

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ABIOMED, INC., ABIOMED R&D, INC., and
ABIOMED EUROPE GMBH,

Petitioner,

v.

MAQUET CARDIOVASCULAR, LLC,
Patent Owner.

IPR2017-02150 and IPR2017-02151 (Patent 9,327,068 B2)
IPR2017-02152 and IPR2017-02153 (Patent 8,888,728 B2)

Before BART A. GERSTENBLITH, JEREMY M. PLENZLER, and
KEVIN W. CHERRY, *Administrative Patent Judges*.

PLENZLER, *Administrative Patent Judge*.

DECISION

Denying Institution of *Inter Partes* Review
35 U.S.C. §§ 314(a) and 325(d); 37 C.F.R. § 42.108
Dismissing Petitioner's Motion for Joinder
35 U.S.C. § 315(c); 37 C.F.R. § 42.122(b)

IPR2017-02150 and IPR2017-02151 (Patent 9,327,068 B2)
IPR2017-02152 and IPR2017-02153 (Patent 8,888,728 B2)

I. INTRODUCTION

A. *Background*

Abiomed, Inc., Abiomed R&D, Inc., and Abiomed Europe GmbH (collectively, “Petitioner”) filed Petitions to institute an *inter partes* review of various claims (the “challenged claims”) from U.S. Patent No. 9,327,068 B2 (“the ’068 patent”) and U.S. Patent No. 8,888,728 B2 (“the ’728 patent”). IPR2017-02150, Paper 2 (“’2150 Pet.”)¹; IPR2017-02151, Paper 2 (“’2151 Pet.”)²; IPR2017-02152, Paper 2 (“’2152 Pet.”)³; IPR2017-02153, Paper 2 (“’2153 Pet.”)⁴. Petitioner filed Motions for Joinder in each of those proceedings concurrent with the filing of the respective Petitions. IPR2017-02150, Paper 3 (“’2150 Mot.”); IPR2017-02151, Paper 3 (“’2151 Mot.”); IPR2017-02152, Paper 3 (“’2152 Mot.”); IPR2017-02153, Paper 3 (“’2153 Mot.”).

We review the Petitions according to 35 U.S.C. § 314, which provides that an *inter partes* review may not be instituted “unless . . . there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.” Under 35 U.S.C. §§ 314(a) and 325(d), and 37 C.F.R. § 42.108(a), we have discretion regarding whether to institute trial. Based on the particular circumstances of the proceedings addressed in this Decision, we exercise our discretion to *deny* the petitions in each of IPR2017-02150, -02151, -02152, and -02153. Petitioner’s motions for joinder in each of those proceedings are *dismissed*.

¹ The ’2150 Petition challenges claims 1, 5, 7, and 9 of the ’068 patent.

² The ’2151 Petition challenges claims 10, 13–15 and 20 of the ’068 patent.

³ The ’2152 Petition challenges claims 1 and 6–8 of the ’728 patent.

⁴ The ’2153 Petition challenges claims 10 and 15–17 of the ’728 patent.

IPR2017-02150 and IPR2017-02151 (Patent 9,327,068 B2)
IPR2017-02152 and IPR2017-02153 (Patent 8,888,728 B2)

B. Related Proceedings

Petitioner and Patent Owner identify a number of proceedings related to the '068 patent and the '728 patent, including IPR2017-01026, -01027, -01028, and -01029. '2150 Pet. 1–2; '2151 Pet. 1–2; '2152 Pet. 1–2; '2153 Pet. 1–2; '2150 Paper 5, 1–2; '2151 Paper 5, 1–2; '2152 Paper 5, 1–2; '2153 Paper 5, 1–2.

C. Asserted Grounds of Unpatentability and Evidence of Record

Petitioner contends that the challenged claims are unpatentable as set forth below ('2150 Pet. 4–5, 30–94; '2151 Pet. 4, 28–87; '2152 Pet. 4–5, 29–88; '2153 Pet. 4, 28–82).⁵

| '068 Patent | | |
|--|-------|--------------|
| Reference(s) | Basis | Claim(s) |
| Aboul-Hosn ⁶ and Siess ⁷ | § 103 | 1 and 5 |
| Aboul-Hosn, Siess, and Sammler ⁸ | § 103 | 7 |
| Aboul-Hosn, Siess, and Wampler ⁹ | § 103 | 9 |
| Sammler, Rau ¹⁰ , Aboul-Hosn, and Siess | § 103 | 1 and 5 |
| Sammler, Rau, Aboul-Hosn, Siess, and Wampler | § 103 | 9 |
| Aboul-Hosn and Sammler | § 103 | 10 and 13–15 |
| Aboul-Hosn | § 102 | 20 |

⁵ Exhibit numbers for the asserted references are those used in IPR2017-02150.

