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Paper 26
Date: July 21, 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, MICHAEL J. FITZPATRICK, and JOHN G. NEW, *Administrative Patent Judges*.

FITZPATRICK, *Administrative Patent Judge*.

ORDER
Denying Petitioner's Motion For Additional Discovery
37 C.F.R. § 42.51(b)(2)

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[1] This Order is being entered in each of the four proceedings identified. The proceedings have not been consolidated. The parties may not file papers captioned for multiple proceedings unless authorized to do so.

On June 25, 2025, Petitioner, Avanos Medical, Inc., timely filed a Motion for Additional Discovery under 37 C.F.R. § 42.51(b)(2). Paper 21 ("Mot.").[2] We authorized the Motion during a conference call held June 24, 2025. Paper 22. Patent Owner, Stratus Medical, LLC, timely filed an Opposition on July 3, 2025. Paper 23 ("Opp."). No reply brief was authorized or filed.

Petitioner's Motion seeks production of certain documents. As explained below, we deny Petitioner's Motion without prejudice.

I. BACKGROUND

Petitioner served seven Requests for Production ("RFPs") on Patent Owner, which Petitioner eventually filed into the record. *See* Ex. 1037. Our Rules do not expressly provide for the service of RFPs; nor do they obligate a served party to respond to RFPs. 37 C.F.R. § 42.51. Nevertheless, according to Petitioner, "Patent Owner agreed to produce certain documents and things in response to some (but not all) RFPs," and "Petitioner agrees to the scope of discovery that Patent Owner previously agreed to produce with respect to RFPs 4–7." Mot. 2.

Petitioner's Motion concerns only RFPs 1–3 only, which state the following:

> **RFP No. 1**: Documents sufficient to show Patent Owner's sales in units, gross revenue, and net revenue for each Nimbus® Multitined Expandable Electrode Product Code (including a description of the device associated with each product code) for each of the fiscal years 2020, 2021, 2022, 2023, and 2024.

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[2] We cite to papers in IPR2024-01210 as exemplary for all four cases identified in the caption above.

> **RFP No. 2**: Documents sufficient to show Patent Owner's sales in units, gross revenue, and net revenue for each Nimbus® Probe RF Thermocouple Electrode Product Code (including a description of the device associated with product code) for each of the fiscal years 2020, 2021, 2022, 2023, and 2024.
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> **RFP No. 3**: All documents and electronically stored information relied on by Cody Jorgensen to prepare the information in paragraphs 16 through 27 (and the associated charts and graphics) of his declaration (Patent Owner's Exhibit 2015).

Ex. 1037, 4.

II. LEGAL PRINCIPLES

The AIA was "designed to establish a more efficient and streamlined patent system that will improve patent quality and limit unnecessary and counterproductive litigation costs." H.R. Rep. No. 112–98, 40 (2011); *see also id*. at 48 (Post grant reviews were meant to be "quick and cost effective alternatives to litigation"). Consistent with that design, Congress limited discovery in AIA cases relative to that available in district court litigation. Specifically, and in regards to *inter partes* reviews, Congress instructed that "discovery shall be limited to—(A) the deposition of witnesses submitting affidavits or declarations; and (B) what is otherwise necessary in the interest of justice." 35 U.S.C. § 316(a)(5).

Our Rules do 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 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).

In *Garmin Int'l, Inc. v. Cuozzo Speed Techs. LLC*, No. IPR2012-00001 (PTAB Mar. 5, 2013) (Paper 26) (precedential), the Board listed five "factors" that "are important" in determining whether additional discovery would be in the interests of justice. *Id.* at 6–7. The *Garmin* factors are: "1. More Than A Possibility And Mere Allegation[;] 2. Litigation Positions And Underlying Basis[;] 3. Ability To Generate Equivalent Information By Other Means[;] 4. Easily Understandable Instructions[; and] 5. Requests Not Overly Burdensome To Answer." *Id.*

Guided by these factors, and as explained below, we determine Petitioner has not shown that the discovery it seeks would be in the interests of justice.

III. ANALYSIS

RFPs 1 and 2 generally seek detailed sales and revenue documents regarding certain Patent Owner products. Ex. 1037, 4. RFP 3 generally seeks all information relied on by Mr. Jorgensen[3] to prepare certain testimony and accompanying graphics regarding alleged commercial success of the Nimbus device. Ex. 1037, 4; *see also* Ex. 2016 ¶¶16–27.

Under *Garmin* factor 3, Petitioner states the following:

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[3] According to Mr. Jorgensen, he is Director of Marketing for Patent Owner Stratus. Ex. 2015 ¶4.

> RFPs 1 and 2 relate to Patent Owner's sales information, which Patent Owner has designated as confidential and is not accessible by Petitioner. POR at 68; Ex-2016, ¶15. RFP 3 relates to documents relied on by Mr. Jorgensen in preparing his declaration, which are not known to Petitioner or otherwise accessible without a discovery request. Patent Owner has also designated the majority of Mr. Jorgensen's testimony regarding its U.S. market as confidential. POR at 69–73; Ex-2016, ¶16–27.

Mot. 9.

The Motion is denied without prejudice.

As part of routine discovery, Petitioner may cross-examine Mr. Jorgensen about his direct testimony, including the cited paragraphs 15 through 27 of his Declaration. *See* 37 C.F.R. § 42.51(b)(1)(ii) ("Cross examination of affidavit testimony prepared for the proceeding is authorized within such time period as the Board may set."). Accordingly, at this point in the process, we are not persuaded that it would be in the interests of justice to grant the Motion. *See Garmin*, at 6 (stating with respect to *Garmin* factor 3: "Information a party can reasonably figure out or assemble without a discovery request would not be in the interest of justice to have produced by the other party.").

IV. ORDER

Accordingly, it is

ORDERED that Petitioner's Motion is denied without prejudice.

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