Medtronic, Inc. v. Teleflex Life Sciences Limited

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United States Court of Appeals for the Federal Circuit _____

MEDTRONIC, INC., MEDTRONIC VASCULAR, INC., Appellants

v.

TELEFLEX LIFE SCIENCES LIMITED, Appellee _____

2022-1721, 2022-1722 _____

Appeals from the United States Patent and Trademark Office, Patent Trial and Appeal Board in Nos. IPR2020- 01343, IPR2020-01344. _____

Decided: November 16, 2023 _____

MADELEINE C. LAUPHEIMER, Wilmer Cutler Pickering Hale and Dorr LLP, Boston, MA, argued for appellants. Also represented by TASHA JOY BAHAL, MARK CHRISTOPHER FLEMING, HANNAH ELISE GELBORT, JEFFREY SOLLER; BRITTANY BLUEITT AMADI, JENNIFER L. GRABER, Washing- ton, DC.

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Before LOURIE, PROST, and CHEN, Circuit Judges. LOURIE, Circuit Judge. Medtronic, Inc. and Medtronic Vascular, Inc. (collec- tively, “Medtronic”) appeal from two final written decisions of the United States Patent and Trademark Office Patent Trial and Appeal Board (“the Board”) holding that

it had not shown the challenged claims of U.S. Patent RE46,116 ("the '116 patent") to be unpatentable. Medtronic, Inc. v. Teleflex Life Scis. Ltd., IPR2020-01343, 2022 WL 557277 (P.T.A.B. Feb. 23, 2022) ("'1343 Decision"); Medtronic, Inc. v. Teleflex Life Scis. Ltd., IPR2020-01344, 2022 WL 557664 (P.T.A.B. Feb. 23, 2022) ("'1344 Decision"). For the reasons provided below, we affirm. BACKGROUND The '116 patent, developed by Vascular Solutions Inc. ("VSI") but now owned by appellee Teleflex Life Sciences Limited ("Teleflex"), issued from U.S. Patent App. 11/416,629 ("the '629 application") filed on May 3, 2006. It is directed to a method for using a guide extension catheter with a guide catheter. See, e.g., '116 patent, col. 13 l. 62–col. 14 l. 25. A key portion of a representative method claim from that patent reads as follows: 25. A method, comprising: advancing a distal end of a guide catheter having a lumen through a main blood vessel to an ostium of a coronary artery; ... Id. col. 13 ll. 62–65. According to Teleflex, VSI conceived the claimed inven- tion in early 2005 and then worked to develop it under the "GuideLiner" name. '1343 Decision at *13. In order to

show when it developed the GuideLiner product, Teleflex submitted numerous declarations and documentary exhib- its. Id. Teleflex asserts that what was known as the "rapid exchange" or "RX" version of the GuideLiner, when used, was an embodiment of the '116 patent. Id. at *14. The RX GuideLiner eventually entered the market in 2009. Id. at *24. In 2019, Medtronic launched its own allegedly infring- ing guide extension catheter product, Telescope. Appellee's Br. at 2. Medtronic filed two petitions for inter partes review ("IPR") of the '116 patent. In the '1343 IPR, Medtronic as- serted that claims 52 and 53 were anticipated by Ressemann; 1 claims 25–40, 42, 44–48, 52, and 53 would have been obvious in light of Ressemann and Itou; 2 and claim 45 would have been obvious in light of Ressemann, Itou, and Kataishi. 3 Medtronic asserted that Itou was prior art under pre-AIA § 102(e). However, Teleflex argued that Itou was not prior art because the claimed invention was (1) conceived prior to Itou's filing date of September 23, 2005 (i.e., the critical date), and (2) was either (a) actu- ally reduced to practice before the critical date or (b) dili- gently pursued until its constructive reduction to practice through its effective filing in May 2006. Medtronic did not contest Teleflex's demonstration of conception, '1343 Deci- sion at *14, but challenged Teleflex's alleged showings of both actual reduction to practice and diligence until con- structive reduction to practice. The Board first found that Ressemann anticipated claims 52 and 53, which Teleflex did not dispute and does not appeal. '1343 Decision at *11. It then found that Itou did not qualify as prior art to the '116 patent under pre-AIA

