UNITED STATES PATENT AD TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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MEDTRONIC, INC., AND MEDTRONIC VASCULAR, INC.,
Petitioner,

v.

TELEFLEX INNOVATIONS S.À.R.L.,
Patent Owner.

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Case IPR2020-00128
Patent RE 45,380

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PETITIONERS' REPLY TO PATENT OWNER'S PRELIMINARY RESPONSE

Medtronic had no obligation to address secondary considerations or reduction to practice in its Petition. Teleflex, as the Patent Owner, has the burden of production and proof and on those issues, respectively. Teleflex's arguments have not been fully developed, let alone adjudicated, before any District Court or in the Patent Office. Neither issue should be addressed until the trial phase.

I. Medtronic did not have to raise secondary considerations in its Petition.

Medtronic had no obligation to address secondary considerations in the Petition. The Board has repeatedly rejected similar arguments, including those involving allegations far more developed than the random assortment of evidence Teleflex presents here. *See, e.g.*, *Lowe's, Cos., Inc. v. Nichia Corp.*, IPR2017-02011, Paper 12 at *4-6 (POPR), Paper 13 at *18 (PTAB Mar. 12, 2018) (Institution Decision); *C&D Zodiac, Inc. v. b/e Aerospace, Inc.*, IPR2017-01275, Paper 6 at *53-56 (POPR), Paper 12 at *15 (PTAB Oct. 31, 2017) (Institution Decision); *Petroleum Geo-Services Inc. v. W. Geco LLC*, IPR2014-01477, Paper 12 at *40-41 (POPR), Paper 18 at *32 (PTAB Mar. 17, 2015) (Institution Decision). Indeed, the Board rejected the same argument from Teleflex's counsel in *Arctic Cat, Inc. v. Polaris Industries Inc.*, IPR2017-00433, Paper 17 at *9-10 (PTAB July 5, 2017). The Board explained that "Patent Owner does not identify, nor are we aware of any persuasive authority requiring Petitioner in this case to address secondary considerations, not previously presented to the Office, in the

Petition." *Id.* at *10. "[T]he burden of production rests on Patent Owner with regard to secondary considerations," and thus "full consideration of evidence of secondary considerations of this nature is not necessary" before institution. *Id*. at *10, *19.

The same rules apply here. Again, Teleflex's counsel identifies no case requiring a petitioner to address evidence of secondary considerations in its petition, absent a decision by the Patent Office, ITC, or District Court crediting that evidence. *See, e.g.*, *Stryker Corp. et al. v. KFx Med., LLC*, IPR2019-00817, Paper 10 at *27-28 (PTAB Sept. 16, 2019) ("[S]econdary considerations evidence was developed fully during the Arthrex Litigation, and the Federal Circuit affirmed the jury's verdict"). The Patent Office never addressed the issue during prosecution of this patent. *See* Exs. 1002-1003. Further, secondary considerations have not even been raised by Teleflex in litigation against Medtronic, let alone been fully developed or adjudicated. Teleflex argues that Medtronic should have cobbled together disparate disclosures to make Teleflex's argument for it, including from an infringement report in a different case (Ex. 2056) and a declaration on purported irreparable harm from preliminary injunction briefing (Ex. 2043), among other exhibits, none of which even mention secondary considerations. Requiring Petitioners to engage in guessing games would waste the parties' and the Board's resources. Under these circumstances, Medtronic did not have to raise secondary

considerations in its Petition.

II. Medtronic had no obligation to address conception and reduction to practice before Teleflex raised the issue.

Conception and reduction to practice are issues for the trial phase that Medtronic did not have to address in its Petition. The Board's rulings on Petitioner's obligations with respect to secondary considerations apply even more forcefully here, because "Patent Owner bears the burden of proof regarding its antedating contention." *Mylan Pharms. Inc. v. Boehringer Ingelheim Pharms. Inc.*, IPR2016-01563, Paper 14 at *4 (PTAB Dec. 7, 2016). Later, the "Petitioner is entitled to respond to the contention after discovery." *Id.* As the Board has explained, "[i]t is premature at the institution stage to address the merits of Patent Owner's antedating contention." *Id.*; *see also Pfizer Inc. v. Genentech, Inc.*, IPR2017-01488, Paper 27 at *15 (PTAB Dec. 1, 2017). And it has rejected arguments "that Petitioners were required in the Petition to foresee and prebut Patent Owner's argument and evidence purporting to show a reduction to practice of certain subject matter." *Associated British Foods PLC v. Cornell Research Found.*, IPR2019-00577, Paper 25 at *31 (PTAB July 25, 2019); *Mylan*, Paper 14 at *3-4. Medtronic had no obligation to do so either.

Teleflex disclosed limited evidence on conception and reduction to practice in the litigation prior to the filing of Medtronic's Petition. In its first interrogatory response from August 15, 2019, Teleflex only disclosed that "the inventors came

up with the idea for what became the GuideLiner catheter product and that led to the inventions claimed in the patents-in-suit at some point in 2004 after the annual Transcatheter Cardiovascular Therapeutics conference that took place in late September of that year." Ex. 2045 at 3-4. The response identified just three supporting documents dated in 2005 and were marked attorney's eyes only ("AEO"). *Id.* at 4; *see, e.g.*, Exs. 2003-2004. That disclosure did not present a complete picture of Teleflex's arguments—it did not even identify a particular date of alleged conception or reduction to practice.

Teleflex did not begin to disclose its actual positions until much later. On November 6, 2019 (less than a week before Medtronic filed its Petition) Teleflex supplemented its interrogatory response to provide its first narrative explanation, marking it AEO. In total, prior to the Petition's filing, Teleflex only disclosed roughly 17 exhibits and its supplemental interrogatory responses. Exs. 2002-2004, 2014-2015, 2017-2019, 2022-2025, 2027, 2036, 2040-2041, 2043, 2045. All of the documents were designated AEO and raised more questions than they clarified Teleflex's position. For example, invoices for part orders do not show conception and reduction to practice of any particular claim limitation. *See, e.g.*, Ex. 2027. Nor did drawings of potential catheter designs, which Teleflex did not map to each and every limitation in its responses. Ex. 2022. Moreover, several days was not sufficient time to explicate Teleflex's arguments and then respond.

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