

Phone Conference - 2/2/2021
Medtronic, Inc., and Medtronic Vascular, Inc. vs. Teleflex Innovations S.A.R.L.

1 UNITED STATES PATENT AND TRADEMARK OFFICE

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3 BEFORE THE PATENT TRIAL AND APPEAL BOARD

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5 Medtronic, Inc., and Medtronic Vascular, Inc.,

6 Petitioners,

7 vs.

8 Teleflex Innovations S.À.R.L.,

9 Patent Owner

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11 Case No.: IPR2020-00126

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13 Case No.: IPR2020-00127

14 -----

15 Case No.: IPR2020-00128

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17 Case No.: IPR2020-00129

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19 Case No.: IPR2020-00130

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21 Case No.: IPR2020-00132

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23 Case No.: IPR2020-00134

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25 Case No.: IPR2020-00135

Case No.: IPR2020-00136

Case No.: IPR2020-00137

Case No.: IPR2020-00138

22 TELEPHONIC PROCEEDING

23 February 2, 2021

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25 By Brandi N. Bigalke, RPR RSA

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A P P E A R A N C E S:

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(**Everyone appeared by telephone)

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The Honorable Christopher Paulraj

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The Honorable Sheridan Snedden

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The Honorable Jon Tornquist

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On Behalf of the Petitioner:

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<p>1 PROCEEDINGS 2 Whereupon, the telephonic proceeding on February 3 2nd, 2021 was commenced at 2:00 p.m. as follows: 4 - - - 5 THE COURT: Good afternoon. 6 This is Judge Paulraj of the Patent 7 Trial and Appeal Board. With me on the line I 8 have Judges Tornquist and Snedden. 9 This is a conference call in 10 ICR2020-00126, 127, 128, 129, 130, 132, 134, 135, 11 136, 137, and 138. 12 Can we start with role call. Let's 13 start with petitioner's counsel first, then patent 14 owner's counsel. 15 MR. MORTON: Sorry, your Honor. I 16 was on mute. I introduced everybody, but I'll do 17 so again. 18 So this is Cy Morton for petitioner. 19 With me also is Chris Pinahs and Sherry 20 Roberg-Perez. 21 And we have do have a court reporter 22 on the line I believe, your Honor. 23 THE COURT REPORTER: Yes. This is 24 Brandi Bigalke with Depo International. 25 THE COURT: All right. Thank you,</p>	<p>1 And once we address the live 2 testimony issue, perhaps we can briefly touch on 3 any other issues relating to logistics. 4 Does that sound like a workable 5 plan? 6 MR. VANDENBURGH: Sounds good, your 7 Honor. 8 THE COURT: All right. You may 9 proceed whenever you're ready. 10 MR. VANDENBURGH: Thank you. 11 Yeah. This is Mr. Vandenburg. 12 Just four quick points following the presidential 13 case on this issue. 14 First of all, of course this is an 15 important family of patents relating to an 16 important dispute between Teleflex and Medtronic. 17 And we simply think it makes sense for the board 18 to have all of the evidence as best as they can to 19 reach the correct decision in this case. 20 It also makes sense because this 21 issue of prior invention is dispositive for many 22 issues in this case. A ruling of course in patent 23 owner's favor would completely resolve 5 of the 11 24 IPRs and roughly half of 2 other IPRs. 25 And of course the flip side is maybe</p>
<p>Page 4 1 Mr. Morton. 2 As is our usual practice, will you 3 submit a copy of the transcript whenever it's 4 available? 5 MR. MORTON: Yes, we will. 6 THE COURT: All right. Let's get 7 role call from patent owner's counsel. 8 MR. VANDENBURGH: Thank you, your 9 Honor. Derek Vandenburg and Peter Kohlhepp for 10 patent owner. 11 THE COURT: All right. Thank you, 12 Mr. Vandenburg. 13 So as we indicated in the invitation 14 for this conference call, this was in response to 15 the parties' submissions for a request for oral 16 hearing. 17 We did see that patent owner 18 requested live testimony in this case, which we've 19 done I believe once before, but we do have a 20 presidential case that I believe you're relying 21 on. 22 Why don't we start with that issue, 23 and Mr. Vandenburg, I'll let you start it since 24 it was patent owner's request. Then have</p>	<p>Page 6 1 not to the same extent, but is somewhat true as 2 well. There are claims we have not disputed would 3 be anticipated if the veto reference is prior art. 4 So that's two. 5 Thirdly, of course when -- this is 6 not an expert witness. This is fact witness 7 testimony. And, you know, this issue of prior 8 invention could in fact turn on the credibility of 9 Teleflex's witnesses and particularly Mr. Root as 10 the primary witness that we're relying on. 11 You know, the petitioner has couched 12 his arguments more in terms of corroboration than 13 in terms of credibility, but at some point it is 14 hard to distinguish between those two things and I 15 think it is important for the board to hear 16 Mr. Root directly explain why his testimony 17 regarding prior -- you know, conception, reduction 18 to practice is corroborated by the documents that 19 were, you know, able to be obtained in this case 20 after all these years relating specifically to the 21 VSI business, the original patent owner. 22 And that kind of leads to the last 23 point, your Honor, which I think it is important 24 for the Board to understand that all companies are</p>

