

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 March 31, 2011, the court granted plaintiff leave to file an amended 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 opposed

plaintiff's motion to amend, in part, on the ground that the proposed amendment would be futile based on the Terminal Disclaimers plaintiff filed with respect to the '195 patent. The court, however, found that "[t]he 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." Order at 4 (Doc. No. 99).

Plaintiff filed his amended complaint on April 1, 2011, and shortly thereafter defendants filed a motion to dismiss Count II of the amended complaint for failure to state a claim. A motion to dismiss under Rule 12(b)(6) tests the legal sufficiency of a complaint. "The court's function on a Rule 12(b)(6) motion is not to weigh potential evidence that the parties might present at trial, but to assess whether the plaintiff's complaint alone is legally sufficient to state a claim for which relief may be granted."<sup>1</sup> In support of their motion, defendants attached documents that were neither referred to in the complaint, nor central to plaintiff's claims.<sup>2</sup> On July 14, 2011, the court issued an order informing the parties that it planned to consider these documents when ruling on defendants' motion. Thus, pursuant to Fed. R. Civ.

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<sup>1</sup>Sutton v. Utah State Sch. for Deaf & Blind, 173 F.3d 1226, 1236 (10th Cir. 1999) (*quoted with approval in Smith v. United States*, 561 F.3d 1090, 1098 (10th Cir. 2009), *cert. denied*, 130 S. Ct. 1142 (2010)).

<sup>2</sup>In analyzing the sufficiency of a claim, the court is not limited to the four corners of the complaint; rather, the court may also consider documents referred to in the complaint if those documents are central to plaintiffs' claims and the parties do not dispute their authenticity. Alvarado v. KOB-TV, L.L.C., 493 F.3d 1210, 1215 (10th Cir. 2007).

P. 12(d), the court converted the motion to one for summary judgment and granted the parties additional time to file any additional “material that is pertinent to the motion.” Fed. R. Civ. P. 12(d). In response, defendants filed the Declaration of Marwan Elrakabawy, which attached authenticated copies of the documents previously attached to defendants’ briefs in support of the motion to dismiss. Declaration of Marwan Elrakabawy (Doc. No. 109).

Summary judgment is appropriate if the pleadings and affidavits “show that there is no genuine issue as to any material fact and that the movant is entitled to judgment as a matter of law.” Fed. R. Civ. P. 56(c)(2). Any doubt as to the existence of a genuine issue of material fact must be resolved against the party seeking summary judgment. In addition, the inferences drawn from the facts presented must be construed in the light most favorable to the nonmoving party. Board of Education v. Pico, 457 U.S. 853, 863 (1982). “[T]here is no issue for trial unless there is sufficient evidence favoring the nonmoving party for a jury to return a verdict for that party. If the evidence is merely colorable, or is not significantly probative, summary judgment may be granted.” Anderson, 477 U.S. at 249-50 (citations omitted).

Defendants argue Count II of the amended complaint should be dismissed because the ‘195 patent is unenforceable in light of the Terminal Disclaimers. 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 Motion to Dismiss Count II of Plaintiff’s Amended Complaint and Brief in Support at 2-3 (Doc. No. 102-4) [hereinafter cited as “Defendants’ Motion”]. This language is in accord with patent regulations, which require that any terminal disclaimer filed to obviate double patenting “[i]nclude a provision that any patent granted on that application . . . shall be enforceable only for and during such period that said patent is commonly owned with the application or patent which formed the basis for the judicially created double patenting.” 37 CFR § 1.321(c)(3). When the precursor to this regulation was initially proposed, it was “intended to provide . . . a basis for requiring inclusion of a common ownership clause in all terminal disclaimers filed to obviate a double patenting rejection.” 35 Fed. Reg. 20,012 (Dec. 31, 1970).<sup>3</sup> The purpose of the common ownership requirement was to “prevent harassment of an alleged infringer by multiple parties due to subsequent different ownership of multiple patents granted as the result of filing a terminal disclaimer to overcome a double patenting rejection.”

