

## Deighan, Kyle

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**From:** Deighan, Kyle  
**Sent:** Tuesday, August 10, 2021 1:32 PM  
**To:** Sung, Lawrence  
**Cc:** Tucker, Todd; Reulbach, John; Summers, Teresa; Sylvia, Mary  
**Subject:** RE: IPR Nos. 2020-01573, 2020-01711, 2021-00017, 2021-00065, 2021-00066

Lawrence,

Thank you for your email and for offering to send a follow-up joint email to Dr. Quintana. Given the approaching due dates for Petitioner's replies in the IPRs, we think it is best to seek further guidance from the Board on this issue. We will be responding to the Board's email shortly to provide our availability for a conference call.

Regards,  
Kyle

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**From:** Sung, Lawrence <LSung@wiley.law>  
**Sent:** Tuesday, August 10, 2021 11:06 AM  
**To:** Deighan, Kyle <KDeighan@Calfee.com>  
**Cc:** Tucker, Todd <TTucker@Calfee.com>; Reulbach, John <JReulbach@calfee.com>; Summers, Teresa <TSummers@wiley.law>; Sylvia, Mary <MSylvia@wiley.law>  
**Subject:** RE: IPR Nos. 2020-01573, 2020-01711, 2021-00017, 2021-00065, 2021-00066

Dear Kyle:

Patent Owners have not received any reply from Dr. Quintana to our joint July 19, 2021 letter and email. Patent Owners would be willing to send a follow-up joint email to Dr. Quintana seeking his availability for deposition in Spain. Please advise whether Petitioner wishes to do so. Thank you.

Lawrence



Lawrence M. Sung, Ph.D.  
Attorney at Law  
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**From:** Trials <[Trials@USPTO.GOV](mailto:Trials@USPTO.GOV)>  
**Sent:** Monday, August 9, 2021 1:08 PM  
**To:** Deighan, Kyle <[KDeighan@Calfee.com](mailto:KDeighan@Calfee.com)>  
**Cc:** Tucker, Todd <[TTucker@Calfee.com](mailto:TTucker@Calfee.com)>; Reulbach, John <[JReulbach@calfee.com](mailto:JReulbach@calfee.com)>; Sung, Lawrence <[LSung@wiley.law](mailto:LSung@wiley.law)>; Summers, Teresa <[TSummers@wiley.law](mailto:TSummers@wiley.law)>; Sylvia, Mary <[MSylvia@wiley.law](mailto:MSylvia@wiley.law)>  
**Subject:** RE: IPR Nos. 2020-01573, 2020-01711, 2021-00017, 2021-00065, 2021-00066

Counsel, as a follow-up to the Board's email of earlier today, we recognize that there was some delay in the Board's message reaching the parties' counsel. Please update the Board as soon as possible on the parties'

progress in scheduling the deposition of Dr. Quintana. If a conference call is desired, please let us know the parties' availability over the course of this week.

Thank you,  
Eric W. Hawthorne  
Supervisory Paralegal Specialist  
Patent Trial and Appeal Board

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**From:** Deighan, Kyle <[KDeighan@Calfee.com](mailto:KDeighan@Calfee.com)>  
**Sent:** Friday, July 30, 2021 5:05 PM  
**To:** Trials <[Trials@USPTO.GOV](mailto:Trials@USPTO.GOV)>  
**Cc:** Conn, Paula <[Paula.Conn@USPTO.GOV](mailto:Paula.Conn@USPTO.GOV)>; Tucker, Todd <[TTucker@Calfee.com](mailto:TTucker@Calfee.com)>; Reulbach, John <[JReulbach@calfee.com](mailto:JReulbach@calfee.com)>; [LSung@wiley.law](mailto:LSung@wiley.law); [TSummers@wiley.law](mailto:TSummers@wiley.law); [MSylvia@wiley.law](mailto:MSylvia@wiley.law)  
**Subject:** RE: IPR Nos. 2020-01573, 2020-01711, 2021-00017, 2021-00065, 2021-00066

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Dear PTAB,

In accordance with the Board's instructions in the July 26<sup>th</sup> email below, Petitioner writes to provide another update regarding scheduling the deposition of Dr. Manuel Quintana in Spain in the above-referenced proceedings. It is Petitioner's understanding that Dr. Quintana has still not yet responded to the parties' joint letter sent on Monday, July 19<sup>th</sup>.

