

IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF ARIZONA

Bard Peripheral Vascular, Inc.; David Goldfarb, M.D.,

Plaintiffs,

vs.

W.L. Gore & Associates, Inc.,

Defendant.

W.L. Gore & Associates, Inc.,

Counterclaimant,

vs.

Bard Peripheral Vascular, Inc., David Goldfarb, M.D., and C.R. Bard, Inc.,

Counterdefendants.

No. CV 03-0597-PHX-MHM

ORDER

Following a jury verdict for Plaintiffs, Bard Peripheral Vascular and David Goldfarb, M.D. (“Plaintiffs”), in this patent infringement case involving United States Patent No. 6,436,135 (the “‘135 patent”), W.L. Gore & Associates, Inc.’s (“Gore” or Defendant”), inequitable conduct claims were tried to the Court during a bench trial that occurred on December 7, 11, and 12, 2007. Since that time, the parties have filed post-trial briefs, including proposed findings of fact and conclusions of law, and have presented oral

1 argument. After considering the trial testimony, oral argument, and the papers submitted, the
2 Court enters this Order addressing the merits of Defendant's claims of inequitable conduct.

3 Gore claims patent invalidity based on inequitable conduct. In support of its position,
4 Gore asserts seven claims of alleged non-disclosure, misleading disclosure, and false
5 statements during the patent application process that Gore argues support finding the patent
6 unenforceable. Specifically, Gore asserts it can prove the following claims to establish
7 inequitable conduct:

- 8 1. Plaintiffs and their attorneys failed to advise the Patent Office of Dr. Volder's
9 connections with Impra in his 1976 affidavit in which he expressed his opinion
10 on the issue of obviousness as a presumably impartial person skilled in the art.
- 11 2. Plaintiffs and their attorneys failed to advise the Patent Office at any time prior
12 to withdrawal of the rejection of Claims 1 to 10 of the Goldfarb patent
13 application, that in 1978 Lenox Baker, M.D., withdrew and repudiated
14 paragraph 6 of his 1976 affidavit filed with the Patent Office.
- 15 3. The filing of and reliance on two 1976 affidavits from D. Dan Detton,
16 notwithstanding Mr. Detton's repudiation of those affidavits before they were
17 filed, and Plaintiffs' subsequent failure to advise the Patent Office of Mr.
18 Detton's 1978 repudiation of his 1976 affidavits.
- 19 4. Plaintiffs' reliance on an error that the Patent Office made in connection with
20 the Matsumoto publication in Surgery, in which the Patent Office Examiner
21 mistakenly interpreted the wall thickness in that publication to be 1 millimeter
22 ("mm") rather than 0.5 mm.
- 23 5. Plaintiffs and their attorneys failed to provide information to the Patent Office
24 about Dr. Volder's work and his possible role as an inventor or co-inventor,
25 including the failure to disclose the existence of and the subsequent destruction
26 of the Volder notebook.
- 27 6. Plaintiffs' and their attorneys' failed to comply with the Patent Office order
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1 requiring production of material information from the Goldfarb v. Impra
2 litigation.

- 3 7. Plaintiffs and their attorneys failed to advise the Patent Office Examiner of the
4 existence of the Gore shipping log, which contained information about prior
5 art vascular graft wall thicknesses that was inconsistent with the 1976
6 affidavits of Harold Green and Mr. Detton, and inconsistent with the argument
7 made by Dr. Goldfarb and Mr. Sutton in persuading the Patent Office
8 Examiner to withdraw the November 1975 rejection of Claims 1 to 10.

9 **FINDINGS OF FACT**

10 **I. PRE-INTERFERENCE *EX PARTE* PROSECUTION OF THE GOLDFARB**
11 **APPLICATION**

12 **A. FORMATION OF IMPRA**

- 13 1. In approximately May 1974, Dr. Goldfarb and others, who would later become
14 associated with a company called International Medical Prosthetics Research
15 Associates, Inc. (“Impra”), retained attorney Samuel J. Sutton to assist them in
16 preparing a patent application. Trial Tr., 12/7/07, at pp. 3830-31 (Sutton).
- 17 2. One of the reasons Impra retained Mr. Sutton was to help it get a patent on the ePTFE
18 graft. Trial Tr., 11/30/07, at p. 2598 (Sutton). Impra determined that such a patent
19 was critical to its survival. Trial Tr., 12/5/07, at p. 3204 (Gall).
- 20 3. In the course of preparing the patent application, Mr. Sutton conducted a thorough
21 investigation into inventorship, during which he met with J.G.R. Volder, M.D.,
22 several times between June and August 1974 for the purpose of investigating
23 inventorship. Trial Tr., 11/30/07, at p. 2597 (Sutton). Mr. Sutton also met
24 extensively with Dr. Goldfarb, who gave Mr. Sutton full access to his laboratory
25 research. Trial Tr., 11/07/07, at pp. 416-17 (Goldfarb); Trial Tr., 11/30/07, at pp.
26 2601-04 (Sutton).
- 27 4. In September 1974, there were many claims and contenders for the position of
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- 1 inventor, including Dr. Goldfarb and Dr. Volder. Trial Tr., 12/7/07, at p. 3826
2 (Sutton); Trial Tr., 11/7/07, at pp. 415-16, 588 (Goldfarb); Trial Tr., 11/30/07, at pp.
3 2606-07 (Sutton).
- 4 5. Mr. Sutton and Impra were concerned in the summer of 1974 that the University of
5 Utah might have an ownership claim to the ePTFE patent if Dr. Volder were the sole
6 inventor or even a co-inventor. Trial Tr., 11/27/07, at pp. 1976-77 and 1983-85
7 (Baker); Trial Tr., 11/30/07, at pp. 2598-99 (Sutton).
- 8 6. At that same time, Mr. Sutton also was concerned about Dr. Goldfarb's relationship
9 with Arizona State University and the Arizona Heart Institute ("AHI") and whether
10 either entity may have an ownership claim to the patent application Mr. Sutton was
11 preparing. Trial Tr., 11/30/07, at pp. 2598-99 (Sutton).
- 12 7. On September 4, 1974, Mr. Sutton received a letter from William H. Drummond, Dr.
13 Volder's personal attorney. DX3048. In that letter Mr. Drummond asserted that "Dr.
14 Volder has kept some fairly accurate and complete records of conception, reduction
15 to practice and diligence . . . [which] leads me to the opinion that Dr. Volder is the
16 sole inventor." Id.
- 17 8. After receiving Mr. Drummond's letter, on September 9, 1974, Mr. Sutton met with
18 Drs. Volder and Goldfarb, as well as Don Gall, M.D., Mr. Harold Green, and Richard
19 Mendenhall, to discuss the draft patent application and to investigate inventorship.
20 Trial Tr., 11/07/07, at pp. 412-19 (Goldfarb); Trial Tr., 11/27/07 at pp. 2003-04 (H.
21 Green); Trial Tr., 11/30/07, at p. 2604 (Sutton); Trial Tr., 12/05/07, at pp. 3191-92,
22 3197-99 (Gall).
- 23 9. At the conclusion of this meeting it was unanimously agreed by all attendees, without
24 objection, that Dr. Goldfarb was the sole inventor. Trial Tr., 12/05/07, at pp. 3191-92,
25 3197-99 (Goldfarb); Trial Tr., 11/27/07, at pp. 2004-05 (H. Green); Trial Tr.,
26 12/05/07, at 3199 (Gall).
- 27 10. The conclusion that Dr. Goldfarb was the inventor was reached solely on the scientific
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merits of Dr. Goldfarb's work, and appears not to be based on an "election." Trial Tr., 11/07/07, at pp. 418-19 (Goldfarb); Trial Tr., 11/27/07, at pp. 2004-05 (H. Green); Trial Tr., 12/05/07, at p. 3200 (Gall).

11. Mr. Sutton summarized the outcome of this meeting in a September 10, 1974 memorandum that stated that it was "unanimously determined that Impra's patent application should be filed in the name of Dr. Goldfarb." PX2.

12. Dr. Volder signed Mr. Sutton's memorandum affirming that it "accurately summariz[ed] the substance of [the] September 9, 1974 discussions." PX2. There is no evidence to suggest that Dr. Volder has ever repudiated this signed acknowledgment.

B. GORE'S ACTIVITIES IN RELATION TO ePTFE

13. In 1972, research began into the use of expanded polytetrafluoroethylene ("ePTFE") as a vascular graft, when Gore and several surgeons experimented to determine the suitability of ePTFE as a vascular graft. Cooper v. Goldfarb, 154 F.3d 1321, 1324 (Fed. Cir. 1998).

14. During 1972-73, Gore manufactured and sent these ePTFE vascular grafts to numerous surgeons to evaluate the material's suitability for use as a vascular prosthesis. Cooper, 154 F.3d at p. 1324; Trial Tr., 11/8/07, at p. 633 (Goldfarb).

15. One of the surgeons to receive ePTFE vascular grafts from Gore was Dr. Volder, then at the University of Utah. Trial Tr., 11/8/07, at p. 633 (Goldfarb). Dr. Volder co-authored one article concerning his results with this material: Volder, et al., "A-V Shunts Created in New Ways," Trans. Amer. Society for Artificial Organs, Vol. XIX, pp. 38-42 (published by Aug. 6, 1973) ("the Volder A-V Shunts Article"). PX115JJ at p. PX115.2667-71; DX3247.

16. Dr. Goldfarb also received ePTFE tubing from Gore. H. Green Dep., 7/12/88, at p. 265 (PX116.8867).

17. In 1973 Gore hired Mr. Detton as a "communicator" between the doctors to whom

1 Gore was sending ePTFE tubing for testing and the engineers at Gore. Detton Dep.,
2 6/19/75, at pp. 5-6 (PX115.874-75); Trial Tr., 11/27/07, at p. 1844 (Detton). Mr.
3 Detton reported directly to Peter Cooper, the plant manager at Gore. Trial Tr.,
4 11/27/07, at pp. 1844-45 (Detton). In April 1974 Mr. Detton was fired by Gore and,
5 for a short time thereafter, had limited involvement with the formation of Impra until
6 he went to Alaska in June 1974 and had no involvement. Detton Dep., 6/19/75, at p.
7 102 (PX115.971); Trial Tr., 11/27/07, at pp. 1890-93 (Detton).

8 **C. GORE SUES IMPRA**

9 18. Shortly after its formation, Impra and certain individuals associated with Impra, were
10 sued by Gore for allegedly misappropriating Gore's trade secrets. Gore v. Impra, No.
11 74-778 PXH WEC (D. Ariz. 1974) (PX115.341-61). During the course of this
12 litigation, Mr. Detton and Mr. Harold Green were both deposed in 1975. Detton Dep.,
13 6/19/75 (PX115.870-1005); H. Green Dep., 7/17 18/75 (PX115.1006-1227).

14 19. Mr. Sutton met with Mr. Detton for about an hour before his deposition. Trial Tr.,
15 12/12/07, at p. 4314 (Detton). Mr. Sutton "did not ask [Mr. Detton] to lie or anything
16 like that." Id. at pp. 4314, 4317.

17 20. In his 1975 deposition, Mr. Detton testified that he received a specific request from
18 Dr. Goldfarb in mid-June 1973 for an ePTFE graft with certain specifications. Detton
19 Dep., 6/19/75, at p. 32 (PX115.901). Mr. Detton further testified that he and Mr.
20 Harold Green (then the Gore employee responsible for fabricating ePTFE tubing)
21 immediately started working on adjusting Gore's production control variables in order
22 to make the grafts specified by Dr. Goldfarb, and that grafts satisfying Dr. Goldfarb's
23 specifications were delivered to him in mid-July 1973. Detton Dep., 6/19/75, at pp.
24 21-32 (PX115.890-901).

25 21. Mr. Detton also testified that in February 1974, he completed and presented internally
26 at Gore a memorandum that was a compilation of the research performed by the
27 various medical researchers, including Drs. Goldfarb and Volder, who were receiving
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1 ePTFE tubing from Gore (the “1974 Detton Memorandum”). Detton Dep., 6/19/75,
2 at pp. 42-47 (PX115.911-16).

3 22. Mr. Harold Green was deposed after Mr. Detton on July 17-18, 1975. H. Green Dep.,
4 7/17-18/75 (PX115.1006-1227). Mr. Green stated that in either June or July 1973 Mr.
5 Detton informed him of what came to be known at Gore as the “Goldfarb Structure.”
6 H. Green Dep., 7/17-18/75, at pp. 54-58 (PX115.1061-68). He identified the
7 “Goldfarb Structure” as that described in the claims of Dr. Goldfarb’s patent
8 application. Id. Mr. Green independently confirmed the physical specifications
9 received from Mr. Detton by calling Dr. Goldfarb directly because the requested
10 grafts were so different then any of the ePTFE tubing that Gore had previously
11 manufactured. PX115O at p. PX115.280. This telephone conversation was
12 corroborated by Dr. Goldfarb. Trial Tr., 11/07/07, at p. 399 (Goldfarb). Mr. Green
13 then used Dr. Goldfarb’s specifications to prepare grafts for Dr. Goldfarb in the
14 summer of 1973. H. Green Dep., 7/17-18/75, at p. 60 (PX115.1067); Trial Tr.,
15 11/07/07, at pp. 399-400 (Goldfarb).

16 **D. PTO PATENT APPLICATION**

17 23. On October 24, 1974, Mr. Sutton filed a patent application with the PTO in the name
18 of Dr. Goldfarb entitled “Prosthetic Vascular Graft” (the “Goldfarb Application”).
19 PX115A. Around the time the Goldfarb Application was filed, Dr. Goldfarb agreed
20 to assign all of his rights in the Goldfarb Application to Impra, which agreement
21 subsequently was memorialized in writing on January 9, 1976. PX1; PX3; PX115M;
22 PX1356; Trial Tr., 11/07/07, at pp. 420-23, 421, 435-37 (Goldfarb). Mr. Sutton was
23 the attorney-of-record for the application. PX115M at p. 115.1.

24 24. All original claims 1-10 of the ‘135 patent application were directed to ePTFE
25 vascular grafts, and each required a wall thickness within a particular range. PX115A
26 at p. 115.44-48.

27 25. On November 26, 1975, the Patent Office mailed its first Office Action in the
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1 Goldfarb Application to Mr. Sutton. PX115B at p. PX115.190-92. The Office Action
2 was signed by Examiner R.L. Frinks - the same examiner assigned to the Cooper
3 Application. (See I.K. Cooper Patent Application *infra.*) (who, in fact, mailed an
4 Office Action in the Cooper Application that same day based on three of the same
5 references (PX117.119-23)). Examiner Frinks rejected the Goldfarb Application as
6 being unpatentable as obvious in view of four articles: (i) Soyer, et al., "A New
7 Venous Prosthesis," Surgery, Vol. 72, page 864 (Dec. 1972) ("the Soyer Article"); (ii)
8 Matsumoto, et al., "A New Vascular Prosthesis for Small Caliber Artery," Surgery,
9 Vol. 74, page 519 (Oct. 1973) ("the Matsumoto III Article"); (iii) the Volder A-V
10 Shunts Article; and (iv) Poth, et al., "The Use of Plastic Fabrics as Arterial
11 Prostheses," Annals of Surgery, Vol. 142, No. 4, pp. 524-632, (Oct. 1955). DX3334,
12 DX3247, DX3009.

13 26. Mr. Sutton had previously identified the Soyer and Matsumoto III Articles as prior art
14 both in the specification of the Goldfarb Application (PX115A at p. PX115.31.), and
15 in a "Pre-Examination Amendment and Citation of Prior Art," received by the PTO
16 on April 21, 1975. PX115RR at p. PX115.57.

17 27. In response to the PTO examiner's rejection of the Goldfarb Application, Mr. Sutton
18 submitted five affidavits to the PTO in 1976 – one by Mr. Harold Green, one by Dr.
19 Baker, two by Mr. Detton, and one by Dr. Volder. PX115C and PX115Q.

20 28. Mr. Sutton, who drafted the Green, Baker, and Volder affidavits and submitted them
21 to the Patent Office, testified that those affidavits formed a material portion of the
22 Patent Office files relating to the '135 patent application, and if those affidavits were
23 incorrect, that would be material to the prosecution of the Goldfarb patent application.
24 Trial Tr., 12/7/07, 3854-3855, 3884 (Sutton). Dr. Goldfarb was familiar with these
25 affidavits, he disagreed with at least some of their content, but they were still filed on
26 his behalf in 1976. Trial Tr., 11/7/07, at pp. 537, 540 and 545-46 (Goldfarb).

E. THE 1976 AFFIDAVITS

1. DR. VOLDER'S 1976 AFFIDAVIT

29. Dr. Volder's 1976 Affidavit was executed on July 29, 1976. PX115Q at p. PX115.311.

30. In his affidavit, Dr. Volder stated that he was the author of the Volder A-V Shunts Article relied on by the examiner and:

That, as a result of his early work at the Division of Artificial Organ in the Department of Surgery of the University of Utah, reported in the 1973 ASAIO [Volder A-V Shunts Article], he was able to speculate . . . that "It is believed that by increasing the average pore size of the material, at the moment 5, it will be possible to accelerate the process of tissue infiltration and development of capillaries."

PX115Q at p. PX115.308.

31. The 1976 Volder Affidavit further describes how, after the preparation of the Volder A V Shunts Article, Dr. Volder requested that Mr. Detton prepare "thick wall" tubing "including a large number of randomly spaced perforations produced by repeatedly running the tubular structure through a sewing machine ..." and that "his research efforts were, and continue to be, in the direction of vascular grafts having open superstructure, characterized by interstitial distances substantially greater than one hundred microns." Id. at p. PX115.308-09. Dr. Volder also stated that he had reviewed the claims of the Goldfarb Application prior to its filing in an effort, *inter alia*, to "ascertain whether any technical overlap or conflict existed between the subject matter claimed ... [and] the work described in the 1973 ASAIO article [Volder A-V Shunts Article]" and that following such review:

[H]e [was] of the unqualified opinion that the prosthetic vascular structure conceived and developed by the applicant, while seemingly apparent when viewed with the aid of hindsight, was by no means obvious to those actively conducting research on expanded PTFE vascular structures during 1972 and 1973.

Id. at p. PX115.310. Dr. Volder never withdrew this affidavit after he signed it.

32. Dr. Volder was a founding director of Impra. DX3380 at pp. I00376-77; Trial Tr., 12/5/07, at pp. 3207-08 (Gall); PX116III at pp. 116:12853-54, 116:12933. Dr. Volder also owned stock in Impra and was on its Medical Advisory Board. DX3379, DX3380 at p. 00381; Trial Tr., 12/5/07, at pp. 3200-01 (Gall); PX116III at pp. 12854-55, 116.12965-66.

33. Although Dr. Volder was a shareholder of Impra at the time he signed his affidavit, the 1976 Volder Affidavit does not discuss this affiliation with Impra. PX115Q. In contrast, Mr. Sutton disclosed both Mr. Harold Green's and Mr. Baker's affiliation with Impra. Trial Tr., 12/12/07, at pp. 4262-63 (Thesz).

34. However, there is no evidence that Dr. Volder was an officer of Impra at the time he signed his affidavit. Trial. Tr., 12/17/2007, at pp. 4135, 4137-38 (Bjorge).

35. Moreover, there is no evidence that Mr. Sutton, who drafted Dr. Volder's affidavit, knew of Dr. Volder's ownership interest in Impra at or before the time the affidavit was submitted, or at any time before 1996. Trial Tr., 12/12/07 at pp. 4263, 4306 (Thesz). Nor is there any evidence that either Dr. Volder or Dr. Goldfarb were aware that Dr. Volder's ownership interest in Impra possibly should have been disclosed in Dr. Volder's affidavit.

2. DR. BAKER'S 1976 AFFIDAVIT

36. Dr. Lenox Baker executed his affidavit in support of the Goldfarb Application on March 15, 1976. In his affidavit Dr. Baker stated:

Under no conditions presently known to him would he use or recommend the use of a graft characterized by a wall thickness greater than approximately .75 mm, since "thick wall" grafts of this type are surgically unacceptable and accordingly subject the patient to an unreasonably high risk of clinical failure.

PX115F at p. PX115.285.

37. Mr. Sutton disclosed in Dr. Baker's affidavit that Dr. Baker was an officer of Impra. PX115F at p. PX115.283.

1 38. On April 22, 1976, Mr. Sutton argued to the Patent Office on behalf of Dr. Goldfarb
2 that the 0.2 to 0.8 mm wall thickness range of the claims was an “extremely
3 important” and non-obvious distinction over the prior art. That argument expressly
4 quoted paragraph 6 of Dr. Baker’s affidavit to establish the criticality of a wall
5 thickness range of 0.2 to 0.8 mm and asked the Patent Office to withdraw the pending
6 obviousness rejection. PX115C at pp. 115.219-20; Trial Tr., 12/11/07, at pp. 3949-51
7 (Bjorge).

8 39. By February 1978, Dr. Baker believed that his April 1976 affidavit was untrue or
9 inaccurate, and this was communicated to Dr. Goldfarb and his counsel. DX3055 at
10 p. G-11106; Trial Tr., 12/7/07, at p. 3874 (Sutton); Trial Tr., 12/11/07, at pp. 3951-52
11 (Bjorge).

