

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 IPR2020-01341
U.S. Patent No. 8,142,413

**PETITIONERS' EXPLANATION OF MATERIAL DIFFERENCES
BETWEEN PETITIONS AND PETITION RANKING FOR
U.S. PATENT NO. 8,142,413**

IPR2020-01341
Patent 8,142,413

Medtronic, Inc. and Medtronic Vascular, Inc. (“Petitioners”) filed two petitions for *inter partes* review against U.S. Pat. No. 8,142,413 (“the ’413 Patent”). (Ex-1001). The Board should consider and institute both petitions because a priority date dispute warrants two petitions.

The Board’s Consolidated Trial Practice Guide provides that “more than one petition may be necessary” when, as here, “there is a dispute about priority date requiring arguments under multiple prior art references.” *Consolidated Trial Practice Guide* (November 2019) at 59.¹ Petitioners filed two petitions challenging the ’413 Patent for this exact reason.

Itou-Based Petition	
Petition 1 IPR2020-01341	Ground 1: Claims 1-2, 4, and 7-14 as anticipated by U.S. Patent No. 7,736,355 (“Itou”). Ground 2: Claims 1-2, 4-5, and 7-14 as obvious over Itou in view of the knowledge of a POSITA. Ground 3: Claims 1-2, 4-5, and 7-14 as obvious over Itou in view of U.S. Patent No. 7,604,612 (“Ressemann”) and/or the knowledge of a POSITA.
Kontos-Based Petition	
Petition 2 IPR2020-01342	Ground 1: Claims 1-2, 4-5, 7-12, and 14 as obvious over U.S. Patent No. 5,439,445 (“Kontos”) in view of U.S. Patent Pub. 2004/0010280 (“Adams”), and/or the knowledge of a POSITA Ground 2: Claim 13 as obvious over Kontos in view of Adams, Takahashi et al., <i>New Method to Increase a Backup Support of a 6 French Guiding Coronary Catheter</i> , published in 2004 (“Takahashi”), and/or the knowledge of a POSITA

¹ [https://www.uspto.gov/sites/default/files/documents/tpgnov.pdf?MURL=.](https://www.uspto.gov/sites/default/files/documents/tpgnov.pdf?MURL=)

The petitions cite different prior art references to cover an anticipated priority date dispute. The '413 Patent claims priority to U.S. Pat. No. 8,048,032, which, on its face, is entitled to a priority date of May 3, 2006. (Ex-1001.) Petition 1 asserts Itou as its primary reference (filed September 23, 2005). (Ex-1007.) But Petitioners anticipate that Patent Owner may allege that the '413 Patent inventors conceived of and reduced to practice the underlying invention earlier than September 23, 2005. (Ex-1084.) So Petitioners filed Petition 2 to challenge the same claims but asserting Kontos as the primary reference. Kontos issued on August 8, 1995. (Ex-1009.) Patent Owner may try to swear behind Itou; it cannot swear behind Kontos. Each petition presents unique, non-duplicative challenges in response to a priority date dispute.

The Board has already instituted two petitions challenging a related patent for this exact reason. *See* IPR2020-00126, Paper 22; IPR2020-00127, Paper 20. The '126 petition asserts grounds based on Itou; the '127 petition asserts grounds based on Kontos. *See, e.g.*, IPR2020-00127, Paper 20 at 10. Citing its Consolidated Trial Practice Guide, the Board determined that two petitions were “justified” as a result of the potential swear-behind issue: “Given the possibility that we may determine that Itou does not qualify as prior art after fully considering Patent Owner’s priority date arguments, this is precisely one of the circumstances . . . in which more than one petition may be necessary.” *Id.* at 10-11. For this exact

IPR2020-01341
Patent 8,142,413

reason, two petitions are justified here. As in the '126 and '127 proceedings, Petitioners rely on Itou in their first petition and on Kontos in their second, because of a priority date dispute that will determine whether Itou is prior art.

The Board's decision in *Microsoft Corp. v. IPA Technologies, Inc.*, is also 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. There, the priority date dispute concerned a prior art reference. Here, the priority date dispute is more fundamental—Patent Owner has raised a priority date issue regarding the challenged patent. Were the Board to deny institution of Petition 2 under § 314(a)—and were Patent Owner to successfully swear behind Itou—the decision would prejudice Petitioners.

Accordingly, the Board should consider and institute Petition 1 *and* Petition 2. Petitioners request that the Board consider its petitions in the following order: Petition 1 (IPR2020-01341), followed by Petition 2 (IPR2020-01342).

RESPECTFULLY SUBMITTED,

ROBINS KAPLAN LLP

Date: July 30, 2020
800 LaSalle Ave, Suite 2800
Minneapolis, MN 55402
612.349.8500

/Cyrus A. Morton/
Cyrus A. Morton

Attorney for Petitioners
Medtronic, Inc. and
Medtronic Vascular, Inc.

IPR2020-01341
Patent 8,142,413

CERTIFICATE OF SERVICE

The undersigned certifies that PETITIONERS' EXPLANATION OF MATERIAL DIFFERENCES BETWEEN PETITIONS AND PETITION RANKING FOR U.S. PATENT NO. 8,142,413 was served on July 30, 2020, by Federal Express mail to the USPTO correspondence address of record listed below:

Paul Onderick
PATTERSON THUENTE PEDERSEN, P.A.
80 South 8th Street
4800 IDS Center
Minneapolis, MN 55402-2100

Courtesy copies were also sent to IPR counsel in the related proceedings at the following email addresses:

J. Derek Vandenburg, Reg. No. 32,179
dvandenburg@carlsoncaspers.com

Dennis C. Bremer, Reg. No. 40,528
dbremer@carlsoncaspers.com

/Cyrus A. Morton/

Cyrus A. Morton
Registration No. 44,954
Robins Kaplan LLP
cmorton@robinskaplan.com

Attorney for Petitioners