

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ABBOTT LABORATORIES,

Petitioner,

v.

MIRACOR MEDICAL SA,

Patent Owner.

IPR2025-00115
Patent 11,674,517

**PATENT OWNER MIRACOR MEDICAL SA'S REQUEST FOR
DIRECTOR REVIEW OF INSTITUTION DECISION**

Pursuant to 37 C.F.R. § 42.75, Patent Owner Miracor Medical SA (“PO”) seeks Director Review of the Board’s Decision Granting Institution (Paper 13, “Dec.”), which rejected PO’s request for discretionary denial made in its Preliminary Response (Paper 8, “POPR”).¹ The Petition here (Paper 1, “Pet.”) lacks particularity, violates claim construction rules, and abuses the word count regulations in several ways. In addition, the *Fintiv* factors and the exceptionally weak merits of the Petition each favor discretionary denial. This *inter partes* review is not an appropriate use of Office resources and should be denied.

I. Discretionary Denial Should Apply Here Because the Petition Failed to Identify Supporting Evidence with Particularity

“[A] petitioner must make its case-in-chief in the petition,” and the petition must “identify ‘with particularity’ the ‘evidence that supports the ground for the challenge to each claim.’” *PeakLogic, Inc. v. Wave Neuroscience, Inc.*, IPR2022-01527, Paper 13 at 4–5 (May 18, 2023) (quoting 35 U.S.C. § 312(a)(3)). For instance, the petition must identify “the particular features of each reference in the modified device of [the] asserted ground.” *IronRidge, Inc. v. Pregasus Solar, Inc.*, PGR2022-00024, Paper 9 at 40 (Aug. 10, 2022) (citing *ActiveVideo Networks, Inc.*

¹ The POPR was filed before issuance of the *Memorandum on Interim Processes for PTAB Workload Management* (Mar. 26, 2025).

v. Verizon Commc'ns, Inc., 694 F.3d 1312, 1327 (Fed. Cir. 2012)). In view of a substantial failure to meet the particularity requirement, the Board should exercise its discretion to deny the petition. *Adaptics Ltd. v. Perfect Co.*, IPR2018-01596, Paper 20 at 24. (Mar. 6, 2019) (informative).

In this case, PO provided several independent bases on which the Petition lacked particularity and explained how PO was prejudiced in not being able to fully respond to Petitioner's allegations. POPR at 8–16. The Board dismissed PO's arguments in a footnote. Dec. at 13, n. 8. Director Review is appropriate because PO's bases clearly do meet the standard for discretionary denial.

For one, Grounds 1–4 are not sufficiently particular because, instead of explaining how the references in each ground allegedly disclose *each limitation of each challenged claim*, Petitioner only presents such information for **less than half** of the challenged claims (specifically, independent claim 1, dependent claims 2–4, 10, 14, 15, and 17, and, in some grounds, elements [21A], [21D], and/or [21G] of independent claim 21). For most elements of independent claim 21 and all other challenged claims (including dependent claims 11, 22, 24, 26, 30, 28, 29, 32, 33, and 35), Petitioner merely cites to the Petition's analysis of other non-identical claim language and to summary paragraphs of the declaration of its expert (Peter Crosby, whose declaration, Exhibit 1003, is referred to herein as "Crosby") that do the same. *See* Pet. at 45–52, 78–81, 113–116, 142–144.

For example, in Ground 1, the entirety of the Petition’s analysis of claim element [21J] is “*See* [1L]. Ex.1003, ¶381.” *Id.* at 51. Meanwhile, paragraph 381 of Crosby says only: “[21J] is largely the same as the previously analyzed [1L], and therefore the following analysis is largely the same.”

Petitioner’s shortcut requires readers to identify differences between the two sets of claim limitations (those analyzed and those not) and to sort out for themselves how the references might apply to unanalyzed claim limitations. For example, while Petitioner correlates the elements of independent claim 21 to various elements of claims 1, 3, and 15 (*see, e.g.*, Pet. at 142–143), there are significant differences between claim elements [21A]–[21J] and claim elements [1A]–[1F], [1H]–[1M], [3A], [3B], and [15], as shown by the highlighting in Exhibit 2012 filed with the POPR. The Petition never explains how the references allegedly apply to the highlighted limitations of claim 21 in Exhibit 2012. PO should not have to guess at Petitioner’s allegations against independent claim 21 or dependent claims 11, 22, 24, 26, 30, 28, 29, 32, 33, and 35.

