

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MEDTRONIC INC., MEDTRONIC VASCULAR, INC.
Petitioners

v.

MARITAL DEDUCTION TRUST
Patent Owner

Case No. IPR2014-00695
Patent No. 5,593,417

PATENT OWNER'S OPPOSITION TO MOTION FOR JOINDER

I. INTRODUCTION

Pursuant to 37 C.F.R. § 42.23(a), the Patent Owner hereby provides an Opposition to the Petitioners' Motion for Joinder filed April 25, 2014 (Paper 2; herein "the Motion"). The Petitioners filed the Motion concurrently with its Second Petition for *Inter Partes* Review of U.S. Patent No. 5,593,417 (Paper 1; herein "the Second Petition"). The Petitioners earlier filed a Petition for *Inter Partes* Review of U.S. Patent No. 5,593,417 in IPR2014-00100 (Paper 1; herein "the First Petition"). A Notice dated May 28, 2014 (Paper 12) authorized the filing of this Opposition at the same time as the Patent Owner's Preliminary Response to the Second Petition. The Patent Owner's Preliminary Response is filed concurrently. This Opposition is therefore timely filed, and no fee is due with this Opposition. If, however, the Office believes that any additional fee is due, it is authorized to charge deposit account No. 50-5836.

The Patent Owner does not oppose joinder in the event that the Board institutes trial with respect to at least one challenge in the Second Petition, provided that the schedule for joined proceedings is fair and reasonable. Nonetheless, the Patent Owner does not agree with the Statement of Material Facts set forth on pages 2-6 of the Motion. The Patent Owner therefore files this Opposition to deny specific facts, to provide a more complete accounting of the

facts, and to propose a fair and reasonable joined schedule for IPR2014-00100 and this IPR2014-00695.

II. RESPONSE TO STATEMENT OF MATERIAL FACTS

1. On November 1, 2012, Endotach LLC (“hereinafter, Patent Owner”) filed a suit against Petitioner, which is pending in the U.S. District Court for the Northern District of California, San Jose Division, in a case titled *Endotach LLC v. Medtronic, Inc., et al.*, No. 5:13-cv-03292-BLF.

Response: Admitted, except that Endotach LLC is not the owner of the ’417 Patent but instead the exclusive licensee. The owner of the ’417 Patent is the Marital Deduction Trust, created under the Valentine J. Rhodes Revocable Trust. Dr. Valentine J. Rhodes, now deceased, was a medical doctor who specialized in vascular surgery and the inventor of the ’417 Patent.

2. On October 31, 2013, Petitioner filed a Petition for *Inter Partes* Review (hereinafter, “First Petition”) requesting review of claims 1, 2, 9, 10, and 13 of the ’417 patent, now instituted as *Medtronic, Inc., et al. v. Endotach LLC*, Case No. IPR2014-00100 (“IPR2014-00100”). In the First Petition, Petitioner raised six grounds of unpatentability based on four prior art references—U.S. Patent No. 5,104,399 to Lazarus (“Lazarus”), U.S. Patent No. 4,562,596 to

Kornberg (“Kornberg”), U.S. Patent No. 5,397,355 to Marin (“Marin”), and U.S. Patent No. 5,122,154 to Rhodes (“Rhodes ’154”).

Response: Admitted.

3. While a decision on the First Petition was pending, on February 18, 2014, Petitioner’s litigation counsel, Karen McDaniel of the Briggs and Morgan firm, received Patent Owner’s Infringement Contentions (Exh. 1007). The Infringement Contentions cite to claim construction rulings in another litigation involving the same patent (*Endotach LLC v. Cook Medical Inc.*, 1:12-cv-1630-LJM-DKL, Southern District of Indiana (Dkt. No. 102)) (hereinafter, “Cook District Court case”). In the Infringement Contentions, Patent Owner posits that the term “engage” means “to partly embed, interlock or enmesh,” while the term “tightly engage” in claim 1 excludes penetration that perforates or creates holes through the wall. Exh. 1007, pg. 16.

Response: Admitted, but the Patent Owner adds the following for the sake of completeness:

(a) The claim construction ruling in the Cook District Court case was issued April 10, 2013 – more than ten months before the Patent Owner served its Infringement Contentions on the Petitioner’s litigation counsel. That claim construction ruling (Ex. 2004) was a non-confidential document

made publicly available on PACER on or about April 10, 2013. Furthermore, several other publicly available pleadings from the Cook District Court case revealed the Patent Owner's claim construction position regarding "engage" and "tightly engage." For example, on December 21, 2012 and January 24, 2013, respectively, the Patent Owner filed on PACER publicly available copies of its Opening and Responsive Claim Construction Briefs, which detail the Patent Owner's claim construction positions regarding "engage" and "tightly engage." (Ex. 2002 at 31-33; Ex. 2003 at 21-23.) Further, on June 28, 2013, Cook filed on PACER a publicly available copy of the Patent Owner's infringement contentions for the '417 Patent that detail the Patent Owner's claim construction positions regarding "tightly engage" as related to Cook's accused products. (Ex. 2005 at 21-26.)

(b) Every paragraph of the '417 Patent specification containing the phrase "tightly engage" also says either "tightly engage, e.g., burrow slightly into" or "tightly engage (and not necessarily penetrate)." ('417 Patent (Ex. 1001) at 4:10-25, 4:26-38, 7:9-33, 9:1:17.) Further, it is a stated object of the invention in the '417 Patent "to provide anchoring means for intraluminal medical devices to be secured within in a vessel, duct, or lumen of a living being, and which anchoring means does not pose a significant risk of

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