

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

NEVRO CORP.,
Petitioner,

v.

BOSTON SCIENTIFIC NEUROMODULATION CORP.,
Patent Owner.

Case IPR2017-01811
Patent 6,895,280 B2

Before HUBERT C. LORIN, MICHAEL W. KIM, and AMANDA F. WIEKER,
Administrative Patent Judges.

WIEKER, *Administrative Patent Judge.*

DECISION ON REQUEST FOR REHEARING
37 C.F.R. § 42.71

I. INTRODUCTION

Nevro Corp. (“Petitioner”) filed a Petition requesting an *inter partes* review of claims 1, 4, 7–9, 11, 18, 19, and 21 (“the challenged claims”) of U.S. Patent No. 6,895,280 B2 (Ex. 1001, “the ’280 patent”). Paper 1 (“Pet.”). Boston Scientific Neuromodulation Corp. (“Patent Owner”) filed a Preliminary Response. Paper 8 (“Prelim. Resp.”). On February 5, 2018, the Board issued a Decision denying institution of an *inter partes* review. Paper 11 (“Dec.”; “Decision”). On February 16, 2018, Petitioner filed a Request for Rehearing of the Decision, limited only to challenged claims 8 and 18. Paper 12 (“Req.”), 1–2.

For the reasons that follow, the Request for Rehearing is *denied*.

II. ANALYSIS

A request for rehearing must identify specifically all matters that the requesting party believes the Board misapprehended or overlooked. 37 C.F.R. § 42.71(d). When rehearing a decision on institution, the Board will review the decision for an abuse of discretion. 37 C.F.R. § 42.71(c).

Independent claims 8 and 18 recite, *inter alia*, “an implantable electrode array detachably connected to the IPG [implantable pulse generator].” Ex. 1001, 53:7–8, 54:59–60.

Petitioner contends that the Board “misapprehended or overlooked that a POSA would have understood Holsheimer to disclose” this limitation. Req. 3. In particular, Petitioner argues that Holsheimer’s lead is “connected” to the IPG, and that connection is not described as being “permanent.” *Id.* at 3–4. Petitioner also relies upon the testimony of its Declarant, Dr. Kroll, who testified that Holsheimer’s Figure 1 “shows a standard connector notch commonly used to depict lead connectors.” *Id.* at 4 (citing Ex. 1003 ¶ 85). Petitioner contends that, “as explained by Dr. Kroll, a POSA would have been familiar with such

connectors and connector notches, and would have understood Holsheimer to disclose that ‘Holsheimer’s leads, which carry the electrode arrays, would have been detachably connected to the IPG.’” *Id.* at 4 (citing Pet. 27).

We are unpersuaded that we misapprehended or overlooked Petitioner’s position. Rather, our Decision addresses expressly each aspect of Petitioner’s argument. For example, the Decision relies upon Holsheimer’s Figures 19 and 20, which depict embodiments of Holsheimer’s implantable pulse generator. Dec. 10–11. As explained in the Decision, Holsheimer discloses that a series of wires 80A–80F connect the implantable pulse generator’s outputs 72, 74, 76, 78 to electrode array 38. *Id.* at 10–11 (citing Ex. 1004, 7:17–20, 7:23–28, 7:47–57). Thus, we did not misapprehend or overlook Holsheimer’s disclosure that the implantable pulse generator and electrode array are “connected.” Req. 3–4. Our Decision also states that these portions of Holsheimer “disclose an apparently permanent, unitary connection with wires 80A–F.” Dec. 11. We understand that Holsheimer does not utilize the word “permanent,” *see* Req. 4, however, as stated in our Decision, “the Petition does not provide any supporting evidentiary basis for [the] otherwise conclusory assertion that wires 80 are detachable from either electrode array 38 or from pulse generator 14.” Dec. 11.

We are also unpersuaded that we misapprehended or overlooked the testimony of Dr. Kroll. We recognize that Dr. Kroll testified that Holsheimer’s Figure 1 “shows a standard connector notch commonly used to depict lead connectors.” Req. 4 (citing Pet. 26–27 (citing Ex. 1003 ¶ 85)); Dec. 12. However, Dr. Kroll does not explain whether a “standard connector notch” allows detachable connections. Ex. 1003 ¶ 85. In other words, even if Dr. Kroll’s testimony had established that Holsheimer’s Figure 1 depicts a standard connector notch, a premise we discuss further below, Petitioner did not take the next, logical, and

needed step, in its Petition or supporting evidence, of either identifying sufficient evidence, or providing sufficient explanation, to establish that the “standard connector notch” of Holsheimer would have allowed for the claimed detachable connection.

Moreover, Dr. Kroll does not identify persuasively any basis for his testimony regarding Holsheimer’s purported depiction of a “standard connector notch.” *See* 37 C.F.R. § 42.65(a). As noted in our Decision, Holsheimer’s disclosure does not support Dr. Kroll’s position. Dec. 11 (citing Ex. 1004, Fig. 1, 2:46–48, 3:53–4:5). Nor do Figures 1, 3, and 4 of Exhibit 1018, also cited by Dr. Kroll, provide a reasonable basis for this opinion. Ex. 1003 ¶ 85. For example, we are unable to ascertain anything in these Figures of Exhibit 1018 that reflect a “standard connector notch.” Ex. 1018, 3:12–16. Neither the Petition nor Dr. Kroll have shown how these Figures are relevant to his stated opinion regarding a “standard connector notch.” Ex. 1003 ¶ 85.

