

IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF DELAWARE

MAGNOLIA MEDICAL
TECHNOLOGIES, INC.,

Plaintiff,

v.

KURIN, INC.,

Defendant.

C.A. No. 24-1124 (CFC)

REDACTED - PUBLIC VERSION

**MAGNOLIA MEDICAL TECHNOLOGIES, INC.'S OPENING BRIEF
IN SUPPORT OF ITS MOTION FOR SUMMARY JUDGMENT OF
INVALIDITY OF U.S. PATENT NO. 12,138,052 UNDER
35 U.S.C. §§ 102 AND 103**

OF COUNSEL:

Ashok Ramani
Micah G. Block
Serge A. Voronov
Elaine M. Andersen
Keon Zemoudeh
Natalie Stoecklein
Elazar Chertow
DAVIS POLK & WARDWELL LLP
900 Middlefield Road, Suite 200
Redwood City, CA 94063
(650) 752-2000

David Jiang
DAVIS POLK & WARDWELL LLP
450 Lexington Avenue
New York, NY 10017
(212) 450-4000

MORRIS, NICHOLS, ARSHT & TUNNELL LLP
Rodger D. Smith II (#3778)
Anthony D. Raucci (#5948)
1201 North Market Street
P.O. Box 1347
Wilmington, DE 19899
(302) 658-9200
rsmith@morrisnichols.com
araucci@morrisnichols.com

*Attorneys for Plaintiff Magnolia Medical
Technologies, Inc.*

July 25, 2025

**Confidential Version filed: 7/25/25
Redacted Version filed: 8/1/25**

TABLE OF CONTENTS

	<u>PAGE</u>
I. NATURE AND STAGE OF THE PROCEEDING	1
II. SUMMARY OF ARGUMENT	1
III. STATEMENT OF FACTS	3
IV. LEGAL STANDARD	7
V. ARGUMENT	8
A. THE KURIN ASSERTED CLAIMS OF THE #052 PATENT ARE INVALID	9
1. #052 Patent Claims 1 and 13 Are Invalid Over Bullington #800	10
a. Bullington #800 Discloses “[a] Device”	10
b. Bullington #800 Discloses “an Inlet Port for Receiving a Blood Sample” (Claim 1) / “an Inlet Port for Receiving Blood” (Claim 13)	10
c. Bullington #800 Discloses “an Outlet Port”	10
d. Bullington #800 Discloses “a Chamber Connected with the Inlet Port and Configured to Collect a First Portion of the Blood Sample when Under a Drawing Force Applied from the Outlet Port from a Blood Sample Collection Device” (Claim 1) / “a Chamber Comprising a Flexible Material, the Chamber Connected with the Inlet Port and Configured to Collect a First Portion of the Blood when Under a Drawing Force Applied from the Outlet Port” (Claim 13)	11
e. Bullington #800 Discloses “a Sampling Channel Connected with the Inlet Port and Configured to Convey a Subsequent Portion of the Blood Sample to the Outlet Port” (Claim 1) / “a Sampling	

	Channel Connected with the Inlet Port and Configured to Convey a Subsequent Portion of the Blood to the Outlet Port” (Claim 13)	13
f.	Bullington #800 Discloses “a Housing that Defines the Inlet Port, the Sampling Channel, and the Outlet Port”	15
2.	Claims 6-9 and 18-21 Are Invalid Over Bullington #800	17
a.	Bullington #800 Discloses “a Valve Configured to Initially Close Off the Sampling Channel” (Claims 6 and 18)	17
b.	Bullington #800 Discloses “a Valve Configured to Initially Close Off the Sampling Channel Until the First Portion of the [Blood Sample / Blood] Is in the Chamber” (Claims 7 and 19)	18
c.	Bullington #800 Discloses “a Valve that Is Configured to Initially Close Off the Sampling Channel Until the First Portion of the [Blood Sample / Blood] Is in the Chamber and Is Further Configured such that, Upon Release, Follow-On Amounts of the [Blood Sample / Blood] Will Bypass the Chamber and Flow Through the Sampling Channel Toward the Outlet Port” (Claims 8 and 20)	19
d.	Bullington #800 Discloses “Wherein the Valve Is Configured to Pinch, Shunt, Bend or Otherwise Close Off the Sampling Channel Before the First Portion of the Blood Sample Is Collected in the Chamber” (Claims 9 and 21)	20
3.	#052 Patent Claims 10 and 22 Are Invalid over Bullington #800, which Discloses “a Patient Needle and the Blood Sample Collection Device”	21
4.	#052 Patent Claims 11 and 23 Are Invalid Over Bullington #800, Which Discloses “the Chamber Having a Volume Sufficient to Collect the First Portion of the	

	Blood Sample that Is More Prone to Contamination and also to Minimize an Amount of Blood to Be Sequestered”	21
5.	#052 Patent Claims 12 and 24 Are Invalid Over Bullington #800, Which Discloses “Wherein the Chamber Has a Volume of Less Than 1.5 Cubic Centimeters”	23
VI.	CONCLUSION.....	23

TABLE OF AUTHORITIES

PAGE

Cases

<i>Exergen Corp. v. Wal-Mart Stores, Inc.</i> , 575 F.3d 1312 (Fed. Cir. 2009)	14
<i>Ineos USA LLC v. Berry Plastics Corp.</i> , 2014 WL 1493852 (S.D. Tex. Apr. 15, 2014)	15
<i>KSR Int’l Co. v. Teleflex Inc.</i> , 550 U.S. 398 (2007)	7, 8
<i>Liebel-Flarsheim Co. v. Medrad, Inc.</i> , 481 F.3d 1371 (Fed. Cir. 2007)	7
<i>Matsushita Elec. Indus. Co. v. Zenith Radio Corp.</i> , 475 U.S. 574 (1986)	8
<i>Regents of Univ. of Minnesota v. AGA Med. Corp.</i> , 717 F.3d 929 (Fed. Cir. 2013)	8, 11
<i>Stragent, LLC v. Volvo Car USA, LLC</i> , 2024 WL 1366813 (D. Del. Apr. 1, 2024)	8
<i>ZUP, LLC v. Nash Mfg., Inc.</i> , 896 F.3d 1365 (Fed. Cir. 2018)	7