12 40. By at least July 1978, Mr. Cates, Dr. Goldfarb’s attorney, was aware of the inaccuracy
13 of Dr. Baker’s April 1976 affidavit. Trial Tr., 12/11/07, at 3958-3959 (Bjorge);
14 DX3481.

15 41. On November 9, 1978, Dr. Baker was deposed for a second time in the Goldfarb v.
16 Impra litigation. Trial Tr., 11/27/07, at pp. 1978-85 (Baker). During that deposition,
17 Dr. Baker indicated that he wanted to change all of Paragraph 6 of his 1976 Affidavit
18 because he “now believed that our thinking at that time was not correct.” Trial Tr.,
19 11/27/07, at pp. 1978-79 (Baker). Dr. Baker was advised the “most proper way” of
20 describing the inaccuracy of paragraph 6 of his March 1976 affidavit would be “at this
21 deposition” because he understood that it “would undoubtedly end up in the U.S.
22 Patent Office in relation to [the ‘135] patent application.” Trial Tr., 11/27/07, at pp.
23 1980-81 (Baker). Dr. Goldfarb was present during that testimony and thereafter read
24 the transcript. PX117 at p. 117.2994, DX3110; Trial Tr., 12/11/07, at p. 4043
25 (Bjorge).

26 42. Dr. Baker confirmed, however, that he did not hold these beliefs at the time he signed
27 the affidavit in 1976 and that he believed the affidavit to be true and correct at the
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1 time he signed it. Trial Tr., 11/17/07, at p. 1978 (Baker).

2 **3. THE 1976 DETTON AFFIDAVITS**

3 43. Two affidavits, signed by Mr. Detton on January 23, 1976, also were filed in April
4 1976 by Mr. Sutton as part of the argument against the November 1975 Patent Office
5 rejection of Dr. Goldfarb's application. PX115N; PX115P. These affidavits stated
6 what Dr. Goldfarb purportedly told Mr. Detton about the desirable properties of grafts
7 and what Mr. Detton knew about the wall thickness of grafts purportedly
8 manufactured by Gore before Dr. Goldfarb's input. PX115P. However, Mr. Detton
9 testified at trial that both such statements in his affidavit were false. Trial Tr.,
10 11/27/07, at pp. 1895-97, 1897-98, 1919 (Detton).

11 44. On January 23, 1976, in the presence of Mr. Sutton, Mr. Harold Green and Mr.
12 Detton's then wife Joanie Prestis, Mr. Detton signed the two affidavits that were later
13 submitted to the Patent Office by Mr. Sutton on behalf on Dr. Goldfarb. These
14 affidavits were drafted by Mr. Sutton. Trial Tr., 12/7/07, at pp. 3853-54 (Sutton).

15 45. At first Mr. Detton refused to sign the affidavits. According to Mr. Detton, Mr.
16 Harold Green pressured Mr. Detton to sign the affidavits. Trial Tr., 12/12/07, at p.
17 4311. Mr. Detton testified that on the drive home after signing the affidavits he
18 decided that they should not be submitted to the Patent Office because they were "so
19 fallacious." Trial Tr., 11/27/07, at p. 1898 (Detton); Trial Tr., 12/12/07, at pp. 4311,
20 4317-18 (Detton).

21 46. On January 26, 1976, the following Monday, Mr. Detton claims to have contacted Mr.
22 Sutton by telephone to request that the affidavits be withdrawn. Trial Tr., 11/27/07,
23 at p. 1898 (Detton). Mr. Detton testified that he told Mr. Sutton that the affidavits had
24 been signed under duress, that he was sending him a letter to that effect, and that he
25 highly objected to them being submitted to the Patent Office. Trial Tr., 12/12/07, at
26 pp. 4311-12 (Detton).

27 47. Also on January 26, 1976, Mr. Detton sent a letter to Mr. Sutton requesting the
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1 withdrawal of the affidavits that he had executed on January 23, 1976 on the basis that
2 he “signed them under duress and anger” and because “the claims contained within
3 those affidavits ... are not totally true.” DX3084; Trial Tr., 11/27/07, at pp. 1898-99,
4 1899 (Detton). The letter was copied to Dr. Goldfarb. DX3084; Trial Tr., 11/27/07,
5 at p. 1899 (Detton).

6 48. Mr. Sutton denies having received the letter, DX3084, from Mr. Detton. Trial Tr.,
7 12/7/07, at p. 3859 (Sutton).

8 49. Mr. Sutton submitted the two Detton affidavits to the Patent Office in April 1976 and
9 relied on them to overcome the 1975 rejection. PX115P.

10 50. In January or February of 1978 a meeting occurred at the Golden Eagle restaurant
11 between Messrs. Detton, Sutton and Harold Green. H. Green Dep., 11/9/78,
12 (PX115.1652-61). At this meeting, Mr. Detton purportedly indicated that he was
13 “uncomfortable” with his 1976 Affidavits, and asked for the best way to repudiate
14 them. Id. At this meeting, Mr. Detton did not specifically identify anything in his
15 affidavits that he believed to be incorrect, false or otherwise improper. Id. Mr. Sutton
16 told Mr. Detton that he was no longer involved in the prosecution of the Goldfarb
17 Application and that he should retain a lawyer or submit a paper directly to the PTO
18 if he wished to recant his affidavits. Trial Tr., 12/07/07, at pp. 3864-65 (Sutton). Mr.
19 Detton never did so.

20 51. Impra disclosed this communication to Dr. Goldfarb in an interrogatory response in
21 the Goldfarb v. Impra litigation, verified by Mr. Harold Green on September 11,
22 1978, which stated that: “During February of 1978, Mr. Detton clearly and
23 unequivocally stated to Mr. Green and ... Samuel J. Sutton, that he (Detton) wishes
24 to repudiate his affidavit and thereby purge the record of any statements that might
25 be false, misleading or ambiguous.” DX3051. Despite repeated requests from Dr.
26 Goldfarb’s attorneys, Impra never provided any details regarding what Mr. Detton
27 believed to be incorrect, false or otherwise improper in his 1976 Affidavits. Trial Tr.,
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- 1 11/07/07, at pp. 444, 448 (Goldfarb).
- 2 52. Mr. Sutton recalled that this meeting took place in April, May, or June 1978, after Mr.
- 3 Sutton's February 1978 withdrawal as Dr. Goldfarb's patent counsel. Trial Tr.,
- 4 11/30/07, at p. 2618 (Sutton).
- 5 53. On November 9, 1978, Mr. Harold Green was deposed in Goldfarb v. Impra. Mr.
- 6 Green testified that the Golden Eagle meeting occurred in January or February 1978.
- 7 PX116 at p. 116.19059. Mr. Harold Green testified that Mr. Detton said with Mr.
- 8 Sutton present that he wanted to repudiate his affidavit:
- 9 [Detton] no longer felt comfortable with the affidavit that he had signed
- 10 related to the [Goldfarb] patent application and was seeking advice on
- 11 how best to repudiate that affidavit
- 12 PX116 at pp. 116.19059-60. Mr. Green stated that if Mr. Detton withdrew his 1976
- 13 Affidavits this may cast a "shadow" over those paragraphs in the 1976 Green
- 14 Affidavit referring to Mr. Green's conversations with Mr. Detton. Id. at pp.
- 15 PX115.1663-66, 1671,1674.
- 16 54. Mr. Sutton's secretary and business partner, Jane Shrum, confirmed that Mr. Sutton
- 17 learned in or about 1978 that Mr. Detton wanted to change parts of his affidavits.
- 18 Trial Tr., 12/12/07, at p. 4152 (Shrum).
- 19 55. In October of 1978, Dr. Goldfarb and his litigation counsel, Harold Swenson, met
- 20 with Mr. Detton at the airport in Prescott. PX1308 at p. 1308.3; Trial Tr., 11/07/07,
- 21 at p. 441 (Goldfarb). At this one-and-a-half to two hour meeting Mr. Detton told Mr.
- 22 Swenson that he did not want to repudiate either of his 1976 Affidavits, and that he
- 23 was upset that Impra had made such a claim. PX1308 at p. PX1308.3-4; Trial Tr.,
- 24 11/07/07, at p. 441 (Goldfarb); Trial Tr., 12/12/07, at pp. 4109-12 (Swenson).
- 25 56. Mr. Harold Green testified that if Mr. Detton wished to repudiate his affidavits,
- 26 paragraphs 3, 7, and 9 of Mr. Harold Green's affidavit would no longer be correct
- 27 because the information contained therein came from Mr. Detton. PX116 at pp.
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116.19071-83.

57. In discussions with Dr. Baker and Mr. Harold Green at different times before Mr. Sutton withdrew as Goldfarb's patent counsel, Mr. Sutton learned that they were worried about their affidavits because they had been based on Mr. Detton's affidavits, and that if something was wrong with Detton's affidavits it could have a "domino effect" on the other affidavits. Trial Tr., 12/7/07, at p. 3874 (Sutton).

58. Dr. Goldfarb was aware of Mr. Detton's repudiation, because he was present during Mr. Harold Green's deposition where it was discussed. PX116 at p. 116.19031; Trial Tr., 11/7/07, at p. 569 (Goldfarb). Dr. Goldfarb also read the transcript of Mr. Harold Green's deposition by at least July 25, 1979. DX3110.

59. On September 11, 1978, Impra filed sworn Interrogatory responses stating that "Mr. Detton has on numerous occasions prior to February 1978 conveyed to Mr. Harold Green an uneasiness regarding the accuracy of [Detton's] affidavit." DX3051 at WGS000449. The sworn interrogatory answers further stated that "[d]uring February 1978, Mr. Detton clearly and unequivocally stated to Mr. Green and the corporate defendant's patent counsel, Samuel J. Sutton, that [Detton] wished to repudiate his affidavit and thereby purge the record of any statements which might be construed to be false, misleading, or ambiguous." DX3051 at p. WGS000449. The interrogatory answers were executed by Mr. Harold Green, then president of Impra. Trial Tr., 11/27/07, at pp. 1991-92 (H. Green).

60. On February 5, 1980, Mr. Detton executed an affidavit stating that "he questioned the correctness of [the] statements" of his 1976 affidavit and that he "was pressured into signing the affidavit." PX115X at p. 115.615. That affidavit also confirms that Mr. Sutton was informed in January 1976 that the Detton affidavit "was not correct," was signed "under duress" and "[Detton] wanted the Patent Office to be informed of this." PX115X at p. 115.615; Trial Tr., 12/12/07, at pp. 4317-18 (Detton). Thus, the 1980 Detton Affidavit provides in its entirety as follows:

1 The undersigned D. Dan Detton deposes and says:

- 2 (1) That he is presently a resident of the State of Colorado residing
3 at 10 Spruce Drive, Montrose, Colorado.
- 4 (2) That he executed an affidavit entitled "Affidavit of D. Dan
5 Detton Relating to Source and Origin of Material Comprising
6 Specification of the Cooper Application" (copy attached)
7 January 23, 1976, which he understands was filed in the patent
8 application for David Goldfarb, Serial No. 517,415, filed
9 October 24, 1974.
- 10 (3) That before execution, he questioned the correctness of
11 statements included in said Affidavit, which had been prepared
12 by representatives of IMPRA, then assignee of the Goldfarb
13 application, but was pressured into signing the Affidavit.
- 14 (4) That he informed Mr. Suten [sic], counsel for IMPRA, by
15 telephone communication on January 26, 1976, (copy of text
16 attached) that he felt that the Affidavit was not correct, that he
17 had signed it under duress, and that he wanted the patent office
18 to be informed of this.
- 19 (5) That the vascular structures reported in his memorandum
20 entitled "Gore-Tex® Medical Product Developments: A
21 Summary of Current Research Findings" (February 1974) as
22 being successful, and the specifications of those structures
23 including wall thickness, density, fibril length and the like, were
24 determined as a result of the investigations reported in the
25 memorandum, and had not been predicted by any of the medical
26 investigators prior to institution of the reported work, and
27 specifically, that neither David Goldfarb nor Peter Cooper
28 described to him prior to the investigation at Arizona Heart
Institute which commenced during the Summer of 1973 those
specifications such as wall thickness, density and fibril length of
a vascular graft that would be successful.

PX115X at p. PX115.615-16.

61. On September 13, 1985, Mr. Lawrence Green, one of Dr. Goldfarb's patent attorneys,
met with Mr. Detton. DX3209. After the meeting, Mr. Lawrence Green sent a letter
to Mr. Detton requesting that Mr. Detton sign another affidavit in order to clarify his
position with respect to the 1976 Affidavits. Id. Mr. Detton failed to respond to this
letter.

4. HAROLD GREEN'S 1976 AFFIDAVIT

62. The 1976 Green Affidavit was executed on March 2, 1976 after Mr. Harold Green had left Gore's employ. PX115C at p. PX115.279-282. There is no evidence that once Mr. Green left Gore, he had access to Gore's internal documents, including any production or shipping logs that might have evidenced the work he did while at Gore. The 1976 Green Affidavit states: "based upon his personal knowledge of prior art efforts to achieve an operative prosthetic, he believes that all prior research was directed to and incorporated 'thick wall' tubes having wall thicknesses equal to or greater than approximately one millimeter [sic] (1mm)." PX115C at p. 115.281.

63. The 1976 Green Affidavit, also mirrored Mr. Harold Green's 1975 Gore v. Impra testimony regarding Dr. Goldfarb's inventorship stating, among other things, that: (i) Mr. Detton communicated the "Goldfarb Specifications" to him in the spring and early summer of 1973; (ii) Mr. Green independently verified the specifications by contacting Dr. Goldfarb directly because such structures "were at substantial variance with the structures previously used and requested by other cardiovascular researchers;" and (iii) having confirmed Dr. Goldfarb's specifications Mr. Green immediately began making the requested grafts. PX115O at p. 115.280.

64. Mr. Sutton disclosed in Mr. Green's affidavit that Mr. Green was an officer of Impra, the assignee of the Goldfarb Application at the time he signed the affidavit. PX115C at p. PX115.279.

F. PTO'S MISTAKE ABOUT MATSUMOTO WALL THICKNESS

65. The Matsumoto Surgery article shows a graft wall thickness of 0.5 mm. Trial Tr., 11/8/07, at p. 653 (Goldfarb); Trial Tr., 11/28/07, at pp. 2101-02 (Goldfarb). However, the Patent Examiner mistakenly believed that the Matsumoto III article disclosed a graft wall thickness of 1 mm. DX3055 at p. G-11106; Trial Tr., 12/4/07, at pp. 2893-94 (Bjorge).

66. In his remarks in the Office Action, Examiner Frinks noted the following:

1 to further make wall thickness 1 mm or less for small diameters such as
2 taught by [the Matsumoto III Article] would be obvious. Applicant's
3 specific wall thickness of 0.2-0.8 mm is not seen to be a patentable
4 distinction over wall thickness of [the Matsumoto III Article] in the
5 absence of proven criticality.

6 PX115SS at p. PX115.191.

7 Although Examiner Frinks had the Matsumoto III Article, from which a wall
8 thickness of 0.5 mm could readily be calculated (Trial Tr., 11/08/08, at pp. 653-54
9 (Goldfarb); Trial Tr., 11/28/07, at p. 2174 (Wheeler); DX 3009 at p. 519), he
10 apparently misinterpreted the Matsumoto III Article as disclosing a wall thickness of
11 1.0 mm. Mr. Sutton testified as to the "substantial confusion" concerning the wall
12 thickness disclosed in the Matsumoto III Article at the time he filed the Goldfarb
13 Application. Trial Tr., 11/30/07, at p. 2612 (Sutton).

14 67. The Patent Office Examiner, in the November 1975 rejection, effectively asked for
15 a showing that the claims range of 0.2 to 0.8 mm was "critical" compared to the prior
16 art. Trial Tr., 12/4/07, at pp. 2893-94 (Bjorge).

17 68. Mr. Sutton acting for Dr. Goldfarb provided such a showing by relying on the 1976
18 Baker affidavit and Mr. Harold Green's 1976 affidavit, asserting that all prior art
19 vascular grafts "incorporated 'thick wall' tubes having wall thicknesses equal to or
20 greater than approximately one millimeter." PX115O. Summarizing, Mr. Sutton
21 stated in his April 1976 response to the Patent Office that: "all prior art efforts
22 (including those of Dr. Volder) were based upon the use of 'thick-walled' commercial
23 PTFE tubing characterized by wall thicknesses greater than 1 mm." PX115E at pp.
24 115.217.

25 69. After the Patent Office rejected Dr. Goldfarb's patent application, Mr. Sutton sought
26 to distinguish the Matsumoto III Article by arguing that:

27 Applicant finds no teaching as to the importance of uniform
28 distribution of nodes and no teaching of the important relationship
between wall thickness and internodular distance.

Matsumoto [III] refers to “porosity” for a definition of internodular distance; however, it is possible to have an eighty percent porous sample of PTFE which has either a few very large nodes or many small nodes per unit volume.

PX115E at p. PX115.218.

70. Impra’s February 1978 letter to Dr. Goldfarb’s counsel acknowledged the Patent Office Examiner had made a mistake as to wall thickness. DX3055 at p. G-11106. Dr. Goldfarb’s counsel, Mr. Cates, conceded the error as well. PX1236 at p. 1236.3 (acknowledging that Matsumoto has a 0.5 mm wall thickness).

71. Dr. Goldfarb disclosed the correct wall thickness during the interference. PX116W at p. PX1116.2676. The PTO found wall thickness not to be a critical or material factor in the invention. See PX116 at p. 116.7300; PX116 at p. 116.4175-77.

G. DR. VOLDER’S INVENTORSHIP CLAIMS AND NOTEBOOK

72. On September 4, 1974, Dr. Volder’s personal attorney, Mr. Drummond, wrote to Mr. Sutton asserting that, based on Volder’s “fairly accurate and complete records” (the “Volder Notebook”), Mr. Drummond believed Dr. Volder to be “the sole inventor” of “developments relating to the artificial blood vessel.” DX3048.

73. At some point, Dr. Volder provided Mr. Sutton with a copy of the Volder Notebook which he asked Mr. Sutton to retain “in confidence.” Trial Tr., 12/07/07, at p. 3825 (Sutton). Mr. Sutton claims Dr. Volder provided the Notebook to him in approximately April 1977. Id.

74. Mr. Sutton – the only person apart from Dr. Volder and his attorney known to have personally reviewed these notes – described the Volder Notebook as reflecting Dr. Volder’s early work on ePTFE grafts, documenting “many failures,” and having a “delightful and close correlation” with the Volder A-V Shunts Article which was a “publication of [the] same data.” Trial Tr., 11/30/07, at pp. 2595-96 (Sutton); Trial Tr., 12/07/07, at p. 3739 (Sutton).

1 75. Dr. Goldfarb asserted under oath in 1979 that Mr. Sutton had possession of the actual
2 Volder notebook in September 1974. DX3110. Mr. Sutton denies he had the
3 notebook before April 1977, when he claims to have received it from Dr. Volder in
4 confidence for safekeeping. DX3062; Trial Tr., 12/7/07, 3825 (Sutton). Mr. Sutton
5 did not advise the Patent Office of the existence of the Volder notebook before he
6 withdrew as Impra's counsel in February 1978.

7 76. On January 18, 1982, Dr. Goldfarb's attorney Mr. Cates sent a letter to Mr. Harold
8 Green noting that neither Impra, nor Mr. Sutton, had provided a copy of the Volder
9 Notebook and again asking for Impra, or Mr. Sutton, to provide the requested
10 materials. DX3060. On January 22, 1982, Mr. Sutton responded to Mr. Cates' letter
11 stating that he had received a copy of the Volder Notebook "under conditions of
12 confidentiality." DX 3062. Mr. Sutton also told Mr. Cates that the Volder notebook
13 contained "detailed, fully witnessed entries which evidenced Dr. Volder's work on
14 ePTFE structures dating back to the early 1970's" and that the contents of the
15 notebook was one of the factors that "precipitated Impra's decision to cease further
16 prosecution of the [Goldfarb] application." DX3062. Further, Mr. Sutton informed
17 Mr. Cates that he could not release his copy of the Volder Notebook "without Dr.
18 Volder's express consent" but that Mr. Cates was "free to contact Dr. Volder directly
19 and seek his permission" to obtain the Volder Notebook. Id. Mr. Cates did not tell
20 the Patent Office about the existence of the Volder notebook.

21 77. Mr. Sutton retired from the practice of law in the early 1990s. Trial Tr., 12/07/07, at
22 pp. 3822-23 (Sutton). In the course of winding up his legal practice between 1990
23 and 1995 Mr. Sutton had hundreds of boxes of files sent to a paper mill for recycling.
24 Id.; Trial Tr., 11/30/07, at p. 2627 (Sutton). The Volder Notebook in Mr. Sutton's
25 possession was likely included among these files. Trial Tr., 11/30/07, at pp. 2594-96
26 (Sutton); Trial Tr., 12/07/07, at p. 3825 (Sutton).

