

Teleconference Hearing - 5/15/2020  
Medtronic, Inc. and Medtronic Vascular, Inc. vs. Teleflex Innovations S.A.R.L.

1 UNITED STATES PATENT AND TRADEMARK OFFICE

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3 BEFORE THE PATENT TRIAL AND APPEAL BOARD

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

6 Petitioners,

7 vs.

8 Teleflex Innovations S.A.R.L.,

9 Patent Owner

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

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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

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

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

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

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

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25 TELEPHONIC PROCEEDING

May 15, 2020

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25 By Brandi N. Bigalke, RPR RSA

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2 Taken pursuant to notice to take telephonic  
3 oral proceeding, on the 15th day of May, 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.

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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,  
3 S.À.R.L.:

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<p>1 PROCEEDINGS</p> <p>2 Whereupon, the telephonic proceeding on May 15,</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 the conference call in a hearing of IPR,</p> <p>7 IPR2020-00126 through IPR2020-00138.</p> <p>8 This is Judge Paulraj, and with me</p> <p>9 I have the two other panel members on this case,</p> <p>10 Judge Tornquist and Judge Snedden.</p> <p>11 Let's start with roll call. Who do</p> <p>12 we have on the call for petitioner?</p> <p>13 MR. MORTON: Yes, your Honor. This</p> <p>14 is Cy Morton for petitioner. With me also on the</p> <p>15 line is Christopher Pinahs and Sharon</p> <p>16 Roberg-Perez.</p> <p>17 Your Honor, we also do have a court</p> <p>18 reporter.</p> <p>19 THE COURT REPORTER: Hello. This</p> <p>20 is Brandi Bigalke with Depo International.</p> <p>21 THE COURT: All right. Thank you.</p> <p>22 Mr. Morton, since we do have a</p> <p>23 court reporter, I would ask for our normal</p> <p>24 practice for you to make that transcript</p> <p>25 available as part of the record, whenever it does</p> <p style="text-align: right;">Page 4</p>	<p>1 the Apple decision, Mr. Morton, and then I'll</p> <p>2 have Mr. Vandenburg respond, and then we'll</p> <p>3 proceed with your second request for timing.</p> <p>4 MR. MORTON: Yes, your Honor.</p> <p>5 So on the first issue, it's pretty</p> <p>6 straightforward, your Honor. As you already</p> <p>7 said, the Board designated Apple v. Fintiv</p> <p>8 precedential, and does provide for a six-factor</p> <p>9 analysis under 314, which is an issue patent</p> <p>10 owner has raised. And obviously that decision</p> <p>11 itself is a decision granting a reply brief to</p> <p>12 address those factors, and that decision is now</p> <p>13 binding on the panel.</p> <p>14 So we thought it made sense to seek</p> <p>15 to provide the Board with some additional facts</p> <p>16 to aid the Board's analysis. And, I mean, I will</p> <p>17 point out, we did not initially seek a reply</p> <p>18 brief on 314 because the district court trial was</p> <p>19 later than final written decisions would be, and</p> <p>20 the patent owner's arguments did not seem to</p> <p>21 merit a reply brief.</p> <p>22 So while that's still true, Apple</p> <p>23 v. Fintiv provides some additional grounds, which</p> <p>24 again are now precedential, that we think support</p> <p>25 a rejection of patent owner's 314 arguments. In</p> <p style="text-align: right;">Page 6</p>
<p>1 become available.</p> <p>2 MR. MORTON: Yes, your Honor.</p> <p>3 Understood.</p> <p>4 THE COURT: So who do we have on</p> <p>5 the line for patent owner?</p> <p>6 MR. VANDENBURGH: Your Honor, this</p> <p>7 is Derek Vandenburg for patent owner, and with</p> <p>8 me on the call is Peter Kohlhepp.</p> <p>9 THE COURT: Thank you,</p> <p>10 Mr. Vandenburg.</p> <p>11 So the purpose of this call is to</p> <p>12 discuss a request from petitioner to file a reply</p> <p>13 to address the 314 factor set forth in the recent</p> <p>14 precedential Apple petition, IPR2020-00019, Paper</p> <p>15 11. And then there was another request from</p> <p>16 petitioner to support timing {ph} with respect to</p> <p>17 the 379 IPR.</p> <p>18 So since it looks like it was</p> <p>19 petitioner's request that prompted this phone</p> <p>20 call, we'll have Mr. Morton address each of those</p> <p>21 issues.</p> <p>22 So perhaps we'll proceed this way:</p> <p>23 We'll -- to the extent that those issues are</p> <p>24 distinct, which it does seem like they are, why</p> <p>25 don't you start with the request for the reply to</p> <p style="text-align: right;">Page 5</p>	<p>1 addition, an institution of trial.</p> <p>2 So just for instance, your Honor,</p> <p>3 and I won't go into too much detail, but under</p> <p>4 Factor 1, Apple v. Fintiv asked the Board to look</p> <p>5 into the district court, whether the district</p> <p>6 court may stay the litigation. And here the</p> <p>7 district court has already stayed co-pending</p> <p>8 litigation on the eve of trial in favor of seeing</p> <p>9 how the IPRs turn out. And our --</p> <p>10 THE COURT: Mr. Morton, I don't</p> <p>11 want you to get into kind of what might be a</p> <p>12 preview of what you might argue in your reply.</p> <p>13 So to the extent that you've already laid out</p> <p>14 your brief {inaudible} your reply {inaudible}</p> <p>15 because of the recent designation of that whole</p> <p>16 decision is precedential.</p> <p>17 Do you have anything else to add</p> <p>18 without getting into perhaps the individual</p> <p>19 factors that might be addressed in any reply?</p> <p>20 MR. MORTON: Sure. The basis is</p> <p>21 really the precedential decision, your Honor.</p> <p>22 Couple other factors we would</p> <p>23 address, and this is really why we, in our</p> <p>24 e-mail, you know, we only ask for two pages. If</p> <p>25 it would help the Board, we'd be happy to do a</p> <p style="text-align: right;">Page 7</p>

