

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MEDTRONIC, INC. AND MEDTRONIC VASCULAR, INC.

Petitioners,

v.

TELEFLEX INNOVATIONS S.À.R.L.,

Patent Owner

Cases IPR2020-0126, IPR2020-0127
U.S. Patent No. 8,048,032

**PETITIONERS' EXPLANATION OF MATERIAL DIFFERENCES
BETWEEN PETITIONS AND PETITION RANKING FOR
U.S. PATENT NO. 8,048,032**

Medtronic, Inc. and Medtronic Vascular, Inc. (“Petitioners”) filed concurrent *inter partes* review (“IPR”) petitions against U.S. Pat. No. 8,048,032 (“the ’032 Patent;” Ex-1401), but the claims are split so only two petitions challenge a given claim. The Board should consider and institute both petitions.

1. Two petitions are necessary because of a priority date dispute.

The Board’s Trial Practice Guide states that “more than one petition may be necessary” where, as here, “there is a dispute about priority date requiring arguments under multiple prior art references.” TPG UPDATE (July 2019) at 26. Petitioners filed two petitions per claim for this exact reason, as outlined below.

Itou-Based Petition	
Petition 1 IPR2020-0126	<p>Ground 1: Claims 1-19 and 22 as anticipated by U.S. Patent No. 7,736,355 (“Itou”).</p> <p>Ground 2: Claims 3, 13, and 14 as obvious over Itou in view of U.S. Patent No. 7,604,612 (“Ressemann”), and/or the knowledge of a POSITA.</p> <p>Ground 3: Claim 20 as obvious over Itou in view of U.S. Patent No. 5,911,715 (“Berg”), and/or the knowledge of a POSITA</p>
Kontos-Based Petition	
Petition 2 IPR2020-0127	<p>Ground 1: Claims 1-7, 9, 11-16, and 18-19 of the ’032 Patent as obvious over U.S. Patent No. 5,439,445 (“Kontos”) in view of U.S. Patent Pub. 2004/0010280 (“Adams”), and/or the knowledge of a POSITA</p> <p>Ground 2: Claims 8 and 17 as obvious over Kontos in view of Adams, Takahashi et al., <i>New Method to Increase a Backup Support of a 6 French Guiding Coronary Catheter</i>, and published in 2004 (“Takahashi”), and/or the knowledge of a POSITA</p>

Ground 3: Claim 20 as obvious over Kontos in view of Adams, Berg, and/or the knowledge of a POSITA

Petition 1 asserts Itou as the primary reference. Itou was filed (and has an effective filing) date of September 23, 2005. (Ex-1407.) But Patent Owner has alleged a conception and reduction to practice date in 2004—a date much earlier than the priority date on the face of the '032 Patent.¹ (Ex-1484; Ex-1401.)

Petitioners therefore submitted a second Petition (Petition 2) that covers a similar set of claims as Petition 1 but asserts prior art references with priority dates *before* 2004. This second petition (Petition 2) relies on Kontos as the primary reference. Kontos issued on August 8, 1995, and it is prior art under at least § 102(b). (Ex-1409.) Patent Owner is not able to swear behind Kontos, as it may attempt to do for Itou in Petition 1.

The Board's decision in *Microsoft Corp. v. IPA Technologies, Inc.* is instructive. IPR2019-00810, Paper 12 (PTAB Oct. 16, 2019). There, as here, the Patent Owner raised a priority date issue necessitating “arguments under multiple prior art references.” IPR2019-00810, Paper 12 at 15. In *Microsoft Corp.* the priority date dispute concerned a single prior art reference. Here, the priority dispute is more fundamental—Patent Owner has raised a priority date issue

¹ The '032 Patent claims priority to U.S. Pat. No. 8,292,850, which, on its face, is entitled to a priority date of May 3, 2006. (Ex-1401.)

regarding the challenged patent itself. It would be manifestly unfair and prejudicial to Petitioner if the Board exercises its discretion under § 314(a) to deny Petition 2 and post-institution Patent Owner successfully swears behind Itou. Accordingly, the Board should consider and institute Petition 1 *and* Petition 2.

2. Two petitions are necessary because of the length and number of claims asserted by Patent Owner in district court.

The '032 Patent has 22 lengthy claims. Claims 1 and 11 of the '032 Patent consist of a combined 628 words. Indeed, in Petition 1 recitation of the challenged claims alone takes up over 1,400 words—more than 10% of Petitioner’s allotted word count.

Given Patent Owner’s allegations in district court, Petitioners must also challenge substantially all claims of the '032 Patent. The Board’s Trial Practice Guide states that “more than one petition may be necessary” where, as here, “the patent owner has asserted a large number of claims in litigation.” TPG UPDATE (July 2019) at 26. In the district court litigation, Patent Owner has refused to identify the specific claims—or a specific number of claims—it will assert against Petitioner. (Ex-1479 ¶ 30 (“Medtronic has infringed and continues to infringe one or more claims of the '032 patent, including at least claims 12 and 14...”); *see also* Ex-1483 at 2 (¶ 5d).)

The Board’s decision in *Microsoft Corp.* is again instructive. There, as here, “word count limitations and a large number of challenged claims” supported the

filing of multiple petitions. IPR2019-00810, Paper 9 at 14. In *Microsoft Corp.*, the patent owner generally alleged infringement of “one or more claims” of the subject patent. IPR2019-00810, Paper 9, 1 (“The complaint identified only claim 61, while generally alleging that Petitioner infringed ‘one or more claims.’”) The patent owner also opposed the streamlining of disputed issues, rejecting petitioner’s proposal to consider a set of twenty-four exemplary claims. IPR2019-00810, Paper 9 at 13.

Here, too, Petitioner cannot reasonably fit its arguments into a single petition. Petitioner cannot reasonably fit both its Itou-based and Kontos-based arguments into a single petition—both of which are necessary, as outlined above—because of Patent Owner’s position regarding its alleged conception and reduction to practice date. And Patent Owner has rejected reasonable proposals to narrow the parties’ dispute (*See* Ex-1483 at 2 (¶ 5d).)

3. The Board should consider and institute both petitions, beginning with Petition 1 and then Petition 2.

For the reasons set forth above, Petitioners respectfully request consideration and institution of both Petition 1 and Petition 2. Petitioners request that the Board consider its petitions in the following order: Petition 1 (IPR2020-0126), followed by Petition 2 (IPR2020-0127).

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