Statutes

35 U.S.C. § 102	1
35 U.S.C. § 103	1

TABLE OF EXHIBITS

EXHIBIT	DESCRIPTION
Ex. 1	U.S. Patent No. 12,138,052
Ex. 2	Rebuttal Expert Report of Erik K. Antonsson, Ph.D., P.E., NAE, Regarding Validity of U.S. Patent No. 12,138,052, served in this case and dated June 27, 2025
Ex. 3	File prosecution history of U.S. Patent No. 12,138,052
Ex. 4	U.S. Patent Application Publication No. 2008/0145933
Ex. 5	Kurin, Inc.'s Responses and Objections to Magnolia Medical Technologies, Inc.'s First Set of Requests for Admission (Nos. 1-30)
Ex. 6	International Application Publication No. WO 2014/085800
Ex. 7	Expert Report of Carl D. Meinhart Regarding Invalidity of U.S. Patent No. 12,138,052, served in this case and dated May 30, 2025
Ex. 8	Patton and Schmitt, "Innovation for Reducing Blood Culture Contamination: Initial Specimen Diversion Technique," J. of Clinical Microbiology, Vol. 48, No. 12 (Dec. 2010)

I. NATURE AND STAGE OF THE PROCEEDING

Kurin asserts infringement of the #052 Patent.¹ Trial is set for December 8, 2025.

II. SUMMARY OF ARGUMENT

Magnolia moves for summary judgment of invalidity as to all Kurin Asserted Claims. The Kurin Asserted Claims are invalid under 35 U.S.C. §§ 102 and 103 because Magnolia invented and publicly disclosed the claimed invention first.

The Kurin Asserted Claims do not claim any inventive technology beyond the technology Magnolia invented and disclosed years before, specifically, technology that Magnolia disclosed in Bullington #800. Instead, the Kurin Asserted Claims at most repackage Magnolia's prior art. To the extent the Kurin Asserted Claims describe any technology not disclosed in Bullington #800, such technology would have been obvious to a POSA over Bullington #800 in view of the knowledge of a POSA.

¹ This Motion uses the following additional abbreviations: Magnolia Medical Technologies, Inc. ("Magnolia"); Kurin, Inc. ("Kurin"); U.S. Patent No. 12,138,052 (the "#052 Patent"); International Patent Application Publication No. WO 2014/085800 ("Bullington #800"); U.S. Patent Application Publication No. US 2008/0145933 ("Patton #933"); U.S. Patent and Trademark Office ("PTO"); person of ordinary skill in the art ("POSA"); and claims 1, 6, 7, 8, 9, 10, 11, 12, 13, 18, 19, 20, 21, 22, 23, and 24 of the #052 Patent, collectively as the "Kurin Asserted Claims."

This case is unique because the PTO has already concluded that the blood sampling device claimed in the #052 Patent is found in Magnolia's prior art from 2008. CSOF ¶¶ 5-6. Specifically, the PTO Examiner responsible for examining the #052 Patent found that Magnolia's prior art discloses all four of the original limitations in Kurin's independent claims. Kurin did not protest, but merely added "a housing that defines the inlet port, the sampling channel, and the outlet port." But that does not save Kurin, as Magnolia had already invented and disclosed that housing. The PTO did not know this, as Kurin did not disclose Bullington #800, published in 2014, during prosecution.

Kurin's expert submitted a validity report opining that Bullington #800 does not disclose all elements of the #052 Patent, which in a typical case might preclude summary judgment. But the opinions put forward by Kurin's expert as to the Bullington #800 reference are either conclusory or contradict well-established patent law. As just one example, Kurin's expert argues that Bullington #800 does not anticipate because the "housing" fails to define a "chamber"—notwithstanding the fact that the #052 Patent claims *do not require a housing that defines the chamber*. Such orthogonal statements about Bullington #800 cannot and do not support genuine disputes of material fact.

III. STATEMENT OF FACTS

The relevant facts are set forth in Magnolia Medical Technologies Inc.’s Concise Statement of Facts in Support of Motion for Summary Judgment of Invalidity of U.S. Patent No. 12,138,052 under 35 U.S.C. §§ 102 and 103 (“CSOF”).

The #052 Patent was filed on July 24, 2024, and issued on November 12, 2024. Ex. 1 (#052 Patent) at Cover; CSOF ¶ 1. The #052 Patent is related to prior applications, including Provisional Application No. 62/318,194, filed on April 4, 2016, Ex. 1 (#052 Patent) at 2, to which Kurin claims priority. Ex. 2 (Antonsson Validity Report) ¶ 30; CSOF ¶ 2. On September 17, 2024, the PTO issued a non-final rejection of claims 1-9, 11-22, 24, and 25. *See* Ex. 3 (Excerpt of #052 Patent Prosecution History) at -1815 (#052 Patent Non-Final Rejection, Sept. 17, 2024); CSOF ¶ 3. Specifically, the PTO rejected claims 1, 6-9, 11, 12, 14, 19-22, 24, and 25 under § 102 as anticipated by Patton #933. Ex. 3 (Excerpt of #052 Patent Prosecution History) at -1816 (#052 Patent Non-Final Rejection, Sept. 17, 2024) (citing Ex. 4 (Patton #933)); CSOF ¶ 3.

Kurin did not contest before the PTO that Patton #933 discloses all of the limitations of the originally filed independent claims of the application. *See* Ex. 5 (Kurin’s RFA Responses) at 22; CSOF ¶ 6. Kurin amended its claims by adding a claim limitation to its two independent claims: a “housing that defines the inlet

port, the sampling channel, and the outlet port.” Ex. 3 (Excerpt of #052 Patent Prosecution History) at -1944, -1946 (#052 Response, Sept. 25, 2024); CSOF ¶ 7. On October 10, 2024, the PTO issued a notice of allowance, explaining that “the most pertinent prior art Patton et al (US 2008/0145933) . . . does not teach, disclose and/or fairly suggest a housing that defines the inlet port, the sampling channel, and the outlet port.” Ex. 3 (Excerpt of #052 Patent Prosecution History) at -1961 (#052 Notice of Allowability); CSOF ¶ 8.

