

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 IPR2017-01297
Patent 6,712,827 B2

Before JAMES A. TARTAL, MICHAEL L. WOODS, and
ROBERT L. KINDER, *Administrative Patent Judges*.

WOODS, *Administrative Patent Judge*.

DECISION

Denying Institution of *Inter Partes* Review
37 C.F.R. § 42.108

I. INTRODUCTION

Edwards Lifesciences Corporation (“Petitioner”) filed a Petition (Paper 2, “Pet.”) requesting *inter partes* review of claims 1–3 and 5–20 of U.S. Patent No. 6,712,827 B2 (“the ’827 patent”). Pet. 1. Boston Scientific Scimed, Inc. (“Patent Owner”) filed a Preliminary Response (Paper 10, “Prelim. Resp.”) in response to the Petition, contending that the Petition should be denied as to all challenged claims. Prelim. Resp. 1.

We have jurisdiction under 37 C.F.R. § 42.4(a) and 35 U.S.C. § 314, which provides that an *inter partes* review may not be instituted unless the information presented in the Petition “shows that there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.” Having considered the arguments and the evidence presented, for the reasons described below, we do not institute an *inter partes* review of any of the challenged claims.

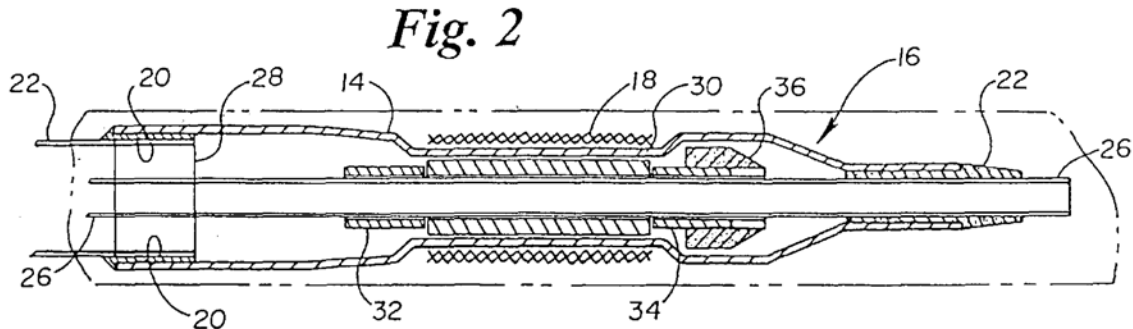
A. *Related Proceedings*

Petitioner represents that the ’827 patent is at issue in *Boston Scientific Corp. & Boston Scientific SciMed Inc. v. Edwards Lifesciences Corp.*, No. 16-cv-730 (C.D. Cal.). Pet. 82.

B. *The ’827 Patent (Ex. 1001)*

The ’827 patent, titled “Stent Delivery System,” is “directed to improved arrangements for releasably attaching [a] stent.” Ex. 1001, 2:11–13. The ’827 patent describes that the “stent is held in place on [a] catheter by means of an enlarged body carried by the catheter shaft within [a] balloon[,] to which the stent and balloon are fitted.” *Id.* at 2:14–16.

To illustrate an embodiment of the '827 patent's catheter, we reproduce Figure 2 of the '827 patent, below:



According to the '827 patent, Figure 2 depicts a stent delivery system with balloon 14 at distal end portion 16 of a balloon catheter. *Id.* at 2:47–49. The '827 patent further describes mounting body 30 within balloon 14 “to provide a cushion and/or substrate of enlarged diameter . . . to support and hold the stent [18] and secure it during crimping and the delivery procedure.” *Id.* at 3:33–37. Mounting body 30 is cylindrical in form and takes the shape of a sleeve carried on inner lumen 26. *Id.* at 3:41–43. Mounting body 30 is preferably made of an elastomer material, and more preferably, a resilient elastomer material, such as lower durometer silicone. *Id.* at 3:55–59. In operation, the catheter is advanced and positioned through a patient’s vasculature until the stent is adjacent to the portion of the vessel where treatment is desired. *Id.* at 3:65–4:2. Once positioned, balloon 14 is inflated to expand stent 18 to a desired diameter, after which balloon 14 is deflated and the catheter is removed, leaving stent 18 in place. *Id.* at 4:2–5.

