

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MEDTRONIC, INC., and MEDTRONIC VASCULAR, INC.,
Petitioner,

v.

MARITAL DEDUCTION TRUST and ENDOTACH LLC,
Patent Owner.

Case IPR2014-00100
Patent 5,593,417

Before JACQUELINE WRIGHT BONILLA, MICHAEL J. FITZPATRICK, and
HYUN J. JUNG, *Administrative Patent Judges*.

BONILLA, *Administrative Patent Judge*.

FINAL WRITTEN DECISION
35 U.S.C. § 318(a) and 37 C.F.R. § 42.73

I. INTRODUCTION

A. Background

Petitioner Medtronic, Inc. and Medtronic Vascular, Inc. (“Petitioner”) filed a corrected Petition (Paper 5, “Pet.”) to institute an *inter partes* review of claims 1, 2, 9, 10, and 13 of U.S. Patent No. 5,593,417 (Ex. 1001, “the ’417 patent”). 35 U.S.C. § 311. Patent Owner, the Marital Deduction Trust, and its exclusive licensee Endotach LLC (“Patent Owner”)¹ did not file a Preliminary Response. We determined that the information presented in the Petition demonstrated that there was a reasonable likelihood that Petitioner would prevail in challenging claims 1, 2, 9, 10, and 13 of the ’417 patent as unpatentable. Paper 15 (“Dec. to Inst.”), 2, 15. Pursuant to 35 U.S.C. § 314, we instituted this proceeding on March 25, 2014, to review whether Kornberg² anticipates claims 1, 2, 9, 10, and 13 of the ’417 patent under 35 U.S.C. § 102, and also whether those claims would have been obvious over Rhodes ’154³ and Kornberg under 35 U.S.C. § 103. Dec. to Inst. 15.

After institution of trial, Patent Owner filed a Patent Owner Response. Paper 27 (“PO Resp.”). Petitioner subsequently filed a Reply to the Response. Paper 35 (“Reply”). An oral hearing was held on November 20, 2014. A transcript of the hearing has been entered into the record. Paper 44 (“Tr.”).

¹ Patent Owner indicates that the Marital Deduction Trust, created under the Valentine J. Rhodes Revocable Trust, is the owner of the ’417 patent, while Endotach LLC is the exclusive licensee of all substantial interests of the patent. Paper 10, 2; Paper 20, 2.

² Kornberg, U.S. Pat. No. 4,562,596, issued Jan. 7, 1986 (“Kornberg”) (Ex.1006).

³ Rhodes, U.S. Pat. No. 5,122,154, issued June 16, 1992 (“Rhodes ’154”) (Ex. 1008).

We have statutory authority under 35 U.S.C. § 6(c). This Final Written Decision is issued pursuant to 35 U.S.C. § 318(a). Petitioner has shown by a preponderance of the evidence that claims 1, 2, 9, 10, and 13 of the '417 patent are unpatentable.

B. Related Matters

Petitioner indicates that Patent Owner has asserted the '417 patent against it in *Endotach LLC v. Medtronic, Inc.*, No. 5:13-cv-03292-EJD (N.D. Cal.). Pet. 1. In its Mandatory Notices, Patent Owner identifies two other cases that may affect or be affected by this proceeding: *Endotach LLC v. Cook Medical Inc.*, No. 1:13-cv-1135 (S.D. Ind.) and *Endotach LLC v. W.L. Gore & Associates, Inc.*, No. 3:12-cv-00308 (N.D. Fla.). Paper 10, 2–3; Paper 20, 2–3.

On April 25, 2014, after we instituted a trial in the current case, Petitioner filed another Petition in Case IPR2014-00695, involving the same parties and same claims of the '417 patent at issue in this proceeding. IPR2014-00695, Paper 1 (“Second Petition”). Petitioner also filed a Motion for Joinder requesting “that the Second Petition be joined with IPR2014-00100.” IPR2014-00695, Paper 2, 2. The Second Petition reasserted two grounds of unpatentability previously asserted in this proceeding, as well as three new grounds relying on two additional references. Second Petition 10–11, 13–32. In a Decision dated September 25, 2014, we denied Petitioner’s Motion for Joinder, as well as Petitioner’s Second Petition. IPR2014-00695, Paper 18, majority op. at 9.

C. The '417 Patent (Ex. 1001)

The '417 patent relates to an intraluminal medical device, such as an endovascular graft or stent. Ex. 1001, 3:45–48. The patent discusses U.S. Pat. No. 5,122,154 (Ex. 1008, “Rhodes '154”), also relating to an intraluminal graft. Ex. 1001, 2:64–3:27. The '417 patent states the present graft device “is

constructed in accordance with the teachings of my aforementioned patent [Rhodes '154], except for the means for fixedly holding it in place within the vessel, duct, or lumen," i.e., the "anchoring means." *Id.* at 5:10–17.

