

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

CARDIOCOM, LLC
Petitioner

v.

ROBERT BOSCH HEALTHCARE SYSTEMS, INC.
Patent Owner

Case IPR2013-00431 (Patent 7,921,186 B2)
Case IPR2013-00449 (Patent 7,840,420 B2)
Case IPR2013-00468 (Patent 7,516,192 B2)¹

Before STEPHEN C. SIU, JUSTIN T. ARBES, and MIRIAM L. QUINN,
Administrative Patent Judges.

SIU, *Administrative Patent Judge.*

DECISION
On Motion for Additional Discovery
37 C.F.R. § 42.51(b)(2)

¹ This Decision addresses an issue pertaining to all three cases, and IPR2013-00469, which has been joined with IPR2013-00468. We exercise our discretion to issue one Decision to be filed in each case. Unless otherwise stated, the Parties are not authorized to use this style heading for any subsequent papers.

Petitioner has filed a motion for additional discovery. IPR2013-00431, Paper 38; IPR2013-00449, Paper 37; IPR2013-00468, Paper 40. Patent Owner has opposed. IPR2013-00431, Paper 40; IPR2013-00449, Paper 39; IPR2013-00468, Paper 42.

As previously discussed during a conference call held on April 22, 2014 with respective counsel for Petitioner and Patent Owner, Patent Owner had filed a declaration from Yadin David, Ed.D., in which Dr. David concluded that a product (i.e., the “Health Buddy”) demonstrated commercial success based on statements made by various “Bosch personnel.” *See, e.g.*, IPR2013-00431, Ex. 2006, ¶ 66; IPR2013-00449, Ex. 2010, ¶ 77; IPR2013-00468, Ex. 2007, ¶ 79. Petitioner requested that Patent Owner identify the “Bosch personnel” and make the “Bosch personnel” available for deposition because, according to Petitioner, Dr. David “form[ed] the factual basis for his opinions related to purported objective indicia of nonobviousness” based on his interviews with the “Bosch personnel.” IPR2013-00431, Paper 38 at 1; IPR2013-00449, Paper 37 at 1; IPR2013-00468, Paper 40 at 1.

We previously determined that a motion for additional discovery under 37 C.F.R. § 42.51(b)(2) was warranted under the circumstances, and that the motion should include an explanation by Petitioner why it believes depositions are “necessary in the interest of justice” and an identification of “what specific issues would be addressed” during the requested depositions. IPR2013-00431, Paper 35 at 3; IPR2013-00449, Paper 34 at 3; IPR2013-00468, Paper 37 at 3. We also instructed the parties that discovery will not be granted if the requests are unduly broad and burdensome. *Id.* We deny Petitioner’s request for additional discovery for the reasons stated below.

Petitioner provides five (5) “examples of specific issues to be addressed” during the requested depositions with “Bosch personnel”:

The relative sales and success of the Health Buddy and any other telehealth products in 2011-12, when Bosch asserted that the market was still new and Bosch was still attempting to develop a successful telehealth business, and the earlier time frames of purported success referenced in Dr. David's declaration.

Why the Health Buddy was still the subject of an effort to become successful in 2012, including what features of the product or marketing and business characteristics associated with the product and market were the same or different in 2011-2012 vs. prior years.

The credibility and self-interest of the Bosch personnel and Mr. Brown regarding the statements they made to Dr. David.

The sources and veracity of the information underlying the statements, including consideration of the scope and merits of the claimed inventions in the three patents at issue, and what sources of information were relied upon by the witnesses for the statements.

An identification of the specific elements of the Health Buddy that led to the purported commercial success, satisfied a long-felt need, or allegedly were copied by others, and whether those elements correspond to the merits of the claimed inventions.

IPR2013-00431, Paper 38 at 3-4; IPR2013-00449, Paper 37 at 3-4; IPR2013-00468, Paper 38 at 3-4. Petitioner's request is overly broad and burdensome because, instead of providing a list of specific, narrow topics to be discussed during the requested depositions, Petitioner provides a non-limiting list of broad topics (i.e., "examples") to potentially discuss and does not specifically exclude any specific topic for discussion. Indeed, it is not clear what topic, if any, is not available for discussion during the proposed deposition(s).

In addition, given the general nature of Petitioner's proposed "examples" of issues to be potentially discussed at the requested depositions, Petitioner does not demonstrate sufficiently a likelihood that such a general line of questioning would be useful in providing relevant information.

In consideration of the foregoing, it is

ORDERED that Petitioner's motion for additional discovery is denied.

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