

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 DENYING DEFENDANT MICHELSON'S MOTION TO COMPEL DOCUMENTS
RE NAME ATTRIBUTION AS MOOT

Before the court is the November 10, 2003 motion of defendant Gary K. Michelson, M.D., seeking to compel plaintiff Medtronic Sofamor Danek, Inc. ("Medtronic") to produce materials responsive to several requests for production of documents related to the name attribution provisions of the parties' agreements. Alternatively, in the event Medtronic contends that it has already produced the materials, Michelson asks that Medtronic be required to identify the items related to name attribution by Bates-stamp number. 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 denied as moot.

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. The motion presently before this court involves Medtronic's alleged failure to provide Michelson with materials falling into two categories: (1) "items that relate to whether Medtronic complied with its name attribution duties, including with the preliminary injunction order" and (2) "items that constitute 'literature' and are therefore subject to name attribution." (Mem. of P. & A. in Supp. of Defs.' Mot. to Compel Docs. Regarding Name Attribution at 1.) Specifically, Michelson claims that Medtronic has failed to produce all documents responsive to Requests Nos. 94, 95, and 96 of Michelson's First Set of Requests for Production ("First Set of Requests"), Requests Nos. 42 and 43 of Michelson's Ninth Set of Requests for Production ("Ninth Set of Requests"), and Requests Nos. 32, 33, 34, 35, 36, 37, 38, and 39 of Michelson's Tenth Set of Requests for Production ("Tenth Set of Requests"). (*Id.*)

Michelson's assertions that Medtronic has failed to produce responsive documents are based on Medtronic's actions at the October 9, 2003 contempt hearing and its recent supplemental response Interrogatory No. 6 of Karlin Technology, Inc.'s ("KTI") First Set of Interrogatories. (*Id.*) Michelson claims that he has been unable to locate the following twenty-one items referenced by Medtronic at the contempt hearing that are responsive to Requests Nos. 32, 33, 34, and 35:

1. Documents related to the stickering process and all correspondence between Medtronic and whoever printed the stickers or who was otherwise involved in the stickering process, including proofs and approvals for the labels, noted by Ms. McCain. (*Id.* at 2.)

2. The list of part numbers used to change from an old literature identification number to a new literature identification number, identified by Ms. McCain. (*Id.*)
3. The list of items identified as Dr. Michelson literature to be put on hold. (*Id.*)
4. All directives that were sent out requesting that all Michelson-related literature be returned to the marketing department as well as any correspondence relating to those directives or the destruction of these documents. (*Id.*)
5. All (from January 1994 to the present) records that show how many of each piece of literature has ever been shipped. (*Id.*)
6. All invoices and timesheets for any temporary or contract workers and paralegals, not simply those relating to the May-June period. (*Id.*)
7. The computer-generated report showing what was shipped from the time of the release of the labeled items to the time they were put back on hold; including the information regarding the recipients of the items (by name and person). (*Id.*)
8. The reports relating to the counts of the [thirty] items of double-stickered literature, mentioned by Ms. McCain. (*Id.*)
9. The documents constituting the computer count of the inventory that needed to be fixed, identified by Ms. McCain. (*Id.* at 3.)
10. All monthly reports which broke-out each individual piece of literature identified by Ms. McCain. (*Id.*)
11. The documents constituting the information regarding literature that were pulled from Medtronic's computer system, identified by Ms. McCain. (*Id.*)
12. The "different" documents compiled by Medtronic regarding the literature, referred to by Ms. McCain. (*Id.*)

13. The reference sheets which show the new numbers assigned to old literature, as identified by Ms. McCain. (*Id.*)
14. The documents constituting the individual counts of items affected, pulled from Medtronic's computers and the documents constituting the written information related thereto, identified by Ms. McCain. (*Id.*)
15. The literature translations created for Hungary and the Czech Republic. (*Id.*)
16. The results of the review of all the foreign literature returned to Memphis, as noted by Mr. Powers. (*Id.*)
17. All communications relating to compliance with the injunction, such as the e-mails identified by Mr. Powers and the other communications identified. (*Id.*)
18. The "Corporate Standards Procedure Book" identified by Ms. McCain during her 30(b)(6) deposition. (*Id.*)
19. All documents and correspondence with printers, both in the U.S. and outside of the U.S. regarding changing/providing attribution for Dr. Michelson and the reprinting of literature. (*Id.*)
20. All documents and correspondence relating to restarting the distribution of any literature. (*Id.*)
21. Printouts or copies of the web pages that were altered as a result of the preliminary injunction and all correspondence (as well as all other responsive documents) to and from the individuals and departments that are responsible for the content of Medtronic's web pages, relating to providing Dr. Michelson attribution as a result of the preliminary injunction. (*Id.* at 4.)

