

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Abiomed, Inc., Abiomed R&D, Inc., and Abiomed Europe GmbH
Petitioners

v.

Maquet Cardiovascular, LLC
Patent Owner

Case IPR2017-02151
U.S. Patent No. 9,327,068

PATENT OWNER'S EXHIBIT 2011

UNITED STATES DISTRICT COURT FOR
THE DISTRICT OF MASSACHUSETTS

ABIOMED INC.,)	
)	
Plaintiff and Counter-Defendant,)	
)	
v.)	
)	Civil Action No. 1:16-10914-FDS
MAQUET CARDIOVASCULAR LLC,)	
)	
Defendant and Counter-Claimant,)	
)	
v.)	
)	
ABIOMED R&D, INC. and ABIOMED)	
EUROPE GMBH,)	
)	
Third-Party Defendants.)	

ORDER ON DISCOVERY MOTIONS

[Docket Nos. 78, 82, 86]

October 6, 2017

Boal, M.J.

Abiomed Inc. has moved to compel Maquet Cardiovascular LLC to (1) make Abraham Ronai available for a deposition and (2) produce certain documents in Maquet's possession. Docket No. 78. Maquet has moved for a protective order barring Abiomed from taking Ronai's deposition. Docket No. 82. For the reasons discussed herein, the Court denies both of these motions.

Maquet has also moved to compel Abiomed to produce technical documents and samples relating to accused products, Docket No. 86, which the Court grants in part and denies in part.

I. FACTUAL AND PROCEDURAL BACKGROUND

In this case, Abiomed seeks a declaratory judgment that its line of intracardiac heart pumps sold under the name Impella do not infringe Maquet's patents. Docket No. 1. In turn, Maquet filed a counterclaim against Abiomed and related entities for patent infringement. Docket Nos. 26, 92.

Abiomed maintains that Getinge AB ("Getinge"), Maquet's parent company, and the entity from which Maquet acquired the subject patents, is in control of the instant litigation. See, e.g., Docket No. 79 at 4-7. As a result, Abiomed has sought discovery on the relationship between Getinge and Maquet. Id. at 7-10.

On July 13, 2017, Abiomed filed its motion to compel Maquet to produce Abraham Ronai for a deposition and to provide it with relevant discovery.¹ Docket No. 78. Abiomed maintains that Ronai is "currently Getinge's General Counsel, Americas, and Vice President, Global Intellectual Property at 'Getinge Group.'" Docket No. 79 at 5. Maquet opposes the motion, Docket No. 104, and has moved separately for a protective order precluding Abiomed from taking Ronai's deposition, Docket No. 82, which, in turn, Abiomed opposes. Docket No. 101. The parties have each filed reply briefs. Docket Nos. 122, 126.

On July 18, 2017, Maquet filed a motion to compel Abiomed to produce certain categories of technical documents and samples. Docket No. 86. Abiomed has produced samples

¹ Abiomed also requested leave to amend its pleadings within fourteen days of Ronai's deposition. Docket No. 78. At oral argument, however, Abiomed agreed that because it has already filed a motion to amend, see Docket No. 95, that request is now moot.

for inspection² but otherwise opposes this motion. Docket No. 115. The parties have each filed reply briefs. Docket Nos. 131, 136.

On August 24, 2017, the Court heard oral argument on the discovery motions. Docket Nos. 78, 82, 86. At the Court's request, Docket No. 145, the parties filed, on September 7, 2017, supplemental briefing in connection with the technical documents motion. Docket Nos. 149-52.

II. DISCUSSION

A. Standard of Review

“Discovery procedures set forth in the Federal Rules of Civil Procedure seek to further the interests of justice by minimizing surprise at trial and ensuring wide-ranging discovery of information.” Cartel Asset Mgmt. v. Ocwen Fin. Corp., No. 01-cv-01644-REB-CBS, 2010 WL 502721, at *9 (D. Colo. Feb. 8, 2010) (citing United States ex rel. Schwartz v. TRW, Inc., 211 F.R.D. 388, 392 (C.D. Cal. 2002)). To that end, Rule 26(b) permits “discovery regarding any nonprivileged matter that is relevant to any party’s claim or defense and proportional to the needs of the case”. Fed. R. Civ. P. 26(b)(1). Factors that must be considered in weighing proportionality include “the importance of the issues at stake in the action, the amount in controversy, the parties’ relative access to relevant information, the parties’ resources, the importance of the discovery in resolving the issues, and whether the burden or expense of the proposed discovery outweighs its likely benefit.” Id. Information within the scope of discovery need not be admissible in evidence to be discoverable. Id.

