

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 IPR2020-0128, IPR2020-0129, IPR2020-0130, IPR2020-00131
Patent RE 45,380E

**PATENT OWNER RESPONSE TO PETITIONER'S EXPLANATION OF
MATERIAL DIFFERENCES BETWEEN PETITIONS AND PETITION
RANKING FOR U.S. PATENT NO. RE 45,380E**

Petitioners Medtronic, Inc. and Medtronic Vascular, Inc. (collectively “Medtronic”) filed four separate petitions against the ’380 patent, challenging a total of only 35 claims. Further, Medtronic’s four petitions include a total of *seven different grounds* against a single claim—claim 27. IPR2020-00129, Paper 1 at 7 (Grounds 1, 2, 3, 4, and 9); IPR2020-00131, Paper 1 at 7 (Grounds 2, 3).

Medtronic’s strategic choice to rely on a section 102(e) reference does not justify institution of four petitions. Medtronic contends it needs four petitions because Teleflex is asserting an invention date that pre-dates the Itou reference (Ex. 1007). Paper 3 at 3–4. Teleflex did invent before the priority date of Itou. Indeed, Itou’s prior art status is at issue in the parallel district court litigation, and Medtronic was aware of substantial corroborated evidence showing Teleflex’s prior invention before it filed its Petitions. Nevertheless, Medtronic chose to rely on a § 102(e) reference and did *not even try to address* the issue of Teleflex’s invention date in its Petitions. Thus, this is not one of the “rare” cases in which “two petitions by a petitioner may be needed.” November 2019 Consolidated Trial Practice Guide (“TPG”) at 59. Where, as here, a Petitioner proceeds with filing petitions relying on a primary reference that it knows full-well is likely to be antedated, four petitions are not justified.

The Board routinely declines to institute multiple petitions, even where there is a priority date dispute. *See, e.g., Comcast Cable Commc’ns., LLC v. Rovi*

Guides, Inc., IPR2019-01354, Paper 10 at 6 (PTAB Jan. 27, 2020) (denying institution of two of three petitions where a potential priority dispute existed); *Dropbox, Inc. v. Whitserve LLC*, IPR2019-01018, Paper 13 at 8-9 (PTAB Nov. 1, 2019) (denying institution of a second petition where parties disputed the priority date of multiple prior art references); *Comcast Cable Comm'ncs, LLC v. Rovi Guides, Inc.*, IPR2019-00279, Paper 10 at 6–7 (PTAB July 1, 2019) (declining to institute four of five filed petitions where a potential priority dispute existed).

Furthermore, the TPG explains that three or more petitions are almost never appropriate (TPG at 59)—here Medtronic seeks institution of four. Medtronic has failed to justify why it needs not just two petitions, but four.

Medtronic cites *Microsoft Corp. v. IPA Techs Inc.*, IPR2019-00810, Paper 12 (PTAB Oct. 16, 2019). See Paper 3 at 3. But *Microsoft* was different. First, the petitioner in *Microsoft* explained that the “main difference” between its petitions was that each petition challenged different claims. *Microsoft*, IPR2019-00810, Paper 12 at 12. Thus, denying one of the petitions would completely eliminate the petitioner’s opportunity to challenge those claims. Here, in contrast, Medtronic filed multiple petitions attacking the *same* claims based on different references. Second, while Medtronic is correct that there was a potential dispute about the priority date of Microsoft’s Kiss reference, the petitioner explained that “the same analysis of the combination of Kiss/FIPA97 is the basic prior art

challenge *to every claim in each petition.*” *Id.* Paper 9 at 1–2 (emphasis added).

Thus, if the Kiss reference was found to not qualify as prior art, all of the petitions would fail. Consequently, the petitioner’s filing of multiple petitions was clearly not intended to provide a “back-up” petition because of a potential priority issue. Medtronic’s reliance on *Microsoft* is inapt.

Medtronic’s strategic choice to include excessive, duplicative challenges to the same claims does not justify institution of four petitions. Medtronic contends that the number and length of the claims, word count constraints, and the means-plus-function aspect of some claims requires four petitions. Paper 3 at 4–5. But here, the four Petitions challenge only a total of thirty-five claims—hardly an unusually high number. Medtronic also challenges the same claims on many duplicative grounds—far more than needed to provide “back-up” in the event the Itou reference is not prior art. For example, as explained above Medtronic challenges claim 27 on *seven separate grounds* across the four petitions.

While Medtronic proffers the means-plus-function as a justification, Medtronic’s Petitions state that the analysis is the same regardless of whether a claim is construed to be means-plus-function. *E.g.*, IPR2020-00129, Paper 1 at 23 (“If this limitation is not construed as means-plus-function, Ressemann’s same teachings satisfy this limitation.”), 25, 66, 68. Where the analysis would differ, Medtronic provides the alternate analysis in one sentence. *See id.* at 24, 68.

Further, Medtronic challenges independent claim 25 and various claims depending therefrom on *three* separate grounds, each based on a different lead reference: Itou, Ressemann, and Kontos. IPR2020-00129, Paper 1 at 7 (Ground 1, Ressemann; Ground 7, Itou); IPR2020-00131, Paper 1 at 7 (Ground 1, Kontos). Medtronic argues that it needs “Itou-based” based arguments (that raise the priority date issue) and back-up “Kontos-based” arguments (that do not raise the priority date issue). Paper 3 at 1–3, 5. But Medtronic *does not explain why it needs a third ground* against the same claims, based on a third reference (Ressemann).

Medtronic’s contention that it could not fit all arguments into a single petition is a problem it created itself. Rather than judiciously selecting its strongest arguments, Medtronic chose, for example, to advance *seven grounds* against claim 27, and *three* separate grounds against independent claim 25. Again, Medtronic’s reliance on *Microsoft* is inapposite. *Microsoft* concerned five petitions challenging *89 claims*; here Medtronic seeks to use four petitions to challenge only *35 claims*. See *Microsoft*, IPR2019-00810, Paper 12 at 14. Medtronic’s deliberate drafting choices do not reasonably justify pursuing an overly burdensome, inefficient, and unfairly duplicative attack on the ’380 patent. See, e.g., *Pfenex, Inc. v. GlaxoSmithKline Biologicals SA*, IPR2019-01027, Paper 12 at 13–14 (PTAB Nov. 13, 2019) (“[T]he mere fact that Petitioner may have had additional art to assert, including a different statutory basis for asserting that art, does not, on these facts,

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