

Telephone Conference - 4/17/2020  
Medtronic, Inc. and Medtronic Vascular, Inc. vs. Teleflex Innovations S.A.R.L.

1 UNITED STATES PATENT AND TRADEMARK OFFICE

2 -----  
3 BEFORE THE PATENT TRIAL AND APPEAL BOARD  
4 -----

5 Medtronic, Inc. and Medtronic Vascular, Inc.,

6 Petitioners,

7 vs.

8 Teleflex Innovations S.À.R.L.,

9 Patent Owner.

10 -----  
11 Case No.: IPR2020-00127  
U.S. Patent No. 8,048,032  
12 -----

13 Case No.: IPR2020-00130  
U.S. Patent No. RE 45,380  
14 -----

15 Case No.: IPR2020-00131  
U.S. Patent No. RE 45,380  
16 -----

17 Case No.: IPR2020-00133  
U.S. Patent No. RE 45,760  
18 -----

19 Case No.: IPR2020-00134  
U.S. Patent No. 45,760  
20 -----

21 Case No.: IPR2020-00136  
U.S. Patent No. RE 45,776  
22 -----

23 Case No.: IPR2020-00138  
U.S. Patent No. RE 47,379  
24 -----

25 TELEPHONIC PROCEEDING

April 17, 2020

By Brandi N. Bigalke, RPR RSA

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2 Taken pursuant to notice to take telephonic  
3 oral proceeding, on the 17th day of April, 2020,  
4 before Brandi N. Bigalke, Registered Professional  
5 Reporter, Realtime Systems Administrator,  
6 Stenographic Court Reporter, and a Notary Public  
7 in and for the State of Minnesota.

8

9 A P P E A R A N C E S:

10 (\*\*Everyone appeared by telephone)

11

12 The Honorable Christopher Paulraj

13 The Honorable Sheridan Snedden

14 The Honorable Jon Tornquist

15

16 On Behalf of the Petitioner:

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1 APPEARANCES (Cont'd)

2 On Behalf of the Patent Owner Teleflex Innovations,  
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<p>1 PROCEEDINGS</p> <p>2 Whereupon, the telephonic proceeding on April 17,</p> <p>3 2020 was commenced at 10:00 a.m. as follows:</p> <p>4 - - -</p> <p>5 THE COURT: Good morning. This is</p> <p>6 a conference call on IPR2020-00127, -00130, 131,</p> <p>7 133, 134, 136, and 138. This is Judge Paulraj,</p> <p>8 and with me on the line I have Judges Tornquist</p> <p>9 and Snedden.</p> <p>10 Let's start with role call. Who do</p> <p>11 we have on the line for petitioner?</p> <p>12 MR. MORTON: Yes, your Honor. This</p> <p>13 is Cy Morton for petitioner. Also on with me is</p> <p>14 Chris Pinahs. And I do want to report we have a</p> <p>15 court reporter on the line as well.</p> <p>16 THE COURT: All right. Thank you,</p> <p>17 Mr. Morton.</p> <p>18 And then since we do have a court</p> <p>19 reporter, I'll have you file the transcript of</p> <p>20 the court reporter -- from the court reporter</p> <p>21 whenever it's available in each of these cases.</p> <p>22 Is that clear?</p> <p>23 MR. MORTON: Yes, your Honor.</p> <p>24 THE COURT: All right. Since we do</p> <p>25 have some other related cases that are in this <span style="float: right;">Page 4</span></p>	<p>1 cases. So it does appear that petitioner would</p> <p>2 like to file a reply along the same lines as what</p> <p>3 we authorized in the other cases, and I do want</p> <p>4 to -- I know the parties to address the, perhaps</p> <p>5 the intervening order from the District Court.</p> <p>6 We are aware that the District</p> <p>7 Court issued an order on the preliminary</p> <p>8 injunction motion more recently, so -- and it</p> <p>9 looks like petitioner wants to address that in</p> <p>10 the surreply, at least for the 134 case.</p> <p>11 So if you can address that,</p> <p>12 Mr. Morton, and then I'll let Mr. Vandenburg</p> <p>13 respond accordingly.</p> <p>14 MR. MORTON: Yes, your Honor.</p> <p>15 Absolutely.</p> <p>16 So as you've already noted, we've</p> <p>17 had reply briefs before on the first six</p> <p>18 petitions. We're talking about the next seven</p> <p>19 now. If you rule consistently, we would get a</p> <p>20 five-page reply brief on the 134 IPR to address</p> <p>21 both issues, and maybe three pages on the rest of</p> <p>22 them that only have the secondary considerations</p> <p>23 issue. And that was our original proposal to</p> <p>24 patent owner.</p> <p>25 Patent owner's position is that we <span style="float: right;">Page 6</span></p>
<p>1 family, go ahead and file the entire set of</p> <p>2 cases. I know that the request for conference</p> <p>3 call was only for perhaps the cases we didn't</p> <p>4 discuss in our prior conference call, but just</p> <p>5 for consistency sake and we have a clear record</p> <p>6 in all these cases, go ahead and file the</p> <p>7 transcript in all these cases.</p> <p>8 MR. MORTON: Sure, your Honor. We</p> <p>9 can probably -- we had a transcript for the last</p> <p>10 call, we could go ahead and file that in the --</p> <p>11 in these current IPRs we're discussing today as</p> <p>12 well.</p> <p>13 THE COURT: That makes sense.</p> <p>14 Thank you, Counsel.</p> <p>15 All right. Who do we have on the</p> <p>16 line for patent owner?</p> <p>17 MR. VANDENBURGH: Yeah. Thank you,</p> <p>18 your Honor. This is Derek Vandenburg for</p> <p>19 Teleflex, and with me on the line is Peter</p> <p>20 Kohlhepp.</p> <p>21 THE COURT: All right. Thank you,</p> <p>22 Mr. Vandenburg.</p> <p>23 So the purpose of this call is</p> <p>24 perhaps a follow-up to what we discussed in our</p> <p>25 prior conference call for the related set of <span style="float: right;">Page 5</span></p>	<p>1 should be limited to filing the identical briefs</p> <p>2 we filed previously. And there's no real basis</p> <p>3 for that. We were never limited to filing the</p> <p>4 same briefs in all IPRs. But to avoid a dispute,</p> <p>5 we agreed to do that on secondary consideration.</p> <p>6 On the swear-behind issue, as</p> <p>7 you've already noted, things have changed with</p> <p>8 the District Court's order in the PI. The</p> <p>9 District Court filed that Medtronic raised a</p> <p>10 substantial question about the attempt to swear</p> <p>11 behind. And in so doing, your Honor, the Court</p> <p>12 relied on documents and evidence that we didn't</p> <p>13 have when we filed the IPRs.</p> <p>14 For instance, and I'll quote from</p> <p>15 the Court on the conception and reduction of</p> <p>16 practice issue. The Court said notably a report</p> <p>17 dated December 1, 2005, months after Teleflex's</p> <p>18 claimed reduction to practice states that, "The</p> <p>19 rapid exchange version requires additional</p> <p>20 engineering, and is not included in our 2006</p> <p>21 forecasts." And it cites to Exhibit 40 on the</p> <p>22 route declaration.</p> <p>23 So we didn't have this Exhibit 40,</p> <p>24 your Honor, and the patent owner didn't attach it</p> <p>25 to their POPR. And it seems like an important <span style="float: right;">Page 7</span></p>

