

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MEDTRONIC, INC.,
Petitioner

v.

MARK A. BARRY,
Patent Owner.

Case IPR2014-01211
Patent 8,361,121 B2

Before DONNA M. PRAISS, BRIAN J. McNAMARA, and
JEREMY M. PLENZLER, *Administrative Patent Judges*.

McNAMARA, *Administrative Patent Judge*.

DECISION ON REQUEST FOR REHEARING
37C.F.R. § 42.71(d)

On March 6, 2015 Medtronic, Inc. (“Petitioner”) filed a Request for Rehearing (Paper 10, “Req. Reh’g.”) of our Decision Denying Institution (Paper 8, “Medtronic v. Barry II”). However, on February 20, 2015, Petitioner filed another Petition challenging the same claims of the same Patent, i.e. claims 1–4 of U.S. Patent 8,361,121 B2 (“the ’121 Patent”), as those challenged in the present proceeding. *Medtronic, Inc. v. Mark A. Barry*, Case IPR2015-00783 (Paper 2, “Second Pet.”). The Second Petition cites many of the same references cited by Petitioner in this proceeding. Upon consideration of the Second Petition, we denied institution of *inter partes* review of claims 1–4 of the ’121 Patent. *Medtronic, Inc. v. Mark A. Barry*, Case IPR2015-00782, slip op. (PTAB Sept. 9, 2015) (Paper 6, Decision Denying Institution) (“Medtronic v. Barry V”).

In the current proceeding, we determined that Petitioner had not established a reasonable likelihood of success that it would prevail on its challenge based on the Video, the Slides, the ’328 Appl., the ’349 appl. and the ’291 Patent or on its challenges based on the combination of the Video, the Slides, MTOS, ’928 Appl., the ’349 Patent, and the ’291 Patent. *Medtronic v. Barry II* 13–21. For each challenge, we determined that the arguments presented by Petitioner did not establish that the combination of references discloses the claimed handle means. *Id.*

In *Medtronic v. Barry V*, we determined that, although Petitioner’s arguments in the petition filed in IPR2015-00782 could support disclosure of the claimed handle means, Petitioner did not present a reasoned articulation to support the obviousness of the claimed cross linking member based on the combination with the ’349 Patent. *Medtronic v. Barry V*, 16–18. The Petition in this proceeding cites the ’349 Patent as supporting the claimed

cross linking member in each challenge. Pet. 32, 54. Thus, based on reconsideration of the issues presented by the combination of the references in *Medtronic v. Barry V*, we arrive at the same conclusion and deny institution of *inter partes* review.

In view of our decision to deny institution of *inter partes* review in *Medtronic v. Barry V* and the overlapping references and issues between this proceeding and IPR2015-00782, we deny Petitioner's Request for Rehearing in this proceeding.

For the reasons discussed above, the Request for Rehearing is DENIED.

Case IPR2014-01211
Patent 8,361,121 B2

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