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 IPR2020-00136
Patent RE45,776

PETITIONER'S REQUEST FOR DIRECTOR REHEARING PURSUANT TO 37 C.F.R. § 42.71(d) AND *UNITED STATES V. ARTHREX*

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I. INTRODUCTION

The Board's Final Written Decision ("FWD," Paper 104) upholding the patentability of all challenged claims, including claims 25, 52, and 53, merits Director review for two independent reasons. *First*, the Board erroneously found that Petitioner failed to rebut the showing of nexus between the recited secondary considerations and Patent Owner's GuideLiner device. More particularly, the Board erred by failing to credit Petitioner's showing that all claim elements were independently described in two separate prior art references: Itou (Ex-1407) and Ressemann (Ex-1408). Because the alleged nexus results from features known in the prior art, Patent Owner's showing of secondary indicia must fail. The Board's finding cannot stand and is incongruous with fundamental tenets of patent law.

Second, the Board misapplied the law by finding that the evidence established copying of the alleged invention. Specifically, the Board erred by analyzing only whether the GuideLiner and the allegedly copied devices were similar—the Board failed to perform a limitation-by-limitation analysis and this was error. Importantly, the Board focused on the similarities between the products as a whole, and determined that identifying such facial similarities is sufficient for the copying analysis. Under the Board's view, copying can be found simply where a product is similar to the claimed invention. Had the Board done the required analysis, it would have found that the claimed limitations are found in the prior art

(and, indeed, in most catheters). Without Director review, the Board will continue to misapply the copying analysis with respect to those elements already known in the prior art.

II. LEGAL STANDARD

The Supreme Court has determined that final written decisions are reviewable by the Director of the PTO. *United States v. Arthrex, Inc.*, 141 S. Ct. 1970, 1988 (2021). The PTO clarified that the "Director's review may address ***any*** issue, including issues of fact and issues of law, and will be ***de novo***." PTO Guidance, Arthrex Q&As | USPTO (emphases added). Accordingly, the standard of review of the FWD by the Director is *de novo*.

III. BACKGROUND

A. State of the Art

Coronary artery disease occurs when plaque buildup (a "stenosis") narrows the arterial lumen that restricts blood flow and increases the risk of heart attack or stroke. Petition ("Pet.," Paper 3) at 8-9 (citing Ex-1405 ¶¶ 28-32, 34-40). Over forty years ago, physicians developed percutaneous coronary interventional ("PCI") procedures that insert catheters through the femoral or radial artery to treat a stenosis. *Id*. The basic components of catheters used during PCI have remained largely unchanged during this time. *Id*. A physician uses a hollow needle to access the patient's vasculature, introduces a guidewire into the needle, then introduces and advances a guide catheter along the vasculature until its distal end is placed in

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