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 OPPOSITION
TO PATENT OWNER'S CORRECTED MOTION TO AMEND

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I. INTRODUCTION

Medtronic, Inc., and Medtronic Vascular, Inc., ("Petitioner") opposes Patent Owner's Corrected Contingent Motion to Amend ("Mot."). Patent Owner ("PO") seeks to amend claims 1, 11, and 16 and proposes substitute claims 23-25. (Mot., 1, Appendix A ("App.").) But the substitute claims are not supported by the original disclosure and are unpatentable over the prior art. PO's Motion should be denied.

II. PROPOSED CLAIMS 23-25 LACK WRITTEN DESCRIPTION OR ARE INDEFINITE.

A. Claims reciting a side opening outside of the substantially rigid portion lack support.

Proposed claim 23 recites a "device for use with a standard 6 French guide catheter … comprising, *in a distal-to-proximal direction* … a flexible tip portion … [a] side opening … and a substantially rigid portion[.]" (App., 1-2.)[1] Similarly, proposed claim 24 recites "a side opening positioned between a proximal end of the reinforced portion and a distal end of the substantially rigid portion." (*Id*., 4.) A POSITA would understand that claims 23 and 24 require a side opening that is separate from (distal to) the "substantially rigid portion." (Ex. 1919, ¶¶ 48-52; *see also* Mot., 4 ("The claim need not expressly recite that the side opening is in the substantially rigid portion.").) But the written description exclusively and repeatedly

[1] All emphasis and annotations added unless otherwise specified.

describes the side opening as *part of* the substantially rigid portion of the claimed device. Thus, proposed claims 23 and 24 should be rejected for lack of written description.

The original patent application describes the invention as a device that is used with "standard guide catheters" in "interventional cardiology procedures." (Ex. 1842, 7-8.) The claims of the original patent application (and the proposed claims here) are generally directed to the "coaxial guide catheter" described in the specification. (*See*, *e.g.*, *id*., 38-44; *see also* POR, 4 (also describing the invention as a "guide extension catheter").) This coaxial guide catheter is consistently described as being made of three distinct portions: "a tip portion, a reinforced portion, and a substantially rigid portion." (Ex. 1842, 9; *see also id.*, 16 (alternatively describing the final section as a "rigid portion 20").) Each of these portions has a specified composition—the tip portion is "a low durometer polymer or elastomer"; the reinforced portion is made of PTFE, Pebax®, and may be reinforced with "metallic fibers in a braided or coiled pattern"; and the rigid portion is "formed from a stainless steel or Nitinol tube." (*Id.*, 9.)

The only portions of the specification that describe a side opening are in the parts describing the "rigid portion." (*Id.*, 9-10, 13-20, 38-41, 43, Figs. 4, 12-16; *see also* Ex. 1919, ¶¶ 28-41, 46-47.) Indeed, PO points to these portions as supporting the "side opening" limitations of the proposed claims. (Mot., 4, 7.)

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