

1 UNITED STATES PATENT AND TRADEMARK OFFICE
2 BEFORE THE PATENT TRIAL AND APPEAL BOARD

3 MEDTRONIC, INC., AND MEDTRONIC
4 VASCULAR, INC.,

5 Petitioners,

6 vs.

7 TELEFLEX INNOVATIONS S.A.R.L.,

8 Patent Owner.

9 IPR2020-00126 (Patent 8,048,032 B2)
10 IPR2020-00127 (Patent 8,048,032 B2)
11 IPR2020-00128 (Patent RE45,380 E)
12 IPR2020-00129 (Patent RE45,380 E)
13 IPR2020-00130 (Patent RE45,380 E)
14 IPR2020-00132 (Patent RE45,760 E)
15 IPR2020-00134 (Patent RE45,760 E)
16 IPR2020-00135 (Patent RE45,776 E)
17 IPR2020-00136 (Patent RE45,776 E)
18 IPR2020-00137 (Patent RE47,379 E)
19 IPR2020-00138 (Patent RE47,379 E)

20 CONTAINS CONFIDENTIAL PORTIONS - ATTORNEYS' EYES ONLY
21 REMOTE VIDEOTAPED DEPOSITION OF
22 PAUL ZALESKY, Ph.D.

23 DATE: January 25, 2021

24 TIME: 9:58 a.m. (Eastern)

25 PLACE: Veritext Virtual Videoconference

PAGES: 1 to 211

JOB NO.: MW 4402874

REPORTED BY: Merilee Johnson, RDR, CRR, CRC, RSA

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Page 2	<p>1 APPEARANCES (All appearing remotely via videoconference)</p> <p>2</p> <p>3 ON BEHALF OF THE PETITIONERS:</p> <p>4 ROBINS KAPLAN LLP BY: Emily J Tremblay, Esq 5 Cyrus A Morton, Esq 800 LaSalle Avenue 6 Suite 2800 Minneapolis, Minnesota 55402 7 Phone: (612) 349-8500 Email: ETremblay@RobinsKaplan com 8 Email: CMorton@RobinsKaplan com 9</p> <p>10 ON BEHALF OF THE PATENT OWNERS:</p> <p>11 CARLSON, CASPERS, VANDENBURGH, LINDQUIST & SCHUMAN, PA 12 BY: Joseph W Winkels, Esq 225 South Sixth Street 13 Suite 4200 Minneapolis, Minnesota 55402 14 Phone: (612) 436-9600 Email: JWinkels@CarlsonCaspers com 15</p> <p>16 -and-</p> <p>17 DORSEY & WHITNEY, LLP BY: Kenneth E Levitt, Esq 50 South Sixth Street 18 Suite 1500 Minneapolis, Minnesota 55402 19 Phone: (612) 340-2600 Email: Levitt Kenneth@Dorsey com 20</p> <p>21 ALSO APPEARED: 22 Greg Smock (Teleflex) (Until 1:28 p m) Jay Church (Videographer) 23 24 25</p>	Page 4
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<p style="text-align: right;">Page 6</p> <p>1 (PROCEEDINGS, 01/25/2021, 9:58 a.m.)</p> <p>2 THE VIDEOGRAPHER: Good morning. We</p> <p>3 are going on the record. The time is currently</p> <p>4 9:58 a.m. This is Eastern Standard Time. Today's</p> <p>5 date is Monday, January 25, 2021.</p> <p>6 This is Media Unit No. 1 of the</p> <p>7 video-recorded deposition of Dr. Paul Zalesky.</p> <p>8 This is in the matter of Medtronic, Inc., et al.,</p> <p>9 versus Teleflex Innovations S.A.R.L. This is filed</p> <p>10 in the U.S. Patent and Trademark Office, Patent</p> <p>11 Nos. IPR2020-00126, 00127, 00128, 00129, 00130,</p> <p>12 00132, 00134, 00135, 00136, 00137, 00138.</p> <p>13 This deposition is being held remotely.</p> <p>14 The witness is currently located in East Greenwich,</p> <p>15 Rhode Island.</p> <p>16 My name is Jay Church from Veritext. I'm</p> <p>17 the videographer. The court reporter is Merilee</p> <p>18 Johnson. I'm not authorized to administer an oath.</p> <p>19 I'm not related to any party in the action nor am I</p> <p>20 financially interested in the outcome.</p> <p>21 If counsel has any objections to</p> <p>22 proceeding, please state them at the time of your</p> <p>23 appearance. And now if we could have counsel state</p> <p>24 your affiliations for the record and then, after</p> <p>25 which, the court reporter can swear in the witness.</p>	<p style="text-align: right;">Page 8</p> <p>1 A. Yeah, I'm not seeing a date. I'm seeing</p> <p>2 "Date Modified" under the exhibits, but I'm not</p> <p>3 seeing the date of the actual share.