus) at 7. This allows the stent to be secured with less crimping, and therefore less risk of deformation, as well as allowing for a reduced diameter of the remainder of the catheter shaft, thereby improving the overall trackability and flexibility of the delivery system. Ex. 1003 (Trotta Decl.) ¶¶122-24.

Pet. 38–40.

We have not found any location in which the language "inflatable means" is addressed to the Board, nor its meaning. As noted in our previous decision, our Rules require that if a challenged claim contains a means plus function limitation under 35 U.S.C. § 112 ¶ 6, Petitioner is required to construe the limitation and "***must*** identify the specific portions of the

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