

1 james.elacqua@dechert.com
2 Noemi C. ("Nicky") Espinosa (CSB No.: 116753)
nicky.espinosa@dechert.com
3 Ellen J. Wang (CSB No.: 215478)
ellen.wang@dechert.com
4 Joshua C. Walsh-Benson (CSB No.: 228983)
joshua.walsh-benson@dechert.com
5 DECHERT LLP
2440 W. El Camino Real, Suite 700
6 Mountain View, California 94040
Telephone: (650) 813-4800
7 Facsimile: (650) 813-4848

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

10
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 corporation,

17 Plaintiffs,

18 v.

19 W.L. GORE & ASSOCIATES, INC., a
20 Delaware corporation,

21 Defendant.

Case No. C06-04455 JSW (JL)

**MEDTRONIC'S OPPOSITION TO
GORE'S MOTION FOR SUMMARY
JUDGMENT OF PATENT INVALIDITY**

Date: August 22, 2008
Time: 9:30 a.m.
Place: Courtroom 2, 17th Floor
Judge: Hon. Jeffrey S. White

TABLE OF CONTENTS

		Page
1		
2		
3	I. INTRODUCTION	1
4	II. APPLICABLE LEGAL STANDARDS	2
5	A. Prerequisites for Summary Judgment	2
6	B. Establishing That A Claim Is Invalid Because It Is Not “Enabled”	4
7	C. Establishing Whether a Claim Is Obvious	5
8	D. Establishing Whether A Claim Is Indefinite	6
9	III. ARGUMENT	7
10	A. Gore Fails To Present Any Clear And Convincing Evidence To Support Its Arguments For Invalidity	7
11	B. Gore’s Non-enablement Argument Regarding The Wiktor Patent Claims Is Contrary to the Law and Present Material Issues of Fact	8
12	1. Gore Misdirects The Court To Require Enablement of Un-recited Claim Elements (“Self-Expanding Stent” or “Resilient Metal Wire”).....	10
13	2. Genuine Issues of Material Fact Preclude Summary Adjudication	11
14	3. Gore’s Inconsistent Arguments Present Material Issues of Fact	12
15	4. Gore Relies on Inapposite Precedents.....	13
16	5. Mr. Wiktor’s Subsequent Efforts to Make a Self-Expanding Stent are Inadmissible Hearsay and Irrelevant to Enablement.....	16
17	C. Gore Presents No Clear And Convincing Evidence of Obviousness of the Jervis Patents.....	16
18	1. Whether The Cragg Filter Reference Qualifies As “Prior” Art Presents A Genuine Issue Of Material Fact	17
19	2. Genuine Issues Of Material Fact Are Presented Regarding The Scope And Content Of The Asserted Prior Art.....	19
20	3. Gore Fails To Review The Differences Between The Invention And The Prior Art And How Such Differences Are Obvious To One Skilled In The Art, Fails To Show A Reason To Combine Teachings, and Belatedly Raises A New Invalidity Contention	21
21	4. Gore Omits Any Analysis of Secondary Factors	23
22	D. Gore Provides No Clear and Convincing Evidence that Claims of the Jervis Patent Are Invalid for Indefiniteness	25
23	1. The Recited Claims Of The Jervis Patents Are Definite.....	27
24	2. Nothing In The Claims Of The Jervis Patents Require A Specific Amount Of SIM To Be Present.....	28
25	3. Gore Has Not Established That A Person Of Ordinary Skill In The Art Would Be Unable To Understand The Metes and Bounds Of The Claims.	29
26	4. Gore’s Reliance On Mr. Jervis’ Deposition Testimony Is Improper	30
27		
28		

1
2
3
4
5
6
7
8
9
10
11
12
13
14
15
16
17
18
19
20
21
22
23
24
25
26
27
28

TABLE OF CONTENTS
(continued)

	Page
5. Gore Contradicts Itself By Arguing That The Claims Are Both Obvious And Indefinite.....	31
6. The Cases Gore Relies On Are Factually Distinguishable From The Facts of This Case	31
IV. CONCLUSION	32

