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

Case IPR2020-01342
U.S. Patent No. 8,142,413

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

Case IPR2020-01344
U.S. Patent No. RE 46,116

PETITIONER'S RESPONSIVE BRIEF ON COLLATERAL ESTOPPEL

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Patent Owner's ("PO") carefully worded brief attempts to mask that collateral estoppel cannot, and should not, apply to these proceedings. The Board's prior decisions are not final, do not address identical issues, and did not rely upon those issues. The Board should not apply collateral estoppel.

I. The Board's First Set of IPR Decisions are not Final.

PO concedes that collateral estoppel does not attach while an appeal is pending. *See* PO Brief at 4-5. Indeed, a final written decision is not final until *either* the time for appeal elapses *or* the Federal Circuit affirms the Board's decision. *See* 35 U.S.C. § 318(b) (issuance of certificate of (un)patentability proper only after appeal time expires or appeal exhausted). Here, Petitioner appealed the previous IPR decisions—none are final, and collateral estoppel does not attach.

PO's argument that the first set of IPR decisions are "sufficiently final" is misleading at best and incorrect at worst. PO relies on cases in which there was no appeal or the appeal had already concluded. *See B&B Hardware, Inc. v. Hargis Indus.*, 575 U.S. 138, 146-48 (2015) (no appeal); *Papst Licensing GMBH & Co. KG v. Samsung Elecs. Am., Inc.*, 924 F.3d 1243, 1249 (Fed. Cir. 2019) (appeal dismissed); *VirnetX Inc. v. Apple, Inc.*, 909 F.3d 1375, 1378 (Fed. Cir. 2018) (appeal affirmed); *MaxLinear, Inc. v. CF CRESPE LLC*, 880 F.3d 1373, 1376 (Fed. Cir. 2018) (appeals affirmed); *Mylan Pharm. Inc. v. Saint Regis Mohawk Tribe*, IPR2016-01129, Paper 154 (PTAB Sept. 27, 2019) (appeals affirmed);

Webpower, Inc. v. Wag Acquisition, LLC, IPR2016-01239, Paper 21 (PTAB Dec. 26, 2017) (no appeal). Indeed, PO cites no case in which collateral estoppel attached *during the pendency of an active appeal*.[1]

PO's other argument—that collateral estoppel can apply when a *district court* decision is pending on appeal—is similarly inapplicable. PO Brief at 2-3. Importantly, a final written decision by the Board is not a decision by a district court. As the Restatement notes, "[t]o determine finality [of agency decisions], reference must be made to the procedures of the agency that specify what official has authority to decide and the point at which the decision becomes effective." Restatement (Second) of Judgments § 83 cmt e. And the procedures of the Patent Office specify that its determinations on patentability are not implemented by publication of a certificate until "the time for appeal has expired or any appeal has terminated." 37 C.F.R. § 42.80; 35 U.S.C. § 318(b). Finality of a Board decision, then, requires finality of appellate process. Petitioner's Opening Brief at 3-4.

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[1] PO cites *Mobile Tech, Inc. v. Invue Security Prods. Inc.*, IPR2019-00481, Paper 29 at 33 (PTAB July 16, 2019) for the proposition that a pending appeal does not prevent the application of collateral estoppel. PO Brief at 4. Not only was this statement dicta—the PTAB addressed the issues on the merits—but eight of the eleven appeals were already complete. *Mobile Tech*, Paper 29 at 7.

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