

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

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

v.

TELEFLEX INNOVATIONS S.À.R.L.
Patent Owner.

IPR2020-00131
Patent RE45,380

Before SHERIDAN K. SNEDDEN, JON B. TORNQUIST, and
CHRISTOPHER G. PAULRAJ, *Administrative Patent Judges*.

TORNQUIST, *Administrative Patent Judge*.

DECISION
Denying Institution of *Inter Partes* Review
35 U.S.C. § 314

INTRODUCTION

Medtronic, Inc. and Medtronic Vascular, Inc. (collectively “Petitioner”) filed a Petition (Paper 3, “Pet.”) requesting an *inter partes* review of claims 25–39 of U.S. Reissue Patent RE45,380 (Ex. 1801, “the ’380 patent”). Teleflex Innovations S.À.R.L. (“Patent Owner”) filed a Preliminary Response to the Petition (Paper 9, “Prelim. Resp.”). Pursuant to our authorization, Petitioner filed a Reply (Paper 14) addressing its burden on secondary considerations and reduction to practice, and Patent Owner filed a Sur-Reply (Paper 15) addressing Petitioner’s burden on those issues. Also pursuant to our authorization, Petitioner filed another Reply (Paper 17) and Patent Owner filed another Sur-Reply (Paper 18) addressing the factors for discretionary denial under 35 U.S.C. § 314(a).

We have authority to determine whether to institute an *inter partes* review. 35 U.S.C. § 314 (2018); 37 C.F.R. § 42.4(a) (2019). As part of this analysis, we may consider whether Petitioner has filed more than one petition directed to the challenged patent. For the reasons discussed below, we determine that Petitioner has not justified an additional Petition directed to the ’380 patent. Accordingly, we do not institute an *inter partes* review.

A. *Related Matters*

The parties indicate that the ’380 patent is the subject of litigation in *Vascular Solutions LLC, et al. v. Medtronic, Inc., et al.*, No. 19-cv-01760 (D. Minn.) and *QXMedical, LLC v. Vascular Solutions, LLC*, No. 17-cv-01969 (D. Minn). Pet. 4–5; Paper 4, 2–3. The ’380 patent is also at issue in IPR2020-00128, IPR2020-00129, and IPR2020-00130. Paper 4, 3; Pet. 5.

B. Prior Art and Asserted Grounds

Petitioner contends claims 25–39 of the '380 patent would have been unpatentable on the following grounds:

Claims Challenged	35 U.S.C. §	Reference(s)/Basis
25, 26, 28–31, 34–37, 39	103	Kontos ¹ , Adams ²
27	103	Kontos, Adams, Kataishi ³
27	103	Kontos, Adams, Enger
32, 33	103	Kontos, Adams, Takahashi ⁴
38	103	Kontos, Adams, Berg ⁵

Petitioner also relies on the testimony of Dr. Stephen JD Brecker (Ex. 1805) and Richard A. Hillstead (Ex. 1842).

ANALYSIS

Petitioner filed four petitions for *inter partes* review of the '380 patent:

IPR	Claims Challenged	Primary Reference	Petitioner's Ranking
IPR2020-00128	1–4, 6–10, 12–21, 23	Itou	Petition 1A
IPR2020-00129	25–39	Ressemann	Petition 1B
IPR2020-00130	1–4, 6–9, 12–21	Kontos	Petition 2A
IPR2020-00131	25–39	Kontos	Petition 2B

¹ Kontos, US 5,439,445, issued August 8, 1995 (Ex. 1809) (“Kontos”).

² Adams, US 2004/0010280 A1, published January 15, 2004 (Ex. 1835) (“Adams”).

³ Kataishi, US 2005/0015073 A1, published January 20, 2005 (Ex. 1825) (“Kataishi”).

