

1 UNITED STATES PATENT AND TRADEMARK OFFICE

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3 BEFORE THE PATENT TRIAL AND APPEAL BOARD

4 * * *

5 NEW WORLD MEDICAL, INC.,

6 Petitioner,

7 v.

8 MICROSURGICAL TECHNOLOGY, INC.,

9 Patent Owner.

10 * * *

11 IPS2020-01573, IPR2020-01711, IPR2021-00017,

12 IPR2021-00065, IPR2021-00066

13 * * *

14 Telephonic Hearing Held Friday, August 13, 2021,

15 before the Honorable:

16 RYAN H. FLAX, ROBERT A. POLLACK, JAMES A. TARTAL,

17 JAMES A. WORTH, and DEVON ZASTROW NEWMAN,

18 Administrative Patent Judges.

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 On behalf of the Patent Owner.
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1 correct?
 2 THE NOTARY: Yes, it is.
 3 MR. TUCKER: This is Mr. Tucker,
 4 and that is correct.
 5 JUDGE FLAX: Okay. Well, when
 6 we're all finished, if you would please
 7 submit the transcript of this call, we
 8 would appreciate that.
 9 One housekeeping note, I note --
 10 and I could be wrong about this, but I
 11 believe that Miss Summers was admitted
 12 pro hac vice, but the mandatory notices for
 13 Patent Owner have not been updated to
 14 identify her as active counsel.
 15 If that's correct, if you would
 16 please update the mandatory notices.
 17 MR. SUNG: Yes, Your Honor.
 18 JUDGE FLAX: Okay, getting to the
 19 matter at hand, so it is our understanding
 20 that we are here to discuss efforts to
 21 secure the deposition of Dr. Quintana,
 22 who's a fact witness in this case. Is that
 23 correct?
 24 MR. TUCKER: This is Mr. Tucker,
 25 that is correct, Your Honor.

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1 JUDGE FLAX: Good morning, this is
 2 Judge Flax. I am joined today by Judges
 3 Pollack, Tartal, Worth and Zastrow Newman.
 4 And, we are here to discuss --
 5 one, two, three, four -- five IPRs,
 6 numbered IPR2020-01573, IPR2020-01711,
 7 IPR2020 -- I'm sorry -- 2021-00017,
 8 IPR2021-00065, and IPR2021-00066.
 9 I understand we have counsel for
 10 the parties on the call.
 11 Could you please identify
 12 yourselves?
 13 MR. TUCKER: Good morning,
 14 Your Honor, this is Todd Tucker for
 15 Petitioner, New World Medical.
 16 MR. SUNG: And good morning,
 17 Your Honor, this is Lawrence Sung of
 18 Wiley Rein on behalf of Patent Owner's
 19 Microsurgical Technology and the Regents of
 20 the University of California.
 21 And along with me today we have
 22 Teresa Summers.
 23 JUDGE FLAX: Thank you.
 24 I understand we also have a
 25 court reporter on the line; is that

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1 JUDGE FLAX: Okay. And, as of our
 2 last conference call, which was held
 3 July 15, when we left that, the parties had
 4 agreed to work together to try to secure
 5 Dr. Quintana's deposition.
 6 And, the parties have reported to
 7 the Panels on essentially a weekly basis to
 8 update us on what was happening, and have
 9 reported that they have been unable to
 10 secure Dr. Quintana's deposition. Is that
 11 also accurate?
 12 MR. SUNG: That is accurate,
 13 Your Honor.
 14 JUDGE FLAX: Okay. So, why don't
 15 you tell us what the current status is and
 16 what you are looking for today.
 17 MR. TUCKER: Your Honor, this is
 18 Mr. Tucker, for Petitioner with New
 19 Medical, thank you.
 20 The Board's characterization of
 21 the efforts are correct. There's been a
 22 couple reach outs to Dr. Quintana via
 23 email, as well as a letter. There's been
 24 no response.
 25 So, you know, cross-examination of

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1 a witness who appears in an affidavit, it's
2 routine discovery. And I think that's
3 whether or not it's -- you know, the claims
4 of a third-party independent witness, I
5 don't think that's a red herring here.
6 It's just that this was an affidavit and
7 there's direct testimony, and so cross is
8 part of the routine discovery.
9 Given that Dr. Quintana's being --
10 has been unresponsive, we can assume we're
11 not going to get that cross-examination
12 testimony.
13 Petitioner's looking for guidance
14 of what we would do next.
15 Do we request -- you know, one
16 thought that we had is to request
17 authorization to file a motion to strike or
18 otherwise remove the affidavit from the
19 record.
20 I went through the Trial Practice
21 Guide, and I found Page, I believe 80, 81,
22 a motion to strike is perhaps more
23 appropriate where it's a procedural issue,
24 such as this, where they can pull and stop
25 making themselves available, as to opposed

