

IN THE UNITED STATES DISTRICT COURT
FOR THE WESTERN DISTRICT OF TENNESSEE
WESTERN DIVISION

MEDTRONIC SOFAMOR DANEK, INC.,)
)
Plaintiffs/)
Counterclaim Defendant.)

vs.)

No. 01-2373 MLV

GARY K. MICHELSON, M.D.)
and KARLIN TECHNOLOGY, INC.,)
)
Defendants/)
Counterclaimants,)

and)

GARY K. MICHELSON, M.D.,)
)
Third Party Plaintiff,)

vs.)

SOFAMOR DANEK HOLDINGS, INC.,)
Third Party Defendant.)

ORDER GRANTING DEFENDANTS MOTION TO COMPEL FURTHER RESPONSES TO
MICHELSON'S FIFTH SET OF REQUESTS FOR ADMISSION

Before the court is the November 10, 2003 motion of the defendant Gary K. Michelson, M.D. seeking to compel the plaintiff Medtronic Sofamor Danek, Inc. ("Medtronic") to admit or deny Request Nos. 3989, 3990, 3991, 4008, 4009, 4010, 4029, 4030, 4031, 4050, 4051, 4052, 4071, 4072, 4073, 4092, 4093, 4094, and 4115 through 4122 from Michelson's Fifth Set of Requests for Admission. The motion was referred to the United States Magistrate Judge for a determination. Medtronic timely responded on December 3, 2003.

For the reasons that follow, the motion is granted.

Briefly, this case involves a dispute between the parties over Medtronic's rights to intellectual property invented by Michelson in the field of spinal fusion technology. As part of the defendants' First Amended and Supplemental Counterclaims against Medtronic, Michelson and KTI have averred that Medtronic has misappropriated Dr. Michelson's trade secrets and has breached various confidentiality agreements. (Mem. of P. & A. in Supp. of Mot. for Order Compelling Further Resps. to Michelson's Fifth Set of Reqs. for Admis. at 2.) The motion presently before the court involves Medtronic's objections to twenty-five requests for admissions relating to these counterclaims.

On June 20, 2003, Michelson served Medtronic with his Fifth Set of Requests for Admission. (*Id.* at 3.) The Fifth Set of Requests included Requests Nos. 3989, 3990, 3991, 4008, 4009, 4010, 4029, 4030, 4031, 4050, 4051, 4052, 4071, 4072, 4073, 4092, 4093, 4094, and 4115 through 4122, which involve three categories of requests directed to Michelson's misappropriation and breach of confidentiality agreement claims. (*Id.*) The first category consists of eighteen requests for admissions that can further be broken down into six groups referring to six different confidentiality/non-disclosure agreements. (*Id.* at 4.) Each of the six groups contains three requests asking for admissions pertaining to the referenced agreement. (*Id.*) The first group, which is representative of all six, reads as follows:

Request for Admission No. 3989:

Admit that Medtronic provided confidential information obtained from Dr. Michelson pursuant to the

May 10, 1995 Non-Disclosure Agreement to other physicians who were not Medtronic employees at the time the confidential information was provided to them.

Request for Admission No. 3990:

Admit that the physicians to whom Medtronic provided confidential information obtained from Dr. Michelson pursuant to the May 10, 1995 Non-Disclosure Agreement and who were not Medtronic employees at the time were not under any contractual obligation not to utilize or disclose Dr. Michelson's confidential information that Medtronic provided to them.

Request for Admission No. 3991:

Admit that, subsequent to providing physicians who were not Medtronic employees at the time with confidential information obtained from Dr. Michelson pursuant to the May 10, 1995 Non-Disclosure Agreement, Medtronic entered into an agreement or agreements with one or more of these physicians by which agreements intellectual property relating to the confidential information disclosed was assigned to Medtronic.

The second category of requests for admissions consists of only one request. Request No. 4115 reads as follows:

Request for Admission No. 4115:

Admit that prior to or at the time of returning to Dr. Michelson invention prototypes Dr. Michelson made available to Medtronic, Medtronic did not give Dr. Michelson or Karlin Technology any written notice that Medtronic believed it owned the inventions.

