UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

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

v.

TELEFLEX INNOVATIONS S.A.R.L.
Patent Owner.

Case IPR2020-00136
Patent RE 45,776

PATENT OWNER'S SUR-REPLY TO PETITIONER'S REPLY TO PRELIMINARY RESPONSE

Medtronic argues for a bright-line rule that a petition need only address secondary considerations when there has been "a decision by the Patent Office, ITC, or District Court crediting that evidence." Paper 14 at 2. No such rule exists, and the Board should decline Medtronic's invitation to create one. As the Board's prior decisions demonstrate, whether a petitioner must address secondary considerations in a petition is fact-specific. *See, e.g.*, *Robert Bosch Tool Corp. v. SD3, LLC*, IPR2016-01753, Paper 15 at 28–30 (PTAB Mar. 22, 2017) ("*In this particular case*, we determine it is appropriate to review and address the objective evidence of nonobviousness proffered by the Patent Owner for purposes of this Decision [Denying Institution].") (emphasis added). The fact that Medtronic can cite cases where, on the facts of those particular cases, the Board found that a patent owner failed to meet its burden of production concerning secondary considerations is irrelevant. Indeed, in *Robert Bosch Tool Corp.*, the Board considered secondary considerations at the institution stage even though the ITC Initial Determination issued ***after*** the petition was filed. IPR2016-01753, Paper 15 at 30 n.9. Here, Medtronic was unquestionably aware of compelling evidence of secondary considerations, and Medtronic's failure to address that evidence in its Petition unfairly deprived the Board of relevant information needed to make an informed decision whether to institute trial.

Contrary to Medtronic's assertion that it must "cobble[] together disparate

disclosures . . . to make Teleflex's argument for it," (Paper 14 at 3), Medtronic was presented with clear objective evidence supporting the validity of the GuideLiner patents. For example, Medtronic complains that "[n]one of Teleflex's identified exhibits even mention 'secondary considerations,'" (*id.*), but Teleflex's motion for preliminary injunction in the district court case—filed over a month before Medtronic filed its Petition—contained ***three separate sections*** with ***specific titles*** directed to long-felt need, commercial success and copying. Ex. 1473 at 2, 5, 9. The objective evidence was also provided in other documents that Medtronic already had, as explained in detail in the Preliminary Response. Paper 10 at 54–67; *see also, e.g.*, Ex. 2058; Ex. 1473 at 5; Ex. 2043 (Welch Decl.), ¶¶ 4, 9–18, 34–35; Ex. 2046 (Root 2013 Decl.), ¶¶ 39, 43–45; Ex. 2059 (Interrog. Resp.); Exs. 2065–2067; Ex. 2069 at 5; Ex. 1479, ¶ 18. In the parallel district court case, Medtronic even deposed a Teleflex Director of Sales well before filing its Petition, specifically questioning the witness on sales of GuideLiner. Ex. 2051. What's more, a mere *three days* after filing its first Petition, Medtronic filed two declarations in the district court seeking to explain, substantively, why Teleflex's evidence did not actually show copying. *Vascular Sols. LLC v. Medtronic, Inc.*, No. 19-cv-01760-PJS-TNL, Dkt. 110, ¶¶ 61–67, Dkt. 109 (D. Minn.). There is no reason Medtronic could not have done the same thing in the Petition. Medtronic's contention that Teleflex's evidence of secondary considerations is not developed

enough to address is just not credible.

Here, not only did Teleflex meet its burden, but Medtronic's own actions show that the burden of production was met. Medtronic was undisputedly aware of an important competitor (Boston Scientific) holding a license to the GuideLiner patents, and ***Medtronic itself*** admittedly asked for a license. Ex. 2068, ¶ 26. Medtronic sought a license to the GuideLiner patents because it was aware of the invention's commercial success, industry praise, and satisfaction of a long-felt need. This real-world evidence confirms that Medtronic cannot credibly argue that the burden of production had not been met.

Ultimately, the Board must be able to accurately evaluate the likelihood that a petitioner will prevail and whether institution is an appropriate use of the Board's resources. Medtronic's failure to address the substantial evidence of secondary considerations of which it was aware prevents the Board from making a fully informed decision. Where the petitioner knows the whole story, the Board should not be forced to make an institution decision based on only half of the story. Medtronic's willful ignorance of the substantial, compelling evidence of secondary considerations unfairly handicaps the Board's ability to make a fair institution decision.

Dated: May 1, 2020.

Respectfully submitted,

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