IN THE UNITED STATES DISTRICT COURT
FOR THE EASTERN DISTRICT OF TEXAS
BEAUMONT DIVISION

MARK A. BARRY, M.D., Plaintiff, v. MEDTRONIC, INC., Defendant.	Civil Action No. 1:14-cv-104 **JUDGE RON CLARK**

PLAINTIFF MARK A. BARRY, M.D.'S,
MEMORANDUM OF POINTS AND AUTHORITIES
REGARDING MEDTRONIC'S FAILURE TO PROVE INEQUITABLE CONDUCT

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Plaintiff Mark A. Barry, M.D. ("Dr. Barry") provides this memorandum in opposition to Medtronic, Inc.'s ("Medtronic") inequitable conduct defense and counterclaim. Medtronic did not come forward with evidence to establish that Dr. Barry or his former patent prosecution counsel, David Henry, withheld information from the U.S. Patent and Trademark Office ("PTO") that they knew to be material to the patentability of U.S. Patent No. 7,670,358 ("the '358 patent").[1] Further, Medtronic failed to prove that either Dr. Barry or Mr. Henry acted with deceptive intent in their dealings with the PTO. Accordingly, Medtronic has failed to establish inequitable conduct as a matter of law.

I. Legal Standard.

"Because inequitable conduct renders an entire patent . . . unenforceable, as a general rule, the doctrine should only be applied in instances where the patentee's misconduct resulted in the unfair benefit of receiving an unwarranted claim." *Therasense, Inc. v. Beckton Dickinson & Co.*, 649 F.3d 1276, 1292 (Fed. Cir. 2011). "To prove inequitable conduct, the challenger must show by ***clear and convincing evidence*** that the patent applicant (1) misrepresented or omitted information material to patentability, and (2) did so with specific intent to mislead or deceive the PTO." *In re Rosuvastatin Calcium Patent Litig.*, 703 F.3d 511, 519 (Fed. Cir. 2012) (emphasis added). "[T]he materiality required to establish inequitable conduct is but-for materiality." *Therasense*, 649 F.3d at 1291. A prior art reference "is but-for material if the PTO would not have allowed a claim had it been aware of the undisclosed prior art." *Id.* In making the decision of whether the PTO would have allowed the claim, courts use the preponderance of the evidence standard used by that agency in prosecuting the application. *Id.* at 1291-92.

[1] During the bench trial, Medtronic focused its inequitable-conduct argument on the '358 patent but should it argue its theories apply to U.S. Patent No. 8,361,121 ("the '121 patent"), for the same reasons, Medtronic cannot carry its burden of proof.

"Intent to deceive may be found only if specific intent to deceive is 'the single most reasonable inference able to be drawn from the evidence.'" *Transweb, LLC v. 3M Innovative Props. Co.*, 812 F.3d 1295, 1304 (Fed. Cir. 2016) (quoting *Therasense*, 649 F.3d at 1290). In sum, Medtronic must show by clear and convincing evidence that Dr. Barry "knew of the reference, knew that it was material, ***and made a deliberate decision to withhold it***." *Therasense*, 649 F.3d at 1290 (emphasis added).

II. Medtronic Failed to Prove Its Theories of Inequitable Conduct.

In its 51-page proposed Findings of Fact and Conclusions of Law (ECF No. 353-1), Medtronic raised many theories in support of its inequitable conduct defense. During the November 7, 2016 bench trial, however, Medtronic did not elucidate testimony regarding many of those positions, and therefore cannot prove them. In particular, Medtronic abandoned its argument that Dr. Barry did not inform the PTO about Dr. Lenke's work with derotators. TT 2243:18-2244:11. Each of Medtronic's theories of inequitable conduct are addressed below.

A. No Evidence of Specific Intent Destroys Medtronic's Claims.

Medtronic must show, as the single most reasonable inference from the evidence of record, that Dr. Barry and his counsel "acted with the specific intent to deceive the PTO." *Therasense*, 649 F.3d at 1290-91. When, as in *Therasense*, "there are multiple reasonable inferences that may be drawn, intent to deceive cannot be found." *Id*.

