

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 No. IPR2020-00135

Case No. IPR2020-00136

U.S. Patent No. RE45,776

**PETITIONER'S OPPOSITION
TO PATENT OWNER'S MOTION TO AMEND**

TABLE OF CONTENTS

	Page
I. Introduction.....	1
II. Proposed Claims 58-62 and 65 Lack Written Description Support and Proposed Claim 64 Is Indefinite.	1
A. Claims reciting a side opening outside of the substantially rigid portion lack support.....	1
B. Proposed claim 64 is indefinite.	11
III. Proposed Claim 65 is a Broadening Amendment	11
IV. The Prior Art Renders Proposed Claims 58-65 Unpatentable.	11
A. Claim Construction.....	11
B. Substitute claims 58-60 and 63-65 are unpatentable over Itou in view of Ressemann and/or Kataishi.	12
1. Substitute Claims 58-60	12
2. Substitute Claims 63-65	21
C. Substitute claims 61 and 62 are unpatentable over Itou in view of Ressemann or Kataishi and Eidschink.	22
D. Substitute claims 58 & 60 are unpatentable over Kontos in view of Ressemann.	26
E. Substitute claims 61 and 62 are unpatentable over Kontos in view of Ressemann and Eidschink.....	29
F. Substitute claims 63-65 are unpatentable over Kontos in view of Ressemann and Takahashi.	30
G. Substitute claims 58-60, 61-62, and 63-65 are unpatentable over Kontos in view of Kataishi, Kontos in view of Kataishi and Eidschink; and Kontos in view of Ressemann, Kataishi and Takahashi, respectively.	34
V. Conclusion	34

TABLE OF AUTHORITIES

	Page(s)
Federal Cases	
<i>Gentry Gallery, Inc. v. Berkline Corp.</i> , 134 F.3d 1473 (Fed. Cir. 1998)	5
<i>ICU Medical, Inc. v. Alaris Medical Sys., Inc.</i> , 558 F.3d 1368 (Fed. Cir. 2009)	10
<i>KSR Int’l Co. v. Teleflex, Inc.</i> , 550 U.S. 398 (2007).....	17, 26, 30
<i>PowerOasis Inc. v. T-Mobile USA, Inc.</i> , 522 F.3d 1299 (Fed. Cir. 2008)	5
<i>Tronzo v. Biomet, Inc.</i> , 156 F.3d 1154 (Fed. Cir. 1998)	5

I. INTRODUCTION

Medtronic, Inc., and Medtronic Vascular, Inc., (“Petitioner”) opposes Patent Owner’s Contingent Motion to Amend (Paper 38, “Mot.”). Patent Owner (“PO”) seeks to amend claims 27, 33, 37, 42, 43, 45, 47, and 56 and proposes substitute claims 58-65. (Mot., 1, Appendix A (“App.”).) But the substitute claims are not supported by the original disclosure and are unpatentable over the prior art. PO’s Motion should be denied for all these reasons.

II. PROPOSED CLAIMS 58-62 AND 65 LACK WRITTEN DESCRIPTION SUPPORT AND PROPOSED CLAIM 64 IS INDEFINITE.

A. Claims reciting a side opening outside of the substantially rigid portion lack support.

Claim 25 (from which substitute claims 58-60 depend), claim 52 (from which substitute claim 65 depends), and substitute claims 61-62 recite “[a] guide extension catheter for use with a guide catheter, comprising: a substantially rigid segment; a tubular structure . . . ; and a segment defining a partially cylindrical opening positioned between a distal end of the substantially rigid segment and a proximal end of the tubular structure.” (Ex. 1001, 13:36-49, 15:15-28; App., 1-3.)¹ A POSITA would understand that claims 58-62 and 65 require a side opening *segment* that is separate from (distal to) the substantially rigid segment. (Ex. 1919, ¶¶ 57-65;

¹ All emphasis and annotations added unless otherwise specified.

see also Mot., 5 (“The claim need not expressly recite that the partially cylindrical opening is in the substantially rigid segment.”).) But the written description exclusively and repeatedly describes the side opening as *part of* the substantially rigid segment of the claimed device. Thus, proposed claims 58-62 and 65 should be rejected for lack of written description.

The original patent application² describes the invention as a device that is used with “standard guide catheters” in “interventional cardiology procedures.” (Ex. 1842, 7-8.) The claims of the original patent application (and the proposed claims here) are generally directed to the “coaxial guide catheter” described in the specification. (*See, e.g., id.*, 38-44; *see also* POR, 4 (also describing the invention as a “guide extension catheter”).) This coaxial guide catheter is consistently described as being made of three distinct portions: “a tip portion, a reinforced portion, and a substantially rigid portion.” (Ex. 1842, 9; *see also id.*, 16 (alternatively describing the final section as a “rigid portion 20”).) Each of these portions has a specified composition—the tip portion is “a low durometer polymer or elastomer”; the reinforced portion is made of PTFE, Pebax®, and may be

² Petitioner cites the parent patent application—the ’629 application (issued as the ’032 patent)—as the parties have stipulated that each application in the priority chain contains substantively identical disclosures. (IPR2020-00135, Paper 38, 2 n.1.)

Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

Real-Time Litigation Alerts



Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

Advanced Docket Research



With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

Analytics At Your Fingertips



Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

LAW FIRMS

Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

FINANCIAL INSTITUTIONS

Litigation and bankruptcy checks for companies and debtors.

E-DISCOVERY AND LEGAL VENDORS

Sync your system to PACER to automate legal marketing.