Nos. 2021-2356, -2358, -2361, -2363, -2365

United States Court of Appeals for the Federal Circuit

MEDTRONIC, INC., MEDTRONIC VASCULAR, INC.,

Appellants,

v.

TELEFLEX INNOVATIONS S.A.R.L.,

Appellee.

Appeals from the United States Patent and Trademark Office, Patent Trial and Appeal Board, in Nos. IPR2020-00126, IPR2020-00128, IPR2020-00132, IPR2020-00135, IPR2020-00137

APPELLEE'S COMBINED RESPONSE TO PETITION FOR PANEL REHEARING AND REHEARING EN BANC

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August 17, 2023

CERTIFICATE OF INTEREST

Counsel for Appellee Teleflex Innovations S.à r.l. certifies the following:

1. **Represented Entities.** Fed. Cir. R. 47.4(a)(1). Provide the full names of all entities represented by undersigned counsel in this case.

Teleflex Innovations S.à r.l.

2. **Real Party in Interest**. Fed. Cir. R. 47.4(a)(2). Provide the full names of all real parties in interest for the entities. Do not list the real parties if they are the same as the entities.

Teleflex Life Sciences Limited; Vascular Solutions LLC; Arrow International LLC; Teleflex LLC

3. **Parent Corporations and Stockholders**. Fed. Cir. R. 47.4(a)(3). Provide the full names of all parent corporations for the entities and all publicly held companies that own 10% or more stock in the entities.

Teleflex Incorporated

4. **Legal Representatives**. List all law firms, partners, and associates that (a) appeared for the entities in the originating court or agency or (b) are expected to appear in this court for the entities. Do not include those who have already entered an appearance in this court. Fed. Cir. R. 47.4(a)(4).

Dennis C. Bremer - CARLSON, CASPERS, VANDENBURGH & LINDQUIST, P.A.

Kenneth E. Levitt – DORSEY & WHITNEY LLP

5. **Related Cases**. Provide the case titles and numbers of any case known to be pending in this court or any other court or agency that will directly affect or be directly affected by this court's decision in the pending appeal. Do not include the originating case number(s) for this case. Fed. Cir. R. 47.4(a)(5). See also Fed. Cir. R. 47.5(b).

QXMedical, LLC v. Vascular Solutions, LLC,
No. 0:17-cv-01969 (D. Minn.)

Medtronic, Inc. v. Teleflex Innovations S.à r.l.,
Nos. 2021-2357, -2360, -2364

Medtronic, Inc. v. Teleflex Life Sciences Limited
Nos. 2022-1605, 22-1606, 22-1721, 22-1722

Vascular Solutions LLC, et al. v. Medtronic, Inc., et al., No. 0:19-cv-01760 (D. Minn.)

Medtronic, Inc. v. Teleflex Innovations S.à r.l.,
Nos. 2021-2359, -2362, -2366 (Fed. Cir.)

6. Organizational Victims and Bankruptcy Cases. Provide any information required under Fed. R. App. P. 26.1(b) (organizational victims in criminal cases) and 26.1(c) (bankruptcy case debtors and trustees). Fed. Cir. R. 47.4(a)(6).

None.

Date: August 17, 2023

/s/ *J. Derek Vandenburgh*
J. Derek Vandenburgh

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INTRODUCTION

Medtronic has not shown that this case merits rehearing or rehearing *en banc*. The majority decision faithfully applied this Court's precedents, correctly concluding that substantial evidence supported the Board's fact-finding that Teleflex reduced its GuideLiner invention to practice prior to the critical date.

Medtronic first argues that, while there was evidence of testing, it was not specifically "comparative" testing. Medtronic ignores that the type and amount of testing needed is a fact question to be decided by the fact-finder. The Panel decision correctly declined to require a specific type of testing as a matter of law, instead properly deferring to the Board's fact-findings that the qualitative testing performed by the inventors was sufficient given the nature of the invention and what was already known in the art.

Medtronic second argues that Teleflex provided no independent corroboration of testing before the critical date. That is incorrect. As the majority explained, the record contains substantial corroborating evidence, including testimony from non-inventors Erb and Schmalz and additional independent documentary evidence. Such evidence is more

than sufficient under the rule of reason to corroborate the testimony of the inventors regarding testing of a relatively simple invention.

