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

SPINE SOLUTIONS, INC., a Delaware Corporation, Plaintiff, v. MEDTRONIC SOFAMOR DANEK, INC., an Indiana corporation; MEDTRONIC SOFAMOR DANEK USA, INC., a Tennessee corporation Defendants.	)	No. 07-2175-MlV

REPORT AND RECOMMENDATION

The defendants, Medtronic Sofamor Danek, Inc. and Medtronic Sofamor Danek USA, Inc. (collectively "Medtronic"), have filed the present motion to compel the plaintiff, Spine Solutions, Inc. ("SSI"), to allow the deposition of Mr. Marvin Petry ("Petry"), the prosecuting attorney of the patent-in-suit, U.S. Patent No. 6,936,071 ("the '071 patent"), to be taken. Specifically, Medtronic seeks to depose Petry regarding his knowledge of the amendments to the '071 patent, any non-privileged factual information about communications with the Patent Office, and other information related to the prosecution of the '071 patent which is key to Medtronic's invalidity defense. The motion was filed October 3, 2007, and was referred to the United States Magistrate Judge for a report and recommendation pursuant to 28 U.S.C. §

636(b)(1)(B) and (C). For the reasons that follow, it is recommended that Medtronic's motion be granted.

PROPOSED FINDINGS OF FACT

A. Procedural History and Background

In the present case, SSI has accused Medtronic of infringing upon its '071 patent by making, exporting, and supplying intervertebral implants covered by claims in the '071 patent. The '071 patent issued from the United States Patent and Trademark Office ("PTO") on August 30, 2005, claiming priority from a Patent Cooperation Treaty ("PCT") application filed on July 2, 1999.

Medtronic contends that the implants it is producing and selling, which were in use a significant time before the issuance of the '071 patent, are fundamentally different than the type of implants described in the '071 patent. Specifically, Medtronic claims that SSI, through Petry, amended the claims in the '071 patent to "add unrelated and unsupported limitations in an effort to profit from Medtronic's products." (Defs.' Mem. Supp. Mot. Compel 4.) Medtronic also states that SSI, through Petry, added nearly a page to the specification of material that was unsupported in the original application in order to support the amended claims. Medtronic argues that it needs to depose Petry because he submitted the amendments to the claims and specification of the '071 patent, and the facts surrounding those amendments are critical to its invalidity defense.

Medtronic also asserts that Petry is the only available source for other essential non-privileged information regarding the prosecution of the '071 patent. In particular, Medtronic seeks to depose Petry about issues involving prior art and interviews with the patent examiner regarding the validity of the '071 patent. Medtronic claims that Petry has information about the facts surrounding the prosecution of the '071 patent and discussions with the patent examiner which are crucial to its invalidity defense. Medtronic argues that Petry's deposition is the only source of this information because patent examiners are not subject to discovery. (Defs.' Mem. Supp. Mot. Compel 6.) Medtronic later states in its reply brief that it intends to seek leave to amend its answer in order to allege inequitable conduct. (Defs.' Reply Br. 3-4.) Medtronic asserts that Petry also has relevant, non-privileged information pertaining to the inequitable conduct defense and should therefore be subject to a deposition. (*Id.*)

In response, SSI argues that, after excluding irrelevant and privileged or protected areas of inquiry, Petry has nothing to offer at a deposition. Specifically, SSI claims that allowing the deposition of opposing counsel is strongly disfavored and Petry has no information to offer that is relevant to Medtronic's invalidity defense. SSI contends that Medtronic's arguments only support taking contested depositions of patent prosecution counsel when inequitable conduct is pled, and that Medtronic has not alleged

such conduct in the instant case. SSI further argues that all of the amendments that Medtronic refers to are accompanied by detailed remarks in the patent prosecution record, and because the prosecution file is a complete account of the prosecution of the '071 patent, any knowledge Petry has of the amendment issues is irrelevant to any invalidity claims that may arise. (Pl.'s Resp. Defs.' Mot. Compel 3-4.) SSI also asserts in its surreply brief that if Medtronic is allowed to amend and plead inequitable conduct, Petry would still have no testimony to offer that would be either relevant or non-privileged. (Pl.'s Surreply Br. 4, 8.)

PROPOSED CONCLUSIONS OF LAW

A. Inequitable Conduct

Since this motion was filed, Medtronic sought and was granted leave to amend its answer to allege inequitable conduct. (*See* Order Granting Defs.' Mot. Amend Answer, Doc. No. 84, Jan. 4, 2008.) This is significant because SSI states in its present motion that "case law does not support compelling Mr. Petry's deposition regarding matters other than inequitable conduct." (Pl.'s Surreply Br. 4.) Because SSI concedes that prosecuting patent attorneys can be proper subjects for depositions when inequitable conduct has been formally pled, the question in this case becomes whether the inequitable conduct alleged justifies deposing Petry. Medtronic argues that it has a right to depose Petry on the facts and circumstances surrounding the declaration of

Dr. Thierny Marnay, one of the inventors of the '071 patent, submitted to the PTO. Medtronic questions the accuracy of the declaration based on recent discovery. SSI asserts that anything Petry could offer about the facts surrounding the drafting and submission of the Marnay's declaration would be both irrelevant and privileged.

