UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MEDTRONIC, INC., AND MEDTRONIC VASCULAR, INC.,

Petitioner,

v.

TELEFLEX LIFE SCIENCES LIMITED,

Patent Owner.

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

Case IPR2020-01342
U.S. Patent No. 8,142,413

Case IPR2020-01343
U.S. Patent No. RE 46,116

Case IPR2020-01344
U.S. Patent No. RE 46,116

PETITIONER'S OPENING BRIEF ON COLLATERAL ESTOPPEL

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I. INTRODUCTION

In June 2021, the Board issued eleven final written decisions examining five challenged patents directed to guide extension catheters and methods for manufacturing the same. IPR2020-00126 to -00130, IPR2020-00132, IPR2020-00134 to -00138 (the "previously decided IPRs" or "first set of IPRs"). In September 2021, Medtronic appealed those decisions. Because collateral estoppel does not apply to non-final decisions, there is no collateral estoppel.

Even if the decisions were final, collateral estoppel would not apply. The issues in the present IPRs are not identical and were not actually litigated in the earlier IPRs. The present claims are method-of-use claims with different claim elements. The '413 patent also presents a new claim construction dispute regarding the order of steps and the meaning of "alongside." The Board also based its decision, in part, on the notion that certain reply arguments were not included in the earlier petitions. That is not the case in the present petitions.

Focusing specifically on the Board's question regarding conception and reduction practice and whether Itou is prior art, collateral estoppel does not apply. Obviously Patent Owner has the burden of showing reduction to practice of all of the elements of the method claims at issue. This includes a different legal test, namely, whether the inventors actually performed the methods as claimed. Under this test, Patent Owner cannot demonstrate all of the claim elements, which require

in vivo testing. Separately, Patent Owner cannot show that the method worked for its intended purpose of providing *increased* back up support because there is no comparative testing. These are new issues that the Board did not address last time. The Board cannot—and should not—apply collateral estoppel.

II. COLLATERAL ESTOPPEL DOES NOT APPLY.

For two independent reasons, collateral estoppel does not apply. In particular, collateral estoppel is inapplicable because (i) the first set of IPRs are not final, and (ii) the issues to be decided in these IPRs are different than the issues previously addressed in the first set of IPRs.

IPR decisions can, *when final*, give rise to collateral estoppel (i.e., issue preclusion). IPR determinations have a preclusive effect when "(1) the issue is identical to one decided in the first action; (2) the issue was actually litigated in the first action; (3) resolution of the issue was essential to a final judgment in the first action; and (4) [the party] had a full and fair opportunity to litigate the issue in the first action." *SynQor, Inc. v. Vicor Corp.*, 988 F.3d 1341, 1353 (Fed. Cir. 2021).

Here, collateral estoppel does not apply because Medtronic appealed the final written decisions, including the Board's determinations regarding conception and reduction to practice and whether another prior art reference, Kontos, rendered certain claims invalid as obvious. In other words, the previous IPRs are not final decisions for purposes of collateral estoppel. Separately, the issues here, including

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