

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

3

MEDTRONIC, INC., AND MEDTRONIC
4 VASCULAR, INC.,

5 Petitioners,

6 vs.

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

8 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

22 CONTAINS CONFIDENTIAL PORTIONS - ATTORNEYS' EYES ONLY
23 REMOTE VIDEOTAPED DEPOSITION OF
24 PAUL ZALESKY, Ph.D.

25 DATE: January 25, 2021

TIME: 9:58 a.m. (Eastern)

PLACE: Veritext Virtual Videoconference

PAGES: 1 to 211

JOB NO.: MW 4402874

REPORTED BY: Merilee Johnson, RDR, CRR, CRC, RSA

Veritext Legal Solutions

www.veritext.com

888-391-3376

Page 2

1 APPEARANCES
 (All appearing remotely via videoconference)
 2
 3 ON BEHALF OF THE PETITIONERS:
 4 ROBINS KAPLAN LLP
 BY: Emily J Tremblay, Esq
 5 Cyrus A Morton, Esq
 800 LaSalle Avenue
 6 Suite 2800
 Minneapolis, Minnesota 55402
 7 Phone: (612) 349-8500
 Email: ETremblay@RobinsKaplan com
 8 Email: CMorton@RobinsKaplan com
 9
 10 ON BEHALF OF THE PATENT OWNERS:
 11 CARLSON, CASPERS, VANDENBURGH,
 LINDQUIST & SCHUMAN, PA
 12 BY: Joseph W Winkels, Esq
 225 South Sixth Street
 13 Suite 4200
 Minneapolis, Minnesota 55402
 14 Phone: (612) 436-9600
 Email: JWinkels@CarlsonCaspers com
 15
 -and-
 16 DORSEY & WHITNEY, LLP
 17 BY: Kenneth E Levitt, Esq
 50 South Sixth Street
 18 Suite 1500
 Minneapolis, Minnesota 55402
 19 Phone: (612) 340-2600
 Email: Levitt Kenneth@Dorsey com
 20
 21 ALSO APPEARED:
 22 Greg Smock (Teleflex) (Until 1:28 p m)
 Jay Church (Videographer)
 23
 24
 25

Page 4

1 EXHIBITS
 (Continued)
 2
 3 Exhibit 1908 Reissue Patent Application for ... 90
 4 Coaxial Guide Catheter for
 5 Interventional Cardiology
 6 Procedures
 7 Exhibit 1919 Declaration of Paul Zalesky 10
 8 Submitted in Support of
 9 Petitioners' Oppositions to
 10 Patent Owner's Motions to Amend
 11 Exhibit 2071 Medtronic marketing: An 161
 12 Extension of You, Telescope Guide
 13 Extension Catheter
 14 Exhibit 2197 Proximal SA Tracker Week 28..... 206
 15 Exhibit 2225 Declaration of Dr. Paul Zalesky .. 26
 16 in Opposition to Motion for
 17 Preliminary Injunction
 18 Exhibit 2234 United States Reissued Patent 108
 19 Patent No. US RE46,116 E, Date of
 20 Reissued Patent: August 23, 2016
 21 Exhibit 2235 Medtronic Telescope Guide 165
 22 Extension Catheter, Clinical
 23 Evaluation Report
 24 MED000134_0001 to 0126
 25

Page 3

1 INDEX
 2
 3 WITNESS: PAUL ZALESKY, Ph.D. PAGE
 4 Examination by Mr. Winkels..... 7
 5 Examination by Ms. Tremblay.....207
 6
 7 SPECIAL INSTRUCTIONS:
 8 Page 166, Line 2
 9
 10 EXHIBITS
 11
 12 EXHIBITS FIRST REFERRED TO: PAGE
 13 Exhibit 1001 United States Reissued Patent 120
 14 Patent No. US RE47,379 E, Date of
 15 Reissued Patent: May 7, 2019
 16 Exhibit 1830 Declaration of Paul Zalesky 148
 17 Submitted in Connection with
 18 Petitioners' Replies to Patent
 19 Owner's Responses
 20 Exhibit 1842 Application Transmittal for 23
 21 Coaxial Guide Catheter for
 22 Interventional Cardiology
 23 Procedures
 24
 25

Page 5

1 EXHIBITS
 (Continued)
 2
 3 Exhibit 2237 Patent Owner's Contingent Motion . 46
 4 to Amend U.S. Patent RE 45,380
 5 Under 37 C.F.R. § 42.121
 6 Exhibit 2238 Patent Owner's Contingent Motion . 123
 7 to Amend U.S. Patent RE 45,776
 8 Under 37 C.F.R. § 42.121
 9 Exhibit 2239 Patent Owner's Contingent Motion . 134
 10 to Amend U.S. Patent 8,048,032
 11 Under 37 C.F.R. § 42.121
 12
 13
 14
 15
 16
 17
 18
 19
 20
 21
 22
 23
 24
 25

