IN THE UNITED STATES DISTRICT COURT FOR THE
WESTERN DISTRICT OF OKLAHOMA

JAN K. VODA, M.D.	)	
	)	
Plaintiff,	)	
	)	
vs.	)	Case No. CIV-09-95-L
	)	
MEDTRONIC INC. and	)	
MEDTRONIC VASCULAR, INC.,	)	
	)	
Defendants.	)	

O R D E R

Plaintiff, Dr. Jan K. Voda, is the holder of United States Patent No. 6,083,213 ("the '213 patent"), which was issued by the United States Patent and Trademark Office on July 4, 2000. Exhibit 1 to Complaint (Doc. No. 1-2). The '213 patent generally relates to plaintiff's inventive technique for using a guiding catheter to perform angioplasty of the left coronary artery. On January 22, 2009, plaintiff filed this action seeking damages for alleged infringement of the '213 patent by defendants Medtronic Inc. and Metronic Vascular, Inc. based on their manufacture and sale of Medtronic EBU Guiding Catheters. Complaint at ¶¶ 15, 17-21.

After the court granted defendants' request for additional time to respond to the complaint, they filed a motion to dismiss for lack of standing on February 27, 2009. Defendants' Motion to Dismiss Complaint (Doc. No. 26). Thereafter, the court held an evidentiary hearing, denied defendants' motion to dismiss, and set the matter on the court's next status conference docket. Before the court could hold the

conference, however, defendants filed a motion to stay the case based on their filing of an *ex parte* reexamination request in the United States Patent and Trademark Office ("USPTO"). Medtronic's Motion to Stay Litigation Pending Reexamination in U.S. Patent and Trademark Office (Doc. No. 55). Defendants' reexamination request, which was filed on June 18, 2009, was granted by the USPTO on July 14, 2009. On July 23, 2009, the court entered a stipulated order staying this matter pending the outcome of the reexamination proceeding.

On May 21, 2010, the Patent Office issued notice that claims 1-5 of the '213 patent were subject to reexamination and were rejected. Thereafter, plaintiff met in person with the patent examiner, and on August 19, 2010, the Patent Office issued notice that claims 1-3 of the '213 patent were confirmed upon reexamination and claims 4 and 5 would be allowed based on the clarification that the catheter advanced through the entire aortic arch. Exhibit 2 to Medtronic's Motion to Stay Litigation Pending Reexamination in U.S. Patent and Trademark Office (Doc. No. 77-2) [hereinafter cited as "Second Motion to Stay"]. While the first reexamination request was pending, defendants filed a second *ex parte* request for reexamination.[1] Exhibit 3 to Second Motion to Stay at 1. That request was denied approximately a month later, on September 22, 2010. The Patent Office found that no substantial

[1]The second request was filed on August 18, 2010, the day before the USPTO issued its Notice of Intent to Issue Ex Parte Reexamination Certificate. *Compare* Exhibit 1 to Notice of Intent to Issue Reexamination Certificate and Request to Lift the Instant Stay at 1 ("DATE MAILED: 08/19/2010") (Doc. No. 74-1) *with* id. at Exhibit 2 at 1 ("FILING DATE 08/18/2010") (Doc. No. 74-2).

new question of patentability was raised by the second request and the prior art cited therein. Id. at 13.

On September 28, 2010, plaintiff gave notice to this court of the USPTO's intent to issue a reexamination certificate confirming the '213 patent. Plaintiff requested that the stay issued in July 2009 be lifted and that this matter be allowed to proceed. Notice of Intent to Issue Reexamination Certificate and Request to Lift the Instant Stay (Doc. No. 74). When defendants did not respond to plaintiff's request, the court issued an order lifting the stay and directing that this case be set for status conference on the court's next available docket. Order at 1 (Doc. No. 75). On November 22, 2010, a docket was issued setting this matter on the court's January 5, 2011 status conference docket. Docket at 3 (Doc. No. 76).

On December 15, 2010, defendants filed the pending motion, which is their second motion to stay this case.[2] Defendants request a second stay of this matter based on their third *ex parte* request for reexamination, which they filed with the USPTO on October 18, 2010.[3] Exhibit 4 to Motion to Stay at 1 (Doc. No. 77-4). On November 19, 2010, the USPTO granted, in part, the third reexamination request.