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1 to waiting till later where it would be
2 something more of an evidentiary objection.
3 But, you know, seeking permission to file
4 that motion to strike.
5 And also, if the Board believes
6 it's not appropriate for a motion to
7 strike, what would be the vehicle that the
8 Board would like Petitioner to proceed to
9 get this issue properly before the Board
10 and give each side a chance to brief it?
11 So, that's -- that's the crux that
12 I think the Petitioner is looking for here,
13 Your Honors, is that guidance.
14 JUDGE FLAX: Okay. Mr. Sung,
15 what's your position?
16 MR. SUNG: I think that we've, on
17 our last call, addressed the Patent Owner's
18 concern that at this point in time, while
19 we don't dispute that it would be an
20 opportunity for cross-examination to, you
21 know, help with this process, that we do
22 not control this particular witness, and
23 have no other relationship with the
24 witness. And as an independent fact
25 witness, for that purpose, we don't have

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1 the opportunity to compel him, otherwise,
2 to be available.
3 We have, as the Board had
4 mentioned, tried to work with Pat --
5 Petitioner to request that the witness be
6 available. And, again, we have not --
7 neither party has heard back from him about
8 that.
9 We don't have an objection to
10 Petitioner pursuing a motion to strike, and
11 we would agree that this would allow the
12 parties to fully brief the issue.
13 JUDGE FLAX: Okay. Just one
14 moment.
15 So, I appreciate what you've had
16 to say, Mr. Sung.
17 One question for you, Mr. Sung,
18 how did you procure Dr. Quintana's
19 affidavit in the first place?
20 MR. SUNG: We had reached out to
21 some contacts in Dr. Quintana's former
22 employ, I believe he's employed with the
23 University of Barcelona, I apologize if I
24 don't have the exact accurate name of the
25 institution.

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1 Again, Dr. Quintana has long
2 retired, but there were individuals at that
3 particular location that were familiar with
4 Dr. Quintana. And through that mechanism
5 we were able to reach out to him.
6 JUDGE FLAX: When you say you
7 reached out to him, what does that mean
8 precisely?
9 MR. SUNG: There was an email
10 address that was provided to us, that we
11 believe it was Dr. Quintana's personal
12 email, and that was, again, the email
13 address we used to reach out with the
14 parties' joint request for his
15 availability.
16 And through that email mechanism,
17 we set up a time for a telephone
18 conference. And he had, you know, spoken
19 with us on that telephone conference.
20 JUDGE FLAX: And have you used
21 these resources to try to get in touch with
22 Dr. Quintana, his email address, his
23 associates in Spain, and his telephone
24 number that you seem to have?
25 MR. SUNG: To correct, Your Honor,

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1 on that point, we don't have Dr. Quintana's
 2 telephone number. He was asked to dial in
 3 to a bridge line that we provided for him.
 4 We did contact him through the
 5 email address that we had available to us.
 6 And, in addition, we sent a letter to what
 7 we understood to be his home address.
 8 JUDGE FLAX: Did he respond to the
 9 emails?
 10 MR. SUNG: He has not.
 11 JUDGE FLAX: So the only direct
 12 contact you've had is a letter sent to what
 13 you understand to be his home, and some
 14 sort of a conference call line, where you
 15 spoke with him, and everyone dialed in; is
 16 that accurate?
 17 MR. SUNG: Yes. And we have not
 18 spoken with Dr. Quintana since the signing
 19 of his affidavit.
 20 JUDGE FLAX: And how do you know
 21 that you're dealing with the actual
 22 Dr. Quintana at all?
 23 MR. SUNG: Well, I think the
 24 easiest way to address that is through our
 25 conversation during the telephone

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1 conference in terms of confirming, you
 2 know, his understanding of the article
 3 that, you know, he is the author of.
 4 JUDGE FLAX: So, am I
 5 understanding you correctly in saying that
 6 you believe you're dealing with the actual
 7 Dr. Quintana because of the person's
 8 knowledge of the article that was submitted
 9 as Exhibit 1004; is that right?
 10 MR. SUNG: I think that's part of
 11 it, Your Honor. And I think the other
 12 component was, again, having initiated the
 13 contact through the university, we had no
 14 reason to, you know, disbelieve that this
 15 individual we were speaking with was not,
 16 in fact, the author of the article.
 17 MS. SUMMERS: Your Honor, this
 18 is --
 19 Judge Flax: Okay.
 20 MS. SUMMERS: This is Teresa
 21 Summers, if I may make a point.
 22 I would love to confirm this, but
 23 my understanding is also that the affidavit
 24 was notarized. But, allow me to confirm
 25 that.