27 78. No one had requested the Volder Notebook from Mr. Sutton in over 15 years, and Dr.
28

1 Volder had not given him permission to release it. Trial Tr., 11/30/07, at pp. 2627-28
2 (Sutton). Gore's patent law expert, Mr. Bjorge, testified that as a matter of PTO
3 practice and procedure, a presumption has emerged that an invention is "abandoned,
4 suppressed or concealed," and thus is not prior art, if it is kept secret for "a period of
5 18 months to two years." Trial Tr., 12/04/07, at pp. 2954-55 (Bjorge). Mr. Thesz
6 agreed with Mr. Bjorge that the so-called Volder Notebook would "satisfy the patent
7 office definition of material that would be considered abandoned, suppressed or
8 concealed," and thus would not constitute prior art. Trial Tr., 12/05/07, at pp.
9 3311-12 (Thesz); Trial Tr., 12/12/07, at pp. 4261-62 (Thesz).

10 79. On August 26, 1996, immediately prior to Bard's acquisition of Impra, James Polese,
11 an attorney for Impra, wrote to Mr. Lawrence Green noting that he had been in touch
12 with Dr. Volder and asking if Mr. Green would like the Volder Notebook which Dr.
13 Volder had indicated he was "confident ... would confirm that Dr. Goldfarb is not the
14 inventor of the Goldfarb invention." DX 3864. At the time of writing his letter Mr.
15 Polese had never seen the Volder Notebook and had no knowledge of its contents or
16 its relevance to the Goldfarb Application. Trial Tr., 11/30/07, at p. 2640 (Polese).

17 80. Although Mr. Lawrence Green did not believe that Dr. Volder's claim of inventorship
18 was credible, because it was inconsistent with Peter Cooper's representations that "he
19 was quite familiar with all of the work of all of these doctors, including Dr. Volder,
20 and that none of these doctors had done anything inventive and that none of them had
21 made any contribution to his invention," he asked to see a copy of the Volder
22 Notebook. Trial Tr., 12/12/07, at p 4221 (L. Green). Accordingly, in October of
23 1996, Mr. Polese wrote to Dr. Volder requesting that Dr. Volder send his notebook
24 directly to Mr. Green, or to have Mr. Sutton or the "current holder" of the Volder
25 Notebook (or a copy) send a copy. DX3160; Trial Tr., 11/30/07, at pp. 2632-36;
26 2641-42 (Polese). Dr. Volder did not send the notebook do so and maintained the
27 confidentiality of the Volder Notebook. Trial Tr., 11/30/07, at pp. 2640-41 (Polese);
28

1 Trial Tr., 12/12/07, at pp. 4221-22 (L. Green).

2 81. Mr. Lawrence Green never told the Patent Office of Dr. Volder's claim and in 2001,
3 when the Goldfarb Application was returned to the patent examiner following the
4 resolution of the interference, Mr. Green testified he had forgotten about letter. Trial
5 Tr., 12/12/07, at p. 4219 (L. Green).

6 82. In September 1996, after Dr. Volder received payment from Bard for his shares of
7 Impra, Dr. Volder contacted Mr. Sutton and sought his aid in using the content of the
8 notebook he believed to be in Mr. Sutton's possession to "KO"¹ the Goldfarb patent.
9 DX3095. Mr. Sutton declined to assist Dr. Volder. DX3096.

10 83. Mr. Sutton was unable to produce the Volder notebook in this litigation. Mr. Sutton
11 testified that he destroyed the notebook during his retirement from law practice at or
12 about the time that C.R. Bard, Inc. ("Bard") agreed to acquire Impra's stock. Trial
13 Tr., 11/30/07, at pp. 2628-29 (Sutton); Trial Tr., 12/7/07, at p. 3823 (Sutton); Trial
14 Tr., 12/12/07, at pp. 4168-70 (Shrum).

15 **H. GOLDFARB SUES IMPRA**

16 84. On September 20, 1977, Dr. Goldfarb sued Impra (then the exclusive licensee of the
17 Goldfarb Application), and subsequently terminated Impra's license to the Goldfarb
18 Application in December 1977. Goldfarb v. Impra, No. C-3568330 (Ariz. Sup. Ct.,
19 Maricopa 1977) (PX3); Trial Tr., 11/07/07 at pp. 431-37 (Goldfarb). At that point in
20 time, Dr. Goldfarb's and Impra's interests in the Goldfarb Application diverged and
21 they became adverse to each other. Trial Tr., 12/12/07, at p. 4108 (Swenson). Dr.
22 Goldfarb confirmed that the relationship between he and Impra deteriorated following
23 the lawsuit and that "[t]here was no relationship. Basically a very bad one," between
24 he and Impra, and that "what IMPRA [was] trying to do is undermine my patent
25 application with me as the inventor." Trial Tr., 11/07/07, at pp. 437, 440 (Goldfarb).

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27 ¹ "KO" is an abbreviation for "knock out."
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- 1 85. Because Mr. Sutton was Impra's attorney and "appeared to be involved in the efforts
2 to make things very difficult for me to pursue the patent prosecution," (Id. at p. 439),
3 Dr. Goldfarb revoked Mr. Sutton's power of attorney to prosecute the Goldfarb
4 Application on January 6, 1978, and granted power of attorney to Mr. Charles Cates
5 in his place. PX115T. Mr. Sutton signed his withdrawal as Dr. Goldfarb's counsel
6 before the PTO on February 21, 1978. PX115.582. Mr. Sutton's involvement in the
7 prosecution of the Goldfarb Application effectively ceased in January when his power
8 of attorney was revoked by Dr. Goldfarb. Trial Tr., 12/12/07, at pp. 4248-50 (Thesz).
9 The relationship between Mr. Cates and Mr. Sutton was neither cooperative nor
10 amicable and they did not collaborate on the prosecution of the Goldfarb Application.
11 Trial Tr., 12/07/07, at pp. 3877, 3886 (Sutton).
- 12 86. Testimony during depositions in the Goldfarb v. Impra litigation established that, as
13 of that time, Dr. Volder was still asserting his claim of inventorship. Trial Tr.,
14 11/27/07, at pp. 1977-78 (Baker).
- 15 87. Interrogatory responses by Impra in that case established Dr. Volder's claim of
16 inventorship, the existence of Dr. Volder's notebook and Impra's belief in Dr.
17 Volder's claim. DX3051.
- 18 88. Dr. Goldfarb and Impra settled their lawsuit in 1979, and in an assignment dated May
19 21, 1979, Impra assigned to Dr. Goldfarb all rights in the Goldfarb Application.
20 DX3475. Subsequent to the settlement of the Goldfarb v Impra lawsuit, Mr. Cates
21 wrote a letter to Dr. Goldfarb's Australian patent counsel summarizing his
22 understanding of the various allegations made by Impra in the Baker and Harold
23 Green deposition testimony and the interrogatory responses provided in that lawsuit.
24 DX3481. In that letter, Mr. Cates noted:
- 25 From these documents, the evasiveness and lack of candor of IMPRA
26 and the deponents emerges clearly. The witnesses' motivations should
27 also be clear: They are heavily interested in IMPRA which is a
28 company that makes essentially one product, and the assignment of the

1 patents and patent applications covering that product was cancelled.
2 They are highly motivated to detract as much as they can from Dr.
3 Goldfarb's patent position.

4 Id. at p. IVG6083138.

5 **I. VERMEIRE LETTER AND GOLDFARB'S DUTY TO THE PTO**

6 89. On February 21, 1978, in conjunction with Dr. Goldfarb assuming responsibility for
7 prosecution of the Goldfarb Application, Mr. Albert A. Vermeire, Impira's litigation
8 counsel in the Goldfarb v. Impira suit, sent all prosecution files to Mr. Swenson, Dr.
9 Goldfarb's litigation counsel. DX3055.

10 90. The Vermeire letter referred to Mr. Detton's repudiation of both of his affidavits. The
11 letter stated, "Mr. Detton has indicated to various persons, including Dr. Goldfarb,
12 that he wishes to repudiate portions of his affidavits." DX3055 at p. G-11106.

13 91. The Vermeire letter also stated that Impira had decided to file "expanded or correct
14 affidavits from Messrs. Baker, Detton, Goldfarb, Green and Volder." As to Dr.
15 Baker, Impira's attorney wrote: "Dr. Baker has indicated that certain statements in his
16 affidavit relating to the criticality of wall thickness, although correct when made, are
17 misleading if not totally incorrect in view of later information which has been
18 developed on wall thickness." DX3055 at p. G-11106.

19 92. In addition, the Vermeire letter stated that "the Matsumoto article as finally published
20 includes reference to wall thicknesses of 0.5 mm, which is within the range of wall
21 thicknesses claimed by IMPRA." DX3055 at p. G-11106. Mr. Vermeire stated that:
22 "it seems appropriate to at least clear the record on this point by advising the examiner
23 regarding the wall thickness reference in the later published Matsumoto reference."
24 DX3055 at p. G-11106.

25 93. The Vermeire letter further stated that "[t]here appears to be a substantial claim to
26 prior or concurrent inventorship by Dr. Volder. This is evidenced by certain entries
27 in his log-book which purport to have been dated and witnessed in 1971." DX3055
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1 at p. G-11105.

2 94. The Vermeire letter concluded with a statement of the duty of disclosure to the Patent
3 Office: “it is our strongest recommendation that the various Patent Offices be fully
4 informed regarding the matters set forth above since failure to do so may irreversibly
5 affect the validity or enforceability of any patent rights which IMPRA may ultimately
6 obtain.” DX3055 at p. G-11107.

7 95. Dr. Goldfarb acknowledges that he was aware of the Vermeire letter and its
8 allegations, as was his attorney, Mr. Cates, and as was Mr. Sutton. Trial Tr., 11/7/07,
9 438-439, 561-562 (Goldfarb); Trial Tr., 11/30/07, 2619-2620 (Sutton); Trial Tr.,
10 12/7/07, 3885 (Sutton); Trial Tr., 12/12/07, 4109 (Swenson); PX1236.

11 96. Mr. Vermiere’s letter did not provide any details or evidence to support these
12 allegations. Mr. Harold Green testified that this letter, and other disclosures provided
13 by Impra in connection with the Goldfarb v. Impra litigation, were part of an effort
14 by Impra to “torpedo” the Goldfarb Application in order to avoid potential litigation
15 in the future. Trial Tr., 11/27/07, 2001 (H. Green); Trial Tr., 11/07/07, at p. 440
16 (Goldfarb).

17 97. Dr. Baker, the largest shareholder of Impra, with approximately 25 percent of the
18 shares, as well as an officer of Impra and chairman of its board, was deposed the day
19 after the date on the Vermiere letter (*i.e.*, February 22, 1978) in the Goldfarb v. Impra
20 litigation. Trial Tr., 11/27/07, at pp. 1975-76 (Baker). During his deposition Dr.
21 Baker stated that there were several claims to inventorship of the Goldfarb
22 Application, including those of Dr. Volder, Dr. Campbell, Mr. Harold Green and Mr.
23 Detton, but that Dr. Goldfarb had been “elected” inventor at the September 9, 1974
24 meeting. Id. at p. 1977. Dr. Baker, however, admitted that he had no personal
25 knowledge of anyone with a claim of inventorship to the Goldfarb Application other
26 than Dr. Goldfarb, and that he was not present at the September 9, 1974 meeting when
27 the so-called “election” occurred. Id. Dr. Baker also never testified that he believed
28

1 that the determination of inventorship was false, or that there was a purposeful
2 misstatement of inventorship. Id. at pp. 1977, 1982-83.

3 98. Following receipt of Mr. Vermiere's February 21, 1978 letter, Mr. Swenson wrote to
4 Mr. Vermiere on March 10, 1978, noting that "[t]he opinions now expressed by your
5 principals in this obtuse fashion are highly suspect, coming as they do from biased
6 parties to a lawsuit." PX1233; Trial Tr., 11/07/07, at pp. 442-45 (Goldfarb). In his
7 letter, Mr. Swenson asked Imprā: "[I]f you have facts to support your self-serving
8 opinions and innuendos, please make them known to us." PX1233 at p. PX1233.2
9 (emphasis original). In particular, Mr. Swenson asked for Imprā to "send a copy of
10 the Volder notes" so that they could "draw our own conclusions." Id. at p. PX1233.1.
11 As Dr. Goldfarb explained, this letter was the start of a series of attempts "to get from
12 IMPRA or Dr. Volder or both the objective evidence from them to support their
13 allegations." Trial Tr., 11/07/07, at pp. 447-49 (Goldfarb). However, Dr. Goldfarb
14 and his attorneys were never able to get a clear understanding of Imprā's allegations.
15 Id. at p. 449.

16 99. On July 19, 1978, having received no response from Mr. Vermeire, Mr. Cates sent a
17 letter to Mr. Sutton requesting copies of the Volder Notebook. PX1236; Trial Tr.,
18 11/07/07, at pp. 446-48 (Goldfarb). In his letter, Mr. Cates stated that if the Volder
19 Notebook was indeed "confidential" and undisclosed, then it would not qualify as
20 invalidating prior art. PX1236. Mr. Cates' letter also requested that Mr. Sutton
21 provide "candid and unequivocal answers" to the questions relating to the Baker,
22 Green, Detton and Volder affidavits, and Dr. Volder's claim to prior or concurrent
23 inventorship, raised in Mr. Vermiere's letter. Id. Mr. Cates never received any
24 substantive response to this letter. Trial Tr., 11/07/07, at p. 452 (Goldfarb). Mr.
25 Sutton responded by saying that he could not provide any answers because he had not
26 received the earlier letters between Mr. Vermeire and Mr. Swenson. Id.; PX1237.

27 100. On April 9, 1979, Mr. Cates sent a letter directly to Dr. Volder in the Netherlands
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1 requesting that Dr. Volder “waive confidentiality of [the Volder Notebook] and
2 permit Mr. Sutton to let us make copies and inspect the original.” DX3058; Trial Tr.,
3 11/07/07, at pp. 455-57 (Goldfarb). Neither Dr. Goldfarb nor his attorneys received
4 a reply to this letter from Dr. Volder. Trial Tr., 11/07/07, at p. 456 (Goldfarb). On
5 June 27, 1979, Mr. Sutton wrote to Mr. Cates directing him to “terminate all further
6 direct communications with Dr. Volder,” and to contact Mr. Sutton if he wished to
7 pursue further the matter of the Volder Notebook. PX1307; Trial Tr., 11/07/07, at pp.
8 456-58 (Goldfarb). Mr. Sutton re-emphasized that he had “received Dr. Volder’s
9 logbook in confidence.” PX1307.

10 **J. CONTINUED EXAMINATION BY THE PTO**

11 101. On September 23, 1980, Dr. Goldfarb licensed his rights in the Goldfarb Application
12 to Bard (*i.e.* C.R. Bard). Trial Tr., 11/7/07, 461-462 (Goldfarb); PX4. On June 24,
13 1981, Mr. Arthur Bookstein, a patent attorney representing Bard, was appointed as an
14 additional attorney in the Goldfarb patent application. PX.115.606. Mr. Bookstein
15 assumed the lead responsibility for the prosecution of the Goldfarb Application and
16 Mr. Cates’ involvement in the prosecution of the Goldfarb Application thereafter was
17 “zero.” Trial Tr., 12/12/07, at p. 4252 (L. Green); Trial Tr., 12/12/07, at pp. 4251-52
18 (Thesz). As with Mr. Cates, Mr. Bookstein, never met with Impra’s lawyer, Mr.
19 Sutton, while Impra was adverse to Dr. Goldfarb. Trial Tr., 12/07/07, at p. 3794
20 (Bookstein).

21 102. On July 16, 1979, Mr. Cates, acting as Dr. Goldfarb’s attorney, filed in the Patent
22 Office a “Motion to Return File to Examiner for Determination of Patentability
23 Issues,” disclosing the existence of the Goldfarb v. Impra litigation and requesting
24 that the Goldfarb Application be returned to the Examiner for continued prosecution.
25 PX115U at p. 115.585. In disclosing the existence of the Goldfarb v. Impra litigation,
26 Mr. Cates specifically noted that “the record of [the lawsuit] is available to the Patent
27 and Trademark Office” and that the “[a]pplicant desires that the record of those
28

proceedings along with the records of the Gore case (in Federal District Court) and Cooper case (in Arizona State Court), both previously referred to in this application file, be made available to the Commission for consideration.” Id.

103. On December 11, 1979, the Assistant Commissioner for Patents granted Dr. Goldfarb’s motion to return the file to the Patent Office Examiner, PX115V, and stated that “[Goldfarb] and his attorney [were] required to submit portions of the record, including depositions, pleadings, etc. in connection with the [Goldfarb v. Impra] litigation, and any other information that they were aware of which was material to the examination of the application.” PX115 at p. 115.593.

104. In the time between the December 11, 1979 Order of the Assistant Commissioner (PX115V), which required production of material from the Goldfarb v. Impra case, and the July 8, 1981 decision (PX115W), neither Dr. Goldfarb nor his attorney submitted the requested documentation from the Goldfarb v. Impra case. Trial Tr., 12/11/07, 3954, 4058-4060, 4061 (Bjorge).

105. PTO Examiner William Pieprz mailed the second Office Action twice: once on April 29, 1981 and again on July 8, 1981. PX115W. Examiner Pieprz – who also assumed responsibility for the Cooper Application (PX117.3699-714) – determined that “the record developed in this application, taken as a whole totally and fully supports the conclusion that Dr. Goldfarb is properly named as the inventor of this application,” thus withdrawing the November 1975 rejection of Goldfarb’s claims 1 to 10. PX115W at p. 115.603.

106. In that second Office Action relating to the Goldfarb Application, Examiner Pieprz withdrew his prior rejection of the claims over the Soyer, Volder A-V Shunts and Matsumoto III articles without explanation and instead rejected claims 1-6 as obvious over an article by Dr. Campbell, “Expanded Polytetrafluoro-Ethylene as a Small Artery Substitute,” dated 1974 (the “Campbell Article”). PX115.2589-93. Consistent with PTO practice and procedure, the examiner treated the Campbell article as prior

- 1 art to the Goldfarb Application, even though it was dated 1974, and the burden was
2 placed on Dr. Goldfarb to “go find the information and argue about whether it was a
3 proper – proper prior art reference or not.” Trial Tr., 12/12/07, at p. 3286 (Thesz).
- 4 107. Mr. Bookstein responded to Examiner Pieprz’s Office Action on December 10, 1981,
5 arguing that the Campbell Article was not prior art because it was not published until
6 January 1975. PX115X at pp. 115.609-14. In addition, although noting that he had
7 “some reasons to believe that the examiner already may be aware of this document
8 because it may have been filed in connection with the ‘Cooper Application’,” Mr.
9 Bookstein submitted a copy a the February 5, 1980 Detton Affidavit that he had
10 obtained from the Australian Patent Office. PX115X; PX116GGG at p. PX116.3718.
11 In submitting the 1980 Detton Affidavit, Mr. Bookstein noted that “applicant submits
12 it without vouching in any way for the authenticity of the document or for anything
13 else concerning the document or any subject matter stated or suggested therein,” and
14 further noted that the 1980 Detton Affidavit “does not appear to seek to contradict or
15 vary the Second Detton affidavit or the Green affidavit” PX115X at p.
16 PX115.611.
- 17 108. Mr. Bookstein further disclosed to the PTO that there were deposition transcripts from
18 the Gore v. Impra, Goldfarb v. Impra, and Goldfarb v. Gore litigations that were
19 “potentially relevant” to the Goldfarb Application. PX115X at pp. 115.611-13.
20 Noting that it was “applicant’s understanding that the examiner may have obtained
21 and reviewed numerous volumes of deposition transcripts” already, Mr. Bookstein
22 identified three lists of deposition transcripts in order “to confirm that the examiner
23 has had an opportunity to review all potentially relevant deposition transcripts.” Id.
24 at p. 115.611.
- 25 109. One list identified those transcripts from the Gore v. Impra litigation that were filed
26 under seal which “it is believed that the examiner already may have reviewed ... and,
27 therefore, it is unnecessary for applicant to make further efforts to duplicate them for
28

the examiner.” PX115X at p. 115.612. A second list identified those transcripts which were not under seal and which were available to the examiner “although applicant’s undersigned counsel does not consider them to be particularly relevant or a variance with any conclusion which the examiner has come to.” PX115X at p. 115.613. This second list included the November 1978 Dr. Baker deposition and the November 1978 Harold Green deposition, which had already been provided to Examiner Pieprz in the Cooper Application. PX117.2992-3054; PX117.3544-630.

110. On May 18, 1982, Examiner Pieprz issued his third Office Action pertaining to the Goldfarb Application, in which he maintained his prior rejection over the Campbell Article based on his understanding that the substance of the article was presented orally in April 1974. PX115Y. Examiner Pieprz also stated his reliance on Mr. Bookstein’s representations concerning the depositions in the Goldfarb v. Impra litigation. He stated as follows:

- Even though Mr. Bookstein had just provided the 1980 Detton Affidavit, it had “been considered in formulation of the prior Office Action” and that it “is not considered to have any effect on the status of [the Goldfarb Application]”;
- He had reviewed all but two of the Gore v. Impra deposition transcripts, but did not need copies of these documents because they would not “yield any significant new, information relevant to the [Goldfarb Application]”; and,
- He had not reviewed “most” of the Goldfarb v. Impra and Goldfarb v. Gore deposition transcripts and would accept Mr. Bookstein’s representation regarding their relevance “at face value.”
- Mr. Bookstein, as counsel for the applicant, is the “final arbiter” of what documents from the Goldfarb v. Impra litigation must be submitted to the Patent and Trademark Office “in satisfaction of his ‘duty to disclose.’”