Bullington #800 was published on June 5, 2014. CSOF ¶ 9. Bullington #800 is prior art to the #052 Patent under 35 U.S.C. § 102(a)(1). CSOF ¶ 10. Bullington #800 is not listed among the references cited and Kurin did not disclose it to the PTO during prosecution of the #052 Patent. Ex. 1 (#052 Patent) at Cover-page 6; CSOF ¶ 11.

Bullington #800 discloses, and Figures 16-17 depict, “a syringe- based transfer device 500 according to an embodiment.” CSOF ¶ 14. Bullington #800 discloses that “[a]s shown in FIG. 16, the first member 537, the second member 538, and the third member 539 can each be in their first position relative to the housing 501 such that the first channel 506 is in fluid communication with the distal port 505, while the second channel 507 is fluidically isolated from the distal port 505 and the proximal port 515.” CSOF ¶ 18.

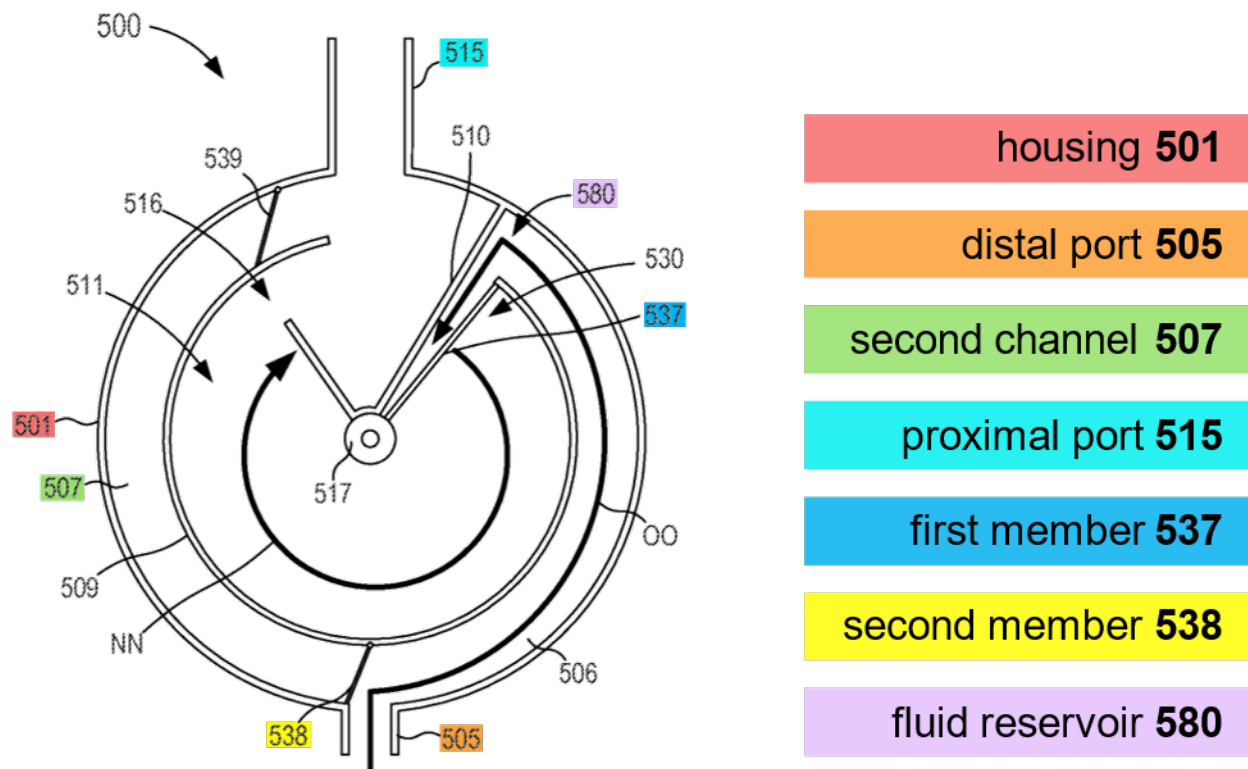


FIG. 16

Ex. 6 (Bullington #800) Figure 16 (annotated).

Bullington #800 discloses “the proximal port 515 can be coupled to a syringe based device or the like that can, for example, introduce a negative pressure in a portion of the inner volume 511 that exerts a suction force through the channel 516, which, in turn, is operable in rotating the first member 537 from its first position to its second position. . . . [W]ith the first channel 506 in fluid communication with the fluid reservoir 580 and the distal port 505, the negative pressure in the fluid reservoir 580 can exert a suction force through the first channel 506 and the distal port 505 that can urge a flow of bodily-fluid from the

patient, through the lumen-defining device (not shown) and the first channel 506, and into the fluid reservoir 580, as indicated by the arrow OO in FIG. 16.” CSOF ¶ 19.

