

IPR2014-00823
Patent 6,482,228

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MEDTRONIC, INC., MEDTRONIC VASCULAR, INC.,
and MEDTRONIC COREVALVE, LLC
Petitioner

v.

TROY R. NORRED, M.D.
Patent Owner

Case IPR2014-00823
Patent 6,482,228

Attorney Docket No. 058888-0000023

PETITIONER'S REPLY TO OPPOSITION TO MOTION FOR JOINDER

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Pursuant to 37 C.F.R. § 42.23(a), Petitioner files this Reply to “Opposition of Patent Owner to Petitioner’s Motion for Joinder” (Paper 7, “Opposition”).

I. RESPONSE TO PATENT OWNER’S ARGUMENTS AGAINST JOINDER

A. Patent Owner Incorrectly Argues That The Deadline For Filing A Request For Rehearing Is Relevant To Joinder

In its Opposition, Patent Owner asserts that the Motion for Joinder is improper because the motion “is nothing more than an out-of-time request for rehearing of the April 25, 2014 decision of the Board to institute trial on claims 20-24 of the ‘228 Patent in IPR2014-00111.” Paper 7, p. 4. The deadline for filing a motion for rehearing is entirely irrelevant, however, because Petitioner did not elect to file a motion for rehearing.

The deadline for filing the Motion for Joinder is one month after the Institution Decision on the Petition in IPR2014-00111 (“First Petition”). 37 C.F.R. § 42.122(b). However, because the one-month period expired on Sunday, May 25, 2014, and Monday, May 26 was a Federal Holiday (Memorial Day), the deadline for filing the Motion for Joinder was Tuesday, May 27, 2014. 37 C.F.R. §§ 1.7 and 42.1(a). The Second Petition and Motion for Joinder were appropriate and timely, as they were concurrently filed on May 27, 2014. The timing for filing a motion for rehearing is not at issue herein.

B. Patent Owner's Argument That "Delay" Warrants Denying Joinder Is Untenable

The Patent Owner argues that joinder is improper because it would result in substantial delay. *See* Opposition, p. 10-11. That is not correct. Patent Owner has already considered and provided its response regarding Figulla as applied to claims 20-24 in the First Petition (*see* IPR2014-00111, Paper 9 (Preliminary Response), p. 21-22 and 39-40), and repeats those arguments in opposition to the Motion for Joinder (*see* IPR2014-00823, Paper 7, p. 11-12).¹ Thus, there is no reason for any substantial delay to arise from joinder. Moreover, Petitioner renews its offer to accommodate any reasonable logistical or scheduling request of Patent Owner, or determined by the Board to be appropriate or necessary, in view of the joinder of the proceedings. *See* IPR2014-00823, Paper 2, p. 8-9. Extensions of the schedule are permitted by law and are not a reason to deny joinder herein. 35 U.S.C. § 316(a)(1); 37 C.F.R. § 42.100(c).

¹ The arguments Patent Owner makes regarding the patentability of claims 20-24 over Figulla rely on limitations missing from the claims and/or erroneous claim constructions, much as the Board concluded in connection with comparable arguments made by Patent Owner in its Preliminary Response to the First Petition. *See, e.g.*, IPR2014-00111, Paper 10 (Decision), at p. 6-11 (rejecting Patent Owner's proposed construction of "means for maintaining" and "ring member").

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C. Patent Owner's Argument That The Second Petition Is Unnecessary Is At Odds With The Indisputable Facts

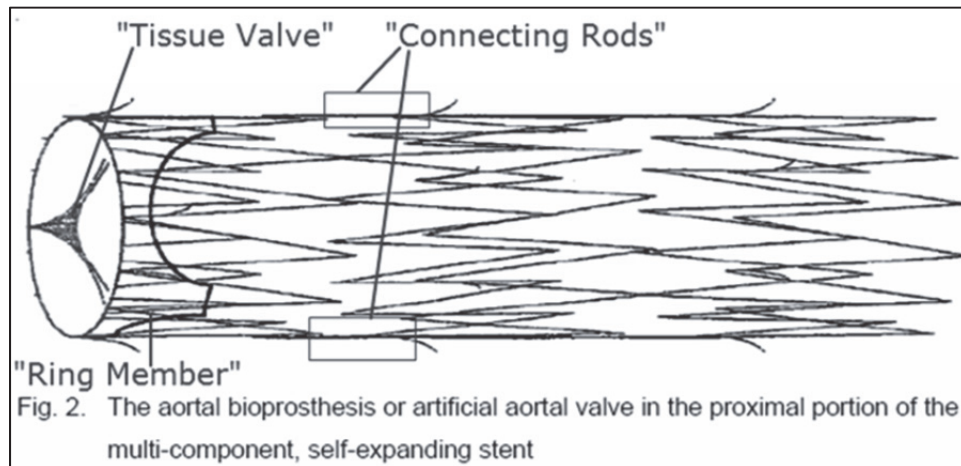
In its Motion for Joinder, Petitioner explained that joinder of the instant petition in IPR2014-00823 ("Second Petition") seeking review of U.S. Patent No. 6,482,228 based on Figulla alone and in combination with Shu will avoid potential prejudice to Petitioner because Figulla and Shu are references under 35 U.S.C. § 102(b) ("102(b)"), whereas Shreck is a reference under 35 U.S.C. § 102(e) ("102(e)") which Patent Owner is attempting to antedate. Paper 2 (Motion) at p. 5. Patent Owner's response is to argue that Petitioner should have "raised these issues in a request for rehearing." Paper 7 (Opposition) at p. 7. The rules, however, do not require Petitioner to file a request for rehearing rather than the timely Second Petition and Motion for Joinder.

Patent Owner also argues that Petitioner will not suffer prejudice if joinder is denied because even if "Norred is able to swear behind Schreck and survive IPR2014-00111 with claims 20-24 intact," Petitioner still has IPR2014-00110 and IPR2014-00395. Paper 7 (Opposition) at p. 8. That argument is baseless.

The claims at issue in IPR2014-00110 (claims 16-19) have no overlap to the claims at issue in this proceeding (claims 20-24). Thus, IPR2014-00110 will not lessen the prejudice to Petitioner if joinder is denied as to the application of Figulla (alone and in combination with Shu) to claims 20-24.

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And while claims 20-24 are at issue in IPR2014-00395, Figulla is an important reference because it is a 102(b) reference that clearly shows the connecting rods connecting each stent segment:



See IPR2014-00823, Paper 3 (Petition), p. 10, Fig. 2.

The Patent Owner is only now (*i.e.*, as of the filing of its Response dated July 17, 2014) apparently asserting that such connecting rods, as disclosed in Figulla, meet the “means for maintaining” limitation of independent claim 20, as illustrated by the following side-by-side comparison of the drawing that Patent Owner offers as evidence of conception of the purported invention of claim 20 and another figure from Figulla:

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