IN THE UNITED STATES DISTRICT COURT
FOR THE WESTERN DISTRICT OF TENNESSEE
WESTERN DIVISION

MEDTRONIC SOFAMOR DANEK, INC.,	)	
	)	
Plaintiff/	)	
Counterclaim Defendant,	)	
	)	
vs.	)	No. 01-2373-MlV
	)	
GARY KARLIN MICHELSON, M.D.	)	
and KARLIN TECHNOLOGY, INC.,	)	
	)	
Defendants/	)	
Counterclaimants,	)	
	)	
and	)	
	)	
GARY K. MICHELSON, M.D.,	)	
	)	
Third Party Plaintiff,	)	
	)	
vs.	)	
	)	
SOFAMOR DANEK HOLDINGS, INC.	)	
	)	
Third Party Defendant.	)	

ORDER DENYING DEFENDANT MICHELSON'S MOTION TO COMPEL FURTHER ANSWERS TO INTERROGATORY NUMBER ELEVEN

Before the court is the March 27, 2003 motion of the defendant Gary K. Michelson, M.D., pursuant to Rule 37, to compel the plaintiff, Medtronic Sofamor Danek, Inc., to answer more fully Interrogatory No. 11 of Michelson's First Set of Interrogatories propounded on September 24, 2001. (Docket No. 330.) The motion was referred to the United States Magistrate Judge for determination.

For the reasons that follow, the motion is denied.

Interrogatory No. 11 asks:

> **For each and every medical device, technology, implant, instrument, method or process based on or incorporating in whole or in part any invention, conception, development, acquisition or possession of Dr. Michelson that has been commercialized anywhere in the world by you or any person to whom you provided such medical device, technology, implant, instrument, method or process, identify [1] the patent numbers, if any, marked on each such medical device, technology, implant, instrument, method or process or on any literature associated therewith and [2] the numbers of all patents or patent applications naming Dr. Michelson on which each such medical device, technology, implant, instrument, method or process is based or which each such medical device, technology, implant, instrument, method or process incorporates.**

Pl.'s Am. Resp. to Defs.' First Set of Interr. at 38. In essence, the interrogatory seeks two categories of information. First, it asks for the patent numbers marked on each medical device that Medtronic has commercialized anywhere, anytime, which incorporates in whole or part one of Dr. Michelson's inventions. Second, it seeks the patent numbers upon which each of Medtronic's medical devices were based.

Medtronic objected to the interrogatory as vague, unduly burdensome, and not calculated to reveal relevant information. Despite its objections, Medtronic has provided, in answer to Interrogatory No. 11, the "marking statements" on each Medtronic product. The "marking statements" contain the patent numbers

marked on each product. In its response to the interrogatory, Medtronic quoted verbatim the two marking statements it uses on three groups of products. In the first group of 310 products, each product is marked with the following statement which identifies three patents:

> Protected by one or more of the following U.S. Patents: 5,015,247 6,149,650 6,264,656.

In the second group of 460 products and in the third group of 19 products, each product is marked with the following statement which identifies twelve patents:

> Protected by one or more of the following U.S. Patents: 5,484,437 5,522,899 5,741,253 5,772,661 5,785,710 5,797,909 6,080,155 6,096,038 6,159,214 6,210,412 6,224,595 6,270,498.

In addition, in answer to Interrogatory No. 12, Medtronic has provided the patent numbers marked on its literature and on packages for discontinued products, to the extent they still exist. Medtronic has incorporated its response to No. 12 in its response to No. 11. Further, by identifying the patent numbers marked on each product, Medtronic maintains that, ipso facto, it has identified the products which are "based" on technology invented by Michelson.

Michelson complains that Medtronic's answer is insufficient because it fails to identify each particular patent that corresponds to each Medtronic product. Michelson asserts that

Medtronic has both a contractual duty and statutory duty to list on its products the patents that cover each product. Michelson further claims that this information is relevant to his counterclaim and indeed necessary for him to evaluate whether Medtronic is providing proper name attribution and notice under the agreements, whether Medtronic is using its best efforts to market Michelson's technology, and to determine royalties.

Both the December 31, 1993 License Agreement between Medtronic and Karlin and the January 11, 1994 Purchase Agreement between Medtronic and Michelson require Medtronic to "identify in its literature that the Medical Device and the Technology were developed by Michelson . . . and [to use] proper patent notices." (Decl.of Dinn, Ex. B @ 4.5; Ex. C @ 4.6.)

In addition, Section 287(a) of Title 35, U.S.C., provides:

> **Patentees, and persons making, offering for sale, or selling within the United States any patented article for or under them . . . may give notice to the public that the same is patented, either by fixing thereon the word "patent" or the abbreviation 'pat.', together with the number of the patent, or when, from the character of the article, this cannot be done, by fixing to it, or to the package wherein one or more of them is contained, a label containing a like notice. In the event of failure so to mark, no damages shall be recovered by the patentee in any action for infringement . . . .**

35 U.S.C. § 287(a).

The first inquiry in Interrogatory No. 11 does not require Medtronic to identify each particular patent which corresponds to

each Medtronic product. Rather, it merely requests Medtronic to supply the patent numbers that are marked on Medtronic products, literature, and packaging. This Medtronic has done by listing verbatim the marking statements placed on each product.

The second inquiry in Interrogatory No. 11 does require Medtronic to indicate each and every patent upon which each Medtronic product is based. Medtronic objects, however, that one-to-one matching of Michelson's patents with Medtronic's products are irrelevant to the issues in Michelson's counterclaim for a number of reasons. First, Medtronic's obligations under the agreements to provide proper patent notice on its products only require it to list one or more of, but not all, the patents associated with the product. In addition, such notice is proper under patent laws. Second, Medtronic is obligated to pay the same royalties on the sale of products and use its best efforts to promote the sale of products whether there is one patent or one hundred patents associated with a product. Royalties under the agreements are determined by Medtronic the sale of "products" incorporating Michelson's patents, not by a particular patent or patents.

After careful consideration of the parties' respective

arguments, the briefs, and exhibits,[1] the court finds Medtronic's relevancy and undue burden objections to be well-taken. A one-to-one matching of patents to products is not relevant to Michelson's marking, name recognition, best efforts and royalty counterclaims. Moreover, this information is not currently in Medtronic's possession and would have to be compiled by reviewing the 1,228 patent claims in the 15 patents at issue to determine if one of the claims is incorporated into one of the 789 products in question. This analysis would be extremely time-consuming and costly.

Accordingly, the court finds that Medtronic has answered fully Interrogatory No. 11, and Michelson's motion to compel is denied.

IT IS SO ORDERED this 12th day of May, 2003.

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DIANE K. VESCOVO
UNITED STATES MAGISTRATE JUDGE

[1] In reaching this decision, the court has considered the arguments presented by Michelson in his reply.