

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 IPR2020-00128

Patent RE45,380

**PETITIONER'S REQUEST FOR DIRECTOR REHEARING
PURSUANT TO 37 C.F.R. § 42.71(d) AND *UNITED STATES V. ARTHREX***

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I. INTRODUCTION

Petitioner seeks Director review of the Final Written Decision (“FWD,” Paper 127) holding that the primary reference, Itou, is not prior art.¹ The Director should reverse and remand for consideration of the asserted grounds on the merits.

The Board erred in finding that Patent Owner’s predecessor, VSI, reduced the claimed coaxial guide catheter (or guide extension catheter) inventions to practice before Itou. The Board found that VSI assembled and tested prototypes embodying the inventions and determined that they would work for their intended purpose. The Board’s ruling on testing, however, cites only inventor testimony, in violation of established corroboration requirements. No document in the record relates to testing relevant prototypes or demonstrating that the prototypes would work for their intended purpose. The Board cited the declaration of a non-inventor, Erb, but not for any details regarding testing relevant prototypes (because he provides none).

The Board’s decision departs from binding authority establishing the contours of corroboration requirements. Neither the Board’s decision nor Patent Owner’s briefing cites a single case or Board decision finding that an invention was demonstrated to work for its intended purpose based on only after-the-fact, litigation-driven testimony, much less on only *inventor* testimony. Director review

¹ Petitioner requested a Precedential Opinion Panel by email.

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