The Panel decision did not provide a "new reduction-to-practice standard." Pet. 3. Rather, it applied existing law. Nor does the decision mean that a patentee may rely exclusively on "self-serving inventor testimony, without any independent corroboration of successful testing." *Id.* To the contrary, the Panel decision expressly required non-inventor corroboration and identified at least five independent pieces of evidence supporting the Board's finding that the inventors' testimony was credible.

The Panel decision is highly fact-specific, squarely in-line with existing reduction to practice law, and does not raise any broader question of exceptional importance. Medtronic's requests for panel rehearing and rehearing *en banc* should be denied.

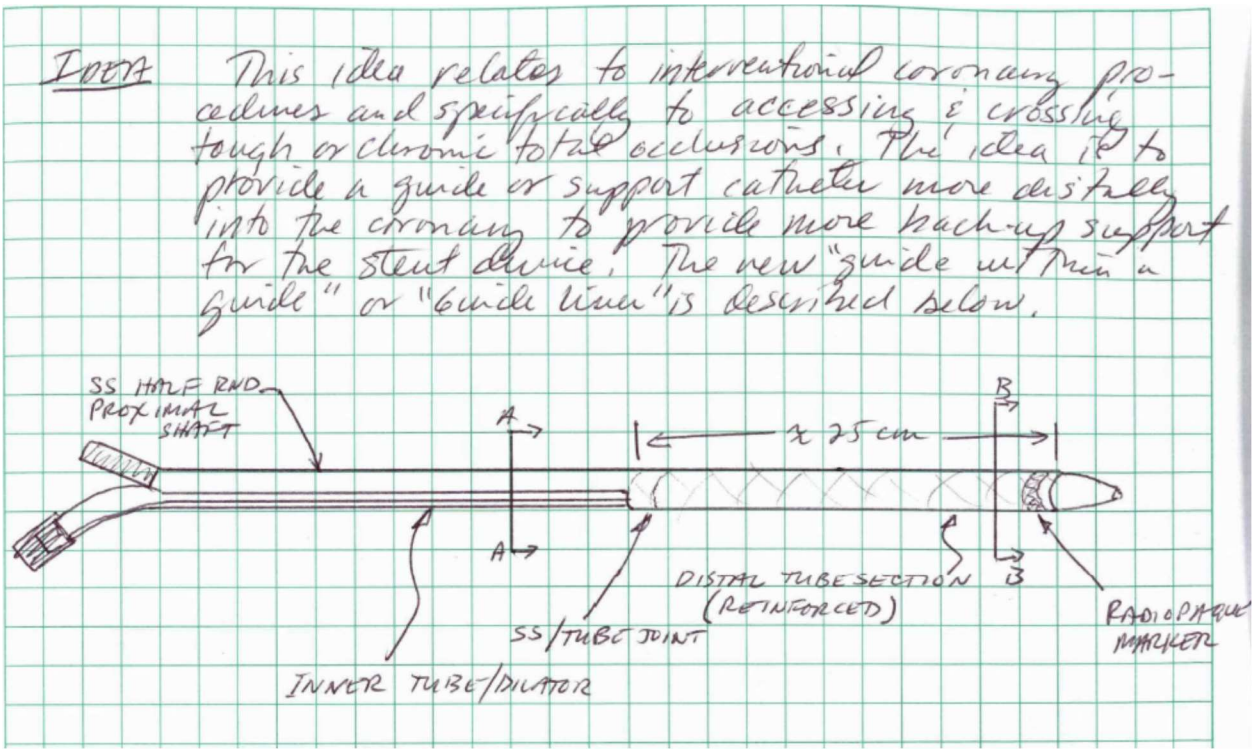
COUNTERSTATEMENT OF THE BACKGROUND

A. Conception

At the time of the invention, the inventors were aware of the existing "mother-and-child" technique for increasing backup support. Appx11807-11808(¶¶5-6); Appx9639(38:10-39:7). This known approach

involved inserting a second, slightly smaller ("child") guide catheter through the main ("mother") guide catheter and partway out the distal end of the main guide catheter into the coronary artery. *E.g.*, Appx12402-12409; Appx12010(¶20). As discussed in the patents-in-suit, this technique was known to provide increased backup support during interventional cardiology procedures. Appx394(2:17-44); Appx12401-12406(¶¶60-63). However, it suffered from various problems associated with use of a full-length child catheter. Appx394(2:34-44)*; see also* Appx12405-12409.