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<p>1 fulsome analysis of all the factors and really 2 get into it. But really we just wanted to add a 3 few facts, like I started to mention, that are 4 just -- would be let in the record for the Board 5 to consider in making the analysis. 6 THE COURT: All right. Thank you, 7 Mr. Morton. 8 Let me turn it over to 9 Mr. Vandenburg to address the request for a 10 reply. 11 MR. VANDENBURGH: Yeah, thank you. 12 In our view, the most important 13 fact is one that Mr. Morton acknowledged, which 14 is that they chose not to address the pending 15 litigation and the 314 factors in their petition. 16 We have a case that we found that 17 is really directly on point. It's Google v. 18 Uniloc, IPR2020-00115, Paper Number 7 from March 19 of this year, which basically address this exact 20 situation where the patent owner didn't -- I'm 21 sorry, the petitioner didn't address it in their 22 petition and then sought a reply. The panel 23 there found no good cause pointing out that not 24 only NHK being out there at that time, but also 25 just an EPG itself indicates that if there is</p> <p style="text-align: right;">Page 8</p>	<p>1 district court. And I am quite confident that if 2 Medtronic is willing to pull its product off the 3 market, that we would probably agree to a stay 4 with them as well. But absent that, that is 5 going to be a hotly contested issue. 6 And then the last point I guess I 7 want to make is I think in their request they 8 suggested simultaneous briefing. And of course 9 we don't think there's good cause at all, but if 10 your Honor is inclined to do it, you know, the 11 way this should have played out is they should 12 have addressed it in their petition, we then 13 could have made our argument and responded to 14 theirs in our POPR. 15 They are now apparently trying to 16 get an effort to make whatever argument they want 17 to make without us being able to respond, and 18 that would simply be unfair. So if you are 19 inclined to grant their relief, it certainly 20 should be sequential briefing. 21 That's what I have. 22 THE COURT: All right. So it 23 sounds like you -- to the extent that we are 24 inclined to grant a reply, you want a fair reply 25 after you've had a chance to review it to view --</p> <p style="text-align: right;">Page 10</p>
<p>1 pending litigation with relevant -- that they be 2 relevant to discretionary denial that it be 3 addressed -- should be addressed in the petition, 4 and it wasn't a cause to come in after the fact. 5 You know, that was the strategic 6 decision they made then, and there's no reason to 7 {inaudible} now. 8 The second point I want to make is 9 that Apple is not new law. You know, four out of 10 six factors identified in Apple can be found in 11 NHK. The other two can be found in other case 12 law, and are also just, you know, pretty 13 self-evidently relevant. So it's not like they 14 couldn't have anticipated those and addressed 15 them in their petition. 16 I hope you'll permit me this 17 latitude. I know you don't want us to go into 18 the merits, but Mr. Morton got to say the part of 19 the story he wanted to tell on this stay in 20 co-pending litigation. 21 I just want to be able to say that 22 that actually favors us because that party in 23 order to get the stay both pulled its product 24 from the market, agreed to keep its product off 25 the market, and waived its defenses in the</p> <p style="text-align: right;">Page 9</p>	<p>1 MR. VANDENBURGH: Certainly. 2 THE COURT: -- whatever reply. 3 Okay. And you did bring up a good 4 cause standard, and that is the standard that's 5 set forth in our rules for granting a reply. 6 So if I understand you correctly, 7 it's your view that notwithstanding the recent 8 designation of the Apple decision of 9 precedential, I believe it was sometime last week 10 {inaudible} -- the decision itself came out 11 sometime in March, you don't believe that fact is 12 sufficient for the good cause standard for reply. 13 MR. VANDENBURGH: That's correct, 14 Your Honor. You know, it makes sense that 15 periodically the Board would, you know, change, 16 you know, update to the latest and greatest 17 opinion to be precedential. But again, if you 18 compare Apple to NHK, it's really not that much 19 of a departure. As you read Apple, every -- you 20 know, all of the factors that they basically 21 collect are either in NHK, or the couple that 22 aren't are from other existing case law. 23 The other point on that is if you 24 read the Apple decision, the reason it looks like 25 they allowed supplemental briefing was, first of</p> <p style="text-align: right;">Page 11</p>

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