

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

**PETITIONER'S REQUEST FOR REHEARING UNDER 37 C.F.R. § 42.71
ON THE DECISION NOT TO INSTITUTE *INTER PARTES* REVIEW**

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I. INTRODUCTION

Petitioner Edwards Lifesciences Corporation requests partial reconsideration of the Board’s Decision in Paper 10 (“Decision”) to deny its petition for *inter partes* review of US Pat. No. 6,371,962 B1 (the “’962 Patent”).¹

The basis of Edwards’ request is straightforward. The Board rested its determination on the failure of the Petition to set forth structures in the specification that correspond to the functions recited in three claim limitations that the Board reads to be stated in means-plus-function format. With respect to two of those three terms, the Board is correct – the Petition does not set forth corresponding structure. But with respect to the third limitation, a “means for inflating the balloon,” the Petition clearly does state the corresponding structure. Edwards respectfully submits that the Board may have inadvertently overlooked Edwards’ submission in this regard. Since this third limitation is the only means-plus-function limitation of independent claim 20, and since Ground 3 of the Petition provides compelling evidence that claim 20 and certain of its dependent claims are invalid over the Ravenscroft reference, Edwards further submits that but for this oversight, the Board would have granted institution of review claim 20 and its dependents.

¹ Prior art and other abbreviations are those used in the Petition and the Decision.

II. RELIEF REQUESTED

Petitioner requests a rehearing of the Decision and institution of an *Inter Partes* Review (“IPR”) with respect to Ground 3 and challenged claims 20 through 22 and 30.

III. STANDARD OF REVIEW

Under 37 C.F.R. § 42.71(c), “[w]hen rehearing a decision on petition, a panel will review the decision for an abuse of discretion.” An abuse of discretion occurs when a “decision was based on an erroneous conclusion of law or clearly erroneous factual findings, or ... a clear error of judgment.” *PPG Indus. Inc. v Celanese Polymer Specialties Co. Inc.*, 840 F.2d 1565, 1567 (Fed. Cir. 1988) (citations omitted). The request must “specifically identify all matters the party believes the Board misapprehended or overlooked and the place where each matter was previously addressed in a motion, an opposition, or a reply.” 37 C.F.R. § 42.71(d).

IV. ARGUMENT

The ’962 patent is directed to a delivery system for a balloon-expandable stent. In its petition, Edwards states five grounds for *inter partes* review. Edwards here does not revisit any of Grounds 1, 2, 4 or 5.

Ground 3 asserts that the Ravenscroft reference, U.S. Patent No. 5,702,418 (Ex. 1017) anticipates independent claims 1 and 20, plus various dependent claims.

This request for rehearing is directed to the application of Ravenscroft solely to claim 20 and its dependent claims 21, 22, and 30.

A. The Board Overlooked the Petition’s Construction of the “means for inflating the balloon” Limitation

As the Board notes, the claims of the ’962 patent together encompass three limitations that incorporate the word “means”: “expandable inflatable means,” “mounting and retaining means,” and “means for inflating the balloon.”

As to the first two terms, Edwards adopted Patent Owner’s litigation position that section 112(f) did not apply. Accordingly, Edwards did not identify in its Petition the specification structures that correspond to these limitations. The Board declined to accept the parties’ position that section 112(f) did not apply. Accordingly, the Board determined that it lacked the analysis required in order to assess the applicability of the art to the claims and review of the claims in which these terms appear, claim 1 and its dependents, was impossible. Edwards does not seek reconsideration of this portion of the Board’s decision.

The final term, “ means for inflating the balloon,” appears only in claim 20, reproduced below:

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

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