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Paper 77
Entered: December 8, 2020

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MEDTRONIC, INC. and MEDTRONIC VASCULAR, INC.,
Petitioner,

v.

TELEFLEX INNOVATIONS S.À.R.L.,
Patent Owner.

IPR2020-00126 (Patent 8,048,032 B2)
IPR2020-00127 (Patent 8,048,032 B2)
IPR2020-00128 (Patent RE45,380)
IPR2020-00129 (Patent RE45,380)
IPR2020-00130 (Patent RE45,380)
IPR2020-00132 (Patent RE45,760)
IPR2020-00134 (Patent RE45,760)
IPR2020-00135 (Patent RE45,776)
IPR2020-00136 (Patent RE45,776)
IPR2020-00137 (Patent RE47,379)
IPR2020-00138 (Patent RE47,379)[1]

Before SHERIDAN K. SNEDDEN, JON B. TORNQUIST, and CHRISTOPHER G. PAULRAJ, *Administrative Patent Judges.*

SNEDDEN, *Administrative Patent Judge*.

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[1] This Decision addresses identical issues in each of these 11 related cases. The parties are not authorized to use this style heading for any subsequent papers.

ORDER
Denying Petitioner's Motion to Compel Deposition of Amy Welch
37 C.F.R. § 42.52

I. INTRODUCTION

With our authorization, Petitioner filed a Motion to Compel Deposition of Amy Welch (Paper 68,[2] "Motion" or "Mot.") in the instant proceedings. The stated purpose of the deposition is to depose Ms. Welch "regarding the basis for her cited statements and potential related omitted information that may refute or undercut Patent Owner's arguments regarding alleged secondary considerations." Mot. 1. Specifically, "Petitioner wishes to depose Ms. Walsh to expose through cross-examination information omitted from Ms. Welch's declaration that helps refute those positions or shows lack of credibility." *Id.* at 7.

With our authorization, Patent Owner filed an Opposition to the Motion. Paper 72 ("Opp.").

For the reasons stated below, Petitioner's Motion is *denied*.

II. DISCUSSION

A. The Parties' Dispute

With its Patent Owner Response, Patent Owner submitted a declaration from Amy Welch regarding secondary considerations of non-

[2] Petitioner filed similar motions in each of the above-identified proceedings. For purposes of expediency, we cite to Papers filed in IPR2020-00126 unless otherwise indicated.

obviousness. PO Resp. 40–41, 46, 48, 50, 53 (citing Ex. 2044[3]). According to Petitioner, "Ms. Welch's declaration is the same declaration that was filed in the now-stayed related district court litigation in connection with Patent Owner's motion for a preliminary injunction." Mot. 1 (citing Exs. 2043, 2044). Petitioner contends, however, that

> Ms. Welch has not been deposed specifically regarding secondary considerations topics, and Petitioner seeks to depose her regarding the basis for her cited statements and potential related omitted information that may refute or undercut Patent Owner's arguments regarding alleged secondary considerations.

Mot. 1. Petitioner contends that Ms. Welch's deposition should be compelled as "routine discovery" under 37 C.F.R. § 42.51(b)(1). *Id.* at 2–4. In the alternative, Petitioner contends that Ms. Welch's deposition is in the interests of justice and should be compelled as "additional discovery" under 37 C.F.R. § 42.51(b)(2). *Id.* at 4–9 (*citing Garmin Int'l, Inc. v. Cuozzo Speed Techs. LLC*, IPR2012-00001, slip op. at 6–7 (PTAB March 5, 2013) (Paper 26) (precedential) ("*Garmin*")).

Patent Owner contends that Ms. Welch's declaration testimony was prepared for the related district court litigation and therefore the cross-examination of Ms. Welch would not fall under routine discovery. Opp. 2–4. Patent Owner contends also that "Petitioner has deposed Ms. Welch on the same testimony in the district court litigation" and that a second deposition will not generate useful information. *Id.* at 5–7. In particular,

[3] The declaration of Ms. Welch was filed under seal as Ex. 2043 and a redacted version was filed as Ex. 2044.