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1 JUDGE FLAX: Well, I've looked at
 2 the exhibit that is the affidavit, and I
 3 agree with you, that there's a portion of
 4 the exhibit that appears to be notarized.
 5 But, in the sense it's -- that
 6 notarization is just about as good as
 7 anything else in the exhibit.
 8 So, if you would hold on the line
 9 for a moment, the Panels will confer.
 10 - - - -
 11 (Thereupon, a discussion was had off the
 12 record.)
 13 - - - -
 14 JUDGE FLAX: Okay. Hello,
 15 everybody, this is Judge Flax.
 16 So, based on what we've heard, the
 17 Panels in all of these cases are
 18 authorizing filing of a motion to strike by
 19 Petitioner.
 20 Mr. Tucker, what exactly do you
 21 need in terms of pages and when can you
 22 file it?
 23 MR. TUCKER: Yes. So, I'm getting
 24 our schedule up here. Would five to ten
 25 pages, I'm leaning more towards about ten,

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1 because I think there's some preferential
 2 case law that we're going to want to
 3 explain, so maybe ten pages.
 4 And, we have expert depositions
 5 next week, with our first reply due
 6 August 31.
 7 I'm thinking maybe shoot to get --
 8 I could get the motion filed by the 17th or
 9 18th, we'll work over the weekend to move
 10 this along, Your Honor.
 11 Maybe the 18th might be best.
 12 JUDGE FLAX: We're talking about
 13 this month; is that correct?
 14 MR. TUCKER: Yeah, that's what I
 15 was thinking.
 16 JUDGE FLAX: Of August?
 17 MR. TUCKER: Yes, sir.
 18 JUDGE FLAX: Okay. All right.
 19 So, in view of that, what we'll do
 20 is we'll authorize seven pages, and we'll
 21 say by the 18th. I mean, I don't know that
 22 this is necessarily urgent so, you know, if
 23 you want more time than the 18th, that
 24 would probably be okay.
 25 But, if you could file it by the

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1 18th, that's fine.
 2 So, perhaps what we'll do is say
 3 the due date will be the 20th.
 4 MR. TUCKER: Okay.
 5 JUDGE FLAX: Be the end of that
 6 week.
 7 Of course, an opposition is
 8 authorized. And we'll say we'll make that
 9 due by the 3rd. Same page limit.
 10 Now, although we're authorizing
 11 this motion and will consider it, we would
 12 suggest that everyone continue to make some
 13 efforts to procure this deposition, as it
 14 seems like the information would be useful,
 15 or whatever information you might get from
 16 the deposition might be useful.
 17 And it sounds like you have an
 18 email address where you might be able to
 19 further try to contact Dr. Quintana. We
 20 suggest using that.
 21 Of course, it's your prerogative
 22 to do it however you want.
 23 But, it seems like if you have
 24 more avenues than just sending a joint
 25 letter, you might want to explore those

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1 avenues.
 2 So, that being said, Mr. Tucker,
 3 are those guidelines satisfactory to you?
 4 MR. TUCKER: Those are perfect,
 5 Your Honor.
 6 JUDGE FLAX: Mr. Sung, do you
 7 understand those?
 8 MR. SUNG: We do, Your Honor,
 9 thank you.
 10 JUDGE FLAX: Okay. So what we'll
 11 do is we'll follow up with an order further
 12 commemorating what we've discussed.
 13 And we understand that you-all
 14 will file a transcript of this conference
 15 call as soon as you can. Is that correct?
 16 MR. TUCKER: Yes, that is correct.
 17 Petitioner will attend to that, Your Honor.
 18 JUDGE FLAX: Okay. As well as the
 19 updated mandatory notices from Patent
 20 Owner, that we discussed.
 21 So, is there anything else you-all
 22 would like to discuss at this time?
 23 MR. TUCKER: Not from Petitioner,
 24 Your Honor.
 25 MR. SUNG: Nothing more from

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1 Patent Owner, Your Honor.
 2 JUDGE FLAX: Let me make sure that
 3 none of the other Judges on the Panel have
 4 anything to say.
 5 I think they might not.
 6 Okay. Then we'll call this
 7 conference call finished, we'll go off the
 8 record, and you-all have a nice weekend.
 9 MR. TUCKER: Thank you. You as
 10 well, Your Honor.
 11 MR. SUNG: Thank you, Your Honor.
 12 - - - -
 13 (Proceedings concluded at 10:20 a.m.)
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 2
 3 C E R T I F I C A T E
 4
 5 I, Elizabeth A. Merritt, a Notary Public
 6 within and for the State of Ohio, do hereby
 7 certify that I attended the foregoing proceedings
 8 in its entirety, that I wrote the same in
 9 stenotypy, and that this is a true and correct
 10 transcript of my stenotype notes.
 11 IN WITNESS WHEREOF, I have hereunto set my
 12 hand and seal of office, at Cleveland, Ohio, this
 13 18th day of August, 2021.
 14
 15
 16
 17
 18
 19 *Elizabeth A. Merritt*
 20 Elizabeth A. Merritt
 21 Notary Public, State of Ohio
 22 My commission expires September 9, 2024
 23
 24
 25

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