

1 UNITED STATES PATENT AND TRADEMARK OFFICE

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3 BEFORE THE PATENT TRIAL AND APPEAL BOARD

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5 NEW WORLD MEDICAL, INC.,

6 Petitioner,

7 v.

8 MICROSURGICAL TECHNOLOGY, INC.,

9 Patent Owner.

10 * * *

11 IPR2020-01573, IPR2020-01711, IPR2021-00017,

12 IPR2021-00065, IPR2021-00066

13 * * *

14 Telephonic Hearing Held on Thursday, July 15,

15 2021, before the Honorable:

16 RYAN H. FLAX, DEVON ZASTROW NEWMAN,

17 ROBERT A. POLLACK, Administrative Patent Judges.

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Page 2

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Page 3

1 JUDGE FLAX: We are here concerning
 2 IPR 2020-01573, 2020-01711, 2021-00017,
 3 2021-00065, 2021-00066, if I am correct. Does
 4 anyone have anything else that they wanted to add
 5 to that list, is that correct?
 6 MR. SUNG: That's correct, your
 7 Honor.
 8 MR. DEIGHAN: Nothing from patent
 9 owner, your Honor.
 10 JUDGE FLAX: To help the court
 11 reporter when you speak, could you please identify
 12 yourself? And this is Judge Flax again.
 13 Each of these IPRs concerns New World
 14 Medical, Inc., as the petitioner versus
 15 Microsurgical Technology, Inc., as the patent
 16 owner. We are also joined by Judge Zastrow
 17 Newman. The panels on each of these cases are not
 18 identical, but we have judges from each panel.
 19 So on July 12th, we received an
 20 e-mail from petitioner's counsel concerning their
 21 desire to depose witness Dr. Manual Quintana, the
 22 patent owner's witness, who according to the
 23 e-mail is not in the United States but is in
 24 Spain.
 25 So what I will do is let petitioner

Page 4

1 explain what it wants and why it needs it, and I
 2 will give patent owner an opportunity to respond
 3 also. So if you could identify yourselves as far
 4 as who we are speaking with and for which party,
 5 please start there.
 6 MR. DEIGHAN: Thank you, your Honor.
 7 This is Kyle Deighan representing petitioner. And
 8 also on the line is my colleague, Todd Tucker, for
 9 petitioner.
 10 MR. TUCKER: Hello, your Honor. I
 11 think it's going to be him doing the argument.
 12 JUDGE FLAX: Okay. And who else do
 13 we have?
 14 MR. SUNG: Good morning, your Honor.
 15 For patent owner, this is Lawrence Sung, and with
 16 me is Teresa Summers.
 17 JUDGE FLAX: Is Ms. Summers on record
 18 in the case? I don't recall seeing her name.
 19 MR. SUNG: Yes, she is, your Honor.
 20 And just as a point of clarification -- I
 21 apologize, as a point of clarification, with one
 22 of the IPRs, the patent owner in that case is the
 23 Regents of the University of California.
 24 JUDGE FLAX: Oh, okay. Thank you for
 25 updating that. Okay. So let's move ahead to what

Page 5

1 petitioner has to say. Mr. Deighan, please go
 2 ahead.
 3 MR. DEIGHAN: Thank you, your Honors.
 4 So as a matter of routine discovery, petitioner is
 5 entitled to depose Dr. Quintana. And under 37 CFR
 6 42.53, a deposition should take place within the
 7 United States. Patent owner has indicated that
 8 Dr. Quintana will not be made available for
 9 deposition in the United States.
 10 Petitioner believes that it's crucial
 11 that we have an opportunity to depose Dr. Quintana
 12 in person and consistent with the rules in the US.
 13 I won't go too far into the weeds on this. But
 14 just to provide a little bit of background,
 15 Dr. Quintana is the author of one of petitioner's
 16 prior art references, which was written by
 17 Dr. Quintana in English in 1985.
 18 Patent owner has submitted a
 19 declaration from Dr. Quintana in these proceedings
 20 that from our perspective we believe contradicts
 21 the clear words of the prior art reference, and so
 22 the words are crucial here. To complicate
 23 matters, patent owner has indicated that
 24 Dr. Quintana does not speak English, and so we
 25 will require an interpreter or translator for a

