

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

PATENT OWNER RESPONSE
PURSUANT TO 37 C.F.R. § 42.120

TABLE OF CONTENTS

| | |
|---|----|
| I. BACKGROUND | 1 |
| II. ARGUMENT | 4 |
| A. Legal Standards | 4 |
| B. DiMatteo does not Anticipate Claims 16-19 of the ‘228 Patent | 6 |
| 1. Norred Conceived his Invention Prior to DiMatteo and Exercised Reasonable Diligence in Constructively Reducing it to Practice..... | 6 |
| a. Conception | 6 |
| b. Constructive Reduction to Practice | 14 |
| c. Norred’s Inventive Process | 16 |
| d. Norred’s Efforts During the Critical Period..... | 27 |
| 2. DiMatteo does not Disclose all of the Prior Art Elements as Arranged in Claims 16-19 of the ‘228 Patent..... | 30 |
| a. Claim Construction..... | 30 |
| b. DiMatteo does not Disclose a Ring Member | 34 |
| 3. Claims 16 and 18 of the ‘228 Patent are not Anticipated by Wolfe..... | 36 |
| a. Claim Construction..... | 37 |
| b. Wolfe does not Disclose all Prior Art Elements as Arranged in Claims 16 through 18..... | 37 |
| III. CONCLUSION | 40 |

TABLE OF AUTHORITIES

Cases

| | |
|---|-----------|
| <i>Advanced Display Sys., Inc. v. Kent State Univ.</i> , 212 F.3d 1272 (Fed. Cir. 2000)..... | 4 |
| <i>Applied Med. Res. Cor. v. United States Surgical Corp.</i> , 147 F.3d 1374 (Fed. Cir. 1998)..... | 5 |
| <i>Brown v. Barbacid</i> , 436 F.3d 1376 (Fed. Cir. 2006)..... | 14 |
| <i>Burroughs Wellcome Co. v. Barr Labs., Inc.</i> , 40 F.3d 1223 (Fed. Cir. 1994)..... | 6 |
| <i>Connell v. Sears, Roebuck & Co.</i> , 722 F.2d 1542 (Fed. Cir. 1983)..... | 4, 31, 34 |
| <i>E.I. du Pont de Nemours & Co. v. Phillips Petroleum Co.</i> , 849 F.2d 1430 (Fed. Cir. 1988)..... | 27 |
| <i>Frazier v. Schlegel</i> , 498 F.3d 1283 (Fed. Cir. 2007)..... | 14 |
| <i>In re Mathews</i> , 408 F.2d 1393 (1969) | 5 |
| <i>In re Spiller</i> , 500 F.2d 1170 (C.C.P.A. 1974) | 6 |
| <i>In re Tanczyn</i> , 347 F.2d 830 (C.C.P.A. 1965) | 6, 13 |
| <i>In re Translogic Tech., Inc.</i> , 504 F.3d 1249 (Fed. Cir. 2007)..... | 27 |
| <i>Jones v. Evans</i> , 46 F.2d 197 (C.C.P.A. 1931)..... | 26 |

| | |
|---|----------------------|
| <i>K & K Jump Start/Chargers, Inc. v. Schumacher Elec. Corp.</i> , 8 2 F. Supp.2d 1012 (W.D. Mo. 2000) | 14 |
| <i>Lindemann Maschinenfabrik GMBH v. Am. Hoist & Derrick Co.</i> , 730 F.2d 1452 (Fed. Cir. 1984)..... | 4 |
| <i>Mahurkar v. C.R. Bard, Inc.</i> , 79 F.3d 1572 (Fed. Cir. 1996)..... | 13 |
| <i>Monsanto Co. v. Mycogen Plant Science, Inc.</i> , 261 F.3d 1356 (Fed. Cir. 2001)..... | 25 |
| <i>Monsanto Co. v. Mycogen Plant Science, Inc.</i> , 61 F. Supp.2d 133 (D. Del. 1999)..... | 13 |
| <i>Net Moneyin, Inc. v. Verisign, Inc.</i> , 545 F.3d 1359 (Fed. Cir. 2008)..... | 4, 5, 26, 31, 32, 35 |
| <i>Renishaw PLC v. Marposs Societa' per Azioni</i> , 158 F.3d 1243 (Fed. Cir. 1998)..... | 27 |
| <i>Singh v. Brake</i> , 317 F.3d 1334 (Fed. Cir. 2003)..... | 6 |
| <i>Stamicabon BV v. Sepracor, Inc.</i> , No. Civ.A. 97-8-GMS, 2001 WL 253118 (D. Del. March 12, 2001) | 13 |
| Statutes | |
| 35 U.S.C. § 102 | 4, 5, 42 |
| 35 U.S.C. § 102(b) | 4 |
| 35 U.S.C. § 102(e) | 4, 6, 29, 30, 34 |
| 35 U.S.C. § 42.107..... | 3 |
| 37 C.F.R. § 42.100(b) | 30 |
| 37 C.F.R. § 42.120..... | 4 |

Other Authorities

Office Patent Trial Practice Guide, 77 Fed. Reg. 48756 (Aug. 14, 2012)33

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