Petitioner also argues that the Board misapprehended other cited evidence, which purportedly shows that detachable leads were well-known, such that a person of ordinary skill in the art would have understood Holsheimer’s connection to be detachable. Req. 5 (citing Pet. 27). For example, Petitioner contends that the ’280 patent and a prior art reference to Mullett, cited by both the ’280 patent and Holsheimer, demonstrate that detachable connections were well-known. Req. 5–6 (citing Ex. 1001, 9:8–11, 10:19–24; Ex. 1016). According to Petitioner, “the Board overlooked that Figure 1 of both Holsheimer and Mullett are depicting the same Itrel II® IPG.” *Id.* at 6 (citing Ex. 1004, 3:60–61, Ex. 1016, 2:47–50). Petitioner also relies on Dr. Kroll’s testimony that detachable connections were known. *Id.* at 6–7 (citing Ex. 1003 ¶¶ 85–87).

We are unpersuaded that we misapprehended Petitioner's position. Rather, our Decision addresses Petitioner's argument that detachable connections were well-known. *See* Dec. 11–12 (discussing Ex. 1003 ¶¶ 85–87; Ex. 1016, Abstract, 2:66–3:2; Ex. 1018, Figs. 1, 3, 4). As stated in the Decision, the cited evidence does not demonstrate persuasively that *Holsheimer's* arrangement is detachable. *Id.* The mere fact that a feature may have been well-known in the prior art is insufficient to establish that it was present in a *specific* prior art reference. For example, Dr. Kroll does not link persuasively the cited evidence regarding known detachable connections, as allegedly disclosed by the '280 patent and by Mullett, to the arrangement disclosed by Holsheimer. Ex. 1003 ¶¶ 86 (discussing Mullett, but not relating it to Holsheimer's arrangement), 87 (discussing benefits of detachable leads, as articulated in the '280 patent, but not relating it to Holsheimer's arrangement).¹ Nor does Dr. Kroll explain *why* a person of ordinary skill in the art would have understood Holsheimer to include such a connection, in light of the cited evidence. Ex. 1003 ¶¶ 85–87. As stated in our Decision, this evidence, including Dr. Kroll's testimony, merely suggests that detachable connections were known and *could have been* used by Holsheimer.² Dec. 11–12;

¹ Although Petitioner now contends that Mullett and Holsheimer utilize the same IPG, this contention was not made in the Petition or in Dr. Kroll's declaration. *Compare* Req. 6, with Pet. 26–27, and Ex. 1003 ¶¶ 85–87. The Board cannot misapprehend or overlook an argument that was not made.

² The Request states that “a POSA . . . would have understood . . . that ‘Holsheimer's leads, which carry the electrode arrays, would have been detachably connected to the IPG.’” Req. 4 (quoting Pet. 27). However, this is merely conclusory attorney argument insufficient, on its own, to establish this fact. *See* Pet. 27 (citing Ex. 1001). Furthermore, this statement is not supported by any portion of Dr. Kroll's testimony. *Compare id.*, with Ex. 1003 ¶¶ 85–87.

see also id. at 12 n.2 (noting that Petitioner did not contend that it would have been obvious to modify Holsheimer to include a detachable connection).

Petitioner also contends that the Board improperly credited the arguments of Patent Owner’s attorney, with respect to Holsheimer’s disclosure. Req. 3, 8–11. Additionally, Petitioner contends that Holsheimer’s wires “do not permanently connect the outputs in the pulse generator with electrodes,” because Holsheimer discloses that “[i]f a smaller number of electrodes are used the unused outputs of the pulse generator 14 are electrically disconnected.” Req. 9 (quoting Ex. 1004, 7:40–42).

We are not persuaded by Petitioner’s contentions. As discussed above, while certainly informed by Patent Owner’s arguments, the Decision only relies upon the Holsheimer reference itself for the relevant findings. *See supra* at 3; Dec. 10–11. For example, we found that Holsheimer expressly disclosed that wires connect the electrode array and implantable pulse generator, and that Petitioner had not provided a sufficient evidentiary basis to support its conclusion that the electrode array and pulse generator were nonetheless detachable. Dec. 10–11 (citing Ex. 1004, 7:17–20, 7:23–28, 7:47–57). Moreover, although the Petition included, in a long string citation, Holsheimer’s disclosure regarding “electrical[] disconnect[ion],” the Petition did not develop any substantive argument linking Holsheimer’s disclosed electrical disconnection of unused outputs to the claim limitation requiring “an implantable electrode array detachably connected to the IPG.” *See* Pet. 26 (citing Ex.1004, Abstract, 2:25–29, 2:54–55, 3:56–59, 6:26–31, 6:66–7:1, 7:22–31, 7:37–62, Figs. 1, 19–20, claim 13). Accordingly, we could not have misapprehended or overlooked an argument that was not made.

III. CONCLUSION

Petitioner’s Request for Rehearing is *denied*.

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