

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

EDWARDS LIFESCIENCES CORPORATION AND
EDWARDS LIFESCIENCES LLC,
Petitioner,

v.

AORTIC INNOVATIONS LLC,
Patent Owner.

Case IPR2023-01151
Patent 11,337,834

**PATENT OWNER AORTIC INNOVATIONS LLC'S
PRELIMINARY SUR-REPLY**

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AGENCY DECISIONS

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EXHIBIT LIST	
2001	Reserved
2002	Declaration of Stephen J.D. Brecker [Brecker-Decl.]
2003-2007	Reserved
2008	Declaration of Nigel Buller, <i>Edwards Lifesciences Corp. et al. v. Aortic Innovations, LLC</i> , IPR2022-00193 (filed Nov. 12, 2021) [-00193-Buller-Decl.]
2009-2039	Reserved
2040	Excerpts from the opposition proceeding to European Patent 2982337 [Spenser-II-European-Proceeding]
2041-2042	Reserved
2043	Institution Decision of IPR2022-00034 [IPR2022-00034 Inst.-Dec.]
2044-2046	Reserved
2047	Edwards Petition for Inter Partes Review filed in IPR2022-00034 [IPR2022-00034 Petition]
2048-2051	Reserved
2052	Deposition Transcript of Nigel P. Buller In IPR2022-00034 [Buller-00034-Depo.]
2053-2086	Reserved
2087	Excerpts of Defendants' Preliminary Invalidity Contentions filed in Aortic Innovations LLC v. Edwards Lifesciences Corp, Edwards Lifesciences LLC, and Edwards Lifesciences (U.S.), Inc. Case No. 1:21-cv-01377-JPM (Delaware) [PICs]

2088-2100	Reserved
2101	U.S. Patent No. US6,663,667 [Dehdashtian]
2102	U.S. Patent Application No. 2006/0004442 to Spenser ['442 Application]
2103	Declaration of Stephen J.D. Brecker filed in IPR2022-00556 [Brecker-556-Decl.]
2104-2107	Reserved
2108	Petitioner's Reply to Patent Owner's Response in IPR2022-00034
2109	Petitioner's Reply to Patent Owner's Response in IPR2022-01527
2110	Petitioner's Reply to Patent Owner's Response in IPR2022-01584
2111-2121	Reserved
2122	Transcript of April 12, 2023 Deposition of Nigel P. Buller in IPR2022-00556 [Buller-556-Reply-Depo.]
2123	Reserved
2124	Final Written Decision of IPR2022-00556 [-00556FWD]
2125	U.S. Patent No. 6,096,052 [Callister]
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2127	<i>Aortic Innovations LLC v. Edwards Lifesciences Corp.</i> No. 1:21-cv-01377-JPM, Claim Construction Order (May 9, 2023) [Aortic-I-Claim-Construction-Order]
2128	Declaration of Nigel P. Buller filed in IPR2022-00556 [Buller-556-Decl.]
2129	Edwards Petition for Inter Partes Review filed in IPR2022-00556 [-00556-Pet.]

2130	Petitioner's Reply to Patent Owner's Response in IPR2022-00556 [-00556-Reply]
2131	Prosecution History of U.S. Patent No. 10,987,236 ['236-FH]
2132	U.S. Patent No. 10,966,846 ['846]
2133	U.S. Patent No. 10,987,236 ['236]
2134	Reply Declaration of Nigel P. Buller filed in IPR2022-00556 [Buller-556-Reply-Decl.]
2135	Disclaimer in Patent Under 37 CFR 1.321(a), U.S. Patent 11, 337, 834, Oct. 10, 2023 [Disclaimer]
2136-2140	Reserved
2141	Declaration of Dr. David Brookstein, Sc.D. Regarding Claim Construction submitted in Case No. 1-23-cv-00158 (D. Del.) [Brookstein-Decl.]