Given the approaching due dates for Petitioner's reply briefs in the above-referenced proceedings, if the parties are unable to make additional progress scheduling Dr. Quintana's deposition by next Friday, August 6<sup>th</sup>, Petitioner respectfully requests: (a) a conference call with the Board for guidance on how the parties should proceed; and/or (b) authorization to move to strike Dr. Quintana's declaration in the above-referenced proceedings. Thank you for your time and assistance in resolving this matter.

Best regards,  
Kyle Deighan

**Kyle T. Deighan**

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**From:** Trials <[Trials@USPTO.GOV](mailto:Trials@USPTO.GOV)>  
**Sent:** Monday, July 26, 2021 9:05 AM  
**To:** Deighan, Kyle <[KDeighan@Calfee.com](mailto:KDeighan@Calfee.com)>; Trials <[Trials@USPTO.GOV](mailto:Trials@USPTO.GOV)>  
**Cc:** Conn, Paula <[Paula.Conn@USPTO.GOV](mailto:Paula.Conn@USPTO.GOV)>; Tucker, Todd <[TTucker@Calfee.com](mailto:TTucker@Calfee.com)>; Reulbach, John <[JReulbach@calfee.com](mailto:JReulbach@calfee.com)>; [LSung@wiley.law](mailto:LSung@wiley.law); [TSummers@wiley.law](mailto:TSummers@wiley.law); [MSylvia@wiley.law](mailto:MSylvia@wiley.law)  
**Subject:** RE: IPR Nos. 2020-01573, 2020-01711, 2021-00017, 2021-00065, 2021-00066

Regarding Counsel's email dated July 23, 2021, the Board appreciates the parties' cooperation in this matter and authorizes more time to coordinate the subject deposition. Please update the Board by July 30, 2021, as suggested.

Regards,

Andrew Kellogg,  
Supervisory Paralegal  
Patent Trial and Appeal Board  
USPTO  
[andrew.kellogg@uspto.gov](mailto:andrew.kellogg@uspto.gov)  
(571)272-7822

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**From:** Deighan, Kyle <[KDeighan@Calfee.com](mailto:KDeighan@Calfee.com)>  
**Sent:** Friday, July 23, 2021 3:06 PM  
**To:** Trials <[Trials@USPTO.GOV](mailto:Trials@USPTO.GOV)>  
**Cc:** Conn, Paula <[Paula.Conn@USPTO.GOV](mailto:Paula.Conn@USPTO.GOV)>; Tucker, Todd <[TTucker@Calfee.com](mailto:TTucker@Calfee.com)>; Reulbach, John <[JReulbach@calfee.com](mailto:JReulbach@calfee.com)>; [LSung@wiley.law](mailto:LSung@wiley.law); [TSummers@wiley.law](mailto:TSummers@wiley.law); [MSylvia@wiley.law](mailto:MSylvia@wiley.law)  
**Subject:** RE: IPR Nos. 2020-01573, 2020-01711, 2021-00017, 2021-00065, 2021-00066

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Dear PTAB,

In accordance with the Board's instructions during the telephonic hearing last Thursday, July 15<sup>th</sup> regarding the deposition of Dr. Manuel Quintana in the above-referenced proceedings, the parties write to provide an update on progress in scheduling Dr. Quintana's deposition in Spain. Following the teleconference with the Board, the parties cooperated to prepare a joint letter requesting that Dr. Quintana be available for deposition in Spain regarding his May 17, 2021 sworn affidavit. Patent Owner's counsel sent the letter via email and expedited international delivery to Dr. Quintana on Monday, July 19<sup>th</sup>, and requested a response from Dr. Quintana by today, Friday, July 23<sup>rd</sup>. Dr. Quintana has not yet responded to the letter.

