

1 UNITED STATES PATENT AND TRADEMARK OFFICE
2 BEFORE THE PATENT TRIAL AND APPEAL BOARD

3 MEDTRONIC, INC., and
4 MEDTRONIC VASCULAR, INC.,

5 Petitioners,

6 vs.

Case No. IPR2020-00126

U.S. Patent No. 8,048,032

7 TELEFLEX INNOVATIONS
8 S.A.R.L.,

Patent Owner.

9
10 IPR2020-00126 (Patent 8,048,032 B2)
11 IPR2020-00127 (Patent 8,048,032 B2)
12 IPR2020-00128 (Patent RE45,380 E)
13 IPR2020-00129 (Patent RE45,380 E)
14 IPR2020-00130 (Patent RE45,380 E)
15 IPR2020-00132 (Patent RE45,760 E)
16 IPR2020-00134 (Patent RE45,760 E)
17 IPR2020-00135 (Patent RE45,776 E)
18 IPR2020-00136 (Patent RE45,776 E)
19 IPR2020-00137 (Patent RE47,379 E)
20 IPR2020-00138 (Patent RE47,379 E)

21 TRANSCRIPT OF TELEPHONIC PROCEEDINGS

22 DATE: January 5, 2021

23 TIME: 10:00 a.m. CST

24 PLACE: Minneapolis, Minnesota

(via teleconference)

25 JOB NO.: MW 4394062

REPORTED BY: Dawn Workman Bounds, CSR

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<p style="text-align: right;">Page 2</p> <p>1 APPEARANCES 2 (ALL APPEARANCES VIA TELECONFERENCE) 3 ADMINISTRATIVE PATENT JUDGES 4 Christopher G. Paulraj 5 Sheridan K. Snedden 6 Jon B. Tornquist 7 8 ON BEHALF OF PETITIONERS: 9 CYRUS A. MORTON, ESQ. 10 CHRISTOPHER PINAHS, ESQ. 11 SHARON ROBERG-PEREZ, ESQ. 12 ROBINS KAPLAN LLP 13 2800 LaSalle Plaza 14 800 LaSalle Ave 15 Minneapolis, MN 55401 16 612.349.8500 17 camorton@rkmc.com 18 cpinahs@robinskaplan.com 19 sroberg-perez@robinskaplan.com 20 21 ON BEHALF OF PATENT OWNER: 22 23 DEREK VANDENBURGH, ESQ. 24 PETER KOHLHEPP, ESQ. 25 CARLSON CASPERS VANDENBURGH & LINDQUIST, PA. Capella Tower, Suite 4200 225 South Sixth Street Minneapolis, MN 55402 612.436.9623 dvandenburgh@carlsoncaspers.com pkohlhepp@carlsoncaspers.com</p>	<p style="text-align: right;">Page 4</p> <p>1 guidance on petitioner's arguments in its reply, that 2 patent owner violated the limitation on incorporation by 3 reference. 4 And then we have the December 30th request 5 from patent owner requesting a Motion to Strike 6 Petitioner's Reply Briefs, or at least portions thereof. 7 And I showed them this in the beginning. 8 Let's actually start with roll call. 9 Who do we have on the line for patent 10 owner, and then who do we have on the line for 11 petitioner? 12 MR. VANDENBURGH: Your Honor, for patent 13 owner, this is Derek Vandenburg of the Carlson Caspers 14 firm, and also on the call is Peter Kohlhepp of our firm. 15 JUDGE PAULRAJ: All right. Thank you, 16 Mr. Vandenburg. 17 And who do we have for petitioner? 18 MR. MORTON: Your Honor, for petitioner 19 this is Cy Morton, and with me also on the line is Chris 20 Pinahs and Sharon Roberg-Perez. 21 And just to preview, Your Honor, usually I 22 do the talking; but I'm just going to handle this first 23 issue; and the motion to strike issue, Mr. Pinahs is 24 going to handle. 25 JUDGE PAULRAJ: All right. Thank you,</p>
