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Paper
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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.

IPR2020-00128
Patent RE45,380

Before SHERIDAN K. SNEDDEN, JON B. TORNQUIST, and
CHRISTOPHER G. PAULRAJ, *Administrative Patent Judges*.

TORNQUIST, *Administrative Patent Judge*.

JUDGMENT

Final Written Decision

Determining No Challenged Claims Unpatentable
Not Deciding Patent Owner's Contingent Motion to Amend
35 U.S.C. § 318(a)

ORDERS

Denying Petitioner's Motion to Exclude (Paper 111)
37 C.F.R. § 42.64(c)

I. INTRODUCTION

Medtronic, Inc. and Medtronic Vascular, Inc. (collectively “Petitioner”) filed a Petition (Paper 1, “Pet.”) requesting an *inter partes* review of claims 1–4, 6–10, 12–21, and 23 of U.S. Reissue Patent RE45,380E (Ex. 1001, “the ’380 patent”). Teleflex Innovations S.À.R.L. (“Patent Owner”) ¹ filed a Preliminary Response to the Petition (Paper 8). Upon review of the Petition and Preliminary Response, we instituted an *inter partes* review of all claims on all grounds asserted in the Petition (Paper 22, “Inst. Dec.” or “Institution Decision”).

Patent Owner subsequently filed a Patent Owner Response (Paper 43, “PO Resp.”) (redacted version available at Paper 44), Petitioner filed a Reply (Paper 83, “Pet. Reply”) (redacted version available at Paper 82), and Patent Owner filed a Sur-Reply (Paper 103, “Sur-Reply”) (redacted version available at Paper 104).

With prior authorization of the Board, Patent Owner filed a Consolidated Response Addressing Conception and Reduction to Practice (Paper 39, “PO CRTP Resp.”), to which Petitioner filed Reply (Paper 78, “Pet. CRTP Reply”) (redacted version available at Paper 79), Patent Owner filed a Sur-Reply (Paper 97, “PO CRTP Sur-Reply”), and Petitioner filed a Sur-Sur-Reply (Paper 112, “Pet. CRTP Sur-Sur-Reply”).

Patent Owner also filed a Contingent Motion to Amend (Paper 38). The Motion requests that if claims 1 or 12 of the ’380 patent are determined

¹ Patent Owner represents that “Teleflex Innovations S.A.R.L. merged into Teleflex Medical Devices S.A.R.L,” which subsequently “transferred ownership of [the ’380 patent] to Teleflex Life Sciences Limited.” Paper 7, 2.

to be unpatentable, that the Board replace the unpatentable claim(s) with proposed substitute claims 43 and 44. Motion 1. Petitioner filed an Opposition to the Motion to Amend (Paper 85), to which Patent Owner filed a reply (Paper 106), and Petitioner filed a sur-reply (Paper 114).

An oral hearing was held on March 8, 2021, and a transcript of the hearing is included in the record. Paper 126 (“Tr.”) (redacted version available at Paper 125).

A. Real Parties in Interest

Petitioner identifies Medtronic, Inc. and Medtronic Vascular, Inc., as the real parties-in-interest, and notes that “Medtronic plc is the ultimate parent of both entities.” Pet. 5.

Patent Owner identifies the real parties-in-interest for itself as Teleflex Medical Devices S.À.R.L., Vascular Solutions LLC, Arrow International, Inc., and Teleflex LLC, and notes that “Teleflex Incorporated is the ultimate parent of the entities listed above.” Paper 4, 2.

B. Related Matters

The parties indicate that the ’380 patent is the subject of litigation in *Vascular Solutions LLC, et al. v. Medtronic, Inc., et al.*, No. 19-cv-01760 (D. Minn.) and *QXMedical, LLC v. Vascular Solutions, LLC*, No. 17-cv-01969 (D. Minn). Pet. 5–6; Paper 4, 2. The ’380 patent is also at issue in IPR2020-00129, IPR2020-00130, and IPR2020-00131 (institution denied). Paper 4, 3; Pet. 6.

The following proceedings before the Board also involve the same parties and related patents: IPR2020-00126 (U.S. Patent No. 8,048,032 B2), IPR2020-00127 (U.S. Patent No. 8,048,032 B2), IPR2020-00132 (U.S. Patent No. RE45,760 E1), IPR2020-00134 (U.S. Patent No. RE45,760 E1),

IPR2020-00128
Patent RE45,380E

IPR2020-00135 (U.S. Patent No. RE45,776 E1), IPR2020-00136 (U.S. Patent No. RE45,776 E1), IPR2020-00137 (U.S. Patent No. RE47379 E1), IPR2020-00138 (U.S. Patent No. RE47379 E1).

