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

MEDTRONIC SOFAMOR DANEK, INC.,	)	
	)	
Plaintiffs/	)	
Counterclaim Defendant,	)	
	)	
vs.	)	No. 01-2373 MlV
	)	
GARY K. 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 GRANTING DEFENDANTS' MOTION TO COMPEL FURTHER RESPONSES TO DISCOVERY REQUESTS TO WHICH PLAINTIFF OBJECTED ON THE BASIS OF THE COURT'S MAY 13, 2003 ORDER RE INTERROGATORY NO. 11

Before the court is the November 10, 2003 motion of the defendants Gary Karlin Michelson ("Michelson") and Karlin Technology, Inc. ("KTI") seeking to compel plaintiff Medtronic Sofamor Danek, Inc. ("Medtronic") to respond fully to one interrogatory and a series of requests for admission to which Medtronic objected on the basis of the court's May 13, 2003 order regarding Interrogatory No. 11. The motion was referred to the

United States Magistrate Judge for a determination. Medtronic timely responded on December 3, 2003. For the reasons that follow, the motion is granted.

Briefly, this case involves a dispute between the parties over Medtronic's rights to intellectual property invented by Michelson in the field of spinal fusion technology. In the course of this litigation, the parties' have had numerous disputes over discovery requests. One of the previous disputes involved Medtronic's objection to Michelson's Interrogatory No. 11, which in essence asked Medtronic to identify the patent number(s) that corresponded to each Medtronic product incorporating Dr. Michelson's inventions. (Defs.' Mem. of P. & A. in Supp. of Mot. to Compel Further Resps. to Disc. Reqs. to which Medtronic Objected on the Basis of the Ct.'s May 13, 2003 Order, Ex. 1 at 2.) Medtronic objected Interrogatory No. 11 on the basis that it did not have such information in its possession and that it would be overly burdensome to provide such a "one-to-one" correlation. (*See* Medtronic's Mem. in Opp'n to Dr. Michelson's Mot. to Compel Further Answers to Interrog. No. 11 at 13-14.) In a decision rendered on May 13, 2003, the court denied Dr. Michelson's motion to compel, finding Medtronic's relevancy and undue burden objections to be well-taken. (Order Den. Def. Michelson's Mot. to Compel Further Answers to Interrog. No. 11, *Medtronic Sofamor Danek, Inc. v. Michelson*, Civil Case No. 01-2373-MlV at 6 (W.D. Tenn, May 13, 2003). Furthermore, the court stated that a "one-to-one matching of patents to products" would be "extremely time-consuming and costly." (*Id.*) Michelson and KTI appealed the court's May 13,

2003 order on May 28, 2003. (Defs.' Mem. of P. & A. in Supp. of Mot. to Compel Further Resps. to Disc. Reqs. to which Medtronic Objected on the Basis of the Ct.'s May 13, 2003 Order, Ex. 1 at 2.)

The motion presently before the court involves Medtronic's reliance on the court's May 13, 2003 order as the basis for its refusal to respond fully to Interrogatory No. 4 and defendants' Requests for Admissions Nos. 3056 through 3150 and Nos. 3162 through 3961. The interrogatory at issue, No. 4, was served on Medtronic and was included in Dr. Michelson's Second Set of Interrogatories. Interrogatory No. 4 asks Medtronic:

> For each and every Royalty Product (as that term is defined in the November 2, 1999 agreement between Dr. Michelson and SDGI Holdings, Inc.), identify the product name, product number, and patent number of each patent the disclosure or claimed subject matter of which covers or is incorporated in that Royalty Product.

(Schultz Decl. in Supp. of Defs.' Mot. to Compel Further Resps. to Disc. Reqs. to which Medtronic Objected on the Basis of the Ct.'s May 13, 2003 Order, Ex. 3 at 5.) Medtronic served its responses on October 31, 2003. In its response, Medtronic objected to Interrogatory No. 4 on the basis that it called for a legal conclusion, that it was overly broad by requiring identification of "the patent number of each patent," and that matching patents to individual products was unduly burdensome. (*Id.*, Ex. 3 at 6.) When Michelson and KTI expressed their dissatisfaction with Medtronic's response to Interrogatory No. 4 in a letter dated November 4, 2003, Medtronic responded that the information Michelson and KTI sought was governed by the court's May 13, 2003 order regarding Interrogatory No. 11. (*Id.* ¶ 2.) Therefore,

Medtronic claimed that it need not identify the patent number of each patent and that the information was otherwise irrelevant. (*Id.*)