<p style="text-align: right;">Page 3</p> <p>1 PROCEEDINGS 2 JUDGE PAULRAJ: This is Judge Paulraj of 3 the Patent Trial and Appeal Board, and with me on the 4 line I have judges Tornquist and Snedden. This is a 5 conference call and in a series of IPRs: IPR 2020-126, 6 127, 128, 129, 130, 132, 134, 135, 136, 137, and 138. 7 Did I get all the cases there? 8 MR. VANDENBURGH: I believe so. 9 JUDGE PAULRAJ: Okay. So we have two 10 requests, both from patent owner; so we'll address both 11 of those in turn. I know the more recent request was 12 requested as part of a separate phone call. But per the 13 e-mail that we sent out this morning, we'd like to 14 address both requests today. 15 Do we have a court reporter on the line? 16 THE REPORTER: Yes, Your Honor. 17 MR. VANDENBURGH: Yes, Your Honor, we do 18 JUDGE PAULRAJ: All right. Excellent. 19 So whoever did arrange for the court 20 reporter, per usual practice, please make a transcript of 21 that part of the record as soon as it's available. 22 MR. VANDENBURGH: Will do. 23 JUDGE PAULRAJ: Okay. So let's take the 24 requests in turn. So we have down a request from Chris 25 Hasid, December 24th, from patent owner asking for</p>	<p style="text-align: right;">Page 5</p> <p>1 Mr. Morton. 2 And if we could just make it clear for the 3 record, identify yourself before you speak. That would 4 be easier for myself, as well as I imagine the court 5 reporter. 6 So happy new year, everyone, and let's 7 start with first request. 8 Mr. Vandenburg, go ahead. 9 MR. VANDENBURGH: Thank you, Your Honor. 10 Procedurally this is, of course, a very 11 unique and complicated case. Not only do we have 11 IPRs 12 consolidated into a single proceeding, but that's, you 13 know, made even more complicated by the fact that seven 14 of the IPRs involved as the lead reference a reference 15 that there's a dispute over whether it actually 16 constitutes a prior art or not. 17 Now, the board I think wisely got out in 18 front of this issue in setting the scheduling order sua 19 sponte setting up a separate briefing on that issue with 20 separate word counts. And I think of relevance to the 21 issue that we're going to be talking about today, when we 22 first had the first of two calls last summer relating to 23 petitioner's request for additional briefing and words on 24 this issue, we asked the board whether it was sort of 25 contemplating a single brief dealing with conception and</p>

