

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

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

v.

TELEFLEX LIFE SCIENCES LIMITED,
Patent Owner.

Case IPR2020-01341 (Patent 8,142,413)
Case IPR2020-01343 (Patent RE 46,116)¹

Before SHERIDAN K. SNEDDEN and CHRISTOPHER G. PAULRAJ,
Administrative Patent Judges.

SNEDDEN, *Administrative Patent Judge.*

ORDER
Denying Petitioner's Motion for Additional Discovery
37 C.F.R. §§ 42.5, 42.51

¹ This Order addresses issues that are identical in each of the above-captioned proceedings. We therefore exercise our discretion to issue one Order to be filed in each proceeding. The proceedings have not been consolidated, and the Parties are not authorized to use this style heading in any subsequent papers.

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I. INTRODUCTION

With our authorization, Petitioner filed a Motion for Additional Discovery (Paper 36,² “Motion” or “Mot.”) in the instant proceedings, and Patent Owner filed an Opposition (Paper 40, “Opp.”). For the reasons stated below, Petitioner’s Motion is denied.

II. DISCUSSION

A party in a contested case may apply to a United States District Court for a subpoena to compel testimony. 35 U.S.C. § 24. A party seeking to compel testimony must first obtain authorization from the Board. 37 C.F.R. § 42.52(a). “[I]n *inter partes* review, discovery is limited as compared to that available in district court litigation.” *Garmin Int’l, Inc. v. Cuozzo Speed Tech. LLC*, IPR2012-00001, Paper 26, 5 (PTAB Mar. 5, 2013) (informative). Additional discovery must be “necessary in the interest of justice.” 35 U.S.C. § 316(a)(5); 37 C.F.R. § 42.51(b)(2). In determining whether additional discovery in an *inter partes* review proceeding is necessary in the interest of justice, the Board considers the following factors: (1) the request is based on more than a mere possibility of finding something useful; (2) the request does not seek the litigation positions of the other party; (3) the information is not reasonably available through other means; (4) the request is easily understandable; and (5) the request is not overly burdensome to answer. *Garmin*, Paper 26 at 6–7.

In its Motion, Petitioner requests additional discovery in the form of cross-examination of “three non-party witnesses: Jim Kauphusman, a former

² Redacted public version available at Paper 37.

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VSI engineer; Katie Mytty, a former VSI technician; and Jeff Welch, a named inventor on the patents-in-suit and former VSI employee.” Mot. 2. Petitioner contends, “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” and that the record contains sufficient 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.” *Id.* at 2–3. More specifically, Petitioner contends,

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.

Id. at 3–4.

Specific to the cross-examination of Mr. Kauphusman, Petitioner contends,

Kauphusman led critical engineering and prototype work, but the evidence more than suggests that Kauphusman did not perform that work during the relevant period. Kauphusman’s laboratory notebook shows that he worked on only OTW prototypes in 2005 and 2006. Ex-1760, 86-87, 91-93 (300-centimeter, 0.014” guidewire indicating OTW, not RX, prototype). And a VSI “Special Work Order Number Assignment Log” shows that in December 2005, VSI cancelled and could not complete GuideLiner design verification testing, due to a “design change.” Ex-1768, 14. “Jim K.”—Kauphusman—requested that work and then cancelled it. This evidence more than suggests that he will

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have information regarding why VSI could not complete that work.

Mot. 6.

Regarding the cross-examination of Mr. Mytty, Petitioner contends that Mytty worked alongside Kauphusman and that

Sutton identified Mytty as one of the “main individuals working with Mr. Kauphusman on the RX version.” Ex-1757, 33:23-34:6. Yet Mytty’s two laboratory notebooks indicate that she worked on only OTW prototypes in 2005 and 2006. Ex-1761, 107-13; Ex-1774, 10-12.

Mot. 6.

Regarding the cross-examination of Mr. Welsh, Petitioner contends that Mr. Welch’s notebook only shows notes related to GuideLiner dated in 2010 (Mot. 7 (citing Ex-1758, 12-14), which is in contrast to Patent Owner’s contention that Mr. Welch built and tested relevant RX prototypes within the relevant timeframe (Mot. 7 (citing Ex. 2118, ¶ 15; Ex. 1756, 62:3–63:20, 67:20–69:11)).

We are not persuaded that Petitioner has shown a basis for granting its request to obtain subpoenas from the district court to compel the requested testimony. Rather, for the reasons stated in Patent Owner’s Opposition at pages 3 to 8, which we adopt as our own, Petitioner has not demonstrated a sufficient showing that there is more than a mere possibility that the requested testimony will be useful to our determination of the patentability of the challenged claims. In particular, we agree with Patent Owner that

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]

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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.

Opp. 4. For example,

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 April and July 2005 GuideLiner RX prototypes, as well as the August 1, 2005 assembly drawing, which the Board already found was “strongly corroborative of an assembled device.” E.g. Ex-2089 at 5, 7 (detailed quote addressed to Kauphusman dated Feb. 11, 2005), 8 (drawing listing Kauphusman dated Feb. 2005); Ex-2092 at 5, 8 (drawing sent to MED from Kauphusman in April 2005); Ex-2113 (drawing listing Kauphusman dated Feb. 2005); Ex-2114 (drawing listing Kauphusman dated June 2005); IPR2020-00126, Paper 129 at 50, Ex-2022 (August 1, 2005 drawing). Medtronic’s suggestion that Kauphusman only performed OTW work is plainly contradicted by these contemporaneous RX documents, as well as the testimony of Root and Sutton. E.g., Ex-2118, ¶¶ 28, 33, 37; Ex-1757, 33:11-15.

Opp. 4–5.

Furthermore, we note that Patent Owner has not relied on testimony from these individuals to show reduction to practice prior to Itou, and agree that Petitioner only relies upon speculation that their depositions would be useful to our determination of the patentability of the challenged claims.

III. ORDER

In consideration of the foregoing, it is hereby:

ORDERED that Petitioner’s Motion for Additional Discovery is *denied*.

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