

Filed on behalf of: Philips Electronics North America Corporation

By: J. Michael Jakes
Denise W. DeFranco
Finnegan, Henderson, Farabow,
Garrett & Dunner, L.L.P.
901 New York Avenue, NW
Washington, DC 20001-4413
Telephone: 202-408-4000
Facsimile: 202-408-4400
E-mail: mike.jakes@finnegan.com
denise.defranco@finnegan.com

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ZOLL LIFECOR CORPORATION
Petitioner

v.

PHILIPS ELECTRONICS NORTH AMERICA CORPORATION
Patent Owner

Case IPR2013-00616
Patent 5,749,905

**Patent Owner's Preliminary Response
to Petition for *Inter Partes* Review
of U.S. Patent No. 5,749,905**

Table of Contents

I. Introduction.....1

II. The Petition Fails to Meet the Requirements for Instituting an
Inter Partes Review3

A. The Pending Petition Should Be Denied Under 35 U.S.C.
§ 315(b) Based on the One-Year Litigation Bar3

1. Philips Served a Complaint on Zoll Medical Alleging
Infringement of the '905 Patent Three Years Before Zoll
Lifecor Filed the Pending Petition4

2. Zoll Medical Is a Real Party in Interest in this Proceeding6

a) Public Documents Show that Parent Zoll Medical
Controls Its Wholly Owned Subsidiary, Zoll
Lifecor.....8

b) Zoll Medical Controls Zoll Lifecor’s Involvement
in the Pennsylvania Action and in this Proceeding12

3. Zoll Medical Is Also a Privy of the Petitioner, Zoll
Lifecor14

a) Zoll Medical Is a Privy Because of Its Relationship
to the Infringing Product.....14

b) As Zoll Lifecor’s Corporate Parent, Zoll Medical
Has Standing, and “Could have Exercised Control
Over” This Proceeding15

c) Zoll Medical Is a Privy of the Petitioner, Zoll
Lifecor, Because Their Relationship Justifies
Applying Estoppel and Preclusion18

4. The Statute, Prior Board Decisions, and Legislative
History Support Denying the Pending Petition24

B.	The Filing Date Should Be Vacated Because Petitioner Did Not Identify all Real Parties in Interest or Related Litigations, as Required by 35 U.S.C. § 312 and 37 C.F.R. § 42.8	28
1.	Zoll Medical Is an Unidentified Real Party in Interest.....	30
2.	The Petitioner Failed to Identify all Related Matters	31
III.	Claim Construction.....	37
A.	Overview of the '905 Patent.....	37
B.	Claim Construction Standard and Prior Claim Construction Decisions	39
C.	Claim Terms	41
1.	“monitoring”	41
2.	“energy source”	43
3.	“patient-dependent electrical parameter”.....	44
4.	“multiphasic (truncated exponential) waveform”.....	46
5.	“shaping”	47
IV.	Conclusion	47

TABLE OF AUTHORITIES

	Page(s)
FEDERAL CASES	
<i>Astron Industrial Associates, Inc. v. Chrysler Motors Corp.</i> , 405 F.2d 958 (5th Cir. 1968)	19, 20
<i>Copperweld Corp. v. Independence Tube Corp.</i> , 467 U.S. 752 (1984).....	16
<i>Dalton v. Honda Motor Co.</i> , 425 F. App'x 886 (Fed. Cir. 2011)	17, 18, 22
<i>Doe v. Urohealth Sys., Inc.</i> , 216 F.3d 157 (1st Cir. 2000).....	20, 21, 22
<i>G & T Terminal Packaging Co. v. Consolidated Rail Corp.</i> , 719 F. Supp. 153 (S.D.N.Y. 1989)	19
<i>Gambocz v. Yelencsics</i> , 468 F.2d 837 (3d Cir. 1972)	19
<i>In re Rambus Inc.</i> , 694 F.3d 42 (Fed. Cir. 2012)	39
<i>In re Vision Serv. Plan Tax Litigation</i> , No. 2:07-md-1829, 2010 WL 2572076 (S.D. Ohio June 22, 2010)	21, 22
<i>Mars Inc. v. Nippon Conlux Kabushiki-Kaisha</i> , 58 F.3d 616 (Fed. Cir. 1995)	20, 21, 27
<i>Phillips v. AWH Corp.</i> , 415 F.3d 1303 (Fed. Cir. 2005)	39, 42
<i>Taylor v. Sturgell</i> , 553 U.S. 880 (2008).....	7
<i>Universal Oil Products Co. v. Rexall Drug & Chemical Co.</i> , 463 F.2d 1122 (C.C.P.A. 1972).....	17
<i>Vitronics Corp. v. Conceptronic, Inc.</i> , 90 F.3d 1576 (Fed. Cir. 1996)	41

PATENT AND TRADEMARK OFFICE DECISIONS

Accord Healthcare, Inc., USA v. Eli Lilly & Co.,
IPR2013-00356, Paper 13 (PTAB Oct. 1, 2013).....22, 25, 26

Apple Inc. v. VirnetX, Inc.,
IPR2013-00348, Paper 14 (PTAB Dec. 13, 2013)25, 26

Apple Inc. v. VirnetX, Inc.,
IPR2013-00349, Paper 14 (PTAB Dec. 13, 2013)25, 26

Apple Inc. v. VirnetX, Inc.,
IPR2013-00354, Paper 20 (PTAB Dec. 13, 2013)25, 26

Apple Inc. v. VirnetX, Inc.,
IPR2013-00393, Paper 17 (PTAB Dec. 18, 2013)25, 26

Apple Inc. v. VirnetX, Inc.,
IPR2013-00394, Paper 15 (PTAB Dec. 18, 2013)25, 26

Apple Inc. v. VirnetX, Inc.,
IPR2013-00397, Paper 15 (PTAB Dec. 18, 2013)25, 26

Apple Inc. v. VirnetX, Inc.,
IPR2013-00398, Paper 16 (PTAB Dec. 18, 2013)25, 26

BioDelivery Sciences International, Inc. v. Monosol RX, LLC,
IPR2013-00315, Paper 31 (PTAB Nov. 13, 2013).....26

In re Guan,
Reexamination Proceeding Control No. 95/001,045,
Decision Vacating Filing Date at 8 (Aug. 25, 2008).....30, 31

St. Jude Medical, Cardiology Div., Inc. v. Volcano Corp.,
IPR2013-00258, Paper 29 (PTAB Oct. 16, 2013).....25, 26

Synopsys, Inc. v. Mentor Graphics Corp.,
IPR2012-00042, Paper 16 (PTAB Feb. 22, 2013).....15

Universal Remote Control, Inc. v. Universal Electronics, Inc.,
IPR2013-00168, Paper 9 (PTAB Aug. 26, 2013).....24, 25, 26

Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

Real-Time Litigation Alerts



Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

Advanced Docket Research



With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

Analytics At Your Fingertips



Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

LAW FIRMS

Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

FINANCIAL INSTITUTIONS

Litigation and bankruptcy checks for companies and debtors.

E-DISCOVERY AND LEGAL VENDORS

Sync your system to PACER to automate legal marketing.