

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

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

Petitioner,

v.

TELEFLEX INNOVATIONS S.À.R.L.,

Patent Owner.

Case IPR2020-00134

Patent RE45,760

**PETITIONER'S REQUEST FOR DIRECTOR REHEARING
PURSUANT TO 37 C.F.R. § 42.71(d) AND *UNITED STATES V. ARTHREX***

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I. INTRODUCTION

Petitioner seeks Director review of the Final Written Decision (“FWD,” Paper 122) holding that the primary reference, Itou, is not prior art.¹ The Board adopted its reduction to practice analysis set forth in its Final Written Decision in IPR2020-00132, Paper 125 (“132 FWD”). FWD at 11. Thus, Petitioner’s analysis here addresses the Board’s analysis in IPR2020-00132.

The Board erred in finding that Patent Owner’s predecessor, VSI, reduced the claimed coaxial guide catheter inventions to practice before Itou. The Board found that VSI assembled and tested prototypes embodying the inventions and determined that they would work for their intended purpose. But the Board’s ruling on testing cites only inventor testimony, in violation of established corroboration requirements. No document in the record relates to testing relevant prototypes. The Board cited the declaration of a non-inventor, Erb, but not for any details regarding testing relevant prototypes (because he provides none).

The Board’s decision departs from binding authority establishing the contours of corroboration requirements. Neither the Board’s decision nor Patent Owner’s briefing cites a single case finding that an invention was demonstrated to work for its intended purpose based on only after-the-fact testimony, much less only *inventor*

¹ Petitioner requested a Precedential Opinion Panel by email.

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