⁶ WO 99/02204 A1, pub. Jan. 21, 1999 (Ex. 1004, “Aboul-Hosn”).

⁷ U.S. Pat. No. 5,921,913, iss. July 13, 1999 (Ex. 1005, “Siess”).

⁸ DE 19821307, pub. Oct. 21, 1999 (Ex. 1045, “Sammler”).

⁹ Wampler et al., *Clinical Experience with the Hemopump Left Ventricular Assist Device*, Supported Complex and High Risk Coronary Angioplasty, Ch. 14, 231–49 (Springer 1st ed. 1991) (Ex. 1008, “Wampler”).

¹⁰ WO 97/37696 A1, pub. Oct. 16, 1997 (Ex. 1046, “Rau”).

IPR2017-02150 and IPR2017-02151 (Patent 9,327,068 B2)
IPR2017-02152 and IPR2017-02153 (Patent 8,888,728 B2)

| '728 Patent | | |
|--|-------|--------------|
| References | Basis | Claim(s) |
| Aboul-Hosn and Siess | § 103 | 1 and 7 |
| Aboul-Hosn, Siess, and Sammler | § 103 | 6 |
| Aboul-Hosn, Siess, and Wampler | § 103 | 8 |
| Sammler, Rau, Aboul-Hosn, and Siess | § 103 | 1 and 7 |
| Sammler, Rau, Aboul-Hosn, Siess, and Wampler | § 103 | 8 |
| Aboul-Hosn and Sammler | § 103 | 10 and 15–17 |

II. ANALYSIS

A. *Motions for Joinder*

“If the Director institutes an inter partes review, the Director, in his or her discretion, may join as a party to that inter partes review any person who properly files a petition under section 311 that the Director . . . determines warrants the institution of an inter partes review under section 314.” 35 U.S.C. § 315(c). Petitioner’s motions for joinder do not identify an *inter partes* review to join for which trial has been instituted. *See* ’2150 Mot. 1 (seeking to join IPR2017-01028); ’2151 Mot. 1 (seeking to join IPR2017-01029); ’2152 Mot. 1 (seeking to join IPR2017-01026); ’2153 Mot. 1 (seeking to join IPR2017-01027).¹¹

Accordingly, independent of our decision to deny institution, discussed further below, we *dismiss as moot* Petitioner’s Motions for Joinder.

¹¹ The Petitions were denied in each of those proceedings, as were Petitioner’s Requests for Rehearing.

IPR2017-02150 and IPR2017-02151 (Patent 9,327,068 B2)
IPR2017-02152 and IPR2017-02153 (Patent 8,888,728 B2)

B. Challenges

At the outset, we note that Petitioner acknowledges that the IPR2017-02150 “Petition relies on substantially overlapping prior art to challenge the same ’068 patent as in IPR2017-01028” (’2150 Mot. 4), the IPR2017-02151 “Petition relies on substantially overlapping prior art to challenge the same ’068 patent as in IPR2017-01029” (’2151 Mot. 4), the IPR2017-02152 “Petition relies on substantially overlapping prior art to challenge the same ’728 patent as in IPR2017-01026” (’2152 Mot. 4), and the IPR2017-02153 “Petition relies on substantially overlapping prior art to challenge the same ’728 patent as in IPR2017-01027” (’2153 Mot. 4).

1. § 325(d)

Under 35 U.S.C. § 325(d), “the Director may take into account whether, and reject the petition or request because, the same or substantially the same prior art or arguments previously were presented to the Office.” There can be no dispute that Aboul-Hosn, Siess, and Wampler are “the same . . . prior art . . . previously . . . presented to the Office.” Indeed, Petitioner, itself, presented the asserted art in the previously denied Petitions in IPR2017-01026, -01027, -01028, and -01029.¹² Each of the claims

¹² With respect to Sammler, Patent Owner notes that “[t]he Sammler reference that is cited herein is identical to and in the chain of priority of the U.S. Sammler reference cited in the previously denied IPR.” ’2150 Prelim. Resp. 16 (citing IPR2017-01208, Ex. 1018). Exhibit 1018 from IPR2017-01208 is U.S. Pat. No. 6,544,216 B1. We note that patent is listed as a reference cited during prosecution of the application resulting in the ’068 patent, which indicates that patent was cited by the Examiner. Further, as Petitioner acknowledges (*see, e.g.*, ’2150 Pet. 20), Sammler expressly references Rau’s disclosure of an intravascular blood pump system (Ex. 1045, 3).

