

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

COOK GROUP INCORPORATED
and
COOK MEDICAL LLC,
Petitioner,

v.

BOSTON SCIENTIFIC SCIMED, INC.,
Patent Owner.

Case IPR2017-00134
Patent 8,709,027 B2

Before JAMES T. MOORE, JAMES A. TARTAL,
and ROBERT L. KINDER, *Administrative Patent Judges*.

MOORE, *Administrative Patent Judge*.

DECISION GRANTING REHEARING

I. INTRODUCTION

Cook Group Incorporated and Cook Medical LLC (“Petitioner”) filed a Petition (Paper 1, “Pet.”) to institute an *inter partes* review of claims 1–20, of U.S. Patent No. 8,709,027 B2 (Ex. 1001, “the ’027 patent”). Boston Scientific Scimed, Incorporated (“Patent Owner”) filed a Preliminary Response (Paper 6, “Prelim. Resp.”). We instituted review of claims 1–19 on a single ground, specifically that these claims are likely unpatentable as obvious based on Sackier and Nishioka. Paper 7 (“Institution Decision” or “Inst. Dec.”). We did not institute review of claim 20. Petitioner seeks rehearing of that decision. Paper 10 (“Request for Rehearing” or “Reh’g Req.”).

Because we erred, rehearing of the decision on institution is GRANTED. Because we have reconsidered the scope of Claim 20, the relief sought is GRANTED. Petitioner has established a reasonable likelihood that claim 20 is unpatentable as obvious based on Sackier and Nishioka.

II. DISCUSSION

A request for rehearing must specifically identify all matters the party believes the Board misapprehended or overlooked, and the place where each matter was previously addressed in a motion, an opposition, or a reply. 37 C.F.R. § 42.71(d).

Petitioner observes that as regards the contention that claim 20 is anticipated by Sackier, the Decision mistakenly states that claim 20 “includes a claim element of ‘moved distally relative to the clip.’” Reh’g Req. 2.

Petitioner is correct. Claim 20 was inadvertently included in a group of claims when it should have been addressed separately. We therefore amend our decision and address claim 20 as follows.

Petitioner also asserts claim 20 would have been obvious over Sackier and Nishioka, and that we misapprehended or overlooked evidence that the clamp of Figures 15–17 of Sackier detaches in the body. Reh’g Req. 4–8. We address this additional contention below.

A. Claim 20 – Alleged Anticipation by Sackier

We analyze independent claim 20 anew. Petitioner asserts that Sackier alone discloses all elements of claim 20, and as a consequence it is anticipated. Pet. 29–34.

Claim 20 is an independent claim directed to a method of using a medical device, which comprises a clip, a control member, and a linkage. Ex. 1001, 15:33–45. We address the pertinent claim elements (*italicized*) below.

20. *A method, comprising:*

Petitioner asserts that Sackier discloses “[a] method for operating [a] clamp.” Pet. 37, citing Ex. 1015, ¶ 50; Ex. 1008, 3:1-2. We agree with this characterization.

inserting into a body a medical device comprising a clip having a first clip leg having a first inner surface and a second clip leg having a second inner surface, a control member extending from a proximal actuator to the clip and a linkage coupled to the control member;

Petitioner asserts that Sackier describes inserting into a body a medical device including clamps and clamp appliers for occluding body conduits. Pet. 37 (citing Ex. 1015 ¶ 51; Ex. 1008, 1:6–8, 3:1–15, 9:5–12,

11:57–64, 14:5–24). The medical device described in Sackier is asserted to include a clip having first and second clip legs, each having an inner surface, a control member extending from a proximal actuator to the clip, and a linkage coupled to the control member. Pet. 37–38. This contention is sufficiently supported based on the record before us.

positioning the medical device at a desired deployment location;

Petitioner asserts that Sackier discloses positioning the medical device at a desired deployment location. Pet. 39 (citing Ex. 1015 ¶ 53; Ex. 1008, 8:29–31).

