

1 LYNN H. PASAHOW (CSB No. 054283) ([lpasahow@fenwick.com](mailto:lpasahow@fenwick.com))  
 CHARLENE M. MORROW (CSB No. 136411) ([cmorrow@fenwick.com](mailto:cmorrow@fenwick.com))  
 2 MICHAEL J. SHUSTER (CSB No. 191611) ([mshuster@fenwick.com](mailto:mshuster@fenwick.com))  
 PATRICK E. PREMO (CSB No. 184915) ([ppremo@fenwick.com](mailto:ppremo@fenwick.com))  
 3 CAROLYN CHANG (CSB No. 217933) ([cchang@fenwick.com](mailto:cchang@fenwick.com))  
 C. J. ALICE CHUANG (CSB No. 228556) ([achuang@fenwick.com](mailto:achuang@fenwick.com))  
 4 FENWICK & WEST LLP  
 Silicon Valley Center, 801 California Street  
 5 Mountain View, CA 94041  
 Telephone: (650) 988-8500  
 6 Facsimile: (650) 938-5200

7 CHARLES F. ROBINSON (CSB No. 113197) ([charles.robinson@ucop.edu](mailto:charles.robinson@ucop.edu))  
 P. MARTIN SIMPSON (CSB No. 122867) ([marty.simpson@ucop.edu](mailto:marty.simpson@ucop.edu))  
 8 RITA HAO (CSB No. 191693) ([rita.hao@ucop.edu](mailto:rita.hao@ucop.edu))  
 UNIVERSITY OF CALIFORNIA  
 9 1111 Franklin Street, 8th Floor  
 Oakland, CA 94607  
 10 Telephone: (510) 987-9800  
 Facsimile: (510) 987-9757

11 Attorneys for Plaintiff/Counterdefendant  
 THE REGENTS OF THE UNIVERSITY OF CALIFORNIA

12  
 13 UNITED STATES DISTRICT COURT  
 14 NORTHERN DISTRICT OF CALIFORNIA  
 15 SAN JOSE DIVISION

16 THE REGENTS OF THE UNIVERSITY OF  
 CALIFORNIA,  
 17 Plaintiff,  
 18 v.  
 19 MICRO THERAPEUTICS, INC., a Delaware  
 corporation, DENDRON GmbH, a German  
 20 corporation, and ev3 INC., a Delaware corporation,  
 21 Defendants,

22 MICRO THERAPEUTICS, INC., a Delaware  
 corporation, and DENDRON GmbH, a German  
 23 corporation,  
 24 Third Party Plaintiffs,  
 25 v.  
 26 BOSTON SCIENTIFIC CORPORATION,  
 a Delaware corporation, and TARGET  
 THERAPEUTICS, INC., a Delaware corporation,  
 27 Third Party Defendants

Case No. C 03 05669 JW (RS)

**PLAINTIFF THE REGENTS OF THE  
 UNIVERSITY OF CALIFORNIA'S  
 OPPOSITION TO DEFENDANTS' MOTION  
 IN LIMINE TO EXCLUDE REFERENCE AT  
 TRIAL TO THE PTO'S REEXAMINATION  
 OF U.S. PATENT No. 5,122,136**

Judge: Honorable James Ware  
 Date: September 7, 2007  
 Time: 9:00 a.m.  
 Place: Courtroom 8, 4th Floor

Trial date: October 16, 2007

1  
2  
3  
4  
5  
6  
7  
8  
9  
10  
11  
12  
13  
14  
15  
16  
17  
18  
19  
20  
21  
22  
23  
24  
25  
26  
27  
28