Courts may also issue protective orders when appropriate. Specifically, Rule 26(c)(1) provides that “[a] party or any person from whom discovery is sought may move for a protective

² At oral argument, the parties represented that Abiomed had satisfied Maquet’s request for the production of samples (i.e., the subject of RFP 1). The Court therefore denies that portion of Maquet’s motion to compel as moot.

order in the court where the action is pending. . . . The court may, for good cause, issue an order to protect a party or person from annoyance, embarrassment, oppression, or undue burden or expense. . . .” Fed. R. Civ. P. 26(c)(1). Rule 26 “confers broad discretion on the trial court to decide when a protective order is appropriate and what degree of protection is required.” Seattle Times Co v. Rhinehart, 467 U.S. 20, 36 (1984).

B. Ronai Deposition: Motion to Compel And Protective Order

In support of its motion to compel the Ronai deposition, Docket No. 78, Abiomed argues that Getinge, Ronai’s employer, exercises “substantial rights” in the patents-in-suit, Docket No. 101, and Ronai possesses relevant business knowledge about Getinge. Docket No. 126. Abiomed alleges that Ronai has global responsibility for managing Getinge’s intellectual property portfolio, and direct involvement in certain patent licensing efforts. Docket Nos. 101 at 5; 126 at 6. Therefore, Abiomed claims that Ronai has knowledge of facts relevant to patent valuation, commercialization, validity and enforceability of the patents-in-suit.

Maquet asserts that it alone has “substantial rights” in all of the patents-in-suit, Docket No. 104 at 6-11, as a result of the 2008 transfer of rights from Guidant Corporation to Maquet of the ’100 patent. Maquet further asserts that each of the patents-in-suit relate back to the ’100 patent and that there are no agreements that transfer substantial rights to the patents-in-suit to Getinge AB or any other Getinge entity. Id. at 3-4. Therefore, given Getinge’s lack of any rights in those patents, Maquet argues that Abiomed has no basis upon which to depose Ronai. Id. In addition, Maquet avers that as a general counsel, Ronai’s otherwise responsive knowledge will be subject to claims of attorney-client privilege and work product doctrine. Id. at 11-13. Maquet has also offered Abiomed an alternative witness, namely, Gary Sufat, a non-attorney. Id. at 13. Sufat is the CFO of Getinge Group- Acute Care Therapies. Id.

Any time a deposition notice names an opposing party's counsel, current or former, as the deponent, red flags go up. Although the Federal Rules of Civil Procedure do not specifically prohibit the deposition of a party's counsel, depositions of opposing counsel are generally disfavored. See, e.g., Bogosian v. Woloohojian Realty Corp., 323 F.3d 55, 66 (1st Cir. 2003). Federal courts have noted a number of concerns that depositions of an opposing party's counsel pose. First, "[a]llowing depositions of opposing counsel, even if those depositions were limited to relevant and non-privileged information, may disrupt the effective operation of the adversarial system by chilling the free and truthful exchange of information between attorneys and their clients." Sterne Kessler Goldstein & Fox, PLLC v. Eastman Kodak Co., 276 F.R.D. 376, 380-81 (D.D.C. 2011) (citations omitted; collecting cases). In addition, "depositions of opposing counsel present a 'unique opportunity for harassment.'" Id. at 381. Another concern is that "counsel depositions carry the substantial potential of spawning litigation over collateral issues related to assertion of privilege, scope, and relevancy." Id. at 382.

In deciding whether a deposition of opposing counsel, including in-house counsel, is appropriate, courts often use the test adopted by the Eighth Circuit in Shelton v. American Motors Corp., 805 F.2d 1323 (8th Cir. 1986).³ See Dunkin' Donuts, Inc. v. Mandorico, Inc., 181 F.R.D. 208, 210 (D.P.R. 1998). Under that test, depositions of opposing counsel should be limited to where the party seeking to take the deposition has shown that (1) no other means exist to obtain the information other than to depose opposing counsel; (2) the information sought is

³ The First Circuit has not explicitly adopted the Shelton test. However, it has used a similar test in deciding whether opposing counsel may be compelled to testify at trial. See Bogosian, 323 F.3d at 66. Under that test, the factors to be considered include: "whether (i) the subpoena was issued primarily for purposes of harassment, (ii) there are other viable means to obtain the same evidence, and (iii) to what extent the information sought is relevant, non-privileged, and crucial to the moving party's case." Id. (citations omitted).

relevant and nonprivileged; and (3) the information is crucial to the preparation of the case.

Shelton, 805 F.2d at 1327 (citation omitted). The crucial factor in determining whether the Shelton test applies is the extent of the lawyer's involvement in the pending litigation. Nat'l W. Life Ins. Co. v. W. Nat'l Life Ins. Co., No. A-09-CA-711-LY, 2010 WL 5174366, at *3 (W.D. Tex. Dec. 13, 2010); see also Desert Orchid Partners, L.L.C. v. Transaction Sys. Architects, Inc., 237 F.R.D. 215, 220 (D. Neb. 2006).

