

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Patent of: Gliner, et al.

U.S. Patent No.: 5,836,978

Attorney Docket No.: 38855-0004IP1

Issue Date: November 17, 1998

Appl. Serial No.: 08/909,656

Filing Date: August 12, 1997

Title: ELECTROTHERAPY METHOD FOR PRODUCING A MULTIPHASIC  
DISCHARGE BASED UPON A PATIENT-DEPENDENT ELECTRICAL  
PARAMETER AND TIME

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**PETITION FOR *INTER PARTES* REVIEW OF UNITED STATES PATENT NO. 5,836,978**  
**PURSUANT TO 35 U.S.C. §§ 311–319, 37 C.F.R. § 42**

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## EXHIBITS

LIFECOR978 -1001	U.S. Patent No. 5,836,978 to Bradford E. Gliner, et al. (“978 Patent”)
LIFECOR978 -1002	Prosecution History of the ‘978 Patent
LIFECOR978 -1003	Declaration of Wayne C. McDaniel, Ph.D.
LIFECOR978 -1004	U.S. Patent No. 3,782,389 (Bell)
LIFECOR978 -1005	Schuder 1984 et al., <i>Transthoracic Defibrillation of 100 Kg Calves with Bidirectional Truncated Exponential Shocks</i> , Transactions – American Society for Artificial Internal Organs, Vol. 30, Issue 1 (1984).
LIFECOR978 -1006	U.S. Patent No. 5,431,686 (Kroll)
LIFECOR978 -1007	U.S. Patent No. 4,850,357 (Bach)
LIFECOR978 -1008	<i>Koninklijke Philips Electronics NV v. Defibtech LLC</i> , Case No. C03-1322JLR, Order dated Dec. 21, 2005
LIFECOR978 -1009	U.S. Patent No. 5,735,879 (Gliner)
LIFECOR978 -1010	American Heritage Dictionary (3d ed. 1992), page 1167

## I. INTRODUCTION

ZOLL Lifecor Corporation (“Petitioner” or “Lifecor”) petitions for *Inter Partes* Review (“IPR”) under 35 U.S.C. §§ 311–319 and 37 C.F.R. § 42 of claims 1-7 (“the IPR Claims”) of U.S. Patent No. 5,836,978 (“’978 Patent”) of Bradford E. Gliner, et al. (“Patentee” or “Gliner, et al.”). As explained in this petition, there exists a reasonable likelihood that Lifecor will prevail with respect to at least one claim challenged in this petition.

The ‘978 Patent claims methods for delivering electrotherapy to a patient using a simple technique in which delivery of energy to the patient’s heart is based on a monitored electrical parameter (e.g., voltage or energy), and a measured period of time. But the patent was improvidently granted without full consideration to the wide body of applicable prior art, such as that relied on in this petition. For example, both U.S. Patent 3,782,389 (“Bell”; LIFECOR978-1004) and U.S. Patent 4,850,357 (“Bach”; LIFECOR978-1007) expressly disclose a limitation that was asserted during prosecution to distinguish over the cited art, namely, a method in which “the electrical parameter and time are monitored simultaneously.” (Amendment filed 4/28/97 at 3). And the other claim limitations are taught either by Bell, Bach, and/or Schuder 1984, the other reference presented in this petition. Moreover, Patent Owner has obtained multiple patents in the same family without submitting terminal disclaimers, and at least one of the claims in the patent is invalid for obviousness-type double patenting over one or more of such related patents. Petitioner respectfully submits that *Inter Partes* Review should be instituted, and the challenged claims be canceled as unpatenta-

ble.

**II. MANDATORY NOTICES UNDER 37 C.F.R § 42.8(a)(1)**

**A. Real Party-In-Interest Under 37 C.F.R. § 42.8(b)(1)**

Petitioner, ZOLL Lifecor Corporation, is the real party-in-interest.

**B. Related Matters Under 37 C.F.R. § 42.8(b)(2)**

Petitioner is not aware of any disclaimers or reexamination certificates for the '978 Patent. Petitioner has been named as a defendant in a recently-filed litigation concerning the '978 Patent, *Koninklijke Philips N.V. and Philips Electronics North America Corp. v. ZOLL Lifecor Corp*, Civil No. 12-1369 (W.D. Pa.). Lifecor has also petitioned—on this same day—for *Inter Partes* Review of other patents at issue in that litigation: U.S. Patent No. 5,735,879 (“the ‘879 Patent”), U.S. Patent No. 5,749,905 (“the ‘905 Patent”), U.S. Patent No. 6,047,212 (“the ‘212 Patent”), U.S. Patent No. 5,607,454 (“the ‘454 Patent”), U.S. Patent No. 5,749,904 (“the ‘904 Patent”), U.S. Patent No. 5,803,927 (“the ‘927 Patent”), and U.S. Patent No. 5,593,427 (“the ‘427 Patent”) (collectively, “the Philips Waveform Patents,” all of which are owned by Koninklijke Philips N.V. and/or Philips Electronics North America Corp. (“Patent Owner” or “Philips”)).

**C. Lead And Back-Up Counsel Under 37 C.F.R. § 42.8(b)(3)**

Petitioner provides the following designation of counsel:

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