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<p style="text-align: right;">Page 6</p> <p>1 reduction to practice or seven different briefs for each 2 case.</p> <p>3 And the guidance we got -- of course, the 4 board didn't say, you know, we had to do one or the 5 other; but the guidance was that they preferred a single 6 brief. And to us that made sense because the real 7 disputes in this case relating to conception and 8 reduction to practice don't really turn on the specific 9 language of a particular claim in a particular patent. 10 They're more generally on the issues of, you know, were 11 prototypes made; is there corroboration; is there 12 testing, was it sufficient. Those are the issues that 13 seem to be in dispute, and from the evidence that we -- 14 briefing we've seen so far in the dispute.</p> <p>15 But, you know, we're asking for 16 clarification today because there is this issue that 17 arises in priority disputes of whether the prototypes 18 that were built meet the limitations of the claims. And 19 we don't -- again, we don't think there's actually much 20 dispute on this issue. If you look at the -- when we 21 briefed this issue, you look at the fact that the -- the 22 specification here in describing the embodiments of the 23 invention, basically all of the preferred embodiments are 24 made up of two subcomponents: a relatively flexible, 25 polymer, tubular portion at the distal end of the device</p>	<p style="text-align: right;">Page 8</p> <p>1 we did. They attached a detailed expert declaration 2 purporting to set forth some limitations that he thought 3 weren't present in the claims.</p> <p>4 But the other thing the petitioner did is, 5 in the course of essentially a single paragraph, they 6 threw the Hail Mary pass. They said: "But, but, wait a 7 minute. We should win as a matter of procedure because 8 that sort of detailed element-by-element analysis is 9 necessary to your burden of proof, patent owner. You 10 violated the incorporation by a reference rule, and so 11 you lose as a matter of procedure."</p> <p>12 That's basically what we are looking for 13 here, guidance. Now, we don't think we did violate. We 14 think that -- you know, we've got 27 pages, including 15 detailed discussion of the prototypes, that provides 16 guidance on how those correspond to claim elements, 17 combined with our appendix in the declaration -- in the 18 expert -- or the inventor's declaration.</p> <p>19 But the important thing and the other 20 reason we're here is because there certainly was no 21 intent to violate any word count limits. Again, we were 22 trying to meet what the board asked for. We gave a 23 single brief, and we put the claim-by-claim specificity 24 into these appendices. Seemed to us to be the efficient 25 thing and what the board wanted.</p>
<p style="text-align: right;">Page 7</p> <p>1 and then a proximal end that is relatively rigid, that 2 according to the spec is preferably made out of steel 3 hypotube.</p> <p>4 So as part of our briefing, we pointed out 5 that our prototypes - and two specific prototypes in 6 particular that were ordered and built - had exactly 7 those two components. We showed them. We annotated them 8 using language -- you know, not the exact language of 9 each claim because the claims are different, but using 10 the language corresponding generally to the claim 11 language. And we pointed out how those prototypes 12 corresponded to the invention described in the patent and 13 claimed in the claims.</p> <p>14 We also included as an appendix to one of 15 the inventor declarations an extremely detailed, 16 element-by-element analysis of each and every claim, each 17 and every claim limitation to those prototypes.</p> <p>18 So what happened then in response? 19 In response, petitioner in their brief -- 20 first of all, they also filed only a single brief on the 21 issue of conception and reduction to practice identical 22 for all seven cases. And in that brief, they didn't 23 identify a single limitation in the prototypes -- I'm 24 sorry -- a single limitation of the claims that they're 25 saying wasn't in the prototypes. Instead they did what</p>	<p style="text-align: right;">Page 9</p> <p>1 We also note that when we had the second 2 of our two calls relating to patent owner's request for 3 an additional brief on this issue and for additional 4 words, that they -- they emphasized that we had put a lot 5 of material in as part of the request for more words, why 6 they needed more words; and they emphasized the fact that 7 they had the burden of proof on this issue. And now 8 they're coming back and saying, no, that's not really the 9 case; there's this procedural defect, and we should just 10 win as a matter of course.</p> <p>11 So -- and I guess, before I wrap this up, 12 I do also want to make one last point why we think that 13 there's no need for the board to consider - and the board 14 shouldn't consider - their procedural argument is we 15 don't think that this is a situation where, at the end of 16 the day, the board is going to end up having to, as some 17 of the cases say, play archeologist with the record to 18 figure out what the parties' arguments are on this issue.</p> <p>19 Now, there's still briefs -- two briefs to 20 go on the issue of conception and reduction to practice. 21 We're going to file a brief at the end of this month 22 where we can address the limitation that their expert 23 says was not in the prototypes, and they get yet another 24 brief after that to discuss the issue. So the issue will 25 be crystallized.</p>