Patent Owner contends that Ms. Welch's statements regarding secondary considerations were addressed in the previous deposition. *Id.* at 6–7 (citing Ex. 2221, 118:25–120:6 (licensing, market share); 211:1–18 (importance of GuideLiner to overall business); 212:11–213:9 (basis for Ms. Welch's testimony); 220:13–221:25 (copying); 234:6–237:5 (copying); 239:20–242:7 (basis for Ms. Welch's testimony); 268:10–269:21 (licensing); 269:22–272:8 (copying); 282:16–283:25 (copying); 294:10–295:21 (sales, market share, licensing)). Thus, according to Patent Owner, another deposition would be redundant and therefore a second deposition is not necessary in the interest of justice. *Id.*

B. Analysis

Discovery is available for the deposition of witnesses submitting affidavits or declarations and for what is otherwise necessary in the interest of justice. 35 U.S.C. § 316(a)(5). Cross–examination of affidavit testimony prepared for the proceeding falls under "routine discovery." 37 C.F.R. § 42.51(b)(1)(ii) ("Cross examination of affidavit testimony prepared for the proceeding is authorized . . . ."). For testimony not prepared for the proceeding, "additional discovery" is available if the party seeking additional discovery can show "that such additional discovery is in the interests of justice." 37 C.F.R. § 42.51(b)(2)(i). In this case, the parties agree that the Ms. Welch's declaration is the same declaration that was prepared for and filed in the related district court litigation rather than the specific proceedings before the Board. Mot. 1; Opp. 2. Consequently, the testimony of Ms. Welch was prepared for another proceeding and her cross-

examination in this proceeding is not "routine discovery." 37 C.F.R. § 42.51(b)(1)(ii).

We thus consider whether cross–examination of Ms. Welch as additional discovery is in the interest of justice under 37 C.F.R. § 42.51(b)(2)(i). The Board has identified factors important in determining whether the additional discovery request meets the standard of being "in the interest of justice." *Garmin* at 6–7. In *Garmin*, we held that the following 5 factors (the so-called "*Garmin* factors") are important in determining whether the additional discovery sought is in the interest of justice: (1) whether there exists more than a possibility and mere allegation that something useful will be discovered; (2) whether the requests seek the other party's litigation positions and the underlying basis for those positions; (3) whether the moving party has the ability to generate equivalent information by other means; (4) whether the moving party has provided easily understandable instructions; and (5) whether the requests are overly burdensome. *Id*.

Having reviewed Patent Owner's request and arguments, we find that the *Garmin* factors do not weigh in favor of allowing additional discovery. In particular, we find *Garmin* Factor 1 dispositive. When assessing this factor, "[t]he mere possibility of finding something useful, and mere allegation that something useful will be found, are insufficient to demonstrate that the requested discovery is necessary in the interest of justice." *Garmin*, Paper 26, at 6. To that point, Petitioner seeks to depose Ms. Welch to uncover "potential related omitted information that may refute

or undercut Patent Owner's arguments." Mot. 1. Here, we agree with Petitioner that

> The very language of this request reveals that Petitioner is merely speculating that omitted information may exist, and that such information, if it does exist, may possibly refute Patent Owner's arguments.

Opp. 5 (emphasis omitted). As noted by Patent Owner, Ms. Welch was previously deposed by Petitioner's counsel in the district court case. Ex. 2221. Insofar as Petitioner seeks an additional deposition to cross-examine Ms. Welch on issues specific to this proceeding, we are not persuaded that Petitioner has shown that such cross-examination of Ms. Welch is in the interests of justice based on the facts and circumstances present here. To the extent that Petitioner is already in possession of relevant information and materials that Ms. Welch omitted from her declaration, Petitioner can identify that information as part of its Reply. Accordingly, in view of the above, we conclude that Petitioner has not met the "necessary in the interest of justice" standard for its request to compel the testimony of Ms. Welch.

We agree with Petitioner, however, "[c]ross-examination is the principal means by which the believability of a witness and the truth of [her] testimony are tested." Mot. 3–4 (quoting *Davis v. Alaska*, 415 U.S. 308, 316 (1974)). As the proponent of the testimony, if the declarant is not made available for cross-examination, Patent Owner runs the risk that the direct testimony will not be considered or that the weight given to her declaration will be minimal. To that point, we note that Patent Owner is not arguing that Ms. Welch could not be made available for deposition and has opted instead to oppose Petitioner's Motion rather than to produce its witness for the

requested limited scope of cross-examination. We will weigh the testimony accordingly.

III. ORDER

It is

ORDERED that Petitioner's Motion to Compel Deposition of Amy Welch is *denied*.

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