

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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MEDTRONIC, INC., MEDTRONIC VASCULAR, INC., AND  
MEDTRONIC COREVALVE, LLC,  
Petitioner,

v.

TROY R. NORRED, M.D.,  
Patent Owner.

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Case IPR2014-00823  
Patent 6,482,228 B1

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Before SHERIDAN K. SNEDDEN, BARRY L. GROSSMAN, and  
MITCHELL G. WEATHERLY, *Administrative Patent Judges*.

Opinion for the Board filed by *Administrative Patent Judge* SNEDDEN.

Opinion Concurring filed by *Administrative Patent Judge* WEATHERLY.

SNEDDEN, *Administrative Patent Judge*.

DECISION

Denying Motion for Joinder,  
and Denying Institution of *Inter Partes* Review  
*37 C.F.R. §§ 42.108, 42.122*

## I. INTRODUCTION

Medtronic, Inc., Medtronic Vascular, Inc., and Medtronic Corevalve, LLC (collectively “Medtronic” or “Petitioner”) filed a petition (Paper 3, “Petition” or “Pet.”) requesting an *inter partes* review of claims 20–24 (the “challenged claims”) of U.S. Patent 6,482,228 B1 (Ex. 1001, “the ’228 patent”). See 35 U.S.C. § 311. Troy R. Norred, M.D. (“Patent Owner”) did not file a Patent Owner Preliminary Response.

Concurrently with the filing of the Petition, Petitioner filed a motion for joinder pursuant to 35 U.S.C. § 315(c). Paper 2, 1 (the “Mot. for Joinder” or “Joinder Motion”). Specifically, Medtronic moves “for Joinder of the Second Petition for *Inter partes* Review of U.S. Patent No. 6,482,228 . . . , with the instituted *inter partes* review, *Medtronic, Inc., et al. v. Troy R. Norred*, Case No. IPR2014-00111, pursuant to 35 U.S.C. § 315(c) and 37 C.F.R § 42.122.” *Id.* Thus, Medtronic seeks to consolidate issues presented in the Petition with issues on which we have instituted review in *Medtronic, Inc. v. Norred*, Case IPR2014-00111 (“the ’111 IPR”). Petitioner timely filed its Joinder Motion within one month after institution of a trial in IPR2014-00111, as required by 37 C.F.R. § 42.122(b). Patent Owner filed an Opposition to Motion for Joinder (Paper 7, “Opp. to Joinder”). Petitioner filed a Reply to Opposition to Motion for Joinder (Paper 11, “Reply”). We have jurisdiction under 35 U.S.C. § 314.

For the reasons provided below, we exercise our discretion under 35 U.S.C. § 315(c) and deny Petitioner’s Motion to join the Petition to the ’111 IPR. We also deny the Petition and do not institute an *inter partes* review of the ’228 patent based on the Petition.

## II. ANALYSIS

### A. *Law of Joinder*

The statutory provision governing joinder of *inter partes* review proceedings is § 315(c), which provides as follows:

(c) JOINDER.—If the Director institutes an inter partes review, the Director, in his or her discretion, may join as a party to that inter partes review any person who properly files a petition under section 311 that the Director, after receiving a preliminary response under section 313 or the expiration of the time for filing such a response, determines warrants the institution of an inter partes review under section 314.

Section 315(c) references § 311, which provides that “a person who is not the owner of a patent may file with the Office a petition to institute an inter partes review of the patent.” Section 315(c) refers also to § 314, which allows the Director to institute an *inter partes* review if there is a reasonable likelihood that the petitioner would prevail with respect to at least one of the claims challenged in the petition.

The Petition was filed on May 27, 2014. Petitioner acknowledges that, more than one year before filing the Petition, it was served with a complaint alleging infringement of the '228 patent in *Norred v. Medtronic, Inc.*, No. 2:13-cv-02061. Pet. 1, 6. Section 315(b) bars institution of *inter partes* review when the petition is filed more than one year after the petitioner is served with a complaint alleging infringement of the patent. 35 U.S.C. § 315(b); 37 C.F.R. § 42.101(b). The one-year time bar, however, does not apply to a request for joinder. 35 U.S.C. § 315(b) (final sentence); 37 C.F.R. § 42.122(b). Thus, absent joinder of this proceeding to IPR2014-00111, the Petition is barred under § 315(b).

The decision to grant joinder is discretionary. 35 U.S.C. § 315(c); 37 C.F.R. § 42.122(b). When exercising that discretion, the Board is mindful that our rules, including the rules for joinder, must be construed to secure the just, speedy, and inexpensive resolution of every proceeding. 37 C.F.R. § 42.1(b).