Michelson also claims that Medtronic has not produced two power point presentations and all of its foreign literature that were requested in Requests Nos. 36 through 39. (*Id.* at 5.) Michelson relies on the fact that Medtronic waited until right before the contempt hearing to begin producing samples of the

foreign literature to support his assertion that additional foreign literature exists other than that produced at the contempt hearing. Because the foreign items produced before the hearing were numerous, Michelson surmises, based on timing and volume, that all foreign literature has not been produced. (*Id.*) Michelson also asks that Medtronic be ordered to produce two power point presentations, identified as "TLAP ST.PPT" and "CLAP ST.PPT," that were cited in Medtronic's response to Interrogatory No. 12 of Michelson's Tenth Set because Michelson has not been able to locate them in Medtronic's production.

Additionally, based on a table that Medtronic submitted in a supplemental response to KTI's Interrogatory No. 6, Michelson asserts that Medtronic has not produced all documents responsive to Request for Production Nos. 94 through 96 of Michelson's First Set of Requests and Nos. 42 and 43 of the Ninth Set of Requests. (*Id.* at 4.) The table listed 965 items purporting to be "items of literature that may have been disseminated since 1993." (*Id.*, Ex. 7 at 8.) Counsel for Michelson was unable to locate 536 of those items in the materials produced by Medtronic. (*Id.*) Michelson asserts that he is entitled to those items because they are responsive to his requests for production seeking "all documents evidencing, reflecting, or relating to literature," as well as "the requests for literature that does and does not evidence compliance." (*Id.*, Ex. 1 at 38 (setting forth Requests Nos. 94-96 of the First Set); *id.*, Ex. 2 at 1 (setting forth Requests Nos. 42 and 43 of the Ninth Set).)

Medtronic opposes Michelson's motion on three grounds: (1)

that Michelson's motion is moot as to Request Nos. 32 through 39 and the disclosure of foreign literature and the power point presentations; (2) that it has already produced all relevant "literature" that it has been able to locate that is responsive to Request for Production Nos. 94 through 96 of Michelson's First Set and Nos. 42 and 43 of Michelson's Ninth Set; and (3) that the motion is overbroad as to those documents identified in response to Interrogatory No. 6 of KTI's First Set.

With respect to the mootness argument, Medtronic contends that the documents Michelson seeks in connection with Request Nos. 32 through 35 of Michelson's Tenth Set have "either been produced, will be produced, or simply do not exist." (Pl.'s Opp'n to Defs.' Mot. to Compel Docs. Re Name Attribution at 7; *id.*, Ex. A.) Specifically, Medtronic argues that it has already produced all twenty-one categories of documents referenced at the contempt hearing that Michelson claims are responsive to Requests Nos. 32 through 35 and that he claims he has been unable to locate. (*Id.* at 3.) Attached as Exhibit A to Medtronic's response to this motion is a chart that identifies by Bates numbers the non-privileged documents responsive to each of the twenty-one categories that have been produced. Medtronic has offered to produce any additional documents that become known. (*Id.* at 6 (referring to the e-mails identified by Mr. Powers).)

Medtronic also states that it has produced the two power point presentations that were cited in Medtronic's response to Interrogatory No. 12 of Michelson's Tenth Set, along with all foreign documents that exist. (*Id.* at 12-13.) The two power point

presentations are identified on the chart attached as Exhibit A to Medtronic's motion response as Bates Nos. MSD 1899824 - 1899905. As to foreign documents, Medtronic re-emphasized that only a "small fraction of the total number of Michelson-related pieces of literature" are produced and maintained by each foreign office individually and that "the vast majority of literature disseminated by Danek throughout the world is English-language literature stored in Danek's Memphis warehouse." (*Id.*) Medtronic has represented to the court that it has conducted a reasonable search and has produced to Michelson "a copy of each item of foreign literature pertaining to products that incorporate technology developed by Dr. Michelson" currently available. (*Id.*) Medtronic has identified the foreign literature by Bates numbers on the chart attached as Exhibit A to its motion response. Medtronic has offered to produce any additional foreign literature as it became known.