**TABLE OF CONTENTS**  
**(continued)**

	<b>Page(s)</b>
I. INTRODUCTION .....	1
II. ARGUMENT .....	2
A. Legal Standard .....	2
B. The PTO’s Reexamination Is Highly Relevant Evidence that Must Be Admitted.....	3
C. MTI’s Attempt to Exclude the Reexamination on the Grounds that It Is Incorrect Should Fail.....	5
1. The PTO Is Presumed to Have Done Its Job Correctly .....	5
a. The PTO Applied the Correct Legal Standards .....	5
(1) The PTO Reexamination Remains Probative Evidence After KSR.....	5
(2) The PTO Applied the Correct Anticipation Analysis .....	6
b. The PTO Properly Analyzed the Bari Paper .....	7
c. The PTO Was Not Bound by the Court’s Claim Construction .....	8
d. MTI Mischaracterizes the Lund Reference.....	8
2. The PTO Reexamination Does Not Need to Be Relevant to All Issues to Be Admissible .....	10
III. CONCLUSION .....	10

**TABLE OF AUTHORITIES**

1  
2  
3  
4  
5  
6  
7  
8  
9  
10  
11  
12  
13  
14  
15  
16  
17  
18  
19  
20  
21  
22  
23  
24  
25  
26  
27  
28

**Page(s)**

**Cases**

*Al-Site Corp. v. VSI Int’l, Inc.*,  
174 F.3d 1308 (Fed. Cir. 1999)..... 1, 5, 10

*American Hoist & Derrick Co. v. Sowa & Sons, Inc.*,  
725 F.2d 1350 (Fed. Cir. 1984)..... 4, 5, 10

*Arnold Partnership v. Dudas*,  
362 F.3d 1338 (Fed. Cir. 2004)..... 6

*Bayer AG v. Schein Pharm., Inc.*,  
129 F. Supp. 2d 705 (D. N.J. 2001) ..... 3, 4, 9

*Brown v. Shimano American Corp.*,  
18 U.S.P.Q. 2d 1496 (C.D. Cal. 1991)..... 3

*Celeritas Techs. v. Rockwell Int’l Corp.*,  
150 F.3d 1354 (Fed. Cir. 1998)..... 4

*Custom Accessories, Inc. v. Jeffrey-Allan Indus., Inc.*,  
807 F.2d 955 (Fed. Cir. 1986)..... 1, 3, 4

*E. I. du Pont de Nemours & Co. v. Cetus Corp.*,  
19 U.S.P.Q. 2d 1174 (N.D. Cal. 1990) ..... 5, 8

*Fresenius Med. Care Holdings, Inc. v. Baxter Int’l, Inc.*,  
No. C03-01431, 2006 U.S. Dist. LEXIS 42159 (N.D. Cal. June 12, 2006) ..... 2

*Fromson v. Advance Offset Plate, Inc.*,  
755 F.2d 1549 (Fed. Cir. 1985)..... 3

*Glaxo Group Ltd. v. Apotex, Inc.*,  
376 F.3d 1339 (Fed. Cir. 2004)..... 4

*Gould v. Control Laser Corp.*,  
705 F.2d 1340 (Fed. Cir. 1983)..... 3

*In re American Academy of Science Tech Center*,  
367 F.3d 1359 (Fed. Cir. 2004)..... 8

*In re Trans Texas Holdings Corp.*,  
No. 2006-1599 -1600, 2007 U.S. App. LEXIS 19909 (Fed. Cir. Aug. 22, 2007) ..... 1, 8

*In re Yamamoto*,  
740 F.2d 1569 (Fed. Cir. 1984)..... 8

*Interconnect Planning Corp. v. Feil*,  
774 F.2d 1132 (Fed. Cir. 1985)..... 1, 3

*KSR Int’l Co. v. Teleflex, Inc.*,  
127 S. Ct. 1727 (2007)..... 5, 6

*Liebel-Flarsheim Co v. Medrad, Inc.*,  
481 F.3d 1371 (Fed. Cir. 2007)..... 4

*Nanometrics, Inc. v. Nova Measuring Instr., Ltd.*,  
Case No. C 06-2252, 2007 U.S. Dist. LEXIS 18785 (N.D. Cal. Feb. 26, 2007)..... 3

**TABLE OF AUTHORITIES**  
**(continued)**

1  
2  
3  
4  
5  
6  
7  
8  
9  
10  
11  
12  
13  
14  
15  
16  
17  
18  
19  
20  
21  
22  
23  
24  
25  
26  
27  
28

