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 IPR2020-00128
Patent RE 45,380

PATENT OWNER'S SUR-REPLY TO PETITIONER'S REPLY TO PRELIMINARY RESPONSE

I. MEDTRONIC ACTIVELY SOUGHT, THEN IGNORED, TELEFLEX'S EVIDENCE SHOWING A PRIOR INVENTION DATE

Medtronic argues it is not "required in the Petition to foresee and prebut" Teleflex's invention date evidence. Paper 12 at 3. But Medtronic fails to acknowledge that it both requested and obtained the details of Teleflex's invention date and supporting evidence before filing its Petition. Months before filing its Petition, Medtronic demanded expedited discovery in the related district court case, including discovery specifically directed to Teleflex's asserted conception and reduction to practice. Ex. 2075 at 10–11; Ex. 2045. Medtronic's request was granted, and Teleflex produced documents and served a lengthy Interrogatory Response describing in detail the timeline over which the invention was conceived and reduced to practice and identifying supporting evidence. Ex. 2045 at 3–10.

Medtronic now complains that this Interrogatory Response was served "less than a week before Medtronic filed its Petition." Paper 12 at 4. But the date on which Medtronic chose to file its Petition was ***entirely*** within Medtronic's control. When Medtronic filed its 13 IPR petitions, it still had seven months before the one-year statutory deadline. Medtronic strategically timed the filing of its 13 IPR petitions to use them as a tool to try to convince the district court to deny Teleflex's preliminary injunction motion. *See* Paper 9 at 3, 25. Further, Medtronic's argument is belied by the fact it filed an expert declaration in the district court case that addressed Teleflex's prior invention evidence a mere ***three***

days after filing its Petition. *Vascular Sols. LLC v. Medtronic, Inc.*, No. 19-cv-01760, Dkt. 112 at ¶¶ 29–36 (D. Minn. Nov. 15, 2019).

Medtronic admits it had at least 17 of the exhibits supporting Teleflex's pre-Itou invention before filing the Petition. Paper 12 at 4. Medtronic mischaracterizes the nature of the additional "new exhibits" Teleflex submitted in connection with its Preliminary Response. These exhibits, which Teleflex located after it served the Interrogatory Response, merely provide additional corroboration for the timeline and evidence Medtronic already had. Prior to filing its Petition, Medtronic knew Teleflex's prior invention position—and supporting evidence—in the form of Teleflex's detailed Interrogatory Response narrative that also identified dozens of supporting documents. That additional evidence was provided later does not excuse Medtronic from addressing the extensive evidence it already had.

Medtronic next argues that its IPR counsel did not have access to Teleflex's Interrogatory Response and supporting documents. Paper 12 at 5. But this argument misses the mark — Medtronic (the party) was fully aware of, and had access to, this information. Medtronic cannot claim ignorance based on its decision to hire separate IPR and litigation counsel. Further, Medtronic *never asked* Teleflex whether it could use the prior invention information in connection with its Petitions. Medtronic's attempt to remain ignorant was further demonstrated when, prior to filing its Petitions, it noticed and then withdrew a Rule

30(b)(6) corporate deposition topic on conception and reduction to practice. Ex. 2076 at Topic No. 24; Ex. 2077.

Medtronic incorrectly argues that depriving it of an opportunity to rebut Teleflex's arguments will shift the burden of proof. The issue currently before the Board is whether Medtronic's Petition justifies a lengthy and duplicative IPR proceeding to evaluate the validity of Teleflex's patents. Medtronic's failure to address the key issue of whether its lead reference qualifies as prior art deprived the Board of information necessary to decide whether institution is warranted.

II. MEDTRONIC WAS FULLY AWARE OF EVIDENCE OF SECONDARY CONSIDERATIONS

Medtronic argues for a bright-line rule that a petition need only address secondary considerations when there has been "a decision by the Patent Office, ITC, or District Court crediting that evidence." Paper 12 at 2. No such rule exists, and the Board should decline Medtronic's invitation to create one. As the Board's prior decisions demonstrate, whether a petitioner must address secondary considerations in a petition is fact-specific. *See, e.g.*, *Robert Bosch Tool Corp. v. SD3, LLC*, IPR2016-01753, Paper 15 at 28–30 (PTAB Mar. 22, 2017) ("*In this particular case*, we determine it is appropriate to review and address the objective evidence of nonobviousness proffered by the Patent Owner for purposes of this Decision [Denying Institution].") (emphasis added). The fact that Medtronic can cite cases where, on the facts of those particular cases, the Board found that a

patent owner failed to meet its burden of production concerning secondary considerations is irrelevant. Indeed, in *Robert Bosch Tool Corp.*, the Board considered secondary considerations at the institution stage even though the ITC Initial Determination issued ***after*** the petition was filed. IPR2016-01753, Paper 15 at 30 n.9.

Contrary to Medtronic's assertion that it must "cobble[] together disparate disclosures to make Teleflex's argument for it," (Paper 12 at 2), Medtronic was fully aware of the objective evidence supporting the validity of the GuideLiner patents. For example, Teleflex's motion for preliminary injunction in the district court case—filed over a month before Medtronic filed its Petition—contained ***three separate sections*** with ***specific titles*** directed to long-felt need, commercial success and copying. Ex. 1073 at 2, 5, 9. The objective evidence was also provided in other documents that Medtronic already had, as explained in detail in the Preliminary Response. *See, e.g.*, Ex. 2043 (Welch Decl.), ¶¶ 4, 9–18, 34–35; Ex. 2046 (Root 2013 Decl.) ¶ 39, 43–45. In the parallel district court case, Medtronic has even deposed a Teleflex Director of Sales. What's more, a mere *three days* after filing its first Petition, Medtronic filed two declarations in the district court seeking to explain, substantively, why Teleflex's evidence did not actually show copying. *Teleflex v. Medtronic*, Dkt. 110, ¶¶ 61–67, Dkt. 109. There is no reason Medtronic could not have done the same thing in the

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