

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 IPR2017-01295
Patent 8,709,062 B2

Before JAMES A. TARTAL, ROBERT L. KINDER, and
AMANDA F. WIEKER, *Administrative Patent Judges*.

WIEKER, *Administrative Patent Judge*.

Conduct of the Proceeding
37 C.F.R. § 42.5

On April 24, 2018, the Supreme Court held that a final written decision under 35 U.S.C. § 318(a) must decide the patentability of all claims challenged in the petition. *SAS Inst., Inc. v. Iancu*, 2018 WL 1914661, at *10 (U.S. Apr. 24, 2018). In our Decision on Institution, we determined that Petitioner demonstrated a reasonable likelihood that it would establish that at least one of the challenged claims of the '062 patent is unpatentable. Paper 9, 33–34. Pursuant to the holding in *SAS*, we modify our Decision on Institution to institute on all of the challenged claims and all of the grounds presented in the Petition.

As set forth in our Scheduling Order, Petitioner's Reply is currently due on May 1, 2018. Paper 10, 7. This Order, however, introduces new claims and grounds into this proceeding, which were not addressed in Patent Owner's Response. *See* Paper 15. Accordingly, we postpone the due date for Petitioner's Reply.

The parties are to meet and confer to discuss their positions with respect to the impact of *SAS* on this proceeding. The parties should discuss their proposals to accommodate the addition of claims and grounds into this proceeding, and shall endeavor to reach agreement and develop a joint proposal. For example, the parties should discuss whether Patent Owner desires to supplement its Patent Owner Response to address these claims and grounds, when such a submission would be filed, and to how many pages such a submission would be limited. In such a circumstance, the parameters of Petitioner's Reply should also be discussed.

Furthermore, the parties should discuss any proposed changes to the Scheduling Order needed to achieve the parties' proposals, with the aim of

concluding this proceeding within the twelve-month timeframe established by statute.

After conferring, the parties must, within five (5) business days of the date of this Order, submit a proposal (or, if the parties do not agree on a joint proposal, the parties must submit their respective proposals) in an email to the Board, in which the parties also request a conference call to seek authorization for such changes or briefing. The parties' email must include proposed times for such a call, when both parties are available.

In consideration of the foregoing, it is hereby:

ORDERED that, pursuant to 35 U.S.C. § 314(a), we modify our Decision on Institution to include review of all challenged claims and all grounds presented in the Petition;

FURTHER ORDERED that the due date for Petitioner's Reply is postponed; and

FURTHER ORDERED that Petitioner and Patent Owner shall confer to determine whether they desire any changes to the schedule or briefing, and, if so, shall provide their proposals and request a conference call with the panel to seek authorization for such changes or briefing within five (5) business days of the date of this Order.

IPR2017-01295
Patent 8,709,062 B2

PETITIONER:

A. James Isbester
KILPATRICK TOWNSEND & STOCKTON LLP
jisbester@kilpatricktownsend.com

Craig S. Summers
Joshua Stowell
KNOBBE, MARTENS, OLSON & BEAR, LLP
2css@knobbe.com
Joshua.Stowell@knobbe.com

PATENT OWNER:

Wallace Wu
Jennifer A. Sklenar
Nicholas M. Nyemah
ARNOLD & PORTER KAYE SCHOLER LLP
Wallace.Wu@apks.com
Jennifer.Sklenar@apks.com
Nicholas.Nyemah@apks.com