**Page(s)**

*PharmaStem Therapeutics, Inc. v. Viacell, Inc.*,  
491 F.3d 1342 (Fed. Cir. 2007)..... 4

*Prima Tek II, L.L.C. v. Polypap, S.A.R.I.*,  
412 F.3d 1284 (Fed. Cir. 2005)..... 4

*Takeda Chem. Indus., Inc. v. Alphapharm Pty., Ltd.*,  
83 U.S.P.Q. 2d 1169 (Fed. Cir. 2007)..... 6

*United States v. Dennis*,  
625 F.2d 782 (8th Cir. 1980)..... 2

*United States v. Marrero-Ortiz*,  
160 F.3d 768 (1st Cir. 1998)..... 2

*United States v. Mende*,  
43 F.3d 1298 (9th Cir. 1995)..... 2

*United States v. Patterson*,  
819 F.2d 1495 (9th Cir. 1987)..... 2

**Rules**

Federal Rule of Evidence 403..... 2

FENWICK & WEST LLP  
ATTORNEYS AT LAW  
MOUNTAIN VIEW

1 **I. INTRODUCTION**

2 MTI's motion *in limine* to exclude reference to the PTO's reexamination of the '136  
3 patent is unsupported by law. MTI does not cite a single case in which evidence of a PTO's  
4 completed reexamination is excluded. Indeed, it is well-established that a court *must* consider a  
5 PTO examiner's decision on reexamination in determining whether the party asserting invalidity  
6 has met its statutory burden by clear and convincing evidence. *Custom Accessories, Inc. v.*  
7 *Jeffrey-Allan Indus., Inc.*, 807 F.2d 955, 961 (Fed. Cir. 1986), *citing Interconnect Planning Corp.*  
8 *v. Feil*, 774 F.2d 1132, 1139 (Fed. Cir. 1985). This law alone compels denial of MTI's motion.

9 MTI nevertheless argues that the reexamination should be excluded, claiming that the  
10 PTO made legal and factual errors during reexamination. MTI once again ignores the law. The  
11 PTO is presumed to have performed its duties properly. *Al-Site Corp. v. VSI Int'l, Inc.*, 174 F.3d  
12 1308, 1323 (Fed. Cir. 1999). Part of MTI's burden of proving invalidity by clear and convincing  
13 evidence is the burden of overcoming this presumption. *Id.* (stating that the statutory  
14 presumption of validity carries with it the presumption that the PTO has done its job). Thus,  
15 MTI's arguments go to the weight of the reexamination evidence at trial, and not the admissibility  
16 of the reexamination record.

17 Furthermore, MTI's claims of error by the PTO are without merit. For example, MTI  
18 claims the PTO erred in finding the '136 claims patentable over the Bari paper. Yet this Court  
19 has also found that the Bari paper does not anticipate the '136 patent claims. *See* August 24,  
20 2007 Order Denying MTI's Motion for Partial Summary Judgment of Invalidity of the Patents in  
21 Suit Under 35 U.S.C. § 102 [Docket No. 876] ("Anticipation SJ Order") at 7:27. MTI also claims  
22 the PTO erred in not applying the Court's claim construction. MTI's suggestion is based solely  
23 on its unsupported belief regarding the examiner's mental processes. In fact, the existence of the  
24 claim construction to date was called out to the examiner. *See* Anstaett Decl., Ex. 4 at 2.  
25 Moreover, the law is clear that the PTO is not bound by a court's construction during its  
26 proceedings; it must give claims their broadest possible interpretation. *In re Trans Texas*  
27 *Holdings Corp.*, No. 2006-1599 -1600, 2007 U.S. App. LEXIS 19909, at \*8, \*15-23 (Fed. Cir.  
28 Aug. 22, 2007). Finally, MTI argues that the PTO's findings are contrary to Dr. Nesbit's

1 purported admission that the Lund reference anticipates claim 1 of the '136 patent. But MTI  
2 mischaracterizes deposition testimony to fabricate an admission where none exists.