1 U.S. Patent 7,604,612 ("Ressemann"). 2 U.S. Patent 7,736,355 ("Itou"). 3 U.S. Patent Application Publication 2005/0015073 ("Kataishi").

first-to-invent provisions, and that Medtronic had there- fore not shown the other challenged claims to be unpatent- able. Specifically, the Board found that (1) the claimed invention was conceived before the critical date of Itou, id. at *14; (2) the claimed invention was actually reduced to practice before the critical date of Itou, id. at *19–25; and (3) the patent owner diligently pursued work on the inven- tion until its constructive reduction to practice through its effective filing in May 2006, id. at *25. The Board, in part, adopted its analysis from another IPR decision on a related patent, Medtronic, Inc. v. Teleflex Innovations S.Á.R.L., IPR2020-00132, Paper 127 at 58–67 (P.T.A.B. Jun. 7, 2021), where it addressed whether or not Itou qualified as prior art to similar, but apparatus, claims with the same priority date. See '1343 Decision at *25. We have since affirmed that decision. Medtronic, Inc. v. Teleflex Innova- tions S.Á.R.L., Appeal No. 21-2356, 68 F.4th 1298 (Fed. Cir. 2023). Unique to this case, however, was the question whether or not in vivo testing was required for actual re- duction to practice because the claims at issue are method claims reciting "advancing . . . a guide catheter . . . through a main blood vessel to an ostium of a coronary artery." '116 patent, col. 13 ll. 62–65. The Board found that such testing was not required. '1343 Decision at *20. It noted that Med- tronic "was unable to identify any legal precedent requiring in vivo performance of a claimed in vivo method to show actual reduction to practice." Id. It found that, for the chal- lenged claims, "the viability of the claimed method can be verified using a physical model that replicates the anatomy in which the method would likewise be performed in vivo." Id. In the '1344 IPR, Medtronic asserted that the chal- lenged claims would have been obvious over various com- binations of references, including Ressemann, or in light of

Root. 4 The Board first found that the challenged claims would not have been obvious over the asserted combina- tions of references. In particular, it found a lack of motiva- tion to combine the references, '1344 Decision at *14–15, 22–24, as well as a nexus to secondary considerations that weighed in favor of nonobviousness, id. at 15–22. The Board then found that the '116 patent was entitled to the '629 application's priority date, and thus that Root did not qualify as prior art. Id. at *23–24. It therefore found that Medtronic had not shown the challenged claims to be un- patentable. Medtronic appealed. Following the completion of brief- ing in this case, we issued decisions in three cases on re- lated patents with similar claims, the same priority date, and overlapping references: Medtronic, 68 F.4th 1298 ; Medtronic, Inc. v. Teleflex Innovations S.Á.R.L., Appeal No. 21-2357, 70 F.4th 1331 (Fed. Cir. 2023); Medtronic, Inc. v. Teleflex Innovations S.Á.R.L., Appeal No. 21-2359, 69 F.4th 1341 (Fed. Cir. 2021) (collectively, "the previous Med- tronic decisions"). Thereafter, Teleflex filed a Citation of Supplemental Authority, ECF 43, to which Medtronic re- sponded, ECF 44, explaining how, in their views, those de- cisions affected this appeal. We have jurisdiction under 28 U.S.C. § 1295 (a)(4)(A). DISCUSSION Teleflex asserts that the previous Medtronic decisions are

dispositive of most arguments advanced by Medtronic here and that the only issue remaining before this court is whether or not the Board erred in concluding that in vivo testing was not required for an actual reduction to practice. ECF 43 at 1. Medtronic conceded that it would no longer argue much of what it had briefed, instead pursuing