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1 piece of information. So we would like to point  
2 that out as additional reasoning for why we  
3 should not have had to address this in the  
4 petition and the issue to the reserve for the  
5 trial phase with a fair process discovery.  
6 Separate point, your Honor, is that  
7 the Court also found a substantial question on  
8 the lack of written description. We've argued  
9 the same point in the 134 IPR as a basis to  
10 change the priority date so the America Invents  
11 Act would apply, and then the patent owner cannot  
12 swear behind, you know, as a legal matter.  
13 This is new information for the  
14 Board that provides another justification to  
15 commit a reply brief, and we also want to bring  
16 it to the board's attention in the reply brief.  
17 So, your Honor, the easiest thing  
18 to do is to grant reply briefs exactly like last  
19 time and let the parties file their briefs.  
20 That's what would normally happen if you just  
21 looked at these current IPRs standing alone that  
22 we're discussing today.  
23 But we're willing to stick to our  
24 offer that we made to patent owner to file the  
25 same content for secondary considerations. We

1 three pages?  
2 MR. MORTON: Yes, we can limit that  
3 to three pages, your Honor.  
4 THE COURT: Okay. And then the  
5 Itou, you're not seeking anything beyond five  
6 pages than we previously authorized to address  
7 those secondary considerations as a swear-behind  
8 issue?  
9 MR. MORTON: No. If you want to  
10 give me six pages, I'll take it, but I think we  
11 can do it.  
12 THE COURT: Okay. Thank you,  
13 Counsel. I'll see if Mr. Vandenburg will give  
14 you the extra page, if he can stipulate to that.  
15 All right. So you did raise  
16 something else that perhaps wasn't argued in the  
17 prior conference call about the written  
18 description argument. It doesn't look like we  
19 authorized any reply briefs to address the  
20 written description issue.  
21 Is that something you're  
22 additionally seeking in terms of addressing in  
23 your reply for the 134 case?  
24 MR. MORTON: Well, I would like  
25 that, your Honor, because this is new

1 just want to use our very limited gauges a little  
2 differently for the 134 IPR when it comes to the  
3 swear-behind issue.  
4 Thank you, your Honor.  
5 THE COURT: All right. Thank you,  
6 Mr. Morton.  
7 So just to be clear, for the  
8 current set of cases that I mentioned from the  
9 numbers at the beginning of this call, the ones  
10 where the Kontos is only an issue, those are the  
11 ones where you're only going to address a  
12 secondary consideration argument in your reply.  
13 And the 134 case, which I think it  
14 sets apart here in terms of the latter set of  
15 cases, addresses Itou again. And that's the one  
16 that you're going to want to address the  
17 swear-behind issue, you know, based on the  
18 District Court's preliminary injunction order; is  
19 that right?  
20 MR. MORTON: Yes, your Honor.  
21 THE COURT: All right. Let me  
22 focus just briefly on the Kontos-based cases. So  
23 those with respect to the secondary  
24 considerations arguments in the reply you're  
25 seeking, you were willing to limit that to just

1 information, a finding from the Court on this on  
2 the same issues that were argued. And it relates  
3 directly to the swear-behind issue. That's  
4 something we put in our IPRs. We may have thrown  
5 it in on our last reply briefs. But basically if  
6 there's a lack of written description, the date  
7 moves until -- to make it a post AIA patent, and  
8 then you can't swear behind the detail reference.  
9 So it's a related point, but yes,  
10 it is something that's a little bit different  
11 based on the decision from the Court.  
12 THE COURT: All right. Let me turn  
13 it over to Mr. Vandenburg so he can respond to  
14 the points you just discussed.  
15 MR. VANDENBURGH: Thank you, your  
16 Honor.  
17 I want to start by just pointing  
18 out the irony of the fact that Medtronic wants to  
19 use the fact that the District Court has now dug  
20 in to the substance of these issues to try to  
21 explain why the Board should start what we view  
22 as a redundant and duplicative proceeding.  
23 You know, in granting the prior  
24 briefing, the Board was clear that it didn't want  
25 to hear about the merits of the issues, but

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