

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 IPR2020-00135
Case IPR2020-00136
Patent RE 45,776

**PATENT OWNER'S CONTINGENT MOTION TO AMEND
U.S. PATENT RE 45,776 UNDER 37 C.F.R. § 42.121**

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I. INTRODUCTION

Patent Owner Teleflex submits this Contingent Motion to Amend U.S. Patent RE 45,776 (“Motion”), with the Declaration of Peter T. Keith in Support of Motions to Amend (“Ex-2124”), under 37 C.F.R. § 42.121. This motion does not seek preliminary guidance. If, after considering Teleflex’s Patent Owner Responses, the Board finds any of issued claims 27, 33, 37, 42, 43, 45, 47, or 56 of the ’776 patent invalid, Teleflex respectfully requests that the Board replace the invalid claim(s) with the respective proposed substitute claim of claims 58-65. *See* 37 C.F.R. § 42.22(a)(2); 35 U.S.C. § 316(d).

II. LEGAL STANDARDS FOR AMENDING CLAIMS

A motion to amend must (1) propose a reasonable number of substitute claims, (2) that respond to a ground of unpatentability involved in the trial, (3) that do not enlarge the scope of the claims or introduce new matter, and (4) are not shown by a preponderance of the evidence to be unpatentable. *See* Memorandum re: Guidance on Motions to Amend in view of *Aqua Products* (Nov. 21, 2017) at 2; 35 U.S.C. § 316(d); 37 C.F.R. § 42.121. It is Petitioner’s burden to show that the proposed substitute claims are unpatentable. *Lectrosonics, Inc. v. Zaxcom, Inc.*, IPR2018-01129, Paper 15 at 4 (PTAB Feb. 25, 2019).

III. CLAIM LISTING

Pursuant to 37 C.F.R. § 42.121(b), Appendix A lists the changes made to the issued claims of the ’776 patent that would be replaced under this Motion. This

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