Filed: January 22, 2021

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MEDTRONIC COREVALVE LLC,

PETITIONER,

V.

COLIBRI HEART VALVE LLC,

PATENT OWNER.

Case No. IPR2020-01454
U.S. Patent No. 9,125,739

SUR-REPLY TO PATENT OWNER'S PRELIMINARY RESPONSE

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Factor 1: Petitioner admits that "the district judge indicated during a 11/17/2020 conference that he intended to deny the motion to stay and that the trial date would not move". (Reply, 1.) Nothing in Petitioner's Reply changes this. The trial date remains September 14, 2021—six months prior to the March 2022 FWD deadline. That the district court never denied the stay in writing is of no moment, as Judge Carter denied the stay orally during the 11/17/20 conference, and subsequently entered a scheduling order "maintaining the September 14, 2020 jury trial date," which is consistent with his denial of the stay motion. (Ex. 2009 ¶ 6; Ex. 2003, 2-4.) That Judge Carter agreed to stay a different case prior to institution has no bearing on the fact that Judge Carter denied Petitioner's stay motion applicable here. *See Apple Inc. v. Fintiv, Inc.* ("*Fintiv II*"), IPR2020-00019, Pap. 15, 13 (PTAB May 13, 2020) (informative) ("declin[ing] to infer, based on actions taken in different cases with different facts, how the District Court would rule should a stay be requested by the parties in the parallel case here").

Petitioner presents no evidence that the court will grant a stay if IPR is instituted. Instead, Petitioner lumps this case in with ones in which, according to Petitioner, "the judge [has] contemporaneously continued other trial dates in light of COVID." (Reply, 1 (citing Exs. 1026-27).) But in Ex. 1027, Judge Carter *denied* the "Application to Continue Trial Date from November 17, 2020 to February 23, 2021," and ruled that the "Parties are to remain prepared to go to trial as soon as

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the Court reopens." (Ex. 1027, 17.) And in Ex. 1026, Judge Carter extended a stipulated continuance first granted *in March* because the Defendants "include the California Department of Public Health" and others "currently focusing their resources on the State's response to the COVID 19 crisis." (Ex. 2012, 2-3.) No such reason exists for continuing this trial date. "[W]hen a district court has denied a motion to stay and has not indicated it would reconsider if an [IPR] is instituted, the facts underlying this factor weigh in favor of denying institution." *Apple Inc. v. Pinn, Inc.*, IPR2020-00999, Pap. 15, 8 (PTAB Dec. 8, 2020).

Factor 2: The Board "generally take[s] courts' trial schedules at face value absent some strong evidence to the contrary." *Fintiv II* Pap. 15, 13 (holding that this factor weighs in favor of discretionary denial where, although the trial had been postponed once due to COVID, the trial was still "scheduled to begin two months before [the] deadline to reach a final decision".) Here, no such contrary evidence exists. Indeed, Petitioner's own evidence indicates that the district court is *unlikely* to move the September 14, 2021 trial date in light of COVID. Ex. 1027 shows that, even in the event of a court closure, Judge Carter is unlikely to extend the trial date by even three months and will instead hold trial as soon as courts are allowed to reopen (ruling "Parties are to remain prepared to go to trial as soon as the Court reopens"). (Ex. 1027, 17.) Ex. 1027 also refutes Petitioner's unsupported argument that Judge Carter will delay cases currently set for trial in order to deal

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with “a backlog of 9+ months.” Rather, Ex. 1027 indicates that Judge Carter does not intend to handle “backlog” by disrupting currently-scheduled cases.

Judge Carter has dealt with COVID not by continuing cases, but rather by “hold[ing] civil cases outside the courthouse doors,” which he did as recently as 1/13/21. (Ex. 2013, 1; Ex. 2014, 2.) In addition, Dr. Fauci, Director of the National Institute of Allergy and Infectious Diseases, has predicted that the U.S. may “approach herd immunity by summer’s end and ‘normality that is close to where we were before’ by the end of 2021.” (Ex. 2015, 2.) Thus, there is no evidence that Judge Carter intends to or will need to delay the 9/14/21 trial date, which he made clear on 11/17/20 “would not move under any circumstances.” (Ex. 2004, 2; Ex. 2009 ¶ 6.). Contemporaneously with that order, and to ensure that the trial proceeds on schedule, Judge Carter appointed a technical special master to expeditiously and efficiently conduct the *Markman* hearing and “issue a Report and Recommendation as to claim construction.” (Ex. 2006, 3.) On 1/21/21, the Special Master indicated that the *Markman* hearing would go forward on 2/1/21. (Ex. 2016, 1.) Thus, the “facts underlying this second *Fintiv* factor strongly favor denying institution.” *Apple*, IPR2020-00999, Pap. 15, 9-10) (denying institution where PO presented evidence that parallel litigation in the Central District of California “likely will proceed as scheduled” despite COVID-19 and where, “even if the district court were to delay the trial by a few months, the trial still would be

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completed well before a final written decision would issue in our proceeding.”).

Factor 3: Petitioner relies on the Board’s holding that a petition filed “promptly after [Petitioner becomes] aware of the claims being asserted [weighs] against denying institution.” *Snap, Inc. v. SRK Tech, LLC*, IPR2020-00820, Pap. 15, 11 (precedential). But as Petitioner acknowledges, PO first filed its complaint against Petitioner in 2019—nine months before this Petition was filed. On Reply, Petitioner cannot and does not deny that it was “aware of the claims being asserted” at the time PO filed its original complaint. (*See* Reply, 2-3.) Rather, Petitioner relies solely on the fact that this complaint was never served. (Reply, 3.) But *Snap* does not base its definition of “promptness” on the date of service, but rather on the relevant date of Petitioner’s awareness of the asserted claims. Thus, Petitioner was not prompt in filing its Petition, resulting in significant investment in the parallel proceeding by the court and the parties, including—by the institution decision deadline—completion of the *Markman* and fact discovery process, as well as infringement and invalidity contentions and responses. (*See* POPR, 20-24; Ex. 2005, 2-3.) As in *Fintiv II*, this factor favors discretionary denial. *See Fintiv II* at 13-14 (factor favors denial where the parties had completed claim construction and infringement and invalidity contentions, despite fact discovery being incomplete and expert discovery and substantive motion practice yet to come).

Factor 4: Petitioner’s third, desperate attempt at a *Sotera*-like stipulation in

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