For each of Medtronic's theories, there is no evidence of a specific intent to deceive the Patent Office. "A finding that the misrepresentation or an omission amounts to gross negligence or negligence under a 'should have known' standard does not satisfy this intent requirement." *Id*. at 1290. Here, Medtronic cannot satisfy its clear and convincing burden to show specific intent. For many of its theories, Medtronic cannot show that Dr. Barry or his counsel was aware that what Medtronic ***alleges*** is prior art, either existed or was prior art. For other theories, there

is no evidence that a mistake was anything other than a mistake or difference in opinion. In sum, as demonstrated by the record as a whole, Medtronic cannot show any acts for which the sole inference is that Dr. Barry or his counsel intended to defraud the PTO.

B. Medtronic's Allegations Based on Pre-2004 Surgeries and IMAST Abstract.

Medtronic's primary inequitable conduct theory repackages its failed invalidity argument regarding Dr. Barry's pre-2004 surgeries. Medtronic, however, did not prove that any of the surgeries were "public" or that they were not experimental in nature—in other words, Medtronic did not prove that they were prior art that could form the basis of a §102(b) rejection.[2] Far from being "public," the testimony at trial established the confidential nature of Dr. Barry's investigational surgeries. *See, e.g.*, TT 303:21-304:24; TT 738:2-10; TT 1901:11-1902:8.

Medtronic's arguments otherwise rely on misrepresentations of the evidence. In its Findings of Fact, Medtronic alleged that Dr. Barry's former surgical team "testified that they knew of no obligation to keep confidential the surgery methods or systems other than HIPAA." ECF No. 353-1, ¶92. Although HIPAA formed part of the witnesses' testimony, it was not the only source of a confidentiality obligation. For example, Dr. Davidson, the anesthesiologist, testified that there were discussions to keep confidential Dr. Barry's developmental work:

> Q. But you don't recall any specific discussions with Dr. Barry where he said, "Don't tell anyone about what I'm working on"?
> A. I don't recall the wording of a specific discussion, but I would -- ***I know that there was a discussion to not discuss what he was doing***.

TT 735:5-10 (emphasis added); *see also* TT 238:2-4 (Ms. Janice Munro, the circulating nurse, testifying about her confidentiality agreement with the hospital). Like Ms. Munro, surgical representatives such as Mr. Pfefferkorn sign confidentiality agreements with the hospitals where

[2] Dr. Barry notes that the "information that Medtronic alleges [he] withheld from the PTO during prosecution of the '358 patent was submitted in the now pending '589 continuation application." ECF No. 355, ¶¶32-33. The PTO allowed the claims as U.S. Patent No. 9,339,301. *Id.*

they work. Ms. Sexton, Medtronic's corporate representative, admitted that "the sales reps, generally speaking, have to sign ***confidentiality agreements with the hospitals*** … ***There is a signed confidentiality with the hospitals covering that***." TT 1388:23-1389:4 (emphasis added). Moreover, as this Court noted, the case law does not require "the confidentiality obligation [] to be imposed by the plaintiff. It just says it was imposed." TT 238:2-4.

Not only were Dr. Barry's pre-2004 surgeries not "public," they were "experimental" under the patent law. Three of the surgeries practiced the claims of the '358 patent (August 4 and 5, and October 14, 2003). TT 425:12-22. Dr. Barry explained that he viewed these late-2003 surgeries as experimental. TT 1860:3-10. When asked, "sitting here today, is it still your contention that you performed experimental surgeries on child patients in the 2003," Dr. Barry responded, "[w]ith regards to the patent law definition, the surgeries were experimental." *Id.* Dr. Barry confirmed the need for follow-up examinations, and only in January 2004 was he able to confirm he had a technique that worked for its intended purpose. TT 196:19-25; *see also* TT 1899:16-1901:2 (Dr. Yassir explaining convention for follow-ups).

Medtronic tried to confuse the issue by asking the surgical-team witnesses whether they viewed the surgeries as "experimental," without drawing a distinction between medical experimentation and the negation of public use. In its Findings of Fact, Medtronic repeated its confused "experimentation" argument without support that "[a]ny surgery that was experimental or conducted to determine whether the technique or tool systems worked for their intended purpose would have required Institutional Review Board (IRB) approval from Sunrise Hospital[.]" ECF No. 353-1, ¶106. Medtronic persisted in this tact despite repeated rulings by the Court confirming medical experimentation is irrelevant to the issues in this case. ECF No.

200, Mot. to Exclude McGuire; ECF No. 292, Order Granting Mot. to Exclude; TT 1058:7-12. Because the surgeries were confidential and experimental uses, they cannot be material prior art.

