

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 IPR2020-00128

Case IPR2020-00129

Case IPR2020-00130

Patent RE 45,380

**PATENT OWNER'S CONTINGENT MOTION TO AMEND
U.S. PATENT RE 45,380 UNDER 37 C.F.R. § 42.121**

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I. INTRODUCTION

Patent Owner Teleflex submits this Contingent Motion to Amend U.S. Patent RE 45,380 (“Motion”), with the Declaration of Peter T. Keith in Support of Motions to Amend (“Ex-2124”), under 37 C.F.R. § 42.121. This motion does not seek preliminary guidance. If, after considering Teleflex’s Patent Owner Responses, the Board finds either of issued claims 1 or 12 of the ’380 patent invalid, Teleflex respectfully requests that the Board substitute the invalid claim(s) with the respective proposed substitute claim of claims 43 and 44. *See* 37 C.F.R. § 42.22(a)(2); 35 U.S.C. § 316(d).

II. LEGAL STANDARDS FOR AMENDING CLAIMS

A motion to amend must (1) propose a reasonable number of substitute claims, (2) that respond to a ground of unpatentability involved in the trial, (3) that do not enlarge the scope of the claims or introduce new matter, and (4) are not shown by a preponderance of the evidence to be unpatentable. *See* Memorandum re: Guidance on Motions to Amend in view of *Aqua Products* (Nov. 21, 2017) at 2; 35 U.S.C. § 316(d); 37 C.F.R. § 42.121. It is Petitioner’s burden to show that the proposed substitute claims are unpatentable. *Lectrosonics, Inc. v. Zaxcom, Inc.*, IPR2018-01129, Paper 15 at 4 (PTAB Feb. 25, 2019).

III. CLAIM LISTING

Pursuant to 37 C.F.R. § 42.121(b), Appendix A lists the changes made to the issued claims of the ’380 patent that would be replaced under this Motion. This

claim listing includes one replacement claim for each of claims 1 and 12. The number of proposed substitute claims is reasonable under 35 U.S.C. § 316(d)(1)(B) and 37 C.F.R. § 42.121(a)(3).

IV. SCOPE OF THE SUBSTITUTE CLAIMS

The proposed substitute claims comply with 35 U.S.C. § 316(d)(3) and 37 C.F.R. § 42.121(a)(2)(ii) because no substitute claim enlarges the scope of, or eliminates any element from, the original claim it replaces. All amendments reflected in substitute claims 43 and 44 are narrowing amendments, in that all amendments only add limitations to the claims without removing language.

V. WRITTEN DESCRIPTION SUPPORT

Substitute claims 43 and 44 are fully supported by the priority application¹ because “the disclosure . . . reasonably conveys to those skilled in the art that the inventor had possession of the claimed subject matter as of the filing date.”

Indivior Inc. v. Dr. Reddy’s Labs., S.A., 930 F.3d 1325, 1347 (Fed. Cir. 2019)

(citation to quoted case omitted); 37 C.F.R. § 42.121(b); *see* Ex-2124, ¶¶ 22-27.

“Drawings constitute an adequate description if they describe what is claimed and

¹ The parties have stipulated that all patents at issue in these IPRs have substantively identical disclosures, and have agreed to cite only the priority application, IPR2020-00126, Ex. 1003, cited herein as “Ex. 1003 at XX.”

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