Figures 2, 3, 7, and 8 of the '417 patent are reproduced below.

FIG. 2

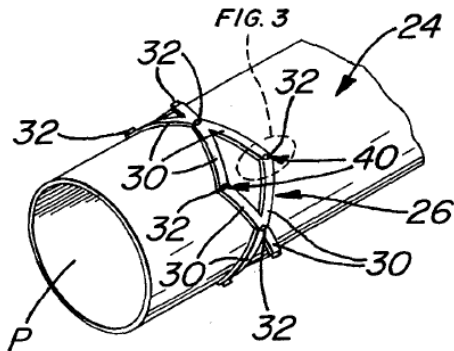


FIG. 3

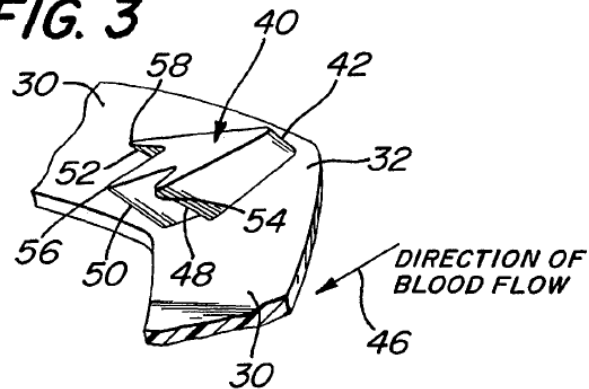


FIG. 7

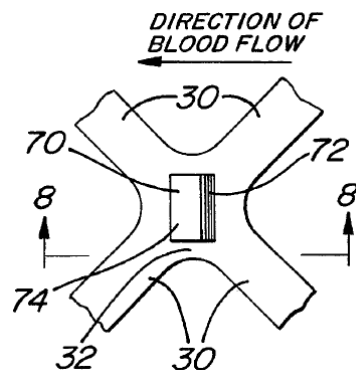


FIG. 8

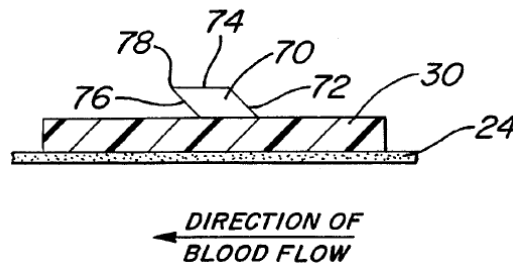


Figure 2 depicts a portion of an endovascular bypass graft. *Id.* at 4:47–52.

Figure 3 depicts an enlarged view of the portion in Figure 2 designated as “FIG. 3” with broken lines. *Id.* at 4:53–55. Figure 7 depicts another embodiment of a graft. *Id.* at 4:65–67. Figure 8 depicts an enlarged sectional view taken along line 8-8 of Figure 7. *Id.* at 5:1–2.

In Figure 2, the graft comprises tubular member 24 having a plurality of expandable, ring-like, stent members 26. *Id.* at 5:54–59. Each stent member 26 comprises a plurality of links 30, where each link is joined to another link by joint

32. *Id.* at 6:21–32. “In order to help hold or secure the graft in position in the artery (or lumen or duct) once the graft has been expanded,” the graft includes anchoring means comprising projections 40. *Id.* at 7:9–13. Figure 3 shows details of an embodiment of “arrow head” projections 40 on joint 32. *Id.* at 7:60–63. Each projection “includes a leading edge 42 defining the ‘tip’ of the ‘arrow-head,’” where “leading edge 42 extends upward at an acute angle to the exterior surface of the stent and terminates at the top surface 44 of the projection.” *Id.* at 7:63–67; *see also* Fig. 4. The projections also include trailing edges 48, 50, and 52, each of which “inclines upward in the direction of the blood flow to terminate at the top surface 44.” *Id.* at 8:2–6.

In another embodiment, shown in Figures 7 and 8, projections 70 are “wedge” shaped. *Id.* at 8:54–56. Leading surface 72 defines “the ‘front face’ of the ‘wedge,’” and “extends upward at an acute angle to the exterior surface of the stent and terminates at the top surface 74.” *Id.* at 8:56–58. The projections also include “trailing surface 76 which inclines upward in the direction of the blood flow to terminate at the top surface 74 in a penetration edge 78,” and “are preferentially oriented at an acute angle to the direction of blood flow.” *Id.* at 8:58–67.

D. Illustrative Claim

Claim 1, the only challenged independent claim, is reproduced below.

1. An intraluminal medical device for securement within a vessel, duct, or lumen of a living being, the vessel, duct, or lumen having an interior surface, said device comprising a tubular member and anchoring means,

said tubular member having a passageway extending therethrough and an outer periphery, said tubular member being arranged to have a body fluid flow through said passageway in a first direction when said device is located within the vessel, duct, or lumen, whereupon a force is applied to said tubular-member,

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