

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MEDTRONIC, INC., AND MEDTRONIC VASCULAR, INC.
Petitioners,

v.

TELEFLEX INNOVATIONS S.A.R.L.
Patent Owner.

Case IPR2020-0126, IPR2020-0127
U.S. Patent No. 8,048,032

**PATENT OWNER RESPONSE TO PETITIONER'S EXPLANATION OF
MATERIAL DIFFERENCES BETWEEN PETITIONS AND PETITION
RANKING FOR U.S. PATENT NO. 8,048,032**

Petitioners Medtronic, Inc. and Medtronic Vascular, Inc. (collectively “Medtronic”) filed two separate petitions against the ’032 patent, challenging a total of only 21 claims.

Medtronic’s strategic choice to rely on a section 102(e) reference does not justify institution of multiple petitions. Medtronic contends it needs two petitions because Teleflex is asserting an invention date that pre-dates the Itou reference (Ex. 1007). Paper 3 at 1-3. Teleflex did invent before the priority date of Itou. Indeed, Itou’s prior art status is at issue in the parallel district court litigation, and Medtronic was aware of substantial corroborated evidence showing Teleflex’s prior invention before it filed its Petitions. Nevertheless, Medtronic chose to rely on a § 102(e) reference and did *not even try to address* the issue of Teleflex’s invention date in its Petitions. Thus, this is not one of the “rare” cases in which “two petitions by a petitioner may be needed.” November 2019 Consolidated Trial Practice Guide (“TPG”) at 59. Where, as here, a Petitioner proceeds with filing petitions relying on a primary reference that it knows full-well is likely to be antedated, multiple petitions are not justified.

Medtronic cites *Microsoft Corp. v. IPA Techs Inc.*, IPR2019-00810, Paper 12 (PTAB Oct. 16, 2019). See Paper 3 at 2. But *Microsoft* was different. First, the petitioner in *Microsoft* explained that the “main difference” between its petitions was that each petition challenged different claims. *Microsoft*, IPR2019-

00810, Paper 12 at 12. Thus, denying one of the petitions would completely eliminate the petitioner's opportunity to challenge those claims. Here, in contrast, Medtronic filed two petitions attacking the *same* claims based on different references. Second, while Medtronic is correct that there was a potential dispute about the priority date of Microsoft's Kiss reference, the petitioner explained that "the same analysis of the combination of Kiss/FIPA97 is the basic prior art challenge to every claim in each petition." *Id.* Paper 9 at 1-2 (emphasis added). Thus, if the Kiss reference was found to not qualify as prior art, all of the petitions would fail. Consequently, the petitioner's filing of multiple petitions was clearly not intended to provide a "back-up" petition because of a potential priority issue.

Medtronic's reliance on *Microsoft* is inapt. Indeed, the Board routinely declines to institute multiple petitions, even where there is a priority date dispute. *See, e.g., Comcast Cable Commc'ns, LLC v. Rovi Guides, Inc.*, IPR2019-01354, Paper 10 at 6 (PTAB Jan. 27, 2020) (denying institution of two of three petitions where a potential priority dispute existed); *Dropbox, Inc. v. Whitserve LLC*, IPR2019-01018, Paper 13 at 8-9 (PTAB Nov. 1, 2019) (denying institution of a second petition where parties disputed the priority date of multiple prior art references); *Comcast Cable Commc'ns, LLC v. Rovi Guides, Inc.*, IPR2019-00279, Paper 10 at 6-7 (PTAB July 1, 2019) (declining to institute four of five filed petitions where a potential priority dispute existed).

Medtronic’s strategic choice to include excessive, duplicative challenges to the same claims does not justify institution of four petitions. Medtronic contends that the number and length of the claims requires two petitions. Paper 3 at 3-4. But here, the Petitions challenge only a total of 21 claims. This is hardly an unusually high number. Medtronic’s contention that it could not fit all arguments into a single petition is a problem it created itself by failing to judiciously select and streamline its strongest arguments. Again, Medtronic’s reliance on *Microsoft* is inapposite. *Microsoft* concerned five petitions challenging **89 claims**; here Medtronic uses two petitions to challenge only **21 claims**. See *Microsoft*, IPR2019-00810, Paper 12 at 14. Medtronic’s deliberate drafting choices do not reasonably justify its choice to pursue an overly burdensome, inefficient, and unfairly duplicative attack on the ‘032 patent. See, e.g., *Pfenex, Inc. v. GlaxoSmithKline Biologicals SA*, IPR2019-01027, P12 at 13-14 (PTAB Nov. 13, 2019) (“[T]he mere fact that Petitioner may have had additional art to assert, including a different statutory basis for asserting that art, does not, on these facts, justify the additional burden of a second petition directed to the same claims.”).

Instituting both petitions will result in inefficiency and unfairness. As discussed above, Medtronic is aware that Teleflex intends to swear behind Itou, and parallel district court litigation addressing this issue is ongoing. Concurrent adjudication of these issues before the district court and the Board will result in

duplicative work, unnecessary and counterproductive litigation costs, the possibility of inconsistent decisions, and will not promote the efficient administration of the Office or the integrity of the patent system. *See* TPG at 56 (the Director must consider “the effect of any such regulation [under this section] on the economy, the integrity of the patent system, the efficient administration of the Office, and the ability of the Office to timely complete proceedings instituted under this chapter”). For the reasons set forth in Patent Owner’s Preliminary Responses to Petitions,¹ the Board should deny both petitions. However, if the Board is inclined to institute trial on one of the petitions, institution on only the Kontos-based petition (IPR2020-0127) would avoid at least some of these inefficiencies.

¹ Patent Owner is filing a Preliminary Response in IPR2020-0126 concurrently herewith, and intends to file a Preliminary Response in IPR2020-0127 before the deadline provided in 37 C.F.R. 42.107(b).

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