Finally, on the issue of specific intent, Medtronic did not establish that either Mr. Henry or Dr. Barry knew that the surgeries might be material prior art, and therefore cannot establish they "knowingly" withheld that information. Mr. Henry was not aware of the IMAST Abstract, the IMAST presentation, or that Dr. Barry had performed any surgeries prior to the critical date that may have fallen within the scope of the claims presented during prosecution of the '358 patent. TT 2230:16-21; 2199:12-15; 2197:15-21. He therefore did not knowingly withhold this information from the PTO.

There is likewise no evidence that Dr. Barry knew that his pre-2004 surgeries could have qualified as prior art, or that there was any reason to consider disclosing them to the PTO. He explained, for example: "Q. Yes, sir. So, you did not disclose anything to the Patent Office about any of your surgeries that took place before December, 2003. A. Like I said, ***I don't recall getting any instruction from my patent attorney to do so***. Now -- so, I guess none were disclosed." TT 2262:18-23 (emphasis added).

Dr. Barry's and Mr. Henry's testimony confirmed that neither knowingly withheld material information with respect to the pre-2004 surgeries. In fact, Dr. Barry viewed his "invention" that he described to Mr. Henry as the system that ultimately included the cross-linking member. Dr. Barry did not complete that system, and the method of using it, until late 2004. Specifically, Dr. Barry testified:

> Q. All right. What did Mr. Henry tell you you needed to disclose?
> A. Well, we had some discussions in early December of 2004. ***I recall things such as him asking me when I felt I had a invention***. ***I told him, you know, when I finally added the cross-connector end of November of 2004***. And I told him I presented it at a meeting in early December of 2004 and I recall discussions

> about potentially going after an international patent and he said, "Well, you already presented it; so, that's off the books."

TT 2238:9-18 (emphasis added). Accordingly, in 2004 and throughout prosecution of the '358 and '121 patent applications, Dr. Barry did not appreciate any potential relevance of his pre-2004 surgeries and thus did not "knowingly" withhold information from the PTO.

Mr. Henry testified consistently that, in his opinion and based on conversations with Dr. Barry, Dr. Barry had completed his invention in 2004—well within the one-year grace period, thereby rendering unnecessary any investigation into Dr. Barry's 2003 activities. TT 2197:15-2198:14; 2207:1-15. As this Court noted, a "layperson like Dr. Barry, you said 'when did you make your invention,' it's a whole lot different than asking a patent lawyer that same question." *Id.*, 2217:10-13. Mr. Henry made clear his discussions with Dr. Barry did not use the terms "conception" and "reduction to practice"; rather, "'When was this invented' was the language of the conversation long ago, which the only reason [Mr. Henry] even remember[ed] that … is having to deliver the bad news about the loss of foreign protection." *Id.*, 2194:13-17.[3]

The evidence supports numerous reasonable explanations for the alleged non-disclosure—including that Mr. Henry did not know about the surgeries, Dr. Barry did not know and was not informed of their potential significance, and they were confidential and experimental. *Supra*. Medtronic's non-disclosure arguments cannot support a finding that Dr. Barry or Mr. Henry engaged in misconduct. Although an exception to the but-for requirement exists "[w]hen the patentee has engaged in affirmative acts of egregious misconduct," "neither mere nondisclosure of prior art references to the PTO nor failure to mention prior art references

[3] Medtronic implies that the disclosure that led to the foreign-protection discussion must have been the IMAST presentation. ECF No. 353-1, ¶88 n.81. It was not. Mr. Henry did not know about the IMAST materials until this lawsuit was underway. TT 2199:12-15; 2197:15-21. Instead, Dr. Barry's December 2004 IPOS presentation led to this discussion. TT 2238:9-18.

in an affidavit constitutes affirmative egregious misconduct." *Therasense*, 649 F.3d at 1292-93. Medtronic has presented no evidence of Dr. Barry's or Mr. Henry's great lengths to deceive the PTO by hiding references that they believed would affect issuance. *Id.*

C. Medtronic's Allegations Based on Pre-2004 "Commercial Activities."

Medtronic also alleges that Dr. Barry failed to disclose to the PTO activities Medtronic couches as pre-critical date commercially motivated activities. Medtronic argued that Dr. Barry's pre-2004 surgeries and interactions with DePuy, Spinevision, and Biomet/Interpore were invalidating, commercial activities. ECF No. 353-1, ¶¶95, 113. Medtronic, however, failed to prove that these activities amounted to invalidating acts under §102(b), much less that Dr. Barry or Mr. Henry knowingly withheld any such allegedly material information from the PTO.