C. Illustrative Claim

Claims 1, 16, and 17 are independent, with claims 2–15 depending from claim 1, and claims 18–20 depending from claim 17. *Id.* at 4:56–6:47.

Claim 1 is illustrative of the subject matter at issue and is reproduced below, with emphases and indentations added for clarity in our Decision:

1. A balloon catheter for dilating vascular constrictions and for simultaneously introducing a deformable stent into a vessel to be dilated in order to stabilize the vessel in the dilated condition, wherein a distal region of the catheter, which is intended to receive the deformable stent, comprises:

an inner tube that is surrounded and crimped onto by the deformable stent;

a balloon arranged between the deformable stent and the inner tube;

a pair of longitudinally spaced image sensitive marking sleeves carried on the inner tube within the balloon such that there is a longitudinal space on the inner tube extending between the pair of marking sleeves and such that the deformable stent is substantially centered there-between;

an outer tube disposed between the inner tube and the balloon as an intermediate layer,

wherein the intermediate layer substantially covers the longitudinal space on the inner tube between the image sensitive marking sleeves,

the intermediate layer having an outer diameter,

wherein the outer diameter of the intermediate layer is substantially constant between the pair of marking sleeves.

Id. at 4:56–5:7 (emphases and indentations added).

D. References Relied Upon

The Petitioner relies in relevant part on the following references:

Name	Reference	Ex. No.
Olympus	Japanese Pub. No. H4-64367, published Feb. 28, 1992, including its English translation	Ex. 1015
Burton	US 5,026,377, issued June 25, 1991	Ex. 1014
Fischell '507	US 4,768,507, issued Sept. 6, 1998	Ex. 1010
Fischell '274	US 5,639,274, issued June 17, 1997	Ex. 1013
Williams	US 5,437,083, issued Aug. 1, 1995	Ex. 1024
Jendersee	US 5,836,965, issued Nov. 17, 1998	Ex. 1016

E. Alleged Grounds of Unpatentability

Petitioner contends that claims 1–3 and 5–20 of the '580 patent are unpatentable under the following grounds:

References	Basis	Claims
Olympus, Burton, Fischell '507, Fischell '274, Williams, and knowledge of a person of ordinary skill in the art	§ 103(a)	1–3, 5–14, and 16–20
Fischell '274, Burton, Williams, and knowledge of a person of ordinary skill in the art	§ 103(a)	1–3, 5, 7–9, 11–14, and 16–20
References relied on in the above grounds and further in view of Jendersee	§ 103(a)	13 and 15

Pet. i–ii.¹

Petitioner also relies on the declaration testimony of Thomas Trotta (Ex. 1003) in support of its Petition.

¹ The Petition appears to lack the particularity and specificity required by 35 U.S.C § 312(a)(3) and 37 C.F.R. § 42.104(b)(2). Petitioner's allegation that the challenged "claims are taught by the references identified below, alone or in combination with each other" (*see* Pet. 30) and Petitioner's identification of the grounds as outlined above, amounts to multiple distinct combinations of references. *See also id.* at 31 (the ground based on Olympus, Burton, Fischell '507, Fischell '274, Williams, and knowledge of a person of ordinary skill in the art), 59 (the ground based on Fischell '274, Burton, Williams, and knowledge of a person of ordinary skill in the art), and 79 (the ground based on the first two grounds and further in view of Jendersee). The function of the Board is not to comb through Petitioner's arguments in order to decipher the strongest argument or to determine the strongest combination of references to challenge the claims. *See generally LG Elecs., Inc. v. Rosetta-Wireless Corp.*, Case IPR2016-01516 (PTAB Apr. 3, 2017) (Paper 25). As such, for each identified ground, we exercise our discretion and consider all of the references in combination as one ground of unpatentability, as this is the most consistent reading of the Petition and claim charts.

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