IPR2017-02150 and IPR2017-02151 (Patent 9,327,068 B2)
IPR2017-02152 and IPR2017-02153 (Patent 8,888,728 B2)

challenged in IPR2017-02150, -02151, -02152, and -02153 was already challenged in IPR2017-01026, -01027, -01028, or -01029.

Patent Owner contends that it is an appropriate exercise of our discretion under 35 U.S.C. § 325(d) to deny Petitioner's challenges. *See, e.g.,* '2150 Prelim. Resp. 15–17. We agree that it is appropriate to deny institution of at least the challenges based on Aboul-Hosn, Siess, and Wampler under 35 U.S.C. § 325(d).

Petitioner contends that, subsequent to those earlier Petitions, it “received service of Patent Owner’s infringement contentions . . . and needed sufficient time to review, digest and formulate its views with respect to those positions that bear directly on the application of the language of the claims.” *See, e.g.,* '2150 Pet. 96. Petitioner, however, fails to address any particular claim construction affected by those litigation positions. *See id.* at 25–27; '2151 Pet. 23–25; '2152 Pet. 24–26; '2153 Pet. 22–25. We decline to revisit Petitioner’s challenges based on the same references unsuccessfully asserted by Petitioner in earlier proceedings directed to the '068 and '728 patents. Accordingly, we exercise our discretion and deny those challenges under 35 U.S.C. § 325(d) and 37 C.F.R. § 108(a).

2. § 314(a)

Petitioner presents additional challenges based on Sammler and Rau, which were not asserted in IPR2017-01026, -01027, -01028, or -01029. Patent Owner contends that we should apply our discretion under 35 U.S.C. § 314(a) to deny those challenges in addition to the others discussed above. *See, e.g.,* '2150 Prelim. Resp. 5–15. We agree.

“The Director may not authorize an inter partes review to be instituted unless the Director determines . . . that there is a reasonable likelihood that

IPR2017-02150 and IPR2017-02151 (Patent 9,327,068 B2)
IPR2017-02152 and IPR2017-02153 (Patent 8,888,728 B2)

the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.” 35 U.S.C. § 314(a). This section grants the Board discretion to deny institution of a later-filed petition based on various factors, as set forth in *General Plastic Indus. Co. v. Canon Kabushiki Kaisha*, Case IPR2016–01357, slip op. 15–19 (PTAB Sept. 6, 2017) (Paper 19) (precedential).

The non-exhaustive factors are as follows:

1. whether the same petitioner previously filed a petition directed to the same claims of the same patent;
2. whether at the time of filing of the first petition the petitioner knew of the prior art asserted in the second petition or should have known of it;
3. whether at the time of filing of the second petition the petitioner already received the patent owner’s preliminary response to the first petition or received the Board’s decision on whether to institute review in the first petition;
4. the length of time that elapsed between the time the petitioner learned of the prior art asserted in the second petition and the filing of the second petition;
5. whether the petitioner provides adequate explanation for the time elapsed between the filings of multiple petitions directed to the same claims of the same patent;
6. the finite resources of the Board; and
7. the requirement under 35 U.S.C. § 316(a)(11) to issue a final determination not later than 1 year after the date on which the Director notices institution of review.

We address each of these factors in turn, but note that not all the factors need to weigh against institution for us to exercise our discretion under § 314(a).

a) Whether the Petitions are Directed to the Same Claims

As noted above, each of the claims challenged in IPR2017-02150, -02151, -02152, and -02153 was already challenged in one of

IPR2017-02150 and IPR2017-02151 (Patent 9,327,068 B2)
IPR2017-02152 and IPR2017-02153 (Patent 8,888,728 B2)

IPR2017-01026, -01027, -01028, or -01029. IPR2017-01026 challenged claims 1–9 of the '728 patent, IPR2017-01027 challenged claims 10–24 of the '728 patent, IPR2017-01028 challenged claims 1–9 of the '068 patent, and IPR2017-01029 challenged claims 10–22 of the '068 patent.