*B. Decision on Motion for Joinder*

Petitioner challenges claims 20–24 of the '228 patent on the following grounds. Pet. 8–14.

Reference[s]	Basis	Claims challenged
Figulla <sup>1</sup>	§ 102(b)	20–24
Figulla and Shu <sup>2</sup>	§ 103(a)	20–24

Petitioner, however, is currently a party in the following instituted *inter partes* review proceedings involving the '228 patent: IPR2014-00111 and IPR2014-00395. These two cases are on-going and were instituted with the following grounds:

Reference[s]	Basis	Claims challenged	Case No.
Schreck <sup>3</sup>	§ 102(e)	20–24	IPR2014-00111
Schreck and Shu	§ 103(a)	22–23	IPR2014-00111

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<sup>1</sup> Figulla, DE App. No. 195 46 692, published Jul. 6, 2000. Ex. 1003 (The English translation is provided as Ex. 1004).

<sup>2</sup> Shu, US 6,139,575, issued Apr. 2, 1999. Ex. 1005.

<sup>3</sup> Schreck, US 6,454,799 B1, issued Apr. 6, 2000.

Reference[s]	Basis	Claims challenged	Case No.
Leonhardt <sup>4</sup>	§ 102(b)	16 and 19–24	IPR2014-00395
Bailey <sup>5</sup>	§ 102(e)	16 and 19–24	IPR2014-00395

The Board determines whether to grant joinder on a case-by-case basis, taking into account the particular facts of each case. Here, we determine that Petitioner’s stated reasons for allowing joinder do not outweigh meaningful reasons not to allow joinder. Petitioner sought *inter partes* review based on Figulla and Shu by filing a new petition, rather than seeking rehearing under 37 C.F.R. § 42.71(d)(1) of the decision in the ’111 IPR not to institute review based on these two references. We, however, already have determined that Petitioner has demonstrated a reasonable likelihood that it would prevail in its challenges to claims 20–24 and we decline to consider modifying the schedule in the ’111 IPR at a late stage in that proceeding to add additional challenges based on prior art references we already have considered. Absent granting the Joinder Motion, the Petition is barred under § 315(b).

Petitioner recognizes that the grounds herein essentially duplicate the grounds presented in the ’111 IPR Petition. Mot. for Joinder 4–5 (“the Board should also consider the grounds based on Figulla initially raised in the First [’111] Petition and *raised again* in this Second Petition”) (emphasis added). Additionally, Petitioner asserts that joinder is warranted because “Patent Owner has already considered and responded to these grounds

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<sup>4</sup> Leonhardt, US 5,957,949, issued Sept. 38, 1999.

<sup>5</sup> Bailey, 6,458,153 B1, issued Oct. 1, 2002.

[Figulla and Figulla combined with Shu] in the Patent Owner’s Response to the First Petition.” Mot. for Joinder 8. This is incorrect. Patent Owner did not respond to asserted grounds based on Figulla and Figulla combined with Shu in Patent Owner’s Response in the ’111 IPR, Paper 15. If we allowed joinder of the Petition herein with the ’111 IPR, Patent Owner would be entitled to respond to the new references and new grounds being joined.

In IPR2014-00111, which Petitioner seeks to join, Patent Owner has filed a Patent Owner Response (Paper 15) and a Motion to Amend the claims (Paper 18). Petitioner has filed a Reply to the Patent Owner Response (Paper 25) and an Opposition to the Motion to Amend. Three depositions have been noticed (Papers 19, 20, 21) and at least two depositions have been taken (Papers 23, 24). The oral argument in the ’111 IPR has been combined with the oral arguments in related cases IPR2014-00110 and IPR2014-00395 and is scheduled for January 27, 2015 (Paper 28). Thus, adding additional grounds raised in the Petition could impose significant delays in the ’111 IPR. Additional responses and replies would be required. Additional depositions of witnesses already deposed also may be required.

Petitioner also asserts, incorrectly, that joinder is warranted because the Petition herein “involves the same patent, the same claims, the same parties, and a subset of the same prior art references as in IPR2014-00111.” Mot. for Joinder 7. The Petition herein *does not* involve a “subset of the same prior art references as in IPR2014-00111.” The *inter partes* review in the ’111 IPR involves only the patentability of claims 20–24 under 35 U.S.C. § 102 as anticipated by Schreck; and the patentability of claims 22 and 23 under 35 U.S.C. § 103 for obviousness over Schreck and Shu.