</p> <p>4 Q. In the far-left window, do you have a bunch</p> <p>5 of folders that say "Depositions"? It should say,</p> <p>6 "Deposition of Dr. Paul Zalesky 1-25-2021."</p> <p>7 A. Just got to it, yeah.</p> <p>8 Q. Okay. Yeah. If you open up that folder --</p> <p>9 A. I'm sorry. No, these are January 8th.</p> <p>10 Q. January 8th.</p> <p>11 A. Let me try again. Oh, I've got one,</p> <p>12 January 24th. Got it. Okay. There.</p> <p>13 Q. Okay. Perfect. I'll generally refer to</p> <p>14 documents in hard copy, if you prefer to look at</p> <p>15 the documents in hard copy. But if you want to</p> <p>16 look on the screen, I'll put the documents in that</p> <p>17 Marked Exhibits folder as well for you. Okay?</p> <p>18 A. Okay.</p> <p>19 Q. All right. So you've had your deposition</p> <p>20 taken before, correct?</p> <p>21 A. Yes.</p> <p>22 Q. Yep. And you've had your deposition taken</p> <p>23 via Zoom before in this case with my colleague Tara</p> <p>24 Norgard, right?</p> <p>25 A. Yes.</p>
<p style="text-align: right;">Page 7</p> <p>1 MR. WINKELS: Good morning. On behalf</p> <p>2 of patent owner, Joe Winkels with the Carlson</p> <p>3 Caspers firm. Also with me is Ken Levitt with the</p> <p>4 Dorsey & Whitney firm and Greg Smock from Teleflex.</p> <p>5 MS. TREMBLAY: Good morning. On behalf</p> <p>6 of petitioners, my name is Emily Tremblay with</p> <p>7 Robins Kaplan. Also with me is Cyrus Morton, also</p> <p>8 with Robins Kaplan.</p> <p>9 PAUL ZALESKY, Ph.D.,</p> <p>10 duly sworn, was examined and testified as follows:</p> <p>11 EXAMINATION</p> <p>12 BY MR. WINKELS:</p> <p>13 Q. Good morning, Dr. Zalesky. How are you?</p> <p>14 A. I'm good. How are you?</p> <p>15 Q. Very good.</p> <p>16 Do you have the Exhibit Share open as well</p> <p>17 as the hard-copy documents in front of you?</p> <p>18 A. I do, but it looks like exhibits from the</p> <p>19 last session or a previous session. I'm not sure.</p> <p>20 I'll try to refresh.</p> <p>21 Q. Yep. So if -- there's two folders,</p> <p>22 actually, for your name. One dated January 13th,</p> <p>23 one dated January 25th. On the left-hand side. If</p> <p>24 you can make sure you're in the January 25th</p> <p>25 folder.</p>	<p style="text-align: right;">Page 9</p> <p>1 Q. Okay. So same process. As you've</p> <p>2 experienced before with these Zoom depositions,</p> <p>3 it's really important that you and I not speak over</p> <p>4 each other. So I will do my best to not interrupt</p> <p>5 you, and if you could do your best to not interrupt</p> <p>6 me, that'll make Merilee's job a lot easier as our</p> <p>7 court reporter.</p> <p>8 Does that sound fair?</p> <p>9 A. Yes.</p> <p>10 MR. WINKELS: It looks like Emily lost</p> <p>11 audio. Let's go off the record and try to get her</p> <p>12 connected to audio here.</p> <p>13 THE VIDEOGRAPHER: We're going off the</p> <p>14 record at 10:03 a.m.</p> <p>15 (Break: 10:03 a.m. to 10:04 a.m.)</p> <p>16 THE VIDEOGRAPHER: We are going back on</p> <p>17 the record at 10:04 a.m.</p> <p>18 BY MR. WINKELS:</p> <p>19 Q. Okay. Dr. Zalesky, so today we're talking</p> <p>20 about your opinions related to written description</p> <p>21 and the secondary considerations of copying. Okay?</p> <p>22 A. Yes.</p> <p>23 Q. And you submitted a couple declarations in</p> <p>24 this regard. The first one is Exhibit 1919; is</p> <p>25 that correct?</p>

