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Paper
Date:

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.

IPR2020-00135
Patent RE45,776 E

Before SHERIDAN K. SNEDDEN, JON B. TORNQUIST, and
CHRISTOPHER G. PAULRAJ, *Administrative Patent Judges*.

PAULRAJ, *Administrative Patent Judge*.

JUDGMENT

Final Written Decision

Determining No Challenged Claims Unpatentable
No Deciding Patent Owner's Contingent Motion to Amend
35 U.S.C. § 318(a)

ORDER

Denying Petitioner's Motion to Exclude (Paper 110)
37 C.F.R. § 42.64(c)

I. INTRODUCTION

A. Background and Summary

This is our Final Written Decision entered pursuant to 35 U.S.C. § 318(a) and 37 C.F.R. § 42.73. For the reasons explained in our analysis below, we determine that the primary reference relied upon by Petitioner for all its patentability challenges does not qualify as prior art because Patent Owner has antedated that reference. Thus, Petitioner has not demonstrated that any of the challenged claims are unpatentable in this proceeding.

On November 14, 2019, Medtronic, Inc. and Medtronic Vascular, Inc. (collectively, “Petitioner”) filed a Petition requesting an *inter partes* review of claims 25–27, 29–33, 35–39, 41–49, and 52–56 of U.S. Patent No. RE45,776 E (“the ’776 patent,” Ex. 1001). Paper 1 (“Pet.”). Teleflex Innovations S.A.R.L. (“Patent Owner”)¹ filed a Preliminary Response. Papers 8 (confidential version), 9 (redacted version). In our Institution Decision, we determined that there was a reasonable likelihood that Petitioner would prevail with respect to at least one challenged claim and accordingly, instituted an *inter partes* review pursuant to 35 U.S.C. § 314 based on all challenges presented in the Petition. Paper 22 (“Institution Decision” or “Inst. Dec.”).

Following institution, Patent Owner filed two post-institution responses: (1) a Consolidated Response Addressing Conception and Reduction to Practice (Paper 39 (“PO CRTP Response” or “PO CRTP

¹ Patent Owner represents that “Teleflex Innovations S.A.R.L. merged into Teleflex Medical Devices S.A.R.L,” which subsequently “transferred ownership of [the ’776 patent] to Teleflex Life Sciences Limited.” Paper 7, 2.

Resp.”)) and (2) a post-institution Response addressing Petitioner’s anticipation and obviousness arguments (Papers 43 (confidential version), 44 (redacted version) (“PO Resp.”)).

Petitioner filed a Reply to Patent Owner’s Response Addressing Conception and Reduction to Practice (Papers 78 (confidential version), 79 (redacted version) (“Pet. CRTP Reply”)) and a Reply to Patent Owner’s Response (Papers 82 (confidential version), 83 (redacted version) (“Reply”)). Patent Owner then filed its post-institution Sur-Reply Addressing Conception and Reduction to Practice (Paper 96, “PO CRTP Sur-Reply”), and Petitioner filed its post-institution Sur-Reply Addressing Conception and Reduction to Practice (Paper 111 (“Pet. CRTP Sur-Sur-Reply”)). Patent Owner also filed a post-institution Sur-Reply to Petitioner’s Reply to Patent Owner’s Response (Papers 102 (confidential version), 103 (redacted version) (“PO Sur-Reply”).

Patent Owner also filed a Contingent Motion to Amend. Papers 38 (original), 95 (corrected) (“Motion”).² The Motion requests that if any of claims 27, 33, 37, 42, 43, 45, 47, or 56 is found unpatentable, they should be replaced by proposed substitute claims 58–65. Motion 1. Petitioner filed an Opposition to the Motion to Amend. Paper 101. Patent Owner filed a Reply in Support of the Corrected Motion to Amend (Paper 105), and Petitioner filed a Sur-Reply (Paper 113).

² Pursuant to a stipulation by the parties, we authorized the filing of the corrected Motion to Amend in order to clarify certain antecedent bases and thereby simplify the issues.

An oral hearing was held on March 8, 2021, and a transcript of the hearing is included in the record. Papers 124 (redacted version) (“Tr.”), 125 (confidential version).

B. Real Parties-in-Interest

Petitioner identifies Medtronic, Inc. and Medtronic Vascular, Inc. as the real parties-in-interest, and notes that “Medtronic plc is the ultimate parent of both entities.” Pet. 5. Patent Owner identifies the real parties-in-interest for itself as Teleflex Medical Devices S.À.R.L., Vascular Solutions LLC, Arrow International, Inc., Teleflex LLC, and Teleflex Life Sciences Limited and notes that “Teleflex Incorporated is the ultimate parent of the entities listed above.” Paper 4, 2; Paper 7, 2.

C. Related Matters

Patent Owner is asserting the ’776 patent against Petitioner in the United States District Court for the District of Minnesota in *Vascular Solutions LLC, et al. v. Medtronic, Inc., et al.*, No. 19-cv-01760 (D. Minn., filed July 2, 2019). Pet. 5; Paper 4, 2. The ’776 patent is also the subject of a declaratory judgment action filed by another party, *QXMedical, LLC v. Vascular Solutions, LLC*, No. 17-cv-01969 (D. Minn., filed June 8, 2017), which was stayed pending our Institution Decision. Paper 19; Paper 20. Petitioner further notes that the ’776 patent is a reissue of U.S. Patent No. 8,292,850 (“850 patent”), which was the subject of a prior district court action and *inter partes* reviews in IPR2014-00762 and IPR2014-00763 filed by a different petitioner. Pet. 5.

Petitioner filed another petition challenging the '776 patent based on different prior art, and we instituted *inter partes* review on that petition on June 26, 2020. *See* IPR2020-00136, Paper 20. We issue our final written decision in IPR2020-00136 concurrently with this Decision. In addition, Petitioner has filed concurrent petitions challenging other related patents: U.S. Patent No. 8,048,032 (IPR2020-00126; IPR2020-00127), RE45,380 (IPR2020-00128; IPR2020-00129; IPR2020-00130; IPR2020-00131), RE 45,760 (IPR2020-00132; IPR2020-00133; IPR2020-00134), and RE47,379 (IPR2020-00137; IPR2020-00138).

D. The '776 Patent

The '776 patent, entitled “Coaxial Guide Catheter for Interventional Cardiology Procedures,” issued on October 27, 2015, as a reissue of the '850 patent, which itself issued from a non-provisional application filed January 26, 2012. Ex. 1001, codes (45), (64). It claims priority as a divisional of Application No. 11/416,629, filed on May 3, 2006, which issued as U.S. Patent No. 8,048,032. *Id.* at code (60).

The '776 patent relates generally to a coaxial guide catheter for use with interventional cardiology devices that are insertable into a branch artery that branches off from a main artery. Ex. 1001, Abstract. According to the '776 patent, interventional cardiology procedures often include inserting guidewires or other instruments through catheters into coronary arteries that branch off from the aorta. *Id.* at 1:45–47. In coronary artery disease, the coronary arteries may be narrowed or occluded by atherosclerotic plaques or other lesions in a phenomenon known as stenosis. *Id.* at 1:50–55. In treating the stenosis, a guide catheter is inserted through the aorta and into

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