

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 OPPOSITION TO PETITIONERS' MOTION FOR
GOOD CAUSE EXTENSION PURSUANT TO 37 C.F.R. § 42.100(c)**

Medtronic's unprecedented motion to extend the statutory 1-year deadline for the convenience of its counsel should be denied. That proceedings Medtronic initiated with full knowledge of the statutorily-mandated schedules have now become inconvenient for Medtronic's counsel is not "good cause," especially when granting Medtronic's motion would prejudice Teleflex and shift inconvenience to Teleflex's counsel. Teleflex would certainly consider less-prejudicial changes that maintain the 1-year deadline, but Medtronic has not offered any.

I. MEDTRONIC CHOSE TO AVAIL ITSELF OF THE IPR PROCESS WITH FULL KNOWLEDGE OF THE STATUTORILY-MANDATED SCHEDULE AND THE SCOPE OF THE PROCEEDINGS

The 13 IPR proceedings that Medtronic chose to initiate have not "ballooned" in any unexpected or unpredictable way. Before even filing its IPRs, Medtronic was well aware that its primary reference, Itou, was a 102(e) reference, that Teleflex contended it pre-dated Itou, and that robust objective evidence of nonobviousness existed. Paper 15 (PO Sur-Reply detailing Medtronic's knowledge of this evidence). Medtronic was also well aware that patent owners can move to amend their patents during IPR proceedings. Medtronic nonetheless chose to file 13 IPR petitions (including many "back-up" petitions that Teleflex has been forced to address), knowing full well what the statutorily-mandated schedule would be. Moreover, Teleflex has already offered Medtronic deposition dates for all routine discovery depositions within the range Medtronic requested, such that all depositions are

scheduled to conclude well before Due Date 2 under the current schedule. Ex-2218 at 1. Having chosen to instigate these proceedings, Medtronic's complaint that the schedule is unfair or inconvenient to its counsel does not constitute good cause.

II. EXTENDING THE STATUTORY DEADLINE WILL PREJUDICE TELEFLEX AND SHIFT INCONVENIENCE TO TELEFLEX'S COUNSEL

The one-year statutory deadline protects patentees by mandating a fast and efficient process for adjudicating patent validity. That need for swift adjudication is particularly important here, where Teleflex filed suit immediately after Medtronic introduced its infringing product and where Medtronic relied on the present IPRs to both overcome Teleflex's preliminary injunction motion and obtain a stay of the district court proceedings.

Medtronic's assertions that Teleflex would not be prejudiced are unfounded. Medtronic contends that the district court is unlikely to lift the stay on the five patents at issue in the present IPRs until after IPR petitions filed by Medtronic against two other patents-in-suit are resolved. Not only is Medtronic's argument speculative (for example, the Board has not yet even decided whether to institute those petitions), it misstates the district court precedent. Medtronic claims that Judge Schiltz previously refused to lift a stay on one patent because of ongoing reexamination of another patent. Paper 46 at 4. In fact, the exact opposite is true. In the *Horton* case cited by Medtronic, Judge Schiltz lifted a stay as to one patent even though reexamination of

a second patent was ongoing. *Horton, Inc. v. Kit Masters, Inc.*, 08-cv-6291, 2010 U.S. Dist. LEXIS 134369, at *3 (D. Minn. Dec. 20, 2010) (“The ’415 patent has now emerged from two reexamination proceedings, and [patentee] has a right to enforce it. Although some slight efficiencies might result from leaving the stay in place until the ’796 patent’s reexamination is concluded..., those efficiencies are offset by the unfairness of continuing to prevent [patentee] from enforcing the ’415 patent.”).¹ Judge Schiltz’s decision is in accord with other courts. *E.g.*, *Centrip. Networks, Inc. v. Cisco Sys.*, 2:18cv94, 2019 U.S. Dist. LEXIS 231215, at *9-11 (E.D. Va. Sep. 15, 2019); *Cequent Performance Prods. v. Hopkins Mfg. Corp.*, 13-cv-15293, 2015 U.S. Dist. LEXIS 153654, at *2-4 (E.D. Mich. Nov. 13, 2015). Thus, Judge Schiltz’s past practice and the practice of many other courts indicates that the stay likely *will* be lifted as to at least the first five patents as soon as a Final Written Decision is issued. Medtronic’s speculation to the contrary is unsupported and does not come close to constituting “good cause” for its highly prejudicial request.

Moreover, Medtronic’s requested extension would not actually reduce the overall inconvenience to counsel; it would merely shift inconvenience from

¹ In the Order cited by Medtronic, Judge Schiltz merely denied (without prejudice) the patentee’s earlier motion to lift the stay as to one patent prior to completion of a second pending reexamination *of that same patent*. See Ex-1102.

Medtronic’s counsel to Teleflex’s. Teleflex’s counsel already compressed all of the work necessary to prepare the PO Response-related filings for all eleven instituted IPRs within the normal one-year schedule.² It would be starkly unfair to now allow Medtronic a much longer than normal time to prepare its Reply-related filings. What’s more, if Medtronic’s unprecedented request to extend the statutory deadline is granted and if the Board institutes the four additional IPR petitions that Medtronic filed, Teleflex’s PO Responses in the new IPRs would be due *at the same time Teleflex is preparing its sur-replies and preparing for trial in the present eleven IPRs*. Medtronic’s request to shift inconvenience from its counsel to Teleflex’s is not good cause.

III. MEDTRONIC IS JUDICIALLY ESTOPPED FROM SEEKING TO EXTEND THE STATUTORY DEADLINE

Judicial estoppel applies where a party takes a later position that is clearly inconsistent with its earlier position, the party persuaded the tribunal to accept its earlier position, and the party will derive an unfair advantage or impose an unfair detriment on the opposing party if not estopped. *Scudder v. Dolgencorp, LLC*, 900

² Medtronic’s assertion that Teleflex had “almost a full year” to respond to the Petitions, (Paper 46 at 1), is simply not true. Teleflex had no reason to begin preparing its PO Responses and other documents until after the Board had decided whether to institute the IPRs and on what basis.

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