

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 No. IPR2020-00132

Case No. IPR2020-00134

U.S. Patent No. RE45,760

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**PETITIONER'S SUR-REPLY  
TO PATENT OWNER'S MOTION TO AMEND**

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## I. INTRODUCTION

Patent Owner’s (“PO”) inventions are not new—they merely commercialize the prior art. The proposed amended claims add no new material limitations that were not present in the art and are therefore invalid for the same reasons the original claims are invalid. Before the alleged invention, Kontos described a “guide catheter extension.” Itou, a suction catheter, and Ressemann, an embolic protection device, are both designed to treat coronary artery disease and would be considered together in designing catheters and treating patients. Ressemann and Kataishi disclose the claimed structure of the amended complex side opening and the art attributes known benefits to this structure. Further, the art describes that similarly shaped openings provide these same benefits when used for both the proximal and distal opening of various catheters. Nonetheless, PO argues that obviousness is nothing but hindsight.

But a POSITA is not an automaton restricted to combining two specific physical embodiments of the prior art. *Univ. of Maryland Biotechnology Institute v. Presens Precision Sensing GmbH*, 711 F. App’x 1007, 1010 (Fed. Cir. 2017). Instead, a POSITA has the ordinary creativity of a skilled artisan using the common knowledge and common sense present in the art. *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 421 (2007). PO narrowly focuses on combining specific embodiments and argues because they are not combinable without making some modifications, the invention is not obvious. PO ignores that these modifications were well-understood

routine engineering concepts within the capability of a POSITA, who had motivation to make them. Taking well-defined structures with known benefits, like the shape of various catheter openings, and applying those structures to other catheters to achieve predictable results is not inventive. Thus, the proposed amended claims are invalid.

## **II. PROPOSED CLAIMS 54-58 ARE UNPATENTABLE**

### **A. Substitute Claims 54-58 Are Unpatentable Over Itou, Itou in View of Ressemann, or Itou in View of Ressemann and Kataishi**

PO argues that the Itou grounds do not invalidate for at least five reasons, including (1) Itou does not disclose stents, (2) Ressemann and Kataishi do not disclose the “concave track,” (3) Itou does not disclose the one French size differential, (4) Itou does not disclose the “coaxial lumen,” and (5) a POSITA would not be motivated to combine the references. Each of these issues is discussed below.

#### **1. Stents and Stent Catheters**

Itou discloses that all four types of interventional cardiology devices are insertable, including stents. First, Itou itself teaches that guidewire (6) is insertable through catheter (2). Ex. 1007, Fig. 5; 4:64-65; *see also* Ex. 1806 ¶ 45. PO’s expert could have, but did not, offer an opinion on whether a guidewire fit through Itou’s structure. Ex. 1805, 139:3-13. Second, the inner diameter of Itou’s tubular portion 24 is 1.5mm, or 0.059 inches, Ex. 1007, Table 1, 1:59-65, *see also* Ex. 1903 ¶¶ 21-22. Even if the “effective opening” of Itou is only 0.046 inches, as PO incorrectly asserts, angioplasty balloons and numerous commercial stents (necessarily deployed

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