PX115Y at pp. PX115.640-41.

111. Examiner Pieprz had, however, reviewed the 1978 deposition transcripts of Mr.

Harold Green and Dr. Baker from the Goldfarb v. Impra litigation in connection with the Cooper Application. PX117.2992-3052; PX117.3055-283.

112. A telephonic interview was held on May 27, 1982, during which Mr. Bookstein argued that the Campbell Article was not prior art because Dr. Goldfarb invented the subject matter of the Goldfarb Application prior to the April 1974 disclosure. PX115.642. As support, Mr. Bookstein relied on the Second Detton Affidavit and the 1976 Green Affidavit. PX115O.

113. On August 27, 1982, Examiner Pieprz withdrew his previous rejections and accepted Mr. Bookstein's argument. The prior rejection over the Campbell article was withdrawn due to the Detton Affidavits and the 1976 Green Affidavit, which "makes clear that applicant had already invented the claimed subject matter prior to the date of the above noted oral presentation." PX115DD at p. 115.692.

K. COOPER PATENT APPLICATION

114. On April 2, 1974, Gore filed a patent application entitled "Artificial Vascular Prostheses" naming Peter Cooper as the sole inventor ("the Cooper Application"). PX117.5-18. Just before such filing, on March 27, 1974, Mr. Cooper assigned all interest in the Cooper Application to Gore. PX117.20-21.

115. The Cooper Application was initially assigned to Examiner Frinks - the same examiner originally assigned to the Goldfarb Application.

116. In July 1975, Gore filed a Petition to Withdraw From Issuance under the provisions of 35 C.F.R. § 1.313. PX117.110-16. The basis for the motion was that allegations in the Gore v. Impra litigation raised questions as to whether Mr. Cooper and Gore had committed fraud in filing the Cooper Application and, in particular, whether the Cooper Application "plagiarized its working examples from a memorandum which described the work of Dr. David Goldfarb and that all of the working examples in the application were, in fact, based on the work of Dr. David Goldfarb and not the work of [Mr. Cooper]." Id. at p. PX117.114.

1 117. The PTO granted the petition to withdraw the Cooper Application on July 29, 1975,
2 before Examiner Frinks had issued any Office Action in the Goldfarb Application.
3 Id. at p. PX117.118. On November 26, 1975 – the same day the first Office Action
4 in the Goldfarb Application was mailed – Examiner Frinks issued an Office Action
5 in the Cooper Application rejecting all pending claims under 35 U.S.C. § 102(f) on
6 the grounds that Mr. Cooper was “not in fact the proper inventor,” and further in view
7 of the Matsumoto III Article or, in the alternative, the Volder A-V Shunts Article. Id.
8 at pp. PX117.119-23. With respect to the Volder A-V Shunts Article, Examiner
9 Frinks specifically noted that it disclosed “increasing pore size (which is directly
10 related to fibril length) beyond 5 microns.” PX117.121.

11 118. On March 4, 1977, the Office of Assistant Commissioner mailed a “Requirement for
12 Information” to Mr. Finnegan acknowledging that there “were substantial questions
13 ... regarding the present [Cooper] application and its inventorship,” and that Gore had
14 failed to fully set forth the details regarding the charges of fraud on the Patent Office
15 raised in the Gore v. Impra litigation. Id. at pp. PX117.187-12. Mr. Finnegan
16 responded to the Requirement for Information on October 4, 1977, by submitting an
17 affidavit and declaration of inventorship from Mr. Cooper, responses to questions
18 from Mr. Uebler, and various papers from the Gore v. Impra litigation including the
19 deposition transcripts of Mr. Harold Green and Dr. Lenox Baker. Id. at pp.
20 PX117.226-34. Through these papers Mr. Finnegan asserted the following:

- 21 - Mr. Cooper still considered himself to be “the original, first, and sole inventor
22 of the subject matter claimed in this application.” Id. at p. PX117.2068.
- 23 - The 1974 Detton Memorandum was used in the preparation of the Cooper
24 Application and the original claims, but that such use was proper because Mr.
25 Cooper’s invention allegedly pre-dated any disclosure by Dr. Goldfarb to
26 Gore. PX117F at pp. PX117.2069-76.
- 27 - “With respect to the surgeons [Mr. Cooper], as Plant Manager of the Gore
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Flagstaff facility, was generally responsible for manufacturing and supplying the surgeons with expanded PTFE vascular grafts for evaluation purposes. ... [Mr. Cooper] worked closely with the surgeons, supplied them with Gore vascular grafts having different structures for implantation and eventual harvesting, and reviewed the experimental results. [Mr. Cooper] participated in many personal and telephone conferences with these surgeons, either directly or through liaison personnel at Gore.” Id. at p. PX117.2079.

- Dr. Volder had “questioned whether Peter B. Cooper was the inventor. [Mr. Uebler] thereupon conducted an additional search to develop any further documents that might be relevant to the question of inventorship and discussed this matter with W.L. Gore. It was again concluded that Peter B. Cooper was the inventor.” Id. at p. PX117.2111.

- That the Soyer and Volder A-V Shunts Articles were “irrelevant” to the Cooper Application (id. at p. PX117.2114) because “pore size” as used in those articles “bears no relationship to fibril length” (id.) as demonstrated by the Affidavit of Wilbert L. Gore, which established that: “[t]he measurement ‘pore size,’ as used in the Soyer, et al., article, is not the same as fibril length, as used in the Cooper Application, which is defined as the spacing or distance between the nodes or the internodular distance.” PX117.2127-37 at p. 117.2133.

119. The Assistant Commissioner issued a second Request for Information on March 10, 1978 seeking information as to why Dr. Kelly was not a named inventor and as to whether the Cooper Application was unpatentable over certain Matsumoto articles.²

² In response to the November 26, 1975 Office Action, Gore employee Ernest A. Uebler had disclosed two articles by Matsumoto - Matsumoto, et al., “Application of Porous Polytetrafluoroethylene to Artificial Blood Vessel, First Report: Application to the Peripheral Artery,” Artificial Organs, 1972 (“the Matsumoto I Article”) and Matsumoto, et

PX117.2819-27. Albert J. Santorelli, who had assumed primary responsibility for the Cooper Application from Mr. Finnegan, responded by arguing that Dr. Kelly was not an inventor because he had not recognized that fibril length (which was key to tissue ingrowth) was the key parameter of a successful ePTFE graft, and that the Matsumoto III Article did not render the Cooper Application unpatentable because it “is not understood ... as disclosing the criticality of fibril length with respect to tissue ingrowth.” PX117.2831-.53 at p. PX117.2840.

120. Mr. Santorelli also submitted a number of papers entitled “Applicant’s Position with Respect to Inventorship and the Rule 131 Affidavit.” In the first paper, Mr. Santorelli disclosed the existence of the Goldfarb v. Impra lawsuit and quoted from Impra’s brief opposing Dr. Goldfarb’s request to unseal the deposition transcripts (for purposes of submitting them to the PTO) in which Impra argued that: “it has recently been testified to by Mr. [Harold] Green and Dr. Lenox Baker that there now exists information which may wholly invalidate the patent application and render certain statements contained in the depositions of Mr. Cooper and Mr. Detton completely stale and misleading.” PX117 at p. 117.3669.

121. In a “First Supplement” to this paper Mr. Santorelli submitted copies of Mr. Harold Green’s and Dr. Baker’s deposition transcripts and exhibits from the Goldfarb v. Impra litigation and specifically noted that: “[i]t is evident from these depositions that IMPRA, formerly assignee of the Goldfarb Application and responsible for the prosecution of that application now (1) repudiates its previous allegation that Dr. Goldfarb is the inventor of the subject matter of the Cooper application; and (2) doubts the veracity of affidavits filed by IMPRA in the Goldfarb Application”

al., “Experimental Studies on Expanded Polytetrafluoroethylene As Vascular Prosthesis - The Second Report: Its Applicability To Veins,” Artificial Organs, 1973 (“the Matsumoto II Article”) - and asserted that the Cooper Application was unpatentable in view of their disclosures. PX117.127-33.

1 PX117.2990-91.

2 122. On March 18, 1980, Mr. Santorelli submitted a “Second Supplement” which was
3 received by Examiner Pieprz – the same patent examiner responsible for the Goldfarb
4 Application. PX117.3644-51. The Second Supplement attached the 1980 Detton
5 Affidavit with both of its attachments (PX117.3675-82) and asserted that: “In light
6 of the recent deposition testimony of Green and Baker and the February 5, 1980
7 affidavit of Detton, their affidavits submitted in the Goldfarb application and the
8 deposition testimony of Detton and Green in the [Gore v. Impira] trade secret litigation
9 cannot possibly be relied on to support a determination that proper inventorship in this
10 case lies solely or jointly in Goldfarb. On the contrary, the record shows that Cooper
11 is the inventor.” PX117.3649.

12 123. On December 11, 1979, the Assistant Commissioner returned both the Goldfarb and
13 Cooper Applications to the Primary Examiner with directions to determine who the
14 proper inventor was and whether there were any grounds to reject the pending claims.
15 PX115V; PX117.3631-43.

16 124. In an Office Action dated March 10, 1981, Examiner Pieprz addressed the various
17 contributions of the persons identified by the Assistant Commissioner and concluded
18 that Dr. Campbell was “a sole inventor rather than a joint inventor with Peter
19 Cooper.” PX117E at p. PX117.3712. With respect to Mr. Detton’s contribution,
20 Examiner Pieprz expressly noted:

21 Incidentally, a deposition by Detton in the Gore v. IMPRA lawsuit
22 contained statements to the effect that Dr. D. Goldfarb defined the
23 successful graft structure. These statements have since been retracted
by Mr. Detton in an affidavit dated February 5, 1980.

24 PX117E at p. 117.3701. Examiner Pieprz further rejected the pending claims under
25 35 U.S.C. § 103 based, *inter alia*, on his conclusion that the Matsumoto III Article
26 had a “photograph [that] appears to show fibril lengths within this preferred range.”
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PX117E at p. 117.3713.

125. On March 17, 1981, Mr. Santorelli responded to Examiner Pieprz's Office Action, objecting to the determination that Dr. Campbell was the sole inventor because Mr. Cooper purportedly invented the subject matter of the Cooper Application before Dr. Campbell started working with Gore's ePTFE grafts. PX117.3719-40. Mr. Santorelli further argued that the Matsumoto III Article did not render the Cooper Application obvious because it contains "absolutely no reference to the term fibril length or distance between nodes. It is unreasonable to hold that a reference that doesn't even mention fibril length makes obvious an invention that specifically equates fibril length to tissue ingrowth and discloses specific ranges for fibril length." PX117.3739.

126. In an interview held on March 29, 1982, between Examiner Pieprz and Messrs. Cooper, W.L. Gore, Campbell and Santorelli, Mr. Santorelli again argued that the Matsumoto III Article "does not even mention fibril length, let alone teach the criticality of this parameter in connection with the promotion of tissue ingrowth." PX117C at p. PX117.3798. Based on these arguments, Examiner Pieprz found the Cooper Application allowable over the Matsumoto III Article concluding that: "The references, alone or combined, do not evidence attachment of any criticality to the fibril length range of the expanded PTFE. Thus not recognizing the relationship between fibril length and tissue ingrowth, the references cannot render the instant claims unpatentable." PX117D at p. 117.3807. Prosecution on the merits was closed and the Cooper Application was referred to the Assistant Commissioner for further consideration regarding the question of inequitable conduct by Mr. Cooper. PX117D at p. 117.3807.

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II. THE *INTER PARTES* INTERFERENCE³

127. On May 18, 1983, Examiner Pieprz mailed a communication to Mr. Bookstein suggesting that the following claim, found allowable, be adopted for the purpose of interference:

An artificial vascular prosthesis comprising expanded, porous, polytetraflouroethylene having a microstructure consisting of nodes interconnected by fibrils which permits tissue ingrowth, wherein said fibrils are above about 5 microns in length.

PX 115J. Notably, the PTO determined that the invention described in Dr. Goldfarb's patent application included allowable claims for an ePTFE vascular prosthesis without wall thickness or density limitations. *Id.* Mr. Bookstein amended the Goldfarb Application on July 1, 1983, to add the claim suggested by Examiner Pieprz. PX115.695-98.

128. On September 19, 1983, the PTO Board of Patent Appeals and Interferences declared an interference between the Goldfarb Application and the Cooper Application, assigning it Interference No. 101,100 ("the Interference"). PX115GG. Dr. Goldfarb, as the later filing party, was designated the "Junior Party," with Mr. Cooper designated the "Senior Party." The initial count of the Interference was identical to the claim that Examiner Pieprz had suggested Mr. Bookstein copy into the Goldfarb Application to initiate the interference.

A. PARTIES MOVE TO DISPOSE OF THE INTERFERENCE

129. On April 30, 1984, both Mr. Santorelli and Mr. Bookstein filed and served various preliminary motions pursuant to 37 C.F.R. § 1.231 which sought to dispose of the Interference.

³ An "interference" is "a proceeding instituted for the purpose of determining the question of priority of invention between two or more parties claiming substantially the same patentable invention. . . ." 37 C.F.R. § 1.201(a) (1984).

1 **1. COOPER’S MOTION TO DISSOLVE**

2 130. Mr. Cooper filed a Motion Under 37 C.F.R. § 1.231 To Dissolve the Interference
3 based on the allegation that Dr. Goldfarb had committed inequitable conduct by: (i)
4 filing the Detton Affidavits even through Mr. Sutton allegedly knew they were not
5 correct; and (ii) withholding from the PTO the 1978 deposition testimony of Mr.
6 Harold Green and Dr. Baker that raised questions regarding their 1976 affidavits.
7 PX116.2448-65. Attached to Mr. Cooper’s motion were the previously-submitted
8 1980 Detton Affidavit and relevant excerpts from Harold Green’s and Dr. Baker’s
9 1978 deposition testimony. PX116.2552-59; PX116.2561-93; PX116.2595-613.

10 131. Mr. Bookstein personally prepared the response to Mr. Cooper’s Motion to Dissolve.
11 Trial Tr., 12/12/07, at p. 4187 (L. Green). In his opposition to Mr. Cooper’s Motion
12 to Dissolve Mr. Bookstein made four basic arguments refuting Gore’s allegations of
13 inequitable conduct. The four arguments he made are as follows:

14 a. Both the 1976 Detton Affidavits were filed in the belief that they were correct;
15 Mr. Cooper had failed to indicate how either affidavit was materially incorrect;
16 the affidavits were independently supported by Mr. Detton’s sworn testimony
17 in the Gore v. Impra litigation (which he did not repudiate) as corroborated by
18 the testimony of Harold Green and Richard Mendenhall; and Goldfarb had
19 submitted the 1980 Detton Affidavit which Examiner Pieprz had concluded
20 “was of no effect on the Goldfarb application.”

21 b. The deposition testimony of Harold Green and Dr. Baker did not repudiate
22 their respective affidavits in any material respect, nor did they raise any serious
23 questions concerning Dr. Goldfarb’s inventorship; Harold Green never
24 withdrew the 1976 Green Affidavit; any repudiation by Detton was immaterial
25 as Mr. Green had independently verified Dr. Goldfarb’s specifications; Dr.
26 Baker never contradicted his 1976 affidavit because he never stated that a wall
27 thickness of 0.5 mm was critical, merely that it was optimal; and Dr. Baker’s
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other testimony concerning Dr. Goldfarb's inventive contribution was based on a lack of personal knowledge and mere speculation.

c. The Examiner had been made aware of, and had read the 1978 deposition transcripts of Harold Green and Dr. Baker, and the Examiner had still found Dr. Goldfarb to be the sole inventor after having considered such testimony thereby indicating that it was not material.

d. Dr. Goldfarb did not withhold affidavit retractions claimed to have occurred during the Green and Baker depositions, and made no misrepresentations concerning the scope of the deposition testimony but made good faith efforts, in consultation with the Examiner and in accordance with the Examiner's directions, to avoid duplicate submissions of voluminous deposition transcripts that the Examiner already had available to him in the Cooper Application. PX116GGG.

132. Further, with respect to the 1980 Detton Affidavit, Mr. Bookstein also argued that it "refers back and relates only to the [Detton-Cooper Source Affidavit]" and that "the 1980 affidavit cannot and should not be considered as being intended to include the [Second Detton Affidavit]." PX116GGG at p. PX116.3719. Both Mr. Bjorge and Mr. Thesz agreed that after reading the 1980 Detton Affidavit a reasonable examiner could conclude that Mr. Detton had misgivings about one of his 1976 affidavits. Trial Tr., 12/04/07, at p. 2936 (Bjorge); Trial Tr., 12/12/07, at p. 4273 (Thesz).

2. GOLDFARB'S MOTION TO DISSOLVE, AMEND, SUBSTITUTE COUNTS, OR STRIKE

133. Mr. Bookstein also filed a preliminary motion to dissolve the Interference (PX116J), arguing that it was unpatentable in light of, *inter alia*: (i) the Matsumoto I Article which he asserted, based on the declaration of Dr. Fredrick Schoen, disclosed a node and fibril microstructure in Figure 1 exhibiting tissue ingrowth with an internodal distance in the "order of 50 microns" (PX116J at pp. PX116.3010-15); (ii) a

1 photomicrograph in the Matsumoto II Article with a ten micron dimensional scale (Id.
2 at p. PX116.3025); (iii) the Soyer Article, which Mr. Bookstein argued disclosed a
3 range of “pore sizes” between .5 and 2.5 microns, and that one of skill in the art
4 would have understood “pore size” to be synonymous with fibril length (id. at pp.
5 PX116.3015-24); and (iv) the Volder A-V Shunts Article which Mr. Bookstein argued
6 disclosed an ePTFE vascular graft with a “pore size” within the claimed range (Id. at
7 pp. PX116.3026-28.)

8 134. Mr. Santorelli opposed Goldfarb’s Motion to Dissolve (PX116AAA) arguing that
9 Matsumoto II was not prior art because it was published in October 1973 (the same
10 time as the Matsumoto III Article), and that Matsumoto I was not anticipatory because
11 it “does not even mention fibrils or fibril length and is silent as to any significance of
12 fibril length, does not in any way teach that tissue ingrowth is functionally related to
13 fibril length, [and] does not describe the fibrils or the fibril length of the graft sections
14 depicted” PX116AAA at p. PX116.3819. With respect to the Soyer and Volder
15 A-V Shunts Articles, Mr. Santorelli argued that the term “pore size” used in those
16 articles does not have, and would not be understood by one of skill in the art to have,
17 the same meaning as “fibril length” or “internodular distance” (PX116AAA at pp.
18 PX116.3831-.3834 and PX116.3838-40) and submitted the declaration of Carleton
19 Angelo Sperati, M.D., in support. PX116.3885-94.

20 135. In the alternative to dissolving the Interference, Mr. Bookstein moved to substitute or
21 add new counts to the Interference, which included an upper limit for fibril length and
22 ranges for wall thickness and density that Mr. Bookstein argued was not disclosed or
23 suggested in the prior art. PX116VV. In particular, with regard to the Matsumoto III
24 Article, Mr. Bookstein noted that it “discloses on page 519 the inside and outside
25 diameters of a graft from which one may calculate that the particular wall thickness
26 was .5 mm,” but otherwise failed to “teach any specific criticality attaching to the wall
27 thickness,” failed to “suggest that any particular importance is to be applied to
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internodal distance (fibril length) or that a range of fibril lengths is critical,” and failed to teach “that the combination of wall thickness and fibril length is an important characteristic.” PX116VV at p. PX116.2676.

136. Mr. Santorelli opposed the Motion to Amend by arguing that “the present count or the contingent count is broader than either count proposed by Goldfarb, [and thus] substitution of Goldfarb’s proposed counts would be improper,” because “[a]n interference should always be determined on the broadest count which is available.” PX116.3794-95. Mr. Santorelli further argued that Dr. Goldfarb had admitted that the Matsumoto III Article was prior art to the Goldfarb Application which disclosed a wall thickness of 0.5 mm (within the claimed range of Dr. Goldfarb’s proposed count), and that wall thickness was not a critical or patentably distinct limitation. PX116.3797-98. In the alternative, Mr. Santorelli filed a contingent motion to substitute count 2 by adding an upper limit of 100 microns to the fibril length. PX116.3945-47.

137. Mr. Bookstein also moved to strike the Cooper Application based on inequitable conduct in deriving the Cooper Application from the 1974 Detton Memorandum which was itself based, in part, on the results of Dr. Goldfarb’s work. PX116.2721-25. Mr. Santorelli opposed the Motion to Strike on the grounds that the Patent Interference Examiner did not have authority to consider such a motion because it related to the question of derivation, over which the Board of Patent Appeals and Interferences had exclusive jurisdiction. PX116.3948-56.

