

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MEDTRONIC, INC., and MEDTRONIC VASCULAR, INC.,
Petitioner,

v.

ENDOTACH LLC,
Patent Owner.

Case IPR2014-00100
Patent 5,593,417

Before JACQUELINE WRIGHT BONILLA, MICHAEL J. FITZPATRICK, and
HYUN J. JUNG, *Administrative Patent Judges*.

BONILLA, *Administrative Patent Judge*.

ORDER
Conduct of the Proceeding
37 C.F.R. § 42.5

1. Introduction

On April 17, 2014, an initial conference call was conducted between counsel for Petitioner, Jack Barufka and Ngai Zhang; counsel for Patent Owner, Matthew Phillips, Brett Pinkus, and Jonathan Suder; and Judges Bonilla and Jung. The purpose of the call was to determine if the parties have any issues concerning the Scheduling Order (Paper 16) and to discuss any motions contemplated by the parties. Prior to the call, Petitioner filed a paper requesting authorization to file a motion to submit supplemental information under 37 U.S.C. § 42.123(a). Paper 17.

2. Related Matters

The parties have identified no other *inter partes* reviews, reexaminations or reissue applications of the '417 patent. Counsel for Patent Owner confirmed that Patent Owner has asserted the '417 patent in three U.S. District Court litigations, including one involving Petitioner as a defendant in the Northern District of California, one involving another defendant (W.L. Gore) in the Northern District of Florida (now settled), and one involving a different defendant (Cook Medical) in the Southern District of Indiana (having a scheduled trial date of September 15, 2014).

3. Scheduling Order

Neither party indicated any issues with respect to the Scheduling Order. The parties are reminded that, without obtaining prior authorization from the Board, they may stipulate to different dates for DATES 1-3 by filing an appropriate notice with the Board. The parties may not stipulate to any other changes to the Scheduling Order.

4. Discovery

There are no discovery issues pending at this time. Counsel for Petitioner indicated that, at some future time, Petitioner may request additional discovery regarding expert reports and other documents potentially relating to patentability, which are currently under seal in a related district court litigation.

The parties are reminded of the discovery provisions of 37 C.F.R. §§ 42.51-52 and Office Patent Trial Practice Guide. *See* Office Patent Trial Practice Guide, 77 Fed. Reg. 48756, 48761-2 (Aug. 14, 2012). As noted in 37 C.F.R. § 42.51(b)(2)(i), the parties may agree to additional discovery between themselves. Discovery requests and objections are not to be filed with the Board without prior authorization. If the parties are unable to resolve discovery issues between them, the parties may request a conference with the Board. A motion to exclude, which does not require Board authorization, must be filed to preserve any objection. *See* 37 C.F.R. § 42.64, Office Patent Trial Practice Guide, 77 Fed. Reg. at 48767.

Each party may depose experts and affiants supporting the opposing party. The parties are reminded of the provisions for taking testimony found at 37 C.F.R. § 42.53 and the Office Patent Trial Practice Guide at 77 Fed. Reg. at 48772, App. D.

5. No Proposed Motion to Amend

During the conference call, counsel for the Patent Owner informed the Board that it will not file a motion to amend.

6. Proposed Motion to Submit Supplemental Information

Before the conference call, Petitioner filed a paper requesting authorization to file a motion to submit supplemental information “to present additional grounds of unpatentability.” Paper 17 at 1. Specifically, Petitioner requested authorization

to file a motion to file in this proceeding Patent Owner's "Infringement Contentions" (Ex. 1009) from the related district court litigation involving Petitioner, as well as three additional prior art references (Exs. 1010-1012). *Id.* at 1-2. During the conference call, Counsel for Petitioner confirmed that Petitioner wished to file such documents to preemptively address positions that Patent Owner may take in its Patent Owner Response regarding claim construction and patentability, based on what Petitioner read in Patent Owner's "Infringement Contentions" filed in district court.

The Board explained that submitting supplemental information under 37 C.F.R. § 42.123(a) as a vehicle to respond to a possible position that another party may take in the future is improper. Moreover, Petitioner may not raise a new ground of patentability after institution of a trial, even assuming Patent Owner offers its own claim construction, and patentability contentions based on that construction, in a Patent Owner Response. *See Palo Alto Networks, Inc., v. Juniper Networks, Inc.*, IPR2013-00369, Paper 37 at 3 (granting a motion to submit supplemental information because, *inter alia*, "the supplemental information Petitioner seeks to submit does not change the grounds of unpatentability authorized in this proceeding, nor does it change the evidence initially presented in the Petition to support those grounds of unpatentability").

Petitioner will have an opportunity to respond to a Patent Owner Response in a Reply. Such a Reply, however, may respond only to arguments raised in the Patent Owner Response. 37 C.F.R. § 42.23(b). The Reply may cite new evidence, such as declarations, references, and other documents, as long as that evidence responds to Patent Owner's arguments and is relevant to the grounds as instituted.

Thus, the Board denies Petitioner's request for authorization to file a motion to submit supplemental information, and will expunge Exhibits 1009-1012 from the record.

7. Possible Motion to Seal and Protective Order

Counsel for Patent Owner indicated that Patent Owner may file a motion to seal regarding documents under seal in a parallel district court litigation, assuming Petitioner obtains such documents through additional discovery, as discussed above. Such a motion is not authorized at this time. The parties may request a conference call with the Board in relation to a motion to seal and proposed protective order, assuming the need arises.

In the meantime, the Board notes, as stated in 37 C.F.R. § 42.54, a party may file a motion to seal if the motion also contains a proposed protective order, such as the default standing protective order set forth in the Office Patent Trial Practice Guide, 77 Fed. Reg. at 48771, App. B. Upon filing of a motion and proposed protective order, the documents or things "shall be provisionally sealed on receipt of the motion and remain so pending the outcome of the decision on the motion." 37 C.F.R. § 42.14.

As discussed in the conference call, no protective order is currently in place, and none will be entered in the proceeding unless a party files a motion to seal with a proposed protective order. If the parties choose to propose a protective order other than or departing from the default protective order, they must submit a joint, proposed protective order, accompanied by a red-lined version based on the default protective order in Appendix B to the Board's Office Patent Trial Practice Guide, 77 Fed. Reg. at 48771.

If a party's filed documents or things are accompanied by a motion to seal, any redacted information for which the motion is granted cannot be used in the

Board's final decision and also remain under seal, because the final decision is a matter of public record. Thus, the parties are cautioned to keep any redactions to a minimum, and to also consider other ways of presenting the information.

8. Motions

The parties are reminded that, except as otherwise provided in the Rules, Board authorization is required before filing a motion. 37 C.F.R. § 42.20(b). A party seeking to file a motion should request a conference to obtain authorization to file the motion. No other motions are authorized in this proceeding at this time.

9. Settlement

Although the parties have engaged in settlement discussions, the parties stated that there is no immediate prospect of settlement that will affect the conduct of this proceeding.

Accordingly, it is

ORDERED that Petitioner's request for authorization to file a motion to submit supplemental information under 37 C.F.R. § 42.123(a) is DENIED;

FURTHER ORDERED that Exhibits 1009-1012 filed on April 15, 2015, are expunged from the record of this proceeding;

FURTHER ORDERED that no other motions are authorized at this time, other than those already authorized by rule or the Scheduling Order; and

FURTHER ORDERED that due dates specified in the Scheduling Order dated March 25, 2014, remain unchanged.

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