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# Praxis

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## Federal Circuit Report

**Benjamin Ediger and  
Amol Parikh**

### Wave Goodbye: Arguments Incorporated by Reference Are Waived

The US Court of Appeals for the Federal Circuit recently affirmed the Patent Trial & Appeal Board's patentability determination, finding that the patent challenger waived an argument it attempted to incorporate by reference to another brief. *Medtronic, Inc. v. Teleflex Life Scis. Ltd.*, Case No. 2022-1721 (Fed. Cir. Nov. 16, 2023) (Lourie, Prost, Chen, JJ.)

### Background of the Case

Teleflex owns a patent directed to a method for using a guide extension catheter with a guide catheter. Medtronic challenged the patent in two *inter partes* review (IPR) proceedings, arguing that certain claims were obvious in light of Ressemann and Itou and that another claim was obvious in light of Ressemann, Itou and Kataishi. Teleflex argued that Itou was not prior art because the claimed invention was conceived prior to Itou's filing date and was either actually reduced to practice before the critical date or diligently

pursued until its constructive reduction to practice date. Medtronic did not contest Teleflex's demonstration of conception but instead challenged Teleflex's alleged showings of both actual reduction to practice and diligence until constructive reduction to practice.

### The Board Decision

The Board ultimately found that Itou did not qualify as prior art and that Medtronic therefore had not shown that the challenged claims were unpatentable. One of the issues before the Board was whether *in vivo* testing was required for actual reduction to practice because the claims at issue were method claims reciting "advancing . . . a guide catheter . . . through a main blood vessel to an ostium of a coronary artery." The Board ultimately found that no such testing was required, explaining that Medtronic "was unable to identify any legal precedent requiring *in vivo* performance of a claimed *in vivo* method to show actual reduction to practice." According to the Board, actual reduction to practice could "be verified using a physical model that replicates the anatomy in which the method would likewise be performed *in vivo*." Medtronic appealed.

Medtronic challenged the Board's determination regarding constructive

reduction to practice, arguing as follows:

In addressing diligence, the Board simply adopted its earlier erroneous diligence analysis in IPR2020-00132. Appx61–62. Therefore, if this Court vacates the Board's diligence holding in No. 21-2356, it should likewise vacate the Board's decision here. Appellant's Br. at 41.

### The Court Ruling

The Federal Circuit explained that it did not vacate the diligence holding in the prior decision, so Medtronic's condition precedent had not been met. Medtronic nevertheless urged the Court to decide the diligence question. The Court refused, finding that Medtronic improperly incorporated by reference an argument from another brief. The Court explained that it would be fundamentally unfair to allow Medtronic to use incorporation by reference to exceed the word limit on briefs. The Court observed that parties pursuing appeals must make certain strategic decisions concerning what material to include in their opening briefs, and here, Medtronic affirmatively chose not to include developed arguments on diligence. The Court therefore found that Medtronic waived its challenge to the Board's diligence finding. With the diligence issue waived and conception stipulated, the Court affirmed the Board's determination that Itou was not prior art with respect to the challenged patent.

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