

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

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

v.

TELEFLEX LIFE SCIENCES LIMITED,
Patent Owner.

Case IPR2020-01342
Patent 8,142,413

**PATENT OWNER'S CONSOLIDATED RESPONSE TO PETITIONER'S
OPENING BRIEF ON COLLATERAL ESTOPPEL**

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Petitioner portrays the application of collateral estoppel as a series of bright line rules that come out in its favor. This is incorrect. Whether the prior, related IPRs are sufficiently final so as to trigger collateral estoppel is not nearly so clear. Petitioner's citations to an unrelated statute and non-binding district court decision (which itself admits of ambiguity), do not support Petitioner's bright line.

Some *issues* are the same and could be decided on the basis of collateral estoppel. For example, on conception and reduction to practice, Petitioner does not challenge conception, and does not argue that the issue of constructive reduction to practice is any different than in the prior IPRs.

Nonetheless, because of ambiguity in the law Patent Owner requests that the Board not rely solely on collateral estoppel and, as other Board panels have done, also address the arguments on the merits and/or substantively adopt its prior findings where appropriate. And whether or not collateral estoppel applies, the Board may and should view the prior Final Written Decisions as highly relevant, persuasive authority.

I. PETITIONER'S BRIGHT LINE RULE FOR FINALITY IS WRONG

Petitioner argues that because it appealed the prior IPRs, they are not final and cannot be the basis for collateral estoppel. Pet. Br., 2-4. This bright line rule is wrong. Such a rule would mean a party could always prevent the application of collateral estoppel simply by appealing a related decision. That runs counter to

general principles and purposes of collateral estoppel. *E.g.*, *Pharmacia & Upjohn Co. v. Mylan Pharm., Inc.*, 170 F.3d 1373, 1381 (Fed. Cir. 1999) (“The law is well settled that the pendency of an appeal has no effect on the finality or binding effect of a trial court's holding.”).

Petitioner cites 35 U.S.C. § 318 for the proposition that IPRs are not final until the time for appeals has expired or any appeals have terminated. Pet. Br., 3. But the language Petitioner cites simply explains when the Director should issue a certificate cancelling or confirming claims. 35 U.S.C. § 318(b). Clearly a certificate does not issue from an IPR until appeals have been exhausted, but the statute says nothing about the finality of fully litigated and decided issues for the purpose of collateral estoppel.

Petitioner also cites the non-binding *Trustid* case from the District of Delaware, for an apparent bright line rule that “the Board’s final written decisions ‘do[] not have preclusive effect until that decision is either affirmed or the parties waive their appeal rights.’” Pet. Br., 3 (quoting 2021 U.S. Dist. LEXIS 134010, at *8-9 (D. Del. July 6, 2021)). But Petitioner did not provide the whole quotation—the District of Delaware acknowledged ambiguity when it found Federal Circuit case law only “*suggests*” such a rule. 2021 U.S. Dist. LEXIS 134010, at *8-9.

Beyond the one (inapplicable) statute and one (misquoted and non-binding) district court case, Petitioner only provides a list of “see” cites. Pet. Br. 3-4.

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