

IPR2020-01341, -01342
Patent 8,142,413

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 No. IPR2020-01341

Case No. IPR2020-01342

U.S. Patent No. 8,142,413

**PETITIONER'S OPPOSITION TO
PATENT OWNER'S CONTINGENT MOTION TO AMEND**

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I. INTRODUCTION

Medtronic, Inc., and Medtronic Vascular, Inc., (collectively “Petitioner” or “Medtronic”) submits this opposition to Patent Owner’s Contingent Motion to Amend (MTA).¹ Patent Owner (“Teleflex”) seeks to amend claims 1, 7, and 8 and proposes substitute claims 15-17. MTA, 1, Appendix A (“App.”). But the substitute claims are unpatentable over the prior art. Teleflex’s motion should be denied.

II. PROPOSED CLAIMS 15-17 ARE UNPATENTABLE.

A. Substitute claims 15-17 are unpatentable over Itou in view of Ressemann or Kataishi.

Unlike original claim 1, substitute claim 15 requires each step of the claimed method to be performed in the order recited. MTA, App. It also recites a “treatment catheter that includes a stent,” instead of an “interventional cardiology device.” Additional limitations added to the substitute claims relate to a size differential between the lumen of the guide catheter and the lumen of the coaxial guide catheter (claim 15), or recite specific sizes for each (claim 16). Limitations added to substitute claim 17 add limitations to the shape of the coaxial guide catheter’s side opening. But these additions cannot overcome the prior art of record. The analysis below focuses on the newly added limitations while briefly addressing the original

¹ Papers or Exhibits cited herein are in Case No. IPR2020-01341 unless indicated otherwise. Counterpart exhibits beginning Ex-14XX are filed in IPR2020-01342.

limitations, which are thoroughly addressed by the original Petition and supporting testimonial evidence.

1. Substitute Claim 15

First, even if the preamble of substitute claim 15 is construed to be limiting, *see* Petition (Pet.), 21 n.6, Itou renders the claim obvious. Itou discloses providing backup support. A POSITA knew that to advance an interventional cardiology device through a guide catheter (“GC”) and into the coronary vasculature, the GC had to provide sufficient backup support. Ex-1015, 548; Ex-1847 ¶17. The ’413 patent similarly teaches that because the disclosed coaxial guide catheter is “extended through the lumen of the guide catheter and beyond the distal end of the guide catheter and inserted into the branch artery,” it “assists in resisting axial and shear forces exerted by an interventional cardiology device passed through the second lumen and beyond the flexible distal tip portion.” Ex-1001, Abstract, 4:64-5:9. As the ’413 patent makes clear, it is the combination of a GC and an extension catheter inserted into the coronary ostium that provides the claimed backup support. Pet., 22. The exact same configuration of catheters is disclosed in Itou.² *Id.*, 23-24; Ex-1847 ¶¶13-24.

² As explained in Petitioner’s Reply in IPR2020-01341 (filed concurrently herewith), Itou is prior art.

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