

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 IPR2020-00126
Patent 8,048,032

PATENT OWNER PRELIMINARY RESPONSE TO PETITION

TABLE OF CONTENTS

	PAGE
I. INTRODUCTION COMMON TO ALL IPR PETITIONS.....	1
II. INTRODUCTION TO THE PRESENT PATENT OWNER RESPONSE	3
III. BACKGROUND	6
A. The Revolutionary GuideLiner Product.....	6
B. The '032 Patent	7
C. The <i>QXM</i> and <i>Medtronic</i> Cases: Parallel Litigation Regarding the Validity of the '032 Patent in the District of Minnesota.....	12
IV. PRIORITY DATE – PRE-AIA LAW APPLIES	14
V. THE PERSON OF ORDINARY SKILL IN THE ART	16
VI. CLAIM CONSTRUCTION	16
A. A flexible tip portion/tubular portion “defining a coaxial lumen having a cross-sectional inner diameter through which interventional cardiology devices are insertable” (Claims 1, 11)	16
B. Other Terms.....	20
VII. THE ITOU REFERENCE (Ex. 1007).....	20
VIII. THE BOARD SHOULD DECLINE TO INSTITUTE REVIEW	21
A. ALL GROUNDS: The Petition Should Be Denied Because the Itou Reference Is Not Prior Art	21
B. ALL GROUNDS: The Petition Should Be Denied Under 35 U.S.C. § 314(a).....	25

C.	ALL GROUNDS: Medtronic Has Not Shown that Itou's Suction Catheter Anticipates Any Challenged Claim.....	36
D.	GROUND 2 AND 3: Medtronic Has Failed to Demonstrate a Reasonable Likelihood of Prevailing as to Its Challenges to Dependent Claims	37
1.	Grounds 2 and 3 Are Substantively Deficient Because Ground 1 Fails.....	37
2.	Grounds 2 and 3 Fail to Address Known Objective Evidence of Non-Obviousness.....	37
(a)	Commercial Success.....	38
(b)	Industry Praise	42
(c)	Licensing and Licensing Attempts	44
(d)	Copying.....	44
(e)	Long-Felt Need.....	47
E.	The Petition Should Be Denied Because Inter Partes Review Is Unconstitutional	49
IX.	CONCLUSION.....	50

..

TABLE OF AUTHORITIES

Cases

<i>Apple Inc. v. Samsung Elecs. Co.,</i> 839 F.3d 1034 (Fed. Cir. 2016)	41
<i>Arthrex, Inc. v. Smith & Nephew, Inc.,</i> 941 F.3d 1320 (Fed. Cir. 2019)	49
<i>Bettcher Indus. v. Bunzl USA,</i> 661 F.3d 629 (Fed. Cir. 2011)	33
<i>Corning Glass Works v. Sumitomo Elec. U.S.A., Inc.,</i> 868 F.2d 1251 (Fed. Cir. 1989)	35
<i>Edwards Lifesciences Corp. v. Boston Scientific Scimed, Inc.,</i> IPR2017-01298, Paper 8 (PTAB Oct. 25, 2017).....	35
<i>Guangdong Alison Hi-Tech Co., Ltd. v. Aspen Aerogels, Inc.,</i> IPR2017-00413, Paper 10 (PTAB June 8, 2017)	35
<i>In re Oelrich,</i> 666 F.2d 578 (C.C.P.A. 1981)	33
<i>Institut Pasteur v. Focarino,</i> 738 F.3d 1337 (Fed. Cir. 2013)	42, 44
<i>Intri-Plex Techs. Inc. et al. v. Saint-Gobain Performance Plastics Rencol Ltd.,</i> IPR2014-00309, Paper 83 (PTAB Mar. 23, 2014)	44
<i>Jack Guttman, Inc. v. Kopykake Enters.,</i> 302 F.3d 1352 (Fed. Cir. 2002).....	16
<i>LG Elecs., Inc. v. Wi-LAN Inc.,</i> IPR2018-00704, Paper 14 (PTAB Sept. 5, 2018).23	
<i>Lucia v. SEC,</i> 138 S. Ct. 2044 (2018).....	49
<i>NHK Spring Co., Ltd., v. Intri-Plex Technologies, Inc.,</i> IPR2018-00752, Paper 8 (PTAB Sept. 12, 2018).....	26

...

<i>Polaris Indus. v. Arctic Cat</i> , 882 F.3d 1056 (Fed. Cir. 2018)	40
<i>Transclean Corp. v. Bridgewood Servs.</i> , 290 F.3d 1364 (Fed. Cir. 2002)	31, 33, 35
<i>Transocean Offshore Deepwater Drilling, Inc. v. Maersk Drilling USA, Inc.</i> , 699 F.3d 1340 (Fed. Cir. 2012)	37
<i>United States v. Booker</i> , 543 U.S. 220 (2005).....	49
<i>Vitronics Corp. v. Conceptronic</i> , 90 F.3d 1576 (Fed. Cir. 1996)	16
<i>WBIP, LLC v. Kohler Co.</i> , 829 F.3d 1317 (Fed. Cir. 2016)	47
<i>Wyers v. Master Lock Co.</i> , 616 F.3d 1231 (Fed. Cir. 2010)	44
Other Authorities	
35 U.S.C. § 100(i)(1)(A).....	15
35 U.S.C. § 311(b)	14
35 U.S.C. § 314(a)	i, 25
35 U.S.C. § 316(b)	25
37 C.F.R. § 42.108	25
AIA § 3(n)(1)	15
MPEP § 2159.02	15
MPEP § 2163(II)(A)(3)(b).....	15
U.S.C. §314(a)	25

...

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.