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14 **IN THE UNITED STATES DISTRICT COURT**  
15 **NORTHERN DISTRICT OF CALIFORNIA**  
**SAN JOSE DIVISION**

16 ENDOTACH LLC,

17 Plaintiff,

18 vs.

19 MEDTRONIC, INC. and  
20 MEDTRONIC VASCULAR, INC.,

21 Defendants.

CASE NO. 5:13-cv-03292-EJD

**PLAINTIFF'S DISCLOSURE OF  
ASSERTED CLAIMS AND  
INFRINGEMENT CONTENTIONS**

Jury Trial Demanded

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PLAINTIFF'S DISCLOSURE OF ASSERTED CLAIMS  
AND INFRINGEMENT CONTENTIONS

1 Plaintiff ENDOTACH LLC (“Plaintiff”), pursuant to Patent Local Rules 3-1  
2 and 3-2, provides the following Disclosure of Asserted Claims and Infringement  
3 Contentions:

4 **Patent L.R. 3-1 Disclosures**

5 **(a) Each claim of each patent in suit that is allegedly infringed by each**  
6 **opposing party, including for each claim the applicable statutory subsections**  
7 **of 35 U.S.C. §271 asserted;**

8 Defendants Medtronic, Inc. and Medtronic Vascular, Inc. (collectively,  
9 “Defendants”) infringe various claims of U.S. Patent Nos. 5,593,417 (“the ‘417  
10 Patent”). More specifically, and based on presently available information, Plaintiff  
11 contends that Defendants directly infringe at least the claims described in the  
12 attached as Exhibit A, including claims 1, 2, and 13 of the ‘417 Patent (“Asserted  
13 Claims”), pursuant to 35 U.S.C. § 271(a).

14 Plaintiff expressly reserves the right to seek leave of Court to amend and/or  
15 supplement this disclosure after discovery from Defendants or as permitted under  
16 the rules. By way of example only, Plaintiff will be obtaining discovery regarding  
17 all technical aspects of Defendants’ Accused Instrumentalities. Plaintiff reserves  
18 the right to assert additional claims as being directly infringed by Defendants and  
19 to assert claims for indirect infringement at a future date after receipt of such  
20 discovery.

21  
22 **(b) Separately for each asserted claim, each accused apparatus,**  
23 **product, device, process, method, act, or other instrumentality (“Accused**  
24 **Instrumentality”)** of each opposing party of which the party is aware. This  
25 **identification shall be as specific as possible. Each product, device, and**  
26 **apparatus shall be identified by name or model number, if known. Each**  
27 **method or process shall be identified by name, if known, or by any product,**

1 **device, or apparatus which, when used, allegedly results in the practice of the**  
2 **claimed method or process;**

3 The following products, devices, or instrumentalities infringe claims 1, 2 and  
4 13 of the '417 Patent: Endurant AAA Stent Graft ("Endurant") and Endurant II  
5 AAA Stent Graft ("Endurant II), including the aorto-iliac bifurcated, the aorti-uni-  
6 iliac, and the aortic extension components – as described in the attached Exhibit A.

7 Plaintiff expressly reserves the right to seek leave of Court to amend and/or  
8 supplement this disclosure after discovery from Defendants or as permitted under  
9 the rules.

10  
11 **(c) A chart identifying specifically where each limitation of each**  
12 **asserted claim is found within each Accused Instrumentality, including for**  
13 **each limitation that such party contends is governed by 35 U.S.C. § 112(6), the**  
14 **identity of the structure(s), act(s), or material(s) in the Accused**  
15 **Instrumentality that performs the claimed function.**

16 Plaintiff's claim chart is attached to these disclosures as Exhibit A pertaining  
17 to claims 1, 2 and 13 of the '417 Patent and are hereby incorporated by reference.

18 Plaintiff does not contend that any claim element in any of the asserted  
19 claims is governed by 35 U.S.C. §112(6).

20 Any citations to Defendants' publicly available documentation in the  
21 attached claim charts are exemplary and not exhaustive, as are the examples  
22 provided of the ways in which the Accused Instrumentalities satisfy the elements  
23 of each asserted claim. Moreover, any and all citations or references to publicly  
24 available documentation should be understood to encompass any and all prior  
25 editions and versions that incorporate the same or similar functionality.

1 Plaintiff expressly reserves the right to seek leave of Court to amend or  
2 supplement this disclosure after discovery from Defendants or as permitted under  
3 the rules.

4  
5 **(d) For each claim which is alleged to have been indirectly infringed,**  
6 **an identification of any direct infringement and a description of the acts of the**  
7 **alleged indirect infringer that contribute to or are inducing that direct**  
8 **infringement. Insofar as alleged direct infringement is based on joint acts of**  
9 **multiple parties, the role of each such party in the direct infringement must be**  
10 **described.**

11 Plaintiff does not currently allege that Defendants indirectly infringe any of  
12 the asserted claims.

13 Plaintiff expressly reserves the right to seek leave of Court to amend and/or  
14 supplement this disclosure after discovery from Defendants or as permitted under  
15 the rules. By way of example only, Plaintiff will be obtaining discovery regarding  
16 all technical aspects of Defendants' Accused Instrumentalities and similar  
17 functioning products, and related to Defendants' knowledge and intent. Plaintiff  
18 reserves the right to assert claims for indirect infringement at a future date after  
19 receipt of such discovery.

20  
21 **(e) Whether each limitation of each asserted claim is alleged to be**  
22 **literally present or present under the doctrine of equivalents in the Accused**  
23 **Instrumentality;**

24 At this time, Plaintiff contends and reasonably believes that all limitations of  
25 the asserted claims are present literally. The chart attached as Exhibit A identifies  
26 any element alternatively present under the doctrine of equivalents.

1 Plaintiff expressly reserves the right to seek leave of Court to amend or  
2 supplement these disclosures after discovery from Defendants or as permitted  
3 under the rules.

4  
5 **(f) For any patent that claims priority to an earlier application, the**  
6 **priority date to which each asserted claim allegedly is entitled; and**

7 The '417 Patent does not claim priority to an earlier application.

8  
9 **(g) If a party claiming patent infringement wishes to preserve the**  
10 **right to rely, for any purpose, on the assertion that its own apparatus,**  
11 **product, device, process, method, act, or other instrumentality practices the**  
12 **claimed invention, the party shall identify, separately for each asserted claim,**  
13 **each such apparatus, product, device, process, method, act, or other**  
14 **instrumentality that incorporates or reflects that particular claim.**

15 Plaintiff does not currently rely, for any purpose, on the assertion that its  
16 own apparatus, product, device, process, method, act, or other instrumentality  
17 practices the claimed invention.

18  
19 **(h) If a party claiming patent infringement alleges willful**  
20 **infringement, the basis for such allegation.**

21 Plaintiff maintains that Defendants had actual knowledge of the '417 Patent  
22 at least as early as 2012, and since that time, Defendant willfully infringed and  
23 continues to willfully infringe the '417 Patent. At a minimum, Plaintiff maintains  
24 that Defendants had actual notice of the '417 Patent no later than November 1,  
25 2012, the filing of the Complaint in *Endotach LLC v. Medtronic Inc.* et al., Civil  
26 Action No. 5:13-cv-00452-EJD.

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