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

New World Medical, Inc.,
Petitioner
v.
MicroSurgical Technology, Inc.,
Patent Owner

Case Nos. IPR2020-01573; IPR2020-01711;
IPR2021-00017; IPR2021-00065; IPR2021-00066
U.S. Patent Nos. 9,107,729; 9,358,155; 9,820,885;
10,123,905, 9,999,544

VIDEOTAPED DEPOSITION OF GARRY CONDON, M.D.
Volume 2

DATE TAKEN: Wednesday, August 18, 2021
TIME: 9:02 a.m. - 10:43 a.m.
Eastern Daylight Time
PLACE: Embassy Suites
202 North Tamiami Trail
Sarasota, Florida 34236

Examination of the witness taken before:
SUSAN D. WASILEWSKI, RPR, CRR, CMRS, CRC, FPR
~ Realtime Systems Administrator ~

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1 I N D E X
2 Volume 2
3 Wednesday, August 18, 2021
4 WITNESS PAGE
5 Called by the Petitioner:
6 EXAMINATION BY MR. TUCKER..... 236
7
8 E X H I B I T S
9 (Attached to transcript)
10 GARRY CONDON, M.D., DEPOSITION EXHIBITS PAGE
11 Condon Exhibit 15 May 19, 2015 Notice of 238
12 Allowance and Fee(s) Due
13 Application Number 14/481,754
14 Condon Exhibit 16 United States Patent 258
15 Patent No. US 9,820,885 B2
16 Condon Exhibit 17 United States Patent 258
17 Patent No. US 10,123,905 B2
18 Condon Exhibit 18 United States Patent 272
19 Patent No. US 9,999,544 B2
20 Condon Exhibit 19 United States Patent 278
21 Patent No. US 9,358,155 B2
22

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1 THE VIDEOGRAPHER: Today's date is August
2 the 18th, the year 2021, the time is 9:02 a.m.
3 This is Volume 2 to the deposition of Garry
4 Condon.
5 Will our court reporter please swear our
6 witness?
7 THE COURT REPORTER: Let me remind you that
8 you are still under oath.
9 MR. TUCKER: Thank you.
10 GARRY CONDON, M.D., called as a witness by
11 Petitioner New World Medical, Inc., having been
12 previously duly sworn, continued to testify as
13 follows:
14 DIRECT EXAMINATION
15 BY MR. TUCKER:
16 Q. All right. Good morning, Dr. Condon. How
17 are you?
18 A. Good morning.
19 Q. We'll try to move quick today. After we --
20 after we finished last night, did you -- did you
21 review anything to prepare yourself for today?
22 A. No.

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1 Q. You didn't review the transcript?

2 A. No.

3 Q. Okay. Did you have any discussions with

4 counsel?

5 A. No.

6 Q. Give me a rough idea of how many hours it

7 took to draft your report?

8 A. A lot. I would say the best part of a week,

9 so probably close to, you know, 40 hours. I'm

10 estimating.

11 Q. And did anyone help you draft your report?

12 A. Only to the extent that they -- I had

13 assistance with the formatting of applying the prior

14 art to a specific claim and matching -- so that

15 there was a continuity between Dr. Netland's listed

16 assertions and what claims they applied to, so to

17 speak, so organizing it.

18 Q. When you say -- sorry to interrupt. When

19 you say they, who are you referring to?

20 A. That's the people -- the counsel people who

21 took what my opinions were and placed them in a

22 format that related to the petition grounds and

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1 claims so that it was organized, basically.

2 Q. So -- just so that we have a clear record,

3 so the attorneys at Wiley Rein?

4 A. The attorneys at Wiley Rein and the staff

5 or --

6 Q. Okay. And did the attorneys provide you

7 with background on patent law?

8 A. To some extent, to the extent that I was

9 trying to understand the formatting and the

10 organization.

11 MR. TUCKER: I always want to call it Wiley

12 Rein, so I had to think there, you know, Rein,

13 Rein. I actually didn't know it was that until

14 you -- one of the telephone calls, I think you

15 said it. Oh, wow, I've been saying the name

16 wrong.

17 Okay. This will be Exhibit 15. Oh, shoot.

18 Okay.

19 (Condon Exhibit 15 was marked for

20 identification.)

21 MR. TUCKER: Give me one second to find the

22 other one.