Given that Dr. Quintana has not yet responded to the deposition request and that the parties are still working to set up Dr. Quintana's deposition in Spain, Petitioner New World Medical, Inc. respectfully requests the opportunity to provide another update to the Board regarding Dr. Quintana's deposition by next Friday, July 30<sup>th</sup>. Thank you for your time in assisting the parties to resolve this matter.

Best regards,  
Kyle Deighan

**Kyle T. Deighan**

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**From:** Conn, Paula <[Paula.Conn@USPTO.GOV](mailto:Paula.Conn@USPTO.GOV)>  
**Sent:** Monday, July 12, 2021 2:40 PM  
**To:** Deighan, Kyle <[KDeighan@Calfee.com](mailto:KDeighan@Calfee.com)>; Tucker, Todd <[TTucker@Calfee.com](mailto:TTucker@Calfee.com)>; Reulbach, John <[JReulbach@calfee.com](mailto:JReulbach@calfee.com)>; [LSung@wiley.law](mailto:LSung@wiley.law); [TSummers@wiley.law](mailto:TSummers@wiley.law); [MSylvia@wiley.law](mailto:MSylvia@wiley.law)

**Cc:** Trials <[Trials@USPTO.GOV](mailto:Trials@USPTO.GOV)>

**Subject:** RE: IPR Nos. 2020-01573, 2020-01711, 2021-00017, 2021-00065, 2021-00066

Counsel,

A conference call has been scheduled for Thursday, July, 12, 2021, at 10:00 am EST.

Call-in number: (866) 692-

3158

Passcode: 8583307

Please email [trials@uspto.gov](mailto:trials@uspto.gov) with any questions and concerns.

*Paula Conn*

*Paralegal Specialist*

*Patent Trial and Appeal Board*

*U.S. Patent and Trademark Office*

*Phone: 571-272-4589*

*Email: [paula.conn@uspto.gov](mailto:paula.conn@uspto.gov)*

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**From:** Deighan, Kyle <[KDeighan@Calfee.com](mailto:KDeighan@Calfee.com)>

**Sent:** Friday, July 9, 2021 3:02 PM

**To:** Trials <[Trials@USPTO.GOV](mailto:Trials@USPTO.GOV)>

**Cc:** Tucker, Todd <[TTucker@Calfee.com](mailto:TTucker@Calfee.com)>; Reulbach, John <[JReulbach@calfee.com](mailto:JReulbach@calfee.com)>; Sung, Lawrence <[LSung@wiley.law](mailto:LSung@wiley.law)>; Summers, Teresa <[TSummers@wiley.law](mailto:TSummers@wiley.law)>; Sylvia, Mary <[MSylvia@wiley.law](mailto:MSylvia@wiley.law)>

**Subject:** IPR Nos. 2020-01573, 2020-01711, 2021-00017, 2021-00065, 2021-00066

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Dear PTAB:

We represent Petitioner New World Medical, Inc. in the above-referenced IPR proceedings. We write to request a teleconference with the Board to seek the Board's guidance on an issue that has arisen regarding the deposition of one of Patent Owner's witnesses in the above-referenced proceedings. Patent Owner has submitted uncompelled direct testimony in the form of a declaration by Dr. Manuel Quintana, who is located in Spain. Patent Owner has indicated that Dr. Quintana will not be made available for deposition in the United States. Petitioner believes Dr. Quintana should appear for in-person deposition in the United States in accordance with 37 C.F.R. § 42.53(b)(2). The parties have met and conferred but have not reached an agreement as to the location of Dr. Quintana's deposition. Petitioner therefore requests a conference call with the Board. The parties are available Wednesday, July 14 from 12-5pm eastern and Thursday, July 15 from 10am-3pm eastern for a conference call.

Best regards,  
Kyle Deighan

**Kyle T. Deighan**

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