

1 UNITED STATES PATENT AND TRADEMARK OFFICE
2 BEFORE THE PATENT TRIAL AND APPEAL BOARD

3

MEDTRONIC, INC., AND MEDTRONIC
4 VASCULAR, INC.,

5 Petitioners,

6 vs.

7 TELEFLEX INNOVATIONS S.A.R.L.,

8 Patent Owner.
9

10 IPR2020-00126 (Patent 8,048,032 B2)
11 IPR2020-00127 (Patent 8,048,032 B2)
12 IPR2020-00128 (Patent RE45,380 E)
13 IPR2020-00129 (Patent RE45,380 E)
14 IPR2020-00130 (Patent RE45,380 E)
15 IPR2020-00132 (Patent RE45,760 E)
16 IPR2020-00134 (Patent RE45,760 E)
17 IPR2020-00135 (Patent RE45,776 E)
18 IPR2020-00136 (Patent RE45,776 E)
19 IPR2020-00137 (Patent RE47,379 E)
20 IPR2020-00138 (Patent RE47,379 E)
21

22 VIDEOTAPED DEPOSITION OF

23 HOWARD C. ROOT

24 DATE: November 13, 2020

25 TIME: 9:32 a.m. Central Time

PLACE: Veritext Virtual Videoconference

REPORTED BY: PAULA K. RICHTER, RMR, CRR, CRC
(By videoconference)

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<p style="text-align: right;">Page 7</p> <p>1 PROCEEDINGS 2 THE VIDEOGRAPHER: We are going on 3 the record at 9:06 a.m. on November 13th, 2020. 4 This is Media Unit 1 of the 5 video-recorded deposition of Howard C. Root being 6 taken via Zoom and taken in the matter of 7 Medtronic, Incorporated and Medtronic Vascular, 8 Incorporated versus Teleflex Innovations, S.A.R.L. 9 in the United States Patent and Trademark Office 10 before the Patent Trial and Appeal Board; Case 11 Number IPR2020-00128. 12 My name is Adam Wallin from the firm 13 Veritext, and I am the videographer. The court 14 reporter is Paula Richter from the firm Veritext. 15 Will counsel please identify 16 themselves for the record. 17 MR. MORTON: Certainly. For 18 Petitioner Medtronic, this is Cyrus Morton of the 19 Robins Kaplan law firm. Also with me is Sharon 20 Roberg-Perez and Emily Tremblay. 21 MR. VANDENBURGH: And for the Patent 22 Owner Teleflex, this is Derek Vandenburg of the 23 Carlson Caspers firm. And also from our firm on 24 the line is Tara Norgard and Alex Rinn. 25 THE VIDEOGRAPHER: Will the court</p>	<p style="text-align: right;">Page 9</p> <p>1 in person with your lawyers? 2 A. No, I don't think so. 3 Q. Do you personally have any objection to 4 having your deposition being live and in person at 5 this point in time? 6 A. It depends on how it's conducted. 7 Q. So if there were safety precautions in place, 8 you'd be okay with it? 9 A. I could be if there's the right safety 10 precautions. 11 Q. Okay. For today's deposition, is there any 12 reason at all why you have any difficulty hearing 13 my questions and giving truthful and accurate 14 answers? 15 A. No. 16 Q. Okay. And is anybody else with you today in 17 the deposition or are you at home alone? 18 A. I'm home alone. 19 Q. All right. Let's go back to VSI, Vascular 20 Solutions, prior to the GuideLiner. Of course 21 we'll get to GuideLiner today, but let's start at 22 the beginning. 23 You're a founder of VSI, right? 24 A. Yes. 25 Q. And your background was as an attorney, not</p>

