

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

EDWARDS LIFESCIENCES COPORATION
Petitioner

v.

MEDTRONIC, INC.
Patent owner

CASE IPR 2014-00362
PATENT 6,306,141

**CORRECTED PETITION FOR *INTER PARTES* REVIEW
OF U.S. PATENT NUMBER 6,306,141 UNDER 35 U.S.C. §§ 311-319**

Edwards Lifesciences Corporation (“Edwards” or “Petitioner”) hereby submits a corrected petition (pursuant to Paper No. 10) seeking *Inter Partes* Review (“IPR”) of Claims 1-22 in U.S. Patent Number 6,306,141 (“the ’141 Patent”) (**Exhibit 1001**). A detailed statement supporting the petition follows.

This document has been served on counsel of record for Patent Owner as reflected in the accompanying Certificate of Service.

TABLE OF CONTENTS

I.	REAL PARTY IN INTEREST UNDER 37 C.F.R. § 42.8(b)(1).....	1
II.	GROUND FOR STANDING UNDER 37 C.F.R. § 42.104(a).....	1
III.	RELATED MATTERS UNDER 37 C.F.R. § 42.8(b)(2)	1
IV.	DESIGNATION OF COUNSEL UNDER 37 C.F.R. § 42.8(b)(3) and 42.10(a)-(b)	1
V.	SERVICE INFORMATION UNDER 37 C.F.R. § 42.8(b)(4).....	1
VI.	STATEMENT OF PRECISE RELIEF REQUESTED UNDER 37 C.F.R. §§ 42.22(a)(1) and 42.104(b)(1)-(2)	2
VII.	HOW THE CHALLENGED CLAIMS ARE TO BE CONSTRUED UNDER 37 C.F.R. § 42.104(b)(3)	3
VIII.	REASONS FOR THE RELIEF REQUESTED UNDER 37 C.F.R. § 42.22(a)(2) and 42.104(b)(4) SHOWING THAT THERE IS A REASONABLE LIKELIHOOD THAT THE PETITIONER WILL PREVAIL UNDER 35 U.S.C. § 314(a)	3
A.	Subject Matter of the '141 Patent.....	4
B.	Prosecution History: Issuance of the '141 Patent Based on a Misunderstanding of the Properties of SMAs and Nitinol.....	6
C.	Construction of the '141 Patent Claim Terms.....	11
D.	Invalidity Analysis	13
a.	Claims 1-22 are anticipated by Cragg I under §102(a).....	13
b.	Claims 1-22 are anticipated by Cragg II under § 102(a) or obvious in view of Cragg II and Cragg I under § 103(a)	15
c.	Claims 1-22 are obvious in view of Miyauchi and Cragg I under § 103(a)	17

d. Claims 1-22 are obvious in view of the '212 Patent and Cragg I
under § 103(a)19

e. Claim chart supporting invalidity grounds 1 through 421

f. Claims 1-22 are invalid for obviousness-type double patenting in
view of the Jervis '378 Patent50

IX. CONCLUSION60

EXHIBIT LIST

- 1001 U.S. Patent No. 6,306,141 to Jervis
- 1002 Declaration of Ming H. Wu, Ph.D.
- 1003 Curriculum Vitae of Ming H. Wu, Ph.D.
- 1004 A. Cragg *et al.*, *Nonsurgical Placement of Arterial Endoprostheses: A New Technique Using Nitinol Wire*, *Radiology*, 147: 261-263 (April 1983)
- 1005 A. Cragg *et al.*, *A New Percutaneous Vena Cava Filter*, *American Journal of Roentgenology*, 141: pp. 601-604 (September 1983)
- 1006 Certified Translation of Japanese Patent Publication No. S58-46923 to Miyauchi *et al.* (filed Sept. 12, 1981; disclosed Mar. 18, 1983)
- 1007 U.S. Patent No. 3,620,212 to Fannon *et al.* (Granted Nov. 16, 1971)
- 1008 H. Ling *et al.*, *Phase Transitions and Shape Memory in NiTi*, *Metallurgical Transactions A*, 11A: 77-79 (1980)
- 1009 U.S. Patent No. 4,503,569 to Dotter (Filed Mar. 3, 1983; Granted Mar. 12, 1985)
- 1010 L. Delaey *et al.*, *Thermoelasticity, Pseudoelasticity and the Memory Effects Associated with Martensitic Transformations. Part 1: Structural and Microstructural Changes Associated with the Transformations*, *Journal of Materials Science*, 9: 1521-1535 (1974)
- 1011 R.V. Krishnan *et al.*, *Thermoplasticity, Pseudoelasticity and the Memory Effects Associated with Martensitic Transformations. Part 2: The Macroscopic Mechanical Behavior*, *Journal of Materials Science*, 9: 1536-1544 (1974)
- 1012 K. Otsuka *et al.*, *Pseudoelasticity*, *Metals Forum*, 4(3): 142-152 (1981)

- 1013 J.R. Patel *et al.*, *Criterion for the Action of Applied Stress in the Martensitic Transformation*, *Acta Metallurgica*, 1: 531-538 (1953)
- 1014 L.M. Schetky, *Shape Memory Alloys*, *Scientific American*, 241(5): 74-82 (1979)
- 1015 K. Otsuka *et al.*, *Stress and Strain Induced Martensitic Transformations*, *Proceedings of the Int'l Conference on Martensitic Transformations: ICOMAT 1979*, 607-618 (Jun 1979)
- 1016 February 26, 2001 BPAI Decision (Excerpt from the '141 Patent Prosecution History)
- 1017 March 18, 1998 Applicant Remarks to Office Action (Excerpt from the '141 Patent Prosecution History)
- 1018 April 2, 1997 Applicant Remarks to Office Action (Excerpt from the '141 Patent Prosecution History)
- 1019 March 18, 1998 Declaration of Dr. Lee Middleman (Excerpt from the '141 Patent Prosecution History)
- 1020 U.S. Patent No. 5,597,378 to Jervis
- 1021 T.L. Lopes *et al.*, *Fatigue Performance of Nitinol Tubing with A_f of 25°C*, *Proceedings of the International Conference on Shape Memory and Superelastic Technologies*, 311-320 (2003)
- 1022 M. Wu *et al.*, *What is the Big Deal About the A_f Temperature?*, *Proceedings of the International Conference on Shape Memory and Superelastic Technologies*, 143-154 (May 2006)
- 1023 D.B. Chernov *et al.*, *The Multiplicity of Structural Transitions in Alloys Based on TiNi*, *Soviet Physics Doklady*, 24(8): 664-666 (Aug. 1979)
- 1024 Original Japanese Patent Publication No. S58-46923 to Miyauchi *et al.* (filed Sep. 12, 1981; disclosed Mar. 18, 1983)
- 1025 Complete Prosecution History of the '141 Patent

Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

Real-Time Litigation Alerts



Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

Advanced Docket Research



With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

Analytics At Your Fingertips



Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

LAW FIRMS

Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

FINANCIAL INSTITUTIONS

Litigation and bankruptcy checks for companies and debtors.

E-DISCOVERY AND LEGAL VENDORS

Sync your system to PACER to automate legal marketing.