

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.

IPR2024-00390
Patent 11,497,634 B2

Before JOHN G. NEW, RYAN H. FLAX, and TIMOTHY G. MAJORS,
Administrative Patent Judges.

MAJORS, *Administrative Patent Judge.*

DECISION
Granting Motion to Dismiss
37 C.F.R. § 42.71(a)
Dismissal Prior to Institution of Trial
35 U.S.C. § 314

I. BACKGROUND

On January 5, 2024, Edwards Lifesciences Corp. and Edwards Lifesciences LLC (collectively “Petitioner”) filed a Petition (Paper 1, “Pet”) requesting *inter partes* review of claims 1–7 and 9 of U.S. Patent No. 11,497,634 B2 (“the ’634 patent”). Pet. 1. The deadline for Aortic Innovation LLC (“Patent Owner”) to file its preliminary response has not yet passed.

On April 2, 2024, Petitioner informed the Board that it sought authorization to file a motion to dismiss the Petition. Ex. 3001. Petitioner also informed the Board that Patent Owner did not, at that time, oppose the contemplated motion provided that it was filed promptly. *Id.* With the Board’s authorization, Petitioner filed the present Motion to Dismiss the Petition (Paper 7, “Mot.” or “Motion”) on April 11, 2024. Patent Owner has since confirmed that it does not oppose the Motion as filed. Ex. 3002.

II. DISCUSSION

“The Board may terminate a trial without rendering a final written decision, where appropriate.” 37 C.F.R. § 42.72. Moreover, under 37 C.F.R. § 42.71(a), the Board “may grant, deny, or dismiss any petition,” as appropriate under the circumstances.

Petitioner moves the Board to dismiss the Petition and terminate the proceeding under Rules 42.71 and 42.72. Mot. 1–2. According to Petitioner, the requested relief is justified for multiple reasons. First, Petitioner notes that this proceeding is at a preliminary stage—the Patent Owner has not yet filed a preliminary response and the Board has not yet entered an institution decision. *Id.* (citing Ex. 3001 (extending deadline for the preliminary response)). Petitioner contends that other Board panels have, under similar circumstances, weighed a proceeding’s early stage and

concomitant preservation of Board and party resources in favor of dismissal. *Id.* (citing, for example, *Regeneron Pharms., Inc. v. Novartis Pharm. AG*, IPR2020-01318, Paper 17 at 3 (PTAB Dec. 7, 2020)).

Second, Petitioner contends that it is barred from refiling a petition challenging the '634 patent. Mot. 2. More specifically, Petitioner notes that it was served with a complaint alleging infringement of the '634 patent more than one year ago. *Id.* And, under 35 U.S.C. § 315(b), Petitioner is therefore time-barred from bringing another IPR challenge against the asserted patent—avoiding inefficiencies in the Board having to consider different or redundant challenges from Petitioner against the '634 patent.

Third, Petitioner represents that the parties have not reached any agreement or understanding (e.g., settlement agreement) made in contemplation of terminating this proceeding. Thus, Petitioner asserts, there is no written document evidencing such agreement to submit to the Board under 37 C.F.R. § 42.74(b). *Id.* at 1.

Petitioner persuades us that its unopposed Motion should be granted. Ex. 3002. This case is in an early stage and no decision concerning whether to institute trial has been made. The opportunity for Petitioner to file a new petition against the '634 patent is foreclosed. Dismissal of the Petition now, accordingly, saves future resources. We also accept Petitioner's representation that no written agreement exists that would trigger the need for such agreement to be filed with the Board under Rule 42.74(b). For the above reasons, Petitioner's Motion is granted and IPR2024-00390 is terminated.

III. ORDER

In consideration of the foregoing, it is hereby:

ORDERED that Petitioner's Motion to Dismiss is *granted*;

FURTHER ORDERED that the Petition (Paper 1) is dismissed; and

FURTHER ORDERED that IPR2024-00390 is terminated before any decision on institution.

IPR2024-00390
Patent 11,497,634 B2

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