

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

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

v.

MARITAL DEDUCTION TRUST
Patent Owner

Case IPR2014-00100
Patent 5,593,417

Attorney Docket No. 058888-0000015

PETITIONER'S REPLY TO PATENT OWNER'S RESPONSE

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TABLE OF REFERENCED EXHIBITS AND OTHER DOCUMENTS

Abbreviation	Exhibit	Description
Resp.	-	Patent Owner Response
'417	1001	U.S. Patent No. 5,593,417 to Rhodes
Kornberg	1006	U.S. Patent No. 4,562,596 to Kornberg
'154	1008	U.S. Patent No. 5,122,154 to Rhodes
Chuter	2009	U.S. Patent No. 5,387,235 to Chuter
Lazarus	2010	U.S. Patent No. 5,397,345 to Lazarus
Tessman	2004	U.S. Patent No. 5,167,614 to Tessman
Rowe Decl.	1003	Declaration of Travis Rowe
Gupta Decl.	1004	Declaration of Atul Gupta
Silver Decl.	2002	Declaration of James Silver, Ph.D.
Rowe Tr.	2023	Transcript of Deposition of Travis Rowe
Gupta Tr.	2021	Transcript of Deposition of Atul Gupta
Silver Tr.	1014	Transcript of Deposition of James Silver
-	1018	Ex. 4 to the Deposition of James Silver (Drawing)
-	1019	Ex. 5 to the Deposition of James Silver (Drawing)
-	1020	Ex. 6 to the Deposition of James Silver (Drawing)
-	1021	Ex. 7 to the Deposition of James Silver (Drawing)
-	1022	Ex. 8 to the Deposition of James Silver (Drawing)
-	1023	Ex. 9 to the Deposition of James Silver (Drawing)
-	1024	Ex. 10 to the Deposition of James Silver (Drawing)

I. A FINDING THAT INDEPENDENT CLAIM 1 IS UNPATENTABLE IS DISPOSITIVE OF DEPENDENT CLAIMS 2, 9, 10, AND 13

The Patent Owner argues that independent claim 1 is patentable, but does not separately address the dependent claims. *See* Resp. at 39 and 42 (arguing “dependent claims 2, 9, 10 or 13” are patentable only because they “include all of the limitations of claim 1”). It therefore is not necessary to separately consider the patentability of the dependent claims. *See, e.g., Garmin International, Inc. v. Cuozzo Speed Technologies, LLC*, IPR2012-00001 (Paper 59 at 47, Nov. 13, 2013).

II. THE CLAIMS ARE ANTICIPATED BY KORNBERG

A. Kornberg Satisfies All the Structural Requirements of the Claims

Claim 1, directed to “[a]n intraluminal medical device,” recites structural elements followed by a “whereupon clause.” The Patent Owner **does not** argue that Kornberg fails to disclose any structural elements of claim 1, and instead focuses **exclusively** on the whereupon clause. *See* Resp. at 31 (“Kornberg does not anticipate those claims because it fails to teach or suggest the [whereupon clause]”). *See also* Resp. §§IV.A, B and C and Silver Decl., ¶¶62, 69, 70, 76 (same arguments). Thus, if the whereupon clause is not a limitation (*see* §II.B below), or it is a limitation which is met by Kornberg (*see* §II.C below), the claims are anticipated by Kornberg.

B. The “Whereupon Clause” Is Not A Limitation

The whereupon clause in claim 1 should not be given any patentable weight

because it simply expresses the intended result of the structural limitations recited in the claim. MPEP 2111.04; *Lockheed Martin Corp. v. Space Systems/Loral, Inc.*, 324 F.3d 1308, 1319 (Fed. Cir. 2003) (no consideration given to whereby clause in claim to a satellite control system “because a whereby clause that merely states the result of the limitations in the claim adds nothing to the substance of the claim”).

Claim 1 recites the structural details of the “anchoring means” of the claimed “intraluminal medical device” as a plurality of projections that includes a leading portion located in the upstream direction of the fluid flow, and a trailing portion located in the downstream direction of blood flow that is “oriented to extend at an acute angle” to the direction of blood flow. ‘417, claim 1.

The whereupon clause that immediately follows expresses the intended result of a device having such projections, namely, to allow fluid force to cause the projections to “tightly engage” with the vessel’s interior surface “to fixedly secure the device in place.” *Id.* This is consistent with the patent’s specification which follows a description of the structure of the projections with statements that it “will be appreciated by those skilled in the art” that the force applied to the projections by the blood flow through the device “will tend to force the projections 40 into good engagement with the wall 12 of the vessel, duct, or lumen.” *Id.*, 8:1-21.

Because the whereupon clause simply expresses the intended result of the structural limitations in the claim, it should not be given any patentable weight.

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