The inventors conceived of an invention that would provide the benefit of the mother-and-child technique (improved backup support) in the same manner but without the associated problems. *See, e.g.*, Appx9639(38:10-41:2). Instead of a full-length inner "child" catheter, the invention employed a "rapid exchange"-type inner catheter having a short distal tubular portion connected to a relatively stiff wire-like proximal shaft. This conception is reflected, *inter alia*, in inventor Sutton's January 4, 2005, notebook:



Appx9585; Appx382(Fig.2).

Medtronic tries to muddy the waters by referencing a second "over-the-wire" ("OTW") GuideLiner product. Pet. 6. That was not a "conception" in the legal sense of being a second invention. Rather, it was simply a full-length "child" inner catheter product intended to be used in the known mother-and-child technique. Appx11816-11817(¶19); Appx394(2:17-44). While VSI (Teleflex's predecessor) initially planned to *commercialize* the known OTW version first, the focus of the *development* work from January to August 2005 was on the new rapid

exchange invention claimed in the patents-in-suit. Appx9877-9879(¶¶4-7); Appx11998-12003.

B. Actual Reduction to Practice

The evidence showed that beginning immediately after conception, the inventors and others at VSI began building rapid exchange prototypes for "proof of concept" testing. *E.g,* Appx11997-12001(¶¶1-11); Appx11814-11815, Appx11818-11819(¶¶15-16, 23-24). The inventors then tested the rapid exchange prototypes in two- and three-dimensional heart models commonly used in the industry. Appx11815-11816, Appx11828-11829, Appx11834(Root Decl. ¶¶17-18, 38, 47); Appx11980-11983(Sutton Decl. ¶¶37-38, 41); Appx5547-5549(100:18-102:13, 105:18-24, 106:9-13); *see also* Appx12010-12013(Keith Decl.). The inventors inserted a standard guide catheter into the heart model, advanced the rapid exchange GuideLiner prototype into the standard guide catheter until the distal end extended out of the guide catheter and into the model artery, and then delivered stents and balloon catheters into that model artery via the combination of standard guide catheter and rapid exchange GuideLiner. *Id.* The inventors also performed pull-tests. *Id.* This testing confirmed that the invention

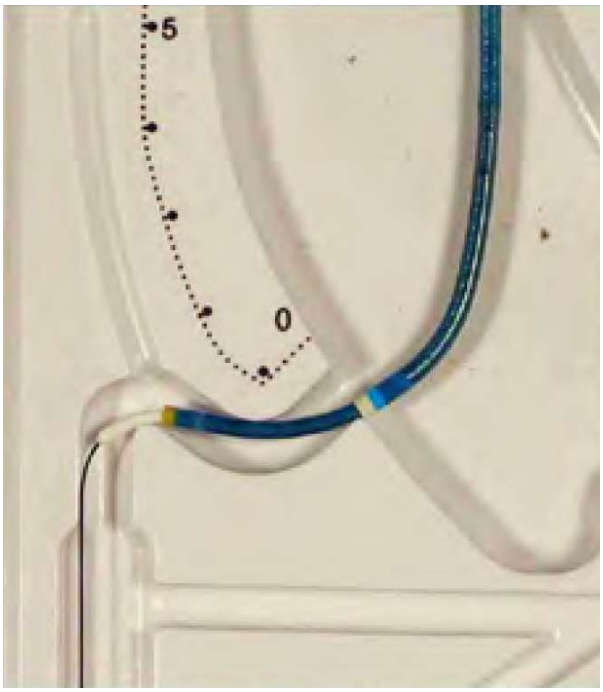
worked to effectively deliver stents and balloon catheters "while providing increased backup support." Appx11834(Root Decl. ¶47); *see also* Appx11983(Sutton Decl. ¶41).

