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Paper
Date:

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MEDTRONIC, INC., and MEDTRONIC VASCULAR, INC.,
Petitioner,

v.

TELEFLEX INNOVATIONS S.À.R.L.,
Patent Owner.

IPR2020-00132
Patent RE45,760 E

Before SHERIDAN K. SNEDDEN, JON B. TORNQUIST, and CHRISTOPHER G. PAULRAJ, *Administrative Patent Judges.*

SNEDDEN, *Administrative Patent Judge*.

JUDGMENT
Final Written Decision
Determining No Challenged Claims Unpatentable
Not Deciding Patent Owner's Contingent Motion to Amend
35 U.S.C. § 318(a)

ORDERS
Denying Petitioner's Motion to Exclude (Paper 109)
37 C.F.R. § 42.64(c)

I. INTRODUCTION

Medtronic, Inc. and Medtronic Vascular, Inc. ("Petitioner") filed a Petition for *inter partes* review of claims 25–42, 44, and 47 of U.S. Patent No. RE45,760 E ("the '760 patent," Ex. 1001). Paper 1 ("Pet."). Teleflex Medical Devices S.À.R.L. ("Patent Owner")[1] filed a Preliminary Response. Papers 8 (confidential version), 9 (redacted version) ("Prelim. Resp."). Upon review of the Petition and Preliminary Response, we instituted an *inter partes* review of all claims on all grounds asserted in the Petition (Paper 22, "Inst. Dec." or "Institution Decision").

Patent Owner subsequently filed a Patent Owner Response (Paper 43, "PO Resp.") (redacted version available at Paper 44), Petitioner filed a Reply (Paper 83, "Pet. Reply") (redacted version available at Paper 82), and Patent Owner filed a Sur-Reply (Paper 101, "Sur-Reply") (redacted version available at Paper 102).

With prior authorization of the Board, Patent Owner filed a Consolidated Response Addressing Conception and Reduction to Practice (Paper 39, "PO CRTP Resp." or "PO CRTP Response"), to which Petitioner filed a Reply (Paper 78, "Pet. CRTP Reply") (redacted version available at Paper 79), Patent Owner filed a Sur-Reply (Paper 96, "PO CRTP Sur-Reply"), and Petitioner filed a Sur-Sur-Reply (Paper 110, "Pet. CRTP Sur-Sur-Reply").

Patent Owner also filed a Contingent Motion to Amend. Paper 38. The Motion requests that if any of issued claims 37, 38, 39, 48, or 51 of the

[1] Patent Owner represents that "Teleflex Innovations S.A.R.L. merged into Teleflex Medical Devices S.A.R.L," which subsequently "transferred ownership of U.S. Patent No. RE45,760E to Teleflex Life Sciences Limited." Paper 7, 2.

'760 patent are determined to be unpatentable, they should be replaced by proposed substitute claims 54–58. *Id.* at 1. Petitioner filed an Opposition to the Motion to Amend (Paper 85), to which Patent Owner filed a reply (Paper 104), and Petitioner filed a sur-reply (Paper 112).

An oral hearing was held on March 8, 2021, and a transcript of the hearing is included in the record. Paper 124 ("Tr.") (redacted version available at Paper 123).

A. Real Parties in Interest

Petitioner identifies its real parties-in-interest as Medtronic, Inc. and Medtronic Vascular, Inc., and notes that "Medtronic plc is the ultimate parent of both entities." Pet. 5.

Patent Owner identifies its real parties-in-interest as Teleflex Medical Devices S.A.R.L.; Vascular Solutions LLC; Arrow International, Inc.; and Teleflex LLC. Paper 4, 2. Patent Owner also notes that "Teleflex Incorporated is the ultimate parent of the entities listed above." Paper 7, 2.

B. Related Matters

The '760 patent is at issue in *Vascular Solutions LLC, et al. v. Medtronic, Inc., et al.* No. 19-cv-01760 (D. Minn. filed July 2, 2019) and *QXMedical, LLC v. Vascular Solutions, LLC*, No. 17-cv-01969 (D. Minn., filed June 8, 2017) ("*QXM*"). Pet. 5–6; Paper 4, 2. The '760 patent is a reissue of U.S. Pat. No. 8,292,850 ("the '850 patent).