3 None of MTI's tenuous arguments overcome the great weight of authority emphasizing  
4 the relevance of the PTO's reexamination proceedings. Accordingly, The Regents respectfully  
5 requests that this Court deny MTI's motion *in limine* to exclude reference to the PTO's  
6 reexamination of the '136 patent.

7 **II. ARGUMENT**

8 **A. Legal Standard**

9 Federal Rule of Evidence 403 is “an extraordinary remedy to be used sparingly because  
10 it permits the trial court to exclude otherwise relevant evidence.” *United States v. Mende*, 43  
11 F.3d 1298, 1302 (9th Cir. 1995), *citing United States v. Patterson*, 819 F.2d 1495, 1505 (9th Cir.  
12 1987). To exclude the PTO's reexamination of the '136 patent under this rule, MTI must show  
13 that the probative value of the reexamination is substantially outweighed by the danger of unfair  
14 prejudice. Fed. R. Evid. 403. MTI cannot make this showing with its claims of prejudice. In  
15 weighing the probative value against the risk of unfair prejudice, courts generally strike the  
16 balance in favor of admission. *Fresenius Med. Care Holdings, Inc. v. Baxter Int'l, Inc.*, No. C  
17 03-01431, 2006 U.S. Dist. LEXIS 42159, at \*14 (N.D. Cal. June 12, 2006), *citing United States v.*  
18 *Dennis*, 625 F.2d 782, 797 (8th Cir. 1980).

19 MTI attempts to diminish the probative value of the '136 patent reexamination and  
20 fabricates unfair prejudice by arguing that the PTO's reexamination was flawed. MTI's  
21 arguments are contrary to law, which recognizes both the highly probative nature of the PTO's  
22 findings on reexamination and the presumption that the PTO performed its duties correctly.  
23 Under the prevailing law, MTI has not and cannot show any unfair prejudice. All evidence is  
24 meant to be prejudicial to one side or the other; it is only *unfair* prejudice against which Rule 403  
25 protects. *United States v. Marrero-Ortiz*, 160 F.3d 768, 774 (1st Cir. 1998). Accordingly, MTI's  
26 motion *in limine* to exclude reference to the PTO's reexamination of the '136 patent should be  
27 denied.

1           **B. The PTO's Reexamination Is Highly Relevant Evidence that Must Be**  
2           **Admitted**

3           Controlling Federal Circuit authority establishes both the relevance of a reexamination  
4 proceeding and the necessity of its admission. One of the purposes of the reexamination  
5 procedure is to facilitate trial by providing the district court with the expert view of the PTO.  
6 *Gould v. Control Laser Corp.*, 705 F.2d 1340, 1342 (Fed. Cir. 1983); *Nanometrics, Inc. v. Nova*  
7 *Measuring Instruments, Ltd.*, No. C 06-2252, 2007 U.S. Dist. LEXIS 18785, at \*7 (N.D. Cal. Feb.  
8 26, 2007); *Brown v. Shimano American Corp.*, 18 U.S.P.Q. 2d 1496 (C.D. Cal. 1991)  
9 (“reexamination by the PTO when issues relevant to prior art are involved is especially helpful  
10 given the PTO’s expertise”). Evidence concerning the reexamination proceeding is particularly  
11 relevant in this case where, in the reexamination, the examiner considered all but four of the  
12 eighteen references MTI now claims it will raise at trial.