Further, Petitioner’s “practice of citing the Declaration to support conclusory statements that are not otherwise supported in the Petition . . . amounts to incorporation by reference” in violation of 37 C.F.R. § 42.6(a)(3). *Cisco Sys., Inc. v. C-Cation Techs., LLC*, IPR2014-00454, Paper 12 at 9–10 (Aug. 29, 2014) (informative) (declining to consider arguments from declaration not made in

petition). As noted above, for most elements of independent claim 21, as well as dependent claims 11, 22, 24, 26, 30, 28, 29, 32, 33, and 35, the Petition cites to a single paragraph from Crosby that introduces a discussion of the claim element by comparing it to another, previously discussed claim element. *See, e.g.*, Pet. at 51 (for element [21J] in Ground 1, citing only “Ex.1003, ¶381”). In Crosby, these cited introductory paragraphs are each followed by numerous paragraphs that address the claim element in detail *but are never cited or discussed in the Petition*. *See, e.g.*, Crosby, ¶¶ 382–390. Those portions of Crosby collectively span 256 pages. Crosby at pp. 160–230, 294–355, 431–492, 554–614. The Board has previously found reliance on substantially smaller amounts of declaration testimony, without sufficient explanation in the petition, to violate § 42.6(a)(3). *Cisco*, Paper 12 at 7–10 (involving tens of pages of declaration testimony).

In sum, the Petition has failed to meaningfully address more than half of the challenged claims in each of Grounds 1–4 or, at best, it has done so via prohibited incorporation by reference of Crosby’s declaration. Considering the Petition as a whole, the Director should exercise her discretion and deny institution based on Petitioner’s failure to comply with the particularity requirement of 35 U.S.C. § 312(a)(3). “[I]n the interests of efficient administration of the Office and integrity of the patent system and as a matter of procedural fairness to Patent Owner, the

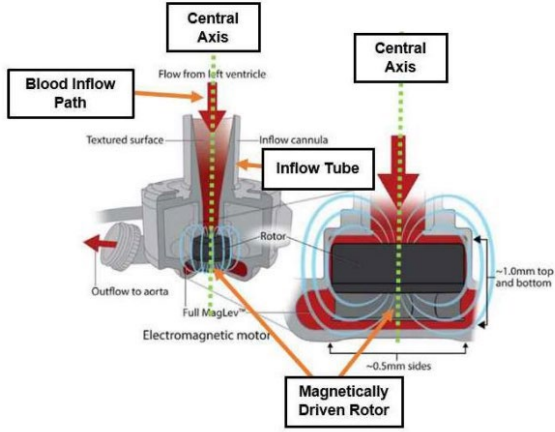
entire petition should be denied under 35 U.S.C. § 314(a).” *Adaptics*, Paper 20 at 24.

II. Discretionary Denial Should Apply Here Because the Petition Failed to Specify the Claim Constructions It Applied

Petitioner and Crosby repeatedly point to the complaint in the co-pending district court case and adopt correspondences alleged in a claim chart there (Ex. 1019) as “claim constructions.” This analysis, repeated for more than a dozen claim elements (*see* Exhibit 2011, filed with the POPR), ignores the plain and ordinary meaning of the claim terms and applies advocacy to twist their meaning in a way that benefits Petitioner’s arguments. *See* POPR at 5–8 (examples).

Office regulations mandate that petitions must identify “[h]ow [each] challenged claim is to be construed.” 37 C.F.R. § 42.104(b)(3). When a petition sets forth arguments or observations of what a claim term means, but does not provide an explicit construction for the claim term, “the [p]etitioner improperly attempts to shift the burden of construing the claim term . . . to the Board[,]” and institution should be denied. *ams AG v. 511 Innovations, Inc.*, No. IPR2016-01792, Paper 15 at 8, 13 (Mar. 16, 2017) (denying institution because, where “the parties disagree over whether the prior art discloses or suggests” a claim term, “Petitioner fails to meet its burden under 37 C.F.R. § 42.104(b)(3)” by not “providing a claim construction for the term”). The Petition should be denied for violating this rule.

