

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
Case IPR2020-00127
Patent 8,048,032

**PATENT OWNER'S CONTINGENT MOTION TO AMEND
U.S. PATENT 8,048,032 UNDER 37 C.F.R. § 42.121**

TABLE OF CONTENTS

	PAGE
I. INTRODUCTION	1
II. LEGAL STANDARDS FOR AMENDING CLAIMS	1
III. CLAIM LISTING	1
IV. SCOPE OF THE SUBSTITUTE CLAIMS.....	2
V. WRITTEN DESCRIPTION SUPPORT.....	2
A. Substitute Claim 23	3
B. Substitute Claim 24	5
C. Substitute Claim 25	7
VI. THE LEVEL OF ORDINARY SKILL IN THE ART	8
VII. THE SCOPE AND CONTENT OF THE PRIOR ART.....	8
VIII. THE PROPOSED SUBSTITUTE CLAIMS ARE PATENTABLE.....	9
A. Substitute Claims 23-25: None of the Prior Art Discloses or Suggests the Claimed Combination of Features Including the Recited Complex Side Opening	9
B. Substitute Claims 23 and 25: The Prior Art Does Not Disclose or Suggest the Claimed Combination of Elements, Including a Tubular Structure Having a Coaxial 0.056 Lumen Configured For Use With a 6 French Guide Catheter	15
C. Substitute Claims 24-25: The Prior Art Does Not Disclose or Suggest the Claimed Combination of Elements, Including a Coaxial Lumen With a Reinforced Portion Having a Uniform, Fixed Outer Diameter Where the Reinforced and Substantially Rigid Portions Provide Backup Support	18
IX. CONCLUSION.....	20

TABLE OF AUTHORITIES

<i>Cases</i>	<i>Page(s)</i>
<i>Cooper Cameron Corp. v. Kvaerner Oilfields Prods., Inc.</i> , 291 F.3d 1317 (Fed. Cir. 2002)	3
<i>Graham v. John Deere Co.</i> , 383 U.S. 1 (1966).....	13
<i>Indivior Inc. v. Dr. Reddy’s Labs., S.A.</i> , 930 F.3d 1325 (Fed. Cir. 2019)	2
<i>KSR Int’l Co. v. Teleflex Inc.</i> , 550 U.S. 398 (2007).....	13
<i>Lectrosonics, Inc. v. Zaxcom, Inc.</i> , IPR2018-01129, Paper 15 (PTAB Feb. 25, 2019).....	1
Memorandum re: Guidance on Motions to Amend in view of <i>Aqua Products</i> (Nov. 21, 2017)	1
<i>Vas-Cath Inc. v. Mahurkar</i> , 935 F.2d 1555 (Fed. Cir. 1991)	3
 <i>Statutes</i>	
35 U.S.C. § 102.....	9
35 U.S.C. § 103.....	9
35 U.S.C. § 316.....	1, 2
 <i>Other Authorities</i>	
37 C.F.R. § 42.121	1, 2, 9
37 C.F.R. § 42.22	1

I. INTRODUCTION

Patent Owner Teleflex submits this Contingent Motion to Amend U.S. Patent 8,048,032 (“Motion”), with the Declaration of Peter T. Keith in Support of Motions to Amend (“Ex-2124”), under 37 C.F.R. § 42.121. This motion does not seek preliminary guidance. If, after considering Teleflex’s Patent Owner Responses, the Board finds any of issued claims 1, 11, or 16 of the ’032 patent invalid, Teleflex respectfully requests that the Board substitute the invalid claim(s) with the respective proposed substitute claim of claims 23-25. *See* 37 C.F.R. § 42.22(a)(2); 35 U.S.C. § 316(d).

II. LEGAL STANDARDS FOR AMENDING CLAIMS

A motion to amend must (1) propose a reasonable number of substitute claims, (2) that respond to a ground of unpatentability involved in the trial, (3) that do not enlarge the scope of the claims or introduce new matter, and (4) are not shown by a preponderance of the evidence to be unpatentable. *See* Memorandum re: Guidance on Motions to Amend in view of *Aqua Products* (Nov. 21, 2017) at 2; 35 U.S.C. § 316(d); 37 C.F.R. § 42.121. It is Petitioner’s burden to show that the proposed substitute claims are unpatentable. *Lectrosonics, Inc. v. Zaxcom, Inc.*, IPR2018-01129, Paper 15 at 4 (PTAB Feb. 25, 2019).

III. CLAIM LISTING

Pursuant to 37 C.F.R. § 42.121(b), Appendix A lists the changes made to the issued claims of the ’032 patent that would be replaced under this Motion. This

claim listing includes one replacement claim for each of claims 1, 11, and 16. The number of proposed substitute claims is reasonable under 35 U.S.C. § 316(d)(1)(B) and 37 C.F.R. § 42.121(a)(3).

IV. SCOPE OF THE SUBSTITUTE CLAIMS

The proposed substitute claims comply with 35 U.S.C. § 316(d)(3) and 37 C.F.R. § 42.121(a)(2)(ii) because no substitute claim enlarges the scope of, or eliminates any element from, the original claim it replaces. All amendments reflected in substitute claims 23-25 are narrowing amendments, in that all amendments only add limitations to the claims without removing language.

V. WRITTEN DESCRIPTION SUPPORT

Substitute claims 23-25 are fully supported by the priority application¹ because “the disclosure . . . reasonably conveys to those skilled in the art that the inventor had possession of the claimed subject matter as of the filing date.” *Indivior Inc. v. Dr. Reddy’s Labs., S.A.*, 930 F.3d 1325, 1347 (Fed. Cir. 2019) (citation to quoted case omitted); 37 C.F.R. § 42.121(b); *see* Ex-2124, ¶¶ 22-27. “Drawings constitute an adequate description if they describe what is claimed and

¹ The parties have stipulated that all patents at issue in these IPRs have substantively identical disclosures, and have agreed to cite only the priority application, IPR2020-00126, Ex. 1003, cited herein as “Ex. 1003 at XX.”

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.