13           Not only is the reexamination evidence highly probative, the Federal Circuit has held  
14 repeatedly that a PTO examiner’s decision on reexamination is “evidence the court *must* consider  
15 in determining whether the party asserting invalidity has met its statutory burden by clear and  
16 convincing evidence.” *Custom Accessories*, 807 F.2d at 961 (emphasis added), *citing*  
17 *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 1139 (Fed. Cir. 1985); *Fromson v. Advance*  
18 *Offset Plate, Inc.*, 755 F.2d 1549, 1555 (Fed. Cir. 1985). It is reversible error not to give “any  
19 credence to the PTO reexamination proceeding.” *Custom Accessories*, 807 F.2d at 961 (reversing  
20 judgment of invalidity where reexamination upholding claims over much of the same art that was  
21 presented before the district court was not considered); *see also Bayer AG v. Schein Pharm., Inc.*,  
22 129 F. Supp. 2d 705, 714-15 (D. N.J. 2001) (discussing *Custom Accessories* and holding that “the  
23 Court must examine what issues were presented to the PTO on reexamination and what  
24 conclusions the PTO reached on those issues”).

25           Furthermore, consideration of the PTO’s confirmation of all claims of the ’136 patent  
26 upon reexamination informs MTI’s burden of proving invalidity. The burden of proving  
27 invalidity by clear and convincing evidence is “especially difficult” when the defendant attempts  
28 to rely on prior art that was before the patent examiner during prosecution or reexamination.

1 *Glaxo Group Ltd. v. Apotex, Inc.*, 376 F.3d 1339, 1348 (Fed. Cir. 2004); *Custom Accessories*, 807  
2 F.2d at 961; *American Hoist & Derrick Co. v. Sowa & Sons, Inc.*, 725 F.2d 1350, 1360 (Fed. Cir.  
3 1984). That is because the PTO's conclusions must be considered as evidence of validity. *Bayer*,  
4 129 F. Supp. 2d at 714.

5 Accordingly, since the reexamination proceeding is highly probative on the issues and  
6 prior art considered during reexamination, and since reexamination proceedings should be  
7 considered in conducting an invalidity analysis, MTI's motion to exclude such evidence should  
8 be denied.

9 MTI cites no law to the contrary. Instead, MTI cites only cases holding that PTO  
10 decisions are not conclusive and a fact finder must conduct its own independent analysis of  
11 patentability. *See* MTI's Motion at 7:1-22. That a PTO's finding of patentability is not  
12 conclusive does not mean it is not probative or admissible. Indeed, the cases on which MTI relies  
13 give due consideration to the PTO's findings in determining patentability. *See Celeritas Techs. v.*  
14 *Rockwell Int'l Corp.*, 150 F.3d 1354, 1360-61 (Fed. Cir. 1998) (recognizing that burden of  
15 proving invalidity is especially difficult when the prior art was before the PTO in addressing  
16 prosecution history evidence); *PharmaStem Therapeutics, Inc. v. Viacell, Inc.*, 491 F.3d 1342,  
17 1366 (Fed. Cir. 2007) (discussing the PTO's examiner's findings on reexamination in conducting  
18 invalidity analysis); *see also Liebel-Flarsheim Co v. Medrad, Inc.*, 481 F.3d 1371, 1381 (Fed. Cir.  
19 2007) (recognizing that burden of showing invalidity is especially difficult when the prior art  
20 reference was before the examiner during prosecution); *Prima Tek II, L.L.C. v. Polypap, S.A.R.I.*,  
21 412 F.3d 1284, 1287 (Fed. Cir. 2005) (acknowledging that prior art reference was before  
22 examiner during prosecution). Thus, the law makes clear that although a district court is not  
23 required to follow the findings of the PTO, it is required to consider them. MTI has not shown  
24 otherwise, and its motion *in limine* to exclude reference to the '136 patent reexamination should  
25 be denied.

1           **C.     MTI’s Attempt to Exclude the Reexamination on the Grounds that It Is**  
2           **Incorrect Should Fail**

3                     **1.     The PTO Is Presumed to Have Done Its Job Correctly**

