

REDACTED

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 IPR2020-01341

Case IPR2020-01343

U.S. Patent No. 8,142,413

U.S. Patent No. RE 46,116

**PETITIONER'S MOTION FOR ADDITIONAL DISCOVERY:
MOTION FOR LEAVE TO SUBPOENA NON-PARTY WITNESSES
(FILED WITH BOARD AUTHORIZATION)**

Pursuant to 35 U.S.C. § 316(a)(5) and 37 C.F.R. § 42.51(b)(2), Petitioner moves for leave to serve subpoenas for testimony on three non-party witnesses: Jim Kauphusman, a former VSI engineer; Katie Mytty, a former VSI technician; and Jeff Welch, a named inventor on the patents-in-suit and former VSI employee.

As the Board knows, conception and reduction to practice is a critical, dispositive issue in these proceedings.¹ The conception and reduction to practice record will dictate whether one of Petitioner's references, Itou, is prior art. The limited record in these proceedings shows that Kauphusman, Mytty, and Welch have unique, first-hand knowledge of whether VSI reduced the claimed inventions to practice via assembly and testing of GuideLiner RX prototypes. Yet we have not heard from these individuals. By all accounts, they are the ones who would have led and performed the engineering and prototype work required to reduce to practice. Petitioner seeks their testimony because it has evidence that these

¹ To the extent Patent Owner argues that the Board already decided conception and reduction to practice in the related set of IPRs, Petitioner submits that the patents at issue here recite *method* claim and, thus, change the character of the reduction-to-practice analysis. Patent Owner will need to show that VSI performed the claimed processes, making the details of the testing and, as a result, the individuals *who purportedly performed that testing*, all the more significant.

individuals did *not* perform RX prototype work during the relevant period, before Itou. Kauphusman’s and Mytty’s laboratory notebooks show that they worked on only OTW (prior art)—not RX (patented)—prototypes during the relevant period. Welch’s notebook does not mention GuideLiner until years after the Itou reference.

Root tries to offer an explanation for the conspicuous discrepancy in the record. *See* Ex-2118 ¶ 94 (arguing that the Kauphusman and Mytty notebooks “show VSI’s testing of GuideLiner OTW in preparation for submitting our application to the FDA for regulatory clearance, not for purposes of confirming the device would work”). But the record contains no evidence that VSI sought regulatory clearance for or commercialized its OTW device. A more plausible explanation for the absence of RX notebook entries (based not on inventor say-so but on the evidentiary record) is that the key engineering witnesses did *not* assemble and test RX prototypes until after Itou. Petitioner moves the Board for leave to get that explanation into the record. This case turns on whether VSI performed the requisite engineering work; the requested testimony is crucial.

The *Garmin* factors favor granting additional discovery and determining, from the key sources, whether Patent Owner can swear behind Itou.

I. Legal Standard

“Under the Leahy-Smith America Invents Act, discovery is available for . . . ‘what is otherwise necessary in the interest of justice.’” *Garmin Int’l, Inc. v.*

Cuozzo Speed Techs. LLC, IPR2021-00001, Paper 26 at 5 (PTAB Mar. 5, 2013) (precedential) (quoting 35 U.S.C. § 316(a)(5)); *see also* 37 C.F.R. § 42.51(b)(2) (“The moving party must show that such additional discovery is in the interests of justice . . .”).

The Board’s precedential *Garmin* decision identifies five factors “important” to deciding whether to allow additional discovery: (1) more than a possibility and mere allegation; (2) litigation positions and underlying basis; (3) ability to generate equivalent information by other means; (4) easily understandable instructions; and (5) requests not overly burdensome to answer. *Garmin*, Paper 26 at 6.

II. First *Garmin* factor: The record demonstrates more than a possibility or mere allegation that Kauphusman, Mytty, and Welch will provide useful testimony that will allow Petitioner to rebut Patent Owner’s reduction-to-practice arguments.

Under the first *Garmin* factor, “[t]he party requesting discovery should already be in possession of evidence tending to show beyond speculation that in fact something useful will be uncovered.” *Garmin*, Paper 26 at 6. “Useful” means “favorable in substantive value to a contention of the party moving for discovery.” *Id.* at 7. Here, laboratory notebooks and other VSI engineering documents, declarations, and deposition testimony more than suggest that Kauphusman, Mytty, and Welch will provide useful, favorable testimony.

Unlike the witnesses that Patent Owner offers, Kauphusman, Mytty, and Welch led RX engineering efforts and assembled and tested GuideLiner

prototypes. But their laboratory notebooks reveal that at most, they performed only OTW work during the relevant period. Thus, Petitioner has evidence tending to show beyond speculation that Kauphusman, Mytty, and Welch will testify they did not build or test RX prototypes during the relevant period. That testimony will undermine Patent Owner's reduction-to-practice narrative and support Petitioner's contention that VSI did not perform critical prototype work sufficient to swear behind Itou.

VSI engineering documents, declarations, and deposition testimony confirm that Kauphusman led VSI's RX engineering and prototype work. Inventor Gregg Sutton testified that Kauphusman was "the primary engineer working on the rapid exchange version" in 2005. Ex-1757, 33:11-15; *see also* Ex-1794, 47:23-48:8 (Sutton identifying Kauphusman as "[REDACTED]

[REDACTED]. Sutton could not remember specifics, but he was "sure" that he met with Kauphusman "to discuss development of the GuideLiner rapid exchange device." Ex-1757, 34:7-20. Sutton and Kauphusman discussed "problem areas"—including "making the—what we called at the time the backbone"—and other engineering issues, including "what materials to use, where to get them, how to make them, [and] how to design them." *Id.*, 34:21-35:15. Kauphusman—and *only* Kauphusman, as far as Petitioner can tell—led RX engineering efforts during the

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