From: Steinert, Adam <ASteinert@fredlaw.com>
Sent: Monday, October 04, 2021 12:09 PM
To: Nate D Louwagie
Cc: Johnson, R. Scott; Aaron W Pederson; _Tennant Company/Oxygenator Water Technologies; OWT
Subject: RE: IPR2021-00625 Proposed Changes and Motions re: Scheduling Order

Follow Up Flag: Follow up
Flag Status: Flagged

Dear Nate,

You appear to be missing the point regarding your questions about testing other prior art devices that do not appear in either IPR. You have not pointed us to any authority supporting the idea that OWT is allowed to inquire into other testing that might or might not have occurred in support of prior art theories from the district court lawsuit that were not presented in an IPR. Your question below is in effect an improper interrogatory couched in an email. Because the question itself is an improper discovery request, you are not entitled to an answer to it.

Regarding your Requests 1 & 4, as I have said twice before, Tennant does not object to those requests as they relate to Wikey and Davies. I do not know what you find confusing about that statement, but to be clear, Tennant will produce information related to all efforts by Dr. Tremblay to reproduce and test embodiments of Wikey and Davies on Tennant's behalf.

Regarding requests 2 & 3, it is not Tennant's job to rewrite your discovery requests for you. We have repeatedly objected to the requests as written, which seek materials beyond (a) those permitted by any prior IPR decision you have cited and (b) the Federal Rules of Civil Procedure. You told the Board that your requests match the *Apple* case, but they do not. We have repeatedly asked you to explain the origin of your requests, but you have not. We have repeatedly encouraged you to narrow your requests to match the scope of discovery allowed by the Board and Rule 26, but you have not. If you wish to propose a permissible discovery request, please send it to us, rather than wasting more of the Board's time and Tennant's resources fighting over your attempt to obtain overbroad discovery.

We anticipate producing materials related to the Wikey and Davies testing next week. Dr. Tremblay is available to be deposed at our offices on November 4 or November 5. Please let us know which of those dates OWT prefers. We can make the reconstructed Wikey and Davies devices available for inspection in our offices during the weeks of October 25 and November 1. Please let us know what day you would like to schedule the inspection for.

Best regards,
Adam

From: Nate D Louwagie <NLouwagie@carlsoncaspers.com>
Sent: Saturday, October 2, 2021 3:02 PM
To: Steinert, Adam <ASteinert@fredlaw.com>
Cc: Johnson, R. Scott <RSJohnson@fredlaw.com>; Aaron W Pederson <APederson@carlsoncaspers.com>; _Tennant Company/Oxygenator Water Technologies <OWT@fredlaw.com>; OWT <OWT@carlsoncaspers.com>
Subject: Re: IPR2021-00625 Proposed Changes and Motions re: Scheduling Order

[EXTERNAL E-MAIL]

Adam,

It appears that the parties may be able to avoid motion practice on Requests 1 and 4.

First, if Tennant can provide a clear statement that it is not aware that Dr. Tremblay is aware of attempts to reproduce prior art that was not cited in either IPR, there will be no need for us to move on this basis. Your email below does not provide such a statement, and if Tennant cannot make that statement it appears the attempts exist. As you know, this information is relevant because the Davies and Wikey references only disclose ranges – rather than particular embodiments. Therefore, attempts to reproduce other references may well have fallen within (or near) the ranges disclosed by these references and would be highly relevant to whether those references inherently create microbubbles and nanobubbles.

Second, with regard to Requests 1 and 4 for Wikey and Davies, I do not believe your response cleanly answers my question. Please provide a clear statement that Tennant will be producing (a) information about any additional attempts to reproduce Wikey or Davies that Dr. Tremblay was aware of, and (b) any data that was generated related the alleged reproductions of these references that were included in Dr. Tremblay's declaration.

If Tennant can provide a clear statement on the issues above we can likely avoid motion practice on Requests 1 and 4.

Regarding Requests 2 and 3, is Tennant suggesting it would be willing to produce documents on some portion of these topics? OWT does not see a relevant distinction between its requests and the *Apple* case, but if Tennant wants to propose a compromise OWT is certainly willing to consider it.