"Defining the scope of . . . privilege for in-house counsel is complicated by the fact that these attorneys frequently have multi-faceted duties that go beyond traditional tasks performed by lawyers." U.S. Postal Serv. v. Phelps Dodge Refining Corp., 852 F. Supp. 156, 160 (E.D.N.Y. 1994); see City of Springfield v. Rexnord Corp., 196 F.R.D. 7, 9 (D. Mass. 2000). The attorney-client privilege does not apply when in-house counsel is engaged in "nonlegal work" such as "the rendering of business or technical advice unrelated to any legal issues." United States v. Windsor Capital Corp., 524 F. Supp. 2d 74, 81 (D. Mass. 2007) (citation omitted).

Here, Abiomed has not argued that Ronai is the only individual involved in these efforts. Maquet has already proposed at least one alternative non-lawyer witness, Docket No. 104 at 13, and represented at oral argument that it may be able to identify others. Accordingly, Abiomed has not met its burden and the Court denies Abiomed's motion to compel Maquet to produce Abraham Ronai for a deposition without prejudice.

For these reasons, "good cause" also exists to justify entry of a protective order prohibiting Ronai's deposition. Because the Court denies Abiomed's motion to compel Ronai's deposition, however, such relief is unnecessary at this time. The Court therefore denies Maquet's motion for a protective order without prejudice.

C. Getinge Document Requests

Abiomed has also moved to compel Maquet to produce documents related to Getinge in response to nine separate requests for production.⁴ Docket No. 78. Maquet maintains that it has agreed to produce documents responsive to all of these requests except RFP 49.⁵ Docket No. 104 at 15.

Days before the August 24, 2017 oral argument, Maquet produced 500,000 pages of documents. Abiomed represented that it had not had the opportunity to review the production and determine whether Maquet had in fact provided it with documents responsive to the RFPs at issue.⁶ Accordingly, the Court denies Abiomed's motion to compel Maquet to respond to RFPs 3, 5, 6, 9, 37, 45, 50 and 56 without prejudice.

⁴ Abiomed seeks documents responsive to requests for production ("RFPs") 3, 5, 6, 9, 37, 45, 49, 50 and 56.

⁵ The Court notes that in their respective responses to each other's document requests, both Abiomed and Maquet relied, in part, on outdated language and boilerplate objections. See, e.g., Docket Nos. 81-7 at 8 ("Maquet objects to this Request to the extent it is overly broad, unduly burdensome, and seeks documents that are neither relevant to the subject matter of the pending action nor reasonably calculated to lead to the discovery of admissible evidence."); 88-2 at 9 ("Abiomed objects to this Request as . . . not reasonably calculated to lead to the discovery of admissible evidence. . ."). In particular, Rules 26 and 34 of the Federal Rules of Civil Procedure were amended in December 2015 with the intention of eliminating such objections without further explanation and changing the standard for discoverability. See Fischer v. Forrest, 14 Civ. 1304 (PAE) (AJP), 2017 WL 773694, at *1-3 (S.D.N.Y. Feb. 28, 2017). Accordingly, all counsel should update their discovery "form" files to remove outdated language.

⁶ Maquet objects to producing documents responsive to RFP 49 because that request seeks information regarding the "legal relationship" between Ronai and each of Maquet and Getinge Group, and therefore may implicate the attorney-client privilege or work product doctrine. Docket No. 104 at 18-19. The Court finds that as written the Request does not seek relevant information. In any event, Maquet stated at oral argument that it is producing corporate organizational charts which may satisfy RFP 49. Thus, the Court denies Abiomed's motion to compel Maquet's response to RFP 49 with prejudice.

D. Technical Documents

Maquet has moved to compel Abiomed to produce technical documents responsive to two of its requests, namely, RFPs 9 and 10. Docket No. 86. RFP 9 seeks:

[a]ll documents and things related to the structure, function, design, development, and/or operation of any or all of the Accused Products and each feature in the Accused Products, including, but not limited to, drawings, schematics, and operating instructions.

Docket No. 88-1 at 5. RFP 10 seeks:

[a]ll documents and things regarding the design, development and testing of any Accused Product, including but not limited to schematics, engineering drawings, configuration guides, structure specifications, product specifications, performance specifications, block diagrams, teardown specifications, teardown reports, service manuals, testing instructions, testing results, testing studies, testing reports, benchmarking tests, laboratory notebooks, laboratory notes, focus group reports, and memoranda.

Id. The “Accused Products” are defined as “Abiomed’s Impella products, including, but not limited to, Abiomed’s Impella 2.5, Impella 5.0, Impella CP, and Impella RP products, and any other Impella product defined in this case as an infringing product.” Docket No. 88-1 at 3.

