

IPR2020-00128
Patent RE 45,380

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.: IPR2020-00128
U.S. Patent No. RE 45,380

PETITIONERS' REQUEST FOR ORAL ARGUMENT

Pursuant to 37 C.F.R. § 42.70, Petitioner hereby respectfully requests oral argument. The Consolidated Scheduling Order (Paper 26) set one day, March 8, 2021, for oral argument. Petitioner believes a typical day includes six hours on the record. Accordingly, Petitioner respectfully requests a total of six hours for a one-day hearing according to the following schedule: (1) 30 minutes of argument per side regarding the consolidated conception and reduction to practice issues for the patents challenged in IPR2020-00126, -00128, -00129, -00132, -00134, -00135, and -00137, (2) two hours of argument per side regarding the instituted grounds of invalidity in all eleven instituted IPRs in IPR2020-00126, -00127, -00128, -00129, -00130, -00132, -00134, -00135, -00136, -00137, and -00138, and (3) 30 minutes of argument per side regarding Patent Owner's five unique contingent motions to amend.

Patent Owner has indicated it may seek a total of seven hours of argument/testimony, with six hours of argument and one hour of live testimony from Mr. Howard Root, an inventor, concerning the consolidated conception and reduction to practice issues. Petitioner opposes any request for live testimony. If the Board wishes to consider allowing live testimony, Petitioner believes the issue should be fully briefed before any ruling by the Board.

Petitioner does not oppose additional time, however. If the Board is considering allotting seven hours, for instance, Petitioner would use the additional

time to address the myriad of issues Patent Owner has raised on the instituted grounds. Petitioner's proposed time for conception and reduction to practice and motions to amend would remain the same.

Issues to be argued in this IPR:

1. Whether the inventors conceived and reduced to practice the various claimed inventions prior to the filing of the Itou reference;
2. A determination that the patent is not entitled to its claim of priority and is instead an AIA patent;
3. Whether claims 1-4, 6-10, 12-20, and 23 are anticipated by U.S. Patent No. 7,736,355 ("Itou");
4. Whether claims 3, 14, and 15 are rendered obvious by Itou in view of U.S. Patent No. 7,604,612 ("Ressemann") and the knowledge of a POSITA;
5. Whether claim 21 is rendered obvious by Itou in view of U.S. Patent No. 5,911,715 ("Berg") and the knowledge of a POSITA;
6. Patent Owner's Contingent Motion to Amend and Petitioners' Opposition to the same; and
7. Any issues raised by the parties in any filings contemporaneous with or subsequent to this Request.

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Dated: January 28, 2021

Respectfully submitted,

/Cyrus A. Morton/

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CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.6(e)(4), the undersigned certifies that on January 28, 2021, a copy of PETITIONERS' REQUEST FOR ORAL ARGUMENT was served in its entirety by electronic mail on Patent Owner's counsel at the following addresses indicated in Patent Owner's Mandatory Notices:

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