<p style="text-align: right;">Page 10</p> <p>1 as an engineer or product development person; is 2 that right? 3 A. Well, I was originally an attorney, and then 4 I worked in medical devices in marketing and 5 product development before starting Vascular 6 Solutions. 7 Q. And what was the impetus to start Vascular 8 Solutions? 9 A. I had the entrepreneurial bug. I wanted to 10 start a company, and I knew medical devices. I 11 thought if I found the right idea, that I could 12 put a company together in Minneapolis, which is 13 the hotbed of medical device companies, and try to 14 grow a company from scratch. 15 Q. Okay. And what was your first idea? 16 A. The first idea we licensed in was called the 17 Duett sealing device. It's D-U-E-T-T, two Ts. 18 Q. And what was your role with respect to the 19 Duett in terms of coming up with the idea, working 20 on and developing it? 21 A. I evaluated it. It was an idea by my 22 co-founder, Dr. Gary Gershoney, who's a 23 cardiologist out in California. I evaluated and 24 then negotiated the license to acquire the rights 25 and then started a development team to bring it</p>	<p style="text-align: right;">Page 12</p> <p>1 first starting to think about GuideLiner. 2 A. So prior to 2005, we probably had somewhere 3 around 10 to 20 medical devices that we had 4 developed and brought to market. 5 Q. And how big of a company did you have during 6 that time? 7 A. Big in terms of number of employees or 8 revenue or -- 9 Q. Yeah, I was thinking of both. 10 A. Revenue, in 2005, we were somewhere around 50 11 million in sales, worldwide revenue, and we 12 probably had somewhere around 100 employees. 13 Q. Okay. And so for those -- I forget already 14 how many products you said, but for each of those 15 products, did you have patent work done, patenting 16 on those products? 17 A. Not each of them. Some of them weren't 18 patentable. Some of them were. 19 Q. Okay. Roughly how many -- how many of the 20 products were patented and how many patents did 21 you get on them? 22 A. If I go down the list, Duett had probably 23 somewhere around five patents at that period of 24 time. 25 D-Stat flowable, I think we had two</p>
<p style="text-align: right;">Page 11</p> <p>1 from a concept to a finished medical device. 2 Q. And did you work with engineers or other 3 people on that? 4 A. Yes. 5 Q. The Duett, that was involved in litigation; 6 is that right? 7 A. Yes. 8 Q. Patent litigation? 9 A. Yes. 10 Q. You probably don't remember. I 11 second-chaired your deposition in that case. I 12 was about a second-year lawyer. 13 A. Which case was that? 14 Q. Datascope. 15 A. Okay. 16 Q. Yeah, we were on the Datascope side, so we 17 were on opposite sides as we are today. 18 A. Okay. 19 Q. Okay. So, again, prior to GuideLiner, how 20 many products did Vascular Solutions come up with? 21 A. Well, prior to when we launched GuideLiner or 22 prior to when we invented GuideLiner, or what date 23 are we talking about? 24 Q. Prior to the dates we'll be talking about 25 later, the 2005, 2006 time frame. So prior to</p>	<p style="text-align: right;">Page 13</p> <p>1 additional patents on that. 2 Vari-Lase, we had one or two patents 3 on that. 4 Pronto, I think we had just one 5 patent on that. 6 Langston, we had a patent on that. 7 Twin-Pass, I don't think we had a 8 patent on it. 9 Skyway, we did not have a patent on 10 it. 11 Micro-introducer kits, we did not 12 have a patent on. 13 That's -- I think there's more, but 14 that's the gist of it. 15 I can't hear. 16 MR. VANDENBURGH: Cy, we can't hear 17 you. 18 THE COURT REPORTER: Adam, he wants 19 to go off the record. 20 THE VIDEOGRAPHER: We are going off 21 the record at 9:14 a.m. 22 (Off the record from 9:14 a.m. until 23 9:19 a.m.) 24 THE VIDEOGRAPHER: We are back on 25 the record at 9:19 a.m.</p>