4 U.S. Patent Application Publication 2007/0260219 ("Root").

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arguments only as to whether or not in vivo testing was required and the issue of diligence. ECF 44 at 2. The par- ties therefore agree that many of the arguments briefed in this case, including all challenges to the '1344 Decision, are foreclosed by our previous Medtronic decisions. The only issues potentially remaining relate to Itou's status as prior art: (1) whether or not in vivo testing was required for ac- tual reduction to practice and (2) whether or not the pa- tentee exercised reasonably continuous diligence until constructive reduction to practice. In considering whether or not a reference qualifies as prior art under pre-AIA 35 U.S.C. § 102 (e), we must con- sider whether or not "the invention was described in . . . a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent." A patent owner may antedate an asserted prior art patent by showing conception of the claimed in- vention prior to the critical date and either actual reduction to practice prior to the reference's critical date or "reason- ably continuous diligence" in reducing the invention to practice until its effective filing date. See ATI Techs. v. Iancu, 920 F.3d 1362 , 1369 (Fed. Cir. 2019); Tyco Healthcare Grp. v. Ethicon Endo-Surgery, Inc., 774 F.3d 968 , 975 (Fed. Cir. 2014). Actual and constructive reduc- tion to practice are alternative and independent bases. Therefore, we may affirm on either actual reduction to practice or reasonably continuous diligence until construc- tive reduction to practice without reaching the other issue. Oral Arg. at. 0:30–54, 29:40–29:55 (available at https://cafc.uscourts.gov/home/oral-argument/listen-to-ora l-arguments/); see also Medtronic, 68 F.4th at 1308. For the reasons provided below, we affirm the Board's finding of constructive reduction to practice and do not reach the issue of actual reduction to practice.

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I An asserted prior art reference can be antedated based on a constructive reduction to practice by a showing of (1) conception prior to the filing date of the asserted reference and (2) reasonably continuous diligence from just before the date the asserted reference was filed until the date that the patent owner filed its priority application. Perfect Sur- gical Techniques, Inc. v. Olympus Am., Inc., 841 F.3d 1004 , 1007 (Fed. Cir. 2016) (requiring diligence for the "entire critical period, which begins

just prior to the competing ref- erence's effective date and ends on the date of the inven- tion's reduction to practice"); see also '1343 Decision at *25. Medtronic does not contest that VSI conceived the claimed invention before Itou's filing date. '1343 Decision at *27. However, Medtronic argues that it "preserved" the issue of diligence at page 41 of its opening brief. ECF 44 at 1. That page of its opening brief includes the following two sen- tences on diligence: "In addressing diligence, the Board simply adopted its earlier erroneous diligence analysis in IPR2020-00132. Appx61–62. Therefore, if this Court va- cates the Board's diligence holding in No. 21-2356, it should likewise vacate the Board's decision here." Appel- lant's Br. at 41. We did not vacate the Board's diligence holding in that decision, see Medtronic, 68 F.4th at 1308, so Medtronic's condition precedent has therefore not been met. That statement by Medtronic in its opening brief therefore con- stitutes a clear waiver of its diligence argument. Recogniz- ing that we did not address the issue of diligence in the previous Medtronic decisions, Medtronic nevertheless urges us, in its Response to Teleflex's Citation of Supple- mental Authority, to "decide" "the diligence question briefed at pp. 51-71 of Medtronic's brief in 21-2356." ECF 44 at 1. That is no argument; it is an improper incorpora- tion by reference. "[A]rgument by incorporation . . . is a vi- olation of Fed. R. App. P. 28(a)(6)." Monsanto Co. v. Scruggs, 459 F.3d 1328 , 1335 (Fed. Cir. 2006) (finding