Citing *Nisus Corp. v. Perma-Chink Systems*, 2004 U.S. Dist. LEXIS 29387, at *8 (E.D. Tenn. Sept. 17, 2004), SSI insists that depositions of opposing counsel are strongly disfavored. (Pl.'s Resp. Defs.' Mot. Compel 5.) Specifically, SSI contends that the heightened standard set forth in *Nationwide Mut. Ins. Co. v. Home Ins. Co.*, 278 F.3d 621, 628 (6th Cir. 2002), should be applied before allowing the deposition of opposing counsel to be taken, namely that the party seeking to take the deposition must show that "(1) no other means exist to obtain the information. . .; (2) the information sought is relevant and nonprivileged; and (3) the information is crucial to the preparation of the case." (Pl.'s Resp. Defs.' Mot. Compel 5-6.) SSI suggests that when this heightened standard is applied, deposing Petry should not be allowed because Medtronic has failed to make such a showing.

As a rule, Medtronic is entitled to "discovery regarding any nonprivileged matter that is relevant to any [of its] claim[s] or defense[s]." FED. R. CIV. P. 26(b)(1). Any person, including attorneys, with relevant information may be subject to a

deposition. *See* FED. R. CIV. P. 30(a)(1) ("A party may . . . depose any person. . . .) In fact, as SSI concedes, depositions of prosecuting patent attorneys in patent infringement cases with a claim of inequitable conduct are not unusual. *See, e.g., Paragon Podiatry Lab., Inc. v. KLM Labs., Inc.*, 984 F.2d 1182, 1193 (Fed. Cir. 1993) (discussing the deposition testimony of a prosecuting patent attorney in connection with an inequitable conduct claim). As this court has previously held, the heightened standard adopted in *Nationwide* only applies when "the attorney to be deposed is either trial/litigation counsel or the subject matter of the deposition may elicit litigation strategy." *Ellipsis, Inc. v. Color Works, Inc.*, 227 F.R.D. 496, 497 (W.D. Tenn. 2005). When the heightened standard is not applied, the party seeking to prevent the taking of a deposition because the information sought is subject to the attorney-client privilege bears the burden of proving that the privilege exists. *See Ross v. City of Memphis*, 423 F.3d 596, 606 (6th Cir. 2005).

In the present case, Petry is not litigation counsel, and SSI does not argue that allowing his deposition to be taken would divulge any litigation strategy. Therefore, the heightened standard used in *Nationwide* is inapplicable in the present case. Accordingly, SSI bears the burden of establishing that the information Medtronic seeks from Petry is privileged. If SSI contends that any relevant information Petry has is privileged, a

mere conclusory statement that the privilege applies is not sufficient to meet SSI's burden and prevent the deposition from being taken. *See Vita-Mix Corp. v. Basic Holdings, Inc.*, No. 1:06 CV 2622, 2007 WL 2344750, at *3 (N.D. Ohio Aug. 15, 2007). Furthermore, any unprivileged information that Petry has regarding the prosecution of the patent would most certainly be relevant to Medtronic's inequitable conduct claim. As a result, Medtronic should be allowed to depose Petry and probe into the relevant facts and circumstances surrounding Dr. Marnay's declaration as they may relate to Medtronic's inequitable conduct claim.

It should, however, be noted that SSI may still instruct Petry to not answer any deposition questions that would require answers giving privileged information. *See* FED. R. CIV. P. 30(c)(2).

B. Invalidity

Because it is recommended that the motion to compel be granted so that Medtronic may obtain discovery relevant to its inequitable conduct claim, this court need not decide whether compelling a deposition of a prosecuting patent attorney on grounds solely related to an invalidity defense would be proper. It is noted, however, that depositions of prosecuting patent attorneys are not limited to issues only relevant to inequitable conduct. *See Amgen Inc. v. Hoechst Marion Roussel, Inc.*, 314 F.3d 1313, 1328 (Fed. Cir. 2003) (prosecuting attorney deposed on issues regarding possible typographical errors in patent).

CONCLUSION

It is recommended that Medtronic's motion to compel the deposition of Petry be granted.

Respectfully submitted this 8th day of January, 2008.

s/ Diane K. Vescovo
DIANE K. VESCOVO
UNITED STATES MAGISTRATE JUDGE