UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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MEDTRONIC, INC., AND MEDTRONIC VASCULAR, INC.,
Petitioner,

v.

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

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Case IPR2020-00134
Patent RE 45,760

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PETITIONERS' REPLY TO PATENT OWNER'S PRELIMINARY RESPONSE

I. Medtronic had no obligation to address conception and reduction to practice in the Petition.

Conception and reduction to practice ("CRTP") are issues for the trial phase that Medtronic did not have to address in its Petition.[1] Indeed, "Patent Owner bears the burden of proof regarding its antedating contention," meaning the "Petitioner is entitled to respond to th[at] contention after discovery." *Mylan Pharms. Inc. v. Boehringer Ingelheim Pharms. Inc.*, IPR2016-01563, Paper 14 at *4 (PTAB Dec. 7, 2016). As the Board has previously explained: "[i]t is premature at the institution stage to address the merits of Patent Owner's antedating contention." *Id.*; *see also Pfizer Inc. v. Genentech, Inc.*, IPR2017-01488, Paper 27 at *15 (PTAB Dec. 1, 2017). The Board routinely rejects arguments "that Petitioners were required in the Petition to foresee and prebut Patent Owner's argument and evidence purporting to show a reduction to practice of certain subject matter." *Associated British Foods PLC v. Cornell Research Found.*, IPR2019-00577, Paper 25 at *31 (PTAB July 25, 2019); *Mylan*, Paper 14 at *3-4.

Medtronic should be afforded the opportunity to respond to Teleflex's CRTP theory. In particular, Medtronic should be able to take discovery and submit expert

[1] Teleflex's attempt to swear behind Itou is moot because the AIA applies. Pet. at 14-15. The Court's decision is relevant because it finds a substantial question on written description for the same reason argued in the Petition. Ex. 1688 at 9.

testimony addressing the holes in Teleflex's evidence, including on the CRTP of each limitation (something Teleflex and its expert has not done). Even more concerning, is the evidence Teleflex has withheld from these proceedings. In denying Teleflex's motion for preliminary injunction, the District Court pointed out that "a report dated December 1, 2005—months *after* Teleflex's claimed reduction to practice—states that '[t]he rapid exchange version requires additional engineering and is not included in our 2006 forecasts.'" Ex. 1688 at 13. Teleflex did not submit that contradictory report with its POPR. Thus, Medtronic would be prejudiced if the burden of proof were shifted and it was deprived of any opportunity to address such issues and rebut Teleflex's arguments and evidence.

Notably, Teleflex disclosed limited evidence on CRTP in the litigation before Medtronic filed its Petition. In Teleflex's first interrogatory response from August 15, 2019, it only disclosed that "the inventors came up with the idea for what became the GuideLiner catheter product and that led to the inventions claimed in the patents-in-suit at some point in 2004 after the annual Transcatheter Cardiovascular Therapeutics conference that took place in late September of that year." Ex. 2045 at 3-4. The response identified just three supporting attorney's eyes only ("AEO") documents from 2005. *Id.* at 4; *see, e.g.*, Exs. 2003-2004. That disclosure was far from a complete picture of Teleflex's theory—it did not even offer alleged dates for CRTP.

Teleflex did not begin to disclose its actual positions until much later. On November 6, 2019 (less than a week before Medtronic filed its Petition) Teleflex supplemented its interrogatory response to provide its first narrative explanation, marking it AEO. In total, prior to the Petition's filing, Teleflex only disclosed roughly 17 exhibits and its supplemental interrogatory responses in the district court litigation. Exs. 2002-2004, 2014-2015, 2017-2019, 2022-2025, 2027, 2036, 2040-2041, 2043, 2045. All of the documents were designated AEO and raised more questions than they clarified on Teleflex's CRTP position. For example, invoices for part orders do not show CRTP of any particular claim limitation. *See, e.g.*, Ex. 2027; *see also* Ex. 1688 at 12-13 ("[T]hese documents do little to corroborate either diligence or reduction to practice of the Rx version."). Nor did drawings of potential catheter designs, which Teleflex did not map to each and every limitation in its responses. Ex. 2022. Moreover, several days was not sufficient time to explicate Teleflex's arguments and then respond.

Nor was Medtronic legally permitted to use any of the evidence from the district court. Teleflex saw to that by designating the documents under the Protective Order, which provides that "[a] confidential document may be used only *in this action*." Ex. 1686, § 3(a). Consequently, Medtronic was prohibited by court order from using that evidence in its Petition. Nor does the Protective Order allow Medtronic's IPR counsel any access to those materials. *Id.*, §§ 1(a), 3(b)-(c).

Further, Teleflex's evidence and arguments continued to evolve after Medtronic filed its Petition. In its POPR, Teleflex relied on roughly 22 new exhibits that it had not produced prior to the Petition. *See, e.g.*, Exs. 2005-2011, 2013, 2016, 2020-2021, 2026, 2028-2036, 2038. This evidence is not analogous to *LG Elecs., Inc. v. Wi-LAN Inc.*, where the Board found that a draft Patent Application showed all limitations sufficient to antedate a prior art reference. IPR2018-00704, Paper 14 at 8-20 (PTAB Sept. 5, 2018). Despite the volume of Teleflex's exhibits, in the order denying Teleflex's motion for preliminary injunction, the District Court's found a "lack of primary documentation that would typically be generated during the development and testing of a medical device." Ex. 1688 at 13-14. The Court also noted "a remarkable discrepancy between the robust documentation of the development of the OTW [over-the-wire] version and the meager documentation that Teleflex has submitted to corroborate the reduction to practice of the Rx [rapid-exchange] version." *Id.* at 12. These types of issues demonstrate why Petitioners should not be saddled with predicting how patent owners could potentially piece together evidence of uncertain applicability. Indeed, even Teleflex has been unable to present a cogent theory sufficient to overcome the "substantial question" of validity based on Itou in the District Court. *Id.* at 14. Thus, Medtronic's Petition did not need to address and prebut Teleflex's CRTP.

1. Medtronic did not have to raise secondary considerations in its Petition.

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