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Paper 20
Date: June 26, 2025

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

AVANOS MEDICAL, INC.,
Petitioner,

v.

STRATUS MEDICAL, LLC,
Patent Owner.

IPR2024-01209 (Patent 10,966,782)
IPR2024-01210 (Patent 10,736,688)
IPR2024-01211 (Patent 10,736,688)
IPR2024-01212 (Patent 10,925,664)[1]

Before SUSAN L.C. MITCHELL and MICHAEL J. FITZPATRICK, *Administrative Patent Judges*.

FITZPATRICK, *Administrative Patent Judge*.

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

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[1] This Order is being entered in the four proceedings identified. The parties may not file papers captioned for multiple proceedings.

A conference call was held with the Board on June 24, 2025. The conference call was requested by Petitioner. Chris Kelly spoke for Petitioner, and Matthew Phillips spoke for Patent Owner, although there were additional attorneys listening to the call.

The purpose of the call was to discuss Petitioner's requests for production ("RFPs") and the location of Petitioner's deposition of Patent Owner's witness, Professor Marc Russo. Petitioner's email to the Board requesting the call and Petitioner's attachment to the email are of record in all four proceedings as Exhibit 3002.

PETITIONER'S REQUESTS FOR PRODUCTION

Petitioner served seven RFPs on Patent Owner, which it states were necessary to respond to Patent Owner's secondary considerations argument raised in Patent Owner's Response. Ex. 3002. Our Rules contemplate the production of certain documents. For example, and for obvious reasons, a party must produce "any exhibit cited in a paper or in testimony." 37 C.F.R. § 42.51(b)(1)(i). The production of additional documents is also contemplated in certain instances, such as when the parties have agreed to do so as either "mandatory discovery" or "additional discovery," when documents are "inconsistent with a position advanced by [a] party during the proceeding," and "[w]hen appropriate . . . during cross examination." *Id.* at § 42.51(a)(1), (b)(2)(i), (b)(1)(iii), and (b)(2)(ii). However, our Rules do not expressly obligate a party to respond to RFPs. Thus, a party serving RFPs, here Petitioner, "must show that such additional discovery is in the interests of justice." *Id.* at § 42.51(b)(2)(ii).

During the call, we authorized Petitioner to file a motion for compelling the discovery sought by the RFPs, the terms of said authorization being specified below. To warrant granting, said motion must show that discovery of the requested documents/things is in the interests of justice. *Id.*

DEPOSITION OF PROF. RUSSO

Patent Owner filed and served a declaration by Professor Marc Russo in support of positions taken in the Patent Owner Response. *See* Papers 13 and 14[2]; Ex. 2001. In his curriculum vitae, Prof. Russo states that he resides in New South Wales, Australia. Ex. 2002.

Patent Owner has offered Prof. Russo to be deposed virtually by videoconference from his home in Australia. Alternatively, Patent Owner has offered Prof. Russo to be deposed in person in Hawaii, as it is the closest U.S. state to Australia. Petitioner requests that Prof. Russo instead be deposed in person at a reasonable location within the contiguous United States.

Our Rules "do not provide for a specific location for taking testimony other than providing that the testimony may be taken at any reasonable location in the United States." *Consolidated Trial Practice Guide* (Nov. 2019), 33.[3] The Board would like to see the issue worked out among the

[2] We cite to the record in IPR2024-01209 as exemplary. Patent Owner filed its Patent Owner Response under seal (Paper 13), along with a redacted public version (Paper 14).

[3] *See* https://www.uspto.gov/sites/default/files/documents/tpgnov.pdf?MURL=TrialPracticeGuideConsolidated.

parties. If the parties cannot, the Board will decide the terms of Prof. Russo's deposition (or the consequence of a failure to make him reasonably available for it). A process for the parties to follow is laid out below.

ORDER

Accordingly, it is

ORDERED that Petitioner may file, no later than June 25, 2025, a motion for additional discovery to compel Patent Owner to produce documents/things in response to Petitioner's RFPs, said RFPs limited in scope to those already conveyed in writing by Petitioner to Patent Owner (i.e., the requests may not be expanded, although they may be narrowed);

FURTHER ORDERED that, if Petitioner files such a motion, Petitioner must file, as an exhibit, the RFPs that are the subject of its motion concurrently with said motion;

FURTHER ORDERED that Patent Owner may file an opposition to the motion no later than July 3, 2025;

FURTHER ORDERED that the motion and opposition are each limited to ten pages, and no reply brief is authorized; and

FURTHER ORDERED that the parties confer further in good faith prior to the close of business on June 30, 2025, regarding the location and any other disputed terms of the deposition of Patent Owner's witness, Professor Marc Russo; and

FURTHER ORDERED that, if the parties cannot reach an agreement by July 1, 2025, Petitioner, after consulting with Patent Owner, must send an

email to Board staff at Trials@uspto.gov, copying counsel for Patent Owner and identifying the specific terms demanded by each party as to the deposition of Prof. Russo.

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