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1 BY MR. TUCKER:

2 Q. I apologize. There is only two copies. Can

3 I let your counsel look at this for a second?

4 A. Please.

5 MR. TUCKER: I'm really sorry.

6 MS. SUMMERS: That's all right.

7 MR. TUCKER: It's a Notice of Allowance from

8 the '729 patent.

9 MS. SUMMERS: Okay.

10 BY MR. TUCKER:

11 Q. Okay. So, Dr. Condon, the court reporter

12 has handed you Exhibit 15, which is a -- I'm trying

13 to find the date on this. It is -- oh, there it is.

14 It didn't print very well. It is a May 19th, 2015

15 Notice of Allowance and Fees Due that was issued in

16 Application Number 14/481,754, which I will

17 represent to you became the '729 patent. Could you

18 take a look at this and let me know if you've seen

19 this before?

20 A. I've not seen this before.

21 Q. Okay. Since you haven't seen that, we'll

22 move on.

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1 So is it your opinion that the beveled sides

2 of the Quintana needle are not first and second

3 cutting edges?

4 MS. SUMMERS: Objection; form.

5 A. So to the extent that we're talking about

6 Quintana's publication and description, there's

7 nowhere I can apply the term "cutting edges" in that

8 context of Quintana.

9 Q. Does Quintana -- and feel free -- Quintana

10 is somewhere in your stack. Does Quintana state

11 that the edges of its needles are not sharp?

12 MS. SUMMERS: Objection; form.

13 A. I don't believe he characterizes -- I'd have

14 to read it again. I'm not recalling that he states

15 anything very much about the needle, including that.

16 If there was some specific element of his

17 publication that you're referring to, I'd be

18 certainly happy to look at it, but I'm just trying

19 to recall.

20 Can I just take one second here just to

21 be -- I'm going to look at this for just a moment

22 and then I was going to look at what --

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1 THE VIDEOGRAPHER: Mr. Tucker, can we go off
 2 the record while he's looking at that for a
 3 moment?
 4 MR. TUCKER: Yeah. Yes.
 5 THE VIDEOGRAPHER: We're going off the
 6 record at 9:09 a.m.
 7 (Recess from 9:09 a.m. until 9:11 a.m.)
 8 THE VIDEOGRAPHER: We're back on the record
 9 at 9:11.
 10 BY MR. TUCKER:
 11 Q. Okay. You were taking a second and then we
 12 had some microphone issues. So is there anything
 13 you want to add to your answer?
 14 A. That I was taking a second, but just now the
 15 question again -- and specifically the question
 16 again, was there -- you started with was there
 17 anything...
 18 Q. Yeah. I believe the question was --
 19 actually, let me see what I said here because I
 20 got -- oh.
 21 So is it your opinion that the beveled sides
 22 of the Quintana needle are not first and second

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1 cutting edges? That was the question that was
 2 pending.
 3 MS. SUMMERS: Objection; form.
 4 A. So in Quintana, anybody reading Quintana
 5 would not have -- Quintana made no reference to the
 6 beveled sides of his trabeculotome tip as being
 7 sharp. He didn't characterize the needle tip to any
 8 great extent, and Dr. Netland's assertion that there
 9 is cutting edges being demonstrated in Quintana is,
 10 I think, erroneous and incorrect.
 11 Q. Okay. Could you -- for the record, what
 12 paragraph were you looking at on your paragraphs?
 13 Can you look at your expert report?
 14 A. I'm looking at Paragraph 24.
 15 Q. Okay. Does -- do you recall, does the '729
 16 patent give any information about what constitutes a
 17 cutting edge?
 18 MS. SUMMERS: Objection; outside the scope.
 19 A. So the patent, in my summary, and in looking
 20 at the patent claims -- so the '729 claim indicates
 21 that there is cutting of the TM by first and second
 22 cutting edges, if that's what you're asking me,

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1 cutting edges being formed at the spaced apart
 2 locations in the '729 patent.
 3 Q. Does the '729 patent say any -- say anything
 4 or provide any information about how sharp the
 5 cutting edges are?
 6 MS. SUMMERS: Objection; outside the scope.
 7 A. So I can -- to my recollection and -- the
 8 lateral cutting edges and only the lateral cutting
 9 edges in the '729 patent are sharp and capable of
 10 cutting tissue.
 11 Q. Does the '729 patent provide a measure of
 12 how sharp those cutting edges are?
 13 MS. SUMMERS: Objection; outside the scope.
 14 A. I never analyzed it.
 15 Q. Okay. If Quintana's goal was to create an
 16 opening in the trabecular meshwork, wouldn't
 17 sharpening the beveled sides been an obvious next
 18 step to make creating that opening easier?
 19 MS. SUMMERS: Objection; form, outside the
 20 scope.
 21 A. I could answer in two parts. One is he
 22 makes no mention of anything like that or the