Id.

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<sup>3</sup>As initially proposed, § 1.321 was actually more restrictive as it required terminal disclaimers to “include a provision that any patent granted on that application shall expire immediately if it ceases to be commonly owned with the application or patent which formed the basis for the rejection.” 35 Fed. Reg. 20,012 (Dec. 31, 1970). Based on comments received, the regulation as adopted did not include the expiration language; rather, the regulation provided that terminal disclaimers must reflect that the patent “shall be enforceable only for and during such period that said patent is commonly owned with the application or patent which formed the basis for the rejection.” 36 Fed. Reg. 7312 (Apr. 17, 1971).

It is undisputed that while plaintiff once owned all three patents, he assigned the '625 and the '195 patents to Katetry KFT, a Hungarian company, in 2008.<sup>4</sup> Exhibit 5 to Defendants' Motion. In the 2008 assignment, plaintiff conveyed to Katetry KFT his "entire rights, titles and interests in" the patents, including the "rights and interests to sue any and all alleged infringers for past, present and future infringement of the Voda Patents in the United States and its territorial possessions and in any and all foreign countries." Id. at 4. Ownership of the '213 patent remained with plaintiff. Effective December 25, 2010, Katetry KFT transferred the "entire rights, titles and interests in and to" the '195 patent back to plaintiff. Exhibit 6 to Defendants' Motion at 1. The 2010 assignment granted to plaintiff Katetry KFT's "entire rights and interests to sue any and all alleged infringers for past, present and future infringement of the 195 Patent in the United States and its territorial possessions." Id. Katetry KFT, however, did not assign its rights to the '625 patent to plaintiff.

Defendants argue that because plaintiff does not own the '625 patent, he cannot sue to enforce the '195 patent under the plain meaning of the Terminal Disclaimers. Plaintiff counters that the language of the Terminal Disclaimers requires "only that the patents be commonly owned 'for and during such a period' of

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<sup>4</sup>The 2008 assignment also assigned rights in patents not at issue in this action. The patents were collectively referred to as the "Voda Patents". Exhibit 5 to Defendants' Motion at 4.

infringement”,<sup>5</sup> and so plaintiff can sue for infringement that occurred prior to the 2008 assignment. The Terminal Disclaimers, however, do not speak in terms of ownership during times of infringement; rather, they require common ownership for enforceability. Moreover, plaintiff’s construction ignores the word “during”, which is contrary to long-standing canons of statutory construction. See FTC v. Accusearch Inc., 570 F.3d 1187, 1198 (10th Cir. 2009) (“Under a long-standing canon of statutory interpretation, one should avoid construing a statute so as to render statutory language superfluous.”) (*quoting* McCloy v. U.S. Dep’t of Agric., 351 F.3d 447, 451 (10th Cir. 2003)). Given that the reason for the common ownership requirement is to prevent multiple suits against an infringer by owners or assignees of related patents, the only construction of the “for and during” language that makes sense is that offered by defendants. To enforce the ‘195 patent, plaintiff must not only own all three patents **for** the period he seeks enforcement of the ‘195 patent,<sup>6</sup> he must also own all three patents **during** the period he files suit to do so. As it is undisputed that plaintiff does not own the ‘625 patent, the ‘195 patent is unenforceable as a matter of law under the plain language of the Terminal Disclaimers.

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<sup>5</sup>Plaintiff’s Opposition to Motion to Dismiss at 5 (Doc. No. 105).

<sup>6</sup>Plaintiff appears to agree with this statement as he concedes that “[f]ollowing the assignment of the ‘195 patent to Katetry without the ‘213 patent, the ‘195 patent was no longer enforceable against infringers.” Plaintiff’s Opposition to Motion to Dismiss at 7.

Medtronic's Motion to Dismiss Count II of Plaintiff's Amended Complaint (Doc. No. 102), which the court has converted to a motion for summary judgment, is therefore GRANTED.

It is so ordered this 17th day of August, 2011.

  
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TIM LEONARD  
United States District Judge