Medtronic also relied on the court's May 13, 2003 order as one of its reasons for refusing to answer Michelson's requests seeking admissions from Medtronic that it had not used its best efforts with respect to specific items that it received under the Purchase Agreement. (*See* Schultz Decl. in Supp. of Defs.' Mot. to Compel Further Resps. to Disc. Reqs. to which Medtronic Objected on the Basis of the Ct.'s May 13, 2003 Order, Ex. 6 at 1-2.) Requests Nos. 3056 through 3150 of Michelson's and KTI's Fourth Set of Requests for Admission ask Medtronic to admit that it did not obtain regulatory approval for or actively promote the sale of any products that utilize any of the technology disclosed or claimed in several patents. (Defs.' Mem. of P. & A. in Supp. of Mot. to Compel Further Resps. to Disc. Reqs. to which Medtronic Objected on the Basis of the Ct.'s May 13, 2003 Order, Ex. 5 at 33-145.) Specifically, the requests ask for the following:

> Admit that you have not["obtained regulatory approval for any"] [or "sought to obtain regulatory approval for any"] [or "filed for regulatory approval for any"] [or "actively promoted the sale of the] [Medical Device] [or product] that utilizes Technology disclosed or claimed in U.S. Patent No. ___.

(*See id.*)

Requests Nos. 3162 through 3961 ask Medtronic to admit that no "unreasonable or unnecessary regulatory, legal, financial, or commercial risk or commitment" precluded Medtronic from using its best efforts to commercialize products that incorporate technology

disclosed or claimed in specific patents. (*Id.* at 145-947.) The requests seek separate admissions for each year from 1994 through 2001, for each type of "risk or commitment," and for each of the several patents that Medtronic contends are at issue.[1]

In Medtronic's response to the requests for admission, Medtronic objected to all 928 requests on the basis that they were "burdensome, harassing, and duplicative." (*Id.*) Medtronic also claimed that the requests were "vague, ambiguous, and contrary to Rule 36(a)." (*Id.*) When Michelson and KTI contacted Medtronic about its objections to the requests for admissions, Medtronic responded by letter, dated August 26, 2003, that its "only objections to responding to these requests related to the reasoning of the Court's May [13] Order." (*Id.*, Ex. 6 at 1-2.)

After several consultations with Medtronic regarding the requests for admissions and Interrogatory No. 4, Michelson and KTI filed the present motion to compel. In their argument in support of their motion, Michelson and KTI assert that the court should

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[1] Specifically, Requests Nos. 3162-3961 ask Medtronic to:

> Admit that in [1994 through 2001] no "unreasonable or unnecessary [regulatory] [or legal] [or financial] [or commercial] risk or commitment" (as that phrase is used in paragraph 4.5 of the Purchase Agreement) precluded Medtronic from seeking regulatory approval for any Medical Device that utilizes Technology disclosed or claimed in U.S. Patent No. __.

(*See* Defs.' Mem. of P. & A. in Supp. of Mot. to Compel Further Resps. to Disc. Reqs. to which Medtronic Objected on the Basis of the Ct.'s May 13, 2003 Order, Ex. 5 at 145-947.)

grant the present motion if United States District Judge Jon P. McCalla were to grant their appeal of this court's May 13, 2003 order because Medtronic has relied on the May 13, 2003 order in its refusal to respond to Michelson's and KTI's discovery requests. (Defs.' Mem. of P. & A. in Supp. of Mot. to Compel Further Resps. to Disc. Reqs. to which Medtronic Objected on the Basis of the Ct.'s May 13, 2003 Order at 1.) Before Medtronic had an opportunity to respond to the defendants' motion, Judge McCalla granted Dr. Michelson's appeal of the May 13, 2003 order. Order Granting Appeal and Objections to Magistrate Judge's Order Entered May 13, 2003, *Medtronic Sofamor Danek, Inc. v. Michelson*, Civil Case No. 01-2373-MlV (W.D. Tenn, Nov. 14, 2003.) In his ruling, Judge McCalla found that a one-to-one matching of the patents to the corresponding products was "relevant to Dr. Michelson's proper patent notice, proper payment of royalties and best efforts claims" and that it was not "unduly burdensome given the importance of this information to the proper resolution of the case." (*Id.* at 4.) He ordered the parties to fully answer Interrogatory No. 11.

In response to Judge McCalla's ruling, Medtronic filed a Motion for Reconsideration and for Clarification of the Court's November 14 Order on December 1, 2003. (*See* Pl.'s Opp'n to Defs.' Mot. to Compel Further Resps. to Disc. Reqs. Relating to the Magistrate Judge's May 13, 2003 Order at 1-2.) Medtronic's motion for reconsideration is still pending. Meanwhile, Medtronic has responded to the present motion and has offered to supplement its responses to Interrogatory No. 4 in a manner consistent with the arguments set forth in its motion for reconsideration of Judge

McCalla's November 14, 2003 order. (*Id.* at 5.)