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1 necessity to do so, or the suggestion that that
 2 would help, number one.
 3 And number two is he indicates that he uses
 4 the pointed tip to perform his procedure of opening
 5 the trabecular meshwork.
 6 Q. So is it your opinion that Quintana -- in
 7 Quintana, the sides are not sharp?
 8 MS. SUMMERS: Objection; form.
 9 Q. Actually, let me strike that. Let me
 10 rephrase it.
 11 So is it your opinion that in Quintana the
 12 sides of his needle are not sharp?
 13 MS. SUMMERS: Same objection.
 14 A. Is it my contention that in his article he
 15 states that the sides of the needle are not sharp
 16 or --
 17 Q. Let's start there. Does he state
 18 specifically the sides of the needle are not sharp?
 19 MS. SUMMERS: Objection; form.
 20 A. I don't believe he states that emphatically
 21 the sides of the needle are not sharp. To that
 22 extent, he doesn't characterize the needle to any

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1 great extent, so he's -- let me just see really
 2 quick here. I'm going to refer to my --
 3 So I'm going to say that Quintana doesn't
 4 indicate that his needle -- that the sides of his
 5 needle are -- he doesn't suggest that they are
 6 sharp, he doesn't specifically say that they are not
 7 sharp. As I said, I can't see any characterization
 8 along those lines within Quintana, so in that
 9 regard, I would disagree with anybody that would
 10 suggest that the needle used by Quintana would have
 11 any sharp edges.
 12 Q. I believe you opined in Paragraphs 23 and 28
 13 that Quintana's needs is not a dual-bladed --
 14 dual-blade device because the beveled sides and
 15 sharp point act as a single blade. Is that -- is
 16 that correct?
 17 MS. SUMMERS: Objection; misstates the
 18 testimony.
 19 A. I'm saying that the sides are not sharp and
 20 intended to cut tissue, so there's no dual blade on
 21 that basis, but if they were -- as I said in my
 22 declaration, they needed to be sharp and intended to

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1 cut tissue, which they are not, then the entire
 2 surface of the single bevel, including the sharp
 3 point and sides, must also be deemed as a single
 4 cutting edge or blade.
 5 So I'm -- the key term here is, you know,
 6 are the edges sharp and intended to cut tissue, and
 7 the answer is no.
 8 Q. Okay. So if the edges were sharp, it's your
 9 opinion that they would only form a single cutting
 10 edge?
 11 MS. SUMMERS: Objection; form, misstates the
 12 testimony.
 13 A. If my opinion was that they were sharp,
 14 which is not my opinion -- so you're asking
 15 hypothetically another opinion of mine which is
 16 not --
 17 Q. Well, it's written right here in the
 18 paragraph, sir.
 19 A. Okay. So --
 20 Q. I mean, let's quit dancing around this.
 21 A. So, in my opinion, they are, you know, not
 22 sharp. If somebody else deemed them to be sharp,

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1 then it would be my opinion that this surface of the
 2 bevel would constitute a single blade or a single
 3 cutting edge.
 4 Q. And is a single cutting edge, where you have
 5 a first side, a sharp point, and a second side to
 6 form that single cutting edge, is that acting
 7 essentially equivalently to a device with dual
 8 cutting edges?
 9 MS. SUMMERS: Objection; form, calls for a
 10 legal conclusion.
 11 A. It would be -- if the sides were sharp, the
 12 tip is sharp, you have a single cutting edge. You
 13 don't have separate cutting edges, if that was the
 14 question you were asking me.
 15 Q. No. The question is in that scenario of the
 16 single blade with sharp sides, is it acting the same
 17 as a device with a dual blade?
 18 MS. SUMMERS: Objection; calls for a legal
 19 conclusion.
 20 A. I don't know.
 21 Q. What would you need to know to figure that
 22 out?