[2]As plaintiff's response to the motion was due on the date set for the status conference, the court continued the status conference to its February 2011 docket.

[3]Defendants' statement that the third request for reexamination was filed after the stay was lifted is thus incorrect. The court's order lifting the stay was issued on November 1, 2010. Defendants filed the third request for reexamination the day before their response to plaintiff's request to lift the stay was due in this court. Nonetheless, defendants did not inform the court that they had filed the reexamination request until nearly two months later, which was almost a month after the USPTO issued its order granting the request for *ex parte* reexamination. *See* Exhibit 4 to Second Motion to Stay at 4 (Doc. No. 77-4).

Id. at 4. The examiner rejected defendants' assertions that two references[4] presented "any new information or technical teaching . . . that was not present in the prior examination". Id. at 14. The examiner did, however, find that two of the references cited by defendants raised a substantial new question of patentability as to the '213 patent. Id. at 21. A review of the transaction history for the third reexamination request reflects that nothing has been filed in that proceeding since November 19, 2010.[5]

As the court has the power to control its docket, it also has the inherent authority to issue a stay of proceedings pending resolution of related actions. Gould v. Control Laser Corp., 705 F.3d 1340, 1341 (Fed. Cir. 1983). Whether to grant a stay is within the discretion of the court. In exercising that discretion with respect to reexamination proceedings before the USPTO, "courts typically consider: (1) whether a stay will unduly prejudice or present a clear tactical disadvantage to the nonmoving party, (2) whether a stay will simplify the issues in question and trial of the case, and (3) whether discovery is complete and whether a trial has been set."

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[4]These references had been considered in previous examination proceedings and therefore "are considered 'old art' for the determination of whether a new substantial question of patentability exists". Id. at 12.

[5]Patent Application Information Retrieval for Control No. 09/011,289 http://portal.uspto.gov/external/portal/!ut/p/c5/04_SB8K8xLLM9MSSzPy8xBz9CP0os3h3cz9XEzcPIwMLvyALA08jF39LE2cjQwMLU6B8JG55dxNKdBuYEtAdDnItftvxyYPMB8kb4ACOBvp-Hvm5qfqR-lHmCFPcff3dgKa4ebh5BxgZG7gb6UfmpKYnJlfqF-SGRhhkBmQEOioqAgBVda8T/dl3/d3/L0lJSklna21DU1EhIS9JRGpBQU15QUJFUkNKRXFnLzRGR2dzbzBWdnphOUlBOW9JQSEhLzdfRzdORTRGSDIwR01PRjBJMkZIRktQMjMwRzIvWVZNa2U4NTQwMDAxNi9zYS5nZXRCaWI!/.

Soverain Software LLC v. Amazon.com, Inc., 356 F. Supp. 2d 660, 662 (E.D. Tex. 2005).

The court finds the first factor weighs against granting a stay. The first reexamination request resulted in a fourteen-month delay, and notice of the USPTO's decision on that request was further delayed by defendants' filing a second *ex parte* request for reexamination. Moreover, defendants' filing of the third reexamination request and concomitant request for a stay has already resulted in additional delay as the court had to reschedule the status conference set for January 2011. Simplification of the issues to be tried in this action is likely to occur only if the USPTO issues a decision rejecting the patent's claims. Given the recent confirmation of the '213 patent, that outcome is not certain and therefore this factor does not weigh in favor of granting a stay. Finally, defendants' argument that this matter is in its early stages ignores the fact that the case has been pending for two years. This factor, therefore, also weighs in favor of denying defendants' second motion to stay.

The court initially granted a stay in this matter, pursuant to the parties' agreement, to permit the USPTO to conduct the first reexamination. Neither the court nor plaintiff anticipated that defendants would file serial reexamination requests each time they failed to achieve their objectives at the USPTO. At some point, the court cannot continue to defer to that body and to the reexamination proceedings at the expense of this litigation. The court finds that point has now been reached.

Medtronic's Motion to Stay Litigation Pending Reexamination in U.S. Patent and Trademark Office (Doc. No. 77) is therefore DENIED.

It is so ordered this 31st day of January, 2011.

Tim Leonard

TIM LEONARD
United States District Judge