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 No. 7,921,186)
CASE IPR2013-00449 (Patent No. 7,840,420)
CASE IPR2013-00468 (Patent No. 7,516,192)

PATENT OWNER'S RESPONSE TO PETITIONER CARDIOCOM, LLC'S MOTION TO COMPEL ADDITIONAL DISCOVERY

Patent Owner Robert Bosch Healthcare Systems, Inc. ("Bosch") respectfully requests that the Board deny Petitioner Cardiocom, LLC's ("Cardiocom") Motion to Compel Additional Discovery. Cardiocom fails to comply with the Board's order requiring that it identify specific issues for deposition. *See* Order at 3. Cardiocom instead seeks broad and open-ended litigation-style discovery that is specifically disfavored under statute and that is unrelated to the discussions between Dr. David and the individuals, Dr. David's opinions, or any issue in these proceedings. Indeed, in an apparent effort to raise ancillary issues, Cardiocom seeks nine hours of deposition time regarding two conversations that lasted no more than one hour each. Such discovery is not "necessary in the interest of justice." 35 U.S.C. § 316(a)(5)(B).

A. (Factor 1) Cardiocom Has Not Demonstrated That Its Discovery Request Will Lead To Useful Information.

Cardiocom's request for depositions must be rejected because Cardiocom has failed to demonstrate "beyond speculation that something useful will be uncovered." *Garmin Int'l, Inc. v. Cuozzo Speed Techs. LLC*, Case IPR2012-00001, Paper 26, at 7 (P.T.A.B. Mar. 5, 2013). "Useful" here "means favorable in substantive value to a contention of the party moving for discovery." *Id.*

It is apparent that Cardiocom intends to engage upon a fishing expedition in the hopes that Bosch's witnesses might disclose something useful. Despite the Board's order that Cardiocom "identify what specific issues would be addressed,

should the depositions be permitted" (Order at 3), Cardiocom purports only to identify "examples" of issues to be addressed. Mot. at 3. This vague, open-ended language is plainly intended to permit Cardiocom to delve into ancillary side issues that are unrelated to any question of validity or Dr. David's opinions.[1]

Indeed, the examples that Cardiocom identifies make clear its intention to engage in fishing. For instance, Cardiocom seeks to depose the witnesses on the "relative sales and success of the Health Buddy and any other telehealth products in 2011-12," *id.*, but Dr. David does not rely upon this information in his declaration, nor has Cardiocom demonstrated beyond speculation that the Bosch witnesses would even have such information. Cardiocom argues that such information might be relevant because Dr. David's opinions concerning commercial success are allegedly inconsistent with prior statements made by

[1] Cardiocom cites *Corning Inc. v. DSM IP Assets B.V.*, Case IPR2013-00043, Paper 27 (P.T.A.B. June 21, 2013), to argue that open-ended witness depositions should be permitted. Cardiocom's reliance is misplaced. *Corning* rejected two of three requests for additional discovery as being open-ended speculative requests, much like Cardiocom's requests here. *Id.* at 5-7. As to the third request, the Board permitted limited, non-burdensome discovery of a single lab notebook because the moving party specifically showed that the expert's opinion turned on whether or not she used certain formulas, which could only be found in the notebook. *Id.* at 4.

Bosch in litigation. Mot. at 3. However, Cardiocom could simply examine Dr. David on any alleged inconsistency (there is none). In any event, Cardiocom cannot show that a general inquiry into the state of the telehealth market in 2011-12—15 years after the priority date of the Bosch patents—contradicts or is otherwise specifically relevant to Dr. David's opinions. The same defects exist with respect to Cardiocom's second topic on the continued development of Health Buddy in 2012, which Dr. David does not address at all.[2]

Cardiocom's other example topics are similarly improper. For instance, the last two examples—seeking "consideration of the scope and merits of the claimed inventions" and "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," *id.* at 4—are vague requests that are akin to the requests for "additional evidence of secondary considerations" that were rejected by the Board in *Garmin* and *Corning*. In any event, these topics appear to seek a patent claim analysis that is clearly the subject of expert testimony, not fact witness testimony. Dr. David—who is an expert in analyzing and selecting telehealth devices for use in hospitals—specifically addresses these topics and Cardiocom is free to depose him.

[2] Cardiocom's assertions regarding supposed representations in litigation suggest that Cardicom is seeking to obtain Bosch's litigation positions from the witnesses. This also weighs against granting the discovery. *Garmin*, Paper 26 at 6 (Factor 2).

B. (Factor 3) Cardiocom Has Failed To Establish That The Requested Discovery Is Not Readily Available By Other Means.

Cardiocom's request should be rejected under Factor 3 because any relevant information is already obtainable from Dr. David's declaration and his upcoming deposition. Cardiocom completely ignores the numerous exhibits that Dr. David relied upon as objective indicia of non-obviousness; these exhibits independently corroborate the statements made by the Bosch witnesses. Case IPR2013-00431, Exs. 2010-2057. By way of example, Dr. David notes that the Bosch personnel "recalled that the Health Buddy was adopted by a number of other hospitals and pharmacies." *Id*., Ex. 2006, ¶ 66. Dr. David then cites several articles that verified the recollection of the Bosch witnesses. *Id.* (citing Exs. 2011-2014). Similarly, the Bosch personnel's statements about the VA's assessment of the Health Buddy are also supported by a VA case study. *Id.* ¶¶ 67-70 (discussing Ex. 2054).

Moreover, Cardiocom will have an opportunity from May 21-23 to depose Dr. David on the discussions that he had with Bosch personnel and how those discussions—along with all the other objective indicia of non-obviousness—helped to form his opinions regarding the validity of the challenged claims.

C. (Factor 4) The Discovery Request Is Not Easily Understandable.

Cardiocom's requests are vaguely worded and have uncertain scope. Moreover, Cardiocom has stated that these topics are only "examples." Accordingly, Cardiocom's motion should be rejected under this factor.

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