

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.

**PATENT OWNER'S CONSOLIDATED RESPONSE ADDRESSING
CONCEPTION AND REDUCTION TO PRACTICE**

TABLE OF CONTENTS

I.	INTRODUCTION	1
II.	EVIDENCE SUBMITTED IN SUPPORT OF PRIOR INVENTION	2
III.	BACKGROUND	3
	A. VSI.....	3
	B. Conception of the Invention of the GuideLiner Patents	3
	C. Reduction to Practice.....	7
	D. Continued Work Towards Commercialization	18
IV.	ITOU IS NOT PRIOR ART TO THE CLAIMED INVENTIONS	19
	A. The VSI Inventors Reduced the Claimed Invention to Practice Prior to September 23, 2005.....	21
	B. Reasonably Diligent Work on the Invention Continued Through the Filing of the Patent Application on May 3, 2006.....	28
V.	CONCLUSION.....	29
	CERTIFICATE OF WORD COUNT COMPLIANCE.....	30
	CERTIFICATION OF SERVICE.....	31

TABLE OF AUTHORITIES

Cases

<i>Arctic Cat Inc. v. GEP Power Prods.</i> , 919 F.3d 1320 (Fed. Cir. 2019)	19, 20, 28
<i>Cooper v. Goldfarb</i> , 154 F.3d 1321 (Fed. Cir. 1998)	24
<i>DSL Dynamic Scis., Ltd. v. Union Switch & Signal, Inc.</i> , 928 F.2d 1122 (Fed. Cir. 1991)	25
<i>Dynamic Drinkware, LLC v. Nat’l Graphics, Inc.</i> , 800 F.3d 1375 (Fed. Cir. 2015)	20, 21
<i>E.I. du Pont de Nemours & Co. v. Unifrax I LLC</i> , 921 F.3d 1060 (Fed. Cir. 2019)	22
<i>In re Asahi/America Inc.</i> , 68 F.3d 442 (Fed. Cir. 1995)	21
<i>In re Dardick</i> , 496 F.2d 1234 (C.C.P.A. 1974)	21
<i>In re Stryker</i> , 435 F.2d 1340 (C.C.P.A. 1971)	23
<i>Loral Fairchild Corp. v. Matsushita Elec. Indus. Co.</i> , 266 F.3d 1358 (Fed. Cir. 2001)	22, 24, 27
<i>Mahurkar v. C.R. Bard, Inc.</i> , 79 F.3d 1572 (Fed. Cir. 1996)	20, 21, 25, 27
<i>Perfect Surgical Techniques, Inc. v. Olympus America, Inc.</i> , 841 F.3d 1004 (Fed. Cir. 2016)	28
<i>Purdue Pharma L.P. v. Boehringer Ingelheim GmbH</i> , 237 F.3d 1359 (Fed. Cir. 2001)	20
<i>Scott v. Finney</i> , 34 F.3d 1058 (Fed. Cir. 1994)	20, 21, 22

Statutes

35 U.S.C. §102(e) 1, 19

I. INTRODUCTION

This consolidated brief is submitted in response to the consolidated scheduling order authorizing the parties to file consolidated briefs specifically addressing the issues of conception and reduction to practice that are relevant to IPR2020-00126, -00128, -00129, -00132, -00134, -00135 and -00137. The patents at issue are collectively referred to as “the GuideLiner patents.”

These IPRs all rely, in whole or in part, on U.S. Patent No. 7,736,355 (“Itou”), which Medtronic asserts is prior art under 35 U.S.C. §102(e) based on an effective filing date of September 23, 2005. Itou is not prior art to the GuideLiner patents. The evidence shows that between January and August 2005, the inventors and others working on their behalf built and tested GuideLiner prototypes and confirmed they would work for their intended purpose. Corroborating the success of this testing, a decision was made in August 2005 to move forward with commercializing the GuideLiner. Thus, the fully corroborated facts demonstrate that the GuideLiner patents were actually reduced to practice prior to the effective filing date of the Itou reference. Moreover, although not necessary to pre-date Itou, diligent work on GuideLiner continued from September 2005 to the filing of its original priority application on May 3, 2006, thus providing an additional basis to conclude that Itou is not prior art.

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.