

UNITED STATES PATENT AND TRADEMARK OFFICE

---

BEFORE THE PATENT TRIAL AND APPEAL BOARD

---

MEDTRONIC, INC. AND MEDTRONIC VASCULAR, INC.

Petitioners,

v.

TELEFLEX INNOVATIONS S.À.R.L.,

Patent Owner

---

Case IPR2020-00131

Patent RE45,380

---

**PETITIONERS' REQUEST FOR REHEARING**

**TABLE OF CONTENTS**

- I. Argument..... 1
  - A. The Decision Could Result in Conflicting Patentability Findings For Substantially Similar Claims, Including Claims 32 and 33 of the '380 Patent. .... 2
  - B. The Kontos Grounds and Challenged Claims in the Instant Petition Are Substantially Similar to Those In the Other Instituted IPRs and Will Not Burden the Board or the Parties. .... 5
  - C. Medtronic Is Willing to Limit the Instant Petition to Claims 32 and 33 to Further Alleviate Any Efficiency or Burden Concerns ..... 8
- II. Conclusion..... 9

In response to the Patent Trial and Appeal Board’s Decision of June 26, 2020 (Paper 20, “Decision”), Petitioners Medtronic, Inc. and Medtronic Vascular, Inc. (“Medtronic”) respectfully request rehearing of the Decision denying institution of *inter partes* review for claims 25-39 (“the challenged claims”) of U.S. Patent No. RE45,380 (“the ’380 patent”). The Decision did not reach the merits of Medtronic’s Petition; instead, the Decision exercised discretion under 35 U.S.C. § 314(a) because the Board granted institution of another petition challenging the ’380 patent (i.e., IPR2020-00129). *See* Dec. at 3–5 (citing Consolidated Trial Practice Guide (“Trial Practice Guide”) (November 2019) at 59). As explained below, Medtronic respectfully requests rehearing of the Decision and institution of this proceeding, and is willing—pending the Board’s guidance in its Rehearing decision—to limit the instant Petition to claims 32 and 33 to further alleviate any efficiency or burden concerns.

## **I. Argument**

Medtronic appreciates the considerations underlying the Board’s policy of limiting institution to a single petition challenging a given set of claims in the absence of special circumstances. *See* Trial Practice Guide at 59-60. The Trial Practice Guide also provides, however, that discretionary denial under § 314 “is informed” by the policies of, among others, “economy, the integrity of the patent system, [and] the efficient administration of the Office.” *Id.* at 56. In particular,

“[t]he AIA was designed to establish a more efficient and streamlined patent system that will improve patent quality and *limit unnecessary and counterproductive litigation costs.*” *Id.* (citing H.R. Rep. No. 112–98, pt. 1, at 40 (2011)) (emphasis added).

The Board’s Decision to deny institution under § 314 does not achieve this goal because it could result in unnecessary and counterproductive litigation. In particular, the Decision has the consequence of causing potentially inconsistent validity rulings for the ’380 patent—in particular, claims 32 and 33—that recites nearly identical subject matter as other claims in the Teleflex family for which this Board found that Medtronic had established a reasonable likelihood of demonstrating invalidity. These potential inconsistencies are not good for either the integrity of the patent system or the efficient administration of the Office. Accordingly, and for the additional reasons set forth below, the Board should grant Rehearing. *See Sand Revolution II, LLC v. Continental Intermodal Group – Trucing LLC*, IPR2019-01393, Paper 24 at 2–3 (P.T.A.B. June 16, 2020) (granting Request for Rehearing that overturned decision exercising discretion under § 314).

**A. The Decision Could Result in Conflicting Patentability Findings For Substantially Similar Claims, Including Claims 32 and 33 of the ’380 Patent.**

The Board denied institution of this Petition because it instituted review of IPR2020-00129. In the -00129 Institution Decision, the Board preliminarily found

that Medtronic demonstrated a reasonable likelihood that claims 25-31, 34-37 and 39 were invalid, but preliminarily disagreed with Medtronic’s argument as to claims 32 and 33. Paper 22 at 23-33 (“-00129 Decision”). In particular, in the -00129 Decision, the Board preliminarily determined that Medtronic did not demonstrate a reasonable likelihood of invalidating claims that require the distance between the inner diameter of the guide catheter and the guide extension catheter to be no more than one French (“One French Claims”). *Id.* at 31–33. Thus, it is possible that the Board may find claim 32 and, by virtue of its dependency, claim 33 not unpatentable in IPR2020-00129.

The Board, however, preliminarily determined in IPR2020-00127 and -00130 that the same Kontos grounds advanced in the instant Petition render the One French Claims unpatentable. Importantly, as shown in the below table, the ’032 and ’380 patents recite substantially the same claim feature—which the Board preliminarily determined to be taught by the Kontos-based prior art—as claim 32 of the ’380 patent.

IPR No.	IPR2020-00127	IPR2020-00130	IPR2020-00131
Claim	“The device of claim 1 wherein the cross-sectional inner diameter of the coaxial lumen of the tubular structure is <i>not more than one French smaller</i> than the cross-sectional	“The system of claim 1, wherein the cross-sectional inner diameter of the coaxial lumen of the tubular structure is <i>not more than one French smaller</i> than the cross-sectional	“The system of claim 25, wherein a uniform inner diameter of a lumen of the means for receiving the interventional device and guiding the interventional device deeper into the branch vessel is <i>not more than</i>

# 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.