Payment, if there was any, associated with the 2003 surgeries does not render the surgeries material prior art. Dr. Barry was paid for surgeries in 2003; nothing during trial indicated he was paid to practice his inventive technique to correct scoliosis. The evidence established only that Dr. Barry received payment for "doing surgeries." TT 430:11-12. Consistent with the trial testimony, Medtronic stressed that Dr. Barry "testified he was compensated for performing the surgeries at his standard rate." ECF No. 353-1, ¶115. That Dr. Barry received his standard payment for performing surgeries does not convert them into invalidating sales. *McGuire v. Acufex Microsurgical, Inc.*, 868 F. Supp. 388, 396 (D. Mass. 1994) (finding it "undisputed that the patient paid McGuire his normal surgical fee for the operation. Payment alone, however, does not make a *per se* case of a section 102(b) bar.").

Both in its Findings of Fact and at trial, Medtronic misrepresented the PTO's guidance regarding the intersection of the on-sale bar, experimental use, and medically based inventions. Citing MPEP §2133.03(e)(2)-(e)(5), Medtronic claimed that "before a sale can be excused for

alleged experimental use under PTO procedure, patients receiving a purchased invention must at a minimum be aware of the intent to experiment." ECF No. 353-1, ¶120. When questioning Mr. Henry, Medtronic attempted to force him into adopting an incorrect statement of the law, asking whether, "if events take place before the critical date and the customer is a medical patient, do you understand that the customer must, at a minimum, be made aware of the experimentation based on these [MPEP] sections?" TT 2231:23-2232:2. The Court pointed out Medtronic's incorrect statement of the law:

> THE COURT: And to think that -- I mean, I suppose it's possible, if you got that admission out of him, that would then be a binding statement of the law that maybe a higher court would take ***over what I would be quoting as the actual statement of the regulation***; but I doubt it.

Id., 2232:17-22 (emphasis added). There is no requirement in the MPEP tying the experimental-use exception to knowledge by medical patients of the experimentation. Medtronic, presumably, was attempting to stretch MPEP §2133.03(e)(2) too far. That section contains the following quote from *LaBounty Mfg., Inc. v. United States Int'l Trade Comm'n*, 958 F.2d 1066, 1072 (Fed. Cir. 1992) (emphasis added): "When sales are made in an ordinary commercial environment and ***the goods*** are placed outside the inventor's control … Under such circumstances, the customer at a minimum must be made aware of the experimentation." It also cites *Paragon Podiatry Lab., Inc. v. KLM Labs., Inc.*, 984 F.2d 1182 (Fed. Cir. 1993), for the same proposition.

Neither case applies here nor do they stand for the broad holding that Medtronic asked this Court to believe. First, unlike in *LaBounty* and *Paragon*, Dr. Barry did not "sell" to his patients goods embodying his invention that they could view and share with others. Rather, he performed a confidential procedure on their backs where, as this Court explained, "[t]hey're not going to know what's going on in their back even if they are awake." TT 1059:6-7; *see also* TT 1058:7-1059:9. Second, courts have found that *Paragon* (which relied on *LaBounty*) does not

mandate that patentees inform customers of the experimental nature of a sale. In *McGuire*, for example, the court acknowledged that it was:

> undisputed that [patentee] McGuire failed to obtain a waiver or release from the patient indicating the experimental nature of the operation. *See Paragon* … ("assertion of experimental sales, at a minimum, requires that customers must be made aware of the experimentation"). The orthotic devices at issue in *Paragon*, however, were sold from Paragon to ordering doctors without any assurance of confidentiality or retention of control. Here, McGuire's assistants are bound to confidentiality through the patient-physician relationship … Therefore, despite the absence of a confidentiality agreement or the awareness by the patient of the experimental nature of the operation which this court considers in its determination, McGuire did not place his invention outside his control.

