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On behalf of **Imperative Care, Inc.**

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

IMPERATIVE CARE, INC.,
Petitioner,

v.

INARI MEDICAL, INC.,
Patent Owner.

Case IPR2024-01257
Patent No. 11,744,691

**PETITIONER'S AUTHORIZED REPLY TO
PATENT OWNER'S PRELIMINARY RESPONSE**

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I. THE BOARD SHOULD NOT DENY INSTITUTION UNDER § 325(d)

The Board should not discretionarily deny institution under § 325(d) because (1) PO has not shown that the Office considered the arguments raised in the IPR and (2) even if the Board did consider the arguments, Petitioner has demonstrated that the Office erred in a manner material to the patentability of the challenged claims.

PO incorrectly argues that the Examiner determined Garrison does not render limitations in the challenged claims unpatentable during prosecution of the '691 patent's great grandparent application ("'315 Application", Ex. 2002). POPR, 2, 30, 37-42. In the '315 Application, the Examiner found certain claims unpatentable over Hogendijk in view of **Garrison '788** (Ex. 2003). Garrison '788 is not related to Garrison and includes significantly less disclosure – Garrison includes 174 paragraphs and 57 figures, while Garrison '788 includes 140 paragraphs and 39 figures. *Compare* Ex. 1006 *with* Ex. 2003. PO concedes that Petitioner relies upon disclosure in Garrison not found in Garrison '788 to show, for example, that Garrison discloses rapid aspiration. POPR, 35 (citing Pet., 36 (citing Ex. 1006, [0129])). PO incorrectly dismisses this disclosure as cumulative of other disclosures in Garrison. *Id.* PO ignores that the cited portion is the only disclosure in Garrison describing test results of rapid aspiration and referring to Figures 56-57 (not found in Garrison '788). *Id.* Further, Petitioner cited other paragraphs in Garrison to support its IPR not found in Garrison '788, including paragraphs 48, 51,

53, 62-63, 65, 70, 98, and 111. Pet., 31-33, 40-41, 45-46, 48, 54, 57-58, 62-63, 65.

Additionally, during prosecution of the '315 Application, the Examiner did not rely on Garrison '788 for most of the claim limitations in dispute at the time of the Office Action. Instead, the Examiner relied on Hogendijk as the primary reference but found that "Hogendijk does not explicitly teach a valve between the second chamber and the aspiration catheter and opening of the valve with negative pressure." Ex. 2002, 126. The Examiner relied on Garrison as a secondary reference to disclose a valve that opens with negative pressure and never addressed whether Garrison met any other claim limitations. *Id.* Moreover, the valve cited by the Examiner **is not** the valve relied upon by Petitioner in this IPR. The Examiner cited "check valve (3419)" in Garrison '788's Figure 15 (like Garrison's Figure 32) as disclosing a valve the opens with negative pressure, while Petitioner relies on stopcock valve 3325 in Garrison's Figure 34 as disclosing the "user-actuatable valve" recited in the challenged claims. Ex. 2002, 126; Ex. 2003, Fig. 15; Ex. 1006, Fig. 34. The Examiner of the '315 Application never mentioned Figure 34 (or its equivalent in Garrison '788) or valve 3325, which is the focus of this IPR. Further, PO's sole basis for distinguishing Garrison now is that Garrison's Figures 32-34 are allegedly restricted to a "peristaltic pump." However, Garrison includes no such restriction and PO has failed to show that the Examiner ever addressed this dispute.

PO subsequently amended the claims to make clear that the claimed valve is

not opened with negative pressure and to more clearly describe the invention. Ex. 2002, 102, 112. PO argued that Hogendijk did not teach the amended claims but did not substantively address whether Garrison '788 met the limitations, instead merely stating, "Garrison fails to cure the deficiencies of Hogendijk." *Id.*, 108. In a later office action, the Examiner rejected the amended claims over additional prior art and found the Hogendijk-Garrison grounds "are moot." *Id.*, 71. Thus, contrary to PO's argument, the Examiner did **not** make any determinations about whether Garrison '788 disclosed other claim limitations. POPR, 2. Moreover, prosecution of the '315 Application continued, and PO added substantial new limitations to obtain allowance. Ex. 2002, 49-56. Thus, the Examiner **never** found the claims in the '315 Application that PO argues are like the challenged claims patentable.

