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Trials@uspto.gov
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Paper
Date:

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.

IPR2020-00126
Patent 8,048,032 B2

Before SHERIDAN K. SNEDDEN, JON B. TORNQUIST, and
CHRISTOPHER G. PAULRAJ, *Administrative Patent Judges*.

PAULRAJ, *Administrative Patent Judge*.

JUDGMENT

Final Written Decision

Determining No Challenged Claims Unpatentable
Not Deciding Patent Owner's Contingent Motion to Amend
35 U.S.C. § 318(a)

ORDER

Denying Petitioner's Motion to Exclude (Paper 111)
37 C.F.R. § 42.64(c)

I. INTRODUCTION

A. Background and Summary

This is our Final Written Decision entered pursuant to 35 U.S.C. § 318(a) and 37 C.F.R. § 42.73. For the reasons explained in our analysis below, we determine that the primary reference relied upon by Petitioner for all its patentability challenges does not qualify as prior art because Patent Owner has antedated that reference. Thus, Petitioner has not demonstrated that any of the challenged claims are unpatentable in this proceeding.

On November 12, 2019, Medtronic, Inc. and Medtronic Vascular, Inc. (collectively, “Petitioner”) filed a Petition requesting an *inter partes* review of claims 1–20 and 22 of U.S. Patent No. 8,048,032 B2 (“the ’032 patent,” Ex. 1001). Paper 1 (“Pet.”). Teleflex Innovations S.À.R.L. (“Patent Owner”)¹ filed a Preliminary Response. Papers 8 (confidential version), 9 (redacted version) (“Prelim. Resp.”). In our Institution Decision, we determined that there was a reasonable likelihood that Petitioner would prevail with respect to at least one challenged claim and accordingly, instituted an *inter partes* review pursuant to 35 U.S.C. § 314 based on all challenges presented in the Petition. Paper 22 (“Institution Decision” or “Inst. Dec.”).

Following institution, Patent Owner filed two post-institution responses: (1) a Consolidated Response Addressing Conception and

¹ Patent Owner represents that “Teleflex Innovations S.A.R.L. merged into Teleflex Medical Devices S.A.R.L,” which subsequently “transferred ownership of [the ’032 patent] to Teleflex Life Sciences Limited.” Paper 7, 2.

Reduction to Practice (Paper 39 (“PO CRTP Response” or “PO CRTP Resp.”)) and (2) a post-institution Response addressing Petitioner’s anticipation and obviousness arguments (Papers 43 (confidential version), 44 (redacted version) (“PO Resp.”)).

Petitioner filed a Reply to Patent Owner’s Response Addressing Conception and Reduction to Practice (Papers 78 (confidential version), 79 (redacted version) (“Pet. CRTP Reply”)) and a Reply to Patent Owner’s Response (Papers 83 (confidential version), 82 (redacted version) (“Reply”)). Patent Owner then filed its post-institution Sur-Reply Addressing Conception and Reduction to Practice (Paper 97 (“PO CRTP Sur-Reply”)), and Petitioner filed its post-institution Sur-Reply Addressing Conception and Reduction to Practice (Paper 112 (“Pet. CRTP Sur-Sur-Reply”)). Patent Owner also filed a post-institution Sur-Reply to Petitioner’s Reply to Patent Owner’s Response (Papers 103 (confidential version), 104 (redacted version) (“PO Sur-Reply”)).

Patent Owner also filed a Contingent Motion to Amend. Paper 38 (original), Paper 96 (corrected) (“Motion”).² The Motion requests that if any of claims 1, 11, or 16 is found unpatentable, they should be replaced by proposed substitute claims 23–25. Motion 1. Petitioner filed an Opposition to Motion to Amend. Paper 102. Patent Owner filed a Reply in Support of the Corrected Motion to Amend (Paper 106), and Petitioner filed a Sur-Reply (Paper 114).

² Pursuant to a stipulation by the parties, we authorized the filing of the corrected Motion to Amend in order to clarify certain antecedent bases and thereby simplify the issues.

An oral hearing was held on March 8, 2021, and a transcript of the hearing is included in the record. Papers 125 (redacted version) (“Tr.”), 126 (confidential version).

B. Real Parties-in-Interest

Petitioner identifies Medtronic, Inc. and Medtronic Vascular, Inc., as the real parties-in-interest, and notes that “Medtronic plc is the ultimate parent of both entities.” Pet. 5. Patent Owner identifies the real parties-in-interest for itself as Teleflex Medical Devices S.À.R.L., Vascular Solutions LLC, Arrow International, Inc., Teleflex LLC, and Teleflex Life Sciences Limited and notes that “Teleflex Incorporated is the ultimate parent of the entities listed above.” Paper 4, 2; Paper 7, 2.

C. Related Matters

Patent Owner is asserting the '032 patent against Petitioner in the United States District Court for the District of Minnesota in *Vascular Solutions LLC, et al. v. Medtronic, Inc., et al.*, No. 19-cv-01760 (D. Minn., filed July 2, 2019). Pet. 5; Paper 4, 2. The '032 patent is also the subject of a declaratory judgement action filed by another party, *QXMedical, LLC v. Vascular Solutions, LLC*, No. 17-cv-01969 (D. Minn., filed June 8, 2017), which was stayed pending our Institution Decision. Paper 19; Paper 20. The '032 patent was also previously the subject of litigation in the District of Minnesota in *Vascular Solutions, Inc. v. Boston Scientific Corp.*, No. 13-cv-01172 (D. Minn., filed May 16, 2013), and the subject of previous *inter partes* reviews in IPR2014-00760 and IPR2014-00761 filed by Boston Scientific Corp., which terminated based on settlement. Pet. 5.

Petitioner has also filed another petition challenging the '032 patent based on different prior art. IPR2020-00127. We also instituted *inter partes* review in IPR2020-00127. IPR2020-00127, Paper 20. In addition, Petitioner has filed concurrent petitions challenging related reissue patents: RE45,380 (IPR2020-00128; IPR2020-00129; IPR2020-00130; IPR2020-00131), RE45,760 (IPR2020-00132; IPR2020-00133; IPR2020-00134), RE45,776 (IPR2020-00135; IPR2020-00136), and RE47,379 (IPR2020-00137; IPR2020-00138).

D. The '032 Patent (Ex. 1001)

The '032 patent, entitled “Coaxial Guide Catheter for Interventional Cardiology Procedures,” issued on November 1, 2011, from a non-provisional application filed May 3, 2006. Ex. 1001, codes (45), (54), (22).

The '032 patent relates generally to a coaxial guide catheter for use with interventional cardiology devices that are insertable into a branch artery that branches off from a main artery. Ex. 1001, Abstract. According to the '032 patent, interventional cardiology procedures often include inserting guidewires or other instruments through catheters into coronary arteries that branch off from the aorta. *Id.* at 1:15–17. In coronary artery disease, the coronary arteries may be narrowed or occluded by atherosclerotic plaques or other lesions in a phenomenon known as stenosis. *Id.* at 1:20–26. In treating the stenosis, a guide catheter is inserted through the aorta and into the ostium of the coronary artery, sometimes with the aid of a guidewire, and is passed beyond the occlusion or stenosis. *Id.* at 1:30–36. However, crossing tough lesions can create enough backward force to dislodge the guide catheter from the ostium of the artery being treated, which can make it

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