Accordingly, this factor weighs against institution.

b) Whether Petitioner Knew or Should Have Known of the Newly Asserted Prior Art

As noted above, Patent Owner states that “[t]he Sammler reference that is cited herein is identical to and in the chain of priority of the U.S. Sammler reference cited in the previously denied IPR.” ’2150 Prelim. Resp. 16 (citing IPR2017-01208, Ex. 1018). Exhibit 1018 from IPR2017-01208 is U.S. Patent No. 6,544,216 B1 (“the ’216 patent”). The ’216 patent lists Sammler (i.e., DE 19821307) as its foreign priority document, and our comparison of Sammler to the ’216 patent reveals those documents are virtually identical. Moreover, the ’216 patent is listed specifically on the ’068 patent. The other newly asserted reference, Rau, is a PCT application, which was published in 1997. We are apprised of no reason that Petitioner did not know of these references when the earlier petitions were filed.

Accordingly, this factor weighs against institution.

c) Whether Information from Prior Proceedings was Available

The Petitions for IPR2017-02150, -02151, -02152, and -02153 were filed on September 22, 2017. Patent Owner’s Preliminary Responses in IPR2017-01026, -01027, -01028, and -01029 were filed by June 30, 2017, and decisions denying institution in each of those proceedings were entered on September 20, 2017. Petitioner contends that these “Petition[s] [are] filed merely two days after the Board decision[s] denying institution” and, “[a]s such it has not, and as a practical matter could not have, been prepared using

IPR2017-02150 and IPR2017-02151 (Patent 9,327,068 B2)
IPR2017-02152 and IPR2017-02153 (Patent 8,888,728 B2)

the Board’s decision[s] as a roadmap.” *See, e.g.*, ’2150 Pet. 96.

Nevertheless, Patent Owner’s Preliminary Responses from the prior proceedings were available for almost three months before filing of the instant Petitions. Accordingly, this factor weighs against institution.

d) Elapsed Time

Petitioner contends that it “filed the instant petition[s] without undue delay and without regard to the Board’s recent September 20, 2017 decision[s].” *See, e.g.*, ’2150 Pet. 96. The petitions in each of IPR2017-01026, -01027, -01028, and -01029 were filed on March 11, 2017, which is more than six months before the Petitions now before us. Petitioner does not allege that it was not aware of the newly asserted art at the time of those earlier petitions. Accordingly, this factor weighs against institution.

e) Whether Petitioner Provides Adequate Explanation

As noted above, over six months passed between the filings of the earlier petitions and those now before us. Petitioner contends that it “received service of Patent Owner’s infringement contentions on May 25, 2017 and needed sufficient time to review, digest and formulate its views with respect to those positions that bear directly on the application of the language of the claims,” but offers no explanation as to how those contentions affect its challenges. *See, e.g.*, ’2150 Pet. 96. We are not apprised of any circumstance that was unexpected or surprising to Petitioner. *See General Plastic* at 11 (“the shift in Petitioner’s challenges was not the consequence of a position that Patent Owner surprisingly advanced or the Board surprisingly adopted”). Accordingly, this factor weighs against institution.

IPR2017-02150 and IPR2017-02151 (Patent 9,327,068 B2)
IPR2017-02152 and IPR2017-02153 (Patent 8,888,728 B2)

f) Board Resources and Final Determination

At best, these factors are neutral, and certainly do not weigh in favor of Petitioner. *See General Plastic* at 21 (“multiple, staggered petition filings” is, in general, “an inefficient use of the *inter partes* review process and the Board’s resources”).

g) Conclusion

In view of the considerations noted above, we determine a majority of the *General Plastic* factors weigh strongly against institution in this case. Accordingly, we exercise our discretion to deny institution under 35 U.S.C. § 314(a) and 37 C.F.R. § 42.108(a).

III. ORDER

For the foregoing reasons, it is

ORDERED that Petitioner’s Motions for Joinder in each of IPR2017-02150, -02151, -02152, and -02153 are *dismissed as moot*;

FURTHER ORDERED that the ’2150 Petition and the ’2151 Petition are *denied* as to all challenged claims of the ’068 patent; and

FURTHER ORDERED that the ’2152 Petition and the ’2153 Petition are *denied* as to all challenged claims of the ’728 patent.

IPR2017-02150 and IPR2017-02151 (Patent 9,327,068 B2)
IPR2017-02152 and IPR2017-02153 (Patent 8,888,728 B2)

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