

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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

v.

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

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Case IPR2020-01343  
Patent RE46,116

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**PATENT OWNER'S OPPOSITION TO PETITIONER'S MOTION FOR  
ADDITIONAL DISCOVERY**

Having lost its argument in the related IPRs that Itou is prior art, Petitioner now asks the Board to license a fishing expedition for new and entirely speculative evidence from three non-declarant third parties whom Petitioner could have, but did not, seek to depose before. This is precisely the type of burdensome, costly, and unfocused discovery that IPRs were designed to eliminate.

There are many reasons why Petitioner's request should be denied. Among them: (1) Petitioner had the same motive and opportunity to seek these depositions in the prior, related IPRs, but determined this discovery was *not* necessary; (2) Petitioner's motion is based on pure conjecture as to what these third parties would say; (3) Petitioner sidesteps the substantial evidence (and the Board's prior finding) regarding reduction to practice; and (4) Petitioner ignores the burdens that its request would place on the deponents, Patent Owner, and the IPR schedule. For these and the additional reasons set forth below, the Board should deny Petitioner's motion.

**I. PETITIONER ALREADY DECIDED THAT THE DEPOSITIONS IT SEEKS NOW ARE NOT "IN THE INTERESTS OF JUSTICE"**

Because Petitioner seeks to depose third parties who did not submit affidavits or declarations, it must show the discovery is "in the interests of justice." 37 C.F.R. § 42.51(b)(1)-(2); *Garmin Int'l, Inc. v. Cuozzo Speed Techs. LLC*, IPR2012-00001, Paper 26 at 5-6 (PTAB March 5, 2013) (precedential) ("*Garmin*"). The Board's analysis is guided by the recognition that IPR discovery "is significantly different from the scope of discovery generally available under the Federal Rules of Civil

Procedure,” and Congress’s intent for the Patent Office to “be conservative in its grants of discovery.” *Garmin* at 5.

Petitioner’s argument is based principally on the contents of these third parties’ lab notebooks, and the testimony of Root, Sutton, and Erb. *E.g.*, Mot. at 4-9. Petitioner had the same information—and every motivation—in the prior IPRs to seek the additional discovery it requests now. Petitioner had the lab notebooks and documents it cites before it even filed its first round of IPRs. *See, e.g.* IPR2020-00126, Exs. 1758 (Welch notebook), 1760 (Kauphusman notebook), 1761 (Mytty notebook), 1774 (Mytty notebook), 1768 (Special Work Order Log) (all showing district court bates numbers beginning “VSIMDT”). And in the course of those earlier IPR proceedings, Petitioner took several depositions regarding conception and reduction to practice, including those of Root, Sutton, and Erb. *See, e.g.* IPR2020-00126, Exs-1756, 1757, 1762. In short, the evidence related to the roles of Kauphusman, Welch, and Mytty was available and well-known to Petitioner in the IPRs where the Board found conception and reduction to practice before Itou. Yet at no point did Petitioner seek to depose these individuals.

Petitioner does not cite a single new piece of information that now makes it necessary to depose these third parties. The only new fact is that Petitioner failed in the first IPRs to show that Itou was prior art. The Board disfavors “second bites at the apple” intended to supplement the record based on the outcomes of prior, related

proceedings. *See, e.g. General Plastic Indus. Co. v. Canon Kabushiki Kaisha*, IPR2016-01357, Paper 19 at 17 (PTAB Sept. 6, 2017) (precedential) (“[F]ollow-on petitions would allow petitioners . . . to strategically stage their . . . arguments in multiple petitions, using our decisions as a roadmap, until a ground is found that results in the grant of review.”); *see also id.* at 17-18, n.14. Petitioner’s efforts to do that here should not be rewarded.<sup>1</sup>

## **II. THE GARMIN FACTORS SHOW THAT THE ADDITIONAL DISCOVERY IS NOT IN THE INTERESTS OF JUSTICE**

### **A. Garmin Factor 1: Petitioner Only Speculates as to What the Requested Depositions Would Yield, and They Would Be Futile**

*Garmin* factor 1 requires Petitioner to show “more than a possibility and mere allegation” that useful information will be discovered. *Garmin* at 6. “The party requesting discovery should already be in possession of evidence tending to show beyond speculation that in fact something useful will be uncovered.” *Id.*

Here, Petitioner’s analysis of factor 1 rests principally on lab notebooks,

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<sup>1</sup> Petitioner’s apparent effort to use the Board’s decisions in the first set of IPRs finding that Itou was not prior art as a roadmap to mount a second-bite attack would be even more unjust here, where Patent Owner had to file its Responses in this second set of IPRs *before* the Board issued its decisions in the first set of IPRs, while Petitioner will be filing its Replies *after* receiving those decisions.

which Petitioner alleges show no work on the RX GuideLiner in 2005 or 2006. Mot. at 4-8. Petitioner posits that the notebooks “more than suggest[] that Kauphusman, Mytty, and Welch will testify that they do *not* remember working on RX prototypes in 2005-2006 and that, if they had, *they would have written it down in their notebooks.*” Mot. at 8; *see also id.* at 5. This is a huge, unfounded logical leap that is contradicted by actual evidence.

Nothing in these individuals’ lab notebooks or other documentation negates the ample evidence showing that the inventors and others reduced the invention to practice before Itou. Indeed, as the Board already found, “more detailed evidence with regard to the OTW GuideLiner . . . [does not] detract[] from or otherwise contradict[] the evidence presented for the RX GuideLiner.” *E.g.* IPR2020-00126, Paper 129 at 49. Petitioner presents *no evidence* that Kauphusman, Welch, and Mytty “do not remember working on RX prototypes in 2005-2006.” Mot. at 4-8. In fact, the very evidence presented by Petitioner contradicts its own conclusion.

Regarding Kauphusman, Petitioner acknowledges that his name appears on component part drawings, but then casts them aside in favor of notebooks to support the hypothesis that he did not perform engineering and prototype work during the relevant period. Mot. at 5. The documentation Petitioner acknowledges, dated well-before Itou’s critical date, does not merely bear Kauphusman’s name, it shows he was engaged in the details of designing and ordering customized components for the

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