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<p style="text-align: right;">Page 14</p> <p>1 BY MR. MORTON: 2 Q. Okay. Sorry about that, Mr. Root. 3 Can we go back to that same time 4 period we were talking about, the earlier days of 5 VSI, prior to thinking about GuideLiner in 2005. 6 Did you have any document retention policies at 7 that time? 8 A. I believe we did, but I don't remember 9 exactly when we created our first document 10 retention policy. 11 Q. Do you remember anything about the policy 12 from prior to GuideLiner? 13 A. No, not really. 14 Q. Were you in charge of developing the policy 15 or was somebody else? 16 A. I don't remember the specific policy, so I 17 may have done it. I'm not sure when we had our 18 first general counsel, and it may have been that 19 person's job. 20 Q. Okay. Do you recall at all if it had to do 21 with hard-copy documents versus electronic 22 documents? 23 A. Well, the policy we had covered both, but I'm 24 not sure when that came into being. 25 Q. Did you have any -- do you recall any policy</p>	<p style="text-align: right;">Page 16</p> <p>1 QXMedical we were the plaintiff -- at least in 2 substantive terms we were the plaintiff as -- on 3 my patent. 4 And I'm not sure if there's any 5 other cases that we have. 6 Q. Have you been deposed before on the issues of 7 conception and reduction to practice? 8 A. I think so, in relation to these earlier 9 GuideLiner cases. 10 Q. Okay. Any other cases besides the GuideLiner 11 cases? 12 A. I don't believe so. 13 Q. Was that the concept of conception and 14 reduction to practice, proving an earlier 15 invention date, was that something that you knew 16 and understood prior to GuideLiner? 17 A. I was not a patent lawyer. I knew the 18 general concept, but I wasn't an expert or 19 specifically trained in that area. 20 Q. All right. On these depositions, I want to 21 show you a couple of transcripts. 22 Can we put up the Boston transcript? 23 (Exhibit 1114 and Exhibit 1115 were 24 marked for identification.) 25</p>
<p style="text-align: right;">Page 15</p> <p>1 about document destruction after a certain amount 2 of time? 3 A. Again, the policies that we had covered that, 4 but I don't know when that policy was put in 5 place. 6 Q. Okay. We mentioned that you've had your 7 deposition taken before, right? 8 A. Correct. 9 Q. In how many patent cases have you had your 10 deposition taken? 11 A. Probably around five. 12 Q. And was your deposition typically taken as an 13 inventor on those patents? 14 A. I -- yeah. In a couple cases, yes. In a 15 couple cases, no. 16 Q. Okay. What were the cases where you were not 17 an inventor? 18 A. Well, inventor of the patent that was being 19 asserted, if you look at it that way. The 20 Datascope case, we were the defendant. And the 21 St. Jude Medical case we were the defendant. The 22 DialMED case we were the defendant. And the 23 Terumo case we were the defendant. 24 And then the Boston Scientific case 25 we were the plaintiff on the GuideLiner patents.</p>	<p style="text-align: right;">Page 17</p> <p>1 BY MR. MORTON: 2 Q. All right. Are you seeing this, Mr. Root, 3 Vascular Solutions v. Boston Scientific, video 4 depo of Howard Charles Root? 5 A. I'm just looking in the Exhibit Share, and 6 it's just 1114 and 1115. Is that -- 7 Q. Yes, 1114. 8 A. Just open that? 9 Q. Yep. 10 A. Okay. Yeah, I see it now. 11 Q. All right. Thanks. 12 Do you recall having your deposition 13 taken in that Vascular Solutions v. Boston 14 Scientific case? 15 A. Yes. 16 Q. Do you recall being placed under oath and 17 swearing to tell the truth in that matter? 18 A. Yes. 19 Q. And you did testify truthfully, right? 20 A. To the best of my ability, yes. 21 Q. Were you given a chance to review the 22 transcript and make any changes that you felt were 23 necessary? 24 A. Yes. 25 Q. And you signed off on this transcript?</p>

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