Decision to Institute, '111 IPR, 20. The Petition herein is *not* a subset of the references or grounds involved in the pending '111 IPR.

Petitioner argues that, *if* we were to deny the Joinder Motion, and *if* Patent Owner were to prevail with respect to Schreck in the '111 IPR, and *if* Patent Owner were to argue in the co-pending district court litigation that 35 U.S.C. § 315(e)(1) estops Petitioner from relying on Figulla, and *if* the district court were to find estoppel, *then* Petitioner would be prejudiced. Mot. for Joinder 5–6. This series of contingencies is too hypothetical to outweigh the immediate and real prejudice that will result from joinder.

Based on the analysis above, on the record before us, Petitioner has not shown that joinder is justified.

### *C. Response to the Concurrence*

We write further to address the interpretation of § 315(c) set forth in the concurring opinion.

Unlike the concurrence, we conclude that § 315(c) encompasses both party joinder and issue joinder, and as such, permits the joinder of any person who properly files a petition under § 311, including a petitioner who is already a party to the existing *inter partes* review. We reach this conclusion because § 315(c) permits the joinder of any person who properly files a petition under § 311. The only person excluded unambiguously from the scope of “any person” under § 315(c) is the patent owner, because the patent owner cannot file a petition under § 311 (“ . . . a person who is not the owner of a patent may file with the Office a petition to institute an *inter partes* review of the patent”).

Furthermore, joinder, as used in § 315(c), does not unambiguously refer solely to the joinder of a party, but rather, includes language related to

the joinder of issues presented in the petition that accompanies the request for joinder—that is, a request for joinder under § 315(c) requires a new petition. A decision on joinder follows consideration of the new petition and any preliminary response, and follows a determination that the new petition, on its own merits, warrants institution of an *inter partes* review under § 314 of the statute.

Section 315(c) thus permits *any* person to file a petition for review by the Director, and gives the Director discretion to join the petition to an existing *inter partes* review if it is determined that the threshold of § 314 is met. The limitation of § 314 is that the information presented in the petition must show that there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition. 35 U.S.C. § 314(a). If the potential for adding new issues by way of joinder were not possible, there is no reason why the Director would need to determine whether *inter partes* review under § 314 is warranted based on the petition and any preliminary response that may be filed.

The joinder provision does not limit the scope of issues that can be raised in the petition, and does not require the scope of issues raised to be identical to issues in the existing *inter partes* review.<sup>6</sup> Rather, § 315(c) permits the joinder of any issue related to a ground of unpatentability shown by any person to be reasonably likely to prevail with respect to at least 1 of the claims challenged. In other words, the statute provides the Director discretion to join the new petition of any party to an existing *inter partes*

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<sup>6</sup> If only identical petitions could be joined to an existing *inter partes* review, there would be no need for substantive review under § 314.

review, once it is determined that that the procedural limitation of § 314 is met, which is a finding that the petition is likely to prevail on its merits.

The concurrence cites to the majority opinion in *Target Corp. v. Destination Maternity Corp.*, Case IPR2014-00508 (PTAB Sept. 25, 2014) (Paper 18), and the reasons expressed therein, as the basis for denying Medtronic's motion for joinder. In reaching the decision to deny joinder, the majority in *Target* concluded that 35 U.S.C. § 315(c) does not permit issue joinder, rather it refers to joining a party and a party cannot be joined to a proceeding to which it is already a party. *Target*, Paper 18 at 3–5. We note that *Target* is not a precedential decision. We also note that views differing from those in *Target* were stated in other Board decisions. *See, e.g., Ariosa Diagnostics v. Isis Innovation Ltd.*, Case IPR2012-00022 (PTAB Sept. 2, 2014) (Paper 166).

In reaching this conclusion, the majority in *Target* found that the use of the word “any” did not render the statute ambiguous, and concluded that the language in § 315(c) excludes from “any person” at least two persons from among those who may be joined to a proceeding. Specifically, the phrase “who properly files a petition under section 311” excludes the patent owner, and “as a party,” excludes persons who are already a party. *Target*, Paper 18 at 5. n.2. The phrase “as a party,” however, does not render the joinder provision of § 315(c) unambiguous. The only person excluded unambiguously from the scope of “any person” under § 315(c) is the patent owner, via reference to § 311. Otherwise, § 315(c) simply is labeled

“Joinder”<sup>7</sup>—as opposed to “Joinder of parties” as in 35 U.S.C. § 299—and, while the phrase “join as a party” is used, § 315(c) also contains language that suggests that the decision on whether to join is made after consideration of issues presented in a petition.