McGuire v. Acufex Microsurgical, Inc., 868 F. Supp. 388, 397 (D. Mass. 1994) (denying summary judgment of invalidity under §102(b)). And in *TP Labs., Inc. v. Prof'l Positioners, Inc.*, 724 F.2d 965 (Fed. Cir. 1984), the Federal Circuit reversed a district court's invalidity determination that had been based on pre-critical date use of inventive dental appliances, holding the use to be experimental. Although the "patients were not aware of the 'testing'" using the dental appliance, *id.* at 969, the Federal Circuit held that "[n]othing in the inventor's use of the device on his patients (or the transfer to them) is inconsistent with experimentation." *Id.* at 972. Likewise, here, nothing in Dr. Barry's interactions with his patients was inconsistent with experimentation. Dr. Barry's pre-2004 surgeries did not invoke the on-sale bar. They are therefore not prior art, cannot be material prior art, and, thus, Dr. Barry and Mr. Henry (who did not know about them in any event) did not knowingly withhold material prior art from the PTO.

Nor do Dr. Barry's interactions with the medical device companies raise any §102(b) issues. Medtronic did not present any evidence that Dr. Barry offered to perform his inventive method for these companies. Instead, Medtronic tried to get Dr. Barry to admit that he met with the companies to offer his "invention" for sale. Regarding the July 17, 2003 DePuy meeting, for example, which took place before Dr. Barry had functioning, linkable instruments, Medtronic

asked Dr. Barry, "You went to offer for sale to DePuy in July, 2013 [sic], your invention in the '358 patent, true?" TT 437:7-8.[4] Dr. Barry unequivocally said no, that was not the purpose of the meeting, "I was -- I don't think I was ready to sell it. Like I said, it was a preliminary meeting to talk about my system that was in evolution and to see if they would get behind it; and ultimately, yes, if they got behind it, then potentially market it and sell it." *Id.*, 437:9-13.

Dr. Barry's interactions with the medical device companies, as well as Gilbert's machine shop, in 2003 were a necessary part of his development work. This was confirmed by Medtronic's own engineers who acknowledged that even Medtronic still has to work with other companies to have things made when in development. TT 1557:2-5. The law is clear that granting rights in an invention differs from selling an embodiment of the invention. *See, e.g.*, *Moleculon Research Corp. v. CBS, Inc.*, 793 F.2d 1261, 1267 (Fed. Cir. 1986).

Medtronic has failed to come forward with any evidence that Dr. Barry's activities were material prior art, or that he (or Mr. Henry) knowingly withheld such information. There is also simply no indication that this alleged non-disclosure was done with deceptive intent.

D. Medtronic's Allegations Based on Figure 6.

The '358 patent mistakenly refers to Figure 6 as showing the results of a surgery using Dr. Barry's inventive method. Medtronic alleged that "the PTO was entitled to rely on those (admittedly false) statements as objective indicia of non-obviousness in allowing the patents in suit to issue. At least to that extent, the false statements would be but-for material under PTO procedure." ECF No. 353-1, ¶81. Medtronic also leapt to the conclusion that the issue

[4] Until trial, Medtronic couched its medical-device company argument in terms of commercially motivated "disclosures." To the extent that Medtronic contends that "disclosure" differs from use or sale, mere public knowledge of an invention does not raise a statutory bar. *See, e.g.*, *TP Labs.*, 724 F.2d at 970.

surrounding Figure 6 "constituted gross and egregious misconduct" and that the "false statements were not corrected during prosecution of the applications leading to the patents in suit." *Id.*, ¶82.

Despite Medtronic's allegations, it failed to establish the mistaken description of Figure 6 was material to patentability. Throughout the trial, Medtronic ignored facts that weighed against its argument. For instance, it avoided the fact that the PTO, when apprised of the same error in applications stemming from the '358 patent application, allowed Dr. Barry to correct the description in the related '121 patent and the '589 continuation application. PX010; PX011; PX651; ECF No. 353-1, ¶145 n.133; TT 2270:22-24. While Medtronic stressed the PTAB denied Dr. Barry's request to correct the Figure 6 description in the '358 patent, Medtronic's counsel acknowledged that the PTAB did not require Dr. Barry to seek reissue of his patent. TT 2172:5-6 ("MS. LOVETT: They are not requiring the reissue, your Honor.").

Medtronic also failed to show that the Figure 6 issue was part of a scheme to defraud the PTO or done with deceptive intent. While Medtronic carelessly accused Dr. Barry and Mr. Henry of "gross and egregious misconduct," it simply ignored the fact that Dr. Barry and his then-counsel only learned about the mistake ***during this litigation***. *See, e.g.*, TT 2198:2-4; *id.*, 2183:4-8; *see also* TT 2189:2-13. Accordingly, during prosecution, Dr. Barry and Mr. Henry could not have intended to deceive or have engaged in gross misconduct regarding the incorrect description of Figure 6, as they were unaware of the error.

