

1 James J. Elacqua (CSB No. 187897)  
james.elacqua@dechert.com  
2 Noemi C. Espinosa (CSB No. 116753)  
nicky.espinosa@dechert.com  
3 Andrew N. Thomases (CSB No. 177339)  
andrew.thomases@dechert.com  
4 Michelle W. Yang (CSB No. 215199)  
michelle.yang@dechert.com  
5 Hieu H. Phan (CSB No. 218216)  
hieu.phan@dechert.com  
6 DECHERT LLP  
2440 W. El Camino Real, Suite 700  
7 Mountain View, California 94040-1499  
Telephone: (650) 813-4800  
8 Facsimile: (650) 813-4848

9 Attorneys for Plaintiffs  
10 MEDTRONIC, INC., MEDTRONIC USA, INC.,  
AND MEDTRONIC VASCULAR, INC.

11 UNITED STATES DISTRICT COURT  
12 NORTHERN DISTRICT OF CALIFORNIA  
13 SAN FRANCISCO DIVISION  
14

15 MEDTRONIC, INC., a Minnesota  
corporation, MEDTRONIC USA, INC., a  
16 Minnesota corporation, and MEDTRONIC  
VASCULAR, INC., a Delaware  
17 corporation,

18 Plaintiffs,

19 v.

20 AGA MEDICAL CORPORATION, a  
Minnesota corporation,

21 Defendant.  
22  
23  
24  
25  
26  
27  
28

Case No. C07-00567 MMC

**MEDTRONIC'S OPPOSITION TO AGA'S  
MOTION (#2) FOR SUMMARY  
JUDGMENT OF INVALIDITY UNDER 35  
U.S.C. §§ 101 ("DOUBLE PATENTING"),  
102(a) ("PRIOR USE") AND 103  
("OBVIOUSNESS")**

Date: April 3, 2009  
Time: 9:00 a.m.  
Place: Courtroom 7, 19th Floor  
Judge: Hon. Maxine M. Chesney

**TABLE OF CONTENTS**

		Page
1		
2		
3	I. INTRODUCTION .....	1
4	II. ARGUMENT .....	1
5	A. Legal Standards Where the Summary Judgment Movant Bears the Burden	
6	of Proof at Trial.....	1
7	B. AGA’s Request For Summary Judgment Regarding The Cragg II Work As	
8	§ 102(a) Prior Art Fails Because It Is Legally Flawed And Because, At A	
9	Minimum, It Raises Genuine Issues Of Material Fact.....	2
10	1. Improper Evidence and Issues Of Material Fact As To Whether	
11	Each Asserted Claim Limitation Is Met Preclude a Finding of	
12	Invalidity on Summary Judgment .....	5
13	2. The Evidence Demonstrates Dr. Cragg’s Lack Of Possession Of	
14	The Jervis Invention And Thus Precludes Summary Judgment Of	
15	Invalidity Under §102(a).....	3
16	3. Issues Of Material Fact As To Whether Dr. Cragg’s Work Was	
17	Public Preclude a Finding of Invalidity on Summary Judgment .....	6
18	C. AGA’s Request For Summary Judgment That Some Of The Asserted	
19	Claims Are Obvious Under § 103 Must Be Denied.....	7
20	D. AGA’s Request for Summary Judgment That The Asserted Claims Are	
21	Obvious In Light Of The Combination Of Cragg I, Tanaka, And Miyauchi	
22	Must Fail Because Numerous Issues of Material Fact Exist.....	8
23	1. Obviousness Requires A Fact-Intensive Inquiry.....	9
24	2. Material Issues Of Fact Regarding The Skill Level Of One Of	
25	Ordinary Skill In The Art Preclude A Finding of Obviousness on	
26	Summary Judgment.....	10
27	3. Material Issues Of Fact Regarding The Scope And Content Of The	
28	Prior Art Preclude A Finding of Obviousness on Summary	
	Judgment .....	10
	4. Material Issues Of Fact Regarding Whether The Differences	
	Between the Prior Art and Invention Would Be Obvious And	
	Whether There Is A Rational Basis To Combine Cited References	
	Preclude A Finding of Obviousness on Summary Judgment .....	13
	5. AGA Fails To Address Medtronic’s Objective Indicia Of	
	Nonobviousness .....	13
	E. AGA’s Motion for Summary Judgment of Obviousness-Type Double	
	Patenting Invalidity of the Jervis ‘141 Patent Should Be Denied.....	14
	1. AGA’s Motion For Summary Judgment of Obviousness-Type	
	Double Patenting Must be Denied Because AGA Did Not Plead	
	The Defense .....	15
	2. AGA’s Motion for Summary Judgment of Obviousness-Type	
	Double Patenting Must be Denied Because Use of the Patent That	
	AGA Relies Upon to Support Its Defense Violates 35 U.S.C. § 121	
	(“Safe Harbor”).....	17
	a. The Law of Double Patenting and Restriction Requirements.....	18