The concurring opinion would have us render a decision on the request for joinder prior to considering the merits of the petition, which is contrary to the language of § 315(c). Section 315(c), via reference to § 314, only includes language referring to challenges of patent claims and makes no reference to other procedural requirements discussed in *Target*.<sup>8</sup> In any case, the statute does not clearly guide us away from considering challenges to the claims of the patent. On the contrary, § 315(c) asks the Director to consider whether the petition contains information showing that the petitioner would prevail with respect to at least one claim, and gives the Director discretion to join the party if there is merit to the information presented in the petition.

The majority in *Target* further reasoned that the one-year time bar under § 315(b) does not apply “to a request for joinder,” such that a time-barred petitioner may be permitted to join an existing *inter partes* review, but may not successfully petition for *inter partes* review. *Target*, Paper 18 at 10. In reaching this conclusion, the *Target* majority reads the request for joinder as a separate filing, one that does not require a petition. Again,

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<sup>7</sup> 35 U.S.C. § 315 uses the heading “Relation to other proceedings or actions” and subsection § 315(c) is labeled “Joinder.”

<sup>8</sup> The majority in *Target* noted that the filing of a petition by a prospective party serves many purposes other than setting forth the challenges to claims in a patent, purposes such as meeting the requirements of identifying real parties-in-interest, related matters, lead and backup counsel, and service information. *Target*, Paper 18 at 5–6.

however, the joinder statute itself makes reference to both the petition and preliminary response, indicating that the merits of the petition that accompanies the request for joinder are to be considered—that is, a motion for joinder must include a petition satisfying the threshold of § 314 before a party successfully may be joined. The request for joinder cannot be treated as a separate filing because a properly filed request for joinder must be accompanied by a petition that meets the standard of § 314. Section 315(c) gives discretion as to whether to join a person who properly files a petition, and it is the Director’s discretion that guards against patent owner harassment and/or over-burdening Office resources.

The concurrence also reasons that, in contrast to joinder under § 315(c), § 315(d) relates to the consolidation of issues. A review of the legislative history of the America Invents Act<sup>9</sup> (“AIA”), however, does not clearly lead one to conclude that Congress used “joinder” narrowly to refer solely to party joinder. Rather, throughout the Senate Debates “joinder” is used in the context of issue joinder. *See e.g.*, 157 Cong. Rec. S 1376 (daily ed. Mar. 8, 2011) (statement of Sen. Kyl) (“If a party seeking joinder also presents additional challenges to validity that satisfy the threshold for instituting a proceeding, the Office will either join that party and its new arguments to the existing proceeding, or institute a second proceeding for the patent.”); 157 Cong. Rec. S 9988 (daily ed. Sept. 27, 2008) (statement of Sen. Kyl) (“[A]dditional petitions can be joined only if, among other things, they are properly filed.”); *id.* (“[A] procedurally proper successive petition

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<sup>9</sup> Leahy-Smith America Invents Act, Pub. L. No. 112-29, 125 Stat. 284 (2011).

for second-period review may be joined to a pending proceeding at the discretion of the Director, even if the 329(b)(2) deadline has not been met, so long as the Director determines that the petition satisfies the threshold set in section 327(c).”) “Consolidation,” as used in § 315(d), on the other hand, is used to refer to the consolidation of different proceeding before the Office. *See* 157 Cong. Rec. S 9988 (daily ed. Sept. 27, 2008) (statement of Sen. Kyl) (“Section 325(c) gives the PTO broad discretion to consolidate, stay, or terminate any PTO proceeding involving a patent if that patent is the subject of a postgrant review proceeding. It is anticipated, for example, that if a second-period proceeding is instituted and reexam is sought, the Director would be inclined to stay the postgrant review during exhaustion of the reexam. On the other hand, if a postgrant review is near completion, the Director may consolidate or terminate any other PTO proceeding that is initiated with regard to that patent.”) Thus, the legislative history does not unambiguously support a conclusion that Congress clearly intended to address joinder of parties under § 315(c) and consolidation of issues under § 315(d).

### III. CONCLUSION

We deny the Joinder Motion and, therefore, deny the Second Petition because it was not filed within the time limits imposed under 35 U.S.C. § 315(b).

### IV. ORDER

Accordingly, it is

ORDERED that Petitioner’s request for joinder is *denied*.

FURTHER ORDERED that the Petition for *inter partes* review of claims 20–24 of the ’228 patent is *denied*.

