UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MEDTRONIC, INC. AND MEDTRONIC VASCULAR, INC.

Petitioners,

v.

TELEFLEX INNOVATIONS S.À.R.L.,

Patent Owner

Cases IPR2019-0128, IPR2019-0129, IPR2019-0130, IPR2019-0131
U.S. Patent No. RE 45,380E

PETITIONERS' EXPLANATION OF MATERIAL DIFFERENCES BETWEEN PETITIONS AND PETITION RANKING FOR U.S. PATENT NO. RE 45,380E

Medtronic, Inc. and Medtronic Vascular, Inc. ("Petitioners") filed four concurrent *inter partes* review ("IPR") petitions against U.S. Pat. No. RE 45,380E ("the '380 Patent;" Ex-1201), but the claims are split such that only two petitions challenge a given claim. The Board should consider and institute all four petitions.

Two petitions per claim are necessary due to a priority date dispute. The Board's Trial Practice Guide states that "more than one petition may be necessary" where, as here, "there is a dispute about priority date requiring arguments under multiple prior art references." TPG UPDATE (July 2019) at 26. As outlined below, Petitioners filed two petitions per claim for this exact reason.

Itou-Based Petitions	
Petition 1A IPR2019-0128	**Ground 1**: Claims 1-4, 6-10, 12-20, and 23 as anticipated by U.S. Pat. No. 7,736,355 ("Itou") **Ground 2**: Claims 3, 14, and 15 as obvious over Itou in view of U.S. Pat. No. 7,604,612 ("Ressemann"), and/or the knowledge of a POSITA **Ground 3:** Claim 21 as obvious over Itou and U.S. Pat. No. 5,911,715 ("Berg"), and/or the knowledge of a POSITA
Petition 1B IPR2019-0129	**Ground 1**: Claims 25-31, 34-37, and 39 as anticipated by Ressemann **Ground 2**: Claim 27 as obvious over Ressemann and the knowledge of a POSITA **Ground 3**: Claim 27 as obvious over Ressemann in view of U.S. Pat. App. 2005/0015073 ("Kataishi") and the knowledge of a POSITA

	Ground 4: Claim 27 as obvious over Ressemann in view of U.S. Pat. No. 5,980,486 ("Enger") and the knowledge of a POSITA **Ground 5**: Claims 32 and 33 as obvious over Ressemann in view of Takahashi and the knowledge of a POSITA **Ground 6**: Claim 38 as obvious over Ressemann in view of Berg and the knowledge of a POSITA **Ground 7**: Claims 25-26, 28-37, and 39 as anticipated by Itou **Ground 8**: Claim 27 as obvious over Itou in view of Kataishi and the knowledge of a POSITA **Ground 9**: Claim 38 as obvious over Itou in view of Berg and the knowledge of a POSITA
Kontos-Based Petitions	
Petition 2A IPR2019-0130	**Ground 1**: Claims 1-4, 6-7, 9, 12-17, and 19-20 as obvious over U.S. Patent No. 5,439,445 ("Kontos") in view of U.S. Pat. Pub. 2004/0010280 ("Adams"), and/or the knowledge of a POSITA **Ground 2**: Claims 8 and 18 as obvious over Kontos in view of Adams, Takahashi et al., *New Method to Increase a Backup Support of a 6 French Guiding Coronary Catheter* ("Takahashi"), and/or the knowledge of a POSITA **Ground 3:** Claim 21 as obvious over Kontos in view of Berg, and/or the knowledge of a POSITA
Petition 2B IPR2019-0131	**Ground 1**: Claims 25-26, 28-31, 34-37, and 39 as obvious over Kontos in view of Adams and/or the knowledge of a POSITA **Ground 2**: Claim 27 as obvious over Kontos in view of Adams, Kataishi, and/or the knowledge of a POSITA **Ground 3**: Claim 27 as obvious over Kontos in view of Adams, Enger, and/or the knowledge of a POSITA **Ground 4**: Claims 32-33 as obvious over Kontos in view of Takahashi, and/or the knowledge of a POSITA

	Ground 5: Claim 38 as obvious over Kontos in view of Adams, Berg, and/or the knowledge of a POSITA

Petitions 1A and 1B assert Itou as a primary reference. Itou has an effective filing date of September 23, 2005. (Ex-1207.) But Patent Owner has alleged a conception and reduction to practice date in 2004—a date much earlier than the priority date on the face of the '380 Patent.[1] (Ex-1284; Ex-1201.) Petitioners therefore submitted another set of Petitions (Petitions 2A and 2B) that cover a similar set of claims as Petitions 1A and 1B but assert prior art references with priority dates *before* 2004. This second set of petitions (Petitions 2A and 2B) rely on Kontos as the primary reference. Kontos issued on August 8, 1995, and it is prior art under at least § 102(b). (Ex-1209.) Patent Owner is not able to swear behind Kontos, as it may attempt to do for Itou in Petitions 1A and 1B.

The Board's decision in *Microsoft Corp. v. IPA Technologies, Inc*. is instructive. IPR2019-00810, Paper 12 (PTAB Oct. 16, 2019). There, as here, the patent owner raised a priority date issue necessitating "arguments under multiple prior art references." *Id.* at 15. In *Microsoft Corp.*, the priority date dispute concerned a single prior art reference. Here, the priority dispute is more

[1] The '380 Patent claims priority to U.S. Pat. No. 8,292,850, which, on its face, is entitled to a priority date of May 3, 2006. (Ex-1201.)

fundamental—Patent Owner has raised a priority date issue regarding the challenged patent itself. It would be manifestly unfair if the Board exercises its discretion under § 314(a) to deny Petitions 2A and 2B and post-institution Patent Owner successfully swears behind Itou. Accordingly, the Board should consider and institute Petitions 1A and 2A *and* Petitions 2A and 2B.

Four petitions are necessary because of the length, type, and number of claims asserted by Patent Owner in district court. The ’380 Patent has 42 lengthy claims. Claim 1 of the ’380 Patent, for example, consists of 359 words. In Petitions 1A and 2A, recitation of the challenged claims alone takes up over 1,400 words—more than 10% of Petitioners’ allotted word count. Further, claims 25 and beyond include means-plus-function limitations requiring unique arguments. Because of these issues, Petitioners split the means-plus-function claims of the ’380 Patent into Petitions 1B and 2B.

Given Patent Owner’s allegations in district court, Petitioners must also challenge substantially all claims of the ’380 Patent and consider multiple potential interpretations of claim limitations. The Board’s Trial Practice Guide states that “more than one petition may be necessary” where, as here, “the patent owner has asserted a large number of claims in litigation.” TPG UPDATE (July 2019) at 26. In the district court litigation, Patent Owner has refused to identify the specific claims—or a specific number of claims—it will assert against Petitioner. (Ex-1279

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