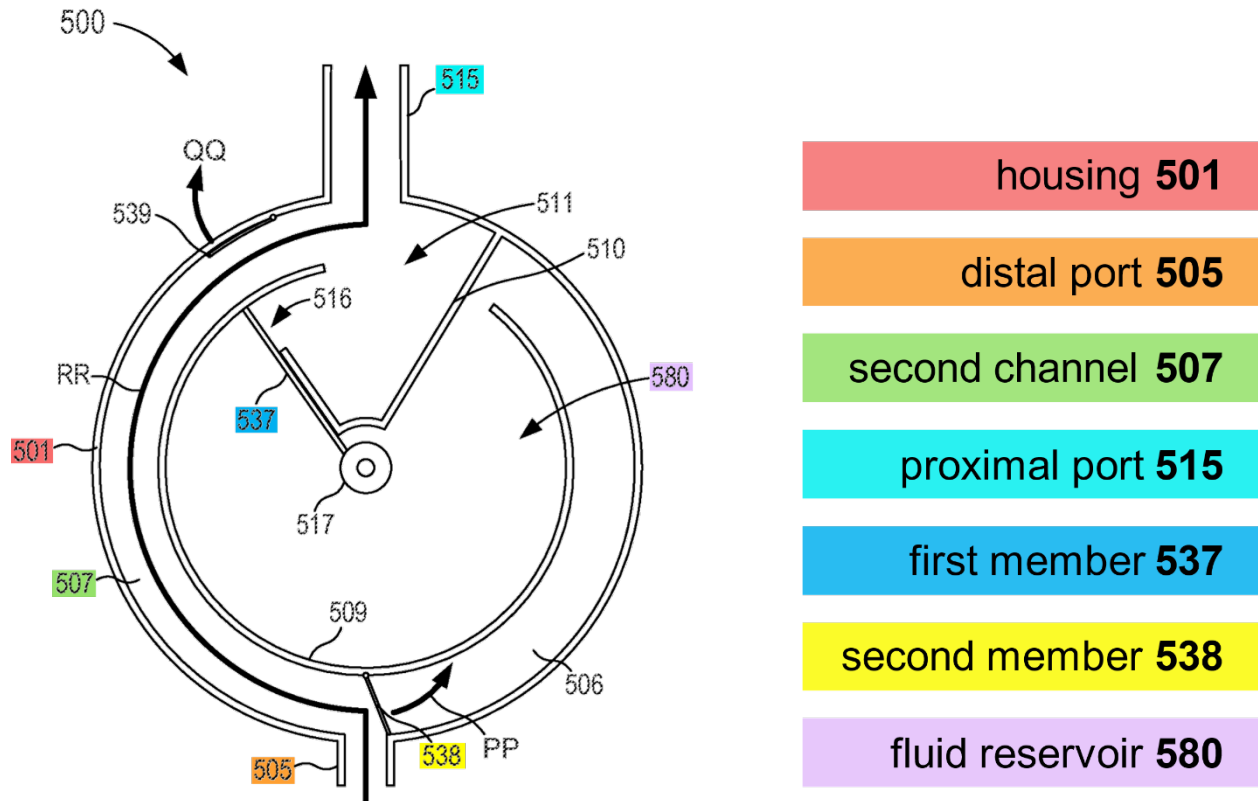


FIG. 17

Ex. 6 (Bullington #800) Figure 17 (annotated).

Bullington #800 further discloses “[a]s shown in FIG. 17, the transfer device 500 can be moved from the second configuration to the third configuration by rotating the second member 538 and the third member 539 of the flow control mechanism 530 relative to the diverter 509 and/or the housing 501, as indicated in FIG. 17 by the arrows PP and QQ, respectively. In this manner, with the first

member 537, the second member 538, and the third member 539 rotated to their second positions, . . . the user can manipulate the syringe to exert a suction force through the proximal port 515, the second channel 507, the distal port 505, and the lumen-defining device that can urge a flow of bodily-fluid from the patient to, for example, a sample reservoir defined by the syringe, as indicated by the arrow RR.” CSOF ¶ 21.

IV. LEGAL STANDARD

Where “the content of the prior art, the scope of the patent claim, and the level of ordinary skill in the art are not in material dispute, and the obviousness of the claim is apparent in light of these factors, summary judgment is appropriate.” *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 427 (2007). Courts may grant summary judgment of obviousness “[w]here the differences between the claimed invention and the prior art are minimal.” *ZUP, LLC v. Nash Mfg., Inc.*, 896 F.3d 1365, 1374 (Fed. Cir. 2018) (alteration in original) (finding that “record evidence indicates that the claimed invention was not the first to achieve the goal of helping users maneuver between positions on a water recreational board”).

Similarly, where there is no genuine issue of material fact as to what the relevant prior art discloses, summary judgment of anticipation or obviousness is available. *Liebel-Flarsheim Co. v. Medrad, Inc.*, 481 F.3d 1371, 1377 (Fed. Cir. 2007) (affirming summary judgment of anticipation and stating “[a]nticipation is a

question of fact, but validity is a question of law.”). While anticipation or obviousness must be proven by clear and convincing evidence because of a presumption of validity, where a prior art reference was not disclosed to the PTO, “the rationale underlying the presumption—that the PTO, in its expertise, has approved the claim”—is diminished. *KSR*, 500 U.S. at 426.

“Conclusory expert assertions cannot raise triable issues of material fact on summary judgment.” *Regents of Univ. of Minnesota v. AGA Med. Corp.*, 717 F.3d 929, 941 (Fed. Cir. 2013) (expert’s testimony was “a conclusion supported by no explanation or reasoning”); *see also Matsushita Elec. Indus. Co. v. Zenith Radio Corp.*, 475 U.S. 574, 586 (1986) (party opposing summary judgment must show “genuine” issue of fact and “must do more than simply show that there is some metaphysical doubt as to the material facts.”); *Stragent, LLC v. Volvo Car USA, LLC*, 2024 WL 1366813, at *4 (D. Del. Apr. 1, 2024) (holding that expert’s “conclusory” opinion did not create genuine dispute of material fact because “she renders a conclusion as to infringement without explaining *how* or *why* she reached that conclusion”), *appeal dismissed*, No. 2024-1793, 2024 WL 4259487 (Fed. Cir. Sept. 23, 2024).

V. ARGUMENT

Claims 1, 6-10, 12-13, 18-22, and 24 are invalid under § 102 because they are anticipated by Bullington #800.

Additionally, claims 11 and 23 of the #052 Patent are invalid under § 103 because they are obvious over a single reference—Bullington #800 in view of the knowledge of a POSA—specifically, because a POSA would have found it obvious to configure the device of Bullington #800 to collect and divert an amount of blood that is more prone to contamination, while also minimizing the volume of diverted blood. Kurin’s expert does not dispute that a POSA would have, by April 4, 2016, had knowledge about the amount of blood necessary to effectively reduce false positives while also minimizing the volume of diverted blood. *Compare* Ex. 7 (Meinhart Invalidity Report) ¶¶ 241, 351 (identifying specific background knowledge of a POSA relevant to invalidity of claims 11 and 23 of the #052 Patent over Bullington #800 in view of the knowledge of a POSA), *with* Ex. 2 (Antonsson Validity Report) ¶¶ 91-92 (discussing Magnolia’s expert’s opinion regarding single-reference obviousness).

