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 IPR2020-00132
Case IPR2020-00134
Patent RE 45,760

PATENT OWNER'S CONTINGENT MOTION TO AMEND U.S. PATENT RE 45,760 UNDER 37 C.F.R. § 42.121

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I. INTRODUCTION

Patent Owner Teleflex submits this Contingent Motion to Amend U.S. Patent RE 45,760 ("Motion"), with the Declaration of Peter T. Keith in Support of Motions to Amend ("Ex-2124"), under 37 C.F.R. § 42.121. This motion does not seek preliminary guidance. If, after considering Teleflex's Patent Owner Responses, the Board finds any of issued claims 37, 38, 39, 48, or 51 of the '760 patent invalid, Teleflex respectfully requests that the Board substitute the invalid claim(s) with the respective proposed substitute claim of claims 54-58. *See* 37 C.F.R. § 42.22(a)(2); 35 U.S.C. § 316(d).

II. LEGAL STANDARDS FOR AMENDING CLAIMS

A motion to amend must (1) propose a reasonable number of substitute claims, (2) that respond to a ground of unpatentability involved in the trial, (3) that do not enlarge the scope of the claims or introduce new matter, and (4) are not shown by a preponderance of the evidence to be unpatentable. *See* Memorandum re: Guidance on Motions to Amend in view of *Aqua Products* (Nov. 21, 2017) at 2; 35 U.S.C. § 316(d); 37 C.F.R. § 42.121. It is Petitioner's burden to show that the proposed substitute claims are unpatentable. *Lectrosonics, Inc. v. Zaxcom, Inc.*, IPR2018-01129, Paper 15 at 4 (PTAB Feb. 25, 2019).

III. CLAIM LISTING

Pursuant to 37 C.F.R. § 42.121(b), Appendix A lists the changes made to the issued claims of the '760 patent that would be replaced under this Motion. This

claim listing includes one replacement claim for each of claims 37, 38, 39, 48, and 51. The number of proposed substitute claims is reasonable under 35 U.S.C. § 316(d)(1)(B) and 37 C.F.R. § 42.121(a)(3).

IV. SCOPE OF THE SUBSTITUTE CLAIMS

The proposed substitute claims comply with 35 U.S.C. § 316(d)(3) and 37 C.F.R. § 42.121(a)(2)(ii) because no substitute claim enlarges the scope of, or eliminates any element from, the original claim it replaces. All amendments reflected in substitute claims 54-58 are narrowing amendments.

The amendment to substitute claim 58 that recites that "the tubular structure . . . [has] a[n] inner diameter that is greater than or equal to 0.056 inches so as to be not more than one French size smaller than the . . . inner diameter of the . . . standard 6 French guide catheter" is narrowing because the original claim recited a "one French size" difference, while the amendment recites only a 6 French guide catheter with at least an 0.070 inch inner diameter used with a tubular structure having an inner diameter "greater than or equal to 0.056 inches." This 0.014 inch one French size difference is supported by the disclosure in the priority application

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