<p>1 The petitioner put in an expert 2 declaration on this issue that purports to talk 3 about how all medical products companies do their 4 product development. It kind of came out at 5 deposition that in fact they're not all the same. 6 But that's where I think it is 7 important to hear from Mr. Root to hear how they 8 did it, why these documents make sense and 9 corroborate the prior invention in terms of how 10 VSI successfully ran its business and also to 11 explain why some of the things that their experts 12 tried to speculate about, for example that, you 13 know, certain prototype parts might have been for 14 some completely different product or for the 15 over-the-wire version of this invention just 16 really does not make sense, again, from the 17 standpoint of somebody who lived through this and 18 knows what these documents are about. 19 So I think this is one of those rare 20 cases where hearing live testimony does make 21 sense. That's all I have. 22 THE COURT: Thank you. 23 Mr. Morton, you can proceed. 24 MR. MORTON: Yes, your Honor. Thank 25 you.</p>	<p>1 hearing. 2 And of course as the Board well 3 knows, there's usually no evidence at a P-TAB 4 hearing. At every turn here patent owner has 5 wanted to put in new evidence. They wanted new 6 surreply evidence when we discussed the briefing 7 on this with the Board last September. 8 Less than a month ago patent owner 9 was seeking more words and possibly more evidence 10 because of their incorporation by reference issue. 11 And now they want live testimony to just talk 12 about this. And that's not how P-TAB trials are 13 supposed to go. We've had a lot of process, spent 14 a lot of time already. 15 Second, your Honor, I have tried to 16 figure out what the testimony will be about. So 17 on the meet and confer I was told only that 18 Mr. Root would testify to "a recollection of what 19 happened and corroboration." 20 Well, a recollection of what 21 happened doesn't tell me anything of course, your 22 Honor. And corroboration is not something that 23 can come from Root, an inventor. So that to me is 24 just wrong. 25 In the request for live testimony,</p>
<p>1 I have I think three general points, 2 which I'll then elaborate on each one. 3 First, your Honor, I'd say we are 4 just concerned that patent owner just wants to 5 illicit new evidence at the hearing. Set a new 6 story. 7 Second, without knowing exactly what 8 the proposed testimony would be, it's hard to 9 argue about whether credibility is actually at 10 issue, and hard to prepare for the hearing. 11 Third, there has not been a showing 12 that any proposed testimony is case dispositive, 13 which is a key factor in whether testimony should 14 be allowed. 15 So on the first point, your Honor, 16 about new evidence, of course we've already had a 17 trial, and Mr. Root testified and was crossed and 18 redirected on Zoom. And that was recorded so that 19 is all available. 20 Now it just seems like patent owner 21 wants the opportunity to do it again as if this 22 were a trial in District Court, and just to have 23 carte blanche to ask Mr. Root anything about 24 conception, reduction to practice and illicit new</p>	<p>1 patent owner, again they raised two issues. Again 2 one was corroboration, and Mr. Root cannot 3 corroborate himself or his story. He's an 4 inventor. 5 They also mentioned documents relies 6 on, this issue that Mr. Vandenburg brought up 7 again just now, about whether orders for certain 8 parts might have related to other products that 9 were in development at the time. 10 And I don't think we have, you know, 11 directly said Mr. Root is lying on this topic. We 12 have pointed out that a lot of the parts are 13 generic and could be for other products. And if 14 that's really all this is about is his testimony 15 that those parts are for the rapid exchange 16 version of GuideLiner, we don't need live 17 testimony. He already testified to that. And his 18 cross and redirect is recorded on Zoom. 19 So if it's more than that, that's 20 where I have a problem. I don't think you should 21 be able to testify as to corroboration generally. 22 That doesn't come from an inventor and there 23 shouldn't be new evidence or surprise at a P-TAB 24 trial.</p>

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