B. PTO DETERMINATION

138. Patent Interference Examiner Michael Sofocleous preliminarily evaluated the motions made by Mr. Cooper and Dr. Goldfarb in an order dated February 1, 1985, dismissing Mr. Cooper’s Motion to Dissolve and Goldfarb’s Motion to Strike and referring the remaining motions to Examiner Pieprz for decision. PX116.4171-73. Examiner Pieprz issued a final decision on the motions in which he denied Goldfarb’s Motion

1 to Dissolve and Motion to Amend, and granted Mr. Cooper's Contingent Motion to
2 Substitute. PX116O.

3 139. With respect to the Matsumoto I and II Articles, Examiner Pieprz found that neither
4 article "discloses any recognition of the criticality of 5 microns as the lower limit for
5 fibril length. Neither of these articles discuss fibril length at all - but rather pore size.
6 Whether pore size is identical to fibril length as alleged has not been proven."
7 PX116O at p. 116.4175. He further found that fibril length was the critical variable
8 to the claimed subject matter, and that wall thickness and density ranges were not
9 patentably distinct limitations. PX116O at pp. 116.4176-77.

10 140. Dr. Goldfarb asked for supervisory review of Examiner Pieprz's decision, which
11 resulted in a third count, having a wall thickness limitation of 0.2 to 0.8 mm being
12 added to the Interference. Thus:

13 A prosthetic vascular graft of expanded polytetrafluoroethylene having
14 a microscopic structure of nodes interconnected by fibrils, said graft
comprising:

15 a wall thickness greater than about 0.2 millimeters and less than about
16 0.8 millimeters; and

17 an average distance between the nodes in the range of between about
18 5 to 100 microns.

19 PX116.4185-98, PX116.4228-48, PX116WW, PX116CCC.

20 **C. MR. HAROLD GREEN REAFFIRMS HIS 1976 AFFIDAVIT**

21 141. Harold Green was deposed for a fifth time on July 12, 1988 as part of the Interference.
22 During his deposition Mr. Green testified that: (i) although Mr. Detton expressed
23 some "discontent" with his 1976 Affidavits he "didn't know, and don't know today,
24 what the specific problem was that he was uncomfortable with"; (ii) he did not recall
25 any conversation with Mr. Detton where he indicated he wanted to withdraw his 1976
26 Affidavits; (iii) he was comfortable with the 1976 Green Affidavit; and (iv) he
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1 recalled at least one conversation with Dr. Goldfarb regarding the “Goldfarb
2 Structure,” and that he had called Dr. Goldfarb directly because the specifications
3 were unlike any he had made before. H. Green Dep., 7/12/88, at pp. 288-97, 312,
4 352-54 (PX116.8890-99, 8914, 8954-56).

5 142. A sixth deposition of Harold Green was taken on December 8, 1988. During this
6 deposition Mr. Green confirmed that his November 9, 1978 deposition was mostly
7 true but that “one also has to remember that the lawsuit that was involved here,
8 Goldfarb versus Impra, was acrimonious, at best, and there were a lot of personal
9 feelings involved here. So perhaps some of these statements may be a bit overstated
10 as we sit here today.” H. Green Dep., 12/8/88, at p. 434 (PX116.9020). Mr. Green
11 also reaffirmed the 1976 Green Affidavit regarding small diameter grafts and that
12 0.7-0.8 millimeters would have been an upper limit for wall thickness at the time of
13 his affidavit. Id. at p. 452 (PX116.9038).

14 **D. THE PTO AWARDS PRIORITY TO DR. GOLDFARB**

15 143. The parties submitted their final briefs in the Interference in the second half of 1990.
16 Mr. Lawrence Green, who had assumed primary responsibility for the Goldfarb
17 Application, argued that Dr. Goldfarb was entitled to priority based on conception,
18 diligence and reduction to practice without relying on any of Mr. Detton’s deposition
19 testimony or his 1976 Affidavits. PX116.6813-62. Mr. Santorelli argued that Mr.
20 Cooper was entitled to priority based on an earlier conception and reduction to
21 practice (PX116HHH at pp. PX116.6924-83), and further argued that count 3, which
22 added a wall thickness limitation, should be dissolved because the claimed wall
23 thickness was known in the prior art and was not patentably distinct from the other
24 counts. PX116HHH at pp. PX116.6983-91. Finally, Mr. Santorelli argued that
25 “Cooper was fully entitled to rely on and use the work of the various evaluators who
26 implanted and harvested expanded PTFE grafts [including Dr. Volder] provided they
27 made no inventive contribution to the counts. None did.” PX116.6971.

1 144. The final hearing in the Interference occurred on November 21, 1991, with the Final
2 Decision not issuing until almost four years later on October 18, 1995. PX116.7227,
3 PX116D. The Board found that count 3 – which contained a wall thickness limitation
4 – was not patentably distinct from count 2 and dissolved it from the Interference.
5 PX116D at p. 116.7300. The Board determined that Dr. Goldfarb was the first to
6 invent and awarded priority to Dr. Goldfarb based on a conception and reduction to
7 practice date no later than July 1973 finding that, although Mr. Cooper may have
8 established a June 5, 1973 conception, Mr. Cooper had not alleged any diligence to
9 a reduction to practice. PX116D at p. 116.7328. The Board did not base its decision
10 on Mr. Detton’s deposition testimony or affidavits but instead cited and relied upon
11 the testimony of others, including Harold Green, who the Board noted had “confirmed
12 the truth of his 1976 affidavit and 1975 deposition,” and Mr. Mendenhall. PX116D
13 at pp. 116.7318-21.

14 145. The Board’s decision finding Dr. Goldfarb the first to invent was upheld by the
15 Federal Circuit on September 1, 1998, which remanded the case back to the Board to
16 consider whether Dr. Goldfarb’s activities inured to the benefit of Gore. Cooper v.
17 Goldfarb, 154 F.3d 1321 (Fed. Cir. 1998). On remand, the Board found no inurement
18 to Mr. Cooper for Dr. Goldfarb’s work. That decision was upheld by the Federal
19 Circuit on March 2, 2001. Cooper v. Goldfarb, 240 F.3d 1378, 1386 (Fed. Cir. 2001).
20 Having lost the Interference and its multiple appeals disputing the PTO’s finding that
21 Dr. Goldfarb was the first to invent, Gore abandoned the Cooper Application.
22 PX117.4008-09.

23 **E. PLAINTIFFS’ EFFORTS TO OBTAIN THE VOLDER NOTEBOOK**

24 146. On January 6, 1986, Mr. Harold Green, then Impra’s CEO, wrote to Dr. Volder
25 seeking permission to disclose the Volder Notebook to the PTO in order to disprove
26 both Mr. Cooper’s and Dr. Goldfarb’s claims of inventorship. DX3052. Despite the
27 fact that Impra was adverse to Dr. Goldfarb, and thus it “would have been in [Dr.
28

Volder's] financial interests" to disclose his notebook, Dr. Volder never gave permission to do so. Trial Tr., 11/27/07, at p. 2002 (H. Green) ; Trial Tr., 12/12/07, at p. 4261 (Thesz). Mr. Green subsequently wrote to Dr. Volder on July 14, 1986 noting that Dr. Volder's refusal to release his notebook was "a great disappointment" as it "supposedly describes experiments to predate both the Cooper (Gore) and Goldfarb patent applications." DX3053. Mr. Harold Green testified that he had never read or reviewed the Volder Notebook, and had "no idea what it is" or any knowledge of its contents. Trial Tr., 11/27/07, at pp. 2002-03 (H. Green); Trial Tr., 12/12/07, p. 4177 (H. Green).

147. C.R. Bard acquired Impra on September 16, 1996. Trial Tr., 11/16/07, at p. 1365 (McDermott). This acquisition extinguished the adverse relationship between Dr. Goldfarb and Impra. Trial Tr., 11/07/07, at p. 491 (Goldfarb).

148. On August 26, 1996, immediately prior to Bard's acquisition of Impra, Mr. James Polese (Impra's counsel) wrote to Mr. Lawrence Green, noting that he had been in touch with Dr. Volder and asking if Mr. Green would like the Volder Notebook which Dr. Volder had indicated he was "confident ... would confirm that Dr. Goldfarb is not the inventor of the Goldfarb invention." DX3864. At the time of writing his letter Mr. Polese had never seen the Volder Notebook and had no knowledge of its contents or its relevance to the Goldfarb Application. Trial Tr., 11/30/07, at p. 2640 (Polese).

149. Mr. Lawrence Green asked to see a copy of the Volder Notebook, despite not believing Dr. Volder's claim of inventorship because it was inconsistent with Mr. Cooper's representations that "he was quite familiar with all of the work of all of these doctors, including Dr. Volder, and that none of these doctors had done anything inventive and that none of them had made any contribution to his invention." Trial Tr., 12/12/07, at p. 4221 (L. Green).

150. In October of 1996, Mr. Polese wrote to Dr. Volder requesting that Dr. Volder send his notebook directly to Mr. Green, or to have Mr. Sutton or the "current holder" of

the Volder Notebook (or a copy) send a copy. DX3160; Trial Tr., 11/30/07, at pp. 2632-36; 2641-42 (Polese). Dr. Volder did not send the notebook, thereby maintaining the confidentiality of the Volder Notebook. Trial Tr., 11/30/07, pp. 2640-41 (Polese); Trial Tr., 12/12/07, at pp. 4221-22 (L. Green).

151. Indeed, only a month prior to Mr. Polese's October letter Dr. Volder had written to Mr. Sutton (who, for many years, had neither represented Impra nor been involved in the prosecution of the Goldfarb Application) confirming that he desired to maintain the confidentiality of the Volder Notebook and any copies. DX3095. When the Goldfarb Application was returned to the patent examiner following the resolution of the interference in 2001, Mr. Green had forgotten about Mr. Polese's letters from five years earlier regarding Dr. Volder. (L. Green Trial Tr., 12/12/07, at p. 4219.)

III. POST-INTERFERENCE PROSECUTION

A. PTO EXAMINER CONSIDERS ALLEGATIONS OF INEQUITABLE CONDUCT

152. On September 27, 2000, prior to the second Federal Circuit's decision, Mr. Lawrence Green filed a "Submission Pursuant to 37 C.F.R. § 1.56" ("Information Disclosure Statement") which attached a declaration and complaint filed by Glenn Kelly, M.D., of Denver General Hospital and the University of Colorado, against Gore, Dr. Goldfarb, and Bard alleging that Dr. Kelly was the inventor of the subject matter of the Goldfarb Application. Dr. Glenn Kelly v. W.L. Gore & Associates, Inc. et al., Civil Action No. 00-N-1691 (D. Colo) (PX115.1515-33).

153. Using the standard forms of his law firm, Mr. Green submitted a second Statement Filed Pursuant to the Duty of Disclosure Under 37 C.F.R. §§ 1.56, 1.97 and 1.98 on April 18, 2001, which attached three PTO-1449 forms. Trial Tr., 12/12/07, at pp. 4189-90 (L. Green). To prepare this Second Information Disclosure Statement and the accompanying PTO-1449 forms, Mr. Green gathered information to disclose to the PTO by contacting Mr. Cates, people at Impra, prior counsel from England, and

1 by attempting to contact Mr. Sutton. Trial Tr., 12/12/07, at p. 4190 (L. Green). In
2 addition, Mr. Green and his colleagues “went back through the interference record
3 and picked out things that we thought would be material to the prosecution of the
4 [Goldfarb] application.” Id. at p. 4192.

5 154. Mr. Green did not disclose every document from the approximately 19,000 page
6 Interference record. For instance, Mr. Green did not disclose the Gore shipping logs
7 (PX116.17943-52) that were produced during the Interference. Trial Tr., 12/12/07,
8 at p. 4214 (L. Green). Gore kept a “shipping log” of the ePTFE vascular grafts that
9 it sent to various hospitals and surgeons, including Dr. Volder, prior to Dr. Goldfarb’s
10 invention date. DX3028; Trial Tr. 11/16/07, 1770-1771, 1782 (Cooper). The log
11 recorded at least 34 instances in which Gore manufactured and shipped vascular grafts
12 having wall thicknesses less than 1.0 mm before February 13, 1973, when Gore sent
13 the first ePTFE vascular grafts to Dr. Goldfarb. DX3028.

14 155. Gore did not present any evidence, however, that any of the doctors who received
15 these “thin wall” ePTFE tubes actually used them in any of their research. Mr. Green
16 testified that he did not disclose the Gore shipping logs because:

17 [T]he only thing they related to was wall thickness. And the patent
18 office had already determined that the wall thickness was not material,
19 that it couldn’t form the basis for a separately patentable claim. So
20 anything that related to wall thickness, in my view, was no longer
21 material. ... I didn’t think they were material at all.

21 Trial Tr., 12/12/07, at pp. 4214, 4216 (L. Green).

22 156. Mr. Green also did not disclose the copy of the Matsumoto III Article that was
23 obtained during the Interference with a date stamp of October 11, 1973. PX116BBB.
24 Mr. Green did not disclose this copy because he was “surprised” that anyone would
25 allege that the Matsumoto III Article was not “dated more than one year prior to the
26 filing date of the Goldfarb application.” Trial Tr., 12/12/07, at p. 4217 (L. Green).
27 Mr. Green did not believe there was “any confusion at all” and confirmed that
28

1 Matsumoto III Article had always been treated as “102(b) prior art to [the] Goldfarb
2 [Application].” Id.

3 157. Mr. Green also “did not make a special point of pointing” out that the Matsumoto III
4 Article disclosed a graft with a wall thickness of 0.5 mm. (Id. at p. 4218.) In
5 particular Mr. Green testified that he did not specially point out the wall thickness of
6 the Matsumoto III Article because:

7 Well, in the first place wall thickness was no longer an important
8 parameter, it was no longer material. And secondly, the article - the
9 examiner had the article... it was a very easy calculation to make. And
10 I didn’t see any need to point it out to the examiner that the wall
11 thickness was .5 millimeters.

12 Id.

13 158. As filed with the PTO, the Second Information Disclosure Statement and the
14 PTO-1449 forms included: (i) those documents previously made of record prior to
15 the requirement to use the PTO-1449 form; (ii) references uncovered or relied upon
16 during the Interference; and (iii) documents produced by Dr. Kelly in the Kelly v.
17 Gore litigation. PX115I at pp. PX115.1594-98; Trial Tr., 12/12/07, at pp. 4189-94 (L.
18 Green). The April 18, 2001 Statement also made of record both Motions to Dissolve
19 filed by Mr. Cooper and Dr. Goldfarb in the Interference, and evidence of a
20 potentially successful alleged use of an ePTFE graft in a human in 1971 by Dr.
21 Norton. PX115I at pp. PX115.1595-96. Examiner Milano initialed all of the
22 PTO-1449 forms with a date of “7/2001” indicating that all disclosed information had
23 been considered. PX115JJ at pp. PX115.1599-1604.

24 159. Mr. Green did not disclose to the PTO Mr. Cooper’s Motion to Dissolve the
25 Interference based on Dr. Goldfarb’s alleged misconduct in an attempt to cure
26 inequitable conduct because Mr. Green “didn’t believe inequitable conduct had
27 occurred.” Trial Tr., 12/12/07, at p. 4194 (L. Green). Instead, he submitted Mr.
28 Cooper’s Motion to Dissolve and its attachments “to get the underlying documents

1 before the examiner so the examiner could consider them in the prosecution of the
2 application.” Id. at p. 4193.

3 **B. INEQUITABLE CONDUCT AND PATENTABILITY ISSUES RAISED**
4 **DURING THE INTERFERENCE**

5 160. On June 27, 2001, Mr. Lawrence Green and others attended an interview with
6 Supervisory Patent Examiner Corrine McDermott in Ms. McDermott’s office, which
7 lasted for several hours. PX115KK; Trial Tr., 12/12/07, at pp. 4197-99 (L. Green) .
8 Among the other persons present at the interview was Patent Examiner Steven Marcus
9 who was an interference practice specialist that had been specifically assigned to
10 assist Examiner McDermott with respect to interference matters concerning the
11 Goldfarb Application. Trial Tr., 12/12/07, at pp. 4198-99 (L. Green).

12 161. At the interview, Mr. Green raised the Information Disclosure Statements because he
13 “felt that the [PTO] needed to consider all of these in making a determination of
14 patentability.” Id. at p. 4203. Mr. Green and the interference practice specialist
15 advised Examiner McDermott of the need to consider the materials raised by Mr.
16 Green in the Information Disclosure Sheets already filed and any future Information
17 Disclosure Sheets Mr. Green filed. Id. at pp. 4203-04. Mr. Lawrence Green testified
18 that Examiner McDermott agreed that “she would review the information disclosure
19 statements.” Id.

20 162. Pursuant to the agreement from the interview, Mr. Lawrence Green filed an
21 amendment on July 6, 2001 amending claims 20-23, cancelling claim 25 and adding
22 claims 25-28. PX115K; Trial Tr., 12/12/07, at pp. 4201-03 (L. Green). With respect
23 to claim 20, Mr. Green informed the Examiner that Dr. Goldfarb had been required
24 to add this claim in 1983 for the purpose of an interference and that the amendments
25 were being made to address potential patentability issues with respect to the claim.
26 PX115K at pp. PX115.3775-78. Mr. Green filed a Supplemental Statement Filed
27 Pursuant to the Duty of Disclosure Under 37 C.F.R. §§ 1.56, 1.97 and 1.98 on July
28

12, 2001, which included certain foreign language documents, further information concerning the Kelly v. Gore lawsuit, new allegations of inventorship in a lawsuit between Dr. Diethrich and Dr. Goldfarb and Bard (Goldfarb v. Diethrich, Civil Action No. 01-2161-PHX-SRB (D. Ariz.), and copies of previously-filed submissions by Dr. Campbell regarding inventorship. Trial Tr., 12/12/07, at pp. 4206-10 (L. Green).

C. DISCLOSURE OF ADDITIONAL DOCUMENTS TO THE PTO

163. Mr. Lawrence Green filed a Second and Third Supplemental Statement Pursuant to the Duty of Disclosure on August 14, 2001 and January 16, 2002. PX115OO; PX115PP. The submissions disclose, *inter alia*, certain abstracts and additional information concerning the Goldfarb v. Diethrich litigation. Mr. Green also submitted substitute PTO-1449 forms which were not in the correct format that were initialed by the Examiner on January 31, 2002. Trial Tr., 12/12/07, at pp. 4206-08 (L. Green).

164. At one point Mr. Green also called the Examiner and realized that he did not receive one of the information disclosure statements. Id. at p. 4211. Mr. Green then photocopied everything again and re-submitted it, with the Examiner's assurance that "he would consider it when it arrived." Id. Mr. Green testified that during this time he "[t]ried to disclose everything [he] thought was material to the examiner." Id.

165. The Notice of Allowance was mailed on July 15, 2001 (PX115.4017) and the issue fee paid on October 10, 2001 (PX115.4318).

D. MR. DETTON'S 2002 DEPOSITION

166. On August 12, 2002, Mr. Detton was deposed in connection with the Diethrich v. Goldfarb litigation. Trial Tr., 11/27/07, at pp. 1900-01 (Detton); PX115QQ at p. PX115.4408. Mr. Lawrence Green attended Mr. Detton's August 12, 2002 deposition. Trial Tr., 12/12/07, at p. 4212 (L. Green). At his deposition Mr. Detton gave testimony that Mr. Lawrence Green had not previously heard about how Mr. Detton thought his affidavits were "untruthful and [that] they were signed under

duress.” Id.

167. Upon hearing Mr. Detton’s testimony regarding the 1976 Affidavits, Mr. Green immediately requested the PTO to withdraw the Goldfarb Application from issuance so that it could consider Mr. Detton’s 2002 deposition testimony. PX115QQ. Mr. Green testified that he “felt that it was important to bring [the testimony] to the attention of the patent office.” Trial Tr., 12/12/07, at p. 4212 (L. Green). In submitting this request Mr. Green stated that he did not have a copy of the transcript at present and thus could not “make any representation as to whether Mr. Detton’s recent testimony is cumulative of the information previously considered by the Office in [the 1980 Detton Affidavit]” or whether “a Rule 56 violation has occurred.” PX115QQ at p. 115.4409.

168. The petition to withdraw the application from issue was dismissed by the PTO as not meeting the condition for withdrawal of the application that Mr. Green “actually assert that the patent is either invalid or unenforceable.” PX115QQ at pp. 115.4412-14; Trial Tr., 12/12/07, at p. 4213 (L. Green). Mr. Green did not make that representation in the petition because he did not believe inequitable conduct had occurred. Trial Tr., 12/12/07, at p. 4213 (L. Green).