Page 6

1 deposition.
2 And so given the technical nature of
3 the article and the importance of the words and,
4 you know, the language barrier issues, we believe
5 pretty strongly that this deposition should be
6 held in person and that it would be extremely
7 prejudicial to petitioner to do this using some
8 sort of remote means. And, again, the rule
9 dictates that the deposition, you know, should be
10 within the United States.
11 As I mentioned, patent owner has
12 indicated that Dr. Quintana will not be made
13 available in the US. They have provided no
14 justification, except for simply that Dr. Quintana
15 refuses to travel to the US.
16 It's our understanding that there are
17 no COVID-related travel restrictions to travel
18 between the US and Spain. In fact, patent owner
19 during the parties' meet and confer last week did
20 not even mention COVID or any other health
21 concerns as being justification for why he would
22 not appear in the US.
23 And it should have been entirely
24 foreseeable to patent owner that Dr. Quintana
25 would need to be made available for deposition,

Page 7

1 and that would need to take place in the US when
2 they submitted his declaration in these
3 proceedings. And, you know, in our view just not
4 wanting to travel to the US is not enough.
5 And so we asked for this conference
6 call with your Honors to seek guidance on how to
7 proceed. You know, we think that Dr. Quintana
8 should be ordered to be made available for
9 deposition in the US.
10 And if not, you know, we would seek
11 an opportunity to move to strike his testimony.
12 And so, again, we are kind of seeking guidance
13 from your Honors on what the parties' next steps
14 would be; whether it's a motion from our side,
15 petitioner's side, to compel his deposition in the
16 US or some other means.
17 So, again, just seeking guidance from
18 your Honor -- your Honors on the next steps.
19 Thank you, your Honors.
20 JUDGE FLAX: Okay, thank you. Moving
21 on, Mr. Sung, what do you have to say?
22 MR. SUNG: Yes, good morning, your
23 Honors. This is Lawrence Sung for patent owners
24 Microsurgical Technology and the Regents of the
25 University of California.

Page 8

1 Dr. Quintana is an 85-year-old
2 retired ophthalmologist who resides in Barcelona,
3 Spain. He is a Spanish citizen. And while he
4 does speak English, English is not his primary
5 language.
6 And as Exhibit 2020 in each of the
7 five related IPRs shows, on May 17th of 2021,
8 Dr. Quintana executed a sworn affidavit. Not a
9 declaration, but a sworn affidavit in Barcelona,
10 Spain, that was duly notarized and apostille under
11 Spanish law.
12 Now, Exhibit 2020 consists of eight
13 paragraphs across three double-spaced pages total,
14 five paragraphs of which are short, simple,
15 declarative statements concerning the 1985 article
16 that he solely authored, which is Exhibit 1004 in
17 each of the five related IPRs.
18 Dr. Quintana is an independent
19 third-party fact witness. He is not being offered
20 as an expert witness. His testimony is not on
21 behalf of either party, but merely seeks to
22 clarify what his article meant to report.
23 Patent owner does not represent or
24 speak for Dr. Quintana. And to patent owner's
25 knowledge, neither party has sought to compel his

Page 9

1 testimony. During the July 9th, 2021, meet and
2 confer, patent owner's counsel explained that the
3 patent owner does not have the ability to make
4 Dr. Quintana available for deposition in the
5 United States.
6 Patent owner's counsel also indicated
7 at that time that attempting to force Dr. Quintana
8 to travel internationally while COVID-19 is still
9 a concern, especially at his advanced age, was not
10 commensurate with the scope of his limited and
11 narrow testimony in Exhibit 2020.
12 It's unclear what prejudice, if any,
13 petitioner in this case would suffer if the board
14 were to decide itself the appropriate way to
15 accord Dr. Quintana's sworn statements. Just
16 because petitioner doesn't like what Dr. Quintana
17 said doesn't make his testimony adverse or
18 unreliable.
19 But in the spirit of compromise,
20 patent owner's counsel raised the possibility of
21 cross-exam by written interrogatories, for
22 example, as a more suitable alternative to pursue,
23 given the language translation issues.
24 Petitioner's counsel hasn't provided
25 any insight into what information they intend to

