Paper No. 17

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

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**BEFORE THE PATENT TRIAL AND APPEAL BOARD**

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ABBOTT LABORATORIES,
Petitioner,

v.

MIRACOR MEDICAL SA,
Patent Owner.

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IPR2025-00116
U.S. Patent No. 11,754,077

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# PETITIONER ABBOTT LABORATORIES' AUTHORIZED RESPONSE TO PATENT OWNER MIRACOR MEDICAL SA'S REQUEST FOR DIRECTOR REVIEW OF INSTITUTION DECISION

PO seeks Director Review for five issues: particularity of the Petition, identification of claim constructions, word count, *Fintiv* factors, and the merits of the Petition. The Board already considered and rejected all but the *Fintiv* argument, and PO does not argue that the Board abused its discretion or reached an erroneous conclusion of law—it simply asks the Director to revisit the Board's findings of fact. As to *Fintiv*, PO raises its argument for the first time here—but it is not of record and was not considered by the Board, so there is nothing for the Director to review.[1]

Granting PO's Request will also inject inefficiencies. PO asserted six related patents asserted in district court, all of which the Board instituted Petitioner's IPRs on. *See* IPR2025-096, -112, -113, -114, -115, -116. The challenged claims significantly overlap, and Petitioner's grounds are the same across all six. PO, however, only seeks Director Review on three institution decisions. No efficiency would be gained from denying institution of this IPR, while at least three other related IPRs proceed.

Compelling reasons also exist for denying this request. PO began prosecuting the challenged claims in 2023—years after Petitioner commercialized the product accused of infringement—but claimed priority to a 2007 application. *See* Pet. at 2.

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[1] PO's *Fintiv* request is not permitted under the *Interim Processes for PTAB Workload Management* (March 26, 2025), which does not apply to this proceeding.

The challenged claims diverge from the specification's disclosure to capture technology that Petitioner disclosed as early as 2001 (i.e., Bourque, Ex. 1007) and spent much time and resources advancing. *Id*. Director Review should be denied.

## I. The Petition Satisfied the Particularity Requirement

PO previously argued that "the Petition lacks particularity and that [the expert declaration] mirrors the Petition." Dec. 32 n.19. But the Board "considered all of Patent Owner's arguments" and "determined [that] Petitioner made a sufficient showing in the Petition to support institution." *Id*. PO argues that the Board "summarily" dismissed PO's arguments, (Req. at 2), but that ignores how the Board found that "Petitioner . . . provided sufficiently articulated reasoning with rational underpinning" and detailed the Petition's supporting evidence. Dec. at 13-30, 32.

PO also faults Petitioner for using a "shortcut." Req. at 3. Petitioner and its expert explained that some "non-identical" claims "correlate" to previously analyzed limitations. Req. at 2-3 (citing Ex.1003). Thus, Petitioner mapped, element-by-element, similar limitations to prior sections. *See e.g.*, Pet. at 44-45 (a "chamber" is disclosed "for the same reasons" as a "housing"); *see also id.* at 44-51, 77, 110-11, 140-42. PO argues that the claims have "significant differences," but has not explained why any "differences" are "significant." Req. at 3. In any case, PO's argument only applies to about "half" of the claims (Req. at 2), so denying institution is unwarranted. *See SAS Inst., Inc. v. Iancu*, 138 S. Ct. 1348, 1359 (2018).

PO misapplies *Cisco*. The petition there only included "conclusory statements," followed by citations to the expert to incorporate "arguments that [were] not made in the petition." IPR2014-00454, Paper 12 at 8-10. Here, the challenged portions relied entirely on arguments in the Petition and the Board found "Petitioner made a sufficient showing in the Petition." Dec. 32 n.18. PO also did not dispute Petitioner's contentions with respect to those non-identical claims. *Id*. at 24-25.

Lastly, PO's claim that it "was prejudiced in not being able to fully respond to Petitioner's allegations" is untrue. PO's Preliminary Response ("POPR") responded to Petitioner's supporting evidence over 56 pages. POPR at 17-73.