Petitioner's Reply accuses Patent Owner of taking inconsistent claim construction positions concerning the term "spacings" before the district court and the Board. This is an exercise in projection. While a party to this proceeding is taking wildly inconsistent positions regarding the term "spacings," that party is Petitioner. Indeed, while Patent Owner's position is entirely consistent in both proceedings, Petitioner fails to disclose that its expert ***fully agrees with Patent Owner's position***, confirming institution should be denied.

I. PETITIONER'S DISTRICT COURT EXPERT AGREES THAT SPENSER II WAS DISCLAIMED AS NOT DISCLOSING OR RENDERING OBVIOUS "SPACINGS."

The Petition contends that Spenser II satisfies the claimed "spacings" (Pet., 48-51, 73-76) while the POPR contends, *inter alia*, that in view of a clear prosecution disclaimer, Spenser II cannot satisfy the claimed "spacings" (POPR, 3-16). Incredibly, after seeking briefing regarding the state of play in the co-pending litigation, Petitioner neglects to disclose that its district court expert ***fully agrees with Patent Owner's position*** (POPR, Section III.A.2) that, in view of a prosecution disclaimer, Spenser II cannot satisfy the "spacing" limitation. Specifically, Dr. Brookstein recognized that "Aortic Innovations argued that the collagen fibers in the Asserted Patents ***were distinguishable from the prior art ... (including Walther and Spenser II)***" due to the "lack of 'spacings.'" Ex. 2141 [Brookstein-Decl.] ¶35 (quoting Ex. 1002 [Pros.-Hist.] 1001). Dr. Brookstein

further confirmed there is no “dispute that the Asserted Patents ***do not include cloths like those described*** in Walther and ***Spenser II.***” *Id.*, ¶33 (the Applicant “repeatedly distinguished the claimed ‘spacing(s)’ from the spacings between fibers that are present in ... the cloths and materials disclosed in Walther and Spenser II”). Thus, while Petitioner here argues that Spenser II discloses or renders obvious “spacings,” Petitioner’s expert has since confirmed the opposite.

And yet, in a brief purportedly about imagined inconsistencies, Petitioner fails to disclose its own inconsistent district court position or even file Dr. Brookstein’s testimony that fully confirms Patent Owner’s position, and “Petitioner left it to Patent Owner to advise us of Petitioner’s differing claim construction arguments to the district court.” *Facebook, Inc. v. Sound View Innovations, LLC*, IPR2017-01002, Paper 13, 17-18 (Sept. 5, 2017); *id.*, (“At the very least, Petitioner’s failure to inform us of its differing claim construction arguments before the district court raises the specter of lack of candor.”).

II. UNLIKE PETITIONER, PATENT OWNER’S POSITION REGARDING “SPACINGS” IS CONSISTENT.

Ignoring its own inconsistency, Petitioner argues that “PO and its expert, Dr. Brecker, propose a [] construction in district court” “contrary” to their position in the IPR. Reply, 2-3. This is nonsense. Patent Owner “propose[d]” no construction of “spacings,” much less one inconsistent with its IPR position.

Rather, Patent Owner has consistently applied the plain and ordinary meaning in view of the Applicant's **undisputed** disclaimer "of Spenser II as **not** disclosing 'spacings.'" POPR, 11; Ex. 1002 [Pros.-Hist.] 1001; Ex. 2141, ¶¶33, 35. Petitioner's contrary position is founded upon Dr. Brecker's testimony that he saw no "disavowal or disclaimer ... requiring that **all** sleeves, layers, and cloths be excluded from the term 'spacings.'" Reply, 3 (quoting Ex. 1145 [Brecker-Claim-Construction-Decl.] ¶92). This is a *non sequitur*. A statement about a Ford F-150 is not a statement about "**all** cars." Just so, a statement about Spenser II's compressible material is not a statement about "**all** sleeves, layers, and cloths."