A. THE ASSERTED CLAIMS OF KURIN’S #052 PATENT ARE INVALID

There is no genuine factual dispute about the disclosures of Bullington #800 or the scope of the Kurin Asserted Claims. Because Bullington #800, in at least the embodiment depicted in Figures 16 and 17 and described in paragraphs [1107]-[1114], discloses each limitation of each of the Kurin Asserted Claims, the Kurin Asserted Claims are invalid under §§ 102 and/or 103.

1. #052 Patent Claims 1 and 13 Are Invalid Over Bullington #800

a. Bullington #800 Discloses “[a] Device”

The embodiment disclosed in Figures 16 and 17 of Bullington #800 is “a syringe-based transfer device 500.” CSOF ¶ 14. As with many of the limitations of the Kurin Asserted Claims, Kurin’s expert, Dr. Antonsson, does not dispute that Bullington #800 discloses the limitation “[a] device.” *See* Ex. 2 (Antonsson Validity Report) ¶ 111.

b. Bullington #800 Discloses “an Inlet Port for Receiving a Blood Sample” (Claim 1) / “an Inlet Port for Receiving Blood” (Claim 13)

At the bottom of syringe-based transfer device 500 in Figures 16 and 17 of Bullington #800 is “distal port 505,” which can be coupled to a needle disposed within a patient’s vein. CSOF ¶ 18. Bullington #800 further discloses that the described device can receive a “flow of bodily-fluid from the patient,” including “blood,” through distal port 505. CSOF ¶¶ 12-13, 19. Dr. Antonsson does not dispute that Bullington #800 discloses the limitation “an inlet port for receiving a blood sample” or “an inlet port for receiving blood.” *See* Ex. 2 (Antonsson Validity Report) ¶ 111.

c. Bullington #800 Discloses “an Outlet Port”

At the top of syringe-based transfer device 500 in Figures 16 and 17 of Bullington #800 is “proximal port 515,” which can be coupled to a syringe or other blood collection device. CSOF ¶ 14. Dr. Antonsson does not dispute that

Bullington #800 discloses the limitation “an outlet port.” *See* Ex. 2 (Antonsson Validity Report) ¶ 111.

- d. **Bullington #800 Discloses “a Chamber Connected with the Inlet Port and Configured to Collect a First Portion of the Blood Sample when Under a Drawing Force Applied from the Outlet Port from a Blood Sample Collection Device” (Claim 1) / “a Chamber Comprising a Flexible Material, the Chamber Connected with the Inlet Port and Configured to Collect a First Portion of the Blood when Under a Drawing Force Applied from the Outlet Port” (Claim 13)**

In the center of syringe-based transfer device 500 in Figures 16 and 17 of Bullington #800 is “fluid reservoir 580,” which can be selectively placed in fluidic communication with the inlet port, distal port 505. CSOF ¶¶ 14-15. Bullington #800 explains that the distal port 505 is part of the “housing 501” and that the housing 501 defines fluid reservoir 580. *Id.*

Dr. Antonsson contends that components are “connected with” each other only when they are physically coupled. Ex. 2 (Antonsson Validity Report) ¶ 170 (opining that two hoses in fluid communication with each other are only “connected with” each other if they are “screwed together”). But Dr. Antonsson’s *ipse dixit* is a conclusory assertion that does not raise a triable issue of material fact. *See Regents of Univ. of Minnesota*, 717 F.3d at 941. Dr. Antonsson’s narrow meaning of “connected with” is not required by the claim language and is belied by the prosecution history. The PTO Examiner found that Patton #933 teaches a

“chamber connected with the inlet port” based on the fact that Patton #933 discloses a chamber connected to the inlet port *via intermediate tubing*. Ex. 3 (Excerpt of #052 Patent Prosecution History) at -1817 (#052 Patent Non-Final Rejection, Sept. 17, 2024); CSOF ¶ 5. In any event, Bullington #800 discloses a “chamber connected with the inlet port” even under Dr. Antonsson’s interpretation. This is because fluid reservoir 580 and distal port 505 are both within and defined by the housing 501 and are not separated by any external, intervening components. CSOF ¶ 14.

Fluid reservoir 580 is configured to collect a first portion of the blood sample when under a “suction force” applied from proximal port 515 from a syringe, vacutainer, or other similar blood sample collection device. CSOF ¶ 19. Dr. Antonsson does not dispute that Bullington #800 discloses a chamber “configured to collect a first portion of the blood sample when under a drawing force applied from the outlet port from a blood sample collection device” and “configured to collect a first portion of the blood when under a drawing force applied from the outlet port.” *See* Ex. 2 (Antonsson Validity Report) ¶¶ 165-76.

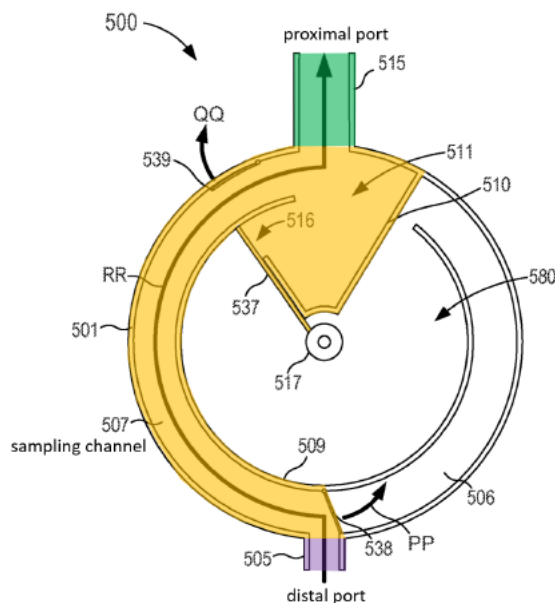
Finally, Bullington #800 discloses a “chamber comprising a flexible material” as required by Claim 13. One of the walls of fluid reservoir 580 is “first member 537.” CSOF ¶ 14. Bullington #800 explains that “the first member 537 can be formed from a relatively flexible and/or compressible material,” so the

chamber comprises a flexible material. CSOF ¶ 16. Although Dr. Antonsson claims that Bullington #800 “is silent regarding the material of the pre-sample reservoir,” Ex. 2 (Antonsson Validity Report) ¶ 176, his opinion is conclusory and contradicted by the disclosure.

