

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

Attorney Docket No. 058888-0000015

**REQUEST FOR AUTHORIZATION TO FILE MOTION TO SUBMIT
SUPPLEMENTAL INFORMATION UNDER 37 C.F.R. § 42.123(a)**

In advance of the initial conference call scheduled for Thursday, April 17, 2014, Petitioner requests authorization under 37 C.F.R. § 42.123(a) to file a motion to submit supplemental information relevant to a claim for which the trial has been instituted. Specifically, Petitioner requests authorization to file a motion to submit supplementation information to present additional grounds of unpatentability because it meets the requirements of 37 C.F.R. § 42.123(a) – specifically: (1) this authorization request is being made within one month of the trial institution date of March 26, 2014; and (2) the supplemental information is relevant to a claim (i.e., claim 1) for which the trial has been instituted.

Petitioner’s request for authorization to file a motion to submit supplemental information should be granted at least because:

- (1) Petitioner has become aware of three secondary references that were unknown to it when the Petition was filed, and which are likely to be relevant to the grounds for which trial has been granted based upon Patent Owner’s claim interpretation in concurrent litigation.
- (2) Specifically, in co-pending litigation over the ‘417 patent between Patent Owner and Petitioner, Petitioner’s litigation counsel, Karen McDaniel of the Briggs and Morgan firm, received Patent Owner’s Infringement Contentions on February 18, 2014 (attached hereto as Exhibit 1009);

(3) In those Infringement Contentions, citing to claim construction rulings in other litigation involving the same patent (*Endotach LLC v. Cook Medical Inc.*, 1:12-cv-1630-LJM-DKL, Southern District of Indiana (Dkt. No. 102)), Patent Owner posits that the term “engage” means “to partly embed, interlock or enmesh,” while the term “tightly engage” in claim 1 excludes penetration that perforates or creates holes through the wall.

(4) The underlined language above is entirely absent from claim 1 when read literally.

(5) While Petitioner appreciates that the rules for claim interpretation used in district court litigation are different than the “broadest reasonable interpretation in light of the specification” used for these IPR proceedings, Petitioner nevertheless expects that Patent Owner will attempt to argue for the same interpretation in these proceedings.

(6) On the basis of Patent Owner’s Infringement Contentions, Petitioner’s litigation counsel performed a prior art search in March 2014 that uncovered three prior art secondary references that show stent projections that partly embed, interlock or enmesh in the surrounding vessel. Specifically, those references are: U.S. Patent No. 5,562,725 to Schmitt, U.S. Patent No. 5,370,657 to Irie, and U.S. Patent

No. 3,952,747 to Kimmel (attached hereto as Exhibits 1010, 1011, and 1012). Petitioner was not in possession of these three secondary references prior to the Petition's filing date of October 31, 2013 for this IPR proceeding.

(7) These three secondary references are highly material to patentability in the context of arguments Petitioner now expects Patent Owner to assert in these proceedings. Petitioner proposes to add these three secondary references to show that this specific attribute is clearly well known in the art.

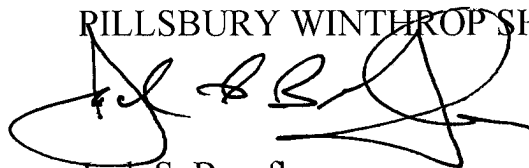
As indicated above, Petitioner (and its litigation and IPR counsels) was not in possession of the relevant Infringement Contention documents or the additional prior art references until after the IPR petition's filing date of October 31, 2013.

Accordingly, authorization for Petitioner to file a motion to submit supplemental information under 37 C.F.R. § 42.123(a) to present the additional grounds for unpatentability should be granted.

Respectfully submitted,

Date: April 15, 2014

RILLSBURY WINTHROP SHAW PITTMAN LLP

A handwritten signature in black ink, appearing to read 'J. Barufka', written over the firm name.

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