

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

EDWARDS LIFESCIENCES CORPORATION AND
EDWARDS LIFESCIENCES LLC,
Petitioner,

v.

AORTIC INNOVATIONS, INC.,
Patent Owner.

IPR2021-01527, Patent 10,792,172 B2
IPR2021-01584, Patent 10,857,011 B2
IPR2022-00034, Patent 10,966,846 B2
IPR2022-00193, Patent 10,881,538 B1¹

Before JOHN G. NEW, JASON W. MELVIN, and RYAN H. FLAX,
Administrative Patent Judges.

PER CURIAM.

ORDER

Denying Patent Owner's Motion Seeking Authorization to File
Supplemental Material and Briefing
37 C.F.R. § 42.123

¹ The combined caption is for administrative convenience only and does not indicate a joined case or an expanded panel. The parties are not authorized to use this caption absent express permission of the Board.

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On December 19, 2022, the Board received an email from Patent Owner seeking authorization to file supplemental information and briefing in these IPRs.² *See, e.g.*, IPR2021-01527, Ex. 3002. Specifically, Patent Owner sought to introduce as an exhibit Dehdashtian et al. (US 6,663,667 B2, December 16, 2003) (“Dehdashtian”) and Spenser et al. (US Appl. Ser. No. 2006/0004442 A1, January 5, 2006) (the “442 application”). Patent Owner stated that it had become aware of these references on December 9 and 10, 2022, respectively. Patent Owner also sought supplemental briefing in support of these filings. Patent Owner represented that Petitioner opposed these supplemental Exhibits and briefing.

In a follow-up email to the Board, Patent Owner also sought authorization to file as an exhibit the transcript of the second deposition of its expert, Dr. Nigel P. Buller (filed as Ex. 2104 in the related IPR2022-00556 (the “Second Buller Deposition”)). *See, e.g.*, IPR2021-01527, Ex. 3003.

A telephone conference was held between the panel and counsel for both parties on Wednesday, December 21, 2022 at 3:00 pm EST. A transcript of the conference was taken and has been entered into the record. *See, e.g.*, IPR2021-01527, Ex. 2115 (“Hearing Transcr.”).

During the conference, Patent Owner represented that Dehdashtian is assigned to Petitioner, and that Mr. Dehdashtian is an author of Walther

² Patent Owner originally attempted to contact the Board *via* an incorrect email mailbox, with the result that the panel did not receive Patent Owner’s email request until December 19, 2022, after oral argument in these *inter partes* reviews had been conducted on December 15, 2022.

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(Ex. 1007) and an inventor of Spenser II (Ex. 1011). Hearing Transcr. 6. In particular, Patent Owner represented that there was reason to believe that Mr. Dehdashtian was the author of Figure 22 of Spenser II, which it stated is of particular relevance to the parties' arguments in these *inter partes* reviews. *Id.* at 6–7.

Patent Owner argued further that the Second Buller Deposition should also be admitted as being relevant to its arguments as presented both in the Patent Owner's Response (IPR2022-00034, Paper 24) and at oral argument. Patent Owner further contended that, because the Second Buller Deposition transcript has been entered as an exhibit in the related IPR2022-00556, entering it in the record of these proceedings would ensure consistency of the record. Hearing Transcr. 11, 20–21.

Petitioner responded that Dehdashtian and the '442 application have been publicly available for many years, and that the Second Buller Deposition was taken on November 11, 2022, and transcript thereof was available to Patent Owner shortly afterwards. Hearing Transcr. 13–14. Petitioner contended that Patent Owner has failed to make a showing of why this supplemental information could not reasonably have been obtained earlier by Patent Owner, as required by 37 C.F.R § 42.123(b). *Id.* at 14. Petitioner also disagreed with Patent Owner's characterization that either document is relevant to any of the Grounds stated in the Petition. *Id.* at 15.

Section 42.123(b) states that:

A party seeking to submit supplemental information more than one month after the date the trial is instituted, must request authorization to file a motion to submit the information. The motion to submit supplemental information must show why the

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supplemental information reasonably could not have been obtained earlier, and that consideration of the supplemental information would be in the interests-of-justice.

We agree with Petitioner that Patent Owner, in seeking to file exhibits and briefing as supplemental information more than one month after trial was instituted (and days before oral argument was conducted) has failed to make a showing of why documents that have been publicly available for more than fifteen years, or a deposition transcript that had been in Patent Owner's possession for a month, could not reasonably have been obtained and entered into the record earlier. We consequently determine that Patent Owner's Request to file Dehdashtian, the '442 application, and the transcript of the Second Buller Deposition is untimely, and Patent Owner's request for authorization to file the supplemental information is DENIED.

It is therefore:

ORDERED that Patent Owner's motion seeking authorization to file supplemental information is DENIED.

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