

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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<p style="text-align: right;">Page 2</p> <p>1 APPEARANCES:  2 On behalf of the Petitioner:  3 Calfee, Halter &amp; Griswold, LLP  4 By: Todd R. Tucker  5 Kyle T. Deighan  6 Attorneys at Law  7 1405 East 6th Street  8 The Calfee Building  9 Cleveland, Ohio 44114  10 216-622-8231  11 ttucker@calfee.com  12 kdeighan@calfee.com  13 On behalf of the Patent Owner:  14 Wiley Rein, LLP  15 By: Lawrence M. Sung  16 Teresa M. Summers  17 Attorneys at Law  18 1776 K Street, NW  19 Washington, D.C. 20006  20 202-719-4181  21 lsung@wileyrein.com  22 tsummers@wileyrein.com  23  24  25</p>	<p style="text-align: right;">Page 4</p> <p>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</p>
<p style="text-align: right;">Page 3</p> <p>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</p>	<p style="text-align: right;">Page 5</p> <p>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</p>

<p style="text-align: right;">Page 6</p> <p>1 deposition.</p> <p>2 And so given the technical nature of</p> <p>3 the article and the importance of the words and,</p> <p>4 you know, the language barrier issues, we believe</p> <p>5 pretty strongly that this deposition should be</p> <p>6 held in person and that it would be extremely</p> <p>7 prejudicial to petitioner to do this using some</p> <p>8 sort of remote means. And, again, the rule</p> <p>9 dictates that the deposition, you know, should be</p> <p>10 within the United States.</p> <p>11 As I mentioned, patent owner has</p> <p>12 indicated that Dr. Quintana will not be made</p> <p>13 available in the US. They have provided no</p> <p>14 justification, except for simply that Dr. Quintana</p> <p>15 refuses to travel to the US.</p> <p>16 It's our understanding that there are</p> <p>17 no COVID-related travel restrictions to travel</p> <p>18 between the US and Spain. In fact, patent owner</p> <p>19 during the parties' meet and confer last week did</p> <p>20 not even mention COVID or any other health</p> <p>21 concerns as being justification for why he would</p> <p>22 not appear in the US.</p> <p>23 And it should have been entirely</p> <p>24 foreseeable to patent owner that Dr. Quintana</p> <p>25 would need to be made available for deposition,</p>	<p style="text-align: right;">Page 8</p> <p>1 Dr. Quintana is an 85-year-old</p> <p>2 retired ophthalmologist who resides in Barcelona,</p> <p>3 Spain. He is a Spanish citizen. And while he</p> <p>4 does speak English, English is not his primary</p> <p>5 language.</p> <p>6 And as Exhibit 2020 in each of the</p> <p>7 five related IPRs shows, on May 17th of 2021,</p> <p>8 Dr. Quintana executed a sworn affidavit. Not a</p> <p>9 declaration, but a sworn affidavit in Barcelona,</p> <p>10 Spain, that was duly notarized and apostille under</p> <p>11 Spanish law.</p> <p>12 Now, Exhibit 2020 consists of eight</p> <p>13 paragraphs across three double-spaced pages total,</p> <p>14 five paragraphs of which are short, simple,</p> <p>15 declarative statements concerning the 1985 article</p> <p>16 that he solely authored, which is Exhibit 1004 in</p> <p>17 each of the five related IPRs.