For example, in discussing the Wampler reference, Mr. Crosby testifies:

Crosby, ¶ 160	Ex. 1019 at 6
I have been informed that in parallel litigation, the Patent Owner has asserted a theory of infringement that maps the impeller portion of the “rotor” of the “HeartMate 3” to the “magnetically driven rotor” element recited in Claim 1. Ex.1019, at pp. 5–6 (Complaint, Ex. 12). For the purposes of my analysis, I map the limitation of a “magnetically driven rotor” to the “impeller 74” of the embodiment of the rotor 17 described in Figure 11 of Wampler-169 in the same way.	

Mr. Crosby’s “construction” is not the plain and ordinary meaning—it is advocacy dressed up as an alleged admission that was never made. Petitioner and Crosby merely take an arrow that happens to be drawn from the bottom in a notice pleading out of context. In fact, PO has taken no position on the claim construction of “magnetically driven rotor” in the parallel litigation.

Petitioner and Crosby engage in this erroneous process for numerous claim elements (*see* Ex. 2011), rendering Petitioner’s analysis unreliable and ambiguous

as to what exactly it is that the prior art is alleged to meet. The Board's Decision never addressed this issue. The Director should grant PO's request for discretionary denial on this basis as well.

III. Discretionary Denial Should Apply Here Because the Petition Systematically Violated Word Count Requirements

The Petition's word-count certification indicates it is 42 words under the 14,000-word limit. *See* Pet. at 149. The Petition uses improper formatting, however, similar to what prompted a cautionary warning from the Board in *Axon Enterprise, Inc., v. Digital Ally, Inc.*, IPR2017-00375, Paper 9 at 2 n.2 (Jun. 6, 2017), as follows:

Petitioner, however, fails to use normal spacing in the Petition for numerous citations in order to reduce the word count. For example, Petitioner did not place spaces in many of its citations such as in “(Ex.1008, ¶22).” Pet. 3; *see also* The Blue Book, Twentieth Ed., Rule 3.3; *Pi-Net Int'l, Inc. v. JPMorgan Chase & Co.*, 600 F. App'x 774, 775 (Fed. Cir. 2015) (determining deletion of required spacing circumvents rule on word count). The Board expects the use of ordinary spacing in phrases and citations in submitted documents.

Like Axon's petition, the Petition here regularly omits a space when citing to exhibits (e.g., “Ex.1001” vs. “Ex. 1001”), the expert's declaration (e.g., “¶¶54–55” vs. “¶¶ 54–55”), statutes (e.g., “§102” vs. “§ 102”), and other sections of the document (e.g., “§VIII.A.1.i” vs. “§ VIII.A.1.i”). While such improper formatting

only undercounts one word with each occurrence, these citations occur so frequently that at least 1,087 words have been improperly undercounted:

Improper Formatting	Omitted Words
No space after “Ex.” (e.g., “Ex.1001” vs. “Ex. 1001”)	685
No space between ¶ symbol and numeral	374
No space between § symbol and numeral or letter (correct in Table of Authorities and Certificates of Compliance and Service)	28
TOTAL	1,087

With proper formatting, the Petition’s word count would be more than 1,000 words over the limit. The result is an advantage to Petitioner and undue prejudice to PO.

The Office cautions against “deleting spacing . . . in order to circumvent the rules on word count” and warns that such formatting “may lead to a party’s brief not being considered.” Consolidated Trial Practice Guide, Nov. 2019 Edition, at 40. Despite the severity of the warning, patent owners are often reluctant to point out such abuses in petitions for fear of being perceived as putting form over substance. The outcome is either a system tilted against patent owners or an “if-you-can’t-beat-them-join-them” environment that degrades the process for all.

