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Paper 35
Entered: April 24, 2014

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 IPR2013-00451 (Patent 7,587,469 B2)
Case IPR2013-00468 (Patent 7,516,192 B2)[1]

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

ARBES, *Administrative Patent Judge.*

ORDER
Conduct of the Proceedings
37 C.F.R. § 42.5

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[1] Case IPR2013-00469 has been joined with Case IPR2013-00468. This Order addresses an issue pertaining to all four cases. Therefore, we exercise our discretion to issue one Order to be filed in each case. Other than the motion papers expressly authorized herein, the parties are not authorized to use this style heading for any subsequent papers.

A conference call in the above proceedings was held on April 22, 2014, among respective counsel for Petitioner and Patent Owner, and Judges Siu, Arbes, Moore, Ward, and Quinn. The call was requested by Petitioner to seek authorization to file a motion for additional discovery.

Petitioner argued that Patent Owner filed, with each of its responses in Cases IPR2013-00431, IPR2013-00449, and IPR2013-00468, a declaration from Yadin David, Ed.D. According to Petitioner, Dr. David testifies regarding certain secondary considerations of nonobviousness, such as commercial success, long-felt need, and copying, and in doing so, relies on discussions he had with Patent Owner "personnel" and Stephen J. Brown, the named inventor of the challenged patents. For example, Dr. David states that "the [Patent Owner] personnel [he] interviewed recalled that the Health Buddy was adopted by a number of other hospitals and pharmacies," and "[t]his commercial success is further evidenced" by news articles from the time. *E.g.*, IPR2013-00431, Ex. 2006 ¶ 66; *see also id*. ¶¶ 64, 65, 67, 69, 92, 93, 95. Petitioner argued that discovery regarding Dr. David's discussions is warranted because he relied on them in forming his opinions and, according to Petitioner, Dr. David has insufficient expertise to give the opinions expressed in his declarations absent the information he was provided. Petitioner requested that Patent Owner be required to identify the specific "personnel" with whom Dr. David spoke, and that Patent Owner make the individuals available for deposition.

Patent Owner argued that additional discovery is not necessary because the substance of Dr. David's discussions is recounted in the declarations, Dr. David's opinions are supported by exhibits already in the record, and Petitioner will have an opportunity to ask Dr. David about the

discussions when it deposes him. Patent Owner further argued that the requested depositions would impose an undue burden and costs on Patent Owner, and are unlikely to lead to anything useful in these proceedings. Patent Owner stated that Dr. David spoke with two "personnel" of Patent Owner. Thus, Petitioner's request is for depositions of three individuals (two employees of Patent Owner and Mr. Brown).

As explained during the call, given the statements in Dr. David's declarations, we determine that a motion for additional discovery under 37 C.F.R. § 42.51(b)(2) is warranted under the circumstances. Petitioner in its motion should explain why it believes depositions of the three individuals are "necessary in the interest of justice." *See* 35 U.S.C. § 316(a)(5); 37 C.F.R. § 42.51(b)(2). The parties are directed to *Garmin Int'l, Inc. v. Cuozzo Speed Techs. LLC*, IPR2012-00001, Paper 26 (Mar. 5, 2013), for guidance regarding motions for additional discovery. In particular, the mere possibility of finding something useful and a mere allegation that something useful will be found are insufficient. Further, requests for discovery will not be granted if they are unduly broad and burdensome. Petitioner in its motion should state how much time it requests for each deposition and identify what specific issues would be addressed, should the depositions be permitted.

In consideration of the foregoing, it is hereby:

ORDERED that Petitioner is authorized to file a motion for additional discovery by April 29, 2014, limited to five pages; Patent Owner is authorized to file an opposition by May 6, 2014, also limited to five pages; and no reply is authorized; and

FURTHER ORDERED that the motion and opposition shall be filed in Cases IPR2013-00431, IPR2013-00449, and IPR2013-00468 using a heading for all three proceedings.

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