

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 IPR2017-01298  
Patent 7,749,234 B2

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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, 5–8, 13, 15, and 18–20 of U.S. Patent No. 7,749,234 B2 (“the ’234 patent”). Pet. 1. Boston Scientific Scimed, Inc. (“Patent Owner”) filed a Preliminary Response (Paper 7, “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 ’234 patent is at issue in *Boston Scientific Corp. & Boston Scientific SciMed Inc. v. Edwards Lifesciences Corp.*, No. 16-cv-730 (C.D. Cal.). Pet. 87.

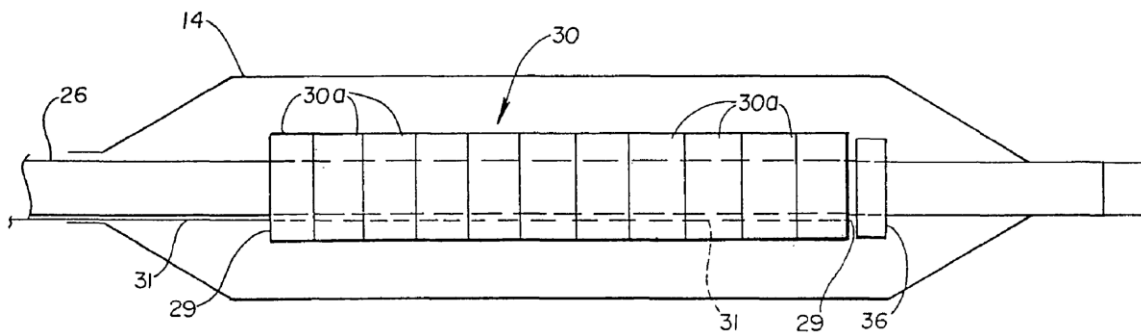
### B. *The ’234 Patent (Ex. 1001)*

The ’234 patent, titled “Catheter Support for Stent Delivery,” is “directed to improved arrangements for catheters of reduced profile for performing angioplasty and for releasably attaching the stent to the catheter to facilitate delivery thereof.” Ex. 1001, 1:64–67. The ’234 patent describes that the “stent is held in place on [a] catheter by means of an enlarged

mounting body carried within the balloon by the catheter shaft to which the stent and balloon are fitted.” *Id.* at 2:29–32.

During prosecution of the ’234 patent, the applicant elected the species of Figure 6. Ex. 1002, 97 (“Applicant hereby elects Species 3 (Figure 6).”). To illustrate the elected catheter, we reproduce Figure 6 of the ’234 patent, below:

*Fig. 6*



According to the ’234 patent, Figure 6 depicts an “embodiment of the invention with a mounting body positioned to receive a stent but with a stent not yet mounted.” Ex. 1001, 3:8–10. In particular, the ’234 patent describes “a cylindrical mounting body 30 made up of a plurality of separate adjacent rings 30a held together by wire 31 which extends therethrough as shown with stops 29 to secure the rings together.” *Id.* at 5:32–36. The ’234 patent further describes mounting body 30 as preferably being made of an elastomer material, and more preferably, a resilient elastomer material, such as lower durometer silicone. *Id.* at 5:4–8. 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 5:15–18. Once positioned, balloon 14 is inflated to expand the stent to a desired

diameter, after which balloon 14 is deflated and the catheter is removed, leaving the stent (not shown) in place. *Id.* at 5:18–22.

*C. Illustrative Claim*

Claim 1 is the sole independent claim. Ex. 1001, 7:61–10:7. Claim 1 is also illustrative of the subject matter at issue and is reproduced below, with emphases added to particular limitations addressed in our Decision:

1. A stent delivery catheter comprising:
  - an inner shaft, the inner shaft having a proximal portion and a distal portion and a center axis,
  - an inflatable medical balloon positioned about the distal portion of the inner shaft, the medical balloon having an expanded state, a contracted state, a proximal end and a distal end, wherein the medical balloon can be expanded from its contracted state to its expanded state, and
    - at least one mounting body secured to the inner shaft, inside the medical balloon and around the center axis, the mounting body having a length, a circumferential surface, wherein the circumferential surface is a surface of the mounting body that is outermost relative to the center axis and that faces radially away from the center axis and toward the medical balloon, and having at least one separation in the circumferential surface, wherein the at least one separation is exposed to a portion of the medical balloon which is located along a radial line which extends from the center axis and through the separation, the at least one separation being a circumferential separation, wherein the mounting body is formed of a material which resiliently deforms under radial pressure.*

*Id.* at 7:61–8:17 (emphases 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. 1027
Sugiyama	US 4,994,032, issued Feb. 19, 1991	Ex. 1009
Ravenscroft	US 5,702,418, issued Dec. 30, 1997	Ex. 1017

*E. Alleged Grounds of Unpatentability*

Petitioner contends that claims 1–3, 5–8, 13, 15, and 18–20 of the '234 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, 5–8, 13, 15, and 18–20
Fischell '274, Burton, Williams, and knowledge of a person of ordinary skill in the art	§ 103(a)	1–3, 5, 13, 15, and 18–20
Sugiyama, Fischell '507, Williams, and knowledge of a person of ordinary skill in the art	§ 103(a)	1, 6–8, 13, 15, and 18–20
Ravenscroft, Williams, and knowledge of a person of ordinary skill in the art	§ 103(a)	1–3, 5, 13, 15, 19, and 20

Pet. i.<sup>1</sup>

<sup>1</sup> 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 following references, alone or in combination with each other" (*see* Pet. 24–25) and Petitioner's identification of the grounds as outlined above, amounts to multiple distinct combinations of references. *See also id.* at 26 (the ground based on Olympus, Burton, Fischell '507, Fischell '274, Williams, and knowledge of a person of ordinary skill in the art), 47 (the ground based on Fischell '274,

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