As explained in Section I above, the Petition also attempts a massive circumvention of the word limit by omitting an analysis for more than half of the

challenged claims. In each of Grounds 1–4, Petitioner addresses claims 11, 21, 22, 24, 26, 30, 28, 29, 32, 33, and 35 by referencing non-identical elements of claims 1–4, 10, 14, 15, and 17, in most cases without any additional analysis. *See* Pet. at 45–52, 78–81, 113–116, 142–144. These sections of the Petition also effectively *incorporate 256 pages* of the Crosby declaration. *See supra*, § I.

The Board responded that PO had not requested additional words for its POPR and had limited its arguments to fit within the word limit, so it was not prejudiced by Petitioner’s flouting of the rules. Dec. at 12–13. PO’s compliance with the rules should not excuse Petitioner’s noncompliance. The Board’s reasoning also entirely overlooks the prejudice PO now faces in preparing its merits response, which must address many more claims and issues than the POPR.

This Petition presents an opportunity for the Director to stop these abusive practices, which are becoming pervasive. *Cf. Perfect Surgical Techniques, Inc. v. Olympus Am., Inc.*, 841 F.3d 1004, 1006 (Fed. Cir. 2016) (“The Board is not free to disregard its own regulations. Nor can it mandate compliance by only some parties.”). In these circumstances, an appropriate remedy would be denial of the Petition. Any lesser remedy would be inconsequential.

IV. The *Fintiv* Factors Also Counsel Denial

Petitioner argued that the *Fintiv* framework favors institution (Pet. at 147–148), but, as discussed below, it actually favors discretionary denial.

1. The Partial Stay in Effect is Neutral

The parties have stipulated to the continuance of “a partial stay of the proceedings pending resolution” of this and other IPRs. Ex. 1031. The matter is not settled, however, because Exhibit 1031 requires the parties to meet and confer about how to proceed in the related litigation after institution of the IPRs. As the future of any stay, including the partial stay that is now in effect, is still to be determined, this factor is neutral.

2. Proximity of the Court’s Trial Date Is Neutral

Trial is not scheduled in the co-pending litigation. However, as *Fintiv* explains, “if the court’s trial date is at or around the same time as the projected statutory deadline . . . even significantly after the projected statutory deadline, the decision whether to institute will likely implicate other factors.” *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 15 at 9 (May 13, 2020) (precedential). This factor is also neutral.

3. The Parties and Court Are Far Into Litigation in the Parallel Proceeding, Favoring Denial

Despite threatening to file the Petition in this proceeding for many months, Petitioner waited to file it ***until the one year bar date***. As a result, both parties served and pursued litigation discovery in earnest, including the serving of substantial contentions and counter-contentions. *See, e.g.*, Ex. 1009 at 3 (PO’s

response to Petitioner’s “Supplemental Initial Invalidity and Unenforceability Contentions” noting that Petitioner had served some 144 invalidity charts concerning 24 prior art references and also noting PO’s infringement contentions).

Given Petitioner’s voluminous contentions, most of which would not be addressed in this IPR, the district court is the preferred venue for this dispute. The parties have already expended significant time and resources addressing those contentions in the litigation, favoring discretionary denial.

4. Petitioner’s Failure to File a *Sotera* Stipulation with the Petition Favors Denial

Petitioner made the strategic decision not to file a *Sotera*-type stipulation, thereby waiving the opportunity to commit to adjudicating validity of the ’517 Patent before the Board. Instead, Petitioner seeks to preserve a second-bite-at-the-apple, in the district court litigation, against the claims that survive this IPR.

Because the parallel district court action remains a viable, and even preferred, option for Petitioner to address its voluminous contentions regarding the validity of the ’517 Patent (*see* Ex. 1009 at 3), and because Petitioner failed to include a timely *Sotera* stipulation, this factor favors discretionary denial.

5. The Same Parties Are in the Parallel District Court Proceeding, Favoring Denial

Petitioner here is the defendant in the parallel district court litigation, which favors discretionary denial.

6. The Additional Factors Outlined Herein Further Favor Denial

Fintiv further provides for the analysis of “other factors,” which include those outlined in greater detail in Sections I-III above, as well as the weakness of the Petition, addressed below. Given that the other factors discussed in this paper all favor discretionary denial, so too does this factor of the *Fintiv* analysis.

