UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MEDTRONIC, INC., AND MEDTRONIC VASCULAR, INC.
Petitioners,

v.

TELEFLEX INNOVATIONS S.A.R.L.
Patent Owner.

Case IPR2020-00136
Patent RE 45,776

PATENT OWNER'S OPPOSITION TO PETITIONERS' MOTION TO COMPEL OR AUTHORIZE DEPOSITION OF AMY WELCH

Patent Owner Teleflex prepared and submitted the declaration of Ms. Amy Welch in the related district court litigation in connection with its motion for a preliminary injunction, and Petitioner Medtronic spent a full day deposing Ms. Welch on the contents of her declaration in that matter. Patent Owner subsequently cited ten discrete paragraphs of Ms. Welch's district court declaration to support a limited number of statements in its Patent Owner Response. Petitioner now seeks to depose Ms. Welch a second time regarding the basis for her statements cited in Patent Owner's Response ***and*** "potential related omitted information that may refute or undercut Patent Owner's arguments regarding alleged secondary considerations." Paper 59 at 1. Petitioner's first request seeks a purely duplicative deposition concerning the same declaration and the same factual information Ms. Welch has already been deposed on, while Petitioner's second request is an undisguised attempt to fish for "***potential*** . . . omitted" information that Petitioner speculates *may* exist and *may* support Petitioner's position. *Id.* (emphasis added). Petitioner's request to depose Ms. Welch on a declaration that was not prepared for this proceeding is not routine discovery. Instead, it is a wholly speculative request for additional discovery that should be rejected as duplicative, unduly burdensome to the party and witness, and contrary to the just and efficient administration of these proceedings. Petitioner's requests should be denied in their entirety.

I. A SECOND DEPOSITION OF MS. WELCH CONCERNING A DECLARATION THAT WAS NOT PREPARED FOR THIS PROCEEDING IS NOT ROUTINE DISCOVERY

The plain language of 37 C.F.R. § 42.51(b)(1)(ii) clearly and unambiguously indicates that Petitioner's request to depose Ms. Welch on declaration testimony that was prepared for the district court litigation is not routine discovery. *Id.* ("Cross examination of affidavit testimony ***prepared for the proceeding*** is authorized . . .") (emphasis added). The "prepared for the proceeding" language was expressly added in a 2015 amendment. *Nestle Healthcare Nutrition, Inc. v. Steuben Foods, Inc.*, IPR2015-00249, Paper 107 at 4, n.3 (PTAB Oct. 29, 2018) (citing 80 FR 28,561, 28,565). Petitioner notes that "no commentary in making this 'clarifying' amendment was provided by the Office," (Paper 59 at 3, citing 80 FR 28,563), and argues that this plain language should be ignored. First, Petitioner's assertion is not accurate. The Office stated that the amendment was made "[t]o clarify that routine discovery includes *only* the cross-examination of affidavit *testimony prepared for the proceeding*." 80 FR 28,563 (emphasis added); *see Taylor Made Golf Co., Inc. v. Parsons Xtreme Golf, LLC*, IPR2018-00675, Paper 50 at 3 (PTAB Jan. 11, 2019) (citing same). The Office evidenced a clear intent that routine discovery only provides for cross-examination of witnesses who have prepared new testimony for the proceeding. Second, the absence of any additional explanatory commentary does not justify departing from the clear and unambiguous meaning of the plain language:

"testimony" that was not "prepared for this proceeding" is not routine discovery. Indeed, an extensive line of Board decisions supports this straightforward reading of the plain language. *E.g.*, *Intel Corp. v. Tela Innovations, Inc.*, IPR2019-01228, Paper 54 at 4-5 (PTAB Aug. 21, 2020); *Taylor Made Golf Co., LLC*, IPR2018-00675, Paper 50; *Steuben Foods*, IPR2015-00249, Paper 107 at 3; *Blue Coat Sys, Inc. v. Finjan, Inc.*, IPR2016-01444, Paper 25 at 3 (PTAB Oct. 6, 2017); *1964 Ears, LLC v. Jerry Harvey Audio Holdings, LLC*, IPR2016-00494, Paper 40 at 5-6 (PTAB Jan. 30, 2017); *Mexichem Amanco Holdings S.A. de C.V. v. Honeywell Int'l, Inc.*, IPR2013-00576, Paper 29 at 2-3 (PTAB Aug. 15, 2014); *CBS Interactive, Inc. v. Helferich Patent Licensing, LLC*, IPR2013-00033, Paper 85 at 2-3 (PTAB Sept. 3, 2013) ("[B]ecause Dr. Deri's declaration is not *new testimony prepared for purposes of the instant inter partes review*, cross-examination of Dr. Deri is not provided as routine discovery . . . .") (emphasis added).

Petitioner identifies only two decisions that allegedly run contrary to this line of decisions, both of which are distinguishable. First, *Ikaria, Inc. v. Geno LLC*, IPR2013-00253, Paper 20 at 2 (PTAB Apr. 1, 2014) was decided before the "prepared for this proceeding" language was added to the regulation and contains no explanation or analysis supporting the Board's conclusion. *See Steuben Foods*, IPR2015-00249, Paper 107 at 4 ("*Ikaria* was decided under the previous version of rule 42.51, and for that reason is no longer applicable."). Second, *IBG LLC v.*

Trading Techs. Int'l, Inc., CBM2015-00179, Paper 39 (PTAB Apr. 15, 2016) involved a unique and distinguishable set of facts. Petitioner relied on prior testimonial evidence to show that a key reference published in Japanese was publicly available, and thus constitutes prior art. The Board stated that the testimonial evidence was "a pivotal part of Petitioner's challenges" and found that "[b]ased on the facts of these cases," Petitioner must secure the availability of the witness. *Id.* at 3. In reaching that conclusion, it is unclear whether the Board allowed the deposition as "routine discovery" or as "additional discovery," even though a separate motion for additional discovery was not filed. *See id.* at 2-3. In any event, the testimony at issue in *IBG* was determinative to the success of Petitioner's challenges, which is in stark contrast to the testimony in this case, which concerns a limited topic on which several other declarants are available for routine cross examination.

Even if the Board believes that, as a matter of policy, cross examination of testimony prepared for other proceedings should be routine discovery, the Board is bound by the plain language of the regulation, which is clear and unambiguous. And even if the Board wished to depart from its well-established line of decisions abiding by this interpretation, this is not the case to do so. Here, the declarant has already been deposed by Petitioner on this testimony. As for Petitioner's speculative request to depose Ms. Welch in hopes of possibly discovering "potential" omitted information, Petitioner unquestionably seeks new information for which Ms. Welch

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