Undisputed evidence also showed that GuideLiner provided backup support in the same way as the known mother-and-child technique (inserting a distal tubular portion partway past the end of the standard guide catheter and deeper into the coronary artery). *E.g.*, Appx397(7:65-8:5); Appx12010-12011(¶20); Appx11626(110:20-111:24); Appx13892(95:20-23). Therefore, the inventors did not need specific comparative testing to know that the rapid exchange GuideLiner invention would likewise provide improved backup support over a guide catheter alone. Appx12010-12012(Keith Decl.). To the extent any testing was needed, it would be merely to confirm that a stent or balloon catheter could inserted into and through the GuideLiner's distal tubular portion while inside a standard guide catheter. Appx12010-12012(¶¶20-22); Appx11815-11816, Appx11828-11829, Appx11834(¶¶17-18, 38, 47); Appx11980-11983(¶¶37-38, 41).

Finally, the record included substantial evidence corroborating the inventors' testimony regarding testing, including:

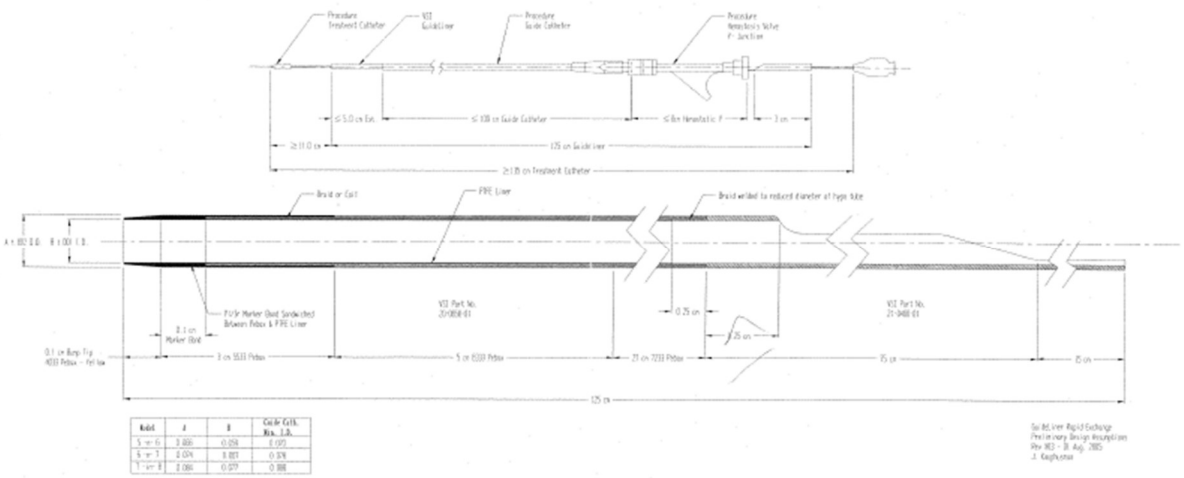
- Testimony from non-inventor Erb, for example that he "worked on the early GuideLiner prototypes," including the "first rapid exchange Guide-Liner prototypes in early 2005"; that "[t]hese prototypes were then tested, including for durability . . . and for functionality in two-dimensional benchtop heart models," which informed the team that "it would work"; that he was personally involved in testing early prototypes, was aware that the same kind of testing was performed on later prototypes, and recalls watching the inventors perform testing; and that "[w]henever a prototype was constructed at Vascular Solutions, it was typical that testing immediately followed". Appx11999-12002; *see also* Appx5202-5203, Appx5206-5207(48:5-50:7; 62:3-19; 66:25-69:13).
- Testimony from non-inventor Schmalz, for example that she "specifically recall[ed] that a working prototype of the rapid exchange version of GuideLiner was created" prior to August 24, 2005 and that certain regulatory documents (dated before the critical date) would not have been created if the product had not already been sufficiently tested to show it worked. Appx9878-9879.

- Invoices and other documentary evidence showing that VSI ordered specialized components for the rapid exchange GuideLiner prototypes, in a timeframe consistent with the testimony regarding testing (April-July 2005). *E.g.,* Appx37-51; Appx9592-9597; Appx11468- 11471; Appx11592-11593, 11595; Appx9616-9618; Appx9619-9623; Appx11980(¶37); Appx9709-9711.
- A photograph of a benchtop testing model in a July 2005 presentation (containing an OTW GuideLiner). Appx9723-9725; Appx11828-11829(¶38).



(Appx9723 (cropped))

- A complete GuideLiner schematic from August 2005 showing VSI had moved beyond prototyping, independently linked to the rapid exchange GuideLiner by document title and part number:



Compare Appx9751-9752 *with* Appx9749-9750; Appx11480-11484 (earlier prototyping drawings); Appx11835(¶49); Appx11981(¶39).