PO also argues that the Examiner already considered Aklog's equivalent during examination of the '691 Patent. POPR, 30-31. However, the Examiner considered Aklog's parent, U.S. Pat. 8,075,510 (Ex. 1019), not Aklog. Aklog is a **continuation-in-part** of its parent and includes additional disclosure, including the claims. Ex. 1005, title page. While Petitioner did not cite this additional disclosure in the Petition, PO has made arguments in its POPR that make it relevant now. For example, PO argues that a POSITA would have understood Garrison to disclose only a "peristaltic pump" in Figures 32-34. Yet, Garrison merely states that the devices may include a "pump" and does not limit the invention to peristaltic pumps. Ex.

1006, [0134]. Aklog confirms that a POSITA would have broadly understood the term “pump,” including in its claims. *See e.g.*, Ex. 1005, 12:9-14, 21:32-37, 22:33-37, 24:8-13. Therefore, while Aklog overlaps with its parent, the additional disclosure in Aklog is relevant to PO’s arguments in this IPR. Further, as noted in the Petition, the examiner of the ’691 patent never applied Aklog. *Comcast Cable Commc’ns LLC v. Promptu Sys. Corp.*, IPR2018-00342, Paper 13 at 18-19 (PTAB July 19, 2018) (declining to deny institution under §325(d) because prior art was not applied); *K/S HIMPP v. Bragi GmbH*, IPR2023-01204, Paper 8 at 15-16 (Mar. 19, 2024) (similar); *Sonos, Inc. v. Google LLC*, IPR2023-00118, Paper 9 at 29 (May 19, 2023) (failure to substantively evaluate reference weighs against *Becton* factor (c)).

Further, even if the Examiner considered the same art and arguments raised in this IPR, Petitioner has demonstrated that the Examiner erred in a manner material to the patentability of the challenged claims. *Advanced Bionics, LLC v. MED-EL Elektromedizinische Gerate GmbH*, IPR2019-01469, Paper 6 at 8 (PTAB Feb. 13, 2020) (precedential). The Examiner of the ’691 Patent allowed the claims because the prior art allegedly did not disclose a “coupled assembly including: the second chamber; the aspiration catheter; and a hemostasis valve.” Pet., 19 (citing Ex. 1002, 51-52). Yet, as shown in the Petition, Garrison discloses such a “coupled assembly” and anticipates the claims. *Id.*, 30-33. Thus, the Examiner made a material error by overlooking the specific teachings of Garrison and Garrison in combination with the

other cited references. *Advanced Bionics*, Paper 6 at 8. For at least these reasons, the Board should not discretionarily deny institution under § 325(d).

II. THE BOARD SHOULD NOT DENY INSTITUTION UNDER § 314(a)

The Director has explained, “the PTAB will not discretionarily deny institution of an IPR or PGR in view of parallel district court litigation where a petitioner stipulates not to pursue in a parallel district court proceeding the same grounds as in the petition or any grounds that could have reasonably been raised in the petition.” *Interim Procedure for Discretionary Denials in AIA Post-Grant Proceedings with Parallel District Court Litigation* at 7 (June 21, 2022). Although the case is in its early stages, Petitioner offers the following stipulation to avoid multiple proceedings addressing the validity of the challenged claims:

Petitioner hereby stipulates that if the Board institutes this IPR based on the grounds and claims raised in the Petition, Petitioner will not pursue in district court the grounds asserted in the IPR Petition or any other ground that could have been reasonably raised in this IPR.

Sotera Wireless, Inc. v. Masimo Corp., IPR2020-01019, Paper 12 at 13-14 (PTAB Dec. 1, 2020) (precedential). Thus, the Board should not grant discretionary denial of institution under § 314(a) based on the parallel district court litigation.

III. CONCLUSION

For the foregoing reasons, Petitioner requests that the Board institute the IPR to assess the patentability of the challenged claims.

Dated: December 16, 2024

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that on the date below copies of
**PETITIONER'S AUTHORIZED REPLY TO PATENT OWNER'S
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