While we indicated in our Institution Decision that deployment would seem to require release, we have reconsidered that position in light of the record brought to our attention in Petitioner’s Request for Rehearing. *See* Inst. Dec. 32–33. We are persuaded that Petitioner has shown sufficiently for purposes of institution of review that the broadest reasonable interpretation of deployed includes the situation where a clamp can be deployed for use in the body without necessarily being released. *See., e.g.,* Ex. 1001, 2:59-61 (indicating that deploying includes an arrangement for opening and closing the clip). Moreover, Sackier suggests a deployed clip would be used within the body but nonetheless remain attached to the sleeve, for example to move a bowel segment. Ex. 1008, 4:35–40.

moving the control member distally to cause the clip to move distally relative to a sleeve housing at least a portion of the clip therein, the movement causing the linkage to contact the first and second inner surfaces to drive the first and second clip legs radially outward to a tissue receiving configuration;

Petitioner points to the circular pivot points for the legs as the claimed linkage. Pet. 23. The Petition then asserts a different embodiment of Sackier illustrated in Figure 2, where one leg is fixed and spring 52 is located between the legs. The spring drives one jaw away from a fixed jaw, thus driving the jaws as a whole apart.

This combination/substitution of distinct embodiments is made to meet the claim limitation of contacting the inner surfaces of the first clip leg and second clip leg.

Petitioner's annotated Figure 2 is reproduced below.

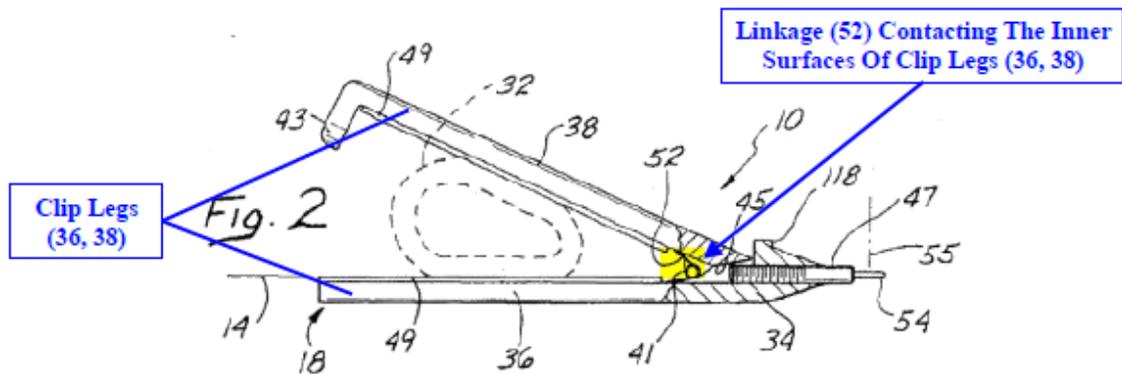


Figure 2 is a cross sectional view of a clamp and blood vessel

Patent Owner takes issue with this selecting and choosing and observes that spring 52 cannot meet the other claim requirements and there is no teaching that the springs should be substituted. Prelim. Resp. 11-14

The flaw in Petitioner's argument and position is that Petitioner is asserting an anticipation ground, but is combining two distinct embodiments to show anticipation. The language of Claim 20 expressly requires driving of the jaws, plural, radially outwardly.

However, Petitioner presently proposes taking a spring portion of a different embodiment where only one jaw moves radially and incorporating it into another embodiment where both jaws move, and a spring is already centrally located on the clip arms.

To establish anticipation, each and every element in a claim, arranged as recited in the claim, must be found in a single prior art reference. *Net MoneyIN, Inc. v. VeriSign, Inc.*, 545 F.3d 1359, 1369 (Fed. Cir. 2008).

We determine that Petitioner has not met its burden of showing this element to be present in Sackier because Petitioner picks features from distinct embodiments in Sackier without establishing persuasively that those embodiments are directly related to each other such that one of ordinary skill in the art, looking at the reference as a whole, would recognize a disclosure of all elements of the claimed invention arranged as in the claim. Accordingly, we decline to alter the outcome of the decision on institution as regards anticipation of claim 20 by Sackier.

B. Claim 20 – Alleged Obviousness Over Sackier and Nishioka

In the Petition, Petitioner contends claim 20 would have been obvious over Sackier and Nishioka. Petitioner asserts in the Request for Rehearing that we erred in the Institution Decision by overlooking or misapprehending its evidence in the Petition and Exhibit 1015 (Dr. Nicosia's Declaration) that the clamp of Sackier detaches within the body. Reh'g. Req. 4–8.