Accordingly, based on Medtronic's representations to the court that all non-privileged documents that exist have been produced, Michelson's motion to compel is denied as moot as to Request for Production Nos. 32 through 39 and the request for foreign literature and the two power point presentations. Michelson has failed to present any evidence that any additional literature relating to these requests exists. Moreover, Medtronic has promised to supplement its production as new documents relating to these requests become known.

As to the remaining items of literature which are the subject of this motion, Medtronic asserts that it has already produced all relevant "literature" that it has been able to locate that is

responsive to Request for Production Nos. 94 through 96 of Michelson's First Set of Requests and Nos. 42 and 43 of Michelson's Ninth Set of Requests. (*Id.* at 7, 12.) Although Michelson claims that Table One of Medtronic's supplemental response to KTI's Interrogatory No. 6 identified additional documents that are responsive to those requests, Medtronic has persuasively argued to the court that its response to Interrogatory No. 6 was much broader than the limited scope of Michelson's requests in that KTI's Interrogatory No. 6 encompassed literature that was not related to products incorporating Michelson's technology. (*See id.* at 7-8.) After careful review of each request in its entirety, it is apparent that Request Nos. 96, 42, and 43 are plainly limited to literature related to products incorporating technology invented by Michelson.¹ Furthermore, as demonstrated by Medtronic, Request Nos. 94 and 95, which request documents relating to "Threaded or Non-Threaded Spinal Implants, Instruments and Methods or Cervical Plate Technology," specifically request documents limited to the

¹ For example, Request No. 42 asks for "[e]ach product and item of literature, advertising and marketing materials produced and/or distributed by Medtronic in which Medtronic has failed to give proper patent notice and/or to give appropriate name recognition to Dr. Michelson in marketing the products based on Dr. Michelson's technology." (Pl.'s Opp'n to Defs.' Mot. to Compel Docs. Re Name Attribution at 9.) Request No. 43 asks for "[e]ach product and item of literature, advertising and marketing materials produced and/or distributed by Medtronic in which Medtronic has given proper patent notice and/or given appropriate name recognition to Dr. Michelson in marketing the products based on Dr. Michelson's technology. (*Id.*) Request No. 96 seeks "[a]ll documents evidencing reflecting or relating to literature, handouts, pamphlets, advertisements, promotional materials testimonials or marketing materials relating to any medical device, technology, implant, instrument method or process invented, conceived, developed, acquired or possessed by Dr. Michelson. (*Id.* at 8.)

technology Michelson developed that is at issue in this case. (*Id.* at 9.) KTI's Interrogatory No. 6, on the other hand, requests, in pertinent part, that Medtronic "identify all 'literature' (as that term is used in the parties' agreements) that you have disseminated or caused to be disseminated since the effective dates of the respective parties' agreements." (*Id.*)

Thus, KTI's Interrogatory No. 6 calls for the identification of "all" literature disseminated and is therefore beyond the scope of Michelson's requests. Furthermore, Michelson has failed to demonstrate to the court why the production of literature items unrelated to products incorporating technology invented by Dr. Michelson are relevant to the issues in this case. Accordingly, the court not only finds that Michelson is not entitled to documents listed in response to Interrogatory No. 6, which do not in any way pertain to literature related to products that incorporate technology developed by Michelson, but also denies Michelson's motion to compel as moot based on Medtronic's representation to the court that it has already produced all documents responsive to Request Nos. 94 through 96 of the First Set of Requests and Request Nos. 42 and 43 of the Ninth Set.

Finally, Dr. Michelson has requested that Medtronic identify the items related to name attribution by Bates-stamp number if Medtronic represents to the court that it has produced all the requested materials. Michelson's request is moot because, as the court has noted, Medtronic has already identified the document production numbers in Exhibit A to its response in opposition to Michelson's motion to compel. (*See id.*, Ex. A.)

For all of the foregoing reasons, Michelson's motion to compel is moot and denied as such. If however, any additional documents responsive to the requests at issue in this motion have become available, Medtronic is ordered to produce them within ten days of the date of entry of this order. Each party is to bear its own costs and attorney fees.

IT IS SO ORDERED this 15th day of December, 2003.

DIANE K. VESCOVO
UNITED STATES MAGISTRATE JUDGE