

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

INTEL CORPORATION,
Petitioner,

v.

TELA INNOVATIONS, INC.,
Patent Owner.

IPR2019-01636 (Patent 10,141,334 B2)
IPR2019-01637 (Patent 10,141,335 B2)¹

Before JO-ANNE M. KOKOSKI, KRISTINA M. KALAN, and
WESLEY B. DERRICK, *Administrative Patent Judges*.

KALAN, *Administrative Patent Judge*.

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

¹ The parties are not authorized to use this style heading for any subsequent papers.

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IPR2019-01637 (Patent 10,141,335 B2)

Tela Innovations, Inc. (“Patent Owner”) contacted the Board via email on April 27, 2020, to request authorization to file a motion for additional discovery regarding: (1) infringement contentions served in the related district court litigation; and (2) sales of Intel Corporation (“Petitioner”) products that are the subject of the related district court litigation. *See* Exhibit A. The Board responded that the request appeared to be similar to Patent Owner’s request in related cases IPR2019-01520, -01521, and -01522. *Id.* The Board asked the parties to indicate whether this was the case, and whether the parties’ positions on briefing were the same as in those related cases. *Id.* The parties replied on April 29, 2020: Patent Owner stated that its proposed motions are for the same or similar documents and would be made for the same or similar reasons as in the related cases; Petitioner stated that it opposed discovery for the same reasons it opposed discovery in the related cases. *Id.*

In related cases IPR2019-01520, -01521, and -01522, a telephone conference was held on April 3, 2020, among respective counsel for Petitioner, Patent Owner, and Judges Kokoski, Kalan, and Derrick. *See, e.g.,* IPR2019-01520, Ex. 1049 (conference call transcript). The subject of the call was Patent Owner’s substantially similar request for authorization to file a motion for additional discovery regarding: (1) infringement contentions served in the related district court litigation; and (2) sales of Petitioner’s products that are the subject of the related district court litigation. During that call, Petitioner articulated its reasons for opposing Patent Owner’s request.

After considering the parties’ arguments in that call, we determined that briefing on Patent Owner’s request for authorization to file a motion for

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additional discovery was warranted. Having considered those arguments, and having been informed by the parties that those arguments are substantially similar to the parties' arguments in the above-identified proceedings, we authorize Patent Owner to file a motion for additional discovery in each of the above-identified proceedings, not to exceed 7 pages. Petitioner is authorized to file an opposition to Patent Owner's motion in each of the above-identified proceedings, also not to exceed 7 pages. No reply is authorized at this time. No additional evidence is authorized with any of the filings.

Patent Owner is reminded that the motion must clearly identify the limited and focused discovery being requested. In addition, the motion must explain, with specific facts and information, why such additional discovery "is in the interests of justice." 37 C.F.R. § 42.51(b)(2)(i). We direct Patent Owner's attention to *Garmin Int'l, Inc. v. Cuozzo Speed Techs. LLC*, IPR2012-00001, Paper 26 at 6–7 (PTAB Mar. 5, 2013) (precedential), which sets forth the factors the Board considers when determining whether additional discovery is in the interests of justice.

Accordingly, it is

ORDERED that Patent Owner's request for authorization to file a motion for additional discovery in each of the above-identified proceedings is GRANTED. The motions are due no later than May 7, 2020, and must not exceed seven pages. Petitioner is authorized to file an opposition to each motion. Petitioner's oppositions are due one week after Patent Owner's motions are filed, and must not exceed seven pages.

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EXHIBIT A

From: Nguyen, Bao <bnguyen@kirkland.com>
Sent: Wednesday, April 29, 2020 12:51 PM
To: Smith, Bryan C. <smithbc@pepperlaw.com>; Trials <Trials@USPTO.GOV>
Cc: #INTEL-TELA-IPR <INTEL-TELA-IPR@kirkland.com>; Friedman, Todd M. <tfriedman@kirkland.com>; Arovas, Greg <garovas@kirkland.com>; Mizzo, F. Christopher <chris.mizzo@kirkland.com>; Leinberg, Gunnar <leinberg@pepperlaw.com>; Gallo, Nicholas J. <gallon@pepperlaw.com>; Zappia, Andrew P. <zappiaa@pepperlaw.com>; McCarthy, Alison L. <mccartha@pepperlaw.com>; Ford, Carla <fordc@pepperlaw.com>; Harris, Jill M. <harrisjm@pepperlaw.com>
Subject: RE: IPR2019-01636 (334) and IPR2019-01637 (335) – Patent Owner Request for Conference Call

Your Honors,

In light of Patent Owner's representation, Petitioner confirms that it opposes the discovery for the same reasons it opposed discovery in the related cases.

Best regards,
Bao

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From: Smith, Bryan C. <smithbc@pepperlaw.com>
Sent: Wednesday, April 29, 2020 8:48 AM
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Subject: RE: IPR2019-01636 (334) and IPR2019-01637 (335) – Patent Owner Request for Conference Call

Your Honors,

In response to the below communication, Patent Owner states that its proposed motions for additional discovery in IPR2019-01636 (334) and IPR2019-01637 (335) are for the

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