C. *The '380 Patent*

The '380 Patent is a reissue of U.S. Patent 8,292,850, and claims priority as a division of application No. 11/416,629, filed on May 3, 2006, now U.S. Patent 8,048,032. Ex. 1001, codes (62), (64). The '380 patent relates to catheters used in interventional cardiology procedures and, in particular, to “methods and apparatus for increasing backup support for catheters inserted into the coronary arteries from the aorta.” *Id.* at 1:31–35.

“In coronary artery disease the coronary arteries may be narrowed or occluded by atherosclerotic plaques or other lesions.” *Id.* at 1:44–46. This narrowing is referred to as stenosis. *Id.* at 1:48–49. To treat a stenosis, “it is commonly necessary to pass a guidewire or other instruments through and beyond the occlusion or stenosis of the coronary artery.” *Id.* at 1:49–52. In this method, a guide catheter is inserted through the aorta and into the ostium of the coronary artery where it is typically seated into the opening or ostium of the artery to be treated. *Id.* at 1:53–57. A guidewire or other instrument is then passed through the lumen of the guide catheter and inserted into the artery beyond the stenosis. *Id.* at 1:39–41, 1:57–59. Crossing the tough lesions, however, may create enough backwards force to dislodge the guide catheter from the ostium of the artery being treated, making it difficult or impossible to treat certain forms of coronary artery disease. *Id.* at 1:59–63.

Figures 1 and 2 of the '380 patent are reproduced below:

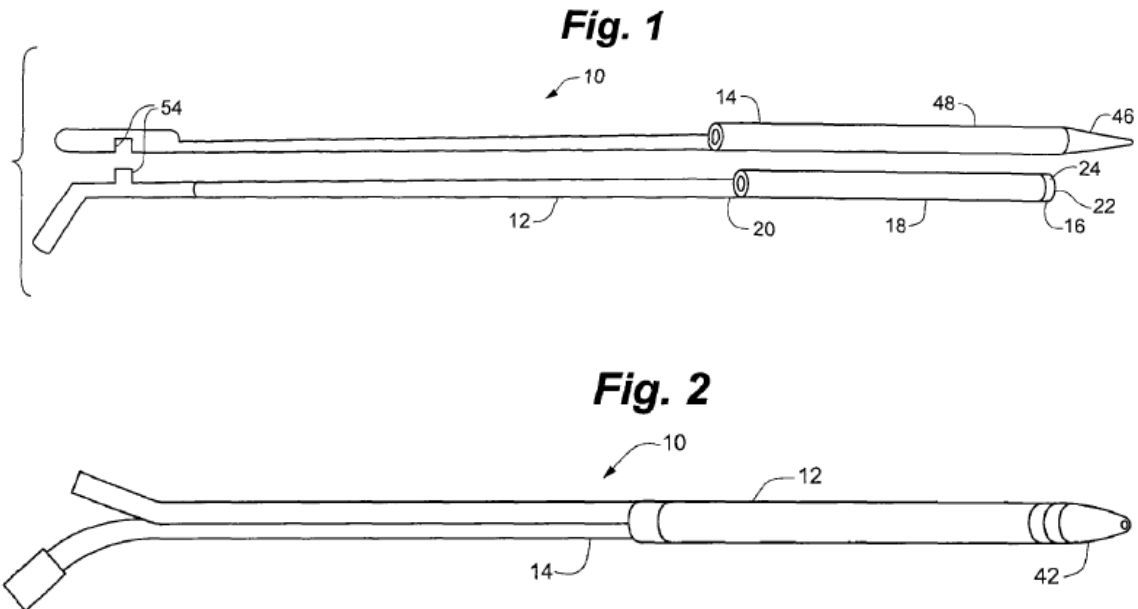


Figure 1 is a schematic depiction of a coaxial guide catheter and a tapered inner catheter and Figure 2 is a schematic depiction of these two elements assembled together. *Id.* at 5:40–45. As shown in Figure 1, coaxial guide catheter 12 includes tip portion 16, reinforced portion 18, and rigid portion 20. *Id.* at 6:34–35. Tapered inner catheter 14 includes tapered portion 46 at a distal end thereof and straight portion 48. *Id.* at 7:16–17. Clip 54 releasably joins tapered inner catheter 14 to coaxial guide catheter 12. *Id.* at 7:21–23.

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