

Deighan, Kyle

From: Deighan, Kyle
Sent: Tuesday, August 10, 2021 1:34 PM
To: Trials
Cc: Tucker, Todd; Reulbach, John; LSung@wiley.law; TSummers@wiley.law; MSylvia@wiley.law
Subject: RE: IPR Nos. 2020-01573, 2020-01711, 2021-00017, 2021-00065, 2021-00066

Dear PTAB,

Thank you for your email and the opportunity to further update the Board on the status of Dr. Quintana's deposition in Spain. It is Petitioner's understanding that Dr. Quintana has still not responded to the parties' joint letter sent on July 19th, and therefore, no additional progress in scheduling Dr. Quintana's deposition has been made.

Given the approaching due dates for Petitioner's reply briefs in the above-referenced proceedings, Petitioner respectfully requests a conference call with the Board for guidance on how the parties should proceed. Petitioner is available Thursday, August 12 from 12-5pm eastern and Friday, August 13 from 9am-3pm eastern for a conference call.

Best regards,
Kyle Deighan

From: Trials <Trials@USPTO.GOV>
Sent: Monday, August 9, 2021 1:08 PM
To: Deighan, Kyle <KDeighan@Calfee.com>
Cc: Tucker, Todd <TTucker@Calfee.com>; Reulbach, John <JReulbach@calfee.com>; LSung@wiley.law; TSummers@wiley.law; 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

From: Deighan, Kyle <KDeighan@Calfee.com>
Sent: Friday, July 30, 2021 5:05 PM
To: Trials <Trials@USPTO.GOV>
Cc: Conn, Paula <Paula.Conn@USPTO.GOV>; Tucker, Todd <TTucker@Calfee.com>; Reulbach, John <JReulbach@calfee.com>; LSung@wiley.law; TSummers@wiley.law; 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 26th 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 19th.

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 6th, 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

Not Licensed in Ohio; Licensed in DC and NY

kdeighan@calfee.com

216.622.8551 Phone

From: Trials <Trials@USPTO.GOV>

Sent: Monday, July 26, 2021 9:05 AM

To: Deighan, Kyle <KDeighan@Calfee.com>; Trials <Trials@USPTO.GOV>

Cc: Conn, Paula <Paula.Conn@USPTO.GOV>; Tucker, Todd <TTucker@Calfee.com>; Reulbach, John <JReulbach@calfee.com>; LSung@wiley.law; TSummers@wiley.law; MSylvia@wiley.law

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

Counsel,

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
(571)272-7822

From: Deighan, Kyle <KDeighan@Calfee.com>

Sent: Friday, July 23, 2021 3:06 PM

To: Trials <Trials@USPTO.GOV>

Cc: Conn, Paula <Paula.Conn@USPTO.GOV>; Tucker, Todd <TTucker@Calfee.com>; Reulbach, John

<JReulbach@calfee.com>; LSung@wiley.law; TSummers@wiley.law; 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 15th 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 19th, and requested a response from Dr. Quintana by today, Friday, July 23rd. 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 30th. Thank you for your time in assisting the parties to resolve this matter.

Best regards,
Kyle Deighan

Kyle T. Deighan

Not Licensed in Ohio; Licensed in DC and NY

kdeighan@calfee.com

216.622.8551 **Phone**

From: Conn, Paula <Paula.Conn@USPTO.GOV>

Sent: Monday, July 12, 2021 2:40 PM

To: Deighan, Kyle <KDeighan@Calfee.com>; Tucker, Todd <TTucker@Calfee.com>; Reulbach, John <JReulbach@calfee.com>; LSung@wiley.law; TSummers@wiley.law; MSylvia@wiley.law

Cc: Trials <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 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

From: Deighan, Kyle <KDeighan@Calfee.com>

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

To: Trials <Trials@USPTO.GOV>

Cc: Tucker, Todd <TTucker@Calfee.com>; Reulbach, John <JReulbach@calfee.com>; Sung, Lawrence <LSung@wiley.law>; Summers, Teresa <TSummers@wiley.law>; Sylvia, Mary <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

Not Licensed in Ohio; Licensed in DC and NY

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