

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.

IPR2020-00134

**PATENT OWNER'S REQUEST
FOR ORAL ARGUMENT PURSUANT TO 37 C.F.R. § 42.70(a)**

Pursuant to 37 C.F.R. § 42.70(a) and the Consolidated Scheduling Order (Paper 26) Patent Owner Teleflex requests an opportunity to present oral argument regarding the claims challenged in IPR2020-00126 (Patent 8,048,032 B2), IPR2020-00127 (Patent 8,048,032 B2), IPR2020-00128 (Patent RE45,380), IPR2020-00129 (Patent RE45,380), IPR2020-00130 (Patent RE45,380), IPR2020-00132 (Patent RE45,760), IPR2020-00134 (Patent RE45,760), IPR2020-00135 (Patent RE45,776), IPR2020-00136 (Patent RE45,776), IPR2020-00137 (Patent RE47,379), and IPR2020-00138 (Patent RE47,379). The Board has set a hearing on this matter for March 8, 2021. (Paper 26, Due Date 8.) Patent Owner requests oral argument (without waiving consideration of any issue not listed below) to address the grounds on which these IPRs were instituted, including the specific invalidity grounds raised in the Petitions of the instituted trials, the parties' dispute regarding conception and reduction to practice ("CRTP") in IPR2020-00126, -00128, -00129, -00132, -00134, -00135, and -00137, and Patent Owner's Contingent Motions to Amend, any motion to exclude filed in this proceeding, any additional issues identified in Petitioners' request for oral argument, and any additional issues on which the Board seeks clarification.

Patent Owner further requests the opportunity to present live testimony from inventor Howard Root on CRTP. The Consolidated Scheduling Order states that "the panel may consider whether live testimony is appropriate for the underlying

factual issues related to” that issue as it is presented in IPR2020-00126, -00128, -00129, -00132, -00134, -00135, and -00137. (Paper 26, 4.)

The factors the Board considers in deciding whether to allow live testimony weigh in favor of allowing Mr. Root’s testimony in these proceedings. *See K-40 Elecs., LLC v. Escort, Inc.*, IPR2013-00203, Paper 34 (PTAB May 21, 2014) (precedential). Petitioner’s Itou-based CRTP challenge is central to the IPRs currently before the Board. A ruling in Patent Owner’s favor on CRTP would be completely dispositive of five IPRs (-00126, -00128, -00132, -00135, and -00137), and resolve several grounds of two additional IPRs (Grounds 7-9 of -00129 and Grounds 1-3 of -00134). Mr. Root is the founder and former CEO of Vascular Solutions, the original owner of the patents at issue, although he is not associated with the current Patent Owner. He is also a named inventor and principal fact witness. *Id.* at 3. Although Petitioner’s expert agrees that Patent Owner’s testimonial and documentary evidence is truthful, Petitioner has put Mr. Root’s credibility at issue by arguing that his testimony is not sufficiently corroborated and by contending that certain documentary evidence he relies on may actually relate to other products. Those arguments directly contradict Mr. Root’s testimony. *See MPOWERD Inc. v. LuminAID Lab, LLC*, IPR2018-01524, Paper 40, 4 (PTAB Nov. 1, 2019). Moreover, if the Board were to reject Petitioner’s argument that Mr. Root’s declaration lacks sufficient corroboration, this case may

well turn on Mr. Root's credibility. *Id.* Thus, Mr. Root's testimony may be case dispositive.

It is well settled that “[t]he fundamental requisite of due process of law is the opportunity to be heard.” *Grannis v. Ordean*, 234 U.S. 385, 394 (1914). “In almost every setting where important decisions turn on questions of fact, due process requires an opportunity” for live testimony. *Goldberg v. Kelly*, 397 U.S. 254, 269 (1970). Under the facts and circumstances presented in these IPRs, Patent Owner believes this an “appropriate situation[]” where live testimony is warranted. Office Trial Practice Guide, 77 Fed. Reg. 48,762 & 48,768 (Aug. 14, 2012); Consolidated Trial Practice Guide (November 2019), 32.

Patent Owner has met and conferred with Petitioner about the parties' respective proposals for conduct of the proceedings. Agreement was not reached on the issue of live testimony or the amount of time for argument on CRTP or the 35 U.S.C. §§ 102/103 validity issues presented in these IPRs. The parties do agree on the appropriate time to allot to Patent Owner's Contingent Motions to Amend. Patent Owner therefore asks the Board to enter the following:

- CRTP: 30 minutes per side for examination of Mr. Root, plus 60 minutes oral argument per side;
- 35 U.S.C. §§ 102/103 issues: 90 minutes oral argument per side; and

- Contingent Motions to Amend: 30 minutes oral argument per side (per parties' agreement).

Approximately ten people from Patent Owner's side will attend the oral argument.

Patent Owner requests technology to display demonstrative exhibits, including technology to allow the exhibits to be viewed by any Judge participating remotely. Patent Owner understands that the Consolidated Scheduling Order (Paper 26) set oral argument, if requested, to take place at the U.S. Patent & Trademark Office headquarters in Alexandria, Virginia, but that in light of the ongoing COVID-19 pandemic and the Board's March 13, 2020 notice (<https://www.uspto.gov/about-us/news-updates/uspto-update-person-meetings>), the oral argument will be conducted remotely by video or telephone. Patent Owner respectfully requests that oral argument be conducted by videoconference rather than teleconference, if possible.

If this request for oral argument is granted, Patent Owner will direct its request for audio-visual technology to PTABHearings@uspto.gov.

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