The third category of requests consists of seven requests, Nos. 4116 through 4122, that each seek the same admission regarding different confidentiality/non-disclosure agreements. Request for Admission No. 4116, which is representative of the group, reads as follows:

Request for Admission No. 4116:

Admit that Medtronic disclosed prototypes of inventions that were made available to Medtronic by Dr. Michelson pursuant to the September 1, 1993 Non-Disclosure Agreement to other physicians who were not Medtronic employees at the time the prototypes were disclosed to them.

On August 5, 2003, Medtronic admitted or denied the majority of Michelson's Fifth Set of Requests for Admission; however, it objected to the twenty-five requests identified above on the grounds that it was unable to admit or deny the requests because the subject of the requests were vague and ambiguous. (Pl.'s Opp'n to Defs.' Mot. to Compel Further Resps. to Dr. Michelson's Fifth Set of Requests for Admission at 2.) Medtronic also asserted that the requests in dispute failed to meet the requirements of Rule 36 of the Federal Rules of Civil Procedure in that they do not "contain the separate, factual information about which admissions are sought." (*Id.*)

For example, Medtronic asserted that it could not admit or deny requests in the first category because the requests "d[id] not specifically identify the alleged 'physicians' or the confidential information" disclosed to Medtronic under any of the six referenced confidentiality agreements. (See *id.* at 3.) Medtronic claimed it could not admit or deny the requests falling into the second and third categories because "Dr. Michelson does not specifically identify the invention prototypes or the inventions" disclosed in connection with the referenced confidentiality agreements. (*Id.*) Furthermore, Medtronic objected to six requests from the first category that mention Medtronic's agreements with physicians for

assignment of intellectual property rights to Medtronic because the requests did not identify the assignment agreements to which Medtronic entered. (Vlahos Decl. in Supp. of Def. Michelson's Mot. for Order Compelling Further Resps. to Fifth Set of Reqs. for Admis., Ex. 2.)

Medtronic's objections to the requests at issue are without merit. Michelson has asserted that Medtronic possesses all the specific information on which it bases its objections, and the court agrees. For instance, Medtronic claims that it cannot respond to the requests in the first category because Michelson does not identify the confidential information allegedly disclosed to Medtronic. Medtronic, however, was a party to the individual confidentiality/non-disclosure agreements and has not denied that it actually received the disclosures. Likewise, Medtronic objects to Michelson's failure to identify the specific invention prototypes that were provided to itself. Medtronic has this information at its disposal because it was a party to the individual agreements referenced in each request. Medtronic cannot object to a request for admission on the bases that it needs specific information it already possesses. The same is true for the specific identification of physicians to whom Medtronic allegedly disclosed confidential information or the physicians with whom Medtronic allegedly entered into intellectual property assignments.

Rule 36(a) provides that "[u]nless the court determines that an objection is justified, it shall order that an answer be served." FED. R. CIV. P. 36(a). After reviewing the requests at

issue, the court finds that Michelson's Requests for Admission Nos. 3989, 3990, 3991, 4008, 4009, 4010, 4029, 4030, 4031, 4050, 4051, 4052, 4071, 4072, 4073, 4092, 4093, 4094, and 4115 through 4122 are sufficiently specific and satisfy the requirements of Rule 36(a) and that Medtronic possesses all the information necessary to fully admit or deny the requests. Accordingly, Medtronic's objections are not justified and are overruled.

For all of the foregoing reasons, Michelson's motion to compel is granted. Medtronic is hereby ordered to supplement its responses to Requests for Admission Nos. 3989, 3990, 3991, 4008, 4009, 4010, 4029, 4030, 4031, 4050, 4051, 4052, 4071, 4072, 4073, 4092, 4093, 4094, and 4115 through 4122 within ten (10) days of the entry of this order. Each party is to bear the cost of its own attorney fees.

IT IS SO ORDERED this 22nd day of December, 2003.

DIANE K. VESCOVO
UNITED STATES MAGISTRATE JUDGE