

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 B1

Before SHERIDAN K. SNEDDEN, BARRY L. GROSSMAN, and
MITCHELL G. WEATHERLY, *Administrative Patent Judges*.

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

Opinion Concurring filed by *Administrative Patent Judge* WEATHERLY.

SNEDDEN, *Administrative Patent Judge*.

DECISION

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

I. INTRODUCTION

Medtronic, Inc., Medtronic Vascular, Inc., and Medtronic Corevalve, LLC (collectively “Medtronic” or “Petitioner”) filed a petition (Paper 3, “Petition” or “Pet.”) requesting an *inter partes* review of claims 20–24 (the “challenged claims”) of U.S. Patent 6,482,228 B1 (Ex. 1001, “the ’228 patent”). See 35 U.S.C. § 311. Troy R. Norred, M.D. (“Patent Owner”) did not file a Patent Owner Preliminary Response.

Concurrently with the filing of the Petition, Petitioner filed a motion for joinder pursuant to 35 U.S.C. § 315(c). Paper 2, 1 (the “Mot. for Joinder” or “Joinder Motion”). Specifically, Medtronic moves “for Joinder of the Second Petition for *Inter partes* Review of U.S. Patent No. 6,482,228 . . . , with the instituted *inter partes* review, *Medtronic, Inc., et al. v. Troy R. Norred*, Case No. IPR2014-00111, pursuant to 35 U.S.C. § 315(c) and 37 C.F.R. § 42.122.” *Id.* Thus, Medtronic seeks to consolidate issues presented in the Petition with issues on which we have instituted review in *Medtronic, Inc. v. Norred*, Case IPR2014-00111 (“the ’111 IPR”). Petitioner timely filed its Joinder Motion within one month after institution of a trial in IPR2014-00111, as required by 37 C.F.R. § 42.122(b). Patent Owner filed an Opposition to Motion for Joinder (Paper 7, “Opp. to Joinder”). Petitioner filed a Reply to Opposition to Motion for Joinder (Paper 11, “Reply”). We have jurisdiction under 35 U.S.C. § 314.

For the reasons provided below, we exercise our discretion under 35 U.S.C. § 315(c) and deny Petitioner’s Motion to join the Petition to the ’111 IPR. We also deny the Petition and do not institute an *inter partes* review of the ’228 patent based on the Petition.

II. ANALYSIS

A. *Law of Joinder*

The statutory provision governing joinder of *inter partes* review proceedings is § 315(c), which provides 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.

Section 315(c) references § 311, which provides that “a person who is not the owner of a patent may file with the Office a petition to institute an inter partes review of the patent.” Section 315(c) refers also to § 314, which allows the Director to institute an *inter partes* review if there is a reasonable likelihood that the petitioner would prevail with respect to at least one of the claims challenged in the petition.

The Petition was filed on May 27, 2014. Petitioner acknowledges that, more than one year before filing the Petition, it was served with a complaint alleging infringement of the '228 patent in *Norred v. Medtronic, Inc.*, No. 2:13-cv-02061. Pet. 1, 6. Section 315(b) bars institution of *inter partes* review when the petition is filed more than one year after the petitioner is served with a complaint alleging infringement of the patent. 35 U.S.C. § 315(b); 37 C.F.R. § 42.101(b). The 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). Thus, absent joinder of this proceeding to IPR2014-00111, the Petition is barred under § 315(b).

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 our rules, 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).

B. Decision on Motion for Joinder

Petitioner challenges claims 20–24 of the '228 patent on the following grounds. Pet. 8–14.

Reference[s]	Basis	Claims challenged
Figulla ¹	§ 102(b)	20–24
Figulla and Shu ²	§ 103(a)	20–24

Petitioner, however, is currently a party in the following instituted *inter partes* review proceedings involving the '228 patent: IPR2014-00111 and IPR2014-00395. These two cases are on-going and were instituted with the following grounds:

Reference[s]	Basis	Claims challenged	Case No.
Schreck ³	§ 102(e)	20–24	IPR2014-00111
Schreck and Shu	§ 103(a)	22–23	IPR2014-00111

¹ Figulla, DE App. No. 195 46 692, published Jul. 6, 2000. Ex. 1003 (The English translation is provided as Ex. 1004).

² Shu, US 6,139,575, issued Apr. 2, 1999. Ex. 1005.

³ Schreck, US 6,454,799 B1, issued Apr. 6, 2000.

Reference[s]	Basis	Claims challenged	Case No.
Leonhardt ⁴	§ 102(b)	16 and 19–24	IPR2014-00395
Bailey ⁵	§ 102(e)	16 and 19–24	IPR2014-00395

The Board determines whether to grant joinder on a case-by-case basis, taking into account the particular facts of each case. Here, we determine that Petitioner’s stated reasons for allowing joinder do not outweigh meaningful reasons not to allow joinder. Petitioner sought *inter partes* review based on Figulla and Shu by filing a new petition, rather than seeking rehearing under 37 C.F.R. § 42.71(d)(1) of the decision in the ’111 IPR not to institute review based on these two references. We, however, already have determined that Petitioner has demonstrated a reasonable likelihood that it would prevail in its challenges to claims 20–24 and we decline to consider modifying the schedule in the ’111 IPR at a late stage in that proceeding to add additional challenges based on prior art references we already have considered. Absent granting the Joinder Motion, the Petition is barred under § 315(b).

Petitioner recognizes that the grounds herein essentially duplicate the grounds presented in the ’111 IPR Petition. Mot. for Joinder 4–5 (“the Board should also consider the grounds based on Figulla initially raised in the First [’111] Petition and *raised again* in this Second Petition”) (emphasis added). Additionally, Petitioner asserts that joinder is warranted because “Patent Owner has already considered and responded to these grounds

⁴ Leonhardt, US 5,957,949, issued Sept. 38, 1999.

⁵ Bailey, 6,458,153 B1, issued Oct. 1, 2002.

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