E. Medtronic's Allegations Based on Dr. Lenke's Alleged Prior Invention.

Medtronic's final non-disclosure theory focused on its belief that Dr. Lenke invented first. It alleges that "Dr. Lenke's prior work was but-for material and needed to be disclosed under PTO procedure." ECF No. 353-1, ¶127. Medtronic failed to come forward with evidence to support this argument. First, there is no proof that, prior to the '358 patent's filing date, Dr.

Lenke used a system that fell within the scope of the claims. Moreover, there is also no evidence that Dr. Barry knew whether or not Dr. Lenke was even using linked derotators before 2004:

> [Ms. Lovett] This is our C4, "Failure to disclose prior invention by Lenke."
> THE COURT: I'm sorry. What prior invention by Lenke did he fail to disclose?
> MS. LOVETT: Your Honor, the preponderance of the evidence before the court -- or the evidence before the court was conclusive that Dr. Lenke conceived of the claimed subject matter in 2002 before Dr. Barry did.
> THE COURT: And how was Barry supposed to know that? …
> THE COURT: How was Dr. Barry -- I don't remember any evidence that Dr. Barry knew about that. He wasn't at the cadaver lab.
> MS. LOVETT: Your Honor, that's true. But Dr. Barry did testify that he was aware that Dr. Lenke was doing this type of work sometime --
> THE COURT: Well, he was doing -- now, wait a minute. He testified that he knew he was doing derotation surgery with some unlinked pedicle [tools] …
> THE COURT: Yes, the tool. And even Dr. Lenke said that he started off with a couple of unlinked ones.
> MS. LOVETT: That was 2001, your Honor, but --
> THE COURT: Right. And then he got to maybe a couple more. But how was Dr. Barry supposed to be knowing what Dr. Lenke was doing supposedly by himself and with his people and at his cadaver lab?
> MS. LOVETT: I'll move on, your Honor.

TT 2243:1-2244:7. Medtronic made no further attempts to show that Dr. Barry was aware of any material prior art related to Dr. Lenke or that he withheld that nonexistent art from the PTO.

The ambiguous Biomet document (PX258), which Medtronic attempts to use as support for its positions, does not support this argument. The handwritten note recognized that the Lenke design would not work for the same reasons Medtronic's witnesses confirmed Dr. Lenke never reduced the invention to practice. TT 1495:10-24. As the Court noted, the section of that document referencing "Danek" does not mention "handles." TT 460:4-5. It is also not possible to determine clearly whether it refers to "holes" for the "same" as opposed to "some" purpose. Regardless, even if the portion about Danek references holes for the "same" purpose—passing a rod through the holes—it still does not establish clearly and convincingly that Dr. Lenke *conceived* of linking derotators or that he actually *used* them. As Dr. Barry explained, "you

know, I wasn't aware what these holes were – well, I thought that they may be there to link; but I never saw that." TT 461:9-11; *see also* TT 2249:21-25.

As with its other failure-to-disclose arguments, Medtronic failed to establish that Dr. Barry had knowledge of anything resembling material prior art from Dr. Lenke, let alone that he appreciated its materiality and nevertheless chose to withhold it from the PTO.

F. Medtronic's Assertions Based on Dr. Barry's PTAB Actions.

At trial, Medtronic confirmed that its complaints about Dr. Barry's attempts to correct Figure 6 relate only to the intent prong of inequitable conduct. TT 2170:14-20, 2171:9-14. Nothing about Dr. Barry's or his patent counsel's efforts to correct the figure's description supports a finding of intent to deceive. In its Findings of Fact, Medtronic first complained that Dr. Barry should have sought reissue, rather than certificates of correction, for the error. *See, e.g.*, ECF No. 353-1, ¶¶131-32.[5] While Medtronic goes on at length about how Dr. Barry ***should*** have sought reissue, at trial, its counsel conceded that the PTAB did "not requir[e] the reissue." TT 2172:5-6. Medtronic also ignored the PTO's decision to grant Dr. Barry's request for a certificate of correction in the '121 patent.

