

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ABBOTT LABORATORIES,
Petitioner,

v.

MIRACOR MEDICAL SA,
Patent Owner.

IPR2025-00096 (Patent 11,351,356 B2)
IPR2025-00113 (Patent 11,376,415 B2)
IPR2025-00114 (Patent 11,572,879 B2)
IPR2025-00115 (Patent 11,674,517 B2)
IPR2025-00116 (Patent 11,754,077 B1)

Before ANNETTE R. REIMERS, JAMES A. TARTAL, and
JOHN D. HAMANN, *Administrative Patent Judges*.

TARTAL, *Administrative Patent Judge*.

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

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Abbott Laboratories (“Petitioner”) requests leave to file replies to the Preliminary Responses of Miracor Medical SA (“Patent Owner”) in each of these proceedings.¹ *See* Ex. 3001, 1. Petitioner seeks to address three issues, which Petitioner identifies as follows: (1) “a claim construction argument in Patent Owner’s Preliminary Response that contradicts infringement positions that Patent Owner has taken in related district court litigation;” (2) “Patent Owner’s argument that the Petition used improper formatting that contradicts its own use and more recent Board precedent;” and (3) the status of “a partial stay of the related litigation at the district court.” *Id.* Patent Owner opposes Petitioner’s request. *Id.*

A teleconference with the Parties was conducted on March 25, 2025, to provide Petitioner an opportunity to show good cause for the requested reply and for Patent Owner to explain its opposition. For the following reasons, Petitioner’s request is denied. Petitioner is, however, authorized to file as an exhibit in each of these proceedings a copy of an order entered by the district court in the related district court litigation concerning the status of a stay of the district court proceeding.

With regard to the claim construction issue, Petitioner explained during the teleconference that in the Petition it applied a construction of the claim term “axially adjacent,” at issue in each of these proceedings,

¹ We provide citations to papers and exhibits filed in IPR2025-00096 as representative of the filings entered in each of the proceedings at issue. Petitioner made a similar request in IPR2025-00112, which we will address in a separate order to be entered in that proceeding.

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purportedly based on assertions made by Patent Owner in the district court litigation. *See, e.g.*, IPR2025-00096, Paper 1 (“Petition”), 27. We note Petitioner contends more broadly in the Petition that Patent Owner’s “apparent” constructions in the district court litigation “differ from the plain and ordinary meaning” of the claim terms and that, because a person of ordinary skill “would find the Challenged Claims unpatentable under any interpretation, the Board need not construe the claim terms.” *Id.* at 7. We also note that in its Preliminary Response, Patent Owner states that “axially adjacent . . . would plainly mean that the two components are positioned adjacent to one another as measured along the previously recited central axis about which the magnetically driven rotor can rotate.” IPR2025-00096, Paper 10 (PO Prelim. Resp.), 18.

During the teleconference, Petitioner argued that a reply to the Preliminary Response is warranted because Patent Owner advanced a different claim construction for “axially adjacent” in these proceedings than it asserted in district court, that Petitioner could not have foreseen such a change prior to filing its Petition, and that it should be provided an opportunity to address how the construction relied upon by Patent Owner in its Preliminary Response contradicts infringement contentions made by Patent Owner in the district court proceeding.

On the teleconference, Patent Owner disagreed that it advanced different or inconsistent positions on the meaning of “axially adjacent” in these proceedings as compared to the district court matter. Patent Owner maintained that in its Preliminary Response it addressed Petitioner’s

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arguments and explained why they were deficient. Patent Owner argued that providing Petitioner an opportunity to reply at this stage of the proceeding, having had the benefit of reviewing Patent Owner's Preliminary Response arguments, is not warranted.

