

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MEDTRONIC, INC. and MEDTRONIC VASCULAR, INC.
Petitioner,

v.

ENDOTACH LLC
Patent Owner.

Case IPR2014-00695
Patent 5,593,417

Before JACQUELINE WRIGHT BONILLA, MICHAEL J. FITZPATRICK,
and HYUN J. JUNG, *Administrative Patent Judges*.

Opinion for the Board filed by *Administrative Patent Judge* BONILLA.

Opinion Concurring filed by *Administrative Patent Judge* FITZPATRICK.

BONILLA, *Administrative Patent Judge*.

DECISION

Denying Petitioner's Motion for Joinder,
and Denying Institution of *Inter Partes* Review
37 C.F.R. §§ 42.108, 42.122

I. INTRODUCTION

On April 25, 2014, Medtronic, Inc. and Medtronic Vascular, Inc. (“Petitioner”) filed a Petition for *Inter Partes* Review (Paper 1, “Second Petition”) involving the same parties and claims of U.S. Patent No. 5,593,417 (Ex. 1001, “the ’417 patent”) at issue in instituted trial proceeding IPR2014-00100. Petitioner concurrently filed a Motion for Joinder, requesting “that the Second Petition be joined with IPR2014-00100.” Paper 2 (“Joinder Motion”), 2. Petitioner filed its Joinder Motion within one month after institution of a trial in IPR2014-00100, as required by 37 C.F.R. § 42.122(b). On June 25, 2014, Patent Owner Endotach LLC (“Patent Owner”) filed an Opposition to Motion for Joinder (Paper 16, “Opp. to Joinder”), and a Preliminary Response (Paper 14, “Prelim. Resp.”). On July 11, 2014, Petitioner filed a Reply to Opposition to Motion for Joinder (Paper 17). We have jurisdiction under 35 U.S.C. § 314.

II. BACKGROUND

The statutory provision governing joinder of *inter partes* review proceedings is 35 U.S.C. § 315(c), which reads as follows:

(c) JOINDER.—If the Director institutes an inter partes review, the Director, in his or her discretion, may join as a party to that inter partes review any person who properly files a petition under section 311 that the Director, after receiving a preliminary response under section 313 or the expiration of the time for filing such a response, determines warrants the institution of an inter partes review under section 314.

35 U.S.C. § 315(b) normally bars institution of *inter partes* review when the petition is filed more than one year after the petitioner (or petitioner’s real party in interest or privy) is served with a complaint alleging

infringement of the patent. 35 U.S.C. § 315(b); 37 C.F.R. § 42.101(b). That one-year time bar, however, does not apply to a request for joinder. 35 U.S.C. § 315(b) (final sentence); 37 C.F.R. § 42.122(b). This is an important consideration here because Petitioner was served with a complaint asserting infringement of the '417 patent more than one year before filing the Second Petition.¹ Thus, absent joinder of Petitioner in this proceeding as a party to IPR2014-00100, the Second Petition is barred.

Joinder may be authorized when warranted, but the decision to grant joinder is discretionary. 35 U.S.C. § 315(c); 37 C.F.R. § 42.122(b). When exercising that discretion, the Board is mindful that patent trial regulations, including the rules for joinder, must be construed to secure the just, speedy, and inexpensive resolution of every proceeding. 37 C.F.R. § 42.1(b).²

III. ANALYSIS

We are not persuaded that Petitioner has shown that joinder is justified in this instance. Petitioner filed its Second Petition one month after institution in IPR2014-00100. This case represents a “second bite at the apple” for Petitioner, who has received the benefit of seeing our Decision to Institute in the prior case involving the same parties and patent claims. *See* IPR2014-00100, Paper 15 (“Institution Decision”). This “second bite at the

¹ Petitioner was served with a complaint alleging infringement of the '417 Patent on November 1, 2012. Prelim. Resp. 17; Second Petition 2, 8. Petitioner filed its Petition in the instant proceeding on April 25, 2014.

² 35 U.S.C. § 316(b) (“In prescribing regulations under this section, the Director shall consider the effect of any such regulation on the economy, the integrity of the patent system, the efficient administration of the Office, and the ability of the Office to timely complete proceedings instituted under this chapter.”).

apple” situation is particularly noteworthy in view of the § 315(b) bar at issue here, as well as a difference of opinion that currently exists at the Board as to whether the Board has discretion under 35 U.S.C. § 315(c) to allow joinder of a person to an ongoing *inter partes* review when that person is already a party to the ongoing *inter partes* review.³

For the purposes of this Decision, we will assume we have discretion to allow joinder under the circumstances of this case. Thus, we assume that a “second bite” for a petitioner is appropriate under certain circumstances, particularly when a § 315(b) bar does not apply. That said, when a § 315(b) bar would apply absent joinder, we hesitate to allow a petitioner a second bite one month after institution in a first case, at the expense of scheduling constraints for everyone, as well as additional costs (and potential prejudice) to Patent Owner, absent a good reason for doing so.

The Board determines whether to grant joinder on a case-by-case basis, taking into account the particular facts of each case. *See* 157 Cong. Rec. S1376 (daily ed. Mar. 8, 2011) (statement of Sen. Kyl) (when determining whether and when to allow joinder, the Office may consider factors including the breadth or unusualness of the claim scope, claim construction issues, and consent of the patent owner). Here, while we appreciate that 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 (Opp. to Joinder 2), we determine that Petitioner’s stated reasons for allowing joinder do not outweigh meaningful reasons to not allow joinder.

³ *See Target Corp. v. Destination Maternity Corp.*, Case IPR2014-00508, (PTAB Sept. 25, 2014) (Paper 18); *see also, e.g., Ariosa Diagnostics v. Isis Innovation Ltd.*, Case IPR2012-00022, (PTAB Sept. 2, 2014) (Paper 166).

As noted above, we are mindful of a public interest in securing “the just, speedy, and inexpensive resolution of every proceeding.” 37 C.F.R. § 42.1(b). As relevant to the “speedy” consideration, we observe that the Second Petition reasserts two grounds of unpatentability previously asserted in IPR2014-00100, as well as three new grounds relying on two additional references. Second Petition 10, 13. Thus, Petitioner raises five grounds potentially requiring a response by Patent Owner after Patent Owner has already filed its Response to the Petition in IPR2014-00100 on July 28, 2014. IPR2014-00100, Paper 5 (“First Petition”); Paper 27 (“PO Resp.”). If we were to grant joinder and institute on any of the five grounds, therefore, it would impact the schedule of IPR2014-00100, because it would require a response by Patent Owner in relation to any additional instituted ground(s).

With respect to the “just” consideration, we note that Petitioner created its own § 315(b) bar situation by filing the Second Petition when it did, something entirely within Petitioner’s control. If a § 315(b) bar did not apply, a trial in the second case could proceed, on its own schedule if needed, assuming Petitioner otherwise met the “reasonable likelihood that [it] would prevail” standard under 35 U.S.C. § 314(a). It is only the existence of a § 315(b) bar in this case that requires us to consider modifying a schedule in a joined case requiring Patent Owner to address additional grounds at a late stage in that first proceeding.

In the Joinder Motion, Petitioner indicates that it received “Patent Owner’s Infringement Contentions” (Ex. 1007, “Infringement Contentions”) as part of a related district court case on February 18, 2014, after Petitioner filed its First Petition, and after the § 315(b) bar applied. Joinder Motion 3. Petitioner contends that Patent Owner’s Infringement Contentions discuss

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