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<p style="text-align: right;">Page 10</p> <p>1 And, of course, there's no prejudice to 2 Medtronic in considering this issue on the merits 3 because, you know, they have -- they have addressed it in 4 detail on the merits. They've taken four fact 5 depositions on the issue of conception and reduction to 6 practice. They've taken expert depositions on the issue. 7 It's fully briefed and considered. There's no prejudice 8 to that.</p> <p>9 So I guess what we'd like to ask the board 10 to do is to confirm today that they aren't going to 11 decide the conception and reduction to practice issue on 12 this procedural question of what evidence and argument 13 should have been in the briefs versus the declarations.</p> <p>14 Again, the parties have put a lot of work 15 into the merits. Everything is there -- you know, needed 16 to decide the issue is already there and will be there 17 with additional briefs that are going to be filed.</p> <p>18 And I guess, most importantly then, as we 19 continue to brief this issue, we don't want to have to 20 devote precious words that we have remaining on this 21 issue to arguing over this procedural issue to explaining 22 why they're wrong. So that's our primary request for 23 today.</p> <p>24 I think, alternatively, if the board is 25 not, you know, willing to grant that clarity today, then</p>	<p style="text-align: right;">Page 12</p> <p>1 there's one brief, and they put all their claim-by-claim 2 analysis in an appendix to a conductory declaration, I 3 think, in general, Your Honor, the patent owner is just, 4 in addition to an advisory opinion, seeking a do-over on 5 that point. And if I can just give a brief history of 6 the issue, I think I can explain why really, at the end 7 of the day, there's nothing the board needs to do now in 8 terms of an advisory opinion or expanded word count.</p> <p>9 So, Your Honor, throughout this process, 10 there have been two related issues. One issue was word 11 count, and one issue was whether we could file different 12 briefs for different IPRs because conception and 13 reduction to practice is a claim-by-claim analysis which 14 can differ for different patents. And the board's 15 original scheduling order back in June addressed both 16 issues setting word counts and setting consolidated 17 briefing, one set of briefs.</p> <p>18 We sought -- petitioner sought to change 19 that first at least by seeking identical word counts of 20 both parties, and patent owner opposed that. In our meet 21 and confer, they said they planned to file one brief. We 22 wouldn't agree to that. We pointed out it was 23 claim-by-claim analysis. And we had a board call where 24 we made these points to the board, and the board decided 25 to wait on any decision.</p>
<p style="text-align: right;">Page 11</p> <p>1 what we would ask for is an additional thousand words for 2 our surreply brief so that we can brief this procedural 3 question in detail.</p> <p>4 You know, petitioner raised it in 5 literally a paragraph. They didn't devote words to it. 6 But it's important. It's potentially dispositive. And 7 so if the board is -- is not willing to just say, you 8 know, "Oh, we're going to decide this on the merits," 9 then we would ask that we be given these thousand extra 10 words to address that issue as part of our surreply.</p> <p>11 That's all I have on that issue, Your 12 Honor.</p> <p>13 JUDGE PAULRAJ: Thank you, 14 Mr. Vandenburg.</p> <p>15 I don't think I have any questions at this 16 point from what you presented.</p> <p>17 Let me turn it over to Mr. Morton, and 18 then we may have questions for the other side after that.</p> <p>19 MR. MORTON: Yes, Your Honors.</p> <p>20 I did think that the request was more for 21 more words. And I think from this presentation, it's 22 clear the request is more for an advisory opinion from 23 the board to decide an issue now that's in the briefing, 24 which I think are generally not how things go.</p> <p>25 You know, on this issue of, you know,</p>	<p style="text-align: right;">Page 13</p> <p>1 The patent owner did not raise any issue 2 with the procedure whatsoever with the board, other than 3 to oppose our request for equal words. Patent owner went 4 ahead then and filed one identical brief for all seven 5 IPRs and put its claim-by-claim analysis in a chart 6 appended to inventor Root's declaration. After that we 7 raised the issues again, and again patent owner opposed. 8 And this time on the board call, the board decided to 9 order equal briefing.</p> <p>10 And we addressed the burden of proof on 11 that time. There is a transcript. It's in the record. 12 I said that they have to send for us. They have to make 13 their case and shift the burden back to us on this issue. 14 And at that time, the patent owner characterized it as 15 their burden of production. That's in the transcript. 16 So -- so they do that. We're going to do that.</p> <p>17 Now, this is the heart of the matter for 18 today's decision, Your Honor; at no time did patent owner 19 object to the limits on their word count. At no point 20 did patent owner object to consolidated briefing. They 21 never said, "Hey, this is going to be difficult to get 22 this in briefs because it's claim by claim." In fact, 23 they embraced the idea of single briefs over our 24 objections, and they only sought to maintain unequal 25 briefing in their favor.</p>