169. The Goldfarb Patent issued on August 20, 2002 as United States Patent No. 6,436,135. PX1.

IV. POST-ISSUANCE DEVELOPMENTS

170. Shortly after his 2002 deposition testimony, Mr. Detton entered into a consulting agreement with Gore pursuant to which he was paid an up front fee of \$10,000 and an hourly rate of \$250 for his “background knowledge ... with respect to events during and after his employment at Gore.” DX3814. Mr. Detton has been paid around \$60,000 or \$70,000 by Gore for his “consulting” since October 2002. Trial Tr., 11/27/07, at p. 1903 (Detton).

171. Mr. Detton has admitted committing perjury in the past. Id. at pp. 1914-15.

172. According to Mr. Detton's trial testimony here, he executed the 1976 Affidavits in front of Mr. Harold Green and Mr. Sutton, he signed them under duress, and he spoke to Mr. Sutton and wrote him a letter the following Monday repudiating his 1976 Affidavits. Trial Tr., 12/12/07, at pp. 4309-11 (Detton).

173. In 2004, Mr. Detton produced, for the first time, the "repudiation" letter he purportedly sent to Mr. Sutton in 1976. The letter Mr. Detton produced in 2004 was similar to the documents he signed in 1976, but there were notable differences. DX 3084; Trial Tr., 11/27/07, at pp. 1953-56 (Detton). For example, the 2004 version of the 1976 "repudiation" letter is signed "Dan Detton" and the 1976 Detton Affidavits and his 1980 affidavit are signed "D. Dan Detton." DX 3084; PX 115N at PX 115.236; PX 115P at PX 115.291; PX 115X at PX 115.615.

174. Mr. Detton's testimony regarding his signing of the 1976 Affidavits was corroborated to some extent by Ms. Prestis, his ex-wife. Trial Tr., 12/11/07, at 4010-13 Prestis). Ms. Prestis, however, testified that Mr. Detton made a "demand for stock" from Harold Green at the meeting and that Mr. Green's refusal of that demand is what caused Mr. Detton to become angry. Id. at 4019.

175. Mr. Detton's testimony was contradicted by Mr. Sutton who testified that he was not present when Mr. Detton signed the 1976 Affidavits, and that he did not speak to or receive any correspondence from Mr. Detton in the days or weeks following the signing of the 1976 Affidavits. Trial Tr., 12/07/07, at pp. 3854-56, 3858-59 (Sutton). Mr. Sutton's testimony was corroborated by his secretary, Ms. Shrum, who testified that neither Mr. Sutton nor Mr. Harold Green were present when Mr. Detton signed his 1976 Affidavits, which she personally notarized. Trial Tr., 12/12/07, at pp. 4157-59 (Shrum). Ms. Shrum also confirmed that Mr. Detton did not call or send a letter to Mr. Sutton seeking to withdraw his affidavits and that, if he had done so, she was "fairly sure I would have recalled [it]," because it was "so soon after signing the affidavits ... [a]nd he's talking about the affidavits and grave doubts, and it's

- 1 something I think I would have remembered.” Id. at pp. 4161-63.
- 2 176. Mr. Sutton's testimony was further corroborated by Mr. Harold Green who testified
3 that he could not recall being present at any meeting where Mr. Detton signed his
4 affidavits. Trial Tr., 12/12/07, at 4179 (H. Green).
- 5 177. Mr. Harold Green also again confirmed the accuracy of his 1976 affidavit and, even
6 after being shown numerous documents which Gore asserts contradict his sworn
7 statements, testified that “I don’t know of any – reading through this document, I
8 don’t know of anything that I read here that I would be inclined to change.” Trial Tr.,
9 12/12/07, at p. 4180 (H. Green).
- 10 178. On November 2, 2007, a jury trial commenced to decide the infringement portion of
11 the instant lawsuit. On December 11, 2007, the Jury returned a verdict for the
12 Plaintiffs on all counts and all claims, including willful infringement. See Jury
13 Verdict, Doc. 771.

14 CONCLUSIONS OF LAW

15 I. LEGAL STANDARD

- 16 179. Stated generally, patent applicants and their patent attorneys have a duty of candor,
17 good faith and honesty in their dealings with the PTO. 37 C.F.R. § 1.56(a) (1989).
18 The duty of candor, good faith and honesty includes the duty to submit truthful
19 information and the duty to disclose to the PTO information known to the patent
20 applicants or their attorneys which is material to the examination of the patent
21 application. Elk Corp. of Dallas v. GAF Bldg. Materials Corp., 168 F.3d 28, 30
22 (Fed.Cir.1999); 37 C.F.R. § 1.56(a) (1989). The duty of candor extends throughout
23 the patent’s entire prosecution history. Fox Industries v. Structural Preservation
24 Systems, Inc., 922 F.2d 801, 803 (Fed.Cir.1991).
- 25 180. Breach of the duty of candor, good faith and honesty may constitute inequitable
26 conduct. Id. If it is established that a patent applicant engaged in inequitable conduct
27 before the PTO, the entire patent application so procured is rendered unenforceable.

- 1 Kingsdown Medical Consultants, Ltd. v. Hollister Inc., 863 F.2d 867, 877 (Fed. Cir.
2 1988).
- 3 181. "To prove that a patent is unenforceable due to inequitable conduct, the [] infringer
4 must provide clear and convincing evidence of (1) affirmative misrepresentations of
5 a material fact, failure to disclose material information, or submission of false material
6 information, and (2) and intent to deceive." Impax Labs., Inc. v. Aventis Pharms.,
7 Inc., 468 F.3d 1366, 1374 (Fed. Cir. 2006).
- 8 182. Information is deemed material if there is a substantial likelihood that a reasonable
9 examiner would have considered the material important in deciding whether to issue
10 the application as a patent. See Elk Corp., 168 F.3d at 31; 37 C.F.R. § 1.56(a).
11 Accordingly, a reference does not have to be prior art to be material information that
12 must be disclosed to the PTO. See 37 C.F.R. § 1.56(a) (1989). "The [information]
13 need only be within a reasonable examiner's realm of consideration." Merck & Co.,
14 Inc. v. Danbury Pharmacal, Inc., 873 F.2d 1418, 1421 (Fed. Cir. 1989).
- 15 183. Submission of a false affidavit may be determined to be "inherently material." Digital
16 Control, Inc. v. Charles Mach. Works, 437 F.3d 1309, 1318 (Fed. Cir. 2006).
- 17 184. "[A]n otherwise material reference need not be disclosed if it is merely cumulative of
18 or less material than other references already disclosed." Elk Corp., 168 F.3d at 31.
- 19 185. While "[m]ateriality does not presume intent, which is a separate and essential
20 component of inequitable conduct" (Allen Eng'g Corp. v. Bartell Indus., Inc., 299
21 F.3d 1336, 1352 (Fed. Cir. 2002) (internal quotes and citation omitted)), the
22 materiality of a reference may lead to an inference of intent. Bruno Indep. Living
23 Aids, Inc. v. Acorn Mobility Servs., 394 F.3d 1348 (Fed. Cir. 2005) ("in the absence
24 of a credible explanation, intent to deceive is generally inferred from the facts and
25 circumstances surrounding a knowing failure to disclose material information").
- 26 186. Intent to deceive is rarely established by direct evidence, and therefore, may be
27 inferred from the facts and circumstances surrounding the applicant's overall conduct.

- 1 Molins PLC v. Textron, Inc., 48 F.3d 1172, 1180 (Fed. Cir. 1995) (intent to deceive
2 is most often proven “by a showing of acts, the most natural consequence of which
3 are presumably intended by the actor”). For example, “intent may be inferred where
4 a patent applicant knew, or should have known, that withheld information would be
5 material to the PTO’s consideration of the patent application.” Critikon, Inc. v.
6 Becton Dickinson Vascular Access, Inc., 120 F.3d 1253, 1256 (Fed. Cir. 1997).
- 7 187. “Intent to deceive, however, cannot be ‘inferred solely from the fact that information
8 was not disclosed;’ there must be a factual basis for a finding of deceptive intent.”
9 Purdue Pharma L.P. v. Endo Pharm., 438 F.3d 1123, 1133-34 (Fed.Cir.2006).
- 10 188. Moreover, if the failure to disclose or misrepresentation occurred due to “[s]imple
11 negligence, oversight, or an erroneous judgment made in good faith,” the intent
12 element is not satisfied. Speciality Composites v. Cabot Corp., 845 F.2d 981, 982
13 (Fed. Cir. 1988). A finding of “gross negligence,” likewise, “does not itself justify
14 an inference of intent to deceive.” Kingsdown, 863 F.2d at 876. However, a patent
15 applicant cannot “cultivate ignorance, or disregard numerous warnings that material
16 information or prior art may exist, merely to avoid actual knowledge of that
17 information or prior art.” FMC Corp. v. Hennessy Industries, Inc., 836 F.2d 521, 526
18 n.6 (Fed. Cir. 1987).
- 19 189. In determining whether the applicant’s overall conduct evidences an intent to deceive
20 the PTO, the Federal Circuit has emphasized that “the involved conduct, viewed in
21 light of all the evidence, including evidence indicative of good faith, must indicate
22 sufficient culpability to require a finding of intent to deceive.” Paragon Podiatry
23 Laboratory, Inc. v. KLM Laboratories, Inc., 984 F.2d 1182, 1189 (Fed. Cir. 1993)
24 (internal quotations and citation omitted).
- 25 190. Once materiality and intent have been established, the court must conduct a balancing
26 test to determine “whether the scales tilt to a conclusion that ‘inequitable conduct’
27 occurred.” Critikon, 120 F.3d at 1256. Generally, “when the misrepresentation or
28

withheld information is highly material, a lesser quantum of proof is needed to establish the requisite intent, ... In contrast, the less material the information, the greater the proof must be.” Purdue Pharma L.P., 438 F.3d at 1128-29 (internal citations omitted).

191. Ultimately, the question of whether inequitable conduct occurred is equitable in nature. The court must make the “equitable judgment concerning whether the applicant’s conduct is so culpable that the patent should not be enforced.” Life Techns., Inc. v. Clontech Labs., Inc., 224 F.3d 1320, 1324 (Fed. Cir. 2000). During this step of the analysis, the court determines “whether the material misrepresentations or omissions in question are sufficiently serious in light of the evidence of intent to deceive, under all the circumstances, to warrant the severe sanction of holding the patent unenforceable.” Hoffman-La Roche, Inc. v. Promega Corp., 323 F.3d 1354, 1372 (Fed. Cir. 2003).

II. THE ACCUSED CONDUCT

A. ALLEGED FAILURE TO ADVISE THE PTO OF DR. VOLDER’S CONNECTION WITH IMPRA IN HIS 1976 AFFIDAVIT

192. Gore asserts that Dr. Goldfarb and/or his attorneys committed inequitable conduct with regard to Dr. Volder’s 1976 Affidavit by (i) failing to disclose to the PTO Dr. Volder’s affiliation with Impira in the 1976 Volder Affidavit, (ii) by not describing the full scope of Dr. Volder’s work with ePTFE grafts in the 1976 Volder Affidavit.

1. MATERIALITY

193. The 1976 Volder Affidavit was not submitted to the PTO in response to a request for an impartial affidavit from the patentee. Instead, Mr. Sutton submitted the 1976 Volder Affidavit without any direction from the PTO.

194. Plaintiffs had a duty to disclose the connection between Dr. Volder and Impira. See Ferring B.V. v. Barr Lab., Inc., 437 F.3d 1181, 1195 (Fed. Cir. 2006) (finding that an inventor and his assignee must “disclose the known relationships and affiliations of

the declarants so that those interests can be considered in weighing the declarations”).⁴

195. The 1976 Volder Affidavit does not state that Dr. Volder has no ownership interest in Impra, or that he is merely a disinterested researcher.

196. Moreover, there is no evidence that Dr. Volder was an officer of Impra at the time he signed his 1976 affidavit.

197. Dr. Volder and Impra became adverse to Dr. Goldfarb in September 1977 – approximately one year after Dr. Volder signed his 1976 Volder Affidavit and nearly one year prior to the next responsive Office Action. At the time the PTO considered the 1976 Volder Affidavit, Dr. Volder had no interest in the Goldfarb Application.

198. Despite it being in Dr. Volder’s and Impra’s financial interests, Dr. Volder never repudiated his affidavit once his interests became adverse to Dr. Goldfarb, or at any other time.

199. Based on these facts, the omission of Dr. Volder’s ownership interest in Impra was not material.

2. INTENT

200. Gore cites Paragon Podiatry Lab., Inc. v. KLM Labs., Inc., 984 F.2d 1182, 1191 (Fed. Cir. 1993), to assert that the Court should find inequitable conduct here because in Paragon the Federal Circuit affirmed the district court’s finding of intent to mislead

⁴ In Ferring the patent applicant submitted affidavits from a number of scientists, but failed to disclose to the PTO that those scientists had either received research funding from, or had previously worked for, the applicant. 437 F.3d 1184. Plaintiffs distinguish Ferring by asserting that these affidavits were submitted at the examiner’s prompting, thereby putting the applicant on notice as to the materiality of the affiant’s relationship. 437 F.3d at 1184. However, Ferring is not so limited. In fact, in Espeed, Inc. v. Brokertec USA, L.L.C., 480 F.3d 1129, 1136 (Fed. Cir. 2006), the Federal Circuit treated Ferring more expansively, stating, “we concluded that the failure to disclose possible bias of the declarants constituted a material omission where the declarations were submitted to overcome a prior art rejection.” Thus, Ferring applies here.

the PTO by the applicant's failure to disclose that three affiants either owned stock in, or had been engaged as a consultant by, the assignee. However, Gore fails to note that in Paragon, the PTO examiner specifically requested an "affidavit from a disinterested third party" for the purpose of assessing obviousness. Id. The three affidavits the applicant submitted were from professionals in the field which affirmatively stated that the affiant had not "been in the past employed by nor do I intend in the future to become employed by" the assignee. Paragon is distinguishable in that, here, there is not evidence of active misleading statements made to the PTO. Though it is true that Dr. Volder's stock ownership was not disclosed, the number of shares Dr. Volder owned was not sizable and, more importantly, it is unclear whether anyone knew that Dr. Volder owned these shares or whether Dr. Volder had ever informed Mr. Sutton, who drafted Dr. Volder's affidavit, as to his stock ownership.

201. There is no evidence that Mr. Sutton was aware of Dr. Volder's ownership interest in Impra at the time he submitted the 1976 Volder Affidavit. To the contrary, Mr. Sutton included in the 1976 Green and Baker affidavits the fact that both affiants were affiliated with Impra. It does not appear that Mr. Sutton was trying to hide any affiliations, rather, he apparently took steps to disclose an affiant's relationship to Impra when he was aware of it.

202. Nor is there any evidence that either Dr. Goldfarb or Dr. Volder were aware that Dr. Volder should disclose such ownership interest in the 1976 Volder Affidavit.

203. There is no duty to disclose information of which a person reasonably was not aware. See the Manual of Patent Examination and Procedure, § 2001.04 (5th ed. rev.3, 1986) (stating that there is a duty to disclose to the Patent and Trademark Office *all material information a party is aware of, or reasonably should have been aware of*, regardless of the source of or how the party became aware of the information).

204. The Court notes that Mr. Sutton is a member in good standing of the Arizona bar, he has taught at the Arizona State University law school, and the record appears to

1 support that the PTO found him credible. Based on Mr. Sutton's deposition testimony
2 presented during trial, his character, and his demeanor there appears to be no basis for
3 the Court to find Mr. Sutton not credible.

4 205. Accordingly, because there is no evidence that Mr. Sutton knew of Dr. Volder's
5 ownership interest in Impra at the time he filed the 1976 Volder Affidavit; there is no
6 evidence that Drs. Volder or Goldfarb were aware that such information was material;
7 there is no evidence that Mr. Sutton or Drs. Goldfarb and Volder intentionally omitted
8 information regarding Dr. Volder's ownership interest from the 1976 Volder
9 Affidavit; and because the Court finds Mr. Sutton's testimony credible, Gore has
10 failed to establish an intent to mislead or deceive the PTO by clear and convincing
11 evidence.

12 3. BALANCE

13 206. The Court concludes that Dr. Goldfarb and his attorneys did not commit inequitable
14 conduct with respect to Dr. Volder's affiliation and his 1976 Volder Affidavit because
15 there was no misrepresentation in the 1976 Volder Affidavit, any omission was not
16 material to the prosecution of the '135 patent, and no intent to mislead or deceive the
17 PTO has been demonstrated. Thus, Gore has failed to establish the existence of
18 inequitable conduct with regard to Dr. Volder's 1976 Affidavit by clear and
19 convincing evidence.

20 B. ALLEGED FAILURE TO ADVISE THE PTO THAT DR. BAKER 21 WITHDREW AND REPUDIATED PARAGRAPH 6 OF HIS 1976 22 AFFIDAVIT

23 207. The 1976 Baker Affidavit states that "[u]nder no conditions presently known ...
24 would [Dr. Baker] use or recommend the use of a graft characterized by a wall
25 thickness of greater than approximately .75 mm"

26 208. At his 1978 deposition, Dr. Baker confirmed that this statement was true and correct
27 at the time he signed his 1976 affidavit, but that subsequent clinical experience has
28

led him to want to change all of Paragraph 6 of his 1976 affidavit because he “now believed that our thinking at that time was not correct.” Such later-acquired scientific knowledge is not relevant to a determination of patentability, which is concerned with the scientific knowledge at the time of the filing or invention date of the Goldfarb Application (Kopykake Enters., Inc. v. Lucks Co., 264 F.3d 1377, 1383 (Fed.Cir.2001), which was four years earlier than Dr. Baker’s deposition testimony.

209. The 1978 deposition testimony of Dr. Baker from the Goldfarb v. Impra litigation was disclosed to the PTO on at least three separate occasions, including:

- In or around 1980, as part of the Cooper Application in an attempt to show that Dr. Goldfarb was not the inventor of the claimed subject matter;
- In or around 1984, as part of Mr. Cooper’s Motion to Dissolve filed during the Interference; and
- In 2001 or 2002, during the resumed *ex parte* prosecution of the Goldfarb Application following the completion of the Interference in which Mr. Cooper’s Motion to Dissolve was disclosed and expressly discussed with the examiner.

210. Information that is disclosed to the PTO cannot be considered to be withheld. Scripps Clinic & Research Found. v. Genentech, Inc., 927 F.2d 1565, 1582 (Fed. Cir. 1991) (“When a reference was before the examiner, whether through the examiner’s search or the applicant’s disclosure, it can not be deemed to have been withheld from the examiner.”).

211. Accordingly, Gore has not demonstrated that Dr. Goldfarb and his attorneys withheld information, let alone material information, from the PTO regarding Dr. Baker’s 1978 deposition testimony.

1. MATERIALITY

212. Further, both the PTO and the Federal Circuit expressly determined that wall thickness was not a patentable distinction with respect to the claimed subject matter

1 and that wall thicknesses in the 0.2 to 0.8 mm range were either known or obvious
2 from the prior art.

3 213. Accordingly, because Dr. Baker's 1978 deposition testimony does not contradict or
4 vary the statements made in the 1976 Baker Affidavit; Dr. Baker's 1978 deposition
5 refers only to later developed scientific knowledge which is not relevant to the
6 determination of patentability; and the PTO and Federal Circuit determined that wall
7 thickness is not a patentable distinction, Dr. Baker's 1978 deposition testimony is not
8 material to the prosecution of the '135 patent.

9 **2. INTENT**

10 214. There is no evidence that Dr. Goldfarb or his attorneys intended to withhold the 1978
11 deposition testimony of Dr. Baker from the PTO. To the contrary, the evidence shows
12 that: (i) Mr. Cates first disclosed the existence of the Goldfarb v. Impra lawsuit to the
13 PTO and sought to make "the record of those proceedings ... available to the
14 Commissioner for consideration"; (ii) Mr. Bookstein again disclosed the Goldfarb v.
15 Impra litigation to the PTO and, knowing that the examiner already had read
16 numerous transcripts from the Cooper Application, disclosed the 1978 Baker
17 deposition and sought to make it available to the examiner should he wish to review
18 it; and (iii) Mr. Lawrence Green expressly disclosed Mr. Cooper's Motion to Dissolve
19 to the PTO, which contained Dr. Baker's testimony, and informed the PTO that it
20 needed to consider this motion.

21 215. The evidence further shows that Dr. Goldfarb and his attorneys did not believe that
22 the 1978 deposition testimony of Dr. Baker was material to the patentability of the
23 Goldfarb Application. Specifically: (i) Mr. Cates wrote a letter to his Australian
24 counterpart noting the "lack of candor" and "evasive and nonspecific" answers
25 provided by Dr. Baker; (ii) Mr. Bookstein informed the PTO that he did not
26 understand the Baker deposition testimony to repudiate or contradict the 1976 Baker
27 Affidavit in any material respect; and (iii) the PTO and Federal Circuit had
28

1 determined that wall thickness was not a patentable distinction, and thus Mr.
2 Lawrence Green believed that “anything that related to wall thickness, in my view,
3 was no longer material.”

4 216. Mr. Lawrence Green testified during trial. His testimony appeared sincere and
5 forthcoming. There was nothing in Mr. Green’s testimony to give the Court a basis
6 to question his credibility.

