

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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

Petitioner,

v.

TELEFLEX LIFE SCIENCES LIMITED,

Patent Owner.

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

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

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**DECLARATION OF PAUL ZALESKY REGARDING CONCEPTION AND  
REDUCTION TO PRACTICE SUBMITTED IN SUPPORT OF  
PETITIONER'S REPLY**

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I, Paul Zalesky, declare as follows:

1. I have been retained by Robins Kaplan LLP on behalf of Medtronic, Inc., and Medtronic Vascular, Inc., (“Petitioner” or “Medtronic”) as an independent expert to provide my opinions in connection with the following *Inter Partes* Review (“IPR”) proceedings: IPR2020-01341 (U.S. Patent No. 8,142,413) and IPR2020-01343 (U.S. Patent No. RE 46,116) (“second set of IPRs”).

2. I make this declaration based on personal knowledge. I am over the age of 21 and am otherwise competent to make this declaration.

3. I have reviewed the Patent Owner Responses in the second set of IPRs and the declarations, exhibits, and other materials that Patent Owner cited in support of its conception and reduction to practice arguments in those Responses. I have also reviewed the transcripts of the depositions of Peter T. Keith, Howard C. Root, and Steven J. Erb taken in connection with the second set of IPRs.

4. I previously offered opinions in connection with related IPR proceedings: IPR2020-00126, -00128, -00129, -00132, -00134, -00135, and -00137 (“first set of IPRs”). I previously reviewed materials related to the first set of IPRs before rendering my opinions. I have reviewed the Board’s Final Written Decision related to conception and reduction to practice in the first set of IPRs.

5. My December 17, 2020 declaration submitted in support of Petitioner's Reply to Patent Owner's Response Addressing Conception and Reduction to Practice in the first set of IPRs, attached here as Appendix A, remains true and correct.

6. I understand that the patents at issue in the second set of IPRs—the '413 and '116 patents—claim priority to a May 3, 2006 application. I understand that, in response to the Itou reference (U.S. Patent No. 7,736,355), Patent Owner has alleged prior invention, including conception in early 2005, actual reduction to practice before Itou's effective filing date (September 23, 2005), and conception before Itou's effective filing date plus diligence through May 3, 2006 (constructive reduction to practice).

7. Based on my review of the materials submitted in connection with Patent Owner's conception and reduction to practice arguments in this second set of IPRs, the arguments and evidence are virtually identical to the conception and reduction to practice arguments and evidence submitted in the first set of IPRs.

8. Consistent with the opinions that I offered in the first set of IPRs, based on my experience and expertise and the materials that I have reviewed, it is my opinion that the inventions claimed in the '413 and '116 patents were not actually reduced to practice before September 23, 2005. It is also my opinion that

Patent Owner has not shown diligence between alleged conception before September 23, 2005, and the filing of the patent application on May 3, 2006.

9. I have extensive experience developing many specialty devices for Interventional Cardiology. I was struck by the paucity of technical documents and data cited by Patent Owner. I would normally expect to see a significant accumulation of “proof-of-concept” documents, including notes, sketches, diagrams, drawings, crude (but critical) subassembly prototypes, documents addressing crucial technical issues, and testing data. That accumulation is then typically filtered and condensed before it is transmitted to patent counsel for composition of a new patent application. In this case, there is, frankly, more technical detail in the patents than appears to be in documents in Patent Owner’s possession from the relevant timeframe. Given the paucity of technical detail produced, the absence of a filed Provisional Patent Application further augments my opinion that there was neither actual reduction to practice before September 23, 2005, nor diligence before May 3, 2006.

10. In short, I have not seen documentary evidence that VSI assembled its so-called “April” and “July” prototypes before September 23, 2005, that it tested those prototypes, that it determined from those tests that the inventions would work for their intended purpose, or that it diligently worked on its prototypes from just before September 23, 2005 through May 3, 2006. Rather, I have seen evidence that

suggests that VSI did *not* actually or constructively reduce to practice before September 23, 2005 or May 3, 2006, respectively.

11. I have already reviewed the conception and reduction to practice arguments and evidence submitted in the first set of IPRs, and the vast majority of those arguments and evidence are submitted in the second set of IPRs.

12. I understand that Patent Owner submitted substantially the same exhibits, using the same numbering, in connection with the second set of IPRs compared to the first set of IPRs. I understand that several exceptions apply:

- Exhibits 2002, 2003, 2004, 2005, and 2006 in the first set of IPRs are numbered 2253, 2254, 2255, 2256, and 2257, respectively, in the second set of IPRs.
- Howard Root has added some content to his declaration, Exhibit 2118.
- Steve Erb has added some content to his declaration, Exhibit 2122.
- Peter Keith has adjusted his opinions slightly, Exhibit 2123.

13. Given the overlap in the evidence that Teleflex cited in the first and second sets of IPRs, I adopt my previous reduction to practice opinions in the second set of IPRs, and I also opine as follows. The follow paragraphs are numbered consistent with my previous declaration and begin where that declaration left off.

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