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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

CARDIOCOM, LLC
Petitioner

v.

ROBERT BOSCH HEALTHCARE SYSTEMS, INC.
Patent Owner

Case IPR2013-00431 (Patent 7,921,186)
Case IPR2013-00449 (Patent 7,840,420)
Case IPR2013-00468 (Patent 7,516,192)

PETITIONER CARDIOCOM, LLC'S MOTION TO COMPEL ADDITIONAL DISCOVERY FROM PATENT OWNER ROBERT BOSCH HEALTHCARE SYSTEMS, INC.

Pursuant to 35 U.S.C. § 316(a)(5) and 37 C.F.R. § 42.51(b)(2), Petitioner Cardiocom moves for "Additional Discovery" from Patent Owner Bosch in the form of (1) an identification of two "Bosch personnel" relied upon by Bosch's expert Dr. Yadin David in declarations arguing for the patentability of Bosch's claims and (2) depositions of the Bosch personnel and inventor Stephen Brown.

Dr. David interviewed the Bosch personnel and Mr. Brown to form the factual basis for his opinions related to purported objective indicia of nonobviousness. (*See, e.g.,* David Declaration ("David Dec."), IPR2013-00431 at ¶¶ 18(g) and 61.) For example, Dr. David relies on the Bosch personnel to conclude the Health Buddy product was commercially successful and well-received "when it was released" in 1999 and thereafter. (*See, e.g.,* David Dec., IPR2013-00431 at ¶¶63-67; *see also id.* at ¶¶ 71 and 73 concerning commercial success, Section Heading VIII.B at p. 31 concerning long-felt need, and ¶¶ 92-93 concerning copying. Further, the same statements can be found in Dr. David's declarations in IPR2013-00449 and IPR2013-00468.)

Dr. David essentially repeated the words of these individuals and used their conclusory statements as objective indicia in his declarations. In the interests of justice, Cardiocom thus should be allowed to identify and depose the individuals to show their statements are not supported by the underlying facts and lack the required nexus to the challenged claims.

Additional Discovery is warranted where the moving party can meet its burden of showing "that such additional discovery is in the interests of justice." 37 CFR 42.51(b)(2)(i). The Board's holding in *Garmin v. Cuozzo* provides the five factors to assess whether a request for Additional Discovery meets the interests of justice standard. IPR2012-00001, Paper No. 26 at 6-7 (PTAB Mar. 5, 2013). The Board has held that Additional Discovery is "per se useful" where a party proffers expert testimony relying upon the information about which discovery is sought to support the invalidity of challenged claims. *Corning Inc. v. DSM IP Assets B.V.*, IPR2013-00043, Paper 27 at 4 (PTAB June 21, 2013).

1. Cardiocom's Request Will Lead to Useful Information Discrediting the Statements Relied Upon by Dr. David.

The Additional Discovery sought by Cardiocom will provide useful information that has substantive value to Cardiocom's reply to Dr. David's opinions on objective indicia of nonobviousness. Bosch, as Patent Owner, "must demonstrate that there is a nexus between the merits of the claimed invention and the evidence of secondary considerations." *Zodiac Pool Sys., Inc. v. Aqua Prod., Inc.*, IPR2013-00159, Paper 26 at 4 (PTAB Oct. 18, 2013). Dr. David makes conclusory statements essentially repeating what these individuals told him, providing little or no factual support for the conclusions or the required nexus. Especially where Dr. David is repeating the statements of others, Cardiocom should be allowed access to the underlying source of those statements.

The depositions will lead to useful information because the statements of the Bosch personnel are facially inconsistent with other statements made on behalf of Bosch related to its *lack of* success in the telehealth industry. For example, in seeking to avoid a stay of litigation involving closely related patents, Bosch relied on a declaration by a Bosch Vice President stating that contracts entered in 2011 "are crucial to the development of a successful telehealth business." *Robert Bosch Healthcare Sys., Inc. v. Cardiocom, LLC*, Case No. 5:12-cv-03864-EJD, Dkt. #25 at ¶ 3 (N.D. Cal. Oct. 19, 2012) (attached hereto as Exhibit 1020). Bosch also asserted that the "telehealth field is a relatively new and growing field" in 2012. *Id.,* Dkt. #23 at p. 6 (attached hereto as Exhibit 1021). Bosch's statements are inconsistent with Dr. David's statements that claim success with these same telehealth products as early as 1999, 12-13 years earlier. Cardiocom should be allowed to show the statements cited by Dr. David cannot be reconciled with, and lack credibility in view of, these other statements.

Examples of the specific issues to be addressed in the depositions include:

- The relative sales and success of the Health Buddy and any other telehealth products in 2011-12, when Bosch asserted that the market was still new and Bosch was still attempting to develop a successful telehealth business, and the earlier time frames of purported success referenced in Dr. David's declaration.

- Why the Health Buddy was still the subject of an effort to become successful in 2012, including what features of the product or marketing and business characteristics associated with the product and market were the same or different in 2011-2012 vs. prior years.

- The credibility and self-interest of the Bosch personnel and Mr. Brown regarding the statements they made to Dr. David.

- The sources and veracity of the information underlying the statements, including consideration of the scope and merits of the claimed inventions in the three patents at issue, and what sources of information were relied upon by the witnesses for the statements.

- An identification of the specific elements of the Health Buddy that led to the purported commercial success, satisfied a long-felt need, or allegedly were copied by others, and whether those elements correspond to the merits of the claimed inventions.

2. Cardiocom Does Not Seek Bosch's Litigation Positions.

Cardiocom does not seek discovery on Bosch's litigation positions. Bosch did not argue otherwise during the parties' call with the Board.

3. The Additional Discovery Is Not Reasonably Available Through Other Means.

The discovery sought by Cardiocom can only be obtained by identifying and deposing the Bosch personnel and Mr. Brown. Cardiocom has no way to test the conclusory second-hand recitation of these unnamed individuals other than through their deposition testimony.

Dr. David does not claim to have expertise about marketing and sales of the Health Buddy or the purported copying of the Health Buddy. Dr. David thus cannot be effectively cross-examined about these facts as they were received from Bosch personnel and Mr. Brown. A deposition is necessary under these circumstances. *See Asus Computer Int'l v. Round Rock Research, LLC*, No. 12-cv-

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