7 217. There can be no intent to mislead or deceive when information is disclosed to the PTO
8 and a good faith belief as to lack of materiality is established. Speciality Composites,
9 845 F.2d at 982. Accordingly, because Dr. Goldfarb and his attorneys expressly
10 disclosed the Goldfarb v. Impra litigation and the 1978 Baker deposition testimony
11 to the PTO; and Plaintiffs have presented substantial evidence demonstrating that Dr.
12 Goldfarb and his attorneys had a good faith belief that the 1978 Baker deposition was
13 not material to the prosecution of Goldfarb Application, Gore has failed to
14 demonstrate an intent to mislead or deceive the PTO by clear and convincing
15 evidence.

16 3. BALANCE

17 218. Gore has failed to establish the existence of inequitable conduct by clear and
18 convincing evidence for the following reasons: (1) the 1978 deposition testimony of
19 Dr. Baker was disclosed to the PTO at various times; (2) the PTO found wall
20 thickness not material to the prosecution of the ‘135 patent; and (3) no intent to
21 mislead the PTO has been demonstrated.

22 219. Without clear and convincing evidence of inequitable conduct, there was no
23 compelling need for Mr. Lawrence Green to cure any inequitable conduct by
24 expressly disclosing the 1978 Baker deposition testimony and any related alleged
25 inequitable conduct to the PTO during the resumed ex parte prosecution following the
26 conclusion of the Interference.

C. FILING AND RELYING ON TWO 1976 DETTON AFFIDAVITS

220. Gore asserts that Dr. Goldfarb and/or his attorneys committed inequitable conduct by failing to disclose to the PTO that Mr. Detton allegedly repudiated his 1976 Affidavits.

1. KNOWLEDGE OF ALLEGED REPUDIATION

221. Mr. Detton asserts that he sought to withdraw his affidavits before they were submitted to the PTO and that he informed Mr. Sutton of this by telephone and letter within a day or two after signing them.

222. Mr. Detton's testimony is directly contradicted by the testimony of three witness: Mr. Sutton, Ms. Shrum and Mr. Harold Green.

223. Mr. Detton has admitted to perjuring himself in the past.

224. Since 2002, Gore has paid Mr. Detton over \$60,000 for his cooperation with regard to the '135 patent proceedings.

225. Dr. Goldfarb and his then attorney, Mr. Swenson, a member in good standing of the Arizona bar, further testified that Mr. Detton denied wishing to change his 1976 affidavits.

226. Gore has not demonstrated by clear and convincing evidence that Dr. Goldfarb and his attorneys submitted the 1976 Detton Affidavits knowing that Mr. Detton had repudiated them.

2. MATERIALITY

227. The 1980 Detton Affidavit was provided to the Examiner by Mr. Bookstein in a December 10, 1981 response to an Office Action. This affidavit expressly stated that the Detton-Cooper Source Affidavit, which incorporated the Second Detton Affidavit, was "not correct" had been signed "under duress." The Examiner acknowledged having already received and considered the 1980 Detton Affidavit – which he recognized retracted Mr. Detton's testimony regarding Dr. Goldfarb's inventorship – in the prior office action. Dr. Goldfarb and his attorneys thus expressly disclosed,

1 and the PTO acknowledged, Mr. Detton's repudiation of his 1976 Affidavits to the
2 PTO. In addition, the 1980 Detton Affidavit was submitted again in 2001.

3 228. Mr. Bookstein further did not misrepresent the 1980 Detton Affidavit to the PTO. Mr.
4 Bookstein did not state that he "could not" vouch for the affidavit or that it "does not"
5 seek to vary or contradict the 1976 Detton Affidavits. To the contrary, he merely
6 stated that the 1980 Detton Affidavit was submitted to the PTO "without vouching"
7 for it and noted that it "does not appear" to contradict or vary the Second Detton
8 Affidavit. A reasonable examiner would have reviewed the 1980 Detton Affidavit
9 and formed his or her own opinions, including that the 1980 Detton Affidavit was
10 repudiating both, one, or none of his 1976 affidavits, and thus Gore has not
11 demonstrated by clear and convincing evidence any misrepresentation by Mr.
12 Bookstein concerning the 1980 Detton Affidavit.

13 229. The 1978 deposition transcripts of Mr. Harold Green and Dr. Baker concerning Mr.
14 Detton's statements at the Golden Eagle restaurant were also disclosed to the PTO.
15 First, they were disclosed to the Examiner in the Cooper Application. Second, they
16 were disclosed to the PTO during the Interference during the preliminary motion
17 period in Mr. Cooper's Motion to Dissolve. Third, Mr. Lawrence Green disclosed
18 Mr. Cooper's Motion to Dissolve to the PTO after the Interference, which the PTO
19 considered. Thus, Gore has not demonstrated by clear and convincing evidence that
20 Dr. Goldfarb and his attorneys withheld any information, let alone material
21 information, concerning Mr. Detton's repudiation of his 1976 Affidavits from the
22 PTO.

23 230. Mr. Detton's repudiation of his 1976 Affidavits would only affect his testimony
24 regarding his receipt of Dr. Goldfarb's specifications. Dr. Goldfarb's inventorship,
25 however, was independently and separately corroborated by the 1976 Green Affidavit,
26 which has never been repudiated or said to be incorrect, and the deposition testimony
27 of Mr. Harold Green and Mr. Mendenhall. The 1976 Detton Affidavits are thus not
28

1 material to the prosecution of the '135 patent, which the Examiner himself expressly
2 recognized in holding the 1980 Detton Affidavit to be of "no effect" on the status of
3 the Goldfarb Application.

4 231. The 1978 deposition transcripts of Mr. Harold Green and Dr. Baker do not establish
5 that Mr. Detton repudiated his 1976 Affidavits, only that he was uncomfortable with
6 certain aspects of them and that he wanted to know the best way to withdraw them.
7 The 1978 deposition testimony also fails to identify any facts that Mr. Detton alleged
8 to be incorrect, false or misleading in his 1976 Affidavits. These deposition
9 transcripts, therefore, are cumulative of the 1980 Detton Affidavit and thus not
10 material to the prosecution of the '135 patent.

11 3. INTENT

12 232. There is no evidence that Dr. Goldfarb and his attorneys intended to mislead the PTO
13 regarding Mr. Detton's repudiation of his 1976 Affidavits. To the contrary, the facts
14 show that:

- 15 - Mr. Detton never identified what he alleged was incorrect, false or misleading
16 about his 1976 Affidavits prior to his 2002 deposition.
- 17 - Mr. Detton expressly told Dr. Goldfarb and his attorneys that he did not want
18 to repudiate his affidavits.
- 19 - Dr. Goldfarb and his attorneys offered Mr. Detton multiple opportunities to
20 clarify his 1976 Affidavits, which he declined to do.
- 21 - Dr. Goldfarb's attorneys had a good faith belief that Mr. Detton's repudiation
22 of his 1976 Affidavits was immaterial to the determination of Dr. Goldfarb's
23 inventorship.
- 24 - Dr. Goldfarb's attorneys disclosed the 1980 Detton Affidavit to the PTO.
- 25 - The 1978 deposition testimony of Mr. Harold Green and Dr. Baker was
26 disclosed to the PTO.

27 233. Thus, Gore has not demonstrated by clear and convincing evidence that Dr. Goldfarb
28

1 or his attorneys intended to withhold any information regarding Mr. Detton's
2 repudiation of the 1976 Detton Affidavits from the PTO.

3 **4. BALANCE**

4 234. The Court notes that Mr. Detton has perjured himself previously. The Court finds his
5 testimony highly suspect and lacking in credibility.

6 235. As stated above, the "repudiation" letter Mr. Detton produced in 2004, which he
7 claims he signed in 1996, was similar to the other documents he signed in 1976, but
8 there are notable differences. DX 3084; Trial Tr., 11/27/07, at pp. 1953-56 (Detton).
9 For example, the 2004 version of the 1976 "repudiation" letter is signed "Dan Detton"
10 and the 1976 Detton Affidavits and his 1980 affidavit are signed "D. Dan Detton."
11 DX 3084; PX 115N at PX 115.236; PX 115P at PX 115.291; PX 115X at PX 115.615.

12 236. Because Mr. Detton's claimed repudiation of his 1976 Affidavits was disclosed to the
13 PTO, is not material to the prosecution of the '135 patent, and no intent to mislead the
14 PTO has been demonstrated, Gore has not established the existence of inequitable
15 conduct by clear and convincing evidence.

16 **D. ALLEGED RELIANCE ON THE PTO'S ERROR IN CONNECTION**
17 **WITH WALL THICKNESS OF THE PRIOR ART MATSUMOTO**
18 **PUBLICATION**

19 237. Gore asserts that Dr. Goldfarb and/or his attorneys committed inequitable conduct
20 with respect to the Matsumoto III Article by failing to correct the examiner's apparent
21 misinterpretation of the Matsumoto III article as having a wall thickness of 0.5 mm.

22 **1. REPRESENTATION**

23 238. Dr. Goldfarb and his attorneys expressly disclosed the Matsumoto III Article as prior
24 art to the PTO, both in the specification of the Goldfarb Application and in a
25 Pre-Examination Amendment and Citation of Prior Art.

26 239. The examiner had the Matsumoto III Article which discloses an inside and outside
27 diameter of the ePTFE grafts used from which one of ordinary skill can readily
28

1 calculate a wall thickness of 0.5 mm.

2 240. Neither in Dr. Goldfarb's 1976 "amendment" response to the PTO's office action
3 concerning the Matsumoto III Article, nor at any time thereafter, did Dr. Goldfarb or
4 his attorneys ever represent to the PTO that the Matsumoto III Article had a wall
5 thickness different than 0.5 mm. Rather, during the Interference Dr. Goldfarb's
6 attorney, Mr. Bookstein, expressly represented to the PTO that wall thickness of the
7 Matsumoto III Article could readily be calculated as 0.5 mm.

8 241. Information that is disclosed to the PTO cannot be considered withheld or
9 misrepresented. Scripps Clinic, 927 F.2d at 1582.

10 242. In his April 1976 response to Examiner Frinks's rejection, Dr. Goldfarb never
11 asserted that the wall thickness of the graft disclosed in the Matsumoto III article was
12 1.0 mm and there is no evidence that Dr. Goldfarb or his lawyers recognized in April
13 1976 that the Examiner was wrong. Although Dr. Goldfarb's counsel argued the
14 importance of wall thickness, he did not distinguish Matsumoto III solely based on
15 wall thickness but argued that the claims were allowable because the article failed to
16 disclose the "relationship between internodal distance and wall thickness" and that
17 "these two parameters are not independent."

18 243. Dr. Goldfarb testified to the best of his recollection as to things that happened many
19 years in the past. Dr. Goldfarb appeared sincere in his testimony. There was nothing
20 in Dr. Goldfarb's testimony that would lead the Court to question his credibility.

21 244. Accordingly, because the Matsumoto III Article, from which wall thickness could
22 readily be calculated, was disclosed to the PTO; Dr. Goldfarb and his attorneys did
23 not misrepresent the wall thickness of the Matsumoto III Article; the correct wall
24 thickness of the Matsumoto III Article was disclosed to the PTO during the
25 Interference; and because the Court finds Dr. Goldfarb's testimony credible, Gore has
26 failed to present clear and convincing evidence that Dr. Goldfarb and his attorneys
27 misrepresented or withheld information from the PTO.

28

2. MATERIALITY

245. During the Interference, the PTO determined that the count was patentable over the Matsumoto III Article despite the disclosure by Dr. Goldfarb's attorneys that the Matsumoto III Article had a wall thickness of 0.5 mm. In particular, the PTO also determined that wall thickness was not a patentable distinction with respect to the claimed subject matter and that wall thicknesses in the 0.2 to 0.8 mm range were either known or obvious from the prior art.

246. Accordingly, because wall thickness is not a patentable distinction and because the PTO expressly determined the count of the Interference to be patentable over the Matsumoto III Article knowing that it disclosed a wall thickness of 0.5 mm, the wall thickness of the Matsumoto III Article is not material to the prosecution of the '135 patent.

3. INTENT

247. Gore has not present sufficient evidence to show that Dr. Goldfarb and his attorneys were aware of the correct wall thickness of the Matsumoto III Article when they disclosed the Matsumoto III Article to the PTO, or that they were aware of the examiner's error in calculating the wall thickness of the Matsumoto III Article at or about the time of the response to the first office action. Indeed, Dr. Goldfarb's attorney noted that there was "substantial confusion" regarding the wall thickness of the Matsumoto III Article at this time.

248. Dr. Goldfarb and his attorneys disclosed the correct wall thickness to the PTO during the Interference.

249. Following the conclusion of the Interference, Dr. Goldfarb and his attorneys did not feel the need to specifically point out the wall thickness of the Matsumoto III Article because the PTO had determined that wall thickness was not a patentable distinction.

250. Accordingly, because there is no evidence that Dr. Goldfarb or his attorneys were aware of the correct wall thickness of the Matsumoto III Article prior to the response

in the first office action; Dr. Goldfarb and his attorneys explicitly disclosed the correct wall thickness to the PTO during the Interference; and Dr. Goldfarb and his attorneys did not believe that it was necessary to specifically point out the wall thickness of the Matsumoto III Article after the Interference, Gore has failed to establish by clear and convincing evidence that Dr. Goldfarb and his attorneys intentionally misrepresented or withheld any information from the PTO.

4. BALANCE

251. Because Dr. Goldfarb and his attorneys did not misrepresent to the PTO, or withhold from the PTO, the wall thickness of the Matsumoto III Article, the wall thickness of the Matsumoto III Article is not material to the prosecution of the '135 patent, and no intent to mislead or deceive the PTO has been demonstrated, Gore has not established the existence of inequitable conduct by clear and convincing evidence.

E. ALLEGED FAILURE TO PROVIDE THE PTO WITH DR. VOLDER'S WORK, NOTEBOOK, AND POSSIBLE ROLE AS AN INVENTOR OR CO-INVENTOR

252. Gore asserts that Dr. Goldfarb and/or his attorneys committed inequitable conduct by failing to disclose to the PTO the Volder Notebook and Dr. Volder's other alleged claims of inventorship.

1. MATERIALITY

253. A short time line concerning Dr. Volder's Notebook and work provides understanding into the materiality of the Volder Notebook. Thus:

- Early 1970s - Dr. Volder was one of several researchers who received ePTFE tubes from Gore to research its use as an artificial vascular graft.
- July 1973 - Dr. Goldfarb conceived and reduced to practice his invention.
- August 1973 - Dr. Volder published the Volder A-V Shunts Article.
- Summer 1974 - Dr. Volder met with Mr. Sutton several times to discuss and investigate inventorship.
- September 4, 1974 - Dr. Volder's personal attorney, Mr. Drummond, sent a

1 letter to Mr. Sutton claiming that Dr. Volder should be the named inventor.

2 - September 9, 1974 - Mr. Sutton met with Drs. Volder, Goldfarb and Gall, as
3 well as Messrs. Harold Green and Richard Mendenhall to discuss inventorship
4 of the draft application. During that meeting it was determined that Dr.
5 Goldfarb was the inventor of the subject matter at issue.

6 - September 10, 1974 - Mr. Sutton summarized the September 9, 1974 meeting
7 in a memorandum, signed by Dr. Volder, stating that it was “unanimously
8 determined that IMPRA's patent application should be filed in the name of Dr.
9 Goldfarb.”

10 - Either September 1974 or April 1977 - Dr. Volder provided to Mr. Sutton a
11 copy of the Volder Notebook to retain “in confidence.” Mr. Sutton describes
12 the Volder Notebook as having a “delightful correlation” with the Volder A-V
13 Shunts article. The Volder Notebook appears to be cumulative of the Volder
14 A-V Shunts article and, therefore, is not material to the prosecution of the ‘135
15 patent.

16 - July 26, 1976 - Dr. Volder signed his affidavit and submitted it to the PTO
17 stating that Dr. Goldfarb's invention was “by no means obvious.”

18 - October 4, 1977 - after conducting an additional search, Gore represented to
19 the PTO that Mr. Cooper – who “worked closely with the surgeons” and had
20 access to all of their work, including Dr. Volder’s – was the proper inventor.

21 Later during the Interference, Gore repeated the position that none of the
22 surgeons made any inventive contribution, including Dr. Volder.⁵

23
24 ⁵ If Dr. Volder's work and the Volder Notebook were material to the ‘135 patent as
25 Gore asserts, Gore logically would have relied on Dr. Volder’s work for the Cooper
26 Application and recognized Dr. Volder as an inventor. Instead, Gore asserted that Mr.
27 Cooper was the inventor. This assertion eventually was rejected by the Board of Patent
28 Appeals and Interferences and the Federal Circuit. Goldfarb v. Cooper, Interference No.
101,100 (Bd. Pat. App. & Int. Oct. 18, 1995) (Final Decision); Goldfarb v. Cooper, Patent

- 1 - February 1978 - After being sued by Dr. Goldfarb, Impra alleges through
2 letters, interrogatories and the deposition testimony of Dr. Baker, that Dr.
3 Volder was making claims to the inventorship of the Goldfarb Application.
4 Impra however, never presented any first hand or documentary evidence of
5 these claims.
- 6 - Late-1970s and early-1980s - Dr. Goldfarb's counsel made repeated attempts
7 to obtain the Volder Notebook from Mr. Sutton, Mr. Green (Impra's president
8 at the time), and Dr. Volder himself. No response is received to any of these
9 attempts, as Dr. Volder continued to maintain the confidentiality of the Volder
10 Notebook.
- 11 - In 1986, Mr. Green attempted to obtain the Volder Notebook, despite having
12 no knowledge of its contents, in the hope that it would somehow help him
13 “torpedo” both the Goldfarb and Cooper Applications. Despite the fact that
14 as a shareholder of Impra it would have been in Dr. Volder's interest to prevent
15 the Goldfarb Application from issuing as a patent, he still did not give
16 permission for Mr. Green to have the Volder Notebook.
- 17 - Early 1990s - Mr. Sutton began to wind down his law practice and recycle old
18 documents as a result. At this point, because no one had requested the copy
19 of the Volder Notebook from him for over ten years and he had no legal or
20 ethical obligation to maintain it, he likely destroyed the copy of the Volder
21 Notebook as he closed up his practice.
- 22 - In 1996, Mr. Lawrence Green asked Mr. Polese to obtain the Volder Notebook
23 for his review. Dr. Volder did not provide his notebook but instead told Mr.
24 Sutton to maintain the confidentiality of his copy of the Volder Notebook.

26 Interference No. 101,100 (Bd. Pat. App. & Int. Dec. 19, 1996) (Reconsideration Decision).
27 Cooper v. Goldfarb, 154 F.3d 1321 (Fed. Cir. 1998).

1 - In 2001, Mr. Lawrence Green, who never believed any claim of Dr. Volder's
2 inventorship, forgot about Mr. Polese's 1996 letter when preparing information
3 disclosure sheets to submit to the PTO.

4 254. For the above reasons, neither the Volder Notebook, nor the various unsubstantiated
5 third party claims of Dr. Volder's inventorship are material to the prosecution of the
6 '135 patent.

7 255. Gore has not met the materiality prong with regard to Dr. Volder's claims of
8 inventorship, especially in light of Dr. Volder's affidavit and the testimony of
9 numerous people who attended the September 9, 1974 meeting. Dr. Volder and
10 others present, including Dr. Gall, Mr. Harold Green, Mr. Mendenhall, and Dr.
11 Goldfarb, have signed affidavits or testified that the outcome of that September 1974
12 meeting was the determination that Dr. Goldfarb was the inventor based on the
13 scientific merits of his research.

14 256. Moreover, Gore's attorneys met with Dr. Volder in the Netherlands, yet failed to
15 memorialize his testimony, despite the fact that Dr. Volder was "available" during the
16 fact discovery period of this litigation and was paid \$1,000 a day by Gore for his
17 cooperation. Trial Tr., 11/30/07, at 2664-65 (Kröner). Such testimony could have
18 established whether Dr. Volder had a valid claim of inventorship.⁶

19 257. Indeed, Dr. Volder was never deposed in this or any of its preceding litigation.

20 2. INTENT

21 258. Mr. Sutton conducted an investigation of Dr. Volder's inventorship claim prior to
22 filing the Goldfarb Application, the result of which was that Dr. Volder signed an
23 acknowledgment that Dr. Goldfarb was the sole inventor. Dr. Volder has never
24 withdrawn that written acknowledgment. As a result of his investigation, Mr. Sutton

25
26 ⁶ Such testimony also could have shown if someone knew in 1976 that Dr. Volder
27 was a shareholder of Impra and that this information should have been disclosed to the PTO.
28 See II.A. above.

1 did not believe that there would be an inventorship claim by Dr. Volder because “I
2 knew precisely that he fell outside the claim.”

3 259. Mr. Sutton also reviewed the Volder Notebook and concluded that it contained the
4 same information as was published in the Volder A-V Shunts Article. Mr. Sutton,
5 thus, had a good faith belief that the Volder Notebook was cumulative to the prior art
6 already before the PTO, and, thus, immaterial to the prosecution of the ‘135 patent.