Page 10

1 seek from Dr. Quintana on cross-examination that
2 would be properly restricted to the limited
3 testimony in the sworn affidavit. And that's all
4 from patent owner's side, your Honors. Thank you.
5 JUDGE NEWMAN: Counsel, this is Judge
6 Newman. Have you explored the opportunity of a
7 video deposition?
8 MR. TUCKER: Your Honor, this is Todd
9 Tucker for the petitioner. In a couple of other
10 cases, I have been doing a series of depositions
11 on Zoom involving translators in Macao, and it's
12 been incredibly difficult.
13 Given the nature with which
14 Dr. Quintana is contradicting what he wrote in
15 1985, I think that it will be very, very difficult
16 when you are entirely focused on what words mean
17 to be having a translator, a potential check
18 translator, and all the parties on video. This is
19 not going to be an efficient or fair deposition if
20 it's done in that manner due to the multiple
21 people that are going to need to be talking in
22 this deposition.
23 It's also -- I think there needs to
24 be some exploration of, you know, English as
25 second language and you need translator if you

Page 11

1 were able to write this article in 1985 to explain
2 to the world what you were doing, which makes a
3 little bit of this suspect. And I think it will
4 be a difficult deposition -- extremely difficult
5 deposition with the potential -- normally, you
6 have two translators, the base translator and then
7 the check translator and then multiple attorneys
8 and the witness.
9 It just seems like this would be
10 very, very prejudicial and that we won't be able
11 to test the sworn statement properly, do a proper
12 cross-examination, your Honor. Thank you.
13 MR. SUNG: Judge Newman, this is
14 Lawrence Sung for patent owner. Let me just say
15 that, of course, while we are aware that a
16 possible mechanism would be video deposition,
17 patent owner has taken no position on whether that
18 would be appropriate here. And just as a
19 remainder, we can't speak for Dr. Quintana in
20 terms of his willingness to participate in a video
21 deposition, either.
22 Just as note, what I wanted to raise
23 in response to what Mr. Tucker has mentioned,
24 clearly the petitioner has had no problems relying
25 on the 1985 article written in English until this

Page 12

1 very moment, and so I am not sure that the
2 protests by petitioner regarding the deposition
3 based on the language issues really applies in
4 this particular case. Thank you.
5 MR. TUCKER: If I may, your Honors, I
6 think that's -- that's really a circular
7 statement. This entire deposition will be what
8 words in English mean, what they meant to
9 Dr. Quintana when he wrote them and what they mean
10 now that he has changed the definitions and
11 changed the contents of his article some 30-odd
12 years after he wrote it.
13 So this is a deposition entirely
14 focused on what words mean. So it is imperative
15 that things are translated properly, that people
16 are not speaking over each other, that we have a
17 clear record, that we are able to overcome the
18 communication barriers to determine exactly where
19 he -- where the potential deponent, where this
20 witness who is contradicting what he wrote, what's
21 his basis for all that. And that's why this
22 deposition needs to be in person, your Honors.
23 JUDGE POLLACK: Counsel, this is
24 Judge Pollack. It sounds to me as though
25 Dr. Quintana is a third-party in a foreign

Page 13

1 country, and it might be pretty difficult to
2 compel him to come here. So have the parties
3 discussed taking his deposition in Spain?
4 MR. TUCKER: Your Honor, this is
5 Mr. Tucker again. We are willing to go to Spain
6 if need be. We think the rule is that they need
7 to provide him in the US. I know they are saying
8 he is a third party.
9 But they submitted the evidence, they
10 need to make him available under 3742. And I am
11 sorry, I got the rule wrong there, but under the
12 rule. So, you know, I think if no deposition
13 occurs, we are going to seek permission to file a
14 motion to strike because we are not getting to
15 test the deposition.
16 We are willing to go to Spain,
17 however. There are no -- again, as Mr. Deighan
18 said, there's no travel restrictions. And
19 Mr. Deighan and I are fully vaccinated, so we are
20 willing to go as well. You know, if there is no
21 deposition, however, you know, then I think we
22 would be asking the board to strike the statement.
23 MR. SUNG: And Judge Pollack, this is
24 Lawrence Sung for patent owner.
25 JUDGE FLAX: Mr. Sung, this is Judge