IPR2014-00823  
Patent 6,482,228 B1

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Before SHERIDAN K. SNEDDEN, BARRY L. GROSSMAN, and  
MITCHELL G. WEATHERLY, *Administrative Patent Judges*.

WEATHERLY, *Administrative Patent Judge*, concurring.

I concur with the majority in the results that the Joinder Motion and the Petition are denied, but I would reach those results for different reasons.

I. THE JOINDER MOTION

I would deny the Joinder Motion based on the interpretation of 35 U.S.C. § 315(c) as set forth in the majority opinion in *Target Corp. v. Destination Maternity Corp.*, Case IPR2014-00508 (PTAB Sept. 25, 2014) (Paper 18) (“the *Target Decision*”). Medtronic moves “for Joinder of the Second Petition for *Inter Partes* Review of U.S. Patent No. 6,482,228 . . . , with the instituted *inter partes* review, *Medtronic, Inc., et al. v. Troy R.*

*Norred*, Case No. IPR2014-00111, pursuant to 35 U.S.C. § 315(c) and 37 C.F.R § 42.122.” Mot. for Joinder 2. Thus, Medtronic seeks to consolidate issues presented in the Petition with issues on which we have instituted review in the ’111 IPR. Under the interpretation of § 315(c) expressed in the *Target* Decision, a party in an existing *inter partes* review may not be “joined” to that review, and additional issues presented in a new petition may not be “joined” to an existing *inter partes* review. For both reasons, I would deny Medtronic’s Joinder Motion.

I also conclude that § 315(d) further supports the interpretation of § 315(c) that is set forth in the *Target* Decision. I consider the text of § 315(d) informative in interpreting § 315(c) because, “[i]n expounding a statute, we must not be guided by a single sentence or member of a sentence, but look to the provisions of the whole law, and to its object and policy.” *Kelly v. Robinson*, 479 U.S. 36, 43 (1986) (quoting *Offshore Logistics, Inc. v. Tallentire*, 477 U.S. 207, 222 (1986)).

To the extent that Medtronic seeks to present new issues in the Petition and consolidate those issues with those already present in the ’111 IPR, Medtronic seeks relief under the wrong provision of § 315. Congress granted authority to the Director to consolidate issues in one *inter partes* review with issues in another *inter partes* review as follows in § 315(d), which states in pertinent part:

(d) Multiple Proceedings.— . . . during the pendency of an *inter partes* review, if another proceeding or matter involving the patent is before the Office, the Director may determine the manner in which the *inter partes* review or other proceeding or matter may proceed, including providing for . . . consolidation . . . of any such matter or proceeding.”

35 U.S.C. § 315(d). The presence of § 315(d) further supports my conclusion that Congress intended to distinguish joinder of persons under § 315(c) from consolidation of issues under § 315(d). In the Joinder Motion, Medtronic seeks the relief that is potentially available under § 315(d) but moves for that relief pursuant to § 315(c). I believe that the Board is not authorized to grant the relief requested by Medtronic under § 315(c). For these reasons alone, I concur in the result reached by the majority in denying the Joinder Motion.

## II. THE PETITION

I would deny the Petition solely based upon Medtronic having been served with a complaint alleging infringement of the '228 patent more than one year before filing the Petition.<sup>1</sup> Section 315(b) states in pertinent part:

An inter partes review may not be instituted if the petition requesting the proceeding is filed more than 1 year after the date on which the petitioner, . . . is served with a complaint alleging infringement of the patent. The time limitation set forth in the preceding sentence shall not apply to a request for joinder under subsection (c).

35 U.S.C. § 315(b). The one-year bar expressed in § 315(b) applies to all petitions filed more than one year after the petitioner is served with a complaint for infringement. The last sentence carves out an exception to the one-year bar that applies solely to a “request for joinder.” This exception does not apply to a petition that is filed concurrently with a request for joinder. Thus, I do not consider the decision on the Joinder Motion to be

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<sup>1</sup> I disagree with the majority to the extent that it concludes that the denial of the Joinder Motion is a condition precedent to the one-year bar in § 315(b) precluding institution of *inter partes* review.

IPR2014-00823  
Patent 6,482,228 B1

relevant to whether the one-year bar in § 315(b) precludes institution of the review requested in the Petition.

Medtronic acknowledges that it was served with a complaint alleging infringement of the '228 patent more than one year before it filed the Petition. Pet. 6. I would find that the one-year bar set forth in § 315(b) prevents the Board from instituting the *inter partes* review sought in the Petition. For these reasons alone, I concur in the result reached by the majority in denying institution of an *inter partes* review.

IPR2014-00823  
Patent 6,482,228 B1

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