Trials@uspto.gov
571-272-7822

Paper 9
Entered: April 1, 2019

UNITED STATES PATENT AND TRADEMARK OFFICE

---

BEFORE THE PATENT TRIAL AND APPEAL BOARD

---

COOK INC., COOK GROUP INC., and COOK MEDICAL LLC,
Petitioner,

v.

MEDTRONIC, INC.,
Patent Owner.

---

Case IPR2019-00123
Patent 6,306,141 B1

---

Before JAMESON LEE, KEN B. BARRETT, and JAMES A. TARTAL, *Administrative Patent Judges*.

BARRETT, *Administrative Patent Judge.*

ORDER
Conduct of the Proceedings
*37 C.F.R. § 42.5*

Petitioner, in an email dated March 21, 2019, requested authorization to file a five page reply to Patent Owner's Preliminary Response. Petitioner indicated that the requested brief would be limited to replying to Patent Owner's arguments regarding: 1) objective indicia of non-obviousness, and 2) denial of the Petition under 35 U.S.C. §§ 314 and 325. Petitioner's email further indicated that Patent Owner opposes the request. In our order of March 25, 2019 (Paper 7), we declined to hold a conference call to discuss the matter, and authorized Patent Owner to file a two-page brief addressing the basis for its opposition. Patent Owner filed that brief on March 27, 2019 (Paper 8), and maintains that we should deny Petitioner's request to reply to the Preliminary Response "because there is no good cause." Paper 8, 1.

Patent Owner argues that "Petitioners were already aware of, but chose to not submit or address, Patent Owner's evidence . . . [because] Petitioners were aware of Exhibits 2001–2007[, which were filed in the present case concurrently with the Preliminary Response]." *Id.* We understand Patent Owner to be referring to purported evidence of objective indicia that may have been the subject of arguments made in prior proceedings. *See id.* (citing to a Preliminary Response filed in a prior case (Ex. 1006) and asserting that Petitioner decided to "ignore evidence of secondary considerations").

Patent Owner further argues: "Likewise, the POPR's arguments addressing §§ 314(a) and 325(d) were 'reasonably foreseeable.'" *Id.* at 2 (citations omitted). In this regard, Patent Owner asserts that "[t]he Petition (p. 1) also discusses Exhibits 2008-2009—petitions in prior proceedings." *Id.* at 1. This is a reference to Petitioner's mandatory identification of

related matters pursuant to 37 CFR § 42.8, and the "discuss[ion]" consists of the following: "Claims 1–22 of the '141 Patent were challenged in IPR2013-00269 and/or IPR2014-00362. Both proceedings were settled and terminated before any institution decision." Pet. 1.

In the Preliminary Response, Patent Owner argues that the Board should exercise its discretion to deny the Petition based, at least, on two prior district court challenges and the two above-referenced challenges before this Board, and because "the vast majority of the asserted references in the Petition already were considered by the Patent Office," and because one of the remaining references is purportedly cumulative of those already considered. Prelim. Resp. 48, 55–56.

We determine that briefing from Petitioner regarding Patent Owner's arguments for discretionary denial would be helpful to a fair disposition of the issues first raised by Patent Owner regarding discretionary denial of the Petition and do not find that Petitioner must have already addressed in its Petition discretionary denial under 35 U.S.C. § 314(a) or § 325(d). As such, there is good cause to allow a reply brief on that subject. In contrast, we see no need for further briefing at this time regarding the subject of objective indicia.

Patent Owner additionally makes the apparently-preemptive argument that there is no good cause to allow Petitioner to address *any* alleged misstatements in the Preliminary Response. *Id.* at 2. Petitioner's reply to the preliminary response is limited to addressing Patent Owner's arguments regarding 35 U.S.C. §§ 314, 325.

It is:

ORDERED that Petitioner is authorized to file a Reply to the Preliminary Response by April 8, 2019, limited to five pages and limited to addressing Patent Owner's arguments regarding discretionary denial under 35 U.S.C. §§ 314, 325.

For PETITIONER:

Dominic Zanfardino
Jeffry Nichols
Jason Schigelone
BRINKS GILSON & LIONE
dpz@brinksgilson.com
jnichols@brinksgilson.com
jschigelone@brinksgilson.com

For PATENT OWNER:

James L. Davis, Jr.
Andrew N. Thomases
Gabrielle E. Higgins
ROPES & GRAY LLP
james.l.davis@ropesgray.com
andrew.thomases@ropesgray.com
gabrielle.higgins@ropesgray.com