

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

TENNANT COMPANY,

Petitioner,

v.

OXYGENATOR WATER TECHNOLOGIES, INC.,

Patent Owner.

Case IPR2021-00625

Patent RE45415

**PATENT OWNER OXYGENATOR WATER TECHNOLOGIES, INC.'S
MOTION FOR ADDITIONAL DISCOVERY**

I. Relief Requested

Patent Owner (“PO”) seeks the following Additional Discovery¹:

- (1) Laboratory notebooks and other documents containing or reflecting the protocols used in connection with the experiments considered by Petitioner’s expert Dr. Tremblay related to his consultation with Petitioner;
- (2) Documents identifying, including, or referring to any instructions, suggestions, or advice provided to Dr. Tremblay concerning the design and/or structure of the purported physical embodiments;
- (3) Documents identifying, including, or referring to any instructions, suggestions, or advice provided to Dr. Tremblay concerning the parameters for operation of the purported physical embodiments; and
- (4) Test reports or other raw data from any experiments conducted by, at the direction of, or for consideration by Dr. Tremblay that analyze the impact of any parameter that is the subject of the claims of the ’415 patent.

II. Background of Dispute

Grounds 1 and 7 are based on Petitioner’s arguments that Wikey and Davies inherently anticipate a number of instituted claims of the ’415 patent. All instituted

¹ To the extent Petitioner possesses information that is inconsistent with the data provided in support of its petition, such as information that unspecified variables impact bubble formation and size, that information is a matter of Routine Discovery and PO respectfully requests the Board order Petitioner to produce it.

claims require the formation of micro- and nanobubbles using electrolysis, but neither Wikey nor Davies teach or suggest the formation of bubbles. As a result, Petitioner, through its expert Dr. Mario Tremblay, fabricated and tested devices it contends are based on the Wikey and Davies references. Paper 1 at 22-29, 52-61; Ex. 1103, ¶¶39-69, 111-57. Petitioner contends that these experiments demonstrate that the devices and operating parameters taught by Wikey and Davies inherently yield micro- and nanobubbles and so inherently anticipate the claims.

The problem is that every one of Petitioner's experiments is based on a fictional embodiment of Wikey and Davies. In performing these tests, Dr. Tremblay had to select a combination of structural and operational parameters that are not taught by the references. Instead, each of these references describe ranges of these variables without teaching an embodiment that combines them in the fashion that Dr. Tremblay did. And, as PO explained in its Preliminary Response, these variables directly impact both the formation of bubbles and the size thereof. *See* Paper 8 at 34, 39-40; Ex. 2109 at ¶¶ 55-57, 61-66. All of the requested discovery at issue is directly relevant to this fundamental, disputed issue: the impact of Dr. Tremblay's selection of unspecified variables on his results.

Despite the direct relevance of the requested information, Petitioner refuses to produce some documents responsive to Requests 1 and 4, and any information responsive to Requests 2 and 3. Ex. 2115.

III. Requests 1 and 4 are in the Interest of Justice

Requests 1 and 4 seek documents concerning all of the *protocols* and *data* for any experiments that Dr. Tremblay considered in forming his opinions that assessed the formation of bubbles using electrolysis as required by the claims. It is unclear how Dr. Tremblay could have been privy to such information without considering it in forming his opinions in this proceeding. Accordingly, the Board has routinely granted requests to such. *See Apple Inc. v. Singapore Asahi Chemical & Solder Industries Pte Ltd.*, IPR2019-00377, Paper 22, at 3-4, 16 (PTAB Oct. 21, 2019); *Mylan Pharmaceuticals Inc. v. Allergan Inc.*, IPR2016-01127, Paper 28, at 3-4 (PTAB May 31, 2017); *Corning Inc. v. DSM IP Assets B.V.*, IPR2013-00043, Paper 27, at 2-5 (PTAB June 21, 2013).

Petitioner has agreed to produce some information responsive to these requests but has refused to produce information about any other experiments Dr. Tremblay is aware of involving “attempts” to reproduce other prior art not disclosed in IPR2021-00602. Ex. 2115. Further, Petitioner has refused to confirm that Dr. Tremblay was unaware of additional experiments assessing the formation and size of bubbles. *Id.* This suggests Dr. Tremblay did consider additional experiments. Petitioner should not be permitted to shield such data.

This information will be useful to assessing Petitioner’s inherent anticipation argument. A reference only inherently anticipates if “the reference discloses prior

art that must necessarily include the unstated limitation”. *Transclean Corp. v. Bridgewood Servs.*, 290 F.3d 1364, 1373 (Fed. Cir. 2002). A reference that discloses a range does not anticipate when the claimed invention “work[s] differently at different points within the prior art range”. *Osram Sylvania, Inc. v. Am. Induction Techs., Inc.*, 701 F.3d 698, 706 (Fed. Cir. 2012). It is not enough that a certain result *may* be achieved. *Cont'l Can Co. v. Monsanto Co.*, 948 F.2d 1264, 1269 (Fed. Cir. 1991).

In making and testing his alleged reproductions, Dr. Tremblay chose structural and operational values within various ranges described by the references, and he also chose values for some parameters that are not disclosed in the references at all. To the extent the selection of different structural and operational variables impacts the formation and size of bubbles yielded by electrolysis devices—whether or not those devices were intended to be “reproductions” of Davies or Wikey—the results of those experiments will be useful to show that Wikey and Davies do not inherently yield micro- and nanobubbles.

All five *Garmin* factors support requiring Petitioner to produce these documents. **First**, there is more than a mere possibility that something useful will be discovered. As described above, data demonstrating that the unspecified structural and operational parameters of Wikey and Davies impact bubble size will refute inherent anticipation. Ex. 2115. For reasons like this, 37 C.F.R. § 42.65

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