e. Bullington #800 Discloses “a Sampling Channel Connected with the Inlet Port and Configured to Convey a Subsequent Portion of the Blood Sample to the Outlet Port” (Claim 1) / “a Sampling Channel Connected with the Inlet Port and Configured to Convey a Subsequent Portion of the Blood to the Outlet Port” (Claim 13)

On the left-hand side of syringe-based transfer device 500 in Figures 16 and 17 of Bullington #800 is “second channel 507” which—when the device is in its third configuration—is physically and fluidically connected with the inlet (distal port 505) and outlet (proximal port 515). CSOF ¶ 21. As explained above, Dr. Antonsson’s definition of “connected with” is not expressly required by the claim language and is belied by the prosecution history. Nonetheless, Bullington #800 discloses “a sampling channel connected with the inlet port” under Dr. Antonsson’s definition. The annotations in Dr. Antonsson’s report illustrate that, when the device is in its third configuration, second channel 507 is directly physically connected with distal port 505 and proximal port 515, without any intervening components. Ex. 2 (Antonsson Validity Report) ¶ 180.

Dr. Antonsson’s annotated image of Figure 17 depicts second channel 507 in yellow, distal port 505 in purple, and proximal port 515 in green:



Id.

After fluid reservoir 580 receives a first portion of blood and the device is transitioned to its third configuration, a subsequent portion of blood flows through second channel 507 to proximal port 515. CSOF ¶ 21. Dr. Antonsson opines that “second channel 507 requires first member 537, second member 538, and third member 539 to rotate to convey a subsequent portion of blood from port 505 to port 515” and that “[w]ithout these three rotating members, the subsequent portion of blood would not flow to second channel 507 and then to port 515.” Ex. 2 (Antonsson Validity Report) ¶ 179. But the inclusion of components that are unclaimed by the #052 Patent in Bullington #800 does not defeat anticipation. *See Exergen Corp. v. Wal-Mart Stores, Inc.*, 575 F.3d 1312, 1318-19 (Fed. Cir. 2009)

(finding that reference’s disclosure of additional point of detecting radiation did not prevent it from anticipating claim-at-issue); *Ineos USA LLC v. Berry Plastics Corp.*, 2014 WL 1493852, at *7 (S.D. Tex. Apr. 15, 2014) (“Prior art that includes an extra component anticipates a patent that claims the same elements but excludes the extra component.”), *aff’d*, 783 F.3d 865 (Fed. Cir. 2015). As Dr. Antonsson admits, with the rotation of these members, “the subsequent portion of blood travels from port 505 into second channel 507.” Ex. 2 (Antonsson Validity Report) ¶ 179. Thus, there is no genuine dispute that Bullington #800 discloses the limitation “a sampling channel connected with the inlet port and configured to convey a subsequent portion of the [blood / blood sample] to the outlet port.”

f. Bullington #800 Discloses “a Housing that Defines the Inlet Port, the Sampling Channel, and the Outlet Port”

“Housing 501” includes and defines distal port 505, proximal port 515, and second channel 507. The annotations in Dr. Antonsson’s report, depicting housing 501 in blue, illustrate that the external housing disclosed by Bullington #800, which entirely defines distal port 505, proximal port 515, and second channel 507. Ex. 2 (Antonsson Validity Report) ¶ 183.

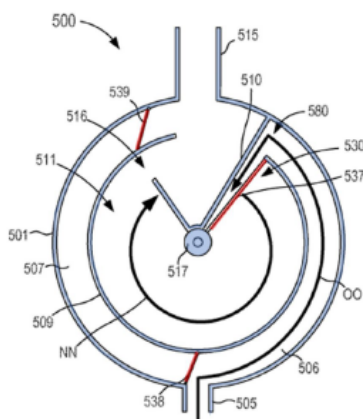


FIG. 16

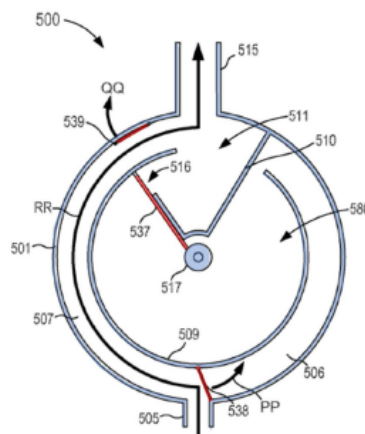


FIG. 17

Dr. Antonsson asserts that this limitation is not met for three reasons. *First*, he opines that Bullington #800 does not meet this limitation because it does not include a “sampling channel” connected with the inlet port. *Id.* ¶ 184. However, as discussed above, there is no genuine issue of material fact as to whether Bullington #800 discloses the claimed sampling channel. *Second*, Dr. Antonsson argues that second member 538 is “required to form a channel and this member is not defined by a housing.” *Id.* ¶ 185. But second member 538 is a valve, and second channel 507 is defined by housing 501 regardless of whether second member 538 is blocking the channel (Figure 16) or not (Figure 17). *Third*, Dr. Antonsson inexplicably opines that the housing does not define the claimed “chamber.” *Id.* ¶ 186. However, neither claim 1 nor 13 of the #052 Patent recites a housing that defines the chamber—both independent claims recite “a housing that defines the inlet port, sampling channel, and outlet port.” Ex. 1 (#052 Patent) at claims 1, 13. It

is not relevant to validity whether the housing of Bullington #800 defines other components.