We find that the Parties have had an adequate opportunity to address the meaning of "axially adjacent," which neither Party suggests is a particularly complicated term of art, for purposes of determining whether to institute *inter partes* review. We find Petitioner's assertion that it could not have anticipated Patent Owner adopting a contradictory construction of a claim term in these proceedings from allegations made in district court implausible as a basis for good cause for additional briefing. It is Petitioner's obligation in the first instance to explain in the Petition "[h]ow the challenged claim is to be construed." 37 C.F.R. § 42.104 (a)(3). This is made clear in the Patent Trial and Appeal Board Consolidated Trial Practice Guide (84 Fed. Reg. 64,280 (Nov. 21, 2019)) ("CTPG").² The CTPG explains as follows:

The Board will determine the claim construction based on the record of the proceeding at issue. Thus, as in a district court proceeding, the parties should point out the specific portions of the specification, prosecution history, and relevant extrinsic evidence they want considered, and explain the relevancy of any such evidence to the arguments they advance. Each party bears the burden of providing sufficient support for any construction advanced by that party.

² Available at <https://www.uspto.gov/TrialPracticeGuideConsolidated>.

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CTPG, 46. Petitioner cannot assume Patent Owner will make the same arguments in these proceedings as in district court for purposes of showing in the Petition how a claim is to be construed—parties commonly take different positions.

Moreover, while we take into consideration whether a party has made contradictory allegations in another forum, our task at this stage is to determine whether Petitioner has made the necessary showing to support institution, including whether any proposed construction is warranted based on the current record. *Id.*; *see also id.* at 48 (stating that “[t]he Board, in its claim construction determinations, will consider statements regarding claim construction made by patent owners and by a petitioner filed in other proceedings, if the statements are timely made of record”). We have before us Petitioner’s claim construction contentions, allegedly supported by a citation to an exhibit to a complaint filed by Patent Owner in district court, along with Patent Owner’s arguments in opposition in its Preliminary Response. *See* Pet. 26 (citing Ex. 1019, 5–7). We will consider these contentions as part of our claim construction analysis.

Because Petitioner fails to show good cause for additional briefing, and because we find the additional briefing requested would be unhelpful in resolving whether *inter partes* review should be instituted based on the Petition, we deny Petitioner’s request to further address the meaning of “axially adjacent” in a reply to Patent Owner’s Preliminary Response.

With regard to the formatting issue, Petitioner identified during the teleconference a nonprecedential Board decision (*NVIDIA Corp. v.*

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Advanced Cluster Systems, Inc., IPR2021-00075, Paper 9 (PTAB May 5, 2021)) that it contends supports the formatting Petitioner applied in the Petition. Petitioner also referred to unspecified formatting procedures allegedly permitted by the U.S. Court of Appeals for the Fourth Circuit as further support. In opposition, Patent Owner argued that the formatting issues it identified are excessive and also acknowledged that it did not seek relief from the Board for the alleged improper formatting prior to filing its Preliminary Response. We find the Parties have sufficiently presented their positions on the issue and that Petitioner did not show good cause for a reply to the Preliminary Response on this formatting issue.

Finally, with regard to the status of a stay in the district court proceeding, Petitioner acknowledged that Patent Owner has not advanced arguments in support of discretionary denial of institution, where the status of a district court stay may be at issue, but instead suggested that it would be more generally of benefit to the Board to be made aware of the status of district court proceedings. Patent Owner did not oppose the filing of a district court order addressing the status of a stay as an exhibit by Petitioner, but maintained that it did not warrant a reply brief. We agree a reply brief is not warranted to address any stay in district court under the circumstances presented here. We further grant leave to Petitioner to file as an exhibit in each proceeding a copy of a district court order addressing the stay of proceedings in district court as an update informing the Board of the status of a related proceeding.

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Accordingly, it is:

ORDERED that Petitioner's request for leave to file a reply in each proceeding to Patent Owner's Preliminary Response is denied for lack of good cause; and

FURTHER ORDERED that Petitioner is granted leave to file as an exhibit in each proceeding a copy of an order entered in the related district court proceeding concerning the status of any stay in district court.

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