C. The Board Proceedings

The Board reviewed the trial evidence and—in a thorough twenty-six page analysis—found Teleflex had sufficiently shown that the GuideLiner was reduced to practice before the critical date. Appx36-62.

The Board first noted that Medtronic's arguments against Teleflex's testing depended on its narrower intended purpose of treating

"tough lesions," which purpose the Board rejected. Medtronic's arguments failed for that reason. Appx57-58.

The Board next found that the testing evidence, though "more qualitative than quantitative," was sufficient to demonstrate that GuideLiner worked for the broader intended purpose of increasing backup support. Appx43-44; Appx55-59. The Board found that "[t]his is not a situation where there were significant variables or uncertainties that needed to be assessed in order to determine whether the RX device would work properly, and thus the 'qualitative testing' done by VSI . . . was sufficient." Appx58-59. The Board also cited expert testimony that testing of the type the inventors conducted would have been sufficient. Appx54 (citing Appx12012(¶22)).

Finally, the Board found sufficient corroboration of the inventors' testimony under the rule of reason. Appx57-62. Corroborating evidence included both testimony from non-inventors (such as Erb and Schmalz) and independent documentary evidence. Appx48-49; Appx57-62.

D. The Panel Decision

Regarding testing, the majority concluded that the trial evidence was "sufficient to show that the claimed invention worked for its

intended purpose as determined by the Board." Op. 9. Both inventors testified that the prototypes were tested, and the tests "were sufficient to enable the inventors to confirm that the prototype would work for its intended purpose." Op. 10. The majority also cited expert testimony explaining that "actual reduction to practice of the GuideLiner invention would have required little if any testing." *Id.* It also noted that the same would be true of the broader intended purpose also supported by the record (merely serving as a guide extension catheter). *Id.*

Regarding corroboration, the majority cited existing precedent for the propositions that, under the rule of reason, corroborative evidence (1) "simply needs to be sufficient to support the credibility of the inventors' story"; (2) "can come from documentary evidence, non-inventor testimony, or a combination of both"; and (3) "may also be circumstantial." Op. 11. The majority found the corroborating evidence more than sufficient, pointing to the testimony of non-inventors Erb and Schmalz as well as independent documentary evidence. Op. 11-13.

ARGUMENT

A. Medtronic's Petition for Panel Rehearing Should Be Denied

The majority decision applied well-settled law and properly deferred to the Board's fact-findings as supported by substantial evidence. Medtronic's Petition does not identify any points of law or fact that the majority overlooked or misapprehended, as required for rehearing, but instead merely rehashes its appeal arguments. There is no reason to rehear this appeal and the Court should reject Medtronic's request.

1. The Majority Correctly Affirmed the Board's Fact-Finding That the Testing Was Sufficient

Medtronic contends that this Court should have imposed, as a matter of law, a rigid requirement for *comparative* testing, regardless of whether the record indicated this specific type of testing was necessary for this invention. Pet. 12. The majority's decision not to impose that requirement and instead defer to the Board's well-supported fact-findings was legally correct.

The type and sufficiency of testing, including whether testing is required at all, are questions of fact. Op. 9 (citing *z4 Techs., Inc. v.*

Microsoft Corp., 507 F.3d 1340, 1352 (Fed. Cir. 2007); *Scott v. Finney*, 34 F.3d 1058, 1061–62 (Fed. Cir. 1994)). Medtronic does not dispute this law.

The majority correctly affirmed the Board's fact-finding that VSI's testing was sufficient in the context of the art and the particular invention. The majority and the Board noted that inventors testified in detail regarding the testing they performed, including confirming they delivered stents and balloon catheters into the proximal opening of the rapid exchange GuideLiner prototype, and then through the GuideLiner's distal tubular portion and out into the model artery, while the GuideLiner was inside the standard guide catheter. Op. 10; Appx44-45 (citing, *e.g.*, Appx11815, Appx11834, Appx11971, Appx11982–11983). The inventors also assessed the forces exerted on the prototype and the durability of the device during these tests. Op. 10. Inventor testimony explained that these tests allowed the inventors to "further confirm" that the GuideLiner invention would "facilitate the delivery of balloon catheters and stents deep into coronary arteries while providing increased backup support." Appx11834(Root Decl. ¶47); *see also* Appx11983(Sutton Decl. ¶41).