*20. A method, comprising:
inserting into a body a medical device comprising a clip
having a first clip leg having a first inner surface and a
second clip leg having a second inner surface, a control
member extending from a proximal actuator to the clip
and a linkage coupled to the control member;*

Petitioner asserts that Sackier describes inserting into a body a medical device including clamps and clamp appliers for occluding body conduits. Pet. 20–25, 64 (citing Ex. 1008, 1:6–8, 3:1–15, 9:5–12, 11:57–64, 14:5–24). The medical device described in Sackier is asserted to include a clip having first and second clip legs, each having an inner surface, a control member extending from a proximal actuator to the clip, and a linkage coupled to the control member. *Id.*

*positioning the medical device at a desired deployment
location;*

Petitioner asserts that Sackier describes positioning the medical device at a desired deployment location. Pet. 64 (citing Ex. 1015 ¶ 96; Ex. 1008, 8:29–31). We have already reconsidered the broadest reasonable interpretation of deployed/deployment, and find that Petitioner has shown sufficiently on the present record that it is broad enough to include a non-released clip.

*moving the control member distally to cause the clip to
move distally relative to a sleeve housing at least a
portion of the clip therein, the movement causing the
linkage to contact the first and second inner surfaces to
drive the first and second clip legs radially outward to a
tissue-receiving configuration*

Petitioner asserts that Sackier discloses multiple embodiments moving the control member distally to cause the clip to move distally relative to a sleeve housing at least a portion of the clip therein. Pet. 60–61, 65 (citing Ex. 1015 ¶¶ 97–98).

Petitioner relies upon Nishioka to disclose moving the control member distally to cause the linkage to contact the first and second inner surfaces to drive the first and second clip legs radially outward to a tissue-receiving configuration. *Id.* (citing Ex. 1015 ¶ 98). Dr. Nicosia testifies that one of ordinary skill in the art would have been motivated to use the Nishioka linkage to improve leverage and stability. *Id.* ¶ 65.

adjusting a position of the clip so that target tissue is received between the first and second clip legs;

Petitioner asserts that Sackier discloses adjusting a position of the clip so that target tissue is received between the clip legs. Pet. 41, 69 (citing Ex. 1015 ¶ 56; Ex. 1008, 3:14–15, 4:35–37).

drawing the control member proximally relative to the sleeve to draw the clip into the sleeve to receive the target tissue between the first and second clip legs; and

Petitioner urges that Sackier discloses drawing the control member proximally relative to the sleeve to draw the clip into the sleeve to receive the target tissue between the first and second clip legs. Pet. 41, 69 (citing Ex. 1015 and Ex. 1008, Figs. 15–17 as illustrating the clip in a retracted and expanded position).

applying a proximal tensile force of at least a threshold level to the control member to separate a link coupling the control member to the clip.

Finally, Petitioner asserts that Sackier discloses a link (connection between ball 163 and flange 176) coupling the control member (58a) to the clip (10a) which separates upon application of a proximal tensile force of at least a threshold level to the control member (58a). Pet. 42–43, 69 (citing Ex. 1015 ¶ 58).

Patent Owner, on the other hand, urges that there is no motivation to combine found within the references. Prelim. Resp. 20–23. Patent Owner also observes that the spring in Sackier already biased the jaws to open. *Id.* at 24. Additionally, Patent Owner argues the Sackier device and Nishioka device have different functions. *Id.* at 24–26. While we have considered Patent Owner’s positions, we note the Petitioner has indicated sufficiently on the record before us that there is motivation as evidenced by the testimony that leverage of the clip would be improved by the linkage, as well as clip leg stability. *See* Ex. 1015 ¶ 65.

Patent Owner also asserts that Sackier does not describe the tensile force to separate a link coupling the control member to the clip. We observe that Petitioner’s witness has testified that the Sackier ball and flange accomplish this. Ex. 1015 ¶ 58.

Accordingly, we grant the request for reconsideration and institute trial on claim 20 as obvious over Sackier and Nishioka.

III. CONCLUSION

For the foregoing reasons, we determine that Petitioner has demonstrated error. Upon reconsideration, we conclude that the information presented establishes a reasonable likelihood that Petitioner would prevail in showing that claim 20 of the ’027 patent is unpatentable as obvious over the

combination of Sackier and Nishioka. We have not made a final determination with respect to the patentability of the challenged claims or any underlying factual and legal issues.

We are aware that this decision, being made at this stage of the proceeding, may require additional briefing from the parties. A conference call will be scheduled shortly after this decision is entered to determine a revised briefing schedule and course of action.

IV. ORDER

Accordingly, it is:

ORDERED that, in addition to the prior order instituting review on claims 1-19, pursuant to 35 U.S.C. § 314(a), an *inter partes* review is also instituted as to claim 20 of the '027 patent on the following ground of unpatentability:

Reference	Basis	Challenged Claims
Sackier and Nishioka	§ 103(a)	20

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