

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MEDTRONIC, INC. AND MEDTRONIC VASCULAR, INC.

Petitioners,

v.

TELEFLEX INNOVATIONS S.À.R.L.,

Patent Owner

Cases IPR2019-0135, IPR2019-0136
U.S. Patent No. RE45,776

**PETITIONERS' EXPLANATION OF MATERIAL DIFFERENCES
BETWEEN PETITIONS AND PETITION RANKING FOR
U.S. PATENT NO. RE45,776**

Medtronic, Inc. and Medtronic Vascular, Inc. (“Petitioners”) filed concurrent *inter partes* review (“IPR”) petitions against U.S. Pat. No. RE45,776 (“the ’776 Patent;” Ex-1401), but the claims are split so only two petitions challenge a given claim. The Board should consider and institute both petitions.

1. Two petitions are necessary because of a priority date dispute.

The Board’s Trial Practice Guide states that “more than one petition may be necessary” where, as here, “there is a dispute about priority date requiring arguments under multiple prior art references.” TPG UPDATE (July 2019) at 26. Petitioner filed two petitions per claim for this exact reason, as outlined below.

Itou-Based Petition	
Petition 1 IPR2019-0135	<p>Ground 1: Claims 25-27, 29-33, 35-37, 41-45, and 47-49 as anticipated by U.S. Patent No. 7,736,355 (“Itou”)</p> <p>Ground 2: Claims 39 and 46 as obvious over Itou in view of the knowledge of a POSITA</p> <p>Ground 3: Claims 36-37 and 52-56 as obvious over Itou in view of U.S. Pat. App. 2005/0015073 (“Kataishi”) and/or the knowledge of a POSITA</p> <p>Ground 4: Claims 32, 36-38, 46, 52-56 as obvious over Itou in view of U.S. Patent No. 7,604,612 (“Ressemann”) and/or the knowledge of a POSITA</p> <p>Ground 5: Claims 52-56 as obvious over Itou in view of U.S. Patent No. 5,980,486 (“Enger”) and/or the knowledge of a POSITA</p>

Kontos-Based Petition	
Petition 2 IPR2019-0136	<p>Ground 1: Claims 25-27, 29, 33, 35-37, 39, 41-49, and 52 as obvious over U.S. Patent No. 5,439,445 (“Kontos”), Ressemann and/or the knowledge of a POSITA</p> <p>Ground 2: Claims 30-32 and 53-56 as obvious over Kontos, Ressemann, Takahasi et al., <i>New Method to Increase a Backup Support of a 6 French Guiding Coronary Catheter</i> (“Takahashi”) and/or the knowledge of a POSITA</p> <p>Ground 3: Claim 52 as obvious over Kontos, Ressemann, Kataishi, and/or the knowledge of a POSITA</p> <p>Ground 4: Claims 53-56 as obvious over Kontos in view of Ressemann, Takahashi, Kataishi, and/or the knowledge of a POSITA</p>

Petition 1 asserts Itou as a primary reference. Itou has an effective filing date of September 23, 2005. (Ex-1407.) But Patent Owner has alleged a conception and reduction to practice date in 2004—a date much earlier than the priority date on the face of the ’776 Patent.¹ (Ex-1484; Ex-1401.) Petitioners therefore submitted a second Petition (Petition 2) that covers a similar set of claims as Petition 1 but asserts prior art references with priority dates *before* 2004. This second petition (Petition 2) relies on Kontos as a primary reference. Kontos issued on August 8, 1995, and it is prior art under at least § 102(b). (Ex-1409.) Patent Owner is not able to swear behind Kontos, as it may attempt to do for Itou in Petition 1.

¹ The ’776 Patent claims priority to U.S. Pat. No. 8,292,850, which, on its face, is entitled to a priority date of May 3, 2006. (Ex-1401.)

The Board’s decision in *Microsoft Corp. v. IPA Technologies, Inc.* is instructive. IPR2019-00810, Paper 12 (PTAB Oct. 16, 2019). There, as here, the patent owner raised a priority date issue necessitating “arguments under multiple prior art references.” *Id.* at 15. In *Microsoft Corp.* the priority date dispute concerned a single prior art reference. Here, the priority dispute is more fundamental—Patent Owner has raised a priority date issue regarding the challenged patent itself. It would be manifestly unfair and prejudicial to Petitioner if the Board exercises its discretion under § 314(a) to deny Petition 2 and post-institution Patent Owner successfully swears behind Itou. Accordingly, the Board should consider and institute Petition 1 *and* Petition 2.

2. Two petitions are necessary because of the length and number of claims asserted by Patent Owner in district court.

The ’776 Patent has 32 lengthy claims. The challenged independent claims—claims 25, 52, and 53—consist of a combined 424 words. Mere recitation of the challenged claims in Petitions 1 and 2 takes up over 1200 words.

Given Patent Owner’s allegations in district court, Petitioners must also challenge substantially all claims of the ’776 Patent. The Board’s Trial Practice Guide states that “more than one petition may be necessary” where, as here, “the patent owner has asserted a large number of claims in litigation.” TPG UPDATE (July 2019) at 26. In the district court litigation, Patent Owner has refused to identify the specific claims—or a specific number of claims—it will assert against

Petitioner. (Ex-1479 ¶ 71 (“Medtronic has infringed and continues to infringe one or more claims of the ’776 patent, including at least claims 25, 36, and 37...;” *see also* Ex-1483 at 2 (¶ 5d).)

The Board’s decision in *Microsoft Corp.* is again instructive. There, as here, “word count limitations and a large number of challenged claims” supported the filing of multiple petitions. IPR2019-00810, Paper 9 at 14. In *Microsoft Corp.*, the patent owner generally alleged infringement of “one or more claims” of the subject patent. *Id.* at 1 (“The complaint identified only claim 61, while generally alleging that Petitioner infringed ‘one or more claims.’”) The patent owner also opposed the streamlining of disputed issues, rejecting petitioner’s proposal to consider a set of twenty-four exemplary claims. *Id.* at 13.

Here, too, Petitioner cannot reasonably fit its arguments into a single petition. Petitioner cannot reasonably fit both its Itou-based and Kontos-based arguments into a single petition—both of which are necessary, as outlined above—because of Patent Owner’s position regarding its alleged conception and reduction to practice date. And Patent Owner has rejected reasonable proposals to narrow the parties’ dispute (*See* Ex-1483 at 2 (¶ 5d).)

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