

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

IMPERATIVE CARE, INC.,
Petitioner,

v.

INARI MEDICAL, INC.,
Patent Owner.

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

PATENT OWNER'S SUR-REPLY TO PETITIONER'S REPLY

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CASES

Advanced Bionics, LLC v. MED-EL Elektromedizinische Geräte GmbH,
 IPR2019-01469, Paper 6, pp.10-11 (P.T.A.B. Feb. 13, 2020) 4

Dropworks, Inc. v. The University of Chicago,
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STATUTES

35 U.S.C. § 325(d) 1, 3

I. THE BOARD SHOULD DENY INSTITUTION UNDER § 325(d)

Every reference relied on in the Petition or a cumulative reference was before the Office during prosecution of the '691 Patent. And in addition to Petitioner's primary reference Garrison being before the Office, the Office expressly considered the same disclosure as Garrison found in another Garrison reference, Garrison '788, during prosecution of a parent application with overlapping key claim limitations at issue here. Petitioner's quibbles with how Garrison '788 was applied during prosecution of the Parent '315 Application are not relevant. There can be no dispute that the Examiner was aware of Garrison's disclosure and substantively applied it during prosecution of claims with limitations similar to the claims of the '691 Patent. *See* Patent Owner Preliminary Response ("POPR"), pp. 37-41. That Petitioner disagrees with the Office's prior consideration of Garrison's disclosure is not sufficient to demonstrate a material error. Accordingly, Patent Owner requests that the Board defer to previous Office evaluation of the evidence of record and deny institution.

In its Reply, Petitioner does not dispute that every reference or its equivalent for every ground in the Petition was before the Office during prosecution of the '691 Patent. Grounds 1-8 rely upon four references. The first three, Garrison, Hartley, and Goff, each appear on the face of the '691 patent. *See* EX1002, p.323 (citing Garrison), p.364 (citing Goff), & p.360 (citing Hartley) for IDS submissions. And

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Petitioner admits that the fourth reference Aklog's parent was before the Office and includes all the disclosure cited to and relied on in the Petition. Reply, p.3 ("Petitioner did not cite this additional disclosure in the Petition....").

Petitioner's assertion in reply that portions of Aklog not cited or relied on in the Petition should prevent denial under 325(d) is wrong and irrelevant. First, Petitioner's new citations to Aklog provided for the first time in the Reply are in fact also found in Aklog's parent. Specifically, Petitioner cites to Aklog at 12:9-14, 21:32-37, 22:33-37, and 24:8-13 for allegedly disclosing how a POSITA would have understood the term "pump." Reply, p.4. But the disclosure in 12:9-14 of Aklog is identically found in Aklog's parent. EX1019, 12:2-7. The remainder of Petitioner's cites to Aklog identify three nearly identical limitations in different independent claims of Aklog pertaining to a pump, *e.g.*: "providing a pump capable of simultaneously creating a suction force and a driving force ... so as to capture any vegetative growth that has become dislodged." EX1005, 21:32-37. Such a pump was identically disclosed in Aklog's parent and, as such, provides no additional disclosure regarding how a POSITA would have understood the term "pump." EX2001, ¶¶99-101, POPR, p.31.

In addition to all of Petitioner's cited art being before the Office, the Office further expressly considered the same disclosure found in Petitioner's primary reference Garrison, which is Petitioner's sole reference in every ground for key

limitations recited in every independent claim. Specifically, the disclosure of Garrison relied on in the Petition was substantively considered by the Office during prosecution of the Parent '315 Application. POPR, pp. 36-41. Petitioner's assertion in its Reply that Garrison '788 includes fewer paragraphs and figures (Paper 8, p.1) than Garrison ignores that the Garrison '788 is cumulative to the disclosure of Garrison cited by the Petition. EX2001, ¶¶95-98; POPR, pp.31-36. Section 325(d) "does not require that the teachings be identical or entirely cumulative...." *Dropworks, Inc. v. The University of Chicago*, IPR2021-00100, Paper 9 at 13-14 (P.T.A.B. May 14, 2021).

And while paragraph [0129] of Garrison is not found verbatim in Garrison '788 (POPR, p.35), the Petition admits that this paragraph is cumulative to other portions of Garrison that are found in Garrison '788. The Petition only cites paragraph [0129] two times. The first cite is a "*see also*" for the disclosure of "aspiration with an accelerated response" in the preamble of Claim 1 after Petitioner extensively cites to Figure 34 and ¶¶[0131]-[0134] of Garrison, which are identically found in Garrison '788. Petition, p.26. Similarly, the second cite comes after citation to Figure 34 and paragraph [0134] of Garrison (identically found in Garrison '788), and the Petition concludes that "[t]hus, Garrison includes multiple disclosures of closing a valve to generate negative pressure and opening the valve after the negative pressure is generated"). *Id.* at p.36. That is, the Petition recites that the disclosure in

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paragraph [0129] is one of multiple cumulative disclosures (the others of which are found in Garrison '788). Indeed, paragraph [0129] of Garrison discloses testing flow rates of systems with different catheter sizes using the methodology described in paragraph [0134] of Garrison, which is found verbatim in Garrison '788 at paragraph [0088]. POPR, pp.35-36; EX2001, ¶97. As such, Petitioner's purportedly new paragraph [0129] does not recite any component, structure, or function not found in Garrison's paragraph [0134], which also disclosed in Garrison '788. POPR, p.36; EX2001, ¶97.

Moreover, Petitioner's contention that it cited other paragraphs from Garrison purportedly not found in Garrison '788 (Reply, pp.1-2 (citing ¶¶ "48, 51, 53, 62-63, 65, 70, 98, and 111")) is both wrong and irrelevant. First, Garrison's paragraphs [0051], [0053], [0062], and [0098] are substantially disclosed in Garrison '788. EX2001, ¶98. Second, Petitioner's citations to other paragraphs [0048], [0063], [0065], [0070], and [0111] are limited to Petitioner's arguments for dependent claims. Petition, pp. 40-41, 45-46, 48, 54, 57-58, 62-63, & 65. Put simply, Garrison itself was before the Office and the portions of Garrison relied upon by Petitioner for key limitations of the independent claims were expressly considered by the Office as disclosed in Garrison '788.

Petitioner has further failed to make a showing that the Office made a material error in allowing the '691 Patent claims over Garrison and the other references relied

Patent Owner's Sur-Reply to Petitioner's Reply on in the Petition. *Advanced Bionics, LLC v. MED-EL Elektromedizinische Geräte GmbH*, IPR2019-01469, Paper 6, pp.10-11 (P.T.A.B. Feb. 13, 2020) ("If reasonable minds can disagree regarding the purported treatment of the art or arguments, it cannot be said that the Office erred in a manner material to patentability ... this framework reflects a commitment to defer to previous Office evaluations of the evidence of record unless material error is shown."). Petitioner's allegation of error is that the Examiner allowed the claims "by overlooking the specific teachings of Garrison." Reply, p.4. Petitioner's generic disagreement with the Office's findings is insufficient because the same Examiner 1) substantively evaluated Garrison's disclosure in the Parent '315 Application, and 2) all of the references cited in the Petition (or their equivalent), including Garrison, were before the Office during prosecution of the '691 Patent.

II. CONCLUSION

For the above reasons, Patent Owner respectfully requests that the Board deny institution.

Respectfully submitted,

Dated: December 23, 2024

By: / Joseph P. Hamilton /
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CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.6(e), I certify that on December 23, 2024, a copy of **PATENT OWNER'S SUR-REPLY TO PETITIONER'S REPLY** was served upon the below-listed counsel by electronic mail:

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