

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 IPR2014-00695
Case IPR2014-00100¹
Patent 5,593,417

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

BONILLA, *Administrative Patent Judge*.

CONFERENCE CALL SUMMARY AND ORDER

Conduct of Proceeding
37 C.F.R. § 42.5

¹ We exercise our discretion to issue one Decision to be entered in each case. The parties may not use this style heading absent our leave.

1. Introduction

On May 22, 2014, a conference call was conducted between counsel for Petitioner, Jack Barufka and Ngai Zhang; counsel for Patent Owner, Matthew Phillips; and Judges Bonilla, Fitzpatrick, and Jung. Both parties requested the call to discuss a Motion for Joinder (Paper 2, “Joinder Motion”) filed by Petitioner, along with its Petition (Paper 1), on April 25, 2014, in IPR2014-00695. The Joinder Motion requests joinder of IPR2014-00695 with IPR2014-00100, which involve the same parties, as well as the same patent and challenged claims. This panel instituted an *inter partes* review in IPR2014-00100 on March 25, 2014. Prior to the call, Petitioner submitted to the Board by e-mail correspondence a proposed scheduling order that Petitioner indicated is “acceptable to both parties” in the event the Board grants the Joinder Motion.

2. Discussion

During the call, counsel for Petitioner emphasized that the parties worked together to agree upon the proposed scheduling order. Counsel for Patent Owner stated that Patent Owner intends to file a preliminary response in IPR2014-00695, but also requests joinder in the event the Board decides to institute review based on any ground in the Petition in this proceeding.

It is premature to decide the Joinder Motion or adopt the proposed scheduling order before we decide whether to institute review in IPR2014-00695 in the first instance. If we deny institution, for example, the Joinder Motion and proposed schedule become moot. That said, during the call, we provided guidance to the parties in relation to what the Board might find acceptable when considering the Joinder Motion in the event that we grant institution.

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First, as stated in the call, we appreciate the agreement between the parties regarding the proposed scheduling order, as well as obvious good efforts to offer a compressed schedule, including an accelerated due date for Patent Owner's preliminary response. Such efforts will help ensure that both proceedings will conclude within one year of institution in the first case, IPR2014-00100. We note, however, that the proposal to move the oral hearing date far beyond the current hearing date in IPR2014-00100 of November 20, 2014, will most likely not be acceptable to the panel. Thus, we suggest that the parties propose a schedule that allows for a hearing date closer to November 20, 2014, such as sometime before the holidays in December 2014, rather than on January 9, 2015.

On this note, because Patent Owner has indicated that it will file a preliminary response and will not oppose joinder in the event of institution, we suggest that Patent Owner file a response to Petitioner's Joinder Motion, indicating agreement between the parties regarding a possible joinder, as well as providing a revised proposed scheduling order along the lines discussed above.

As also indicated during the call, regardless of the joinder issue, the parties may stipulate to different dates for DUE DATES 1-5 (earlier or later, but no later than DUE DATE 6) in IPR2014-00100. A notice of such stipulation, specifically identifying the changed due dates, must be promptly filed. Currently, the DUE DATES in IPR2014-00100 remain as indicated in the Scheduling Order (Paper 16) for that proceeding.

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Accordingly, it is

ORDERED that Patent Owner is authorized to file a response to Petitioner's Motion for Joinder at the same time it files its preliminary response, including a revised proposed scheduling order as an appendix; and

FURTHER ORDERED that the parties may stipulate to different dates for DUE DATES 1 through 5 (earlier or later, but no later than DUE DATE 6) in IPR2014-00100.

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