The '850 patent was the subject of two previous *inter partes* reviews: IPR2014-00762, filed May 16, 2014 and terminated August 11, 2014 by way of joint motion to terminate, and IPR2014-00763, filed May 16, 2014 and terminated August 11, 2014 by way of joint motion to terminate. Pet. 6; Paper 4, 2–3. The '850 patent was also at issue in the U.S. District Court for

the District of Minnesota in *Vascular Solutions, Inc. v. Boston Scientific Corp.*, No. 13-cv-01172 (D. Minn., filed May 16, 2013). *Id.*

Petitioner has filed two additional Petitions for *inter partes* review of the '760 patent as IPR2020-00133 and IPR2020-00134.

C. The '760 Patent

1. Specification

The subject matter claimed in the '760 patent is directed to a device for use with a standard guide catheter. Ex. 1001, 13:36–17:13. Figures 1 and 5 of the '760 patent, reproduced below, depict a coaxial guide catheter and a tapered inner catheter.

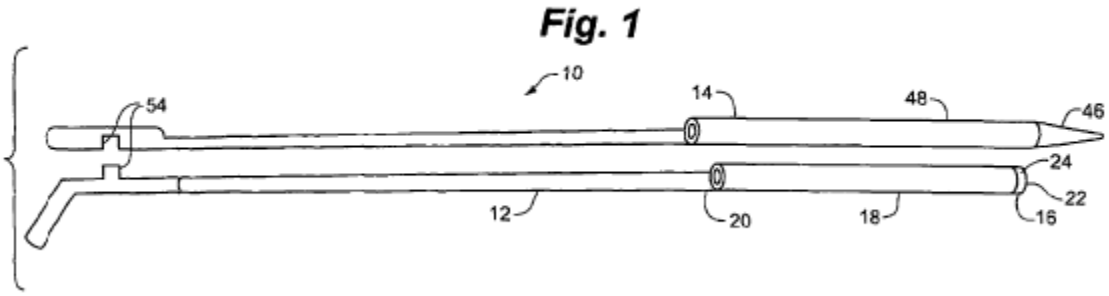

Figure 1 of the '760 patent

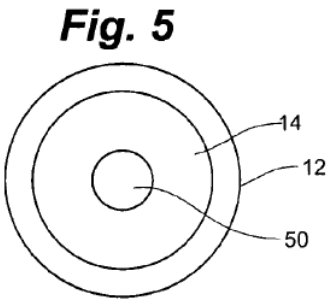

Figure 5 of the '760 patent

As shown in Figures 1 and 5, above, coaxial guide catheter assembly 10 includes coaxial guide catheter 12 and tapered inner catheter 14. *Id.* at 6:37–39. Coaxial guide catheter 12 generally includes tip portion 16,

reinforced portion 18, and rigid portion 20. *Id.* at 6:40–41. Tip portion 16 generally includes bump tip 22 and marker band 24. *Id.* at 6:44–45. Bump tip 22 includes taper 26 and is relatively flexible. *Id.* at 6:45–46. Marker band 24 is formed of a radiopaque material such as platinum/iridium alloy. *Id.* at 6:49–50. Tapered inner catheter tip 42 includes tapered portion 46 at a distal end thereof, and straight portion 48. *Id.* at 7:22–23. Both tapered portion 46 and straight portion 48 are pierced by lumen 50. *Id.* at 7:23–24. Tapered inner catheter 14 may also include clip 54 at a proximal end thereof to releasably join tapered inner catheter 14 to coaxial guide catheter 12. *Id.* at 7:27–29. Thus, tapered inner catheter 14 is keyed to coaxial guide catheter 12. *Id.* at 7:29–30.

2. Illustrative Claim

Independent claim 25, reproduced below, is illustrative of the challenged claims.

25. A system, comprising:

> a guide catheter configured to be advanceable through a main blood vessel to a position adjacent an ostium of a coronary artery, the guide catheter having a lumen extending from a hemostatic valve at a proximal end of the guide catheter to a distal end of the guide catheter that is adapted to be positioned adjacent the ostium of the coronary artery; and
>
> a guide extension catheter configured to be partially advanceable through the guide catheter and into the coronary artery, the guide extension catheter having a length such that a distal end of the guide extension catheter is extendable through the lumen and beyond the distal end of the guide catheter, and a proximal end of the guide extension catheter is extendable through the hemostatic valve at the proximal end of the guide catheter,
>
> the guide extension catheter including, in a proximal to distal direction, a substantially rigid segment, a segment defining

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