UNITED STATES DISTRICT COURT
DISTRICT OF MINNESOTA

VASCULAR SOLUTIONS LLC; ARROW INTERNATIONAL, INC.; TELEFLEX LLC; and TELEFLEX LIFE SCIENCES LIMITED;

Plaintiffs,

v.

MEDTRONIC, INC. and MEDTRONIC VASCULAR, INC.,

Defendants.

Case No. 19-CV-1760 (PJS/TNL)

ORDER

J. Derek Vandenburgh, Tara C. Norgard, Joseph W. Winkels, Alexander S. Rinn, and Shelleaha L. Jonas, CARLSON, CASPERS, VANDENBURGH & LINDQUIST, P.A., for plaintiffs.

Kurt J. Niederluecke, Lora M. Friedemann, Laura L. Myers, and Anne E. Rondoni Tavernier, FREDRIKSON & BYRON, P.A., for defendants.

Plaintiffs Vascular Solutions, LLC, Arrow International, Inc., Teleflex LLC, and Teleflex Life Sciences Limited (collectively "Teleflex") bring this patent-infringement action against defendants Medtronic, Inc. and Medtronic Vascular, Inc. (collectively "Medtronic"). Teleflex claims that Medtronic's Telescope catheter infringes claims in seven patents that are directed to guide extension catheters used in interventional

cardiology procedures.[1] Medtronic counterclaims for declarations of non-infringement and invalidity.

This matter is before the Court on Teleflex's motion for a preliminary injunction. For the reasons that follow, the motion is denied.

A. Standard of Review

A court must consider four factors in deciding whether to grant a preliminary injunction: (1) the movant's likelihood of success on the merits; (2) the threat of irreparable harm to the movant if the injunction is not granted; (3) the balance between that harm and the harm that granting the injunction will inflict on the other parties; and (4) the public interest. *Dataphase Sys., Inc. v. C L Sys., Inc.*, 640 F.2d 109, 114 (8th Cir. 1981).[2] Preliminary injunctions are extraordinary remedies, and the party seeking such relief bears the burden of establishing its entitlement to an injunction under the *Dataphase* factors. *Watkins Inc. v. Lewis*, 346 F.3d 841, 844 (8th Cir. 2003).

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[1]The technology is described in a *Markman* order entered in another case involving some of the same patents. *See QXMédical, LLC v. Vascular Sols., LLC*, No. 17-CV-1969 (PJS/TNL), 2018 WL 5617568 (D. Minn. Oct. 30, 2018).

[2]Generally speaking, the Federal Circuit applies regional circuit law when reviewing the grant or denial of a preliminary injunction. *Metalcraft of Mayville, Inc. v. The Toro Co.*, 848 F.3d 1358, 1363 (Fed. Cir. 2017). But the Federal Circuit gives "dominant effect to Federal Circuit precedent insofar as it reflects considerations specific to patent issues." *Id.* (citation and quotation marks omitted).

B. Likelihood of Success

For purposes of this motion, Teleflex argues that it is likely to succeed in showing that Medtronic infringes claims in four of its patents: U.S. Patent Nos. RE45,380 ("RE'380"), RE45,776 ("RE'776"), RE47,379 ("RE'379"), and RE45,760 ("RE'760").

"To establish a likelihood of success on the merits, a patentee must show that it will likely prove infringement of the asserted claims and that its infringement claim will likely withstand the alleged infringer's challenges to patent validity and enforceability." *Metalcraft of Mayville, Inc. v. The Toro Co.*, 848 F.3d 1358, 1364 (Fed. Cir. 2017). The likelihood of success must be considered "in light of the presumptions and burdens that will inhere at trial on the merits." *Sciele Pharma Inc. v. Lupin Ltd.*, 684 F.3d 1253, 1259 (Fed. Cir. 2012).

Ultimately, however, the burden remains with the patentee to establish its entitlement to a preliminary injunction. If the non-movant "raises a substantial question concerning either infringement or validity, *i.e.*, asserts an infringement or invalidity defense that the patentee cannot prove lacks substantial merit, the preliminary injunction should not issue." *Amazon.com, Inc. v. Barnesandnoble.com, Inc.*, 239 F.3d 1343, 1350-51 (Fed. Cir. 2001) (citation and quotations omitted). "The showing of a substantial question as to invalidity . . . requires less proof than the clear and convincing showing necessary to establish invalidity itself." *Id.* at 1359.

1. Written Description

Medtronic argues that all of the asserted claims in the RE'776, RE'379, and RE'760 patents are invalid for lack of a written description.[3] In particular, Medtronic argues that the original written description of the invention discloses a side opening only in the substantially rigid portion of the catheter, yet Teleflex's asserted claims place the side opening outside of the substantially rigid portion.

The written-description requirement is set forth in 35 U.S.C. § 112(a):

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor or joint inventor of carrying out the invention.

Section 112(a) therefore requires *both* (1) a written description of the invention *and* (2) a written description of the manner and process of making and using it. *Ariad Pharms., Inc. v. Eli Lilly & Co.*, 598 F.3d 1336, 1344 (Fed. Cir. 2010) (en banc). In the context of a reissued patent, the necessary disclosure must appear in the original specification. *Revolution Eyewear, Inc. v. Aspex Eyewear, Inc.*, 563 F.3d 1358, 1366 (Fed. Cir. 2009).

[3]For purposes of this motion, Teleflex asserts the following claims in these three patents: claims 25, 36, and 37 of the RE'776 patent; claims 25, 33, 34, 38, and 44 of the RE'379 patent; and claims 25, 28, 29, 32, and 48 of the RE'760 patent.

The purpose of requiring a written description of the invention "is to prevent an applicant from later asserting that he invented that which he did not; the applicant for a patent is therefore required to recount his invention in such detail that his future claims can be determined to be encompassed within his original creation." *Amgen Inc. v. Hoechst Marion Roussel, Inc.*, 314 F.3d 1313, 1330 (Fed. Cir. 2003) (citation and quotation marks omitted).

The test for determining the adequacy of the written description is whether it "reasonably conveys to those skilled in the art that the inventor had possession of the claimed subject matter as of the filing date." *Ariad*, 598 F.3d at 1351. The adequacy of the written description is a question of fact and "varies depending on the nature and scope of the claims and on the complexity and predictability of the relevant technology." *Id.*

Medtronic's expert, Dr. Paul Zalesky, opines that the written description for the asserted patents does not reasonably convey to a person of ordinary skill in the art that the inventor had possession of catheters with openings in locations other than the substantially rigid portion. Zalesky Decl. ¶¶ 68-85. Pointing to the prosecution history of the RE'379 patent, Dr. Zalesky notes that the patent examiner rejected some of the

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