4           MTI next suggests that the reexamination proceedings in this case are so legally and  
5 analytically flawed that their admission would cause jury confusion and undue prejudice. MTI’s  
6 argument is an improper attempt to relieve itself of its burden of proof in this case. As a matter of  
7 law, PTO examiners are presumed to perform their duties correctly. *Al-Site Corp. v. VSI Int’l,*  
8 *Inc.*, 174 F.3d 1308, 1323 (Fed. Cir. 1999); *American Hoist*, 725 F.2d 1350, 1359 (Fed. Cir.  
9 1984) (stating that the presumption of validity is based on the “basic proposition that a  
10 government agency such as the then PTO is presumed to do its job”). That is why a challenger’s  
11 burden of proving invalidity by clear and convincing evidence is especially difficult when the  
12 prior art was before the PTO examiner. *Al-Site Corp.*, 174 F.3d at 1323. “When an attacker  
13 simply goes over the same ground travelled by the PTO, part of the *burden* is to show that the  
14 PTO was wrong in its decision.” *American Hoist*, 725 F.2d at 1360 (emphasis in original).

15           Therefore, it is part of MTI’s burden at trial to prove that the PTO was wrong in its  
16 decision to uphold the ’136 patent claims on reexamination. *See id.*; *see also E. I. du Pont de*  
17 *Nemours & Co. v. Cetus Corp.*, 19 U.S.P.Q. 2d 1174, 1179 (N.D. Cal. 1990). The arguments  
18 MTI makes now address the weight of the evidence, not its admissibility. Therefore, MTI offers  
19 no grounds justifying exclusion of the reexamination.

20           In addition, MTI’s specific claims of error by the PTO are unsupported by law or fact, and  
21 do not substantially outweigh the probative value of the PTO’s findings on reexamination.

22                     **a.     The PTO Applied the Correct Legal Standards**  
23                             **(1)    The PTO Reexamination Remains Probative Evidence**  
24                                     **After KSR**

25           MTI first argues that the PTO’s reexamination decision should be excluded because the  
26 examiner did not apply the obviousness standard articulated in *KSR Int’l Co. v. Teleflex, Inc.*, 127  
27 S. Ct. 1727 (2007). *See* MTI’s Motion at 8:24-10:12. MTI’s experts never opined on the  
28 correctness of the PTO’s reexamination of the ’136 patent. Specifically, MTI’s patent law expert

1 offered no opinions that the PTO examiner committed any error during the reexamination.<sup>1</sup> MTI  
2 should be precluded from doing so now.

3 Moreover, MTI's reliance on *Arnold Partnership v. Dudas*, 362 F.3d 1338, 1340 (Fed.  
4 Cir. 2004), to argue that application of an incorrect legal standard entitles the PTO to no  
5 deference is misplaced. *Arnold Partnership* involved a patent owner's challenge of the PTO's  
6 denial of patent term extension under the Administrative Procedure Act (APA), a decision which  
7 was ultimately upheld. *Id.* at 1340, 1343. As an action under the APA, the case did not address  
8 the deference due, or admissibility of, PTO reexamination proceedings. Thus, it has no  
9 application here.

10 In any event, MTI admits that the PTO examiner applied the correct obviousness standard  
11 in effect at the time of the reexamination. *See* MTI's Motion at 9:14-16. Its only complaint is  
12 that *KSR* issued subsequent to the reexamination. The PTO's findings with respect to the prior art  
13 are still probative of the obviousness inquiry, however, even under the *KSR* standard. *See*  
14 *Takeda Chem. Indus., Inc. v. Alphapharm Pty., Ltd.*, 83 U.S.P.Q. 2d 1169, 1173-74 (Fed. Cir.  
15 2007) (reviewing evidence presented in district court and upholding pre-*KSR* verdict of  
16 nonobviousness where trial court's analysis was not inconsistent with *KSR*). Meanwhile, the risk  
17 of jury confusion is low. All parties acknowledge that the PTO's findings are not conclusive.  
18 The jury will be instructed to apply the obviousness standard set forth in *KSR* in conducting its  
19 own independent obviousness analysis. The PTO reexamination is evidence that the jury should  
20 consider in conducting that analysis.

