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Paper 15
Entered: March 25, 2014

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

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

v.

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*.

DECISION
Institution of *Inter Partes* Review
37 C.F.R. § 42.108

I. INTRODUCTION

A. Background

Petitioner Medtronic, Inc. and Medtronic Vascular, Inc. ("Medtronic") 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"), pursuant to 35 U.S.C. § 311. Patent Owner Endotach LLC ("Endotach") did not file a Preliminary Response. We have jurisdiction under 35 U.S.C. § 314.

The standard for instituting an *inter partes* review is set forth in 35 U.S.C. § 314(a), which provides:

> THRESHOLD—The Director may not authorize an inter partes review to be instituted unless the Director determines that the information presented in the petition filed under section 311 and any response filed under section 313 shows that there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.

For the reasons set forth below, we conclude that Medtronic has shown that, under 35 U.S.C. § 314(a), there is a reasonable likelihood that it would prevail with respect to at least one of the challenged claims. We institute an *inter partes* review of claims 1, 2, 9, 10, and 13 of the '417 patent.

B. Related Matters

Medtronic indicates that Endotach asserted the '417 patent against it in *Endotach LLC v. Medtronic, Inc. and Medtronic Vascular, Inc.*, No. 5:13-cv-03292-EJD (N.D. Cal.). Pet. 1. In its Mandatory Notices, Endotach 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.

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.

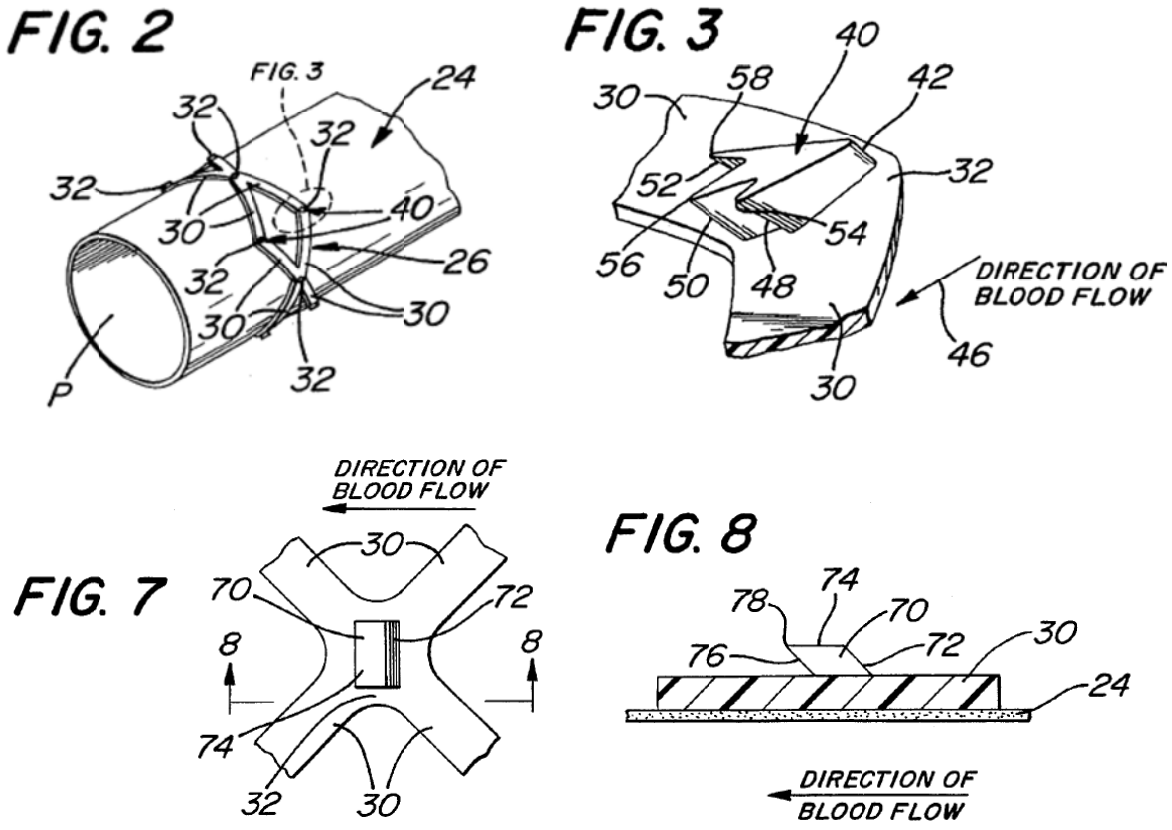

Figure 2 depicts a portion of an endovascular bypass graft. *Id*. at 4:47-52. Figure 3 depicts an enlarged view of the portion in Figure 2 designated as "FIG. 3" with broken lines. *Id*. at 4:53-55. Figure 7 depicts another embodiment of a graft. *Id*.

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,
>
> said *anchoring means* being located adjacent said outer periphery of said tubular member and *comprising plural projections* arranged for engagement with the interior surface of the vessel, duct, or lumen,
>
> each of said projections having *a leading portion located in the upstream direction of the fluid flow* and *a trailing portion located in the downstream direction thereof, said trailing portion including at least one surface preferentially oriented to extend at an acute angle to the first direction*,
>
> whereupon the force applied to said tubular member by the fluid flowing through said passageway produces on each of said projections a force component to cause said at least one surface to tightly engage the interior surface of the vessel, duct, or lumen to fixedly secure said device in place.

Id. at 9:23-45 (paragraph indentation and emphasis added).

E. Prior Art Relied Upon

Medtronic relies upon the following prior art references:

Lazarus, U.S. Pat. No. 5,104,399, issued Apr. 14, 1992 ("Lazarus") (Ex. 1005);

Kornberg, U.S. Pat. No. 4,562,596, issued Jan. 7, 1986 ("Kornberg") (Ex.1006);

Marin, U.S. Pat. No. 5,397,355, issued Mar. 14, 1995 ("Marin") (Ex. 1007); and

Rhodes, U.S. Pat. No. 5,122,154, issued Jun. 16, 1992 ("Rhodes '154") (Ex. 1008).

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