

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MEDTRONIC, INC., AND MEDTRONIC VASCULAR, INC.
Petitioner,

v.

TELEFLEX INNOVATIONS S.À.R.L.,
Patent Owner

Case No. IPR2020–00126

Case No. IPR2020–00127

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

**PETITIONER’S SUR-REPLY
TO PATENT OWNER’S CORRECTED MOTION TO AMEND**

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I. INTRODUCTION

Patent Owner’s (“PO”) inventions are not new—they merely commercialize the prior art. The proposed amended claims add no new material limitations that were not present in the art and are therefore invalid for the same reasons the original claims are invalid. Before the alleged invention, Kontos described a “guide catheter extension.” Itou, a suction catheter, and Ressemann, an embolic protection device, are both designed to treat coronary artery disease and would be considered together in designing catheters and treating patients. Ressemann and Kataishi disclose the claimed structure of the amended complex side opening and the art attributes known benefits to this structure. Further, the art describes that similarly shaped openings provide these same benefits when used for both the proximal and distal opening of various catheters. Nonetheless, PO argues that obviousness is nothing but hindsight.

But a POSITA is not an automaton restricted to combining two specific physical embodiments of the prior art. *Univ. of Maryland Biotechnology Institute v. Presens Precision Sensing GmbH*, 711 F. App’x 1007, 1010 (Fed. Cir. 2017). Instead, a POSITA has the ordinary creativity of a skilled artisan using the common knowledge and common sense present in the art. *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 421 (2007). PO narrowly focuses on combining specific embodiments and argues because they are not combinable without making some modifications, the invention is not obvious. PO ignores that these modifications were well-understood

routine engineering concepts within the capability of a POSITA, who had motivation to make them. Taking well-defined structures with known benefits, like the shape of various catheter openings, and applying those structures to other catheters to achieve predictable results is not inventive. Thus, the proposed amended claims are invalid.

II. PROPOSED CLAIMS 23–25 ARE UNPATENTABLE

A. Substitute claims 23–25 are unpatentable over Itou in view of Ressemann or Kataishi.

PO argues that the Itou grounds do not invalidate for at least five reasons, including (1) Itou does not disclose all four interventional cardiology devices, (2) Ressemann and Kataishi do not disclose the “concave track,” (3) Itou does not disclose the 0.056 inch inner lumen diameter with a 6 Fr guide catheter, (4) Itou does not disclose the “coaxial lumen,” and (5) a POSITA would not be motivated to combine the references. Each of these issues is discussed below.

1. Interventional Cardiology Devices

Itou discloses that all four types of interventional cardiology devices are insertable.¹ First, Itou itself teaches that guidewire (6) is insertable through catheter (2). Ex. 1007, Fig. 5; 4:64-65; *see also* Ex. 1806 ¶ 45. PO’s expert could have, but

¹ PO incorrectly alleges that Petitioner’s expert agreed the invention requires all four devices. He only agreed with the language recited in the specification that the Board has already considered. Ex. 2242, 89:1-18; *see also id.*, 208:15-209:10.

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