

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

BIOTRONIK, INC.,
Petitioner,

v.

ATLAS IP LLC,
Patent Owner.

Case IPR2015-00534
Patent 5,371,734

Before BARBARA A. BENOIT, LYNNE E. PETTIGREW, and
GEORGIANNA W. BRADEN, *Administrative Patent Judges*.

PETTIGREW, *Administrative Patent Judge*.

DECISION

Institution of *Inter Partes* Review and Grant of Motion for Joinder
37 C.F.R. § 42.108
37 C.F.R. § 42.122(b)

I. INTRODUCTION

Petitioner, Biotronik, Inc., filed a Petition for *inter partes* review of claims 6, 11, 14, and 21 of U.S. Patent No. 5,371,734 (Ex. 1001, “the ’734 patent”). Paper 1 (“Pet.”). Concurrently with its Petition, Biotronik filed a

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Motion for Joinder. Paper 2 (“Mot.”). The Motion for Joinder seeks to join this proceeding with *St. Jude Medical, Inc. v. Atlas IP, LLC*, Case IPR2014-00916 (“the St. Jude IPR”). Mot. 1. Patent Owner, Atlas IP LLC, indicates it does not oppose the Motion for Joinder and it has opted not to file a Preliminary Response. Paper 8, 2. Petitioner in the St. Jude IPR—St. Jude Medical, Inc., St. Jude Medical S.C., and Pacesetter, Inc. (collectively, “St. Jude”)—has not filed an opposition to Biotronik’s Motion for Joinder after being given the opportunity to do so. *See St. Jude Medical, Inc. v. Atlas IP, LLC*, Case IPR2014-00916, Paper 14, 2–3.

For the reasons explained below, we institute an *inter partes* review of claims 6, 11, 14, and 21 of the ’734 patent and grant Biotronik’s Motion for Joinder.

II. INSTITUTION OF INTER PARTES REVIEW

The Petition in this proceeding asserts the same grounds as those on which we instituted review in the St. Jude IPR. Pet. 4; Mot. 2. On December 8, 2014, we instituted a trial in the St. Jude IPR on the following grounds: (a) claims 6, 14, and 21 as anticipated under 35 U.S.C. § 102(a) by Natarajan 1992;¹ (b) claim 11 for obviousness under 35 U.S.C. § 103(a) over Natarajan 1992 and Bella;² (c) claims 6, 14, and 21 for obviousness under 35 U.S.C. § 103(a) over Natarajan ’542³ and Bantz;⁴ and (d) claim 11 for

¹ K.S. Natarajan et al., *Medium Access Control Protocol for Wireless LANs (An Update)*, IEEE P802.11/92-39, Mar. 9, 1992 (Ex. 1011, “Natarajan 1992”).

² U.S. Patent No. 4,542,499, issued Sept. 17, 1985 (Ex. 1026, “Bella”).

³ U.S. Patent No. 5,241,542, issued August 31, 1993 (Ex. 1003, “Natarajan ’542”).

⁴ U.S. Patent No. 5,123,029, issued June 16, 1992 (Ex. 1013, “Bantz”).

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obviousness under 35 U.S.C. § 103(a) over Natarajan '542, Bantz, and Bella. *St. Jude Medical, Inc. v. Atlas IP, LLC*, Case IPR2014-00916, Paper 7, 22.

In view of the challenges in the instant Petition and the petition in the St. Jude IPR, we institute an *inter partes* review in this proceeding on the same grounds as those on which we instituted in the St. Jude IPR. We do not institute *inter partes* review on any other grounds.

III. GRANT OF MOTION FOR JOINDER

The Petition in this proceeding has been accorded a filing date of January 6, 2015, and, thus, satisfies the requirement that joinder be requested no later than one month after the institution date of the St. Jude IPR. *See* 37 C.F.R. § 42.122(b); Paper 4 (Notice of Filing Date Accorded to Petition).

The Petition in this proceeding sets forth the same grounds and combinations of prior art, the same expert declaration, and the same arguments considered by the board in instituting trial in the St. Jude IPR. *See* Mot. 5. Biotronik represents in its Motion for Joinder that it has conferred with counsel for St. Jude, and both Biotronik and St. Jude will agree to consolidated filings on the existing briefing schedule, for which St. Jude will be responsible. Mot. 6. Similar to procedures ordered in other *inter partes* reviews, Biotronik is willing to be limited to separate filings, if any, of no more than seven pages directed only to points of disagreement with St. Jude, with the understanding it will not be permitted separate arguments in furtherance of those advanced in St. Jude's consolidated filings. *Id.* Biotronik represents that St. Jude and Biotronik have agreed to work together to manage the time normally allotted for depositions and oral argument, with St. Jude permitted to ask questions before Biotronik at any deposition and to present argument before Biotronik at any oral argument if

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St. Jude so chooses. *Id.* As noted, St. Jude does not oppose Biotronik's Motion for Joinder of this proceeding with the St. Jude IPR.

Under the circumstances, we conclude Biotronik has demonstrated that joinder will not unduly complicate or delay the St. Jude IPR, and therefore, we grant Biotronik's Motion for Joinder to join this proceeding with *St. Jude Medical, Inc. v. Atlas IP, LLC*, Case IPR2014-00916.

IV. ORDER

Accordingly, it is:

ORDERED that IPR2015-00534 is instituted and joined with IPR2014-00916;

FURTHER ORDERED that the grounds on which IPR2014-00916 was instituted are unchanged, and no other grounds are instituted in the joined proceeding;

FURTHER ORDERED that the Scheduling Order in place for IPR2014-00916 (Paper 8) shall govern the joined proceedings;

FURTHER ORDERED that, throughout the joined proceeding, St. Jude and Biotronik will file any paper, except for a motion that does not involve the other party, as a single, consolidated filing on behalf of Petitioner, and St. Jude will identify each such filing as a consolidated filing;

FURTHER ORDERED that for any consolidated filing made by St. Jude, Biotronik may file an additional paper, not to exceed seven pages, which may address only points of disagreement with St. Jude;

FURTHER ORDERED that IPR2015-00534 is terminated under 37 C.F.R. § 42.72, and all further filings in the joined proceeding are to be made in IPR2014-00916;

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FURTHER ORDERED that a copy of this Decision will be entered into the record of IPR2014-00916; and

FURTHER ORDERED that the case caption in IPR2014-00916 shall be changed to reflect joinder with this proceeding in accordance with the attached example.

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