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arguments incorporated by reference from district court memoranda waived). Further, "[i]t would be fundamen- tally unfair to allow a party to use incorporation to exceed word count." Microsoft Corp. v. DataTern, Inc., 755 F.3d 899 , 910 (Fed. Cir. 2014). Medtronic does not contest that its arguments on dili- gence amount to incorporation by reference. Oral Arg. at 1:19–1:50 ("I think we are trying to incorporate by refer- ence."). It argues that, despite that argument being an un- disputed incorporation by reference, it should still be considered because the Board incorporated its analysis by reference. See id. at 1:51–2:33; '1343 Decision at *25. That argument has no merit. The Board is certainly entitled to incorporate by reference analyses from other decisions, but that does not entitle an appellant to violate our rules when it argues before us. Moreover, we have word limits on briefs before this court. We limit principal briefs to 14,000 words, and if a litigant wishes to exceed that limit, it must move to do so. Fed. Cir. R. 32(b)(1). In this case, Medtronic moved to extend the word limit by 6,000 words, for a total of 20,000 words for its principal brief. Appeal No. 22-1605, ECF 21. 5 The motions panel denied that motion, confirming that the opening briefs were "not to exceed 14,000 words." ECF 5. According to its Certificate of Compliance, Medtronic's opening brief

5 Appeal Nos. 22-1605, 22-1606, 22-1721, and 22- 1722 were originally consolidated, with 22-1605 as the lead appeal. Medtronic moved, unopposed, to deconsolidate the cases at the same time it asked for an increased word limit. Appeal No. 22-1605, ECF 21. The motions panel granted that motion to deconsolidate 22-1601 and 22-1602 from 22- 1721 and 22-1722 but left them as companion cases and denied the motion to increase the word limit. ECF 5.

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includes 13,979 words, yet it attempts to incorporate by ref- erence twenty pages from another brief in another case, amounting to over 4,000 extra words. See Appeal No. 21-2356, ECF 20 at 51–71. That is a clear violation of both the motions panel's order and our rules. In pursuing this appeal, Medtronic chose to make cer- tain strategic decisions concerning what material to in- clude in its opening brief, and it affirmatively chose not to include developed arguments on diligence. See, e.g., Mon- santo, 459 F.3d at 1341 ("In order for this court to reach the merits of an issue on appeal, it must be adequately devel- oped."). It cannot now undo those decisions. We therefore consider Medtronic's challenges to the Board's finding of diligence waived. United States v. Olano, 507 U.S. 725 , 733 (1993) ("Whereas forfeiture is the failure to make the timely assertion of a right, waiver is the 'intentional relin- quishment or abandonment of a known right.'" (quoting Johnson v. Zerbst, 304 U.S. 458 , 464 (1938)). Because Medtronic waived any challenges to the Board's diligence finding, and did not contest conception, we affirm the Board's finding that Itou is not prior art to the challenged claims based on VSI's constructive reduc- tion to practice. '1343 Decision at *25. Because we agree with the Board that Itou does not qualify as prior art, we likewise affirm the Board's holdings in its '1343 Decision that Medtronic did not demonstrate by a preponderance of the evidence that the challenged claims of the '116 patent are unpatentable. 6 II Medtronic additionally argues that the Board erred in finding that there was an actual reduction to practice prior to Itou's filing. As we explained above, a patent owner may

6 We do not address the Board's holding of claims 52 and 53 as anticipated, as that finding was not appealed.

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antedate an asserted reference based on prior conception and either actual reduction to practice or constructive re- duction to practice. Here, the Board found that the patent owner had demonstrated both. '1343 Decision at *25. Ap- pellants acknowledge that we can affirm on either issue. Oral Arg. at. 0:30–54 ("The court could affirm on either ac- tual reduction to practice [or constructive reduction to practice]."); id. at 29:40–29:55 ("If you decide that the ar- gument on diligence issue is not before you, then I agree, your honor, that you can affirm the case."). Because we affirm on constructive reduction to practice, we need not reach the issue of actual reduction to practice, including the question of whether or not in vivo testing was required. III Further, because Medtronic dropped its challenges to the Board's other holdings in light of our previous Med- tronic decisions, ECF 44, we likewise affirm the Board's holdings in its '1344 Decision that Medtronic did not demonstrate by a preponderance of the evidence that the challenged claims of the '116 patent are unpatentable. CONCLUSION We have

considered Medtronic's remaining arguments but find them unpersuasive. For the foregoing reasons, the decision of the Board is affirmed. AFFIRMED