And, as a glance at Figure 22 will confirm, the Applicant's statement that Spenser II's compressible material lacks the claimed "spacings" is in full harmony with the plain meaning. In accord, the Board found that Spenser II's compressible material "corresponds to an outer graft covering," and favorably cited Dr. Brecker's testimony distinguishing the "spacings" depicted in the '834's Fig. 13 from Spenser II's "solid, non-porous graft material." Ex. 2124 [-556-FWD] 29-30, 33-34 (quoting Ex. 2103 [Brecker-556-Decl.] ¶160); Ex. 1120 [-00034-FWD] 48, 44 (similar). Petitioner, moreover, proposed claims in European prosecution requiring that "the compressible material is a fluid impermeable membrane" (Ex. 2040 [Spenser-II-European-Proceeding] 2087-2093); *i.e.*, a material without spacings. And, Dr. Buller, similarly, testified that Spenser II's compressible

material must “be sufficiently dense to prevent blood from leaking through the cloth/fabric.” Ex. 2128 [Buller-556-Decl.] ¶222.

Petitioner argues that Patent Owner “suggests” that the Applicant’s disclaimer was “limit[ed] ... to Spenser II,” arguing instead for an expansive disclaimer, broadly extending to all grafts, sleeves, and cloths. Reply, 3-4. This is an errant argument erected upon a false premise. The Applicant distinguished the claimed “spacings” from “a very tightly knitted outer seal made of tightly knitted fibers (such as found in ... Walther ... or [Spenser II], with reference to Figure 22 ...” Ex. 1002, 1001 (quoted at POPR, 9). Thus, the disclaimer is not limited to Spenser II for it plainly extends to Walther and to a “very tightly knitted outer seal made of tightly knitted fibers.” Equally plain, the disclaimer does not extend to all “grafts,” “graft coverings,” “sleeves,” and “cloths.” Reply, 4.¹

Petitioner further alleges that the claims are indefinite, and that the

¹ A loosely woven/knitted cloth with “spacings” extending through its thickness to or through the frame may well satisfy the limitation. Petitioner’s contention that Ultra’s outer skirt is a “graft covering” lacking “spacings” (Reply, 3) is contradicted by Dr. Buller’s testimony that it is not a “graft covering” and “clearly” has “holes [] going all the way through it.” Ex. 1128, 132:14-133:10.

Applicant failed to “provide any objective boundaries for the ‘spacings.’” Reply, 4. This is wrong and, moreover, is outside the Board’s statutory jurisdiction. The Examiner had no trouble discerning that the “spacings” limitation was “not disclose[d] or render[ed] obvious” by the prior art. Ex. 1002 [Pros.-Hist.] 850.

Petitioner further contends “[b]oth PO and Dr. Brecker have” allegedly “admitted” that all cloths have “spacings” in related prosecution and IPRs. *Id.*, 4-5 (citing Ex. 1146 [Brecker-556-Depo.] 185:18-20; Ex. 1148, 13; Ex. 1149, 14). The Applicant made no such admission and, again, Dr. Brookstein agrees that the Applicant disclaimed Spenser II as lacking “spacings.” Ex. 2141, ¶¶33, 35. And, immediately following Petitioner’s quoted excerpt of his testimony, Dr. Brecker clearly states that any inherent spaces between fibers are “not what I’m talking about, and that’s not what the patentee is talking about.” Ex. 1146 [Brecker-556-Depo.] 185:14-186:7 (“it’s as clear as anything ... and totally different to something that was unintentional or inherent.”). Just so, as the distance between tightly woven/knitted fibers in a tightly constructed outer seal would not satisfy other claim elements. *See, e.g.*, Ex. 1001, cl. 17 (requiring “compression” of the fibers “relative to the spacing to create a seal thereabout”).

In sum, it is Petitioner, not Patent Owner, who has taken inconsistent positions and its own expert confirms institution should be denied.

Respectfully submitted,

/Kenneth J. Weatherwax/

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Nathan N. Lowenstein (*pro hac vice*)
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Date: December 4, 2023

CERTIFICATE OF SERVICE

The undersigned hereby certifies that the following documents were served
by electronic service, by agreement between the parties, on December 4, 2023:

**PATENT OWNER AORTIC INNOVATIONS LLC'S
PRELIMINARY SUR-REPLY**

EXHIBIT 2141

The names and address of the parties being served are as follows:

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