

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MEDTRONIC, INC., MEDTRONIC VASCULAR, INC.,
and MEDTRONIC COREVALVE, LLC
Petitioner

v.

TROY R. NORRED, M.D.
Patent Owner

Case IPR2014-00110
Patent 6,482,228

DECLARATION OF JAMES J. KERNELL

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Medtronic, Inc., Medtronic Vascular, Inc.,
Medtronic Corevalve, LLC
v. Troy R. Norred, M.D.

I, James J. Kernell, declare as follows:

1. I am the attorney that prepared and prosecuted the application for United States Patent No. 6,482,228 (the “228 patent”). In preparing this declaration, I have reviewed my workload and correspondence from the date I first met with Dr. Troy R. Norred until the date the patent application was filed. I have personal knowledge of the following facts and would and could testify competently regarding the following statements if called as a witness.

2. I passed the patent bar in 1997 and graduated from law school in 2000. Following graduation, I began work as an associate at the law firm then known as Chase & Yakimo, L.C. (“Chase & Yakimo”). As an associate with Chase & Yakimo, I was the attorney primarily responsible for legal research for legal issues pertinent to the other attorneys’ cases and clients as assigned. Other duties included client consultations and conferences, and preparing drawings for some of the patent applications. Because I was a recent graduate, all of my work was reviewed by a partner of the firm. For the ‘228 patent application, Mr. Mike Yakimo reviewed all of my work.

3. Generally a patent application requires 40-60 hours to prepare. A more complex application or application regarding unfamiliar subject matter may take 80 hours or more to prepare. It is my practice to meet with the inventor to receive an

initial disclosure of the invention, discuss various aspects of the invention, and discuss the patent process. In order to begin preparing the application I require drawings to be prepared. This may involve meeting with a draftsman, or preparing the drawings myself, depending on the complexity of the drawings. Additionally, I take time to research the subject matter of the invention to become familiar with the particular art. During the process of preparing the application, I typically have two or more telephone conferences with the client to discuss various aspects of the invention. Once the application is prepared it is sent to the inventor for review and comments. Because of the complexity and subject matter of Dr. Norred's invention, the application for the '228 patent took approximately 80 hours to prepare.

4. On May 3, 2000, I met with Dr. Norred. At this meeting Dr. Norred provided an initial disclosure of his invention and some sketches, Exhibit 2050. We discussed his invention and the patent process. The meeting lasted approximately two hours.

5. On May 11, 2000, I received a retainer check from Dr. Norred and formal authorization to begin preparing the patent application.

6. At this time I was involved in several litigation matters and working on other patent and intellectual property matters. As is my practice, I handled each of these matters in chronological order as they were assigned to me to handle, except to the extent that filing deadlines in litigation matters or patent

applications with a higher priority, such as a pending statutory bar, necessitated affording those matters a different priority.

7. From May 3, 2000 to November 14, 2000, I was involved in seven lawsuits in seven different courts.

8. From May 3, 2000 to November 14, 2000, I prepared 19 patent applications and prepared numerous office action responses.

9. The following is a summary of the time spent on various matters from May 3, 2000 until November 14, 2000.

10. During the weeks of May 1 and 8, I worked on plaintiff's First Amended Petition in the lawsuit *Ed Tobergte Associates Company dba Gear 2000 v. Zide Sport Shop of Ohio, Inc. et al*, District Court of Sedgwick County, Kansas, Civil Court Department, Case No. 00 C0422. I also worked on a patent application serial No. 09/569,281, entitled Interactive Offer System for Elective Medical Procedures, which was filed May 12, 2000. The application concerned an interactive offer procedure and apparatus for selecting an elective medical or surgical procedure from a list of available procedures over the Internet and making an offer to a selected physician to perform the selected procedure at an offered price to a patient is provided. The physician may accept or reject the offer and notify the patient, and if the offer is accepted, schedule a further consultation with the patient to determine final acceptance of the offer and subsequent performance of the requested medical

procedure. This application took approximately 60 hours to complete. I researched legal issues related to *Kustom Signals, Inc. v. Applied Concepts, Inc. & John L. Aker*, U. S. Court of Appeals for the Federal Circuit, Appeal No. 03-1431, -1432, and drafted the opposition to ACI's motion to file a supplemental appendix, which was filed on May 12, 2000. Additionally, I worked on the patent application for U. S. Patent No. 6,378,430, filed May 17, 2000. The '430 patent discloses a flexible plate gripped and secured to a plate cylinder in a rotary printing press by spaced-apart tines extending from an operating shaft rotatably mounted within a bore in the cylinder. The leading and trailing legs of the flexible plate are inserted in a channel in the cylinder, and then rotation of the shaft to a plate-securing position causes the tines to penetrate the trailing leg and hold the plate. I spent approximately 20 hours preparing the claims for this application.

11. During the weeks of May 15 and 22, 2000, I worked on the patent application for U. S. Patent No. 6,415,922, filed May 19, 2000. The '922 patent discloses a tool case with first and second housings pivotal about a central spine to present a book-shaped configuration. Within each housing is two or more walls having a plurality of post-shaped flanges therealong. A tool accessory tray includes a shelf having recesses for a snap fit engagement of the particular tool accessory therein. At the opposed end of the shelves are recesses for slidably seating the flanges therein so as to releasably maintain the tray within the housing. The tray type and number

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