

UNITED STATES PATENT AND TRADEMARK OFFICE

---

BEFORE THE PATENT TRIAL AND APPEAL BOARD

---

**ST. JUDE MEDICAL, CARDIOLOGY DIVISION, INC.**  
Petitioner

v.

**VOLCANO CORPORATION**  
Patent Owner

---

Case IPR2013-00258 (JL)  
Patent 7,134,994

---

Before JAMESON LEE, JOSIAH C. COCKS, and SCOTT E. KAMHOLZ,  
*Administrative Patent Judges.*

LEE, *Administrative Patent Judge.*

DECISION

St. Jude Motion to Make Non-Electronic Filing  
*37 C.F.R. § 42.6(b)*

Petitioner, St. Jude Medical, Cardiology Division, Inc. (“St. Jude”) filed a petition for *inter partes* review of Patent 7,134,994. Together with the petition, St. Jude filed a motion for authorization to file 7 exhibits (Exhibits 1063, 1065,

1069, 1132, 1142, 1143, and 1145) non-electronically. St. Jude filed by overnight delivery two DVD disks containing those seven exhibits.

Per 37 C.F.R. § 42.6(b), unless otherwise authorized, submissions to the Board are to be made electronically.

These are the exhibits identified by St. Jude for filing non-electronically:

Ex #	Exhibit Description
1063	PEICoreDisp.dll (via the decompiled file PEICoreDisp.c).
1065	Copy of both the NIDAQNT.sys driver version 4.9.0 and the complete 6.9.1 driver distribution package.
1069	Windows NT 4.0 version of device driver for the SMC 8432 Ethernet card (smcpwrn.sys).
1132	Source Code for the Main Application Software installed on the CPU in EP-WorkMates ("Byrd Decl., Ex. Q").
1142	SmartFlow Source Code ("Barak Lit Decl., Ex. 19").
1143	SmartFlow Source Code (Demo Version) ("Barak Lit Decl., Ex. 20").
1145	Video of Phil Lonbeck Prucka Session.

According to St. Jude, the above-identified exhibits consist of source or disassembled code (Exhibits 1063, 1065, 1069, 1132, 1142, and 1143) and a video file (Exhibit 1145). In that regard, St. Jude states (Motion 2:16-17):

**These files cannot be rendered as PDF files in a practical manner.** For example, Ex. 1063 when printed to PDF resulted in access of 2000 pages before printing was canceled. Some of the exhibits (e.g. Exs. 1065, 1132, 1142, 1143 and 1145), although they represent a single concept (such as the source code for a product) actually comprise multiple files. The total number of files is over 3800, which if individually assigned exhibit numbers would exceed the highest exhibit number allotted to petitioners (1999). For these reasons, the Petitioner has submitted the Exhibits on DVDs having directories labeled by the Exhibit numbers. Each of the exhibits is also the subject of a motion to seal, filed herewith.

(Emphasis added.)

The Board's electronic filing system, *i.e.*, PRPS ("Patent Review Processing System") accepts only files stored in PDF or MPEG format. Converting files to one of the two acceptable formats is something every party is required to do for electronic filing. We understand that St. Jude is having some difficulty in converting one of its exhibits into PDF, *i.e.*, Exhibit 1063, and represents that it has over 3800 files to upload. However, St. Jude's motion is not sufficiently specific.

The motion does not describe specifically the contents of each exhibit, in terms of the type, size, and number of files, and it does not describe what options remain at its disposal for converting the exhibits into an acceptable format, *e.g.*, using a commercial service. The motion also assumes that St. Jude's experience with Exhibit 1063 would be repeated if an attempt is made to convert the other exhibits to PDF format. There are few facts represented in the motion.

Based on the motion, we do not know if the conversion to PDF or MPEG format is impossible, or if possible, at what cost. St. Jude simply represents that conversion is impractical. But it is St. Jude who desires and relies on the benefit afforded by these exhibits. Some level of impracticality is not an unreasonable trade-off for the benefit provided thereby. St. Jude should demonstrate that it would be prejudiced unfairly in this proceeding unless it is permitted to file these seven exhibits non-electronically. That, it has not done.

In any event, St. Jude has not indicated what tool or tools are required to open the files it submitted via the DVDs. The Board cannot accept for filing files which cannot be opened and viewed by the Board's computer equipment. At least one computer used by the panel is unable to open many files on the DVDs.

For the foregoing reasons, it is

**ORDERED** that St. Jude's motion to be relieved from the requirement of electronic filing, for Exhibits 1063, 1065, 1069, 1132, 1142, 1143, and 1145, is dismissed, without prejudice for renewal; and

**FURTHER ORDERED** that any renewed motion by St. Jude to be relieved from the requirement of electronic filing via PRPS, for Exhibits 1063, 1065, 1069, 1132, 1142, 1143, and 1145, should be filed within ten (10) days of the date of this communication.

IPR2013-00258  
Patent 7,134,994

For PETITIONER:

Matthew Smith  
Glen Law  
Foley & Lardner LLP  
[MSmith-PRPS@foley.com](mailto:MSmith-PRPS@foley.com)  
[glaw@foley.com](mailto:glaw@foley.com)

For PATENT OWNER

Haynes and Boone, LLP  
2323 Victory Avenue  
Suite 700  
Dallas, Texas 75219

and

Leydig, Voit, & Mayer, Ltd.  
Two Prudential Plaza, 4900  
Chicago, Il 60601-6780