2 (Pages 2 - 5)

Veritext Legal Solutions

www.veritext.com

888-391-3376

Page 6

1 (PROCEEDINGS, 01/25/2021, 9:58 a.m.)
2 THE VIDEOGRAPHER: Good morning. We
3 are going on the record. The time is currently
4 9:58 a.m. This is Eastern Standard Time. Today's
5 date is Monday, January 25, 2021.
6 This is Media Unit No. 1 of the
7 video-recorded deposition of Dr. Paul Zalesky.
8 This is in the matter of Medtronic, Inc., et al.,
9 versus Teleflex Innovations S.A.R.L. This is filed
10 in the U.S. Patent and Trademark Office, Patent
11 Nos. IPR2020-00126, 00127, 00128, 00129, 00130,
12 00132, 00134, 00135, 00136, 00137, 00138.
13 This deposition is being held remotely.
14 The witness is currently located in East Greenwich,
15 Rhode Island.
16 My name is Jay Church from Veritext. I'm
17 the videographer. The court reporter is Merilee
18 Johnson. I'm not authorized to administer an oath.
19 I'm not related to any party in the action nor am I
20 financially interested in the outcome.
21 If counsel has any objections to
22 proceeding, please state them at the time of your
23 appearance. And now if we could have counsel state
24 your affiliations for the record and then, after
25 which, the court reporter can swear in the witness.

Page 7

1 MR. WINKELS: Good morning. On behalf
2 of patent owner, Joe Winkels with the Carlson
3 Caspers firm. Also with me is Ken Levitt with the
4 Dorsey & Whitney firm and Greg Smock from Teleflex.
5 MS. TREMBLAY: Good morning. On behalf
6 of petitioners, my name is Emily Tremblay with
7 Robins Kaplan. Also with me is Cyrus Morton, also
8 with Robins Kaplan.
9 PAUL ZALESKY, Ph.D.,
10 duly sworn, was examined and testified as follows:
11 EXAMINATION
12 BY MR. WINKELS:
13 Q. Good morning, Dr. Zalesky. How are you?
14 A. I'm good. How are you?
15 Q. Very good.
16 Do you have the Exhibit Share open as well
17 as the hard-copy documents in front of you?
18 A. I do, but it looks like exhibits from the
19 last session or a previous session. I'm not sure.
20 I'll try to refresh.
21 Q. Yep. So if -- there's two folders,
22 actually, for your name. One dated January 13th,
23 one dated January 25th. On the left-hand side. If
24 you can make sure you're in the January 25th
25 folder.

Page 8

1 A. Yeah, I'm not seeing a date. I'm seeing
2 "Date Modified" under the exhibits, but I'm not
3 seeing the date of the actual share.
4 Q. In the far-left window, do you have a bunch
5 of folders that say "Depositions"? It should say,
6 "Deposition of Dr. Paul Zalesky 1-25-2021."
7 A. Just got to it, yeah.
8 Q. Okay. Yeah. If you open up that folder --
9 A. I'm sorry. No, these are January 8th.
10 Q. January 8th.
11 A. Let me try again. Oh, I've got one,
12 January 24th. Got it. Okay. There.
13 Q. Okay. Perfect. I'll generally refer to
14 documents in hard copy, if you prefer to look at
15 the documents in hard copy. But if you want to
16 look on the screen, I'll put the documents in that
17 Marked Exhibits folder as well for you. Okay?
18 A. Okay.
19 Q. All right. So you've had your deposition
20 taken before, correct?
21 A. Yes.
22 Q. Yep. And you've had your deposition taken
23 via Zoom before in this case with my colleague Tara
24 Norgard, right?
25 A. Yes.

Page 9

1 Q. Okay. So same process. As you've
2 experienced before with these Zoom depositions,
3 it's really important that you and I not speak over
4 each other. So I will do my best to not interrupt
5 you, and if you could do your best to not interrupt
6 me, that'll make Merilee's job a lot easier as our
7 court reporter.
8 Does that sound fair?
9 A. Yes.
10 MR. WINKELS: It looks like Emily lost
11 audio. Let's go off the record and try to get her
12 connected to audio here.
13 THE VIDEOGRAPHER: We're going off the
14 record at 10:03 a.m.
15 (Break: 10:03 a.m. to 10:04 a.m.)
16 THE VIDEOGRAPHER: We are going back on
17 the record at 10:04 a.m.
18 BY MR. WINKELS:
19 Q. Okay. Dr. Zalesky, so today we're talking
20 about your opinions related to written description
21 and the secondary considerations of copying. Okay?
22 A. Yes.
23 Q. And you submitted a couple declarations in
24 this regard. The first one is Exhibit 1919; is
25 that correct?