**TABLE OF CONTENTS**  
**(CONTINUED)**

		<b>Page</b>
1		
2		
3		
4	(1) Obviousness-Type Double Patenting.....	18
5	(2) Restriction Requirements And Related Divisional Patent Applications .....	18
6	(3) Statutory “Safe Harbor” Under 35 U.S.C. § 121 .....	19
7	b. A “Restriction Requirement” in the Jervis ‘378 “Parent” Patent Application Led to the Nonelected Claims in the Jervis ‘141 “Child/Divisional” Application And Triggered the “Safe Harbor” Provision of 35 U.S.C. § 121 .....	20
8		
9	(1) The Prosecution of the ‘378 “Parent” Patent Included a Restriction Requirement and Nonelected Claims Were Withdrawn.....	20
10		
11	(2) The Nonelected Claims Were Then Pursued In a Divisional Application That Became the ‘141 Patent.....	21
12		
13	(3) The Examiner Was Aware of the “Safe Harbor” and Never Rejected the ‘141 Claims Over the ‘378 Claims .....	22
14		
15	(4) In Sum, Section 121 Precludes AGA’s Double Patenting Defense .....	22
16	3. Putting Aside the Safe Harbor, AGA Fails to Establish that the Jervis ‘141 Patent Claims Are Not “Patentably Distinct” From the Jervis ‘378 Patent Claims.....	22
17	III. CONCLUSION .....	25
18		
19		
20		
21		
22		
23		
24		
25		
26		
27		
28		



1	<u>Matsushita Electrical Industrial Co. v. Zenith Radio Corp.</u> , 475 U.S. 574, 106 S. Ct. 1348 (1986).....	2
2		
3	<u>Medtronic Vascular, Inc. v. Advanced Cardiovascular Sys., Inc., No. C 06-1066</u> , 2009 U.S. Dist. LEXIS 8948 (N.D. Cal., Feb. 6, 2009).....	10, i
4	<u>Monarch Knitting Machinery Corp. v. Sulzer Morat GmbH</u> , 139 F.3d 877 (Fed. Cir. 1998).....	13
5		
6	<u>Mycogen Plant Science, Inc. v. Monsanto Company</u> , 243 F.3d 1316 (Fed. Cir. 2001).....	3, 4
7	<u>Oddzon Products, Inc. v. Just Toys, Inc.</u> , 122 F.3d 1396 (Fed. Cir. 1997).....	7
8		
9	<u>Pfizer, Inc. v. Teva Pharms USA, Inc.</u> , 518 F.3d 1353 (Fed. Cir. 2008).....	20
10	<u>Pharmacia &amp; Upjohn Co. v. Mylan Pharms., Inc.</u> , 170 F.3d 1373 (Fed. Cir. 1999).....	23
11		
12	<u>Ruiz v. A.B. Chance Co.</u> , 234 F.3d 654 .....	9, 14
13	<u>Studiengesellschaft Kohle mbH v. Northern Petrochemical Co.</u> , 784 F.2d 351 (Fed. Cir. 1986).....	20
14		
15	<u>Takeda Chemical v. Alphapharm</u> , 492 F.3d 1350 (Fed. Cir. 2007).....	9
16	<u>Union Carbide Co. v. Dow Chemical Co.</u> , 619 F. Supp. 1036 (D. Del. 1985).....	20
17		
18	<u>W.L. Gore &amp; Assocs., Inc. v. Garlock, Inc.</u> , 721 F.2d 1540 (Fed Cir. 1983).....	4, 11
19	<u>Welch v. General Motors Corp.</u> , 330 F. Supp. 80 (E.D. Va. 1970).....	23
20		
21	<u>Woodland Trust v. Flowertree Nursery, Inc.</u> , 148 F.3d 1368, 47 USPQ2d 1363 (Fed.Cir.1998) .....	7
22	<b>FEDERAL STATUTES</b>	
23	37 C.F.R. § 1.142 .....	18, 19
24	37 C.F.R. § 1.143 .....	19
25	37 C.F.R. § 1.146 .....	19
26	35 U.S.C. §§ 101 .....	15
27	35 U.S.C. §§ 102 .....	16
28	35 U.S.C. § 103 .....	1, 3, 7, 8, 13

# Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

## Real-Time Litigation Alerts



Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

## Advanced Docket Research



With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

## Analytics At Your Fingertips



Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

## API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

## LAW FIRMS

Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

## FINANCIAL INSTITUTIONS

Litigation and bankruptcy checks for companies and debtors.

## E-DISCOVERY AND LEGAL VENDORS

Sync your system to PACER to automate legal marketing.