Both the majority and the Board also credited testimony from Teleflex's expert that, given the relative simplicity of the invention and the knowledge in the art, little if any testing would have been required. Op. 10 (citing Appx12010-12012 (Keith Decl.)); *see also* Appx54. Regarding increased backup support, the cited expert testimony explained that "because mother-in-child procedures already were understood to provide back-up support, testing would not have been necessary to understand that a rapid exchange GuideLiner prototype would work for that purpose." Appx12010. Indeed, it was undisputed that mother-in-child was known to improve backup support (*e.g.*, Appx394(2:17-44)) and that, with respect to backup support, GuideLiner operates under the same principles (*e.g.*, Appx397(7:65-8:5); Appx12010-12011(¶20); Appx11626(110:20-111:24); Appx13892(95:20-23)). As the Board reasonably concluded, "[t]his is not a situation where there were significant variables or uncertainties that needed to be assessed in order to determine whether the RX device would work properly . . . ." Appx58-59; *see also Scott,* 34 F.3d at 1062 ("A certain amount of 'common sense' must be applied in determining the extent of

testing required. . . . where the invention is sufficiently simple, mere construction or synthesis of the subject matter may be sufficient . . . .").

Medtronic cites the dissent's contention that "[o]n their face, the [inventors'] tests do not relate to whether the prototypes provided increased backup support." Diss. 3-4, n.5. But that *assumes* such comparative testing was required as a matter of law. As explained above, the sufficiency of testing is a question of fact. Medtronic entirely *ignores* the record evidence discussed above showing that the testing the inventors did was more than sufficient to assure them that the GuideLiner would work to deliver stents and balloon catheters with "increased backup support." *See also Scott*, 34 F.3d at 1063 (not necessary to test aspects of the invention already known to work). There is no "disconnect" between the inventors' testing and the testing needed to show the GuideLiner would work for its intended purpose. Rather, the evidence shows the inventors did exactly what they needed to do—given their knowledge and the knowledge in the art—to confirm the invention would work.

The majority decision is also not an outlier. In many cases this Court has affirmed actual reduction to practice with less testing

evidence. For example, *Mahurkar v. C.R. Bard, Inc.* found flow and pressure drop testing in an inventor's kitchen sufficient for a dual lumen catheter invention. 79 F.3d 1572, 1578 (Fed. Cir. 1996). *Scott* found inflation/deflation testing sufficient for a penile implant invention. 34 F.3d at 1063. *In re Asahi/America Inc.* held that no testing was required to establish reduction to practice of a pipe coupling system invention. 68 F.3d 442, 446-447 (Fed. Cir. 1995).

Medtronic's only case, *z4 Techs., Inc.*, 507 F.3d at 1352-1353, is inapplicable. First, *z4* concerned different facts in a different field—whether a feature of Microsoft's "BP 98" software product reduced to practice a claimed anti-piracy software invention. *Id.* at 1351-53. Second, *z4* was merely analyzing whether sufficient evidence supported a jury verdict, not establishing a new rule requiring comparative testing as a matter of law.

The majority's decision does not undermine the reduction-to-practice requirement that an invention be shown to work for its intended purpose. *See* Pet. 15. Rather, the majority unremarkably concluded that substantial evidence supported the Board's finding that the testing was sufficient to allow the inventors to understand that

GuideLiner worked for its intended purpose. There was no "legal error."

2. The Majority Correctly Affirmed the Board's Fact-Finding That There Was Sufficient Corroboration Under the Rule of Reason

Medtronic also contends that the majority "legally erred" because it allowed corroboration of assembly to stand in for corroboration of testing. Pet. 15. Medtronic is wrong.

The sufficiency of corroborating evidence is evaluated under a "rule of reason," which considers all pertinent evidence. *Cooper v. Goldfarb*, 154 F.3d 1321, 1330 (Fed. Cir. 1998). Corroborating evidence need not be direct—under the rule of reason it may be circumstantial. *Id*. Nor is it necessary that every individual aspect of reduction to practice be corroborated. *E.I. du Pont de Nemours & Co. v. Unifrax I LLC*, 921 F.3d 1060, 1077 (Fed. Cir. 2019). Instead, corroborative evidence "simply needs to be sufficient to support the credibility of the inventors' story." Op. 11 (*citing E.I. du Pont*, 921 F.3d at 1077). That is exactly the situation here. The majority correctly held that the Board's finding was supported by substantial evidence. Op. 11-14.

