

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 IPR2020-00136
Patent RE 45,776

**PETITIONERS' REPLY TO PATENT OWNER'S
PRELIMINARY RESPONSE**

Medtronic had no obligation to address secondary considerations in its Petition. Instead, Teleflex, as the Patent Owner, has the burden of production on that issue. Teleflex's positions on secondary considerations—which are not even supported by expert testimony—have not been fully developed, let alone adjudicated, in Court or the Patent Office. Nor has Teleflex identified any authority requiring a Petitioner to address secondary considerations absent those instances. Thus, secondary considerations should not be addressed until the trial phase.

The Board has repeatedly rejected arguments that a petition must address secondary considerations, including in cases involving allegations far more developed than the miscellaneous assortment of evidence presented here. In *Lowe's Co. v. Nichia Corp.*, the Board granted institution and found that the Petitioner did not have to address evidence of secondary considerations even though the District Court's findings of fact previously credited that evidence. IPR2017-02011, Paper 12 at *4-6, 55-58 (POPR), Paper 13 at *18 (PTAB Mar. 12, 2018) (Institution Decision); *see also Petroleum Geo-Services Inc. v. W. Geco LLC*, IPR2014-01477, Paper 12 at *40-41 (POPR), Paper 18 at *32 (PTAB Mar. 17, 2015) (Institution Decision). Similarly, in *C & D Zodiac, Inc. v. b/e Aerospace, Inc.*, the Board concluded that a petition need not “introduce and address such secondary considerations evidence” that was “discovered during the co-pending litigation.” IPR2017-01275, Paper 12 at *15 (PTAB Oct. 31, 2017).

Indeed, the Board rejected the same arguments from Teleflex’s counsel in *Arctic Cat, Inc. v. Polaris Industries Inc.*, IPR2017-00433, Paper 17 at *9-10 (PTAB July 5, 2017). The Board explained that “Patent Owner does not identify, nor are we aware of any persuasive authority requiring Petitioner in this case to address secondary considerations, not previously presented to the Office, in the Petition.” *Id.* at *10. Instead, “the burden of production rests on Patent Owner with regard to secondary considerations.” *Id.* Thus, the Board found that “full consideration of evidence of secondary considerations of this nature is not necessary” before institution. *Id.* at *19.

Teleflex’s arguments are no more compelling here. Again, Teleflex’s counsel identifies no authority for requiring a Petitioner, such as Medtronic, to address evidence of secondary considerations, absent a decision by the Patent Office, ITC, or District Court crediting that evidence. *See, e.g., Stryker Corp. et al. v. KFx Med., LLC*, IPR2019-00817, Paper 10 at *27-28 (PTAB Sept. 16, 2019) (“[S]econdary considerations evidence was developed fully during the Arthrex Litigation, and the Federal Circuit affirmed the jury’s verdict”); *Robert Bosch Tool Corp. v. Sd3*, No. IPR2016-01753, Paper, at *12 (PTAB Mar. 22, 2017) (“[A]fter development of the record at the ITC, including cross-examination, the Administrative Judge determined that the evidence of secondary considerations was ‘very strong’ in favor of Patent Owner.”); *Gilead Sciences, Inc. v. United*

IPR2020-00136
Patent RE 45,776

States, IPR2019-01453, Paper 14 at *26-27 (PTAB Feb. 20, 2020) (“[W]ell-developed evidence of” secondary considerations “was key to the allowance of the claims”); *Coal. for Affordable Drugs V LLC v. Hoffman-LaRoche Inc.*, IPR2015-01792, Paper 14 at 17-18 (PTAB Mar. 11, 2016) (pointing to “objective indicia of nonobviousness presented to the Office during the prosecution”). None of those circumstances are present here.

The Patent Office never addressed secondary considerations during prosecution of this patent. *See* Exs. 1402-1403. Nor have secondary considerations even been raised by Teleflex in litigation against Medtronic, let alone fully developed or adjudicated. None of Teleflex’s identified exhibits even mention “secondary considerations.” Instead, an expert report from a different case discusses infringement (Ex. 2056); a declaration from Teleflex’s preliminary injunction briefing addresses purported irreparable harm (Ex. 2043); and an interrogatory response sets forth Teleflex’s alleged market share (Ex. 2059). Teleflex argues that Medtronic should have cobbled together disparate disclosures from these types of exhibits to make Teleflex’s argument for it. Requiring petitioners to engage in guessing games would waste the parties’ and the Board’s resources. Under these circumstances, Medtronic did not have to raise secondary considerations in its Petition. The Board should grant institution and reject Teleflex’s attempt to shift the initial burden on secondary considerations to Medtronic.

IPR2020-00136
Patent RE 45,776

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Respectfully submitted,

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