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<p style="text-align: right;">Page 14</p> <p>1 Now, nothing has changed since then, Your 2 Honor. We simply made the argument that was available to 3 us that the Root charts are a proper incorporation by 4 reference. Very common argument in IPRs. And the 5 argument's not a stretch. There's nothing in the briefs 6 about the various claims across the patents, there's only 7 that chart. 8 But the board certainly does not need to 9 decide that issue here today. In the final written 10 decision, the board can decide whether or not the patent 11 owner met its burden on this issue in its opening briefs. 12 The board does need to render an advisory opinion or give 13 patent owner a do-over with more words. 14 So I'm guessing patent owner will try to 15 meet its burden in its surreply briefs now, which I think 16 is improper. If they do that, we will point that out in 17 our surreply briefs. And the board can decide the matter 18 in the final written decision. 19 So in conclusion, Your Honor, patent owner 20 has known all along that it's a claim-by-claim analysis. 21 That's basic patent law. They chose to embrace the 22 filing of one brief and never asked for more words. 23 There's no reason to adjust the procedure now just 24 because we made an incorporation-by-reference argument. 25 Thank you, Your Honor.</p>	<p style="text-align: right;">Page 16</p> <p>1 But we -- it is not our intent to -- to go 2 back and somehow -- and, of course, there's no possible 3 way we could do so with a thousand words -- somehow 4 incorporate, you know -- or put claim charts into our 5 surreply brief. That is not our plan. 6 JUDGE PAULRAJ: Okay. And just to follow 7 up. 8 Is it -- regardless of whether it's 9 inappropriate or not -- and we're not, at least right now 10 on this call, going to make a judgment on that -- is it 11 your intent for us to rely upon the claim charts in 12 addition to the arguments you've made in the -- in the 13 brief itself? 14 MR. VANDENBURGH: Well, they are -- they 15 are evidence. 16 JUDGE PAULRAJ: Okay. 17 MR. VANDENBURGH: And just like I am sure 18 that Mr. Morton would say that their expert's lengthy 19 appendix is evidence. 20 But, again, we -- our hope is that we are 21 going to provide the guidance that the board would like 22 of what's actually in dispute relative to whether the 23 prototypes are covered in the claim in the briefs 24 themselves and not have to somehow parse that out on 25 their own out of the -- out of the appendices.</p>
<p style="text-align: right;">Page 15</p> <p>1 JUDGE PAULRAJ: Thank you, Mr. Morton. 2 Let me put the parties on hold. I'm going 3 to confer with my panel about whether we have any 4 questions before we address this issue further. 5 (Off the record 10:18-10:19.) 6 JUDGE PAULRAJ: Mr. Vandenburg, one 7 question we have for the patent owner's side in terms of 8 what you're asking for in terms of the thousand extra 9 words: Would those thousand extra words be used to only 10 argue that you didn't improperly incorporate Root 11 reference, or are you going to more or less remedy 12 perhaps the alleged improper incorporation by reference 13 by -- by making substantive arguments in your surreply? 14 Could you clarify that point? 15 MR. VANDENBURGH: What we intend to do is 16 to address the -- the alleged deficiency and obviously 17 brief that in issue -- in detail. And there are cases 18 from the board on this issue that need analysis. 19 In addition, we do contemplate addressing 20 the things that their expert says; you know, what they 21 put their dec -- in their lengthy declaration that they 22 incorporated and address the specific issues that the 23 board -- or I'm sorry -- that petitioner is contending 24 were not in the prototypes so that the board does not 25 have to play archeologist.</p>	<p style="text-align: right;">Page 17</p> <p>1 JUDGE PAULRAJ: Okay. And just one 2 follow-up. 3 Perhaps, Mr. Morton, you can answer; and 4 I'll let both sides respond. 5 In terms of the claim charts included with 6 petitioner's expert declarations, are those claim 7 charts -- and what I'm trying to get at is, are they also 8 kind of entitled to be like a claim-by-claim, 9 patent-by-patent analysis analogous to what -- what 10 you've included in patent owner's briefs? 11 MR. MORTON: So, Your Honor, I guess I 12 wouldn't -- I wouldn't agree that we haven't made any 13 argument about what's missing from the prototypes in our 14 briefs. I think we did make an argument in our briefs. 15 Certainly there are a lot more words in the claim charts 16 in the expert's declaration. 17 I do think there is a little bit of a -- 18 you know, if the board is going to consider their claim 19 charts, which we say our incorporated by reference, at 20 that point I guess it's all fair game and our stuff's 21 probably in, too. But I don't think it's just purely a 22 goose/gander situation. I think we've said things in the 23 briefs as far as what's -- what's missing. 24 JUDGE PAULRAJ: All right. Thank you 25 both. Let me put the parties on mute again and discuss</p>

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