7 260. Mr. Sutton received a copy of the Volder Notebook “in confidence” in April 1977⁷
8 and never received permission from Dr. Volder to disclose it. Thus, the Volder
9 Notebook has been suppressed for over 30-years. Because work that has been
10 “abandoned, suppressed, or concealed” is not prior art (E.I. du Pont de Nemours &
11 Co. v. Phillips Petroleum Co., 849 F.2d 1430, 1437 (Fed. Cir. 1988); see also Trial
12 Tr., 12/04/07, at 2954-55 (Bjorge). Trial Tr., 12/05/07, at 3311-12 (Thesz); Trial Tr.,
13 12/12/07, at 4261-62 (Thesz)), Dr. Goldfarb and his attorneys had formed a good faith
14 belief that the Volder Notebook was immaterial.

15 261. The Court again notes that Mr. Sutton is a member in good standing of the Arizona
16 bar, he has taught at the Arizona State University law school, and the record appears
17 to support that the PTO found him credible. Based on Mr. Sutton’s deposition
18 testimony presented during trial, his character, and his demeanor, there appears to be
19 no basis for the Court to find Mr. Sutton not credible.

20 262. Mr. Sutton's power of attorney to prosecute the Goldfarb Application was revoked in
21 January 1978, at which point in time Mr. Sutton become adverse to Dr. Goldfarb.
22 Neither Dr. Goldfarb nor his new attorneys have ever seen a copy of the Volder
23 Notebook, despite diligent efforts over a period of years to obtain a copy or gain
24 access to a copy from Impira and Dr. Volder himself. Because there is no obligation

25
26 ⁷ The date Mr. Sutton was given a copy of the Volder Notebook is controverted. Mr.
27 Sutton testified that he received it in April 1977, whereas Dr. Goldfarb testified that Mr.
28 Sutton had it in April 1974.

1 to disclose what you do not know or have, there is no evidence that Dr. Goldfarb and
2 his attorneys intentionally withheld any information concerning the Volder Notebook
3 from the PTO.

4 **3. BALANCE**

5 263. Gore has not established that the claims about Dr. Volder's alleged inventorship and
6 the Volder Notebook are material to the prosecution of the '135 patent.

7 264. There is no evidence that Dr. Goldfarb, Impra, or their counsel intended to mislead
8 the PTO about the existence or content of the Volder notebook.

9 265. Gore has not established the existence of inequitable conduct by clear and convincing
10 evidence.

11 **F. ALLEGED FAILURE TO PRODUCE MATERIAL INFORMATION**
12 **FROM GOLDFARB V. IMPRA AS ORDERED BY THE PTO⁸**

13 266. Gore asserts that Dr. Goldfarb and/or his attorneys committed inequitable conduct
14 with respect to information obtained in the Goldfarb v. Impra litigation by: (i) failing
15 to disclose to the PTO that the 1976 Baker Affidavit was not correct in light of Dr.
16 Baker's 1978 deposition testimony; and (ii) failing to disclose to the PTO Dr.
17 Volder's claims of inventorship, Mr. Detton's repudiation of his 1976 affidavits, the
18 Baker and Harold Green deposition transcripts from the Goldfarb v. Impra litigation,
19 and the 1978 Vermeire letter.

20 267. Section 2001.06(c) of the Manual of Patent Examining Procedure ("MPEP") as it
21 existed in April 1980 (DX3965), required disclosure of information from related
22 litigation. For example, the manual required disclosure of evidence of possible prior
23 public use or sales, questions of inventorship, prior art, allegations of "fraud" or
24 violations of the duty of disclosure.

25
26 ⁸ These issues have been addressed previously. Nevertheless, the Court will discuss
27 them again in the context of Plaintiffs' alleged failure to produce material information from
28 the Goldfarb v. Impra litigation as ordered by the PTO.

1 **1. DR. BAKER'S 1978 DEPOSITION TESTIMONY**

2 **a) MATERIALITY**

3 268. Again, Dr. Baker's 1978 deposition testimony in the Goldfarb v. Impra litigation was
4 disclosed to the PTO on at least three separate occasions, including the following:

- 5 - As part of the Cooper Application in an attempt to show that Dr. Goldfarb was
6 not the inventor of the claimed subject matter;
7 - As part of Cooper's Motion to Dissolve filed during the Interference; and
8 - During the resumed ex parte prosecution of the Goldfarb Application
9 following the completion of the Interference in which Cooper's Motion to
10 Dissolve was disclosed and expressly discussed with the examiner.

11 269. Information that is disclosed to the PTO cannot be considered to be withheld. Scripps
12 Clinic, 927 F.2d at 1582.

13 270. Accordingly, Gore has failed to demonstrate that Dr. Goldfarb and his attorneys
14 withheld any information, let alone material information, from the PTO regarding Dr.
15 Baker's 1978 deposition testimony.

16 271. Again, the 1976 Baker Affidavit states that "[u]nder no conditions presently known
17 ... would [Dr. Baker] use or recommend the use of a graft characterized by a wall
18 thickness of greater than approximately .75 mm"

19 272. At his 1978 deposition, Dr. Baker confirmed that this statement was true and correct
20 at the time he signed his 1976 affidavit, but that subsequent clinical experience
21 suggested that a wall thickness less than 0.75 mm might not be appropriate for all
22 indications. Such later acquired scientific knowledge is not relevant to a
23 determination of patentability, which is concerned with the scientific knowledge at
24 the time of the filing or invention date of the Goldfarb Application, some four years
25 earlier than Dr. Baker's deposition testimony.

26 273. Further, both the PTO and the Federal Circuit expressly determined that wall
27 thickness was not a patentable distinction with respect to the claimed subject matter
28

1 and that wall thicknesses in the 0.2 to 0.8 mm range were either known or obvious
2 from the prior art.

3 274. Accordingly, because Dr. Baker's 1978 deposition testimony does not contradict or
4 vary the statements made in the 1976 Baker Affidavit; Dr. Baker's 1978 deposition
5 refers only to later developed scientific knowledge which is not relevant to the
6 determination of patentability; and the PTO and Federal Circuit determined that wall
7 thickness is not a patentable distinction, Dr. Baker's 1978 deposition testimony is not
8 material to the prosecution of the '135 patent.

9 **b) INTENT**

10 275. There is no evidence that Dr. Goldfarb or his attorneys intended to withhold the 1978
11 deposition testimony of Dr. Baker from the PTO. To the contrary, the evidence shows
12 that: (i) Mr. Cates first disclosed the existence of the Goldfarb v. Impra lawsuit to the
13 PTO and sought to make "the record of those proceedings ... available to the
14 Commissioner for consideration"; (ii) Mr. Bookstein again disclosed the Goldfarb v.
15 Impra litigation to the PTO and, knowing that the examiner already had read
16 numerous transcripts from the Cooper Application, disclosed the 1978 Baker
17 deposition and sought to make it available to the examiner should he wish to review
18 it; and (iii) Mr. Lawrence Green expressly disclosed Cooper's Motion to Dissolve to
19 the PTO, which contained Dr. Baker's testimony, and informed the PTO that it
20 needed to consider this motion.

21 276. The evidence further shows that Dr. Goldfarb and his attorneys did not believe that
22 the 1978 deposition testimony of Dr. Baker was material to the patentability of the
23 Goldfarb Application. Specifically: (i) Mr. Cates wrote a letter to his Australian
24 counterpart noting the "lack of candor" and "evasive and nonspecific" answers
25 provided by Dr. Baker; (ii) Mr. Bookstein informed the PTO that he did not
26 understand the Baker deposition testimony to repudiate or contradict the 1976 Baker
27 Affidavit in any material respect; and (iii) the PTO and Federal Circuit had
28

1 determined that wall thickness was not a patentable distinction, and thus Mr.
2 Lawrence Green believed that “anything that related to wall thickness, in my view,
3 was no longer material.”

4 277. There can be no intent to mislead or deceive when information is disclosed or the
5 PTO or where a good faith belief as to lack of materiality is established. Speciality
6 Composites, 845 F.2d at 982. Accordingly, because Dr. Goldfarb and his attorneys
7 expressly disclosed the Goldfarb v. Impra litigation and the 1978 Baker deposition
8 testimony to the PTO; and Plaintiffs have presented substantial evidence
9 demonstrating that Dr. Goldfarb and his attorneys had a good faith belief that the 1978
10 Baker deposition was not material to the prosecution of Goldfarb Application, Gore
11 has failed to demonstrate an intent to mislead or deceive the PTO by clear and
12 convincing evidence.

13 **c) BALANCE**

14 278. Gore has failed to establish the existence of inequitable conduct by clear and
15 convincing evidence. This is true for the following reasons: (1) the 1978 deposition
16 testimony of Dr. Baker was disclosed to the PTO at various times; (2) the PTO found
17 wall thickness not material to the prosecution of the ‘135 patent; and (3) no intent to
18 mislead the PTO has been demonstrated.

19 279. Without clear and convincing evidence of inequitable conduct, there was no
20 compelling need for Mr. Lawrence Green to cure any inequitable conduct by
21 expressly disclosing the 1978 Baker deposition testimony and any related alleged
22 inequitable conduct to the PTO during the resumed ex parte prosecution following the
23 conclusion of the Interference.

24 /////

2. **DR. VOLDER’S CLAIMS OF INVENTORSHIP, MR. DETTON’S
REPUDIATION OF HIS 1976 AFFIDAVITS, THE BAKER AND
HAROLD GREEN DEPOSITION TRANSCRIPTS, AND THE
1978 VERMEIRE LETTER**

a) **MATERIALITY**

280. As noted previously, the unsubstantiated allegations of Dr. Volder’s claim of inventorship was not material to the prosecution of the ‘135 patent. There is no evidence that Dr. Goldfarb was ever “elected” as the inventor of the ‘135 patent. The sole evidence regarding the so-called election was the hearsay testimony of Dr. Baker (a 20 percent shareholder in Impra) at a time when Impra was seeking to “torpedo” the Goldfarb Application, and the hearsay testimony of Mr. Detton, who has admitted to committing perjury. This testimony, which is both hearsay and lacks foundation, is contradicted by the testimony of those persons who actually attended the September 9, 1974 meeting, who testified that it was unanimously agreed that Dr. Goldfarb was the inventor based on the scientific merits of his research. The hearsay allegations made during the Goldfarb v. Impra litigation are thus immaterial to the prosecution of the ‘135 patent.

281. Mr. Detton’s alleged repudiation of his 1976 Affidavits were not withheld and were not material to the prosecution of the ‘135 patent. Further, Mr. Detton’s repudiation of his 1976 Affidavits was disclosed to the PTO in the 1980 Detton Affidavit. In contrast to the allegations by Impra in the Goldfarb v. Impra litigation, the 1980 Detton Affidavit provided Mr. Detton’s own sworn description of the scope of his alleged repudiation.

282. As stated above, the 1978 deposition testimony of Dr. Baker and Mr. Harold Green from the Goldfarb v. Impra litigation was disclosed to the PTO on at least three separate occasions. This deposition testimony set forth all of the allegations made by Impra in the Goldfarb v. Impra litigation regarding Dr. Volder’s inventorship, the

1 so-called “election” of Dr. Goldfarb as inventor, and the alleged repudiation of the
2 1976 Detton affidavits.

3 283. Information that is disclosed to the PTO cannot be considered to be withheld. Scripps
4 Clinic, 927 F.2d at 1582. Accordingly, Gore has failed to demonstrate that Dr.
5 Goldfarb and his attorneys withheld any information from Dr. Baker’s and Mr. Harold
6 Green’s 1978 deposition testimony from the PTO.

7 284. The Vermeire letter did not provide details or evidence to support the allegations it
8 contained. Mr. Harold Green testified that this letter, and other disclosures provided
9 by Impra in connection with the Goldfarb v. Impra litigation, were part of an effort
10 by Impra to “torpedo” the Goldfarb Application in order to avoid potential litigation
11 in the future. Following receipt of Mr. Vermeire’s February 21, 1978 letter, Mr.
12 Swenson wrote to Mr. Vermeire on March 10, 1978, requesting facts to support the
13 allegations contained in the letter and asked for a copy of the Volder Notebook. No
14 facts were provided, nor was the Volder Notebook disclosed.

15 285. The Baker and Green deposition testimony and the allegations in Mr. Vermeire’s
16 1978 letter can be considered cumulative, and therefore less material than the
17 information already before the PTO.

18 286. There is no obligation to disclose immaterial or cumulative information to the PTO.
19 Elk Corp., 168 F.3d at 31.

20 287. Gore has failed to demonstrate that Dr. Goldfarb or his attorneys withheld material
21 information from the PTO by clear and convincing evidence because the allegations
22 from the Goldfarb v. Impra litigation regarding Dr. Volder’s claims of inventorship,
23 Mr. Detton’s alleged repudiation of his 1976 Affidavits, the Baker and Harold Green
24 deposition transcripts, and the 1978 Vermeire Letter, were either immaterial or
25 cumulative of evidence already before the PTO.

26 **b) INTENT**

27 288. As noted previously, there is insufficient evidence to support a finding that Dr.
28

Goldfarb and his attorneys intended to mislead or deceive the PTO with respect to Dr. Volder's alleged inventorship, or Mr. Detton's alleged repudiation of his 1976 affidavits. In fact, Dr. Goldfarb and his attorneys also had a good faith belief that the allegations regarding the so-called "election" of Dr. Goldfarb as inventor were false. In addition, there is insufficient evidence to support finding that Dr. Goldfarb and his attorneys intended to withhold the Baker and Harold Green deposition transcripts from the Goldfarb v. Impra litigation or the 1978 Vermeire letter.

289. Gore has failed to demonstrate by clear and convincing evidence that Dr. Goldfarb and his attorneys intended to mislead or deceive the PTO with respect to this same information from the Goldfarb v. Impra litigation.

c) BALANCE

290. Because the 1978 deposition testimony of Dr. Baker and Mr. Harold Green was disclosed to the PTO, the allegations made by Impra concerning Dr. Volder's inventorship and Mr. Detton's repudiation of his 1976 Affidavits is not material to the prosecution of the '135 patent, and no intent to mislead the PTO has been demonstrated, Gore has failed to establish the existence of inequitable as to the Goldfarb v. Impra litigation evidence by conduct by clear and convincing evidence.

G. ALLEGED FAILURE TO ADVISE THE PATENT OFFICE OF THE EXISTENCE OF THE GORE SHIPPING LOG

291. The Gore shipping logs were disclosed to the PTO during the Interference as part of the Interference record.

292. Although these shipping logs indicate that Gore may have shipped "thin wall" grafts to Dr. Volder prior to Dr. Goldfarb's invention date, there is no evidence that Dr. Volder actually used any such "thin wall" grafts in his medical research prior to such use by Dr. Goldfarb.

1. MATERIALITY

293. The PTO expressly determined that wall thickness was not a patentable distinction

1 with respect to the claimed subject matter and that wall thicknesses in the 0.2 to 0.8
2 mm range were either known or obvious from the prior art. The Gore shipping logs
3 indicating that ePTFE grafts with a wall thicknesses of less than 1.0 mm were shipped
4 to Dr. Volder are thus not material to the prosecution of the '135 patent.

5 294. There is no evidence that Dr. Volder actually used any ePTFE grafts received from
6 Gore with a wall thickness of less than 1.0 mm in any medical research prior to Dr.
7 Goldfarb's work. To the contrary, the Volder A-V Shunts Article (PX115JJ) only
8 reports on the use of grafts with a wall thickness of 1.2 mm and Dr. Volder, who was
9 represented by his own attorney, has never asserted otherwise or sought to repudiate
10 his 1976 Affidavit on this basis. The Gore shipping logs indicating that ePTFE grafts
11 with a wall thicknesses of less than 1.0 mm were shipped to Dr. Volder are thus not
12 material to the patentability of the '135 patent for this additional reason.

13 295. Furthermore, Gore was in possession of the shipping logs during the prosecution of
14 the Cooper Application, yet never disclosed them to the PTO in the Cooper
15 Application. Indeed, despite having possession of the Gore shipping logs, Gore told
16 the PTO that it had investigated whether Dr. Volder had a claim of inventorship and
17 had determined that he did not. Thus, Gore must not have believed that the shipping
18 logs were material to the patentability of the claimed invention.

19 2. INTENT

20 296. There is no evidence that Dr. Goldfarb or his attorneys had any possession or
21 knowledge of Gore's shipping logs at the time the 1976 Volder Affidavit was
22 submitted. Indeed, there is no evidence that they had the shipping logs until the
23 Interference.

24 297. Further, once they had the shipping logs, there is no evidence that Dr. Goldfarb or his
25 attorneys considered Gore's shipping logs to contradict the 1976 Volder Affidavit or
26 otherwise be material to the prosecution of the '135 patent. To the contrary, Mr.
27 Lawrence Green testified that he did not disclose the shipping logs to the *ex parte*
28

1 patent examiner because they only concerned wall thickness, which was not a
2 patentable distinction, and thus were not material.

3 298. There can be no intent to mislead or deceive when there is a failure to disclose
4 unknown information or where a good faith belief as to lack of materiality is
5 established. Speciality Composites, 845 F.2d at 982. Gore has not established that
6 Dr. Goldfarb and his attorneys intentionally withheld any information from the 1976
7 Volder Affidavits or material information concerning the Gore shipping logs.

8 3. BALANCE

9 299. Because the 1976 Volder Affidavit does not contain any misrepresentation, the Gore
10 shipping logs are not material to the prosecution of the '135 patent, and no intent to
11 mislead the PTO has been demonstrated, Gore has not establish the existence of
12 inequitable conduct by clear and convincing evidence.

13 IV. CONCLUSION

14 Gore has not demonstrated the requisite intent or bad faith to establish the affirmative
15 defense of inequitable conduct.⁹ Gore has failed to present sufficient evidence to establish
16 that Plaintiffs have not fulfilled their duty of candor, good faith, and honesty to the PTO.
17 Nor has Gore established by clear and convincing evidence that Plaintiffs participated in
18 affirmative misrepresentations of a material fact, failed to disclose material information, or
19 submitted false material information, and an intent to deceive.

20 Specifically, Gore has failed to present sufficient evidence to establish inequitable
21 conduct by clear and convincing evidence as to Plaintiffs' failure to advise the PTO of Dr.

22
23 ⁹ As an aside, it should be noted that the Jury heard a substantial amount of evidence
24 that related to inequitable conduct. The Court recognizes that the Jury was asked to consider
25 the validity of claims 20 through 27 of the '135 patent and the inequitable conduct evidence
26 pertains to claims one through ten. Nevertheless, much of the inequitable conduct evidence
27 was allowed to be presented to the Jury as it relates to the substantive claims. Despite
28 hearing much of Gore's inequitable conduct evidence, the Jury returned a verdict for
Plaintiffs on every count and every claim.

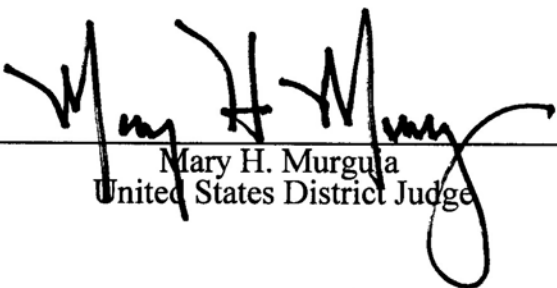
1 Volder's connections with Impra in his 1976 affidavit. Gore has failed to present sufficient
2 evidence to establish inequitable conduct by clear and convincing evidence as to Plaintiffs'
3 alleged failure to advise the PTO that Dr. Baker withdrew and repudiated Paragraph 6 of his
4 1976 Affidavit. Gore has failed to present sufficient evidence to establish inequitable
5 conduct by clear and convincing evidence as to Plaintiffs' alleged inappropriate filing and
6 reliance on Mr. Detton's two 1976 Affidavits. Gore has failed to present sufficient evidence
7 to establish inequitable conduct by clear and convincing evidence as to Plaintiffs' alleged
8 inappropriate reliance on the PTO's error in connection with wall thickness of the prior art
9 Matsumoto Publication. Gore has failed to present sufficient evidence to establish
10 inequitable conduct by clear and convincing evidence as to Plaintiffs' alleged failure to
11 provide to the PTO Dr. Volder's work, notebook, and possible role as an inventor or co-
12 inventor. Gore has failed to present sufficient evidence to establish inequitable conduct by
13 clear and convincing evidence as to Plaintiffs' alleged failure to produce material information
14 from Goldfarb v. Impra as ordered by the PTO. Gore has failed to present sufficient
15 evidence to establish inequitable conduct by clear and convincing evidence as to Plaintiffs'
16 alleged failure to advise the PTO of the existence of the Gore Shipping Log.

17 Accordingly, the Court finds that Gore has not proven by clear and convincing
18 evidence that Dr. Goldfarb and/or his attorneys committed inequitable conduct during the
19 prosecution of U.S. Patent No. 6,436,135.

20 **JUDGMENT ENTERED ACCORDINGLY** as to this Order and the Jury's Verdict,
21 which was entered December 11, 2007 (Doc. 771).

22 DATED this 29th day of July, 2008.

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Mary H. Murgula
United States District Judge