

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.

IPR2020-00126 (Patent 8,048,032 B2)
IPR2020-00127 (Patent 8,048,032 B2)
IPR2020-00128 (Patent RE45,380)
IPR2020-00129 (Patent RE45,380)
IPR2020-00130 (Patent RE45,380)
IPR2020-00132 (Patent RE45,760)
IPR2020-00134 (Patent RE45,760)
IPR2020-00135 (Patent RE45,776)
IPR2020-00136 (Patent RE45,776)
IPR2020-00137 (Patent RE47,379)
IPR2020-00138 (Patent RE47,379)¹

Before SHERIDAN K. SNEDDEN, JON B. TORNQUIST, and
CHRISTOPHER G. PAULRAJ, *Administrative Patent Judges*.

SNEDDEN, *Administrative Patent Judge*.

¹ This Decision addresses identical issues in each of these 11 related cases. The parties are not authorized to use this style heading for any subsequent papers.

IPR2020-00126, IPR2020-00127 (Patent 8,048,032 B2) IPR2020-00128, IPR2020-00129, IPR2020-00130 (Patent RE45,380) IPR2020-00132, IPR2020-00134 (Patent RE45,760) IPR2020-00135, IPR2020-00136 (Patent RE45,776) IPR2020-00137, IPR2020-00138 (Patent RE47,379)

ORDER

Denying Petitioner's Motion for Good Cause Extension 35 U.S.C. § 316(a)(11); 37 C.F.R. § 42.100(c)

With our authorization, Medtronic, Inc. and Medtronic Vascular, Inc. ("Petitioner") filed a Motion for a Good Cause Extension Pursuant to 37 § C.F.R. § 42.100(c). Paper 56.² Also with our authorization, Teleflex Medical Devices S.À.R.L. ("Patent Owner") filed an Opposition to Petitioner's Motion for Good Cause Extension. Paper 61 ("Opp."). For the reasons that follow, we deny Petitioner's Motion.

A. Background

On November 12, 2019, Petitioner filed Petitions initiating each of the above-identified proceedings. *See, e.g.*, IPR2020-00126, Paper 1.

On June 8, 2020, the Board instituted trial in each of IPR2020-00126, IPR2020-00128, IPR2020-00129, IPR2020-00132, IPR2020-00135, and IPR2020-00137. *See, e.g.*, IPR2020-00126, Paper 22. The one-year period normally available to issue a Final Written Decision in each of those cases expires on June 8, 2021.

On June 26, 2020, the Board instituted trial in each of IPR2020-00127, IPR2020-00130, IPR2020-00134, IPR2020-00136, and IPR2020-00138 (Paper 20). *See, e.g.*, IPR2020-00127, Paper 20. The one-year period normally available to issue a Final Written Decision in each of those cases expires on June 26, 2021.

² Petitioner filed similar motions in each of the above-identified proceedings. For purposes of expediency, we cite to Papers filed in IPR2020-00126 unless otherwise indicated.

IPR2020-00126, IPR2020-00127 (Patent 8,048,032 B2) IPR2020-00128, IPR2020-00129, IPR2020-00130 (Patent RE45,380) IPR2020-00132, IPR2020-00134 (Patent RE45,760) IPR2020-00135, IPR2020-00136 (Patent RE45,776) IPR2020-00137, IPR2020-00138 (Patent RE47,379)

On June 30, 2020, the Board issued a Consolidated Scheduling Order placing each of above-identified proceedings on the same trial schedule.

DISCUSSION

B. Petitioner's Contentions

In its Motion, Petitioner contends that the current IPR schedule is unworkable in view of the volume of information submitted with each of the Patent Owner Responses, including: 4 expert declarations and 4 fact declarations in support of the Patent Owner Responses; evidence of secondary indicia of nonobviousness; separate briefing attempting to antedate Petitioner's prior art by establishing an earlier conception and reduction to practice date ("CRTP"); 65 documents and 7 declarations (one expert and 6 fact declarations) in support of Patent Owner's CRTP briefs; 11 motions to amend; up to 8 amended claims and a separate expert declaration in support of each proposed amendment; and 9 fact declarations attempting to authenticate exhibits. Mot. 1–2. "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." *Id.* at 2.

Petitioner further contends that Patent Owner will not be prejudiced by a three-month extension. *Id.* at 3–5.

C. Patent Owner's Contentions

In its Opposition, Patent Owner contends that "[t]he 13 IPR proceedings that Medtronic chose to initiate have not 'ballooned' in any unexpected or unpredictable way." Opp. 1.

Patent Owner further contends that extending the statutory deadline will prejudice Patent Owner. Specifically, Patent Owner contends that the

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“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.” *Id.* at 2.

Patent Owner further contends that extending the statutory deadline will shift inconvenience to Patent Owner’s counsel. *Id.* at 3–4. Specifically, Patent Owner contends that

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. 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.***

Id. at 4.

D. Analysis

“An *inter partes* review proceeding shall be administered such that pendency before the Board after institution is normally no more than one year.” 37 C.F.R. § 42.100(c). Although “[that] time can be extended by up to six months for good cause by the Chief Administrative Patent Judge,” the Board has rarely extended any review beyond the one-year period. *See id.*; *see also* 37 C.F.R. § 42.1(b) (seeking to “secure the just, speedy, and inexpensive resolution of every proceeding”).

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Having considered the parties' positions and evidence of record, summarized above, we are not persuaded that good cause exists to extend the statutory deadline in these cases. We do not discern any issue developing in these cases that to lead us to a conclusion that these cases are developing in an unexpected and unpredictable way. We recognize that the issues presented in these cases are complex. However, Petitioner chose the PTAB as the forum to address the patentability issues knowing the complexity of the issues that would likely be raised, including the possibility that Patent Owner would file a motion to amend. The issues identified by Petitioner as a reason to request extension, including Patent Owner's CRTP and secondary considerations arguments, are issues that commonly arise in *inter partes* review.

Furthermore, we make our decision in view of our various Board rules that reflect the strong public interest in securing just and speedy resolution of IPRs. *See* 37 C.F.R. §§ 42.1(b), 42.5(c)(1). Congress viewed the statutory deadline as an important tool for ensuring *inter partes* reviews serve the public interest in prompt review of issued patents. H.R. REP. 112–98, 45, 47 (2011) (IPR statutory deadline an improvement over *inter partes* reexaminations that can last “several years”). Moreover, we are persuaded by Patent Owner's arguments that any extension of statutory deadline will merely shift inconvenience to Patent Owner's council. *Opp.* 3–4.

Accordingly, we deny Petitioner's request for a good cause extension to the statutory deadline.

It is therefore,

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