As Factors 3, 4, 5, and 6 favor denial and Factors 1 and 2 are neutral, the *Fintiv* analysis favors discretionary denial. Even if Factors 1 and/or 2 are found to favor not exercising the Director’s discretion to deny the Petition, the balance of the factors still favor denial.

V. The Petition’s Weakness on the Merits Counsels Denial

The Petition is weak. Grounds 1 (Wampler alone) and 3 (Akamatsu alone) plainly fail. In these grounds, Petitioner makes obviousness allegations without ever admitting deficiencies in the references or proposing modifications or combinations. POPR at 8–10. While PO presented only a limited number of objections to Wampler, the Board *agreed* that Wampler failed to teach or suggest the challenged claims. Dec. at 30–31. The Board similarly *agreed* that Akamatsu failed to teach or suggest the challenged claims. *Id.* at 42–44.

For Ground 2 (Bourque alone and/or modified by Wampler), the Board agreed that Bourque fails to teach or suggest elements of the claims. *Id.* at 32–36. Regarding the proposed modification of Bourque with Wampler’s teachings, the

Board noted Petitioner’s reasoning that Bourque’s pump could “fit[] well between the apex of the heart and the adjacent diaphragm.” *Id.* at 39. It is undisputed that Bourque did not teach such placement, but that Wampler did because its “pump casing is compact and disk-shaped.” *Id.* at 40–41. Further undisputed (and undisputable) evidence consisting of the direct statements of Mr. Bourque himself show that the Bourque pump will not fit between the apex of the heart and the adjacent diaphragm—thus nullifying the asserted rationale for the combination. *Id.* at 40–41; POPR at 49–51. For example, Mr. Bourque is quoted as saying, following a description of substantial design changes to the prior art Bourque pump to reduce its size, that “now we don’t need to implant it down here (in the abdomen), we can go right in the chest.” Ex. 2007 at 7. He further noted that after these changes, the pump could go “right in the heart” in the manner proposed by Petitioner—but that happened *many years after* the Bourque reference and the ’517 Patent’s priority date. *Id.*

Remarkably, the Board dismissed these quotations of Mr. Bourque and his scientific publications as unsupported attorney argument and mischaracterized evidence. Dec. at 41. PO submits to the Director that the quotations of Mr. Bourque constitute undisputed evidence that Petitioner’s *post hoc* rationale for modifying Bourque with Wampler fails because the prior art Bourque pump could not fit in the placement proposed without substantial redesign.

Similarly, for Ground 4 (Schima combined with Akamatsu), despite the admitted and substantial flaws in the references (Dec. at 45; *also see, e.g.*, Figure 1 of Ex. 1006, which Petitioner alleges to show that Akamatsu is “deliverable to the heart” and is “insertable into a ventricle of the heart”), the Board concluded that pointing out these flaws was “only . . . attorney argument.” Dec. at 45–46. In the end, however, the Board refused even to finish its analysis of this combination, saying that it had already decided to institute. *Id.* at 47. The grounds advanced in the Petition are exceptionally weak, which also favors denial.

VI. Conclusion

For each of the reasons above, PO respectfully requests that the Director review the Board’s Decision and exercise her discretion to deny institution under 35 U.S.C. § 314(a). The Petition lacks the particularity required by statute, violates claim construction rules, and flouts the word count limit. The *Fintiv* factors and the exceptionally weak merits of the Petition also favor discretionary denial.

Ultimately, Petitioner has not shown that this IPR is an appropriate use of Office resources, and it should therefore be denied.

IPR2025-00115 (Patent 11,674,517)
PO Request for Director Review

Respectfully submitted,

Date: June 25, 2025

/Joshua P. Larsen/

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CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.6(e), the undersigned certifies that on this 25th day of June 2025, I caused a true and correct copy of the foregoing PATENT OWNER MIRACOR MEDICAL SA'S REQUEST FOR DIRECTOR REVIEW OF INSTITUTION DECISION to be served via e-mail on the following counsel for Petitioner:

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