

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.

IPR2020-01341 (Patent 8,142,413 B2)
IPR2020-01342 (Patent 8,142,413 B2)
IPR2020-01343 (Patent RE46,116 E)
IPR2020-01344 (Patent RE46,116 E)

Before SHERIDAN K. SNEDDEN, JAMES A. TARTAL, and
CHRISTOPHER G. PAULRAJ, *Administrative Patent Judges*.¹

PAULRAJ, *Administrative Patent Judge*.

ORDER
Conduct of the Proceeding
37 C.F.R. §§ 42.5

¹ This Order addresses issues that are identical in each of the above-captioned proceedings. We therefore exercise our discretion to issue one Order to be filed in each proceeding. The proceedings have not been consolidated, and the Parties are not authorized to use this style heading in any subsequent papers.

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In a prior set of cases, IPR2020-00126, -00127, -00128, -00129, -00130, -00132, -00134, -00135, -00136, -00137, and -00138, the Board issued final written decisions addressing the patentability of the claims of certain patents that are related to the challenged patents in these proceedings. In those prior decisions, the Board resolved the issue of whether U.S. Patent No. 7,736,355 B2 (“Itou”) qualified as prior art to the previously challenged patents (with the same priority date as the currently challenged patents), as well as patentability arguments based on other prior art references also at issue in the current proceedings. *See, e.g.*, IPR2020-00126, Paper 127 (determining that Itou did not qualify as prior art based on Patent Owner’s showing of prior conception and reduction to practice); IPR2020-00127, Paper 105 (addressing patentability arguments based on Kontos and Adams references, and Patent Owner’s secondary considerations arguments).

The Board is interested in further briefing from the parties on the issue of whether the doctrine of collateral estoppel or issue preclusion applies to any issues that were previously addressed by the Board in the earlier set of related cases, including in particular the Board’s prior resolution of the conception/reduction to practice issue raised by Patent Owner and whether Itou qualifies as prior art. *See Papst Licensing GMBH & Co. KG v. Samsung Elecs. Am., Inc.*, 924 F.3d 1243, 1251 (Fed. Cir. 2019) (holding that the issue preclusion doctrine can apply to prior Board decisions that have become final); *MaxLinear, Inc. v. CF CRESPE LLC*, 880 F.3d 1373, 1376 (Fed. Cir. 2018) (same).

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Accordingly, it is hereby:

ORDERED that Petitioner and Patent Owner shall each simultaneously file a brief addressing the applicability of the collateral estoppel/issue preclusion doctrine to any issues to be addressed by the Board in these proceedings; such a brief shall be no longer than 10 pages in length and due no later than the close of business on November 12, 2021;

FURTHER ORDERED that Petitioner and Patent Owner shall each file a responsive brief addressing the other party's briefs on collateral estoppel/issue preclusion; such a responsive brief shall be no longer than 5 pages in length and due no later than the close of business on November 17, 2021;

FURTHER ORDERED that no additional evidence shall be filed with the briefs authorized by this Order.

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