2. Claims 6-9 and 18-21 Are Invalid Over Bullington #800

Dependent claims 6-9 and 18-21 all claim particular valves, and all of them have in common “a valve configured to initially close off the sampling channel.” Claims 6-9 and 18-21 depend from claims 1 and 13, respectively. As explained above, Bullington #800 discloses each limitation of claims 1 and 13. *See supra* § V.A.1.

a. Bullington #800 Discloses “a Valve Configured to Initially Close Off the Sampling Channel” (Claims 6 and 18)

Bullington #800 discloses “second member 538,” which “can be [a] valve[] or the like.” CSOF ¶ 16. Bullington #800 explains that “[i]n use, the second member 538 can be rotated between a first position and a second position to selectively place the first channel 506 and the second channel 507, respectively, in fluid communication with the distal port 505.” CSOF ¶ 17. As shown in Figure 16, second member 538 initially closes off second channel 507 (the sampling channel). CSOF ¶ 14.

Dr. Antonsson’s response is that Magnolia has not explained why second member 538 is a valve, and that “[a]ssuming, *arguendo*, that second member 538 could be considered a valve,” Magnolia “cannot rely on it for both the sampling

channel and the valve elements of the claims.” Ex. 2 (Antonsson Validity Report) ¶ 191. But Bullington #800 expressly states that second member 538 can be a “valve,” and second member 538 is not part of the sampling channel, so Dr. Antonsson’s conclusory statements do not create a genuine dispute of material fact. CSOF ¶¶ 14, 16.

b. Bullington #800 Discloses “a Valve Configured to Initially Close Off the Sampling Channel Until the First Portion of the [Blood Sample / Blood] Is in the Chamber” (Claims 7 and 19)

In addition to the disclosures above for claims 6 and 18, Bullington #800 discloses that “[w]ith the desired amount of bodily-fluid transferred to the first reservoir 580, a user can engage the transfer device 500 to move the transfer device 500 from the second configuration to the third configuration.” CSOF ¶ 20. Moving to the third configuration rotates second member 538 to its second position, as shown in Figure 17, where second member 538 no longer closes off second channel 507. CSOF ¶ 14.

Dr. Antonsson provides no reason why Bullington #800 does not meet the limitation of claims 7 and 19 beyond the assertions he raises as to claims 6 and 18. Ex. 2 (Antonsson Validity Report) ¶ 192-195. For the reasons explained above, *see supra* § V.A.2.a, Dr. Antonsson’s conclusory statements do not create a genuine dispute of material fact.

- c. **Bullington #800 Discloses “a Valve that Is Configured to Initially Close Off the Sampling Channel Until the First Portion of the [Blood Sample / Blood] Is in the Chamber and Is Further Configured such that, Upon Release, Follow-On Amounts of the [Blood Sample / Blood] Will Bypass the Chamber and Flow Through the Sampling Channel Toward the Outlet Port” (Claims 8 and 20)**

In addition to the disclosures above for claims 6 and 18, Bullington #800 discloses that when the device is in the third configuration, as depicted by Figure 17, the chamber is “fluidically isolated” from the inlet and outlet port. CSOF ¶ 21. Thus, as shown by arrow RR, subsequent blood will bypass the chamber as it flows through the sampling channel to the outlet. CSOF ¶ 14; Ex. 6 (Bullington #800) at Figure 17.

Dr. Antonsson provides no reason why Bullington #800 does not meet the limitation of claims 8 and 20 beyond the assertions he raises he raises as to claims 6 and 18. Ex. 2 (Antonsson Validity Report) ¶ 196-199. For the reasons explained above, *see supra* § V.A.2.a, Dr. Antonsson’s conclusory statements do not create a genuine dispute of material fact.

d. Bullington #800 Discloses “Wherein the Valve Is Configured to Pinch, Shunt, Bend or Otherwise Close Off the Sampling Channel Before the First Portion of the Blood Sample Is Collected in the Chamber” (Claims 9 and 21)

Claims 9 and 21 depend from claims 6 and 18, respectively. As explained above, Bullington #800 discloses the limitations of claims 6 and 18. *See supra* § V.A.2.a.

Bullington #800 discloses “second member 538,” which “can be [a] valve[] or the like.” CSOF ¶ 16. Bullington #800 explains that “[i]n use, the second member 538 can be rotated between a first position and a second position to selectively place the first channel 506 and the second channel 507, respectively, in fluid communication with the distal port 505.” CSOF ¶ 17. As shown in Figure 16, second member 538 initially closes off second channel 507 (the sampling channel). CSOF ¶ 14. Specifically, Bullington #800 discloses that second member 538 closes off second channel 507 because “the second member 538 can extend from an outer surface of the annular wall forming a portion of the diverter 509 to be placed in contact with the inner surface of the housing [501].” CSOF ¶ 17.

Dr. Antonsson provides no reason why Bullington #800 does not meet the limitation of claims 9 and 21 beyond the assertions he raises as to claims 6 and 18. Ex. 2 (Antonsson Validity Report) ¶¶ 200-203. For the reasons explained above,

see supra § V.A.2.a, Dr. Antonsson’s conclusory statements do not create a genuine dispute of material fact.

3. #052 Patent Claims 10 and 22 Are Invalid over Bullington #800, which Discloses “a Patient Needle and the Blood Sample Collection Device”

Bullington #800 discloses that “distal port 505 can be coupled to a proximal end portion of a lumen-defining device such as, for example, a butterfly needle.” CSOF ¶ 18. Bullington #800 further discloses that the device can be coupled to a syringe or similar blood collection device to receive the blood sample. CSOF ¶¶ 14, 21. Dr. Antonsson does not dispute that Bullington #800 discloses the elements of claim 10.

