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.

Case No. IPR2020-00132
Case No. IPR2020-00134
U.S. Patent No. RE45,760

PETITIONER'S OPPOSITION
TO PATENT OWNER'S MOTION TO AMEND

TABLE OF CONTENTS

Page

TABLE OF AUTHORITIES

Page(s)

Federal Cases

I. INTRODUCTION

Medtronic, Inc., and Medtronic Vascular, Inc., ("Petitioner") opposes Patent Owner's Contingent Motion to Amend (Paper 38, "Mot."). Patent Owner ("PO") seeks to amend claims 37-39, 48, and 51 and proposes substitute claims 54-58. (Mot., 1, Appendix A ("App.").) But the substitute claims are not supported by the original disclosure and are unpatentable over the prior art. PO's Motion should be denied for all these reasons.

II. PROPOSED CLAIMS 54-56 AND 58 LACK WRITTEN DESCRIPTION SUPPORT.

A. Claims reciting a side opening outside of the substantially rigid portion lack support.

Claim 25, from which substitute claims 54-56 depend, recites a "guide extension catheter including, *in a proximal to distal direction*, a substantially rigid segment, a segment defining a side opening, and a tubular structure." (Ex. 1001, 13:53-57.)[1] Similarly, substitute claim 58 recites a "guide extension catheter including, *in a proximal to distal direction*, a substantially rigid rail structure segment, a segment defining a side opening, and a tubular structure comprising a reinforced portion and a cylindrical distal tip portion." (App., 5.) A POSITA would understand that claims 54-56 and 58 require a side opening *segment* that is separate

[1] All emphasis and annotations added unless otherwise specified.

from (distal to) the substantially rigid segment. (Ex. 1919, ¶¶ 53-56; *see also* Mot., 6 ("The claim need not expressly recite that the side opening segment is in the substantially rigid segment.").) But the written description exclusively and repeatedly describes the side opening as *part of* the substantially rigid segment of the claimed device. Thus, substitute claims 54-56 and 58 should be rejected for lack of written description.

The original patent application[2] describes the invention as a device that is used with "standard guide catheters" in "interventional cardiology procedures." (Ex. 1842, 7-8.) The claims of the original patent application (and the proposed claims here) are generally directed to the "coaxial guide catheter" described in the specification. (*See*, *e.g.*, *id.*, 38-44; *see also* POR, 4 (also describing the invention as a "guide extension catheter").) This coaxial guide catheter is consistently described as being made of three distinct portions: "a tip portion, a reinforced portion, and a substantially rigid portion." (Ex. 1842, 9; *see also id.*, 16 (alternatively describing the final section as a "rigid portion 20").) Each of these portions has a specified composition—the tip portion is "a low durometer polymer

[2] Petitioners cite the parent patent application—the '629 application (issued as the '032 patent)—as the parties have stipulated that each application in the priority chain contains substantively identical disclosures. IPR2020-00132, Paper 38, 3 n.1.

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