

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MEDTRONIC, INC., AND MEDTRONIC VASCULAR, INC.,
Petitioner,

v.

TELEFLEX INNOVATIONS S.À.R.L.,
Patent Owner.

Case IPR2020-00128
Patent RE 45,380

**PETITIONER'S MOTION TO COMPEL OR AUTHORIZE DEPOSITION
OF AMY WELCH
(FILED WITH AUTHORIZATION OF THE BOARD)**

Petitioner respectfully requests leave to take the deposition of Patent Owner's declarant, Ms. Amy Welch, in this proceeding. Ms. Welch is the Director of Sales-East for Patent Owner-related entity Teleflex Incorporated. Patent Owner cited Ms. Welch's declaration in support of its Patent Owner Response ("POR") on October 1, 2020. Ms. Welch's declaration is the same declaration that was filed in the now-stayed related district court litigation in connection with Patent Owner's motion for a preliminary injunction. *See* Ex. 2043/2044.¹ In the district court, Ms. Welch's declaration was submitted in support of allegations of "irreparable harm." Here, in its POR, Patent Owner submits (and cites) Mrs. Welch's deposition in support of its arguments regarding secondary considerations of non-obviousness. *See* POR at 39-41, 46, 48, 50, 53 (citing Welch decl. (Ex. 2044)). Ms. Welch has not been deposed specifically regarding secondary considerations topics, and Petitioner seeks to depose her regarding the basis for her cited statements and potential related omitted information that may refute or undercut Patent Owner's arguments regarding alleged secondary considerations.

A deposition or "[c]ross examination of affidavit testimony prepared for the proceeding is authorized" as part of "routine" discovery. 37 C.F.R.

¹ The declaration of Ms. Welch was filed under seal as Ex. 2043 and a redacted version was filed as Ex. 2044.

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Patent RE 45,380

§ 42.51(b)(1)(ii). In certain non-precedential and non-informative decisions the Board has, however, ruled “that depositions are not available as routine discovery when the witness’s testimony was prepared for or given in a different proceeding and then later filed in an inter partes review.” *Taylor Made Golf Co., Inc. v. Parsons Xtreme Golf, LLC*, IPR2018-00675, Paper No. 50 (PTAB Jan. 11, 2019) (citing *Nestle Healthcare Nutrition, Inc. v. Steuben Foods, Inc.*, Case IPR2015-00249, Paper 107 at 3–4 (PTAB Oct. 29, 2018); *1964 Ears, LLC v. Jerry Harvey Audio Holdings, LLC*, IPR2016-00494, Paper 40 at 5-6 (PTAB Jan. 30, 2017)); *see also Mexichem Amanco Holdings S.A. de C.V. v. Honeywell Int’l, Inc.*, IPR2013-00576, Paper 29 (PTAB Aug. 15, 2014). Citing these decisions, Patent Owner has refused to produce Ms. Welch for a deposition in this proceeding. The parties participated in a telephonic hearing before the Board on November 9, 2020, and the Board authorized submission of the instant motion. *See* Ex. 1105. As detailed below, the deposition of Ms. Welch should be compelled as “routine discovery” or allowed as “additional” discovery pursuant to 37 C.F.R. § 42.51(b).

I. MS. WELCH’S DEPOSITION SHOULD BE COMPELLED AS “ROUTINE” DISCOVERY.

Congress provided that discovery of relevant evidence, including specifically “the deposition of witnesses submitting affidavits or declarations,” should be allowed in inter partes review proceedings. 35 U.S.C. § 316(a)(5).

Congress indicated that depositions of declarants are “necessary in the interest of

justice.” *See id.* (allowing for other discovery that is also “*otherwise* necessary in interest of justice” (emphasis added)).

Petitioner submits that that the *Steuben Foods* line of decisions are wrongly decided. 37 C.F.R. § 42.51(b)(ii) was amended in 2015 to add the words “prepared for this proceeding.” *E.g., Nestle*, Paper 107 at 4 n.3 (citing 80 FR 28,561, 28,565 (May 19, 2015)). However, no commentary in making this “clarifying” amendment was provided by the Office. *See* 80 FR 28,563. Nothing indicates that the Office intended to preclude depositions of witnesses whose declarations or affidavits were prepared as an exhibit for, submitted in, and specifically relied on by a party in presenting its arguments in a particular inter partes review proceeding.

Interpreting § 42.51(b)(ii) as not allowing for depositions of declarants whose testimony was prepared as an exhibit for and submitted in the particular IPR proceeding would be contrary to the governing statute. Indeed, the Board has at least in some cases ordered, as “routine discovery,” depositions of a declarant whose testimony was submitted and relied upon on in the Board proceeding, even though the declaration was prepared originally for use in a different proceeding. *E.g., IBG LLC v. Trading Techs. Int’l, Inc.*, CBM2015-00179, Paper 39 (Apr. 15, 2016); *Ikaria, Inc. v. Geno LLC*, IPR2013-00253, Paper 20 at 2 (Apr. 1, 2014).

Not allowing a deposition here would subvert the interests of justice by shielding direct testimony from cross-examination. “Cross-examination is the

principal means by which the believability of a witness and the truth of his testimony are tested.” *Davis v. Alaska*, 415 U.S. 308, 316 (1974). Patent Owner submitted Ms. Welch’s declaration, in full, in support of its arguments in its POR. Ex. 2043/2044. A deposition should thus be allowed as cross-examination is a traditional safeguard of due process that it should “be assumed that Congress ... intended to afford.” *Greene v. McElroy*, 360 U.S. 474, 507-08 (1959).

II. MS. WELCH’S DEPOSITION IS IN THE INTERESTS OF JUSTICE

In an *inter partes* review, a party seeking discovery beyond what is expressly permitted by rule must do so by motion, and must show that such additional discovery is “in the interests of justice.” 37 C.F.R. § 42.51(b)(2)(i); *see also* 35 U.S.C. § 316(a)(5)(B). The Board has set forth five factors—the so-called *Garmin* factors—to be considered in determining whether “additional discovery” is in the interests of justice. The five *Garmin* factors are: (1) whether there exists more than a possibility and mere allegation that something useful will be discovered; (2) whether the requests seek the other party’s litigation positions and the underlying basis for those positions; (3) whether the moving party has the ability to generate equivalent information by other means; (4) whether the moving party has provided easily understandable instructions; and (5) whether the requests are overly burdensome. *Garmin Int’l, Inc. v. Cuozzo Speed Techs. LLC*, IPR2012-00001, Paper 26 at 6-7 (PTAB March 5, 2013) (precedential).

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