3 (Pages 6 - 9)

Veritext Legal Solutions

www.veritext.com

888-391-3376

Page 10

1 A. Yes.
2 (Exhibit No. 1919 was introduced.)
3 Q. And do you have Exhibit 1919 in front of
4 you?
5 A. I do.
6 Q. Okay. We'll focus on your opinions in that
7 declaration for the first part of today and then
8 we'll transition to your second declaration later
9 in the day.
10 In connection with your Exhibit 1919, with
11 that declaration, what did you review in support of
12 that declaration?
13 A. There was a brief, I believe. Probably two
14 of them, one from different counsels, regarding
15 suggested claim amendments. So that was the
16 primary document that I reviewed. And the
17 background to that including, I believe, a case
18 special expert report.
19 Q. Okay. Now, in this case you've also
20 reviewed the five patents and claims that are at
21 issue in these IPRs, right?
22 A. My emphasis was on the '629 application and
23 the '032 issue, as it was my understanding that
24 that's where the -- I don't know if "baseline" is
25 the correct term, but the original specifications

Page 11

1 resided.
2 Q. Okay. Did you look at the claims of the
3 other patents in addition to the '032 patent?
4 A. I would certainly have looked at those.
5 It's been a while, quite honestly. But I did look
6 at them and saw a lot of redundancy.
7 Q. Okay. How about the prosecution histories
8 for the five patents that are at issue in these
9 IPRs. Have you reviewed the prosecution history
10 for those five patents?
11 A. I was given at some point a chart of the
12 file history, and there was also a table on page 11
13 of the application numbers, filing dates, and
14 patent numbers at issue. But as I said earlier, I
15 emphasized the '629 and '032 and didn't re-review
16 in any detail the other patents -- or applications.
17 Q. Okay. When I refer to "prosecution
18 history," do you understand that I'm referring to
19 the process by which the application is reviewed by
20 the patent office and there's some correspondence
21 that is generated as part of that process?
22 A. I do. I'm familiar with that. I don't
23 recall seeing a detailed prosecution history or
24 detail. I do recall some specific excerpts, such
25 as a hearing from the patent office, I believe, in

Page 12

1 the 2011-2012 time frame.
2 Q. Okay. So let me just go through one by one
3 because I do want to understand what you reviewed
4 and what you haven't reviewed.
5 Have you reviewed the entirety of the '032
6 prosecution history?
7 A. I don't believe I've seen the entire
8 prosecution history.
9 Q. Okay. Have you reviewed the entirety of
10 the '380 prosecution history?
11 A. The same answer. In each of these, I don't
12 recall looking at the entire prosecution histories.
13 Q. Okay. And just for the record, that's the
14 same answer for the '776 patent, the '760 patent,
15 and the '379 patent, correct?
16 A. Yes.
17 Q. Okay. Is the only portion of the
18 prosecution history that you've reviewed are
19 portions that were specifically given to you by
20 counsel to review?
21 A. That's my recollection, yes. And just to
22 give you a very specific example, on page 19
23 there's a citation regarding patent office claim
24 rejection.
25 So it's only that level of detail that I

Page 13

1 reviewed.
2 Q. Okay. So is it fair to say that the only
3 portions of the prosecution history of the five
4 patents you reviewed are the portions that you
5 expressly discuss in your declaration,
6 Exhibit 1919?
7 A. Yes, that's correct.
8 Q. Now, you also mention the motions to amend.
9 Do you understand that there were motions to amend
10 brought in each of the five -- strike that.
11 Do you understand that there were motions
12 to amend brought regarding each of the five patents
13 at issue in this case?
14 A. I don't remember explicitly seeing that,
15 but that was my understanding, that the proposed
16 amendments applied to the various patents.
17 Q. Okay. And through your process of
18 providing your opinions in this case, did you
19 review all of the proposed amendments for the
20 five patents in this case?
21 A. I don't believe I did. You know, I'd have
22 to go through each one, literally, one by one.
23 And, of course, that's all in my declaration. So
24 the specific amendments that I did review are as
25 listed in the Substitute Claim section of my

4 (Pages 10 - 13)

Veritext Legal Solutions

www.veritext.com

888-391-3376

Page 14

1 declaration.