For the documents Tennant does not object to in Requests 1 and 4, please provide a date certain by which Tennant will produce them by noon Monday. We may need to mention the timing issue in our motion if Tennant cannot commit to production sufficiently in advance of the deadline for OWT's response. Tennant's argument that it is entitled to delay production of documents it agrees are responsive because it forced OWT to seek relief from the Court and Board on other issues is meritless.

Please also identify dates for Dr. Tremblay's deposition and the inspection of his creations.

Thank you,

Nate

Nate D Louwagie
Carlson Caspers
225 S. Sixth St., Suite 4200
Minneapolis, MN 55402
Direct: 612.436.9656
Cell: 612.716.3924
NLouwagie@carlsoncaspers.com
carlsoncaspers.com
BIO | vCard | Disclaimers

On Oct 1, 2021, at 3:14 PM, Steinert, Adam <ASteinert@fredlaw.com> wrote:

Dear Nate,

No, you may not "understand" anything about the substance of Dr. Tremblay's work as an expert witness based on my statement that "***[t]o the extent that materials regarding uncited prior art exist***, they are irrelevant to the IPR proceeding and an improper attempt to obtain discovery outside the scope of the IPR." You have not pointed to any authority for the relevance in an IPR proceeding of whether or not an expert evaluated prior art that is *not* part of the IPR proceeding. This is an improper fishing expedition to attempt to learn the scope of protected litigation communications.

Regarding your Requests 1 & 4, as stated in my message below, Tennant does not object to those requests as they relate to Wikey and Davies. As noted above, Tennant's objection is to the attempt to seek discovery regarding prior art that is not part of the instituted IPR petition.

Regarding Requests 2 & 3, you appear to be arguing that those requests contain some overlap with permissible discovery requests from other cases. Requests that seek both permissible and impermissible discovery materials are, by definition, overbroad. In the nine days since we spoke with the Board, you have done nothing to conform Requests 2 and 3 to the scope of discovery permitted by the Board or Fed. R. Civ. P. 26.

We are in the process of collecting and reviewing materials in response to the non-objectional portions of Requests 1 & 4. We will produce them in due course. Your demand for immediate production is inappropriate when you have forced the parties to waste considerable time and energy before both the Board and the district court fighting over the scope of your overbroad discovery requests.

Sincerely,
Adam

From: Nate D Louwagie <NLouwagie@carlsoncaspers.com>
Sent: Wednesday, September 29, 2021 2:55 PM
To: Steinert, Adam <ASteinert@fredlaw.com>; Johnson, R. Scott <RSJohnson@fredlaw.com>; Aaron W Pederson <APederson@carlsoncaspers.com>
Cc: _Tennant Company/Oxygenator Water Technologies <OWT@fredlaw.com>; OWT <OWT@carlsoncaspers.com>
Subject: RE: IPR2021-00625 Proposed Changes and Motions re: Scheduling Order

[EXTERNAL E-MAIL]

Adam,

Thanks for your note. A couple comments/questions:

First, based on your email below, we understand that Dr. Tremblay is aware of attempts to reproduce prior art that was not cited in either IPR. If that is not true, please let us know. Otherwise, OWT believes that information is clearly discoverable because it is not clear how Dr. Tremblay could not have considered the information he gained from reviewing those attempted reproductions. This discovery is supported by at least the *Yeda* case OWT identified on the call. Note that if Dr. Tremblay reviewed any product and assessed the types of bubbles that product might create (if any) as part of his consultation with Tennant, OWT believes that information is directly relevant and discoverable.

Second, for Requests 1 and 4, please clarify whether Petitioner is also refusing to produce (a) information about any additional attempts by Dr. Tremblay to reproduce Wikey or Davies, or (b) any data that was generated related the alleged reproductions of these references that were included in Dr. Tremblay's declaration.

Third, for Requests 2 and 3, OWT suggested the possibility of the compromise you identify below, but it was clear OWT was not prepared to formally offer that compromise on the phone. Regardless, OWT also explained that Requests 2 and 3 were very similar to Request 1 from the *Apple* case which required production of instructions provided to a testing lab specifying the studies to be conducted. Requests 2 and 3 seek the instructions provided to Dr. Tremblay related to the studies identified in his declaration. This information is discoverable under Rule 26 and the discovery is in the interest of justice under the *Garmin* factors.

Finally, on a related note, please explain when we can expect Tennant to produce the documents responsive to requests 1 and 4 that it does not object to producing. Given the deadline for OWT's response in November, it is important that Tennant produce these documents next week at the latest. Please also provide dates for Dr. Tremblay's deposition and the examination of Tennant's alleged reproductions pursuant to the parties' previous discussions.