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1 MS. SUMMERS: Same objection.
 2 A. I don't know. I don't know what I would
 3 need to know to figure it out.
 4 Q. If Quintana's needle had sharp sides, would
 5 it act the same as the dual-bladed cutting device
 6 disclosed in the '729 patent?
 7 MS. SUMMERS: Objection; form, calls for a
 8 legal conclusion.
 9 A. I can't conclude how it would behave. I
 10 have no experience with an instrument or seeing it
 11 demonstrated.
 12 Q. Do the inventions of the '729 patent cover a
 13 bent needle --
 14 MS. SUMMERS: Object --
 15 Q. -- used to remove a section of TM?
 16 MS. SUMMERS: Objection; form, beyond the
 17 scope.
 18 A. I would say no, the '729 does not refer to a
 19 bent needle.
 20 Q. Okay. If the point of Quintana's needle was
 21 not sharp, would that make Quintana's -- strike
 22 that.

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1 If the point of Quintana's needle was not
 2 sharp and the sides were, would that make it a
 3 dual-bladed device?
 4 MS. SUMMERS: Objection; form.
 5 A. You're ascribing hypothetical
 6 characteristics to a needle that I can't say what it
 7 would be. As you've changed these descriptions of
 8 the needle, I can't tell you what it would be.
 9 Q. Okay. You can't answer the question?
 10 A. I don't know that I'm not answering the
 11 question. I'm telling you -- you asked me what it
 12 would be and so my answer to the question is I don't
 13 know what it would be. So you're taking away the
 14 sharp tip and you're adding sharp sides, a lot of
 15 things going on, so I don't know what it would be.
 16 It would still be a needle.
 17 Q. And needles don't have sharp sides?
 18 MS. SUMMERS: Objection; form.
 19 A. Needles have sharp tips, points, sharp
 20 points.
 21 Q. But they don't have sharp sides?
 22 A. They don't have sharp sides.

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1 Q. Okay. So do you recall yesterday we were --
 2 we had some discussions about a reference written by
 3 Jacobi?
 4 A. Right.
 5 Q. Okay. And it's in your stack if you need
 6 it. Is it your opinion that Jacobi does not
 7 disclose taking strips of TM from Schlemm's canal?
 8 MS. SUMMERS: Objection; form.
 9 A. So I'm trying to recall. I believe you
 10 asked me that question yesterday, and I could just
 11 read to you Jacobi's description of what he found to
 12 be as accurate as possible with the answer.
 13 Q. How about this. Do you recall that
 14 Jacobi -- and again, look at the article if you
 15 want, but do you recall that Jacobi's device results
 16 in strings of trabecular meshwork?
 17 MS. SUMMERS: Objection; form.
 18 A. Okay. Let's look here. Gonioscopically,
 19 strings of trabecular tissue could be observed
 20 intraoperatively by gonioscurettage, and he's
 21 certainly not describing a strip of trabecular
 22 meshwork or the defined width, so strings of

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1 trabecular tissue otherwise not described is what he
 2 says in his article.
 3 Q. Exhibit 3 is the '729 patent. Do you have
 4 that available?
 5 A. Exhibit 3?
 6 Q. Yes.
 7 A. Is that the patent?
 8 Q. That's the patent, yeah, that's the '729
 9 patent.
 10 A. I'm sure I do.
 11 Q. That's it. Is that it?
 12 A. This is it.
 13 Q. Okay. Let's go to Column 7, the very last
 14 page, and the first paragraph there is the end of
 15 Claim 1.
 16 A. I'm sorry. The first paragraph is --
 17 Q. That's the end of Claim 1. If you look back
 18 at Page 6, you will see that's the start of Claim 1.
 19 A. Okay.
 20 Q. And as a matter of fact, feel free to look
 21 at the entire claim.
 22 Does -- do the claim -- does Claim 1 in the

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1 '729 patent require a strip of a defined width?
 2 MS. SUMMERS: Objection; beyond the scope.
 3 A. Yeah, I believe it does, with the said width
 4 of this strip of tissue width W, width W being
 5 approximately equal to the distance between the
 6 first and second cutting edges.
 7 Q. So the width of the strip just needs to be
 8 the distance between the cutting edges, correct?
 9 MS. SUMMERS: Objection; beyond the scope.
 10 A. I'm just going to say it needs to be of a
 11 defined width. I don't know what the width -- exact
 12 width is between the cutting edges, but I believe
 13 that the patent claim is stating that the width be
 14 equal to the distance between the first and second
 15 cutting edges, is what this said.
 16 Q. Right. I'm not asking about a measurement.
 17 I'm just asking you the patent would say that the
 18 width is just the same as the distance between the
 19 cutting edges?
 20 MS. SUMMERS: Objection; misstates the
 21 record.
 22 A. You know, the specific definition of what

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