

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 No.: IPR2020-00136
U.S. Patent No. RE 45,776

**Petitioners' Motion for Good Cause Extension Pursuant
to 37 C.F.R. § 42.100(c)**

Medtronic submits this Motion for a Good Cause Extension Pursuant to 37 § C.F.R. § 42.100(c). Specifically, Medtronic requests that the Chief Administrative Judge (i) determine that good cause exists to extend the one-year period for issuing a Final Written Decision and (ii) authorize the Board to extend the date for the Oral Hearing by three months.

I. The Scope of This IPR is Unprecedented.

It is not hyperbole to say that these IPRs—in light of Teleflex’s POR submissions—have ballooned to such an extent that the current IPR schedule is unworkable. The typical IPR schedule for the parties and the Board did not contemplate this situation. A good-cause extension is warranted.

In November 2019, Medtronic filed its IPR Petitions. Teleflex had almost a full year—its PORs were filed on October 1—until Due Date 2. In conjunction with that due date, Teleflex submitted its (i) PORs, including its alleged secondary indicia of nonobviousness, (ii) separate briefing attempting to antedate Medtronic’s prior art by establishing an earlier conception and reduction to practice date (“CRTP”), and (iii) eleven Motions to Amend.

In support of its PORs, Teleflex submitted four expert declarations and four fact declarations. For CRTP, Teleflex submitted more than sixty-five documents and seven declarations (one expert and six fact declarations). In support of its Motions to Amend, Teleflex submitted up to eight amended claims and a separate

expert declaration in support of each proposed amendment. Finally, Teleflex submitted nine fact declarations attempting to authenticate its exhibits. In sum, in conjunction with Due Date 2, in addition to its briefing, Teleflex submitted up to 215 exhibits, six expert declarations, and twenty fact declarations per IPR.

Medtronic's opposition to Teleflex's CRTP brief and its opposition to the Motion to Amend are due on December 17 and its Reply to the Petition is due on December 21. Based on the current schedule, Medtronic has less than three months—despite Teleflex having had nearly a year to prepare its POR submissions—to analyze Teleflex's arguments, complete its depositions, and prepare fulsome responses. In the “typical” IPR context, three months provides sufficient time, but this is not the typical—rather, this is the extraordinary—IPR.

To prepare its Replies to the POR, Medtronic must review and analyze more than 16,000 documents submitted in the district court in order to respond to Teleflex's CRTP arguments and alleged secondary indicia of non-obviousness.¹ And in conjunction with the Motions to Amend, Medtronic must not only analyze and apply the prior art to the proposed claim amendments, but also prepare Section 101 and 112 defenses (that were not previously within the scope of these IPRs).

¹ Teleflex submitted four expert declarations and cites three fact declarants in support of its alleged secondary indicia of non-obviousness.

Medtronic has less than three months to take numerous depositions, and develop declarations for numerous responsive witnesses, for both the current and proposed substitute claims. The parties will then have about two months, January and February, for numerous additional depositions, sur-replies, and the rest of the motion to amend process, which is likely to involve more declarations and depositions. And the Board will have to extend the hearing anyway if Patent Owner chooses—which Petitioner believes is necessary—to file Amended Motions to Amend. Accordingly, a good cause extension under § 42.100(c) is warranted.

II. A Three-Month Extension Will Not Prejudice Teleflex.

Teleflex’s prejudice arguments were already rejected by the district court, which found no irreparable harm absent an injunction and that Teleflex’s litigation strategy created a delay that subsumes Petitioner’s requested extension. In denying the Preliminary Injunction, the District Court explained that “Teleflex ha[d] failed to make a particularly compelling case that it [wa]s threatened with ‘substantial and immediate irreparable injury.’” Ex-1488, at 14. Thereafter, in granting Medtronic’s stay of the district court litigation, the court found that any alleged harm (if proven) could be compensated “by monetary damages.” Ex-1500, at 4; *see also* Ex-1501, at 4 (noting that the “harm Teleflex may suffer is likely to be of the reparable variety”). It is unlikely Teleflex will be able to demonstrate irreparable

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harm, and thus an injunction under *eBay Inc. v. MercExchange, L.L.C.*, 547 U.S. 388 (2006), is unlikely.

Even if Teleflex were able to obtain a permanent injunction, a three-month extension in these IPRs will not delay that relief. These IPRs are more than nine months ahead of co-pending IPRs asserted against related patents, which Teleflex added to the district court litigation just this year (“New Patents”). Within less than six months of Teleflex adding the New Patents, Medtronic filed additional IPRs challenging those claims in July 2020. Assuming institution, a Final Written Decision in the later-filed IPRs of the New Patents will not issue until March 2022. Based on past practice, the district court is unlikely to lift the litigation stay until the later-filed IPRs conclude. Thus, any minimal extension of these IPRs will not delay the eventual district court trial date.

Only once—to the best of counsels’ knowledge—has Judge Schiltz assessed a motion to lift a stay while post-grant proceedings were pending. In *Horton, Inc. v. Kit Masters, Inc.*, Civ. No. 08-6291 (D. Minn., filed Dec. 8, 2008), after ex parte reexamination proceedings were initiated against two patents, Judge Schiltz stayed the litigation. Patent owner subsequently sought to lift the stay while certain of the reexamination proceedings were still pending. *Id.* Judge Schiltz denied the motion, explaining that “[i]t would be inefficient for the Court to lift the stay with respect to the ’415 patent until the pending [Patent Office] proceedings conclude[.]” Ex-

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