

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

FOIL BOARDING COMPANY, INC.

Petitioner,

v.

MHL CUSTOM, INC.

Patent Owner

U.S. Patent No. 9,586,659

IPR Case No.: IPR2024-00085

**PATENT OWNER'S UNOPPOSED MOTION FOR ADDITIONAL
DISCOVERY REGARDING DEPOSITION OF DR. KUTTENKEULER**

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I. STATEMENT OF THE PRECISE RELIEF REQUESTED

Pursuant to 37 C.F.R. §42.51(b)(2)(i) and as authorized by the Board via email to the parties on June 25, 2025, MHL Custom, Inc. (“MHL”), without the opposition of Petitioner, asks the Board to approve additional discovery in the form of cross-examination via deposition of declarant Dr. Jakob Kутtenkeuler.

Dr. Kутtenkeuler's declaration (EX1018) was prepared for prior litigation¹, and accordingly Dr. Kутtenkeuler is not subject to cross-examination as a part of routine discovery. *See Medtronic, Inc. and Medtronic Vascular, Inc. v. Teleflex Innovations S.A.R.L.*, IPR2020-00126, Paper 77 at 4 (Dec. 8, 2020) (“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).”). However, as will be outlined herein, the interests of justice favor allowing MHL to take cross-examination testimony of Dr. Kутtenkeuler limited to the portions of Dr. Kутtenkeuler's declaration relied on by Petitioner. *See Garmin Int'l, Inc. v. Cuzzo Speed Techs. LLC*, Case IPR2012-00001, Paper 26 at 6-7 (Mar. 5, 2013) (precedential).

Specifically, MHL requests cross-examination testimony of Dr. Kутtenkeuler limited to the portions of Dr. Kутtenkeuler's declaration relied on by

¹ *MHL Custom, Inc. v. Waydoo USA, Inc., et al.* (D. Del. 1:21-cv-00091).

Petitioner including the following issues: (1) the alleged publication and public availability of the Evolo Report (*see e.g.*, paragraph 18 of Kутtenkeuler Declaration); (2) the alleged publication and public availability of the Evolo Videos (*see e.g.*, paragraphs 24 and 27 of Kутtenkeuler Declaration); and (3) the Batnytt Article (*see e.g.*, paragraphs 29-31 of Kутtenkeuler Declaration). MHL requests five (5) hours for this cross-examination testimony.

Accordingly, Patent Owner’s motion for additional discovery should be granted.

II. STATEMENT OF REASONS FOR RELIEF REQUESTED

A. Legal Standard

1. The *Garmin* Factors

The Leahy-Smith America Invents Act (“AIA”) and related Regulations empower the PTAB to authorize additional discovery that is necessary “in the interest of justice.” 35 U.S.C. § 316(a)(5); 37 C.F.R. § 42.51(b)(2)(i). The Board generally considers five factors (i.e., the “*Garmin* factors”) in determining whether the interests of justice are served by granting additional discovery requests. *See Garmin Int’l, Inc. v. Cuozzo Speed Techs. LLC*, Case IPR2012-00001, Paper 26, p. 6-7 (Mar. 5, 2013) (precedential).

Furthermore, in line with the Board’s previous rulings. MHL has identified herein a list of specific issues to be addressed, as well as the amount of time

requested for the cross-examination of Dr. Kутtenkeuler. *See Cardiacom, LLC v. Robert Bosch Healthcare Systems, Inc.*, IPR2013-00431, Paper 35 at 3 (April 24, 2014).

B. The Requested Discovery Meets the *Garmin* Factors

1. The Discovery MHL Seeks is Based on More than a Possibility and Mere Allegation

The first *Garmin* factor considers whether there exists more than a “mere possibility” or a “mere allegation that something useful [to the proceeding] will be found.” *Garmin* at 6. A key issue in the proceeding is whether the Evolo Report and/or Evolo Videos qualify as prior art. Petitioner relies on Dr. Kутtenkeuler’s Declaration – specifically, paragraphs 18, 24, 27, and 29-31 – in an attempt to establish the public accessibility of the Evolo Report and/or Evolo Videos prior to the critical date (October 10, 2013).

However, Dr. Kутtenkeuler’s statements lack specificity and MHL should be given the opportunity to test their veracity and discover any information contrary to Petitioner’s position that such statements allegedly establish that the Evolo Report and/or Evolo Videos qualify as prior art. Cross-examination of Dr. Kутtenkeuler’s statements regarding how, when, and where these documents/videos were allegedly uploaded to the internet, their accessibility, and the Batnytt Article is relevant and highly likely to yield information useful to the

proceedings. Dr. Kутtenkeuler, as the person having allegedly uploaded the Evolo Report and at least one of the Evolo Videos, is highly likely to have additional information specific to these events.

The discovery MHL seeks therefore will be useful to this proceeding, satisfying *Garmin* factor 1.

2. MHL Does Not Seek Petitioner’s Litigation Positions or Their Underlying Basis

Garmin factor 2 provides that requesting an opposing party’s “litigation positions and the underlying basis for those positions is not necessary in the interest of justice.” *See Garmin* at 13. MHL’s request for additional discovery is quite narrow and includes only the cross-examination of the portions of Dr. Kутtenkeuler’s declaration relied on by Petitioner in these proceedings. The discovery requested does not seek Petitioner’s underlying litigation positions or bases for them. Furthermore, Petitioner does not oppose this motion for additional discovery. MHL therefore satisfies *Garmin* factor 2.

3. MHL Cannot Generate Equivalent Information by Other Means

Garmin factor 3 relates to whether the requested information is obtainable by the patent owner through other means. Dr. Kутtenkeuler was a faculty advisor to the students involved in the Evolo Project and has testified in his declaration regarding the Evolo Report and Evolo Videos being allegedly uploaded to the

internet. MHL cannot otherwise obtain this information because it is exclusively available through Dr. Kutteneuler, the person who allegedly uploaded the Evolo Report and at least one of the Evolo Videos. MHL therefore satisfies *Garmin* factor 3.

4. The Discovery Requests are Easily Understandable

Garmin factor 4 relates to whether the requested discovery is easily understandable. The requested discovery is easily understandable, as the requested discovery is limited to the cross-examination of the portions of Dr. Kutteneuler's declaration relied on by Petitioner, the specific issues of which are provided herein. Further, the deposition will follow common deposition protocols. MHL therefore satisfies *Garmin* factor 4.

5. The Discovery Requests are Narrowly Tailored and Not Burdensome

Garmin factor 5 relates to the degree of burden the requests place on the petitioner. The requested discovery is narrow and is limited to the cross-examination of the portions of Dr. Kutteneuler's declaration relied on by Petitioner. The request is "sensible and responsibly tailored according to a genuine need." *See Garmin* at 14-16. Furthermore, since Dr. Kutteneuler is located abroad, MHL is willing to take the deposition via video-conference; so, Petitioner's compliance with the requested discovery will not require significant

expenditure of resources. Nor will Petitioner's compliance place a significant burden on meeting deadlines in this proceeding or affect the trial schedule. MHL therefore satisfies *Garmin* factor 5.

IV. CONCLUSION

For the foregoing reasons, MHL respectfully requests that the Board grant MHL's requested additional discovery of the cross-examination of Dr. Kutteneuler.

Dated: June 26, 2024

Respectfully submitted,

/Megan E. Gibson/

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CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.6(e), the undersigned certifies that on June 26, 2024, a copy of this Patent Owner's Unopposed Motion for Additional Discovery was served on the Petitioner's counsel at the email addresses provided in the Petition for service.

Dated: June 26, 2024

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