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<p style="text-align: right;">Page 10</p> <p>1 A. Yes. 2 (Exhibit No. 1919 was introduced.) 3 Q. And do you have Exhibit 1919 in front of 4 you? 5 A. I do. 6 Q. Okay. We'll focus on your opinions in that 7 declaration for the first part of today and then 8 we'll transition to your second declaration later 9 in the day. 10 In connection with your Exhibit 1919, with 11 that declaration, what did you review in support of 12 that declaration? 13 A. There was a brief, I believe. Probably two 14 of them, one from different counsels, regarding 15 suggested claim amendments. So that was the 16 primary document that I reviewed. And the 17 background to that including, I believe, a case 18 special expert report. 19 Q. Okay. Now, in this case you've also 20 reviewed the five patents and claims that are at 21 issue in these IPRs, right? 22 A. My emphasis was on the '629 application and 23 the '032 issue, as it was my understanding that 24 that's where the -- I don't know if "baseline" is 25 the correct term, but the original specifications</p>	<p style="text-align: right;">Page 12</p> <p>1 the 2011-2012 time frame. 2 Q. Okay. So let me just go through one by one 3 because I do want to understand what you reviewed 4 and what you haven't reviewed. 5 Have you reviewed the entirety of the '032 6 prosecution history? 7 A. I don't believe I've seen the entire 8 prosecution history. 9 Q. Okay. Have you reviewed the entirety of 10 the '380 prosecution history? 11 A. The same answer. In each of these, I don't 12 recall looking at the entire prosecution histories. 13 Q. Okay. And just for the record, that's the 14 same answer for the '776 patent, the '760 patent, 15 and the '379 patent, correct? 16 A. Yes. 17 Q. Okay. Is the only portion of the 18 prosecution history that you've reviewed are 19 portions that were specifically given to you by 20 counsel to review? 21 A. That's my recollection, yes. And just to 22 give you a very specific example, on page 19 23 there's a citation regarding patent office claim 24 rejection. 25 So it's only that level of detail that I</p>
<p style="text-align: right;">Page 11</p> <p>1 resided. 2 Q. Okay. Did you look at the claims of the 3 other patents in addition to the '032 patent? 4 A. I would certainly have looked at those. 5 It's been a while, quite honestly. But I did look 6 at them and saw a lot of redundancy. 7 Q. Okay. How about the prosecution histories 8 for the five patents that are at issue in these 9 IPRs. Have you reviewed the prosecution history 10 for those five patents? 11 A. I was given at some point a chart of the 12 file history, and there was also a table on page 11 13 of the application numbers, filing dates, and 14 patent numbers at issue. But as I said earlier, I 15 emphasized the '629 and '032 and didn't re-review 16 in any detail the other patents -- or applications. 17 Q. Okay. When I refer to "prosecution 18 history," do you understand that I'm referring to 19 the process by which the application is reviewed by 20 the patent office and there's some correspondence 21 that is generated as part of that process? 22 A. I do. I'm familiar with that. I don't 23 recall seeing a detailed prosecution history or 24 detail. I do recall some specific excerpts, such 25 as a hearing from the patent office, I believe, in</p>	<p style="text-align: right;">Page 13</p> <p>1 reviewed. 2 Q. Okay. So is it fair to say that the only 3 portions of the prosecution history of the five 4 patents you reviewed are the portions that you 5 expressly discuss in your declaration, 6 Exhibit 1919? 7 A. Yes, that's correct. 8 Q. Now, you also mention the motions to amend. 9 Do you understand that there were motions to amend 10 brought in each of the five -- strike that. 11 Do you understand that there were motions 12 to amend brought regarding each of the five patents 13 at issue in this case? 14 A. I don't remember explicitly seeing that, 15 but that was my understanding, that the proposed 16 amendments applied to the various patents. 17 Q. Okay. And through your process of 18 providing your opinions in this case, did you 19 review all of the proposed amendments for the 20 five patents in this case? 21 A. I don't believe I did. You know, I'd have 22 to go through each one, literally, one by one. 23 And, of course, that's all in my declaration. So 24 the specific amendments that I did review are as 25 listed in the Substitute Claim section of my</p>