</p> <p>18 Dr. Quintana is an independent</p> <p>19 third-party fact witness. He is not being offered</p> <p>20 as an expert witness. His testimony is not on</p> <p>21 behalf of either party, but merely seeks to</p> <p>22 clarify what his article meant to report.</p> <p>23 Patent owner does not represent or</p> <p>24 speak for Dr. Quintana. And to patent owner's</p> <p>25 knowledge, neither party has sought to compel his</p>
<p style="text-align: right;">Page 7</p> <p>1 and that would need to take place in the US when</p> <p>2 they submitted his declaration in these</p> <p>3 proceedings. And, you know, in our view just not</p> <p>4 wanting to travel to the US is not enough.</p> <p>5 And so we asked for this conference</p> <p>6 call with your Honors to seek guidance on how to</p> <p>7 proceed. You know, we think that Dr. Quintana</p> <p>8 should be ordered to be made available for</p> <p>9 deposition in the US.</p> <p>10 And if not, you know, we would seek</p> <p>11 an opportunity to move to strike his testimony.</p> <p>12 And so, again, we are kind of seeking guidance</p> <p>13 from your Honors on what the parties' next steps</p> <p>14 would be; whether it's a motion from our side,</p> <p>15 petitioner's side, to compel his deposition in the</p> <p>16 US or some other means.</p> <p>17 So, again, just seeking guidance from</p> <p>18 your Honor -- your Honors on the next steps.</p> <p>19 Thank you, your Honors.</p> <p>20 JUDGE FLAX: Okay, thank you. Moving</p> <p>21 on, Mr. Sung, what do you have to say?</p> <p>22 MR. SUNG: Yes, good morning, your</p> <p>23 Honors. This is Lawrence Sung for patent owners</p> <p>24 Microsurgical Technology and the Regents of the</p> <p>25 University of California.</p>	<p style="text-align: right;">Page 9</p> <p>1 testimony. During the July 9th, 2021, meet and</p> <p>2 confer, patent owner's counsel explained that the</p> <p>3 patent owner does not have the ability to make</p> <p>4 Dr. Quintana available for deposition in the</p> <p>5 United States.</p> <p>6 Patent owner's counsel also indicated</p> <p>7 at that time that attempting to force Dr. Quintana</p> <p>8 to travel internationally while COVID-19 is still</p> <p>9 a concern, especially at his advanced age, was not</p> <p>10 commensurate with the scope of his limited and</p> <p>11 narrow testimony in Exhibit 2020.</p> <p>12 It's unclear what prejudice, if any,</p> <p>13 petitioner in this case would suffer if the board</p> <p>14 were to decide itself the appropriate way to</p> <p>15 accord Dr. Quintana's sworn statements. Just</p> <p>16 because petitioner doesn't like what Dr. Quintana</p> <p>17 said doesn't make his testimony adverse or</p> <p>18 unreliable.</p> <p>19 But in the spirit of compromise,</p> <p>20 patent owner's counsel raised the possibility of</p> <p>21 cross-exam by written interrogatories, for</p> <p>22 example, as a more suitable alternative to pursue,</p> <p>23 given the language translation issues.</p> <p>24 Petitioner's counsel hasn't provided</p> <p>25 any insight into what information they intend to</p>

