

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

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

Petitioners,

v.

TELEFLEX INNOVATIONS S.À.R.L.,

Patent Owner.

IPR2020-00126

IPR2020-00128

IPR2020-00129

IPR2020-00132

IPR2020-00134

IPR2020-00135

IPR2020-00137

**PETITIONERS' SUR-SUR-REPLY TO PATENT OWNER'S SUR-REPLY
ADDRESSING CONCEPTION AND REDUCTION TO PRACTICE**

TABLE OF CONTENTS

| | | |
|-------|--|----|
| I. | INTRODUCTION | 1 |
| II. | TELEFLEX MUST PROVE PRIOR INVENTION. | 1 |
| III. | CONCEPTION | 2 |
| IV. | REDUCTION TO PRACTICE | 3 |
| A. | Teleflex cannot prove that VSI assembled RX prototypes before Itou. | 3 |
| B. | VSI needed to test RX prototypes, and Teleflex does not show that it did..... | 6 |
| 1. | VSI needed to conduct particular testing to demonstrate that RX would work for its intended purpose..... | 7 |
| 2. | Reduction to practice requires <i>demonstrating</i> that the invention would work for its intended purpose, and demonstrating requires <i>testing</i> for all but the most primitive inventions. | 9 |
| 3. | The Board cannot evaluate whether Teleflex’s testing “evidence” proves that VSI demonstrated that RX would work for its intended purpose. | 12 |
| V. | DILIGENCE | 14 |
| VI. | TELEFLEX CANNOT PROVE PRIOR INVENTION OF EVERY CLAIMED INVENTION. | 14 |
| VII. | INCORPORATION BY REFERENCE..... | 15 |
| VIII. | CONCLUSION..... | 17 |

TABLE OF AUTHORITIES

Cases

| | |
|---|------------|
| <i>Aparator Miitors ApS v. Kamstrup A/S</i> , 887 F.3d 1293 (Fed. Cir. 2018) | 1 |
| <i>Apple v. Yu</i> , IPR2019-01258, 2021 WL 41670 (PTAB Jan. 5, 2021) | 2 |
| <i>Bos. Sci. Corp. v. Johnson & Johnson</i> , 481 F. Supp. 2d 1018 (N.D. Cal. 2007)..... | 10 |
| <i>Dynamic Drinkware, LLC v. Nat’l Graphics, Inc.</i> , 800 F.3d 1375 (Fed. Cir. 2015) | 1 |
| <i>E. Rotorcraft Corp. v. United States</i> , 384 F.2d 429 (Ct. Cl. 1967)..... | 10 |
| <i>In re Magnum Oil Tools Int’l, Ltd.</i> , 829 F.3d 1364 (Fed. Cir. 2016) | 1 |
| <i>In re Stempel</i> , 241 F.2d 755 (C.C.P.A. 1957) | 11 |
| <i>Mahurkar v. C.R. Bard, Inc.</i> , 79 F.3d 1572 (Fed. Cir. 1996) | 2, 9, 10 |
| <i>Mason v. Hepburn</i> , 13 App. D.C. 86 (D.C. Cir. 1898)..... | 10 |
| <i>Pfizer, Inc. v. Genentech, Inc.</i> , IPR2017-01488, Paper 87 (PTAB Nov. 29, 2018)..... | 11 |
| <i>REG Synthetic Fuels, LLC v. Neste Oil Oyj</i> , 841 F.3d 954 (Fed. Cir. 2016) | 2 |
| <i>Scott v. Finney</i> , 34 F.3d 1058 (Fed. Cir. 1994) | 10, 12, 13 |
| <i>Slip Track Sys., Inc. v. Metal-Lite, Inc.</i> , 304 F.3d 1256 (Fed. Cir. 2002) | 12 |

Other Authorities

37 C.F.R. § 42.6(a)(3).....15

I. INTRODUCTION

Teleflex asks the Board to conclude that VSI reduced its GuideLiner RX inventions to practice before Itou, based on conclusory, uncorroborated statements and a record devoid of meaningful documents. Even if the VSI documents are exactly what the inventors say they are, the record cannot support the inventors' sweeping assertions that they assembled and tested RX prototypes before September 23, 2005. Teleflex cannot carry its burden.

II. TELEFLEX MUST PROVE PRIOR INVENTION.

Teleflex misstates its burden—if the Board is uncertain about the CRTIP evidence, then Teleflex has not satisfied its burden. Teleflex bears “the burden of going forward with evidence...and presenting persuasive argument based on” that evidence. *Dynamic Drinkware, LLC v. Nat'l Graphics, Inc.*, 800 F.3d 1375, 1379 (Fed. Cir. 2015). It must “establish[] that its claimed invention is entitled to an earlier priority date than an asserted prior art reference.” *In re Magnum Oil Tools Int'l, Ltd.*, 829 F.3d 1364, 1376 (Fed. Cir. 2016). Prior invention is “effectively an affirmative defense.” *Id.* Teleflex must prove that VSI invented before Itou, not Medtronic prove that VSI did not. *Aptor Miitors ApS v. Kamstrup A/S*, 887 F.3d 1293, 1297 (Fed. Cir. 2018). The fact that Medtronic must prove unpatentability does not change that.

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.