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

Cases IPR2019-0132, IPR2019-0133, IPR2019-0134
U.S. Patent No. RE 45,760E

PETITIONERS' EXPLANATION OF MATERIAL DIFFERENCES BETWEEN PETITIONS AND PETITION RANKING FOR U.S. PATENT NO. RE 45,760E

Medtronic, Inc. and Medtronic Vascular, Inc. ("Petitioners") filed three concurrent *inter partes* review ("IPR") petitions against U.S. Pat. No. RE 45,760E ("the '760 Patent;" Ex-1001). However, the claims are split such that only two petitions challenge claims 25-42, 44, and 47, with a third petition addressed to claims 48 and 51-53. The Board should consider and institute all three petitions.

1. Three petitions are necessary due to a priority date dispute.

The Board's Trial Practice Guide states that "more than one petition may be necessary" where, as here, "there is a dispute about priority date requiring arguments under multiple prior art references." TPG UPDATE (July 2019) at 26. As outlined below, Petitioners filed multiple petitions for this very reason.

Itou-Based Petition	
Petition 1 IPR2019-0132	**Ground 1**: Claims 25-31, 33-38, 41, 42, 44, and 47 as anticipated by U.S. Pat. No. 7,736,355 ("Itou"). **Ground 2**: Claims 25, 30, 32, 39, and 40 as obvious over Itou in view of U.S. Pat. No. 7,604,612 ("Ressemann") and/or the knowledge of a POSITA **Ground 3:** Claim 32 as obvious over Itou, U.S. Pat. App. 2005/0015073 ("Kataishi"), and/or the knowledge of a POSITA **Ground 4**: Claim 32 as obvious over Itou in view of U.S. Pat. No. 5,980,486 ("Enger") and the knowledge of a POSITA
Ressemann-Based Petition	
Petition 2 IPR2019-0133	**Ground 1**: Claims 25-42, 44, and 47 as obvious over Ressemann in view of Takahashi et al., *New Method to Increase a Backup Support of a 6 French Guiding Coronary Catheter* ("Takahashi"), and/or the knowledge of a POSITA

	Ground 2: Claim 32 as obvious over Ressemann in view of Takahashi, Kataishi, and the knowledge of a POSITA **Ground 3**: Claim 32 as obvious over Ressemann in view of Takahashi, Enger, and/or the knowledge of a POSITA
***Combined* Itou and Ressemann-Based Petition for Claims 48 and 51-53**	
Petition 3 IPR2019-0134	**Ground 1**: Claims 48, 51, and 53 as anticipated by Itou **Ground 2**: Claims 48, 51, and 53 as obvious over Ressemann and/or the knowledge of a POSITA **Ground 3**: Claim 52 as obvious over Itou in view the knowledge of a POSITA **Ground 4**: Claims 48 and 51-53 as obvious over Ressemann in view of Takahashi, and/or the knowledge of a POSITA

Petition 1 asserts Itou as a primary reference. Itou has an effective filing date of September 23, 2005. (Ex-1007.) But Patent Owner has alleged a conception and reduction to practice date in 2004—a date much earlier than the priority date on the face of the '760 Patent.[1] (Ex-1084; Ex-1001.) Petitioners therefore submitted another Petition (Petition 2) that covers a similar set of claims as Petition 1 but asserts prior art references with priority dates *before* 2004. This second petition (Petition 2) relies on Ressemann as the primary reference. Ressemann was filed on August 9, 2002, and it is prior art under both pre-AIA §102(e) and post-AIA

[1] The '760 Patent claims priority to U.S. Pat. No. 8,292,850, which, on its face, is entitled to a priority date of May 3, 2006. (Ex-1001.)

§102(a)(1), (2). (Ex-1008.) Patent Owner is not able to swear behind Ressemann, as it may attempt to do for Itou in Petition 1 and Petition 3 (Grounds 2 and 4).

Due to the number of claims that Petitioners needed to address and the accompanying word count issues, *discussed infra*, Petitioners *combined* Itou- and Ressemann-based grounds for claims 48 and 51-53 in a third petition (Petition 3). As shown in the above chart, the grounds in Petition 3 are divided similar to the divide between Petition 1 and Petition 2. That is, Petition 3 addresses the same set of claims across two Itou-based grounds and two Ressemann-based grounds. This split is driven by Patent Owners' conception and reduction to practice position, which necessitates the filing of multiple petitions.

The Board's decision in *Microsoft Corp. v. IPA Technologies, Inc*. is instructive. IPR2019-00810, Paper 12 (PTAB Oct. 16, 2019). There, as here, the patent owner raised a priority date issue necessitating "arguments under multiple prior art references." *Id.* at 15. In *Microsoft Corp.*, the priority date dispute concerned a single prior art reference. Here, the priority dispute is more fundamental—Patent Owner has raised a priority date issue regarding the challenged patent itself. It would be manifestly unfair if the Board exercises its discretion under § 314(a) to deny Petition 2 (or the Ressemann-based grounds in Petition 3) and post-institution Patent Owner successfully swears behind Itou. Accordingly, the Board should consider and institute Petitions 1, 2, and 3.

2. Three petitions are necessary because of the length and number of claims asserted by Patent Owner in district court.

The ’760 Patent has 28 lengthy claims. Claim 25 of the ’760 Patent, for example, consists of 339 words. Mere recitation of the challenged claims takes up almost 2,000 words.

Given Patent Owner’s allegations in district court, Petitioners must also challenge a significant number of claims in the ’760 Patent and consider multiple potential interpretations of claim limitations. The Board’s Trial Practice Guide states that “more than one petition may be necessary” where, as here, “the patent owner has asserted a large number of claims in litigation.” TPG UPDATE (July 2019) at 26. In the district court litigation, Patent Owner has refused to identify the specific claims—or a specific number of claims—it will assert against Petitioner. (Ex-1079 ¶ 71 (“Medtronic has infringed and continues to infringe one or more claims of the ’760 patent, including at least claims 25, 28, 29, 32, and 48…;” *see also* Ex-1083, ¶ 5d.)

The Board’s decision in *Microsoft Corp.* is again instructive. There, as here, “word count limitations and a large number of challenged claims” supported the filing of multiple petitions. IPR2019-00810, Paper 9 at 14. In *Microsoft Corp.*, the patent owner generally alleged infringement of “one or more claims” of the subject patent. IPR2019-00810, Paper 9, 1 (“The complaint identified only claim 61, while generally alleging that Petitioner infringed ‘one or more claims.’”) The patent

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