

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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

v.

TROY R. NORRED, M.D.  
Patent Owner

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Case IPR2014-00111  
Patent 6,482,228

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Before JOSIAH C. COCKS, SHERIDAN K. SNEDDEN, and  
BARRY L. GROSSMAN, *Administrative Patent Judges*.

COCKS, *Administrative Patent Judge*.

INITIAL CONFERENCE SUMMARY

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

### 1. Introduction

On May 28, 2014, an initial conference call was conducted between respective counsel for the parties and Judges Cocks, Snedden, and Grossman. Medtronic, Inc., Medtronic Vascular, Inc., and Medtronic Corevalve, LLC (“Petitioner”) was represented by lead counsel Jack Barufka and Evan Finkel. Troy R. Norred, M.D. (“Patent Owner”) was represented by lead counsel James Kernell. The purpose of the call was to determine if the parties have any issues concerning the Scheduling Order (Paper 11) and to discuss any motions contemplated by the parties.

### 2. Related Matters

No reexaminations or reissue applications of patent 6,482,228 (“the ’228 patent”) have been identified by the parties.

Petitioner advised the panel that it had filed on May 27, 2014 an additional request for *inter partes* review of the ’228 patent<sup>1</sup> and had filed also a motion for joinder of that *inter partes* review proceeding with this involved proceeding. Patent Owner informed the Board that it would oppose joinder. The panel indicated that it would consider the matter when appropriate.

Petitioner also informed the panel that it had filed previously an additional *inter partes* review proceeding involving the ’228 patent and observed that the proceeding that been assigned to a different panel.<sup>2</sup> Petitioner questioned the present panel as to whether the claim construction that had been articulated in this involved proceeding (IPR2014-00111) would be the same as in the related proceeding. The panel of this proceeding indicated that it could not speak for a

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<sup>1</sup> See IPR2014-00823.

<sup>2</sup> See IPR2014-00395.

different panel in a different proceeding, but expressed that, in such circumstances, the Board as a whole strives for consistency.

### *3. Scheduling Order*

Lead counsel for Patent Owner expressed some concern that Patent Owner may have difficulty in timely providing the appropriate filings due by DUE DATE 1. During the call, the panel reminded the parties that, without obtaining prior authorization from the Board, they may stipulate to different dates for DATES 1-5<sup>3</sup> by filing an appropriate notice with the Board. Lead counsel for Patent Owner indicated that he had not yet conferred with opposing counsel as to possible stipulation of the due dates should the need arise. The panel advised counsel to confer and, if necessary, contact the Board if agreement cannot be reached.

### *4. Protective Order*

The parties have not discussed a protective order at this time. No protective order has been entered. Should circumstances change, the parties are reminded of the requirement for a protective order when filing a Motion to Seal. 37 C.F.R. § 42.54. If the parties choose to propose a protective order other than or departing from the default Standing Protective Order, Office Trial Practice Guide, 77 Fed. Reg. 48756, App. B (Aug. 14, 2012), they must submit a joint, proposed protective order, accompanied by a red-lined version based on the default protective order in Appendix B to the Board's Office Patent Trial Practice Guide. *See id.* at 48769.

### *5. Discovery*

The parties are reminded of the discovery provisions of 37 C.F.R. §§ 42.51-52 and Office Trial Practice Guide. *See* 77 Fed. Reg. at 48761-2. Discovery

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<sup>3</sup> The parties may not stipulate to changes for any other DUE DATE.

requests and objections are not to be filed with the Board without prior authorization. The parties may request a conference with the Board if the parties are unable to resolve discovery issues between them. A motion to exclude, which does not require Board authorization, must be filed to preserve any objection. *See* 37 C.F.R. § 37.64, Office Trial Practice Guide, 77 Fed. Reg. at 48767. There are no discovery issues pending at this time.

Each party may depose experts and affiants supporting the opposing party. The parties are reminded of the provisions for taking testimony found at 37 C.F.R. § 42.53 and the Office Trial Practice Manual at 77 Fed. Reg. at 48772, App. D.

#### *6. Motions*

The parties are reminded that, except as otherwise provided in the Rules, Board authorization is required before filing a motion. 37 C.F.R. § 42.20(b). A party seeking to file a motion should request a conference to obtain authorization to file the motion. No motions are authorized in this proceeding at this time.

#### *7. Motion to Amend*

Although Patent Owner may file one motion to amend the patent by cancelling or substituting claims without Board authorization, Patent Owner must confer with the Board before filing a motion to amend. 37 C.F.R. § 42.121(a). During the conference call, counsel for the Patent Owner informed the Board that it is contemplating actively a motion to amend concerning the request entry of narrowing substitute claims for claims 16 and claim 20 of the '228 patent.

During the call, the Board reminded Patent Owner that, as the moving party, it bears the burden of proof in establishing entitlement for the requested relief. *See* 37 C.F.R. § 42.20(c). A motion to amend must explain in detail how any proposed substitute claim obviates the grounds of unpatentability authorized in this

proceeding, explain how any substitute claim is patentable generally over the prior art known to the Patent Owner, and clearly identify where the corresponding written description support in the original disclosure can be found for each substitute claim. If the motion to amend includes a proposed substitution of claims beyond a one-for-one substitution, the motion must explain why more than a one-for-one substitution of claims is necessary.

Counsel for Patent Owner expressed that he was aware of the distinction in amendment practice between *inter partes* review proceedings and other proceedings such as during examination, reexamination, and reissue proceedings. The following is a reproduction of a blog posting from the Boards “AIA Blog,” that is titled “USPTO Message from PTAB: How to Make Successful Claim Amendments in an AIA Trial Proceeding”<sup>4</sup>:

In an AIA trial proceeding, such as an *inter partes* review (IPR), post-grant review (PGR), or a covered business method patent review (CBM), a patent owner may move to amend the claims of the challenged patent. The patent owner should not, however, approach the amendment process in an AIA trial proceeding like the amendment process to overcome an Office rejection filed during the prosecution of a patent application or during a reexamination or reissue proceeding.

During the prosecution of a patent application or during a reexamination or reissue proceeding, an applicant has a right to amend claims prior to a final Office action. Once an amendment is made, the burden then falls on the Examiner to show that the amended claims are unpatentable. In doing so, the Examiner undertakes a further prior art search, taking into account the added limitations. These aspects are different in an IPR, PGR, or CBM proceeding.

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<sup>4</sup> See [http://www.uspto.gov/blog/aia/entry/uspto\\_ptab\\_message\\_how\\_to](http://www.uspto.gov/blog/aia/entry/uspto_ptab_message_how_to) (last accessed May 28, 2014).

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