First, non-inventor Erb, a former VSI Research & Development Technician, provides corroborating testimony. Op. 11-12. Medtronic contends that the testing Erb discusses either involves prototypes that Teleflex does not claim reduced the invention to practice or does not specify timing, and that Erb was not "personally involved" in the testing. Pet. 16. Medtronic's criticisms fail. The initial prototypes had the basic elements of the GuideLiner invention, i.e., a proximal rail structure attached to a short distal tubular portion with an angled transition in-between (Appx12001(¶¶10-11); Appx11814-11816(¶¶16-18)), and their successful testing corroborates the evidence that later prototypes were also promptly tested and worked. Further, Erb's testimony provides additional evidence corroborating the inventors' testimony that the prototypes were tested before the critical date because evidence showed GuideLiner prototypes were made by April and July 2005, and Erb testified that "[w]henever a prototype was constructed at Vascular Solutions, it was typical that testing immediately followed". Appx12001-12002. Finally, Erb expressly testified that he recalls "watching Howard Root and others working in R&D test" those prototypes and that they "knew from our early testing

of prototypes of the device that it would work." *E.g.*, Appx12002(¶¶12-13). That Erb did not personally test later prototypes does not mean his testimony cannot corroborate. Indeed, an "actual over-the-shoulder observer" is not required. *Cooper*, 154 F.3d at 1330. But Erb testified that he *was* an over-the-shoulder observer; he simply did not personally perform the tests. It is not contrary to law for the factfinder to credit Erb's testimony as corroborating the inventors' testimony that they tested the prototypes immediately after they were assembled in April and July 2005.

Second, non-inventor Schmalz, VSI's former VP of Regulatory and Clinical Affairs, provided corroborating testimony that she "specifically recall[ed] that a ***working*** prototype of the rapid exchange version of GuideLiner was created" prior to the creation of an August 24, 2005 Products Requirements document. Op. 12 (citing Appx9878-9879 (emphasis added)). Medtronic faults this testimony because Schmalz "claimed no first-hand knowledge of any ***testing*** and did not describe any testing purportedly performed." Pet. 17 (emphasis in original). Again, the law does not require over-the-shoulder observation. *Cooper*, 154 F.3d at 1330. It is not contrary to law for the factfinder to credit

Schmalz's independent recollection of a "working" GuideLiner prototype before the critical date as corroborating the inventors' testimony that they determined the GuideLiner worked for its intended purpose prior to the critical date.

Third, corroborating documentary evidence shows VSI ordered specialized components in the first half of 2005 with dimensions consistent with engineering drawings specific to the rapid exchange GuideLiner. Op. 12 (citing evidence); *see also* Appx37-51. Medtronic contends that this evidence says nothing about testing. Pet. 18. Again, Medtronic ignores the rule of reason—corroborating evidence can be circumstantial. *Cooper*, 154 F.3d at 1330. And again, there is nothing legally wrong with allowing the fact-finder to credit independent evidence showing that prototypes were created close in time to when the inventors testified that they tested the prototypes as further corroborating the inventors' testimony. *E.g., Loral Fairchild Corp. v. Matsushita Elec. Indus. Co.*, 266 F.3d 1358, 1364-65 (Fed. Cir. 2001) (relying on purchase of prototype components to corroborate testing).

Fourth, a July 2005 sales presentation has a photograph of a benchtop testing apparatus like the one the inventors testified about.

Appx9723-9725; Appx11828-11829(¶38). Medtronic notes that the photograph shows an OTW GuideLiner device (not a rapid exchange GuideLiner) in the testing apparatus, and faults the majority for concluding that this benchtop model "could have been used" to also test the rapid exchange GuideLiner prototype. Pet. 18. Again, corroborating evidence may be circumstantial. Allowing the fact-finder to credit independent evidence confirming a benchtop model for testing a device like the GuideLiner existed and was in use at VSI in July 2005 as corroborating the inventors' testimony that they tested the GuideLiner on such a device during that time period is not contrary to law.

