

Sung, Lawrence

From: Sung, Lawrence
Sent: Wednesday, October 7, 2020 1:33 PM
To: 'Deighan, Kyle'
Cc: Tucker, Todd; Reulbach, John; Summers, Teresa
Subject: RE: IPR2020-01573

Kyle:

Patent Owner disagrees with your mischaracterization. Petitioner's "compromise" was given its due consideration. But it should be unsurprising that Patent Owner cannot accept a proposal that contravenes the letter and spirit of the discovery rules by your restricting access to nonprivileged matter, which you admit is relevant to the real party in interest statutory mandate, and which is proportional to the needs of this inter partes review (IPR). Among other things, the offer of a Petitioner-redacted version of the University license as part of your demand for Patent Owner's overall waiver of any discovery relating to the financial interest of the University in the outcome of this IPR squarely ignores the essence of our request and the law governing the real party in interest inquiry. In view of Petitioner's stand, Patent Owner has no recourse but to seek relief from the Board, and without further unnecessary delay. Thank you.

Lawrence

From: Deighan, Kyle <KDeighan@Calfee.com>
Sent: Wednesday, October 7, 2020 12:10 PM
To: Sung, Lawrence <LSung@wiley.law>
Cc: Tucker, Todd <TTucker@Calfee.com>; Reulbach, John <JReulbach@calfee.com>; Summers, Teresa <TSummers@wiley.law>
Subject: RE: IPR2020-01573

External Email

Lawrence,

We are disappointed that Patent Owner has immediately rejected out-of-hand Petitioners' proposed compromise, which would have avoided burdening the Board and saved the parties' resources. Understand that we intend to oppose your request and in view of the quick rejection, question its true motives. We are available for a teleconference with the Board from 12-2pm eastern on Thursday, October 8. We are not available on Friday, October 9. We are available from 10am-4pm on Monday, October 12.

Regards,
Kyle

Kyle T. Deighan

Not Licensed in Ohio; Licensed in DC and NY

kdeighan@calfee.com

216.622.8551 **Phone**

From: Sung, Lawrence <LSung@wiley.law>

Sent: Tuesday, October 6, 2020 8:24 PM

To: Deighan, Kyle <KDeighan@Calfree.com>

Cc: Tucker, Todd <TTucker@Calfree.com>; Reulbach, John <JReulbach@calfree.com>; Summers, Teresa <TSummers@wiley.law>

Subject: RE: IPR2020-01573

Kyle:

Patent Owner cannot accept your proposal below. Please advise soonest your availability to attend a teleconference with the Board between 10:00 a.m. and 4:00 p.m. ET on either Thursday, October 8, 2020, or Friday, October 9, 2020. Thank you.

Lawrence

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

Sent: Tuesday, October 6, 2020 8:18 PM

To: Sung, Lawrence <LSung@wiley.law>

Cc: Tucker, Todd <TTucker@Calfree.com>; Reulbach, John <JReulbach@calfree.com>; Summers, Teresa <TSummers@wiley.law>

Subject: RE: IPR2020-01573

External Email

Lawrence,

Further to the parties' meet-and-confer yesterday regarding Patent Owner's request for additional discovery concerning a license agreement between Petitioner and The Regents of the University of Colorado ("Colorado"), we have considered your request and provide the following response.

As discussed during the meet-and-confer, the "factual" information that you provided that forms the basis of your request for additional discovery is limited to statements suggesting that Petitioner and Colorado have a preexisting relationship and that Colorado has licensed certain technology to Petitioner. You confirmed during the call that you do not have any additional evidence demonstrating that, for example, Colorado has any control over Petitioner's participation in this proceeding or that Petitioner is acting as a proxy for Colorado in this proceeding. Instead, Patent Owner is requesting additional discovery merely to determine whether this may be the case. You also explained that, although there is no statutory bar applicable to the present situation, Patent Owner's motivation for pursuing this additional discovery is so that Colorado is subject to estoppel. We do not believe that any of the information you have provided either: (a) demonstrates that Colorado is a real-party-in-interest in this proceeding or (b) shows that your requested additional discovery is in the interests of justice (at least because under *Garmin*, you have failed to show beyond mere speculation that any of the additional discovery you have requested will show Colorado is, in fact, a real-party-in-interest in this proceeding).

Nonetheless, to avoid burdening the Patent Trial and Appeal Board ("PTAB") with a conference call and potential briefing on Patent Owner's request for additional discovery, Petitioner is willing to offer the following compromise. Petitioner will provide a redacted, "attorneys-eyes-only" version of the license agreement (and amendments thereto) between Petitioner and Colorado related to the Kahook Dual Blade technology, which will clearly demonstrate that Colorado is not a real-party-in-interest in this proceeding. Specifically, Petitioner will redact certain financial terms from the agreement, as the financial terms of the agreement are not relevant to the question of whether Colorado is a real-party-in-interest in the proceeding. In exchange, Patent Owner will agree to drop its request for additional discovery and will agree not to pursue any other additional discovery regarding whether Colorado is a real-party-in-interest in the above-captioned proceeding or any other IPR proceeding brought by Petitioner challenging

patents asserted against Petitioner in *MicroSurgical Tech., Inc. v. New World Medical, Inc.*, No. 20-cv000754 (D. Del.), including but not limited to the redacted portions of the agreements or “financial records of payments made and/or owed to the University by Petitioner under that agreement.” Additionally, although we are confident that after examining the agreement you will agree Colorado is not a real-party-in-interest, Patent Owner will agree to meet-and-confer if it intends to further pursue the issue with the Board.

Please let us know if you will agree to the compromise described above. If Patent Owner does not agree, Petitioner will oppose your request for additional discovery.

Regards,
Kyle

Kyle T. Deighan

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216.622.8551 **Phone**

From: Sung, Lawrence <LSung@wiley.law>

Sent: Tuesday, October 6, 2020 12:52 PM

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

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

Subject: RE: IPR2020-01573

Kyle:

Thank you for the update.

Lawrence

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

Sent: Tuesday, October 6, 2020 11:39 AM

To: Sung, Lawrence <LSung@wiley.law>

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

Subject: RE: IPR2020-01573

External Email

Lawrence,

As discussed during yesterday’s meet-and-confer and as you indicated in your email below, we told you that we expected to be able to get back to you by today regarding Patent Owner’s request for additional discovery. Our client was not available yesterday. We will be discussing Patent Owner’s request with our client this afternoon and expect to provide you with a response later today.

Regards,
Kyle

Kyle T. Deighan

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From: Sung, Lawrence <LSung@wiley.law>

Sent: Tuesday, October 6, 2020 11:11 AM

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

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

Subject: IPR2020-01573

Dear Kyle:

We understood from yesterday's meet and confer that you would consult with your client and inform us no later than today about Petitioner's decision whether to oppose Patent Owner's proposed Motion for Additional Discovery related to whether The Regents of the University of Colorado is a real party-in-interest in the instant proceeding. Please let us know Petitioner's decision and the availability of counsel to attend a teleconference with the Board between 10:00 a.m. and 4:00 p.m. ET on either Thursday, October 8, 2020, or Friday, October 9, 2020. Thank you.

Lawrence



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Note: The firm's domain has changed to wiley.law. To update my contact information, please download my [vCard](#)