4. #052 Patent Claims 11 and 23 Are Invalid Over Bullington #800, Which Discloses “the Chamber Having a Volume Sufficient to Collect the First Portion of the Blood Sample that Is More Prone to Contamination and also to Minimize an Amount of Blood to Be Sequestered”

“Fluid reservoir 580,” shown in the center of syringe-based transfer device 500 in Figures 16 and 17 of Bullington #800, can collect an initial portion of blood that “can contain undesirable microbes such as, for example, dermally-residing microbes and/or other external contaminants.” CSOF ¶¶ 14, 19. Bullington #800 further discloses that contaminants can be in the first portion of the blood sample because of “the transfer of microbes from a bodily surface (e.g., dermally-residing microbes) dislodged during needle insertion into a patient.” CSOF ¶ 12. Bullington

#800 further discloses minimizing an amount of blood to be sequestered, explaining that the reservoir can be configured to collect “the desired amount of bodily-fluid,” which may be “the first centiliter or few centiliters of bodily-fluid” or an amount “from about 0.1 ml to about 3.0 ml” of blood. CSOF ¶ 20.

Dr. Antonsson asserts, in conclusory fashion, that these disclosures do not address the “first portion of the blood sample that is more prone to contamination and also to minimize an amount of blood to be sequestered.” Ex. 2 (Antonsson Validity Report) ¶ 208. But, as described above, Bullington #800 expressly discloses collecting the first portion of blood, which is more likely to contain contaminants including dermally residing microbes, and minimizing the amount of blood so collected. *See* CSOF ¶¶ 12, 20.

Moreover, a POSA would understand that diverting a 0.5mL to 2.0mL volume would effectively reduce false positives, while also minimizing the volume of diverted blood. *See* Ex. 7 (Meinhart Invalidity Report) ¶¶ 241, 351. This is supported by Dr. Patton’s 2010 study, which concludes that reduced blood sample contamination “may be realized with less diversion volume” than previously thought and that “ ≥ 0.5 ml and ≤ 2.0 ml is adequate diversion volume to significantly reduce contamination.” Ex. 8 (Patton 2010) at -0984-985; CSOF ¶ 22. Although Dr. Antonsson asserts that “the knowledge of a POSA does not render obvious this claim limitation,” he provides no explanation for his position, nor

does he discuss the evidence cited by Magnolia's expert. Ex. 2 (Antonsson Validity Report) ¶ 266. Dr. Patton's 2010 study is among the references cited by the #052 Patent, further confirming that a POSA would have been aware of its teachings as of Kurin's claimed priority date. CSOF ¶ 23.

5. #052 Patent Claims 12 and 24 Are Invalid Over Bullington #800, Which Discloses "Wherein the Chamber Has a Volume of Less Than 1.5 Cubic Centimeters"

Bullington #800 discloses that "the first reservoir 580 can be configured to contain from about 0.1 ml to about 3.0 ml." CSOF ¶ 20. Dr. Antonsson does not dispute that Bullington #800 discloses the elements of claim 12.

VI. CONCLUSION

For the foregoing reasons, Magnolia respectfully requests that the Court enter summary judgment that the Kurin Asserted Claims are invalid under § 102 and/or § 103.

OF COUNSEL:

Ashok Ramani
Micah G. Block
Serge A. Voronov
Elaine M. Andersen
Keon Zemoudeh
Natalie Stoecklein
Elazar Chertow
DAVIS POLK & WARDWELL LLP
900 Middlefield Road, Suite 200
Redwood City, CA 94063
(650) 752-2000

David Jiang
DAVIS POLK & WARDWELL LLP
450 Lexington Avenue
New York, NY 10017
(212) 450-4000

July 25, 2025

MORRIS, NICHOLS, ARSHT & TUNNELL
LLP

/s/ Anthony D. Raucci

Rodger D. Smith II (#3778)
Anthony D. Raucci (#5948)
1201 North Market Street
P.O. Box 1347
Wilmington, DE 19899
(302) 658-9200
rsmith@morrisnichols.com
araucci@morrisnichols.com

*Attorneys for Plaintiff Magnolia Medical
Technologies, Inc.*

CERTIFICATION OF BY COUNSEL

I hereby certify that the foregoing MAGNOLIA MEDICAL TECHNOLOGIES, INC.'S OPENING BRIEF IN SUPPORT OF ITS MOTION FOR SUMMARY JUDGMENT OF INVALIDITY OF U.S. PATENT NO. 12,138,052 UNDER 35 U.S.C. §§ 102 AND 103 complies with the type and number limitations set forth in the November 10, 2022 Standing Order. The total number of words, including introductions and footnotes, but excluding the cover page, table of contents, table of authorities, and signature page is 4,836 according to the word processing system used to compile the brief. The text of the brief is 14-point, Times New Roman.

/s/ Anthony D. Raucci

Anthony D. Raucci (#5948)

CERTIFICATE OF SERVICE

I hereby certify that on July 25, 2025, I caused the foregoing to be electronically filed with the Clerk of the Court using CM/ECF, which will send notification of such filing to all registered participants.

I further certify that I caused copies of the foregoing document to be served on July 25, 2025, upon the following in the manner indicated:

Kelly E. Farnan
Sara M. Metzler
RICHARDS, LAYTON & FINGER, P.A.
920 North King Street
One Rodney Square
Wilmington, DE 19801
Attorneys for Defendant Kurin, Inc.

VIA ELECTRONIC MAIL

Gregg F. LoCascio, P.C.
Sean M. McEldowney
Kelly Tripathi
Matthew J. McIntee
Socrates L. Boutsikaris
KIRKLAND & ELLIS LLP
1301 Pennsylvania Ave., NW
Washington, DC 20004
Attorneys for Defendant Kurin, Inc.

VIA ELECTRONIC MAIL

Sam Blake
KIRKLAND & ELLIS LLP
555 South Flower Street, Suite 3700
Los Angeles, CA 90071
Attorneys for Defendant Kurin, Inc.

VIA ELECTRONIC MAIL

Jonathan Hangartner, Esq.
X-PATENTS, APC
5670 La Jolla Blvd.
La Jolla, CA 92037
Attorneys for Defendant Kurin, Inc.

VIA ELECTRONIC MAIL

/s/ Anthony D. Raucci

Anthony D. Raucci (#5948)