

Medtronic's Cautionary Tale Of Fed. Circ. Word Limits

By **Sean Murray and Jeremiah Helm** (January 9, 2024)

The U.S. Court of Appeals for the Federal Circuit recently penalized a party that sought to incorporate material by reference into an appellate brief.

In the Nov. 21 *Medtronic Inc. v. Teleflex Life Sciences Ltd.* decision, the court ruled that Medtronic waived an argument by citing its brief in a related appeal against the same opponent.

The case illustrates the pitfalls facing parties in complex patent cases involving numerous disputed issues that cannot all be addressed within the strict word limits for appellate briefs.

The issue arose during Medtronic's appeal of a decision by the Patent Trial and Appeal Board that Medtronic had not shown that the challenged claims in Teleflex's patent were unpatentable.

Teleflex's patent claimed methods of using a guide extension catheter with a guide catheter. Medtronic petitioned for inter partes review of the patent after Medtronic launched its own guide-extension catheter product under the Telescope brand.

Medtronic argued in the IPR that some of the challenged claims were obvious in view of the Ressemann and Itou patents. However, the board ruled that Itou was not prior art to Teleflex's patent and therefore did not render any of its claims obvious.

Whether Itou qualified as prior art turned on pre-America Invents Act Title 35 of the U.S Code, Section 102(e), which embodies the now-abrogated first-to-invent rule.

Under that provision, a patent owner may antedate a prior-art patent by showing that the claimed invention was conceived before the critical date of the prior patent and by showing either (1) that the claimed invention was actually reduced to practice before that critical date, or (2) that it was constructively reduced to practice before the critical date because the inventors diligently worked on the project until its effective filing date.

Teleflex argued that its patent antedated Itou under both prongs.

The PTAB agreed with Teleflex on both points. In its written decision, the board incorporated its analysis in a related IPR in which Medtronic relied on Itou to challenge a related Teleflex patent containing apparatus claims, rather than a method claims.

The PTAB's analysis in the apparatus-patent IPR was dispositive of both issues in the method-patent inter partes review — i.e., actual reduction to practice and diligence — except for one new argument that Medtronic raised only in the method-patent IPR.

Specifically, Medtronic argued that an actual reduction to practice required in vivo testing because the method claims were directed to "advancing ... a guide catheter ... through a main blood vessel to an ostium of a coronary artery."



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Medtronic's in vivo argument appeared to raise an issue of first impression. However, the PTAB rejected the argument and ruled that the inventors were able to assess the viability of the claimed method using a physical model that replicates the relevant human anatomy.

The board therefore ruled that Teleflex had established both an actual reduction to practice and a constructive reduction to practice before Itou's critical date.

Medtronic appealed the board's final written decision to the Federal Circuit. The appeal was complex. It involved two different IPRs, 24 challenged claims, several prior art references and many disputed issues, including the issue of first impression relating to in vivo testing.

Medtronic therefore petitioned the Federal Circuit for leave to file a brief that exceeded the court's 14,000-word limit by 6,000 words.

The court denied Medtronic's motion, so Medtronic filed a brief consisting of 13,979 words. To comply with the 14,000-word limit, Medtronic was required to make hard choices as to which issues to address in its brief.

Notably, it had to divide its brief between the two IPRs. In the space Medtronic allotted to the IPR involving the Itou reference, Medtronic argued its issue of first impression: that there was no actual reduction to practice before Itou's critical date because the claimed medical-treatment method could only be assessed via in vivo testing.

But Medtronic did not substantively address the diligence issue on which constructive reduction to practice turned. Medtronic had already briefed that issue in connection with its appeal in the IPR of Teleflex's apparatus patent.

Medtronic therefore included the following two sentences on diligence in its brief: "In addressing diligence, the Board simply adopted its earlier erroneous diligence analysis in [the apparatus-patent IPR]. Therefore, if this Court vacates the Board's diligence holding in [that case], it should likewise vacate the Board's decision here."

The Federal Circuit decided the appeal of the apparatus-patent IPR while the appeal of the method-patent IPR was still pending. Unfortunately for Medtronic, it did not vacate the board's diligence finding or even address the diligence issue in its opinion.

The court found that the apparatus invention had been actually reduced to practice before Itou's critical date and therefore never reached constructive reduction to practice or the subsidiary issue of diligence.

In the still-pending method-patent appeal, Medtronic urged the Federal Circuit to address and decide the diligence issue. To support its position, Medtronic referred the court to 20 pages of its brief in the apparatus-patent appeal.

The Federal Circuit refused to consider the diligence issue. It ruled that Medtronic had waived its diligence argument by failing to include a developed argument in its brief. The court considered the two sentences in Medtronic's brief to be "no argument" but rather "an improper incorporation by reference."

In the court's view, Medtronic was attempting to circumvent the court's 14,000-word limit by seeking "to incorporate by reference twenty pages from another brief in another case, amounting to over 4,000 extra words." The court ruled that Medtronic had made strategic decisions about what material to include in its opening brief, and that it could not undo

those decisions.

The Federal Circuit's waiver decision had harsh consequences for Medtronic. Because Medtronic had waived any argument on diligence, the court ruled that Teleflex had established a constructive reduction to practice.

Then, because the court found a constructive reduction to practice, it declined to reach Medtronic's argument that there was no actual reduction to practice. The court therefore never addressed Medtronic's issue of first impression regarding whether in vivo testing was required for an actual reduction to practice.

The Federal Circuit's Medtronic decision will keep appellate lawyers up late at night. But it is also instructive.

When appealing a case involving too many issues to address within the Federal Circuit's word limit, it can sometimes make sense to omit an issue that will be addressed in a parallel, co-pending appeal against the same party. If you prevail on the issue in the parallel appeal, the issue will be collateral estoppel in your appeal.

On the other hand, if you lose on the issue in the parallel appeal, you likely would have lost in your appeal, so there is little downside to omitting the issue.

But Medtronic demonstrates that this strategy is risky, particularly where the appellate court can resolve the parallel appeal without reaching the common issue. But is it riskier than filing a brief that addresses every issue poorly? Lawyers may soon turn to generative AI engines to calculate which appellate strategy is the least risky.

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