Paper No. _____
Date Filed: August 8, 2013

Filed on behalf of: Medtronic, Inc.

By:

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Lombard Medical Technologies PLC
Petitioner,
v.
Medtronic, Inc.
Patent Owner.

Case IPR2013-00269
U.S. Patent 6,306,141

PRELIMINARY RESPONSE BY PATENT OWNER MEDTRONIC INC.
UNDER 37 C.F.R. § 42.107

Patent Owner Medtronic Inc. (hereinafter, "Patent Owner") hereby respectfully submits this Preliminary Response to the Petition seeking *inter partes* review in this matter. A trial should not be instituted based on Ground #6 because there is no statutory basis for the Petitioner to raise a challenge based on obviousness-type double-patenting in an *inter partes* review. In addition, although none of the references or combinations of references that Petitioner relies upon is reasonably likely to result in the invalidation of any one of claims 1-10 and 18-22 of U.S. Patent No. 6,306,141 ("the '141 patent") [Grounds 1-5], Patent Owner has not addressed those substantive issues in this Preliminary Response.

Ground 6 of the Petition requests invalidation of the claims-at-issue "under the doctrine of obviousness-type double patenting over the claims of U.S. Patent No. 5,597,378 to Jervis." (Petition at 3) The America Invents Act strictly limits the grounds on which a petitioner can seek review in an *inter partes* review to only those arguments "that could be raised under section 102 or 103 and only on the basis of prior art consisting of patents or printed publications." 35 U.S.C. § 311(b) (emphasis added). Petitioner's obviousness-type double patenting challenge is thus impermissible for two reasons: (1) it is based on a judicially-created doctrine stemming from Section 101, not Section 102 or 103; and (2) U.S. Patent No. 5,596,378 ("the '378 patent") is not prior art to the '141 patent because they are both in the same patent family.

Obviousness-type double patenting is not a statutory rejection based on either 35 U.S.C. § 102 or § 103; it is a judicially created doctrine. *See In re Braat*, 937 F.2d 589, 592 (Fed. Cir. 1991); *In re Berg*, 140 F.3d 1428, 1431 (Fed. Cir. 1998). Moreover, obviousness-type double patenting has its roots in 35 U.S.C. § 101, which prohibits patenting of the same invention twice. *See Ex parte Davis*, No. 1999-1924, 56 U.S.P.Q.2d 1434, 1435 (B.P.A.I. May 1, 2000). The judicially created variation "extends the fundamental legal doctrine [prohibiting double-patenting] to preclude 'obvious variants' of what has already been patented." *Id*. In other words, obviousness-type double patenting cannot be the basis for *inter partes* review because it is the wrong sort of claim rejection (based on judicial doctrine, rather than statute), and derives from the wrong statute (Section 101, not Section 102 or 103). Moreover, it is well established that "the patent principally underlying the [obviousness-type] double patenting rejection is not considered prior art." MPEP § 804(II)(B)(1) (8th ed. Rev. 7, July 2008). In this case, the '378 patent and the '141 patent both claim ultimate priority to the same patent application— Appl. No. 06/541,852, filed October 14, 1983. Thus, the '378 patent is not prior art to the '141 patent.

Because obviousness-type double patenting is a non-statutory, non-prior-art-based argument, it is not a permissible basis for *inter partes* review under 35 U.S.C. § 311(b). Therefore, review of claims 1-10 and 18-22 should not be instituted based on at least Ground 6.

Dated: August 8, 2013

Respectfully submitted,

/Justin J. Oliver/

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CERTIFICATE OF SERVICE

The undersigned certifies service on the Petitioner, pursuant to 37 C.F.R. § 42.6(e), by FEDERAL EXPRESS delivery of a true copy of the foregoing PRELIMINARY RESPONSE BY PATENT OWNER MEDTRONIC INC. UNDER 37 C.F.R. § 42.107 to lead counsel of record for Petitioner as follows:

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Dated: August 8, 2013

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