

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
Case No. IPR2020-00129
Case No. IPR2020-00130
U.S. Patent No. RE45,380

**PETITIONER'S SUR-REPLY
TO PATENT OWNER'S MOTION TO AMEND**

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I. INTRODUCTION

Patent Owner's ("PO") claimed inventions are not new—they are merely commercialization of the prior art. The proposed amended claims add no new material limitations that were not present in the art and are therefore invalid for the same reasons the original claims are invalid. Before the alleged invention, Kontos described a “guide catheter extension,” or “support catheter . . . distally extended from a guide catheter for delivering a PTCA catheter to a restriction in the artery.” Itou, a suction catheter, and Ressemann, an embolic protection device, are both designed to treat coronary artery disease and would be considered together in designing catheters and treating patients. Ressemann and Kataishi disclose the claimed structure of the amended complex side opening and the art attributes known benefits to this structure. Further, the art describes that similarly shaped openings provide these same benefits when used for both the proximal and distal opening of various catheters. Nonetheless, PO argues the claims are not obvious because a POSITA (1) would not be motivated to make the combinations where the art uses different ways to treat coronary arteries and (2) would not have an expectation of success because modifications would need to be made to incorporate the art together.

A POSITA is not an automaton restricted to combining two specific physical embodiments of the prior art. *Univ. of Maryland Biotechnology Institute v. Presens Precision Sensing GmbH*, 711 F. App'x 1007, 1010 (Fed. Cir. 2017). Instead, a

POSITA has the ordinary creativity of a skilled artisan using the common knowledge and common sense present in the art. *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 421 (2007). PO narrowly focuses on combining specific embodiments and argues because they are not readily combinable without making some modifications, the invention is not obvious. PO ignores that these modifications were well-understood routine engineering concepts within the capability of a POSITA, who had motivation to make them. Taking well-defined structures with known benefits, like the shape of various catheter openings, and applying those structures to other catheters to achieve predictable results is not inventive. Thus, the proposed amended claims are invalid.

II. PROPOSED CLAIMS 43 AND 44 ARE UNPATENTABLE.

A. Substitute claims 43 and 44 are unpatentable over Itou in view of Ressemann or Kataishi.

PO argues that the Itou grounds do not invalidate substitute claims 43 and 44 for at least five reasons, including (1) Itou does not disclose stents, (2) Ressemann and Kataishi do not disclose the claimed “concave track,” (3) Itou does not disclose the claimed diameter sizes with a 6 Fr guide catheter, (4) Itou does not disclose the claimed “coaxial lumen,” and (5) a POSITA would not be motivated to combine Itou and Ressemann, and/or Itou and Kataishi. Each of these issues is discussed below.

1. Stents and Stent Catheters

Itou discloses that all four types of interventional cardiology devices are insertable, including stents. First, Itou itself teaches that guidewire (6) is insertable

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