21 **(2) The PTO Applied the Correct Anticipation Analysis**

22 MTI also argues that the PTO applied an incorrect anticipation standard in finding that the  
23 Bari paper did not anticipate the claims of the '136 patent. MTI focuses on the PTO's findings  
24 that Bari's breaking off of the electrode tip was a failure of the experiments and did not teach the  
25 method claimed in the '136 patent. Such findings, MTI argues, is at odds with law that states  
26 anticipation cannot be avoided simply because the prior art experiment was a failure. *See* MTI's

27 \_\_\_\_\_  
28 <sup>1</sup> The Regents will be filing a motion *in limine* to address in detail MTI's patent law expert's  
failure to offer any opinions on the reexamination of the '136 patent. That motion will seek to  
preclude him from offering any opinions at trial regarding the reexamination proceedings.

1 Motion at 10:15-11:11. MTI misapprehends the PTO’s findings and the requirements of the ’136  
2 patent. Anticipation was not avoided simply because the Bari experiments were a failure;  
3 anticipation was avoided because the Bari paper did not teach all the steps of the claimed method.

4 Indeed, this Court has already rejected MTI’s arguments, agreeing with the PTO that the  
5 Bari paper does not anticipate the ’136 patent claims. *See* Anticipation SJ Order at 4:18-7:27.  
6 The method claimed in the ’136 patent requires the step of “detaching said distal tip.” *See* ’136  
7 patent at col. 9:14-16. This inventive step requires that “manipulative steps” be taken for the  
8 purpose of detaching the tip. Anticipation SJ Order at 7:1-2. Applying the proper legal standard,  
9 both the PTO examiner and this Court found that the Bari paper does not teach a manipulative  
10 step taken for the purposes of detaching the tip. *See id.* at 7:23-27; Anstaett Decl., Ex. 6 at 4  
11 (“Why the tip broke off is speculation and the break off appears from reading the reference in  
12 total a failure of three of the fifteen case study.”). Therefore, there was no legal error in the  
13 PTO’s reexamination of the ’136 patent, and this Court should deny MTI’s motion to exclude  
14 evidence of the reexamination.

15 **b. The PTO Properly Analyzed the Bari Paper**

16 MTI next argues that the reexamination should be excluded because the examiner failed to  
17 explain coherently why the Bari paper does not anticipate claim 1 of the ’136 patent. MTI’s  
18 Motion at 11:14-12:26. MTI does so by mischaracterizing the deposition testimony of Mr.  
19 Nusbaum, The Regents’ patent law expert. *Id.* at 12:1-15. Mr. Nusbaum did not testify that the  
20 PTO’s conclusion was incoherent or flawed. When asked what he believed the examiner thought  
21 was missing from the Bari paper, Mr. Nusbaum testified that:

22 We know – we know for sure that – that even – that the examiner  
23 indicates that [the Bari paper] does disclose insertion of a metal  
24 electrode into an aneurysm, application of a current, breaking off of  
25 the electrode tip.

26 And one might infer from that that the – that which is required by  
27 the detaching step of leaving the distal tip within the vascular cavity  
28 is not shown ...

26 Anstaett Decl., Ex. 5 at 156:24-158:11. In fact, Mr. Nusbaum testified that “we know for sure  
27 that the examiner concluded that this – the methodology that’s referred to in claim 1 was neither  
28 disclosed, taught or suggested with respect to the claimed invention in claim 1.” *Id.* at 157:5-8.

1                    **c.        The PTO Was Not Bound by the Court’s Claim Construction**

2                    MTI goes on to argue that the PTO’s failure to apply the Court’s claim construction  
3 justifies exclusion of the reexamination. This too is contrary to law. The Federal Circuit has  
4 rejected the notion that the PTO, in the course of reexamination proceedings, is bound by a  
5 court’s claim construction. *In re Trans Texas Holdings Corp.*, No. 2006-1599 -1600, 2007 U.S.  
6 App. LEXIS 19909, at \*8, \*15-23 (Fed. Cir. Aug. 22, 2007). In so doing, the Federal Circuit  
7 confirmed the well-established principle that “[c]laims are given ‘their broadest reasonable  
8 interpretation, consistent with the specification, in reexamination proceedings.’” *Id.* at \*20, *citing*  
9 *In re Yamamoto*, 740 F.2d 1569, 1571 (Fed. Cir. 1984); *see also In re American Academy of*  
10 *Science Tech Center*, 367 F.3d 1359, 1364 (Fed. Cir. 2004). The fact the ’136 patent claims  
11 survived reexamination in light of the PTO’s broader interpretation of claims further speaks to the  
12 highly probative nature of the reexamination. *See Cetus*, 19 U.S.P.Q. 2d at 1179. Rather than  
13 exclusion, MTI’s arguments further support inclusion of evidence of the reexamination.