⁴ Takahashi, et al., *New Method to Increase a Backup Support of a 6 French Guiding Coronary Catheter*, *Catheterization and Cardiovascular Interventions* 63:452–456 (2004) (Ex. 1810) (“Takahashi”).

⁵ Berg, US 5,911,715, issued June 15, 1999 (Ex. 1851) (“Berg”).

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As indicated in the chart above, IPR2020-00128 relies on Itou as the primary reference; IPR2020-00129 relies on Ressemann as the primary reference; and IPR2020-00130 and IPR2020-00131 rely on Kontos as the primary reference. Paper 2, 1–2. Petitioner labels IPR2020-00128 as “Petition 1A,” IPR2020-00129 as “Petition 1B,” IPR2020-00130 as “Petition 2A,” and IPR2020-00131 as “Petition 2B.” *Id.* at 1–3. Petition 1A is directed to claims 1–4, 6–10, 12–21, and 23 of the ’380 patent. *Id.* at 1. Petition 1B is directed to claims 25–39 of the ’380 patent. *Id.* at 1–2. Petitioner 2A is directed to claims 1–4, 6–9, and 12–21 of the ’380 patent. *Id.* at 2. Petition 2B is directed to claims 25–39 of the ’380 patent. *Id.*

The Patent Trial and Appeal Board Consolidated Trial Practice Guide (“Trial Practice Guide”) (Nov. 2019)⁶ explains that “there may be circumstances in which more than one petition may be necessary, including, for example, . . . when there is a dispute about priority date requiring arguments under multiple prior art references.” Trial Practice Guide at 59. “In such cases two petitions by a petitioner may be needed, although this should be rare.” *Id.* The Trial Practice Guide further instructs that “it is unlikely that circumstances will arise where three or more petitions by a petitioner with respect to a particular patent will be appropriate.” *Id.* Here, Petitioner has filed four petitions challenging claims of the ’380 patent. Paper 2, 1–3.

Petitioner contends Petitions 1A and 1B “assert Itou as a primary reference” and Patent Owner has “raised a priority date issue necessitating ‘arguments under multiple prior art references.’” *Id.* at 3 (quoting *Microsoft*

⁶ Available at <https://www.uspto.gov/TrialPracticeGuideConsolidated>.

Corp. v. IPA Techs., Inc., IPR2019-00810, Paper 12 at 15 (PTAB Oct. 16, 2019)). And, according to Petitioner, “[i]t would be manifestly unfair if the Board exercises its discretion under § 314(a) to deny Petitions 2A and 2B” and, post-institution, Patent Owner successfully swears behind Itou. *Id.* at 4.

We do not find Petitioner’s arguments persuasive. As noted by Petitioner, the petition in IPR2020-00129 addresses the same challenged claims as the current Petition, but asserts “Itou as a primary reference.” *Id.* at 3. The petition in IPR2020-00129, however, only includes Itou in its seventh, eighth, ninth, and tenth grounds, and does so in addressing claims that are already addressed by its earlier anticipation and obviousness grounds based on Ressemann, a § 102(e) reference with a filing date of August 9, 2002. IPR2020-00129, Paper 1, 7–8. Patent Owner has only asserted that conception of the invention claimed in the ’380 patent occurred in late 2004 and reduction to practice occurred “in the spring and summer of 2005.” *See* IPR2020-00128, Paper 8, 21–22. Thus, even if Patent Owner successfully swears behind Itou, the petition in the -00129 IPR would still contain grounds addressing every challenged claim based on a primary reference (Ressemann) that Patent Owner has not attempted to swear behind. In this situation, a fourth petition challenging the ’380 patent is not justified.

In view of the foregoing, Petitioner has not demonstrated a need for its Petition in IPR2020-00131. Accordingly, we exercise our discretion under 35 U.S.C. § 314 and *deny* the current Petition.

CONCLUSION

For the reasons discussed above, we do not institute an *inter partes* review.

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ORDER

It is:

ORDERED that no *inter partes* review is instituted.

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