2 Q. Okay. And that's -- and paragraph 14 of

3 your declaration, that's what I was kind of asking

4 you about, is you said, "I have been asked to

5 review the Root patents and patent owner's

6 contingent motions to amend the Root patents..."

7 And I just want to confirm that you did, in

8 fact, look at all five of the motions to amend for

9 the five patents that were at issue in the case.

10 A. I believe so, yes.

11 Q. Okay. Now, did you prepare to testify

12 today, I take it?

13 A. Yes. I had some preparation with counsel

14 on -- this past Friday. And then over the weekend,

15 I probably spent maybe an hour just reviewing my

16 declaration.

17 Q. Okay. Let's go to just the background part

18 of your declaration. And I just want to understand

19 just a little bit of your prior work because I know

20 you've done a lot of work in the catheter area. So

21 I just have a few questions about that.

22 In paragraph 5 you discuss the advent --

23 what I call the advent of interventional cardiology

24 in the '70s and '80s; is that right?

25 A. Yes.

Page 15

1 Q. Is that when you would say interventional

2 cardiology started, is in the '70s?

3 A. I probably wouldn't make that general of a

4 statement. I was fortunate in my very first job in

5 the medical industry to be at an American Heart

6 meeting, I believe it was in Florida, when

7 Dr. Andreas Grüntzig from Switzerland made a

8 presentation in a very small meeting room about

9 doing the very first what is now known as coronary

10 angioplasty.

11 So you could argue that -- I believe that

12 was 1979. You could argue that was the initiation,

13 but interventional cardiology, I think in general,

14 is more of a 1980s event.

15 Q. Okay. And it looks like at least as early

16 as 1986 you started working directly in

17 interventional cardiology; is that right?

18 A. Actually a bit before that. So in 1984, as

19 a vice president for a company called Meadox, I

20 went over to Denmark, to a young company in a small

21 town outside of Copenhagen and looked at guide

22 catheters that were being fabricated for

23 commercialization.

24 So I would say starting in 1984. And then

25 between 1984 and 1986, I worked at a fledgling

Page 16

1 division of Boston Scientific called Mansfield

2 Scientific, which evolved into their interventional

3 cardiology company. And during my tenure there as

4 the head of R&D, I presented, for instance, to the

5 panel at the FDA for Boston's first approval of its

6 initial coronary angioplasty catheter.

7 Q. And how long were you at Boston Scientific

8 in that role?

9 A. Approximately two years.

10 Q. Then as we move on to paragraph 6, it looks

11 like around 1986 you cofounded InterTherapy; is

12 that right?

13 A. Yes.

14 Q. And with InterTherapy, were you still

15 working and designing catheters and working in the

16 cath lab?

17 A. Pretty much so. It was a startup, which we

18 thought was the only one in the world, dealing with

19 what's called intravascular ultrasound. In other

20 words, putting ultrasound technology into a

21 catheter that could actually fit inside of a

22 coronary artery.

23 So the focus was clearly on

24 angioplasty-related procedures in a cardiac cath

25 lab.

Page 17

1 Q. Okay. And then it looks like around 1990,

2 am I correct that you transitioned to Baxter, the

3 Baxter company?

4 A. Yes.

5 Q. And with Baxter, were you working on

6 catheters and catheter design as well?

7 A. Baxter had a group called the

8 CardioVascular Specialties group in Irvine,

9 California, which is where I was located. And I

10 had a dual role. I was VP of R&D for the

11 cardiopulmonary bypass surgery division called

12 Bentley, but I also was the point person for the

13 various five divisions, one of which was called

14 LIS, Least Invasive Surgery. And that was

15 dedicated to interventional cardiology.

16 I represented that company and regularly

17 participated in their developments and their

18 related activities to cardiology.

19 Q. And did that include developments in

20 catheter design and things of that nature?

21 A. Yes.

22 Q. Okay. And then in 1995 you founded the

23 TherOx company; is that right?

24 A. Yes.

25 Q. And I believe you said that you were

5 (Pages 14 - 17)

Veritext Legal Solutions

www.veritext.com

888-391-3376

Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

Real-Time Litigation Alerts



Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

Advanced Docket Research



With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

Analytics At Your Fingertips



Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

LAW FIRMS

Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

FINANCIAL INSTITUTIONS

Litigation and bankruptcy checks for companies and debtors.

E-DISCOVERY AND LEGAL VENDORS

Sync your system to PACER to automate legal marketing.