14                    **d.        MTI Mischaracterizes the Lund Reference**

15                    MTI also argues the PTO examiner erred in failing to reject claim 1 of the ’136 patent  
16 over the Lund reference. MTI’s Motion at 13:3-14:5. To support this argument, MTI clips  
17 together incomplete and out of context excerpts of the deposition testimony of Dr. Nesbit, The  
18 Regents’ technical expert. Specifically, MTI cites only a portion of Dr. Nesbit’s response to  
19 claim that Lund teaches endovascularly disposing a guidewire:

20                    Q. And does it teach endovascularly disposing a guidewire near an  
                         endovascular opening into the vascular cavity?

21                    A. Yes.

22                    MTI’s Motion at 13:13-15, *citing* Anstaett Decl., Ex. 7 at 61:17-20. MTI does not include Dr.  
23 Nesbit’s complete response, however. In fact, Dr. Nesbit’s full response reveals that he did not  
24 understand the Lund reference to teach endovascularly disposing a guidewire:

25                    Q. And does it teach endovascularly disposing a guidewire near an  
                         endovascular opening into the vascular cavity.

26                    A. Yes. *Well, I mean it’s really not a guidewire, though. It’s*  
27 *really a coil.*

28                    Anstaett Decl., Ex. 7 at 61:17-22 (emphasis added). Dr. Nesbit went on to explain his testimony,

1 stating that Lund discloses endovascularly disposing a guidewire *only if* the guidewire is  
2 construed to be the coil:

3 Q. Okay. So that's endovascularly disposing that guidewire into  
4 the cavity that you want to fit?

5 A. If you construe the guidewire to be the coil, including the coil,  
6 that would fit into that, yes.

7 *Id.* at 63:19-22. Dr. Nesbit, however, did not understand the coil to be the guidewire or the distal  
8 tip of the guidewire:

9 Q. ... And the coil would constitute the distal tip of the guidewire  
10 in the Lund device, correct? There's a guidewire and then at the tip  
11 there's a coil, correct?

12 A. But they're separate. They're just screwed together.

13 Q. I understand they're screwed together, but until they're  
14 detached, it's one – it's one piece, correct?

15 A. Yeah. I guess they're interconnected, yes, with the screw-on  
16 portion.

17 Q. Okay. And the screw-on portion is the distal tip, correct?

18 A. No.

19 Anstaett Decl., Ex. 7 at 61:17-22, 62:8-20. Therefore, a review of the complete record shows that  
20 there was no concession by Dr. Nesbit that the Lund reference anticipates claim 1 of the '136  
21 patent.

22 MTI's suggestion that the PTO examiner missed the Lund reference due to the volume of  
23 references submitted on reexamination is also without merit. The PTO examiner specifically  
24 acknowledged his review of the Lund reference in the Information Disclosure Statement  
25 submitted during reexamination. *See* Declaration of Carolyn Chang in Support of Opposition to  
26 Motion *In Limine* to Exclude Reference to Reexamination, Ex. A. Moreover, the law presumes  
27 that an examiner reviewed and considered all materials submitted during reexamination. *Bayer*,  
28 129 F. Supp. 2d at 715 (refusing to discount the voluminous materials submitted during  
reexamination and finding the examiner properly considered all references submitted during  
reexamination notwithstanding the fact that the examiner did not expressly dispose of those issues  
in her written response). Whatever MTI or any expert may argue regarding the Lund reference,

