

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

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

ORDER

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.

On June 18, 2009, defendants filed a request for *ex parte* reexamination of the ’213 patent in the United States Patent and Trademark Office (“PTO”); that request was granted on July 14, 2009. Thereafter, the parties agreed to stay this case pending action by the PTO. Order and Stipulation Concerning Discovery and Stay in View of Reexamination (Doc. No. 61). On September 28, 2010, plaintiff gave

notice to the court of the PTO's intent to issue a reexamination certificate confirming the '213 patent and requested that the stay issued in July 2009 be lifted. When defendants did not respond to plaintiff's request to lift the stay, the court issued an order lifting the stay and directing that the matter be set on the court's next available status conference docket. Order at 1 (Doc. No. 75). Before the court could hold the conference, however, defendants filed a second motion to stay the case. That motion was denied on January 31, 2011, and the status conference was conducted on February 8, 2011. During that conference, plaintiff indicated his desire to amend the complaint. The court significantly shortened the time frame within which a motion to amend could be filed, directing that it be filed no later than February 18, 2011. Scheduling Order at ¶ 2 (Doc. No. 88). The court's normal deadline for filing motions to amend would have been September 1, 2011. Id.

This matter is now before the court on plaintiff's motion to amend the complaint to add claims of infringement of United States Patent No. 6,475,195 ("the '195 patent"). Like the '213 patent, the '195 patent covers plaintiff's inventive technique for using the catheter to perform angioplasty. In addition to method claims, the '195 patent also includes apparatus claims. Defendants oppose plaintiff's motion to amend, arguing that plaintiff unduly delayed seeking leave to amend and that they would be prejudiced by the amendment. In addition, defendants assert that the proposed amendment would be futile based on the Terminal Disclaimers plaintiff filed with respect to the '195 patent. Those

Disclaimers provide that the '195 patent "shall be enforceable only for and during such period that it" is commonly owned with the '213 patent and United States Patent No. 5,445,625 ("the '625 patent"). Exhibit 4 to Medtronic's Opposition to Plaintiff's Motion to Amend Complaint and Brief in Support Thereof at 3-4 (Doc. No. 90-4) [hereinafter cited as "Medtronic's Opposition"].

The standard governing motions to amend is clear.

Rule 15(a) provides that leave to amend "shall be freely given when justice so requires." Refusing leave to amend is generally only justified upon a showing of undue delay, undue prejudice to the opposing party, bad faith or dilatory motive, failure to cure deficiencies by amendments previously allowed, or futility of amendment.

Frank v. U.S. West, Inc., 3 F.3d 1357, 1365-66 (10th Cir. 1993) (citations omitted).

"A proposed amendment is futile if the complaint, as amended, would be subject to dismissal." Lind v. Aetna Health, Inc., 466 F.3d 1195, 1199 (10th Cir. 2006) (quotations omitted). A complaint is subject to dismissal if it fails to present a plausible claim for relief. See Bell Atlantic Corp. v. Twombly, 550 U.S. 544, 570 (2007).

Based on these standards, the court grants plaintiff's motion to amend. Defendants' delay arguments are not well-taken, given that much of the delay that has occurred to date is the result of their filing serial reexamination requests before the PTO. Plaintiff filed his motion to amend within the shortened time frame set forth in the court's Scheduling Order. In addition, the court finds defendants have not established prejudice. Discovery is in its infancy, and the parties still have more than

seven months to conduct discovery. Finally, the court concludes that, based on the current state of the record, defendants have not demonstrated that plaintiff's amending the complaint to assert a claim for damages for past infringement of the '195 patent would be futile. The arguments regarding the Terminal Disclaimers have not been sufficiently developed for the court to rule at this juncture that plaintiff cannot present a plausible claim for relief. Should defendants wish to pursue this issue, they can file a properly supported motion to dismiss in response to plaintiff's amended complaint. For the court to make a preemptive ruling based on the limited argument presented to date would not be reasonable, particularly given that leave to amend should be freely given.

Plaintiff's Motion to Amend Complaint (Doc. No. 89) is therefore GRANTED. Plaintiff shall file his amended complaint no later than **April 1, 2011**.

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


TIM LEONARD
United States District Judge