Thank you,

Nate

Nate D Louwagie
Carlson Caspers
225 S. Sixth St., Suite 4200
Minneapolis, MN 55402
Direct: 612.436.9656
Cell: 612.716.3924
NLouwagie@carlsoncaspers.com
carlsoncaspers.com
BIO | vCard | Disclaimers

From: Steinert, Adam <ASteinert@fredlaw.com>
Sent: Wednesday, September 29, 2021 1:57 PM
To: Nate D Louwagie <NLouwagie@carlsoncaspers.com>; Johnson, R. Scott <RSJohnson@fredlaw.com>; Aaron W Pederson <APederson@carlsoncaspers.com>
Cc: _Tennant Company/Oxygenator Water Technologies <OWT@fredlaw.com>; OWT <OWT@carlsoncaspers.com>
Subject: RE: IPR2021-00625 Proposed Changes and Motions re: Scheduling Order

Dear Nate,

I write to follow up on our meet and confer this morning.

Regarding your requests (1) and (4), we stated (as we did during last week's call with the Board) that we have no objection to these requests as they relate to the prior art at issue in the instituted IPR (Wikey and Davies).

You stated that you were not seeking materials related to the prior art presented in the non-instituted IPR petition (the Tremblay reference), but that you are seeking materials related to any prior art that was not cited in *either* IPR. You directed us to the decision in *Yeda Research v. Abbott GMBH*, 292 F.R.D. 97 (D.D.C. 2013), as allegedly supporting discovery of such materials. We have reviewed the *Yeda* decision. Nothing in it relates to discovery regarding expert analysis of uncited prior art, let alone seeking such discovery in an IPR. To the extent that materials regarding uncited prior art exist, they are irrelevant to the IPR proceeding and an improper attempt to obtain discovery outside the scope of the IPR.

Regarding your requests (2) and (3), you proposed dropping those requests in exchange for us agreeing to the discovery you seek in items (1) and (4) above related to uncited prior art. We stated that horse-trading objectionable discovery requests is not appropriate.

We asked you to identify the source of the text for Requests (2) and (3) in the two IPR decisions you cited to the Board (*Apple v. Singapore Asahi Chemical*, IPR2019-00377, Paper No. 22 (Oct. 21, 2019) and *Corning v. DSM IP*, IPR2013-00043, Paper No. 27 (June 21, 2013)). You were unable to do so. As we indicated on the call, the text of Requests (2) and (3) does not appear to come from any request authorized by the Board in *Apple* or *Corning*. Based on the current record, it appears that you made up the text of Requests (2) and (3). You indicated that if there is a source for the text of Requests (2) and (3), you will send it to us. We requested that you do so today, so that we have an opportunity to evaluate it in advance of your Monday deadline.

Best regards,
Adam

From: Steinert, Adam <ASteinert@fredlaw.com>
Sent: Tuesday, September 28, 2021 9:38 PM
To: Nate D Louwagie <NLouwagie@carlsoncaspers.com>; Johnson, R. Scott <RSJohnson@fredlaw.com>; Aaron W Pederson <APederson@carlsoncaspers.com>
Cc: _Tennant Company/Oxygenator Water Technologies <OWT@fredlaw.com>; OWT <OWT@carlsoncaspers.com>
Subject: RE: IPR2021-00625 Proposed Changes and Motions re: Scheduling Order

Dear Nate,

We are available to meet and confer at 10:30AM tomorrow if that time works for you.

Best regards,
Adam

From: Nate D Louwagie <NLouwagie@carlsoncaspers.com>
Sent: Monday, September 27, 2021 10:52 AM
To: Steinert, Adam <ASteinert@fredlaw.com>; Johnson, R. Scott <RSJohnson@fredlaw.com>; Aaron W Pederson <APederson@carlsoncaspers.com>

DOCKET ALARM

Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

Real-Time Litigation Alerts

Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

Advanced Docket Research

With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

Analytics At Your Fingertips

Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

LAW FIRMS
Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

FINANCIAL INSTITUTIONS
Litigation and bankruptcy checks for companies and debtors.

E-DISCOVERY AND LEGAL VENDORS
Sync your system to PACER to automate legal marketing.