

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In the *Inter Partes* Review of:

Trial Number: _____

U.S. Patent No. 7,587,469

Filed: January 29, 2007

Issued: September 8, 2009

Attorney Docket No.:

12771.0106USWX

Inventors: Stephen J. Brown

Assignee: Health Hero Network, Inc.

Title: AUDIO INSTRUCTIONS FOR

Panel: To Be Assigned

APPLIANCES

**MOTION FOR JOINDER OF PETITION FOR *INTER PARTES*
REVIEW IPR2014-00436 OF U.S. PATENT NO. 7,587,469
FILED ON FEBRUARY 14, 2014 WITH
IPR2013-00451 INSTITUTED ON JANUARY 16, 2014**

I. Relief Requested

Pursuant to 35 U.S.C. §315(c) and 37 C.F.R. §42.122(b), Petitioner Medtronic, Inc. (“Medtronic” or “Petitioner”), hereby moves for joinder of the concurrently-submitted petition for *inter partes* review (IPR2014-00436) of claim 1-22 of U.S. Patent No. 7,587,469 (“the ‘469 Patent”) filed by Medtronic, Inc. on February 14, 2014 with the *inter partes* review IPR2013-00451 filed by Cardiocom, LLC (“Cardiocom”) as to the same ‘469 Patent and instituted on January 16, 2014.

II. Statement of Materials Facts

1. On April 26, 2013, Robert Bosch Healthcare Systems filed a patent infringement lawsuit against Cardiocom, LLC and Abbott Diabetes Care in the United States District Court for the Eastern District of Texas, Case No.: 2:13-cv-349 alleging, among other patents, infringement of the ‘469 patent.
2. On July 17, 2013, Cardiocom filed a petition for *inter partes* review requesting cancellation of claims 1-22 of the ‘469 patent. *Cardiocom, LLC v. Robert Bosch Healthcare Systems, Inc.*, IPR2013-00451 (P.T.A.B.) (“First Petition”). The details of related proceedings and related patents can be found in the Petition for *Inter Partes* Review, filed on July 17, 2013, in IPR2013-00451.
3. Subsequently, Medtronic acquired Cardiocom.

4. On January 16, 2014, the Board instituted trial as to claims 1, 2, and 5-10 in IPR2013-451. The Board, however, did not institute trial as to claims 3-4 and 11-22. *See* IPR2013-00451, Paper 23 at 13, 29.
5. On February 13, 2014, the Board held its initial conference call in IPR2013-00451 with the parties. In Cardiocom's list of proposed motions, Cardiocom identified that it would file a motion to join IPR2013-00451 with a Petition for *inter partes* review being filed (the present Petition).
6. On February 14, 2014, Medtronic filed a petition for *inter partes* review of the '469 patent ("Second Petition") seeking the cancellation of claims 1-22.
7. Medtronic's grounds for challenging the patentability of claims 1-22 in the Second Petition are based on prior art references (Cohen and Wahlquist) included in the First Petition, and on a new prior art reference, European Publication No. 0342 859 to Kaufman, et al. ("Kaufman") (Ex. 1003), not part of IPR2013-00451. Kaufman in combination with the previously-cited art addresses the reasons *inter partes* review was denied as to claims 3-4 and 11-22 and further demonstrates claims 1-22 are invalid.

III. Governing Rule(s)

§42.122 Multiple Proceedings and Joinder.

(b) Request for Joinder. Joinder may be requested by a patent owner or petitioner. Any request for joinder must be filed, as a motion under §42.22, no

later than one month after the institution date of any *inter partes* review for which joinder is requested. The time period set forth in §42.101(b) shall not apply when the petition is accompanied by a request for joinder.

IV. Discussion

The Leahy-Smith America Invents Act (AIA) permits the Patent Trial and Appeal Board (“the Board”) to join *inter partes* review proceedings in its discretion. *See* 35 U.S.C. §315(c). A motion for joinder must be filed no later than one month after the institution date of any *inter partes* review for which joinder is requested. *See* 37 C.F.R. §42.122(b). This joinder motion is timely as IPR2013-00451 was instituted on January 16, 2014 and the present Petition has just been filed.

Joinder is appropriate because it will be more efficient for both the Board and the parties to address the issues in both proceedings, which are related, in one IPR rather than separately. The Second Petition (IPR2014-00436) seeks cancellation of claims 1-22 of the ‘469 Patent based on new prior art in combination with prior art which supported the grant in part of the First Petition. Moreover, Medtronic acquired Cardiocom, the Petitioner in IPR2013-00451, and thus combining the two *inter partes* reviews will be more efficient as the two Petitioners are related and have the same counsel representing them in both proceedings. Both Medtronic and Cardiocom support joinder. Joinder is also

appropriate as there will be no discernable prejudice to the Patent Owner from joining the two proceedings. Pursuant to 37 C.F.R. §42.122 (b), the instant motion was timely filed within one month of the Board instituting IPR2013-00451 and before the trial is instituted in the present proceeding.

In IPR2013-451, the Board instituted trial on claims 1, 2 and 5-10 as being obvious over Cohen and Wahlquist and alternatively as being obvious over Cohen, Wahlquist, Neumann and Jacobs. However, the Board did not institute trial as to claims 3, 4, and 11-22, finding that Cohen does not teach a “single housing unit” recited in claim 3 and the “household appliance” recited in claims 4 and 11-22. After and based on the Board’s findings and its claim construction in IPR2013-00451, Medtronic identified a prior art reference, Kaufman, that in combination with the previously-cited art cures the deficiencies that led the Board to deny trial on claims 3, 4 and 11-22, and prepared the present Petition.

Medtronic’s Petition includes two grounds of unpatentability: (1) Claims 1-6, 11-12 and 17-18 are obvious over Cohen in view of Kaufman, and (2) all claims are unpatentable as obvious over Cohen in view of Kaufman and further in view of Wahlquist. Kaufman provides both the “single housing unit” and “household appliance” elements found missing in Cohen.

For example, Kaufman discloses the primary and secondary devices being housed within a “single housing unit” 12 or 102 of the patient assistance system

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