ANALYSIS

In light of Judge McCalla's order on Interrogatory No. 11, Medtronic now opposes Michelson's and KTI's motion on essentially two grounds: (1) that the motion is moot as to Interrogatory No. 4 because Medtronic has consented to supplement its responses and (2) that the defendants' requests for admissions violate Rule 36(a) of the Federal Rules of Civil Procedure. The court disagrees on both counts.

First, the court agrees that the present motion to compel Medtronic to fully respond to Interrogatory No. 4 is moot; however, the court's finding is not based on Medtronic's consent to supplement its responses. Medtronic has qualified its consent to supplement its responses by offering to do so in a manner "consistent with the arguments set forth in [Medtronic's] Motion for Reconsideration and/or Clarification of the November 14 Order." (*Id.*) Medtronic's qualified consent does not render the defendants' motion moot. On the other hand, Judge McCalla's November 14 order does render the defendants' motion moot as such because that order reasoned that "a one-to-one matching of the patents to the corresponding products is relevant to Dr. Michelson's proper patent notice, proper payment of royalties and best efforts claims." Order Granting Appeal and Objections to Magistrate Judge's Order Entered May 13, 2003, *Medtronic Sofamor Danek, Inc. v. Michelson*, Civil Case No. 01-2373-MlV at 4 (W.D. Tenn, Nov. 14, 2003.) This reasoning is controlling in the present discovery dispute over Interrogatory No. 4. Consequently,

Medtronic is ordered to supplement its responses to Interrogatory No. 4 in accordance with the court's November 14, 2003 order.

As to the requests for admissions, Medtronic now argues that the requests for admissions violate Rule 36(a) of the Federal Rules of Civil Procedure because they fail to "separately set forth" "each matter of which an admission is requested" by merging multiple matters into each request. (Pl.'s Opp'n to Defs.' Mot. to Compel Further Resps. to Disc. Reqs. Relating to the Magistrate Judge's May 13, 2003 Order at 2.) The court finds that Medtronic's present argument is without merit.

Michelson and KTI have formulated almost 100 requests for admissions that relate to the specific issue of whether Medtronic has used its best efforts with respect to specific items that it received under the Purchase Agreement. For example, Request for Admission No. 3076 specifically asks Medtronic to "[a]dmit that you have not obtained approval for any product that utilizes Technology disclosed or claimed in U.S. Patent No. 5,522,899." (Schultz Decl. in Supp. of Defs.' Mot. to Compel Further Resps. to Disc. Reqs. to which Medtronic Objected on the Basis of the Ct.'s May 13, 2003 Order, Ex. 5 at 55.) Furthermore, Michelson and KTI have propounded approximately 799 requests asking Medtronic to admit that no "unreasonable or unnecessary regulatory, legal, financial, or commercial risk or commitment" precluded Medtronic from using its best efforts to commercialize products that incorporate technology disclosed or claimed in specific patents. The separate requests seek admissions for each year from 1994 through 2001, for each type of "risk or commitment," and for each of the several

patents that Medtronic contends are at issue. Rule 36(a)provides that "[u]nless the court determines that an objection is justified, it shall order that an answer be served." FED. R. CIV. P. 36(a). After reviewing the requests at issue, the court finds that Michelson's and KTI's Requests for Admissions Nos. 3056 through 3150 and Nos. 3162 through 3961 are properly worded and satisfy the requirements of Rule 36(a). Accordingly, Medtronic's objections are not justified and are overruled.

CONCLUSION

For all of the foregoing reasons, Medtronic's objection to Interrogatory No. 4 is moot, and Michelson's and KTI's motion to compel is granted as to that interrogatory. Additionally, Medtronic's objections to Requests for Admissions Nos. 3056 through 3150 and Nos. 3162 through 3961 are overruled, and Medtronic is ordered to admit, deny, or "set forth in detail" the reasons why it cannot admit or deny the requests in accordance with Rule 36(a). FED. R. CIV. P. 36(a). Medtronic is hereby ordered to supplement its responses to Interrogatory No. 4 and Requests for Admissions Nos. 3056 through 3150 and Nos. 3162 through 3961 within ten (10) days of the entry of this order. Each party is to bear the cost of its own attorney fees.

IT IS SO ORDERED this 11th day of December, 2003.

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DIANE K. VESCOVO
UNITED STATES MAGISTRATE JUDGE