Fifth, an August 2005 CAD schematic showed a complete rapid exchange GuideLiner prototype. Appx9751-9752. As the majority noted, this document further corroborates the inventors' testimony that they had moved beyond prototyping and testing by that time (August 2005). Op. 13. Medtronic contends that nothing in the drawing indicates testing, but again, corroboration can be circumstantial. It is not contrary to law to conclude that a document that is more detailed and of a different type than earlier drawings used to order prototype

components corroborates inventor testimony that they had completed confirmatory testing by that time.

The majority's decision follows this Court's precedents. It does not "excuse" the requirement that inventors' testimony be corroborated, nor does it "remove[] the guardrail" of the corroboration requirement. To the contrary, it applies the corroboration requirement (Op. 11), identifies at least five pieces of independent corroborating evidence supporting the Board's decision, and then properly defers to the Board's fact-finding (Op. 11-14). Further, Medtronic now does not dispute that the GuideLiner prototypes were assembled well before the critical date, and record evidence showed that once the prototypes were fully assembled little to no testing would have been required to confirm they would work for their intended purpose. Appx12010-12012 (Keith Decl.); *see also* Op. 10, Appx54. Thus applying a heightened corroboration requirement for testing would be particularly inappropriate in this case.

The cases Medtronic cites are not to the contrary. In *In re Garner*, this Court affirmed the Board's fact-finding of insufficient corroboration of reduction to practice because the only independent evidence was a one-page declaration from an individual who testified he saw the device

sitting in a laboratory. 508 F.3d 1376, 1311 (Fed. Cir. 2007). This case is both procedurally and factually different—here, the majority affirmed the Board's fact-finding of sufficient corroboration based on at least five separate sources of corroborating evidence. *Brown* is likewise inapplicable—unlike here, the sole allegedly-corroborating independent evidence in *Brown* was a witness who provided no testimony regarding any testing that practiced the invention. *Brown v. Barbacid,* 276 F.3d 1327, 1336-37 (Fed. Cir. 2002).

B. Medtronic's Petition for Rehearing En Banc Should Be Denied

Disagreement with a panel's decision is not sufficient reason for *en banc* review. *Apple Inc. v. Samsung Elecs. Co., Ltd*., 839 F.3d 1034, 1086 (Fed. Cir. 2016). *En banc* review is generally reserved for "actual conflicts between precedential cases and for cases of exceptional importance." *Id.* Neither prerequisite exists here.

First, there is no conflict between or with precedential cases. Medtronic's Statement of Counsel asserts that the majority decision is contrary to three precedents, but its petition does not explain how or why. The panel decision is not, in fact, contrary to those cases. *Scott*

held that a minimal level of testing—inflation/deflation of the device—was sufficient to show reduction to practice. 34 F.3d at 1063. *Cooper* held that testimony from co-workers that the inventor told them about his reduction to practice was sufficient corroboration. 154 F.3d at 1330-1331. And Teleflex fully explained why *Brown* is factually inapposite above and in its appeal brief. Dkt. 26 at 58.

Second, Medtronic does not explain why the purported comparative testing and corroboration issues raise questions of exceptional importance, and they do not. The majority decision merely applies settled law to the particular facts of this case. *See* Op. 9 (citing *z4 Techs.*, 507 F.3d at 1352 and *Scott*, 34 F.3d at 1061-62 for the settled proposition that the type and amount of testing (and whether testing is required at all) is a question of fact); Op. 11 (citing *Loral*, *Cooper*, and *E.I. du Pont* for the settled propositions that, under the rule of reason corroborating evidence can come from any independent evidence, including circumstantial evidence, and need only be sufficient to support the credibility of the inventor). This case is nothing more than routine application of settled law to an extensive factual record, and the rehearing *en banc* request should be denied.

Dated: August 17, 2023

Respectfully submitted,

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CERTIFICATE OF COMPLIANCE
WITH TYPE-VOLUME LIMITATIONS

I, J. Derek Vandenburgh, certify that the foregoing document was prepared using a proportionally spaced typeface and contains 3,889 words, thereby complying with the type-volume limitations of the Federal Rules of Appellate Procedure and the Federal Circuit Rules.

Dated: August 17, 2023

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