

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MEDTRONIC, INC. AND MEDTRONIC VASCULAR, INC.

Petitioners,

v.

TELEFLEX INNOVATIONS S.À.R.L.

Patent Owner

Cases IPR2020-01344
U.S. Patent No. RE46,116

**PETITIONERS' EXPLANATION OF MATERIAL DIFFERENCES
BETWEEN PETITIONS AND PETITION RANKING FOR
U.S. PATENT NO. RE46,116**

Medtronic, Inc. and Medtronic Vascular, Inc. (“Petitioners”) filed two petitions for *inter partes* review against U.S. Pat. No. RE46,116 (“the ’116 Patent”). Petitioners ask the Board to consider and institute both petitions.

1. Priority date disputes warrant two petitions.

The Board’s Consolidated Trial Practice Guide provides that “more than one petition may be necessary” when, as here, “there is a dispute about priority date requiring arguments under multiple prior art references.” Consolidated Trial Practice Guide (Nov. 2019) at 59.¹ Petitioners filed two petitions, advancing arguments under multiple prior art references, to address two priority date disputes.

Ito-Based Petition	
Petition 1	Ground 1: Ressemann anticipates claims 52 and 53.
IPR2020-01343	Ground 2: Ito renders claims 25-40, 42, 44-48, 52, and 53 obvious in view of Ressemann and the knowledge of a POSITA. Ground 3: Ito renders claim 45 obvious in view of Ressemann, Kataishi, and the knowledge of a POSITA.
Kontos-Based Petition	
Petition 2	Ground 1: Kontos renders claims 52-53 obvious in view of Ressemann and the knowledge of a POSITA.
IPR2020-01344	Ground 2: Kontos renders claims 25-40, 42, and 44-48 obvious in view of Ressemann, Takahashi, and the knowledge of a POSITA. Ground 3: Kontos renders claim 45 obvious in view of Ressemann, Takahashi, Kataishi, and the knowledge of a POSITA. Ground 4: Root renders claims 25-55 obvious in view of the knowledge of a POSITA. Ground 5: Kontos renders claims 45-46 obvious in view of Ressemann, Takahashi, Root, and the knowledge of a POSITA.

¹ <https://www.uspto.gov/sites/default/files/documents/tpgnov.pdf?MURL=>

First, the petitions rely on different primary references to cover an anticipated swear-behind dispute. The '116 Patent claims priority to U.S. Pat. No. 8,048,032, which, on its face, is entitled to a priority date of May 3, 2006. (Ex-1401.) Petition 1 asserts Itou as its primary reference (filed September 23, 2005). (Ex-1407.) But Petitioners anticipate that Patent Owner may allege that the '116 Patent inventors conceived of and reduced to practice the underlying invention earlier than September 23, 2005. (Ex-1484.) So Petitioners filed Petition 2 to challenge the same claims but asserting Kontos as the primary reference. Kontos issued on August 8, 1995. (Ex-1409.) Patent Owner may try to swear behind Itou; it cannot swear behind Kontos. Each petition presents unique, non-duplicative challenges in response to a priority date dispute.

In addition, Petition 2 advances a unique argument related to a second priority date dispute. With the Kontos grounds, Petitioners contend that the challenged claims are not entitled to claim priority to May 2006, based on a lack of written description support, and incorporate an intervening art argument unique to Petition 2. *See* Petition 2 at Sections X-XII. This priority date dispute is separate from, and in addition to, the Itou swear-behind dispute.

The Board has already instituted two petitions challenging a related patent based on the Itou swear-behind dispute. *See* IPR2020-00135, Paper 22; IPR2020-00136, Paper 20. The '135 petition asserted grounds based on Itou; the '136

petition asserted grounds based on Kontos. *See, e.g.*, IPR2020-00136, Paper 20 at 37. The Board determined that two petitions were justified because of the potential swear-behind issue: “Given the possibility that we may determine that Itou does not qualify as prior art after fully considering Patent Owner’s priority date arguments, we determine that Petitioner provides a sufficient explanation as to why it was necessary to rely upon the obviousness challenges presented [in the second petition] as an alternative basis for unpatentability. Indeed, this is precisely one of the circumstances . . . in which more than one petition may be necessary.” *Id.* at 39. Petitioners were entitled to rely on Itou as prior art and protect against a potential swear behind with Kontos. *Id.* Further, the Board determined that the petitions presented unique, non-duplicative challenges—“the prior art and issues to be decided do not significantly overlap with each other.” *Id.* at 40.

For these exact reasons, two petitions are justified here. As in the ’135 and ’136 proceedings, Petitioners rely on Itou in their first petition and on Kontos in their second, because of a priority date dispute that will determine whether Itou is prior art.

The Board’s decision in *Microsoft Corp. v. IPA Technologies, Inc.*, is also instructive. IPR2019-00810, Paper 12 (PTAB Oct. 16, 2019). There, as here, the Patent Owner raised a priority date issue necessitating “arguments under multiple prior art references.” *Id.* at 15. There, the priority date dispute concerned a prior art

reference. Here, the priority date disputes are more fundamental, relating to the challenged patent. Were the Board to deny institution of Petition 2 under § 314(a)—and were Patent Owner to successfully swear behind Itou—the decision would prejudice Petitioners. Thus, the Board should consider and institute Petition 1 and Petition 2.

2. The length and number of challenged claims warrant two petitions.

Petitioners challenge claims 25-40, 42, 44-48, 52, and 53 of the '116 Patent in Petition 1 and claims 25-55 in Petition 2. Reciting the challenged claims requires nearly 1500 words, which additionally warrants two petitions.

Petitioners must challenge these claims to preserve their right to do so in the event that Patent Owner asserts them in litigation.² Here, Patent Owner has, to date, asserted only one claim of the '116 Patent against Petitioners. But Patent Owner may assert additional claims later by seeking to amend its infringement contentions (Ex-1118). More significantly, it may assert additional claims against Petitioners in a second case, against a new product. Petitioners will not have the opportunity to challenge additional claims later if their one-year period to do so—triggered by the pending litigation—expires before then. *See* 35 U.S.C. § 315(b). The Board strictly enforces its one-year time bar to petition for IPR. *See, e.g.,*

² “[M]ore than one petition may be necessary . . . when the patent owner has asserted a large number of claims in litigation.” Consolidated Trial Practice Guide (Nov. 2019) at 59.

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