

PUBLIC VERSION

Trials@uspto.gov
571-272-7822

Date: Paper

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.

IPR2020-00129
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 Some Challenged Claims Unpatentable
Not Deciding Patent Owner's Contingent Motion to Amend
35 U.S.C. § 318(a)

I. INTRODUCTION

Medtronic, Inc. and Medtronic Vascular, Inc. (collectively “Petitioner”) filed a Petition (Paper 1, “Pet.”) requesting an *inter partes* review of claims 25–39 of U.S. Reissue Patent RE45,380E (Ex. 1201, “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 the Preliminary Response, we instituted an *inter partes* review of all claims and grounds asserted in the Petition (Paper 22)

Patent Owner subsequently filed a Patent Owner Response (Paper 43, “PO Resp.”) (redacted version available at Paper 44), Petitioner filed a Reply (Paper 82, “Pet. Reply”) (redacted version available at Paper 83), and Patent Owner filed a Sur-Reply (Paper 101, “Sur-Reply”) (redacted version available at Paper 102).

With prior authorization of the Board, Patent Owner filed a Consolidated Response Addressing Conception and Reduction to Practice (Paper 39), to which Petitioner filed Reply (Paper 78 (redacted version available at Paper 79)), Patent Owner filed a Sur-Reply (Paper 96), and Petitioner filed a Sur-Sur-Reply (Paper 110).

Patent Owner also filed a Contingent Motion to Amend (Paper 38, “Motion”) requesting that if either of claims 1 or 12 of the ’380 patent are determined to be unpatentable, that the Board substitute those claims with proposed substitute claims 43 and 44, respectively. Motion 1. Petitioner

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.

filed an opposition (Paper 85) to the Motion, Patent Owner filed a reply (Paper 104), and Petitioner filed a sur-reply (Paper 112).

An oral hearing was held on March 8, 2021, and a transcript of the hearing is included in the record. Paper 123 (“Tr.”) (redacted version available at Paper 124).

A. 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. 4–5; Paper 4, 2. The ’380 patent is also at issue in IPR2020-00128, IPR2020-00130, and IPR2020-00131 (institution denied). Paper 4, 2–3; Pet. 5.

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 E), IPR2020-00134 (U.S. Patent No. RE45,760 E), IPR2020-00135 (U.S. Patent No. RE45,776 E), IPR2020-00136 (U.S. Patent No. RE45,776 E), IPR2020-00137 (U.S. Patent No. RE47,379 E), IPR2020-00138 (U.S. Patent No. RE47,379 E).

B. Real Parties-in-Interest

Petitioner identifies Medtronic, Inc. and Medtronic Vascular, Inc. as real parties-in-interest and notes that Medtronic plc is the “ultimate parent of both entities.” Pet. 4–5.

Patent Owner identifies itself and Vascular Solutions LLC, Arrow International, Inc., and Teleflex LLC as real parties-in-interest. Paper 7, 2.

Patent Owner further notes that “Teleflex Incorporated is the ultimate parent” of each of these entities. *Id.*

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. 1201, 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. To achieve this result, 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:

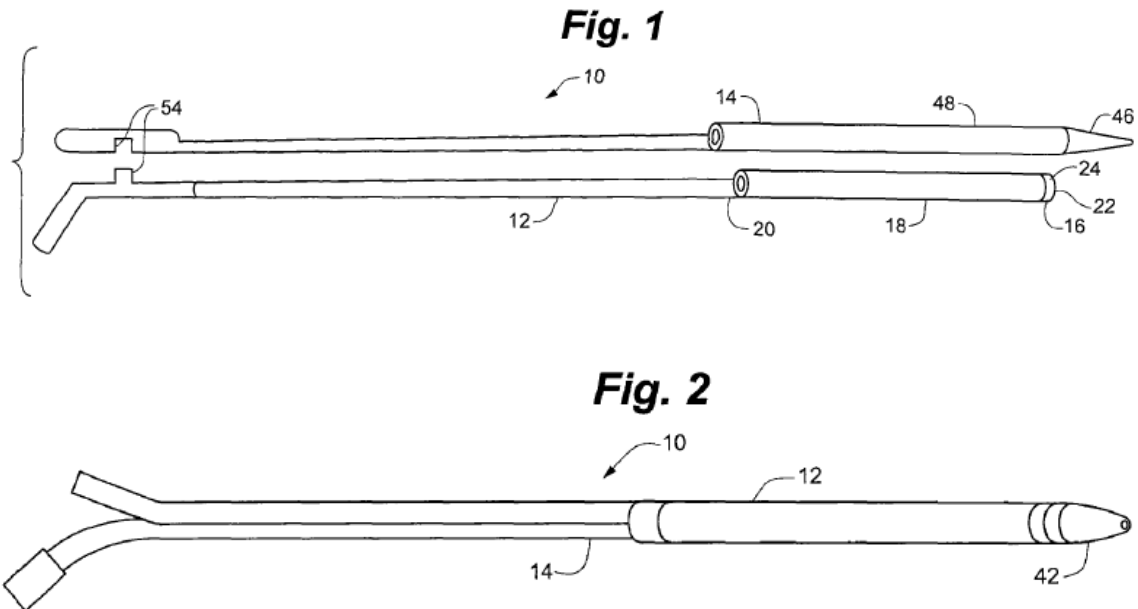


Figure 1 is a schematic depiction of a coaxial guide catheter and a tapered inner catheter, and Figure 2 is a schematic depiction of these two elements assembled together. *Id.* at 5:40–45. As shown in Figure 1, coaxial guide catheter 12 includes tip portion 16, reinforced portion 18, and rigid portion 20. *Id.* at 6:34–35. Tapered inner catheter 14 includes tapered portion 46 at a distal end thereof and straight portion 48, both of which are pierced by lumen 50 (not labeled in Figure 1). *Id.* at 7:16–20. Clip 54 releasably joins tapered inner catheter 14 to coaxial guide catheter 12. *Id.* at 7:21–23.

Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

Real-Time Litigation Alerts



Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

Advanced Docket Research



With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

Analytics At Your Fingertips



Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

LAW FIRMS

Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

FINANCIAL INSTITUTIONS

Litigation and bankruptcy checks for companies and debtors.

E-DISCOVERY AND LEGAL VENDORS

Sync your system to PACER to automate legal marketing.