

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 IPR2017-01295  
Patent 8,709,062 B2

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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 May 9, 2018, a conference call was held between Administrative Patent Judges Tartal, Kinder, and Wieker; counsel for Petitioner, Mr. James Isbester and Mr. Joshua Stowell; and counsel for Patent Owner, Mr. Wallace Wu. The conference call was held to discuss any requested changes to the schedule for this proceeding, resulting from our Order modifying the Decision on Institution to include all claims and grounds presented in the Petition (“the newly-added challenges,” i.e., the Petition’s Ground 1 and Ground 2; *see* Pet. 20–78). Paper 17, 2. Pursuant to our Order, the parties met and conferred but had not reached agreement as to whether any changes to the briefing schedule are warranted.

In this proceeding, Patent Owner filed its Patent Owner Response on January 31, 2018. Paper 15. During the conference call, Mr. Wu stated that Patent Owner was not inclined to supplement its Response to address the newly-added challenges and, accordingly, Petitioner should not be permitted to address those newly-added challenges in its Reply. Mr. Wu stated that the U.S. Supreme Court’s decision in *SAS Inst., Inc. v. Iancu*, 2018 WL 1914661 (U.S. Apr. 24, 2018) does not give Petitioner an opportunity to correct defects in its Petition. Mr. Wu also expressed concern that supplemental briefing may impact the Board’s ability to render a Final Written Decision within the twelve-month timeframe established by statute. Mr. Wu was not prepared to state whether Patent Owner would like to supplement its Response if the Board allows Petitioner an opportunity to address the newly-added challenges.

For Petitioner, Mr. Isbester requested that Petitioner be afforded an opportunity to respond, in its Reply, to the arguments made by Patent Owner

in the Preliminary Response (Paper 8) and to the preliminary findings and conclusions made by the Board in the Decision on Institution (Paper 9), with respect to the newly-added challenges.

The Board considered the parties' positions and indicated its intention to allow Petitioner to address, in its Reply, the newly-added challenges. *See* 35 U.S.C. § 316(a)(13) ("providing the petitioner with at least 1 opportunity to file written comments within a time period"). As such, the Board instructed Mr. Wu to consult with Patent Owner to determine whether Patent Owner would like to file a supplemental Patent Owner's Response to address the newly-added challenges, before Petitioner files its Reply. The Board counseled Mr. Wu that any arguments not made in a Patent Owner Response generally are deemed waived. *See* Paper 10, 3 ("[A]ny arguments for patentability not raised in the response will be deemed waived."). Therefore, the Board suggested that Patent Owner consider whether it would like to file a supplemental paper to reiterate its arguments made in the Preliminary Response, and to provide that response to the Board.

On May 10, 2018, Mr. Wu informed the Board by email that "Patent Owner submits that, in the event that Petitioner is permitted to address the newly instituted claims and grounds in its Reply, Patent Owner hereby supplements its January 31, 2018 Response by incorporating by reference its August 9, 2017 Preliminary Response with respect to the newly instituted claims and grounds." Ex. 3001.

We understand Patent Owner's response to be a request to incorporate into its Patent Owner Response (Paper 15) the arguments and evidence provided with its Preliminary Response (Paper 8), as directed to the newly-

instituted claims and grounds. Typically, “[a]rguments must not be incorporated by reference from one document into another document.” 37 C.F.R. § 42.6(a)(3). Notwithstanding this provision, however, the Supreme Court’s decision in *SAS* has created an unusual circumstance, especially because this proceeding is at a fairly late stage. Therefore, considering the facts before us and our need to secure the just, speedy, and inexpensive resolution of this proceeding (37 C.F.R. §§ 42.1(a), 42.100(c)), we determine that it is appropriate to waive 37 C.F.R. § 42.6(a)(3) to allow this incorporation by reference. Our determination in this regard applies *only* to the newly-added challenges. *See* Paper 17.

Additionally, considering the facts before us, we determine that it is appropriate for Petitioner, in its Reply, to be permitted to respond to both the Decision on Institution and the arguments and evidence provided in Patent Owner’s Preliminary Response, with respect to the newly-added challenges. The provisions of 37 C.F.R. § 42.23 otherwise apply. *See, e.g.*, 37 C.F.R. § 42.23(b) (“A reply may only respond to arguments made in the corresponding . . . patent owner response.”).

In Paper 17, we postponed the due date for Petitioner’s Reply. Accordingly, we amend our Scheduling Order (Paper 10) such that DUE DATE 2 is rescheduled to June 15, 2018. All other dates remain as scheduled. As noted in the Scheduling Order, the parties may stipulate to adjust DUE DATES 1–5. Paper 10, 2.

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In consideration of the foregoing, it is hereby:

ORDERED that we waive 37 C.F.R. § 42.6(a)(3) such that the arguments and evidence provided in Patent Owner's Preliminary Response (Paper 8), and directed to the newly-added challenges, are incorporated into Patent Owner's Response (Paper 15);

FURTHER ORDERED that DUE DATE 2 is amended to June 15, 2018; and

FURTHER ORDERED that Petitioner's Reply may respond to our Decision on Institution (Paper 9) and Patent Owner's Preliminary Response (Paper 8), with respect to the newly-added challenges.

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