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<p style="text-align: right;">Page 14</p> <p>1 declaration.</p> <p>2 Q. Okay. And that's -- and paragraph 14 of</p> <p>3 your declaration, that's what I was kind of asking</p> <p>4 you about, is you said, "I have been asked to</p> <p>5 review the Root patents and patent owner's</p> <p>6 contingent motions to amend the Root patents..."</p> <p>7 And I just want to confirm that you did, in</p> <p>8 fact, look at all five of the motions to amend for</p> <p>9 the five patents that were at issue in the case.</p> <p>10 A. I believe so, yes.</p> <p>11 Q. Okay. Now, did you prepare to testify</p> <p>12 today, I take it?</p> <p>13 A. Yes. I had some preparation with counsel</p> <p>14 on -- this past Friday. And then over the weekend,</p> <p>15 I probably spent maybe an hour just reviewing my</p> <p>16 declaration.</p> <p>17 Q. Okay. Let's go to just the background part</p> <p>18 of your declaration. And I just want to understand</p> <p>19 just a little bit of your prior work because I know</p> <p>20 you've done a lot of work in the catheter area. So</p> <p>21 I just have a few questions about that.</p> <p>22 In paragraph 5 you discuss the advent --</p> <p>23 what I call the advent of interventional cardiology</p> <p>24 in the '70s and '80s; is that right?</p> <p>25 A. Yes.</p>	<p style="text-align: right;">Page 16</p> <p>1 division of Boston Scientific called Mansfield</p> <p>2 Scientific, which evolved into their interventional</p> <p>3 cardiology company. And during my tenure there as</p> <p>4 the head of R&D, I presented, for instance, to the</p> <p>5 panel at the FDA for Boston's first approval of its</p> <p>6 initial coronary angioplasty catheter.</p> <p>7 Q. And how long were you at Boston Scientific</p> <p>8 in that role?</p> <p>9 A. Approximately two years.</p> <p>10 Q. Then as we move on to paragraph 6, it looks</p> <p>11 like around 1986 you cofounded InterTherapy; is</p> <p>12 that right?</p> <p>13 A. Yes.</p> <p>14 Q. And with InterTherapy, were you still</p> <p>15 working and designing catheters and working in the</p> <p>16 cath lab?</p> <p>17 A. Pretty much so. It was a startup, which we</p> <p>18 thought was the only one in the world, dealing with</p> <p>19 what's called intravascular ultrasound. In other</p> <p>20 words, putting ultrasound technology into a</p> <p>21 catheter that could actually fit inside of a</p> <p>22 coronary artery.</p> <p>23 So the focus was clearly on</p> <p>24 angioplasty-related procedures in a cardiac cath</p> <p>25 lab.</p>
<p style="text-align: right;">Page 15</p> <p>1 Q. Is that when you would say interventional</p> <p>2 cardiology started, is in the '70s?</p> <p>3 A. I probably wouldn't make that general of a</p> <p>4 statement. I was fortunate in my very first job in</p> <p>5 the medical industry to be at an American Heart</p> <p>6 meeting, I believe it was in Florida, when</p> <p>7 Dr. Andreas Grüntzig from Switzerland made a</p> <p>8 presentation in a very small meeting room about</p> <p>9 doing the very first what is now known as coronary</p> <p>10 angioplasty.</p> <p>11 So you could argue that -- I believe that</p> <p>12 was 1979. You could argue that was the initiation,</p> <p>13 but interventional cardiology, I think in general,</p> <p>14 is more of a 1980s event.</p> <p>15 Q. Okay. And it looks like at least as early</p> <p>16 as 1986 you started working directly in</p> <p>17 interventional cardiology; is that right?</p> <p>18 A. Actually a bit before that. So in 1984, as</p> <p>19 a vice president for a company called Meadox, I</p> <p>20 went over to Denmark, to a young company in a small</p> <p>21 town outside of Copenhagen and looked at guide</p> <p>22 catheters that were being fabricated for</p> <p>23 commercialization.</p> <p>24 So I would say starting in 1984. And then</p> <p>25 between 1984 and 1986, I worked at a fledgling</p>	<p style="text-align: right;">Page 17</p> <p>1 Q. Okay. And then it looks like around 1990,</p> <p>2 am I correct that you transitioned to Baxter, the</p> <p>3 Baxter company?</p> <p>4 A. Yes.</p> <p>5 Q. And with Baxter, were you working on</p> <p>6 catheters and catheter design as well?</p> <p>7 A. Baxter had a group called the</p> <p>8 CardioVascular Specialties group in Irvine,</p> <p>9 California, which is where I was located. And I</p> <p>10 had a dual role. I was VP of R&D for the</p> <p>11 cardiopulmonary bypass surgery division called</p> <p>12 Bentley, but I also was the point person for the</p> <p>13 various five divisions, one of which was called</p> <p>14 LIS, Least Invasive Surgery. And that was</p> <p>15 dedicated to interventional cardiology.</p> <p>16 I represented that company and regularly</p> <p>17 participated in their developments and their</p> <p>18 related activities to cardiology.</p> <p>19 Q. And did that include developments in</p> <p>20 catheter design and things of that nature?</p> <p>21 A. Yes.</p> <p>22 Q. Okay. And then in 1995 you founded the</p> <p>23 TherOx company; is that right?</p> <p>24 A. Yes.</p> <p>25 Q. And I believe you said that you were</p>

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