The parties’ disputes center around three core areas: (1) whether the requests should apply to Accused Products or Accused Features; (2) the types of documents requested; and (3) the appropriate time frame for the requested materials.

1. Accused Products vs. Accused Features

Abiomed argues that it should only have to produce responsive documents for Accused Features, as opposed to Accused Products defined by Maquet. Abiomed defines Accused Features as “only those features of products that are accused in this litigation for allegedly infringing the Patents-in-Suit.” Docket No. 88-2 at 4. More specifically, Abiomed has identified as falling within its Accused Features definition twelve specific features of the

Accused Products. Docket Nos. 87 at 2-3; 149 at 2. The parties have unsuccessfully attempted to agree on the scope of the discovery to be produced using the Accused Features limitation.

Abiomed opposes the use of the Accused Products definition to determine the scope of the responsive materials. It claims such requests seek essentially all technical documents for four of the five products that it develops, and therefore impose an immense burden. Docket No. 149 at 4.

Maquet argues that Abiomed's production of technical documents using the Accused Features definition thus far has been insufficient. Docket No. 149 at 2. It claims that the list of twelve features is impermissibly narrow given that the lawsuit concerns whether the design and use of the Accused Products – in their entirety – infringe patents-in-suit. Docket No. 149 at 2.

This Court finds that the Accused Products term is more appropriate for the issues here. However, the Court will limit the definition to only the four specific products at issue in this case -- Abiomed's Impella 2.5, Impella 5.0, Impella CP, and Impella RP.

2. Types Of Documents

RFPs 9 and 10 request "all documents and things" related to or regarding particular topics. "Courts may find requests overly broad when they are couched in such broad language as to make arduous the task of deciding which of numerous documents may conceivably fall within their scope." W. Res., Inc. v. Union Pac. R.R., Co., No. 00-2043-CM, 2002 WL 1822430, at *2 (D. Kan. July 23, 2002) (citation omitted). Indeed, discovery requests seeking information "related to" a particular topic are overly broad because they do not provide a basis upon which an individual or entity can reasonably determine what information may or may not be responsive. See id.; Twigg v. Pilgrim's Pride Corp., No. 3:05-CV-40, 2007 WL 676208, at *9 (N.D. W. Va. Mar. 1, 2007). Nevertheless, at the discovery stage, relevancy must be construed

“such that information is discoverable if there is any possibility it might be relevant to the subject matter of the action.” Broomkam v. Time Warner Cable, Inc., No. 3:16-cv-11395-MGM, 2017 WL 2836993, at *3 (D. Mass. June 30, 2017) (citation omitted).

Accordingly, the Court finds the request for “all documents and things” to be too broad as it would, for example, potentially encompass all emails referring to any of the four specific products. However, the list of specific examples of types of documents contained in RFP 9 and 10 is appropriate and Abiomed should produce those documents pertaining to the four specific products.

3. Date Limitations

Abiomed objects to the relevance of documents dated before September 22, 2010, on the basis that Maquet is barred under 35 U.S.C. § 286 from recovering damages for any alleged infringement that occurred six years prior to the filing of Maquet’s counterclaims.⁷ Docket 149 at 4. Maquet argues that it is entitled to technical documents predating September 22, 2010, not for the purpose of damages discovery, but because such discovery goes to the merits of the case. In particular, Maquet seeks discovery on Abiomed’s design and development of the Accused Products. Docket No. 149 at 3. Maquet has the better argument. Abiomed first received FDA 510(k) clearance for its Impella 2.5 pump in June 2008. Docket No. 1 at ¶ 8. It claims that “prior art, including prior art developed and patented by Abiomed’s predecessors-in-interest, renders each asserted claim of the patents-in-suit invalid under 35 U.S.C. §§ 102 or 103.” Id. at ¶ 15. Accordingly, this Court finds that the requested technical documents generated prior to September 22, 2010 are relevant and should be produced.

⁷ Nevertheless, Abiomed produced materials that predated September 22, 2010 to the extent those materials implicated features in products sold after that date. Docket No. 149 at 4.

III. ORDER

For the foregoing reasons, the Court denies Abiomed's motion to compel Ronai's deposition without prejudice. The Court also denies Abiomed's motion to compel Maquet to respond to RFPs 3, 5, 6, 9, 37, 45, 50 and 56 without prejudice; and RFP 49 with prejudice. The Court further denies Maquet's motion for a protective order without prejudice. Finally, the Court grants in part and denies in part Maquet's motion to compel the production of technical documents.

Responses in accordance with this order must be provided within four weeks.

/s/ Jennifer C. Boal
JENNIFER C. BOAL
United States Magistrate Judge