TABLE OF AUTHORITIES

FEDERAL CASES

	Page
<u>02 Micro Int'l Ltd. v. Monolithic Power Systems, Inc.</u> , 467 F.3d 1355 (Fed. Cir. 2006).....	22
<u>American Hoist & Derrick Co. v. Sowa & Sons, Inc.</u> , 725 F.2d 1350 (Fed. Cir. 1984).....	22
<u>Anderson v. Liberty Lobby, Inc.</u> , 477 U.S. 242 (1986).....	26, 28
<u>Automotive Technologies Int'l, Inc. v. BMW of North America, Inc.</u> , 501 F.3d 1274 (Fed. Cir. 2007).....	14, 15, 16
<u>BJ Services Co. v. Halliburton Energy Services, Inc.</u> , 338 F.3d 1368 (Fed. Cir. 2003).....	6
<u>Bancorp Serv., L.L.C. v. Hartford Life Ins. Co.</u> , 359 F.3d 1367 (Fed. Cir. 2004).....	6, 7, 27, 32
<u>Bey v. Kollonitsch</u> , 806 F.2d 1024 (Fed. Cir. 1986).....	19
<u>Boston Scientific Corp. v. Johnson & Johnson</u> , 534 F.Supp.2d 1062 (N.D. Cal. 2007).....	5, 6, 17, 23
<u>Burke, Inc. v. Bruno Indep. Living Aids, Inc.</u> , 183 F.3d1334 (Fed. Cir. 1999).....	30
<u>Celotex Corp. v. Catrett</u> , 477 U.S.317 (1986).....	29
<u>Christie v. Seybold</u> , 55 F. 69 (6th Cir. 1893).....	17
<u>Continental Can Company USA, Inc. v. Monsanto Co.</u> , 948 F.2d 1264 (Fed. Cir. 1991).....	3
<u>Corning Glass Works v. Sumitomo Elec. U.S.A., Inc.</u> , 868 F.2d 1251 (Fed.Cir.1989).....	30
<u>Depomed, Inc. v. Ivax Corp.</u> , 532 F. Supp. 2d 1170 (N.D. Cal. Dec. 12, 2007).....	5
<u>Eisai Co. v. Dr. Reddy's Labs., Ltd.</u> , No. 2007-1397,-1398, 2008 U.S. App. LEXIS 15399 (Fed. Cir. 2008).....	5, 16, 23
<u>Exxon Research & Eng'g Co. v. United States</u> , 265 F.3d 1371 (Fed. Cir. 2001).....	7, 25
<u>Falkner v. Inglis</u> , 448 F.3d 1357 (Fed. Cir. 2006).....	4, 5

TABLE OF AUTHORITIES
(continued)

		Page
1		
2		
3	<u>Fontenot v. Upjohn,</u>	
4	780 F.2d 1190 (5th Cir. 1986).....	2
5	<u>Fraser v. Goodale,</u>	
6	342 F.3d 1032 (9th Cir. 2003).....	2
7	<u>Fresenius Med. Care Holdings, Inc. v. Baxter Int'l, Inc.,</u>	
8	No. 03-1431, 2006 U.S. Dist. LEXIS 36788 (N.D. Cal. May 25, 2006).....	3
9	<u>In re GPAC Inc.,</u>	
10	57 F.3d 1573 (Fed. Cir. 1995).....	25
11	<u>Genentech Inc. v. Novo Nordisk A/S,</u>	
12	108 F.3d 1361 (Fed. Cir. 1997).....	4
13	<u>Graham v. John Deere Co.,</u>	
14	383 U.S. 1 (1966).....	5, 16, 21
15	<u>Halliburton,</u>	
16	514 F.3d 1244	27, 31, 32
17	<u>Honeywell Int'l, Inc. v. Int'l Trade Comm'n,</u>	
18	341 F.3d 1332 (Fed. Cir. 2003).....	32
19	<u>Houghton v. South,</u>	
20	965 F.2d 1532 (9th Cir. 1992).....	2
21	<u>Int'l Shortstop, Inc. v. Rally's, Inc.,</u>	
22	939 F.2d 1257 (5th Cir. 1991).....	2
23	<u>Intel Corp. v. VIA Technologies, Inc.,</u>	
24	319 F.3d 1357 (Fed. Cir. 2003).....	7
25	<u>Intertrust Technologies Corp. v. Microsoft Corp.,</u>	
26	275 F. Supp. 2d 1031 (N.D. Cal. 2003)	7
27	<u>Invitrogen Corp. v. Clontech Labs., Inc.,</u>	
28	429 F.3d 1052 (Fed. Cir. 2005).....	<i>passim</i>
	<u>Johns Hopkins University v. CellPro,</u>	
	152 F.3d 1342 (Fed. Cir. 1998).....	13, 16
	<u>KSR Int'l Co. v. Teleflex, Inc.,</u>	
	127 S. Ct. 1727 (2007).....	<i>passim</i>
	<u>Koito Mfg. Co. v. Turn-Key-Tech L.L.C.,</u>	
	381 F.3d 1142 (Fed. Cir. 2004).....	4, 8
	<u>Liebel-Flarsheim Co. v. Medrad, Inc.,</u>	
	358 F.3d 898 (Fed. Cir. 2004).....	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.