## II. Petitioner Presented Alternative Claim Constructions

Contrary to PO's argument, the Petition articulates and applies the correct plain and ordinary meaning constructions. Pet. at 7-15. Because PO takes a broader view of claim terms in its infringement contentions to capture Petitioner's product, however, the Petition alternatively applies PO's broader constructions in separate Grounds. *Id*. PO's "ambigu[ity]" argument was directly addressed and rejected by the Board—PO "d[id] not dispute" the terms so they were afforded their plain and ordinary meaning. Req. at 6-7; Dec. at 10-11 ("we do not need to construe these terms"). PO also argues that the constructions "adopt[ed]" from its infringement case "ignore[] the plain and ordinary meaning" without articulating why Petitioner's recitation of PO's infringement chart is wrong. Req. at 5-7.

## III. Petitioner Complied with the Word Count

The Board has expressly permitted the use of Petitioner's citation format, and has done so more recently than the non-precedential *Axon* decision PO relies on. *See NVIDIA Corp. v. Advanced Cluster Sys., Inc.*, No. IPR2021-00075, Paper No. 9 at 65 (PTAB May 5, 2021) (finding "non-standard formats such as 'EX-1001' . . . to make two words count as one" do not violate the rule). This format is also permitted at the appellate level. *See* Federal Circuit, Electronic Filing Procedures, version 3.2.2, at 34, accessible at https://www.cafc.uscourts.gov/wp-content/uploads/ElectronicFilingProcedures.pdf ("Appx123"). In any event, as the Board found, PO "did not avail itself of the opportunity to seek relief to address any alleged undue prejudice." Dec. at 31-32. The Board thus correctly concluded that denial of the Petition on this basis was not warranted. *Id*.

## IV. PO's Request to Consider the *Fintiv* Factors Is Improper, and in Any Case, the Factors Favor Institution

Given the litigation stay and no scheduled trial date, PO unsurprisingly did not raise *Fintiv* in its POPR. Consequently, the Board did not address *Fintiv*. PO is precluded from doing so here for the first time—"The Director will not consider . . . new arguments not part of the official record." USPTO, Director Review Process at 3.E. But even if considered, PO's argument lacks merit. Factors 1-2 weigh against denial because the litigation is stayed and the earliest expected trial date is July 2028, about two years after a FWD. Pet. at 146. Factor 3 weighs

against denial because little has happened in district court: final contentions have not been served, and neither claim construction nor expert discovery have begun. The Board has devoted significantly more resources to these issues than the district court. Factors 4-5 are neutral because the issues and parties are the same.

## V. The Merits of This Petition Are Compelling

Each primary reference proposes the same solutions using nearly identical architecture as the challenged claims under the correct constructions, illustrating the Petition's compelling merits. *See, e.g.,* Pet. at 6. PO argues the merits are "weak"—it argues that Ground 2 would require "substantial redesign." Req. at 13-14. But the Board correctly dismissed this argument as "unsupported, conclusory . . . attorney argument and mischaracterized evidence." Dec. at 22-23. PO "d[id] not [otherwise] dispute that [Ground 2] teaches the remaining limitations." Dec. at 24. Similarly, PO does not challenge Ground 4's merits, apparently accepting the Board's findings that the flaws alleged in the POPR about Ground 4 were merely "attorney argument." Req. at 14. Grounds 1 and 3 are also compelling, given that the Board's only critique turned on a disputed claim construction, which is not a final determination. Dec. at 32. Finally, PO argues that "the Board refused even to finish its analysis." Req. at 14. But this only confirms the Petition's strength—the Board considered Ground 2 sufficiently strong and there was no need to say more. *See SAS*, 138 S. Ct. at 1359.

For the foregoing reasons, Director Review should be denied.

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Respectfully Submitted,

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**CERTIFICATE OF SERVICE**

Pursuant to 37 C.F.R. § 42.6(e), I hereby certify that on July 2, 2025, I caused to be served a true and correct copy of the foregoing to be served via e-mail on the following counsel for Patent Owner:

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