

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 IPR2020-0132, IPR2020-0133, IPR2020-0134
Patent RE 45,760E

**PATENT OWNER RESPONSE TO PETITIONER'S EXPLANATION OF
MATERIAL DIFFERENCES BETWEEN PETITIONS AND PETITION
RANKING FOR U.S. PATENT NO. RE 45,760E**

Petitioners Medtronic, Inc. and Medtronic Vascular, Inc. (collectively “Medtronic”) filed three separate petitions against the ’760 patent, challenging a total of only 23 claims. Further, Medtronic’s three petitions include a total of *six different grounds* brought against a single claim—claim 32. IPR2020-00132, Paper 1 at 8 (Grounds 2, 3, 4); IPR2020-00133, Paper 1 at 7 (Grounds 1, 2, 3).

Medtronic’s strategic choice to rely on a section 102(e) reference does not justify institution of three petitions. Medtronic contends it needs three petitions because Teleflex is asserting an invention date that pre-dates the Itou reference (Ex. 1007). Paper 3 at 1-3. Teleflex did invent before the priority date of Itou. Indeed, Itou’s prior art status is at issue in the parallel district court litigation, and Medtronic was aware of substantial corroborated evidence showing Teleflex’s prior invention before it filed its Petitions. Nevertheless, Medtronic chose to rely on a § 102(e) reference and did *not even try to address* the issue of Teleflex’s invention date in its Petitions. Thus, this is not one of the “rare” cases in which “two petitions by a petitioner may be needed.” November 2019 Consolidated Trial Practice Guide (“TPG”) at 59. Where, as here, a Petitioner proceeds with filing petitions relying on a primary reference that it knows full-well is likely to be antedated, three petitions are not justified.

The Board routinely declines to institute multiple petitions, even where there is a priority date dispute. *See, e.g., Comcast Cable Commc’ns, LLC v. Rovi*

Guides, Inc., IPR2019-01354, Paper 10 at 6 (PTAB Jan. 27, 2020) (denying institution of two of three petitions where a potential priority dispute existed); *Dropbox, Inc. v. Whitserve LLC*, IPR2019-01018, Paper 13 at 8-9 (PTAB Nov. 1, 2019) (denying institution of a second petition where parties disputed the priority date of multiple prior art references); *Comcast Cable Commc'ns, LLC v. Rovi Guides, Inc.*, IPR2019-00279, Paper 10 at 6-7 (PTAB July 1, 2019) (declining to institute four of five filed petitions where a potential priority dispute existed). Furthermore, the TPG explains that three or more petitions are almost never appropriate (TPG at 59). Medtronic has failed to justify why it needs not just two petitions, but three.

Medtronic cites *Microsoft Corp. v. IPA Techs Inc.*, IPR2019-00810, Paper 12 (PTAB Oct. 16, 2019). See Paper 3 at 3. But *Microsoft* was different. First, the petitioner in *Microsoft* explained that the “main difference” between its petitions was that each petition challenged different claims. *Id.* at 12. Thus, denying one of the petitions would completely eliminate the petitioner’s opportunity to challenge those claims. Here, in contrast, Medtronic filed two petitions attacking the *same* claims based on different references, and a third petition challenging only four claims. Second, while Medtronic is correct that there was a potential dispute about the priority date of Microsoft’s Kiss reference, the petitioner explained that “the same analysis of the combination of Kiss/FIPA97

is the basic prior art challenge *to every claim in each petition.*” *Id.* Paper 9 at 1-2 (emphasis added). Thus, if the Kiss reference was found to not qualify as prior art, all of the petitions would fail. Consequently, the petitioner’s filing of multiple petitions was clearly not intended to provide a “back-up” petition because of a potential priority issue. Medtronic’s reliance on *Microsoft* is inapt.

Medtronic’s strategic choice to include excessive, duplicative challenges to the same claims does not justify institution of three petitions. Medtronic contends that the number and length of the claims, as well as “word count issues,” require three petitions. Paper 3 at 3-5. But the three Petitions challenge only a total of 23 claims—hardly an unusually high number. What’s more, Medtronic challenges the same claims on many duplicative grounds—far more than needed to provide “back-up” in the event the Itou reference is not prior art. For example, as explained above Medtronic challenges claim 32 of the ’760 patent on *six separate grounds*.

Medtronic’s contention that it could not fit all arguments into a single petition, or two petitions, at most, is a problem it created itself. Rather than judiciously selecting its strongest arguments, Medtronic chose to advance excessive, cumulative challenges to the same claims based on the same references. For example:

- Medtronic’s Petition #1 (IPR2020-0132) challenges claim 32 on three

separate grounds: *Ground 2*: Itou/Ressemann; *Ground 3*:

Itou/Kataishi; *Ground 4*: Itou/Enger;

- Medtronic’s Petition #2 (IPR2020-0133) challenges claim 32 on three separate grounds: *Ground 1*: Ressemann/Takahashi; *Ground 2*, Ressemann/Takahashi/Kataishi; *Ground 3*: Ressemann/Takahashi/Enger;
- Medtronic’s Petition #3 (IPR2020-0134) challenges claims 48, 51, and 53 on three separate grounds: *Ground 1*: Itou; *Ground 2*: Itou/Ressemann; *Ground 3*: Ressemann.

Medtronic’s third petition challenges only four claims total, based on the same primary references, Itou and Ressemann, asserted in its first and second petitions. Medtronic’s argument that it could not have sufficiently challenged all claims in one Itou-based petition and one Ressemann-based petition strains credulity.

Again, Medtronic’s reliance on *Microsoft* is inapposite. *Microsoft* concerned five petitions challenging **89 claims**; here Medtronic seeks to use three petitions to challenge only **23 claims**. See *Microsoft*, IPR2019-00810, Paper 12 at 14. Medtronic’s deliberate drafting choices do not reasonably justify its choice to pursue an overly burdensome, inefficient, and unfairly duplicative attack on the ’760 patent. See, e.g., *Pfenex, Inc. v. GlaxoSmithKline Biologicals SA*, IPR2019-01027, P12 at 13-14 (PTAB Nov. 13, 2019) (“[T]he mere fact that Petitioner may

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