Medtronic also argued that Dr. Barry should have sought a Request for Continued Examination or further continuation during prosecution of the '589 continuation application to address the incorrect description. ECF No. 353-1, ¶145. Medtronic provides no authority for the notion that Dr. Barry's failure to follow Medtronic's preferred path supports a finding of intent to deceive. In the '589 application, Dr. Barry provided the PTO with many of the invalidity-related filings from this action outlining Medtronic's invalidity-based Figure 6 arguments (ECF No. 355,

[5] Medtronic argues that Dr. Barry should have corrected the second-to-last sentence of the Summary of Invention. ECF No. 353-1, ¶¶133, 151. The sentence is accurate. It does not refer to Figure 6 and therefore does not require modification.

¶¶32-33), sought an Amendment After Allowance, and the PTO allowed the claims as U.S. Patent No. 9,339,301. PX010; PX011; PX651; ECF No. 353-1, ¶145 n.133.

Although its arguments seemed to shift during trial, Medtronic argued that three aspects of the '358 patent *inter partes* review ("IPR") proceeding bolstered its allegation of deceptive intent. First, it pointed out that Dr. Barry's IPR declaration ***appeared*** inconsistent with what was written in his opposition to Medtronic's early summary judgment letter brief. ECF No. 353-1, ¶149. Dr. Barry's former counsel wrote, in opposing summary judgment, that the IMAST Abstract lacked sufficient detail to evaluate any patent claims. ECF No. 50-1, at 3. This same statement does not appear in Dr. Barry's declaration accompanying that opposition brief. ECF No. 50-3. In the IPR, Dr. Barry executed a declaration showing how the abstract disclosed the claims of his patent. PX706. The apparent tension between these two documents does not lead to the conclusion that there was any deceptive intent. Both were written in 2015, long after either asserted patent issued, and at most, they show a potential point of disagreement between Dr. Barry's analysis of the IMAST Abstract and that of his former counsel.

Second, Medtronic alleges that Mr. Pfefferkorn's declaration in this matter was inconsistent with his declaration in the IPR. ECF No. 353-1, ¶150. Mr. Pfefferkorn testified that he and Dr. Barry attended a meeting at DePuy in 2004. ECF No. 50-5, ¶8. In the IPR, he explained that "[i]n a declaration submitted in another litigation matter concerning these patents, I stated that Dr. Barry and I went to the DePuy headquarters in the spring of 2004. Based on an old email I subsequently located I now believe that this meeting took place in July 2003." DEF-398, ¶9. Accordingly, he corrected his misstatement. Neither Mr. Pfefferkorn nor Dr. Barry hid this information from Medtronic, informing it of the correct date both via the IPR proceeding and through amended interrogatories (PX427 at 11, 24).

Third, at trial, Medtronic seemed to argue that there was an inconsistency between Dr. Barry's declarations in the IPR. TT 2275:7-18. Medtronic's position was that Dr. Barry's IPR declaration comparing the abstract to the claims (PX706) conflicts with his declaration in support of a certificate of correction (DEF-495[6]). *Id.* The premise of Medtronic's theory is that, by mapping the abstract to the claims, Dr. Barry admitted that all 21 surgeries (including the June 2003 Figure 6 surgery) that predated the abstract practiced all of the claims, yet he did not disclose the surgeries to the PTO. TT 2275:14-16. This argument is unavailing and distorts the statements in the declarations. Dr. Barry never admitted that all 21 surgeries met the claim limitations. Further, the Figure 6 surgery predated Dr. Barry's receipt of workable, linkable handles and did not practice the claims. Ultimately, this argument collapses into Medtronic's failed theory that Dr. Barry failed to disclose his pre-2004 surgeries.

Again, Medtronic offers no evidence of intent by Dr. Barry or his counsel to deceive the Patent Office. In fact, given the findings of the jury, there is no inference that can be drawn concerning Dr. Barry's actions during the prosecution of his patent that could lead to the singular conclusion of a specific intent to defraud.

III. Conclusion.

Dr. Barry respectfully requests that the Court find against Medtronic on its affirmative defense and counterclaim of inequitable conduct because the record is void of any evidence of material prior art intentionally and knowingly withheld from the Patent Office.

DATED: November 29, 2016

Respectfully submitted,

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[6] This is the same declaration found at ECF No. 50-3, submitted in opposing summary judgment.

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that the foregoing document was filed electronically in compliance with Local Rule CV-5(a), and as such, this document was served on all counsel who have consented to electronic service. All other counsel of record not deemed to have consented to electronic service were served with a true and correct copy of the foregoing by email on November 29, 2016. True and correct copies of all sealed documents were promptly served on all counsel of record by email on November 29, 2016.

DATED: November 29, 2016

/s/ Sean P. DeBruine
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