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 IPR2020-00133
Patent RE 45,760E

PATENT OWNER'S SUR-REPLY TO PETITIONER'S REPLY TO ADDRESS 35 U.S.C. § 314(a)

The POPR explains why the Board should decline to institute under 35 U.S.C. § 314(a). Paper 9 at 18-21. The *Apple* factors confirm this.

Factor 1: Petitioner has not sought a stay, and a stay is unlikely. Where, as here, neither party has requested a stay the Board declines to infer how the district court would rule. *E.g. Intel*, IPR2020-00113, Paper 15 at 8-9 (May 19, 2020); *Apple*, IPR2020-00019, Paper 15 at 12 (May 13, 2020). The *QXMédical* case was stayed only because QXMédical agreed to exit the market and waived its obviousness/anticipation defenses. Ex. 1094 at 2. Petitioner's assertion that Judge Schiltz has previously granted stays ignores that (i) one was stipulated and (ii) none involved direct competitors/allegations of irreparable harm.

Factor 2: The trial-ready date (August 1, 2021) is only weeks after the last statutory deadline (July 8, 2021). The dates are very close; that the statutory deadline is first should not significantly impact the analysis. Petitioner notes that Judge Schiltz has extended trial-ready dates in other cases but provides no information regarding the circumstances. Indeed, in both this and the *QXMédical* case the extension was by stipulation of the parties, not *sua sponte*.

Factor 3: The District Court is already deeply invested and the litigation has significantly progressed. As the POPR explains, the Court is already very familiar with the GuideLiner patents, the validity arguments and prior art, and the issue of Teleflex's pre-Itou invention via (i) the co-pending *QXMédical* case and (ii) the

parties' extensive litigation of the preliminary injunction motion. The parties have exchanged infringement contentions. There have been two depositions; three more are set for the coming weeks (Exs. 2050, 2051, 2082–2084). Fact discovery will be ***finished*** by Sept. 1, 2020, only 1.5 months after any institution decision. Ex. 2049 at 2. Also, Petitioner did delay—as the POPR explains Petitioner knew this dispute was coming long ago but waited until November 2019 to file. Paper 9 at 2.

Factor 4: There is complete overlap between the issues raised in the parallel proceedings. In the district court, Petitioner challenges the validity of *all* claims in each asserted patent, based on the *same* invalidity art and arguments as the petitions. Ex. 2078 at 55 ("Second Defense"), 58-61. The fact- and witness-intensive issue of whether Teleflex's invention pre-dates Itou is also in both proceedings. The Petitioner also seeks to raise a written description issue in both.

Factor 5: The Petitioner and the district court defendant are the same party.

Factor 6: Other circumstances favor denial. As the POPRs explain, the petitions have significant substantive weaknesses. Moreover, the petitions themselves are highly burdensome and inefficient, challenging some claims on numerous duplicative grounds. *E.g.* IPR2020-00129, -00131 (claim 27 (seven grounds)); IPR2020-00132, -00133, -00134 (claim 32 (six grounds), claims 48, 51, 53 (three grounds each)); IPR2020-00135, -00136 (claims 52-56 (five grounds), claims 36 (four grounds)); IPR2020-00137, -00138 (claim 44 (seven grounds)).

Dated: May 21, 2020.

Respectfully submitted,

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CERTIFICATION OF SERVICE

Pursuant to 37 C.F.R. § 42.6(e) and the agreement of the parties, the undersigned certifies that on May 21, 2020, a true and correct copy of the foregoing *Patent Owner's Sur-Reply to Petitioner's Reply to Address 35 U.S.C. § 314(a)* was served via electronic mail upon the following:

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