

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

NEW WORLD MEDICAL, INC.,
Petitioner,

v.

MICROSURGICAL TECHNOLOGY, INC.,
Patent Owner.

IPR2020-01573, Patent 9,107,729 B2
IPR2020-01711, Patent 9,358,155 B2
IPR2021-00017, Patent 9,820,885 B2
IPR2021-00065, Patent 10,123,905 B2
IPR2021-00066, Patent 9,999,544 B2¹

Before JAMES A. TARTAL, JAMES A. WORTH,
ROBERT A. POLLOCK, RYAN H. FLAX, and
DEVON ZASTROW NEWMAN *Administrative Patent Judges*.

FLAX, *Administrative Patent Judge*.

ORDER

Granting Petitioner's Motions to Strike
37 C.F.R. §§ 42.5(a), 42.12, 42.51(b)(1)(ii)

¹ Because this Order applies to each of these related *inter partes* review proceedings, we use this caption for efficiency. The parties are not authorized to follow this practice, but may request such authorization.

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IPR2021-00066, Patent 9,999,544 B2

New World Medical, Inc. (“Petitioner”) filed a Petition for an *inter partes* review in: IPR2020-01573 challenging claims of Patent 9,107,729 B2; IPR2020-01711 challenging claims of Patent 9,358,155 B2; IPR2021-00017 challenging claims of Patent 9,820,885 B2; IPR2021-00065 challenging claims of Patent 10,123,905 B2; and IPR2021-00066 challenging claims of Patent 9,999,544 B2. *See, e.g.*, Paper 1 of IPR2020-01573; *see also* respective Petitions of other noted proceedings.²

MicroSurgical Technology, Inc. (“Patent Owner”) is the Patent Owner in each of these *inter partes* review proceedings. Trial has been instituted in each proceeding. *See, e.g.*, Paper 22 in IPR2020-01573. Patent Owner filed its Response to the Petition (Paper 29), Petitioner filed a Reply to the Response (Paper 35), and Patent Owner filed a Sur-Reply to the Reply (Paper 44).

As evidence in support of its Response, Patent Owner submitted Exhibit 2020, which is titled “Sworn Affidavit of Manuel Quintana, M.D.” Ex. 2002 (“Quintana Affidavit”). “Manuel Quintana” is the named author of an article titled “Gonioscopic Trabeculotomy. First Results,” which is Petitioner’s Exhibit 1004 and evidence submitted with the Petition. Ex. 1004 (the “Quintana Article”). It is Patent Owner’s position that the Quintana Affidavit is the sworn testimony of the author of the Quintana Article and “clarif[ies] what his article meant to report.” *See* Ex. 1026, 8:1–22.

² For efficiency, we cite to the record from IPR2020-01573; the records in the related proceedings are similar.

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Petitioner requests that the Board strike the Quintana Affidavit from the record. Paper 34, 1 (“Motion to Strike”). Patent Owner opposes this Motion to Strike. Paper 36 (“Opposition”). The Motion to Strike and Opposition were authorized. Ex. 1027, 12:14–16:8. Petitioner’s Reply to Patent Owner’s Opposition (Paper 45) and Patent Owner’s Sur-Reply to Petitioner’s Reply (Paper 46) were also authorized. Paper 43.

Petitioner sought to cross-examine Dr. Quintana as routine discovery pursuant to the Board’s Rule 37 C.F.R. 42.51(b)(1)(ii). Ex. 1028; Ex. 2026. According to Patent Owner, Dr. Quintana is an 85-year-old, retired, Spanish citizen, residing in Barcelona, Spain. Ex. 1026, 8:1–3. Pursuant to 37 C.F.R. § 42.53(b)(2), Petitioner requested to depose the witness at a location within the United States. Ex. 1028. Patent Owner indicated to Petitioner that Dr. Quintana would not travel to the United States from Spain because of health concerns and the COVID-19 pandemic. *Id.*

When Petitioner’s desire for this deposition failed to come to fruition the parties consulted the Board and we instructed the parties to cooperate to secure the deposition of Dr. Quintana in Spain in as convenient a manner as possible for the witness, which they pursued for several weeks; the parties’ efforts included emailing and forwarding a letter to Dr. Quintana requesting his deposition. Ex. 1026, 17:8–19:7; Ex. 1029; Ex. 1044; Ex. 1045; Ex. 2027; Ex. 2028. Again, these efforts failed to procure Dr. Quintana for deposition. Ex. 1027.

Providing some finality to the issue, on August 22, 2021, Dr. Quintana emailed Patent Owner’s counsel stating as follows:

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Sorry I did not reply earlier. I have been away on holiday and will not return until September. Please understand that I am retired and do not wish to be involved in your lawsuit. I agreed to explain what my article reported, but I do not wish to answer any more questions and ask that you do not contact me about this anymore.

Yours sincerely

Manuel Quintana, M.D.

Ex. 1040. Thus, Dr. Quintana unequivocally refuses to submit to cross-examination by Petitioner.

Petitioner argues that “here, Patent Owner is solely responsible for Dr. Quintana and [his] Affidavit, and the failure to make Dr. Quintana available for deposition calls for the testimony to be struck from the record.” Motion to Strike 6. Petitioner argues that the refusal of cross-examination is “extremely prejudicial” because the Quintana Affidavit “contradicts and attempts to rewrite portions of the [Quintana Article].” *Id.*; *see also* Ex. 1026, 8:20–22 (Patent Owner agreeing that the Quintana Affidavit seeks to clarify what was meant by the text of the Quintana Article). Petitioner argues that when submitting the Quintana Affidavit, Patent Owner should have understood and planned for compliance with the Board’s rules on routine discovery, which make cross-examination of affidavit testimonial witnesses obligatory. Motion to Strike 7.

Patent Owner responds that the Quintana Affidavit is self-authenticating; that it is only two pages long, such that making a trip to Spain for deposition is not commensurate with its value; and that, rather than strike the evidence, the Board should instead accord it the appropriate

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weight. Opposition 1. Patent Owner argues that something less than a live deposition would be suitable alternative discovery for Petitioner. *Id.* Patent Owner argues that Dr. Quintana’s testimony “is not dispositive to the issues in dispute” in this proceeding and, thus, cross-examination is not needed and the Board may simply weigh the evidence in its absence. *Id.* at 5.

We are persuaded that the appropriate action here is to grant Patent Owner’s Motion to Strike Exhibit 2020 from the record.³ Under authority of 35 U.S.C. § 316(a)(5), the Director has prescribed regulations “setting forth standards and procedures for discovery of relevant evidence including that such discovery shall be limited to . . . the deposition of witnesses submitting affidavits or declarations.” Routine discovery, as defined by our Rules, requires that when a party proffers a witness’s testimony by affidavit, that party must make the witness available for cross-examination by the other party. *See* 37 C.F.R. §§ 42.51–42.53. Our Consolidated Trial Practice Guide makes clear that “[d]iscovery is a tool to develop a fair record and to aid the Board in assessing the credibility of witnesses,” and that “a party presenting a witness’s testimony by affidavit should arrange to make the witness available for cross-examination. This applies to witnesses employed by a party as well as experts and non-party witnesses.” CTPG 22–23.

We will not consider the affidavit of Dr. Quintana without Patent Owner making the witness available for the desired cross-examination by

³ Although Petitioner further requests that we expunge Exhibit 2020 (*see, e.g.,* Motion to Strike 1, 4), we decline to do so in interest of a complete record upon any appeal.

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