<p style="text-align: right;">Page 10</p> <p>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</p>	<p style="text-align: right;">Page 12</p> <p>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</p>
<p style="text-align: right;">Page 11</p> <p>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</p>	<p style="text-align: right;">Page 13</p> <p>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</p>

<p style="text-align: right;">Page 14</p> <p>1 Flax.</p> <p>2 MR. SUNG: I'm sorry, Judge Flax.</p> <p>3 JUDGE FLAX: This is Judge Flax.</p> <p>4 Would you be willing to assist petitioner in</p> <p>5 getting Dr. Quintana to a deposition if they</p> <p>6 travel to Spain?</p> <p>7 MR. SUNG: The understanding would be</p> <p>8 that we would make the effort to reach out to</p> <p>9 Dr. Quintana to see if that were possible, but it</p> <p>10 is our understanding that he would not be willing</p> <p>11 to voluntarily submit to deposition.</p> <p>12 And, Judge Flax, if I could just</p> <p>13 answer Judge Pollack's question very briefly. We</p> <p>14 did want to say, again, just to reiterate that we</p> <p>15 do not control Dr. Quintana, and we don't really</p> <p>16 have an ability to compel him for additional</p> <p>17 deposition or additional testimony in other</p> <p>18 measures, either.</p> <p>19 What we are trying to do is to see if</p> <p>20 we can seek some type of cooperation with him</p> <p>21 about that. And so, again, because we don't speak</p> <p>22 for him, I could not tell you on the phone today</p> <p>23 what may or may not be possible from Dr. Quintana.</p> <p>24 The other point that I did want to</p> <p>25 make because Mr. Tucker has raised it is the</p>	<p style="text-align: right;">Page 16</p> <p>1 to either have an opportunity to test it or it</p> <p>2 should be withdrawn.</p> <p>3 I think it's also a little</p> <p>4 questionable for patent owner to say they have no</p> <p>5 control over the witness when they were able to</p> <p>6 probably secure a sworn statement that we will</p> <p>7 find out if they helped draft it or not, but --</p> <p>8 and we are also -- since they do not represent</p> <p>9 him, I think another area that's extremely</p> <p>10 important is they have had communications with</p> <p>11 him.</p> <p>12 And we are entitled to find out about</p> <p>13 those communications because they -- since patent</p> <p>14 owner's counsel does not represent Dr. Quintana,</p> <p>15 there is clearly no privilege. So that is another</p> <p>16 area that needs to be explored, your Honor, to</p> <p>17 truly see what is the value of this after the</p> <p>18 fact, you know, 35 years later statement, your</p> <p>19 Honor. Thank you.</p> <p>20 JUDGE FLAX: I think what we will do</p> <p>21 right now is put you, counsel and the court</p> <p>22 reporter, on hold for a moment while the judges</p> <p>23 convene, unless you have something you want to add</p> <p>24 before we do that?</p> <p>25 MR. SUNG: Nothing from patent owner.</p>
<p style="text-align: right;">Page 15</p> <p>1 Quintana article is a seven-page short article.</p> <p>2 Dr. Quintana's sworn affidavit similarly brief, as</p> <p>3 I mentioned. And it's only Mr. Tucker who is</p> <p>4 asserting today that the sworn statements of</p> <p>5 Dr. Quintana are in any way different or</p> <p>6 contradictory.</p> <p>7 I think that the board is in as good</p> <p>8 a position as anyone to look at the statements and</p> <p>9 make its own determination based on what's there,</p> <p>10 and as I mentioned as well, to determine whether</p> <p>11 there should be weight accorded to the sworn</p> <p>12 statement, the sworn affidavit.</p> <p>13 Again, it's been duly notarized and</p> <p>14 apostilled, and I hear petitioner today to concede</p> <p>15 that Dr. Quintana, the person who signed the sworn</p> <p>16 statement, is the same Dr. Quintana who authored</p> <p>17 the article. Thank you.</p> <p>18 MR. TUCKER: Your Honors, if I could</p> <p>19 just briefly respond, I think patent owner is</p> <p>20 missing the point that they have submitted this</p> <p>21 statement. And this statement, we are --</p> <p>22 petitioner is entitled to test that statement.</p> <p>23 And, you know, so a written</p> <p>24 interrogatory is not going to work. This is</p> <p>25 essentially direct testimony, and we are entitled</p>	<p style="text-align: right;">Page 17</p> <p>1 MR. TUCKER: Kyle, anything else from</p> <p>2 petitioner?</p> <p>3 MR. DEIGHAN: Nothing else from</p> <p>4 petitioner.</p> <p>5 JUDGE FLAX: Okay. Please just hold</p> <p>6 on for a moment. Thank you.</p> <p>7 (Recess taken.)</p> <p>8 JUDGE FLAX: Okay, everybody. We are</p> <p>9 back. So having considered what everybody has</p> <p>10 said today, in the interest of fairness, we think</p> <p>11 that the parties need to work together to try to</p> <p>12 secure Dr. Quintana for a deposition in Spain.</p> <p>13 Based on what everybody has said, it</p> <p>14 appears that the patent owner is not controlling</p> <p>15 Dr. Quintana, has at least some relationship with</p> <p>16 him so that they could communicate with him, be in</p> <p>17 contact with him, and try to schedule something</p> <p>18 for a convenient time for petitioner's counsel to</p> <p>19 go to Spain and take a brief deposition of the</p> <p>20 doctor.</p> <p>21 What we want you to do is make these</p> <p>22 efforts together and report back to the board by</p> <p>23 e-mail by next Friday. Does everybody understand</p> <p>24 that?</p> <p>25 MR. TUCKER: For petitioner, this is</p>



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