Page 14

1 Flax.
2 MR. SUNG: I'm sorry, Judge Flax.
3 JUDGE FLAX: This is Judge Flax.
4 Would you be willing to assist petitioner in
5 getting Dr. Quintana to a deposition if they
6 travel to Spain?
7 MR. SUNG: The understanding would be
8 that we would make the effort to reach out to
9 Dr. Quintana to see if that were possible, but it
10 is our understanding that he would not be willing
11 to voluntarily submit to deposition.
12 And, Judge Flax, if I could just
13 answer Judge Pollack's question very briefly. We
14 did want to say, again, just to reiterate that we
15 do not control Dr. Quintana, and we don't really
16 have an ability to compel him for additional
17 deposition or additional testimony in other
18 measures, either.
19 What we are trying to do is to see if
20 we can seek some type of cooperation with him
21 about that. And so, again, because we don't speak
22 for him, I could not tell you on the phone today
23 what may or may not be possible from Dr. Quintana.
24 The other point that I did want to
25 make because Mr. Tucker has raised it is the

Page 15

1 Quintana article is a seven-page short article.
2 Dr. Quintana's sworn affidavit similarly brief, as
3 I mentioned. And it's only Mr. Tucker who is
4 asserting today that the sworn statements of
5 Dr. Quintana are in any way different or
6 contradictory.
7 I think that the board is in as good
8 a position as anyone to look at the statements and
9 make its own determination based on what's there,
10 and as I mentioned as well, to determine whether
11 there should be weight accorded to the sworn
12 statement, the sworn affidavit.
13 Again, it's been duly notarized and
14 apostilled, and I hear petitioner today to concede
15 that Dr. Quintana, the person who signed the sworn
16 statement, is the same Dr. Quintana who authored
17 the article. Thank you.
18 MR. TUCKER: Your Honors, if I could
19 just briefly respond, I think patent owner is
20 missing the point that they have submitted this
21 statement. And this statement, we are --
22 petitioner is entitled to test that statement.
23 And, you know, so a written
24 interrogatory is not going to work. This is
25 essentially direct testimony, and we are entitled

Page 16

1 to either have an opportunity to test it or it
2 should be withdrawn.
3 I think it's also a little
4 questionable for patent owner to say they have no
5 control over the witness when they were able to
6 probably secure a sworn statement that we will
7 find out if they helped draft it or not, but --
8 and we are also -- since they do not represent
9 him, I think another area that's extremely
10 important is they have had communications with
11 him.
12 And we are entitled to find out about
13 those communications because they -- since patent
14 owner's counsel does not represent Dr. Quintana,
15 there is clearly no privilege. So that is another
16 area that needs to be explored, your Honor, to
17 truly see what is the value of this after the
18 fact, you know, 35 years later statement, your
19 Honor. Thank you.
20 JUDGE FLAX: I think what we will do
21 right now is put you, counsel and the court
22 reporter, on hold for a moment while the judges
23 convene, unless you have something you want to add
24 before we do that?
25 MR. SUNG: Nothing from patent owner.

Page 17

1 MR. TUCKER: Kyle, anything else from
2 petitioner?
3 MR. DEIGHAN: Nothing else from
4 petitioner.
5 JUDGE FLAX: Okay. Please just hold
6 on for a moment. Thank you.
7 (Recess taken.)
8 JUDGE FLAX: Okay, everybody. We are
9 back. So having considered what everybody has
10 said today, in the interest of fairness, we think
11 that the parties need to work together to try to
12 secure Dr. Quintana for a deposition in Spain.
13 Based on what everybody has said, it
14 appears that the patent owner is not controlling
15 Dr. Quintana, has at least some relationship with
16 him so that they could communicate with him, be in
17 contact with him, and try to schedule something
18 for a convenient time for petitioner's counsel to
19 go to Spain and take a brief deposition of the
20 doctor.
21 What we want you to do is make these
22 efforts together and report back to the board by
23 e-mail by next Friday. Does everybody understand
24 that?
25 MR. TUCKER: For petitioner, this is

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