

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

NEVRO CORP.,
Petitioner,

v.

BOSTON SCIENTIFIC NEUROMODULATION CORP.,
Patent Owner.

IPR2019-01216
Patent 7,177,690 B2

Before ROBERT A. POLLOCK, SCOTT C. MOORE, and
RICHARD J. SMITH, *Administrative Patent Judges*.

SMITH, *Administrative Patent Judge*.

JUDGMENT

Granting Request for Adverse Judgment After Institution of Trial
37 C.F.R. § 42.73(b)

I. INTRODUCTION

Nevro Corp. (“Petitioner”) filed a Petition requesting *inter partes* review of claims 1–10, 23, and 32–38 of U.S. Patent No. 7,177,690 B2 (the “’690 patent”). Paper 1 (“Petition”). Boston Scientific Neuromodulation Corp. (“Patent Owner”) filed a Preliminary Response to the Petition. Paper 8. Patent Owner filed a statutory disclaimer of claim 23 in the ’690 patent file on October 23, 2019, and along with its Preliminary Response. Ex. 2001; Paper 8, 1–2. Claim 23 having been disclaimed by Patent Owner, we instituted an *inter partes* review as to challenged claims 1–10 and 32–38 on January 21, 2020. Paper 9.

On May 29, 2020, Petitioner and Patent Owner filed a Joint Stipulation of Modification for Due Dates 1–3 and 5–6 (“Stipulation”). Paper 21. Pursuant to the Stipulation, the deadline (Due Date 1) for Patent Owner to file its response and a motion to amend the ’690 patent was extended to June 12, 2020. *Id.* at 2. However, Patent Owner did not file its response or a motion to amend on or before June 12, 2020.

On June 30, 2020, Petitioner forwarded an e-mail to the Board regarding the Patent Owner’s “failure to file a patent owner response or a motion to amend,” detailing Petitioner’s efforts to communicate with Patent Owner regarding the “failure to file,” and requesting a conference call with the Board to discuss the matter. Ex. 3001. On July 6, 2020, Patent Owner forwarded an e-mail to the Board requesting authorization to file a motion seeking entry of an adverse judgment in the present *inter partes* review, which we authorized on July 8, 2020. *Id.*

On July 8, 2020, Patent Owner filed a Request for Adverse Judgment Pursuant to 37 C.F.R. § 42.73(b), asking the Board to “cancel the instituted claims” (1–10 and 32–38) and “enter an adverse judgement against Patent

Owner and terminate this proceeding.” Paper 22, 2. Patent Owner also represented that “[c]ounsel for Petitioner has stated that Petitioner does not oppose the requested relief.” *Id.*

II. DISCUSSION

Under 37 C.F.R. § 42.73(b), “[a] party may request judgment against itself at any time during a proceeding.” As permitted by this Rule, Patent Owner has explicitly asked the Board to enter adverse judgment cancelling claims 1–10 and 32–38 of the ’690 patent. Paper 22. Claims 1–10 and 32–38 are the only claims at issue in this proceeding. *See* Paper 9, 1, 2, 29.

III. CONCLUSION

Having reviewed Patent Owner’s request for adverse judgment, we determine that entry of judgment against Patent Owner cancelling claims 1–10 and 32–38 of the ’690 patent is appropriate. Thus, we grant the request for adverse judgment pursuant to 37 C.F.R. § 42.73(b). This constitutes a final written decision pursuant to 35 U.S.C. § 318(a) cancelling claims 1–10 and 32–38 of the ’690 patent.

IV. ORDER

Accordingly, it is

ORDERED that adverse judgment is entered against Patent Owner pursuant to 37 C.F.R. § 42.73;

FURTHER ORDERED that claims 1–10 and 32–38 of the ’690 patent are cancelled;

FURTHER ORDERED that this constitutes a Final Written Decision under 35 U.S.C. § 318(a);

FURTHER ORDERED that Patent Owner shall file a notice and copy of this judgment in the files of any proceeding or action involving the ’690 patent; and

IPR2019-01216
Patent 7,177,690 B2

FURTHER ORDERED that, pursuant to 37 C.F.R. § 42.73(d)(3), Patent Owner is precluded from taking any action inconsistent with this judgment, including obtaining any patent claim that is not patentably distinct from a cancelled claim in this proceeding.

FOR PETITIONER:

Ching-Lee Fukuda
Sharon Lee
Matthew Hopkins
SIDLEY AUSTIN LLP
clfukuda@sidley.com
sharon.lee@sidley.com
matthew.hopkins@sidley.com

Jon Wright
STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.
jwright-ptab@skgf.com

FOR PATENT OWNER:

David A. Caine
Wallace Wu
ARNOLD & PORTER KAYE SCHOLER LLP
david.caine@arnoldporter.com
wallace.wu@arnoldporter.com