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UNITED STATES DISTRICT COURT
DISTRICT OF OREGON
EUGENE DIVISION

GLAS-WELD SYSTEMS, INC., an Oregon
corporation,

Plaintiff,

v.

MICHAEL P. BOYLE, dba SURFACE
DYNAMIX; and CHRISTOPHER M. BOYLE

Defendants.

Case No. 6:12-cv-02273-AA

DISCOVERY REPORT

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Pursuant to the Court's Order of Nov. 7, 2014, Plaintiff ("Glas-Weld") submits this Discovery Report briefly setting forth the Parties' disputes as to who may properly be deposed. Glas-Weld submits this report unilaterally due to Defendant Michael Boyle's failure to cooperate in finalizing this report. Specifically, Glas-Weld provided Mr. Boyle with a draft of this report on November 24, 2014. Although the parties discussed the identity of the deponents and the timing of the depositions, Michael Boyle refused to send a revised report back to Glas-Weld until December 17, 2014. Throughout this time Michael Boyle continued to add and remove deponents making it impossible for the parties to finalize a schedule.

Finally on December 16 & 17, 2014, Michael Boyle provided Glas-Weld with PDF copies of his revisions to the draft joint discovery report, in which Mr. Boyle identifies several new witnesses not previously identified for deposition, including providing a list of six experts (eight if Michael and Christopher Boyle intend to serve as experts as well), all on the issue of patent infringement.¹ When asked to provide a Word version of the joint discovery report, Michael Boyle refused. Glas-Weld also requested that Michael Boyle narrow his experts to a reasonable number given that six experts on the topic of non-infringement is excessive, duplicative, and wasteful of the parties and the Court's time and resources. Michael Boyle has since narrowed that number to three new experts, totaling five experts counting John Waltosz and Michael Boyle who have already provided a declarations giving opinions, and six experts for Defendants if Christopher Boyle does the same. Glas-Weld believes four-to-six experts for Defendants, solely on the topic of non-infringement is excessive, and objects to same. Given Michael Boyle's refusal to cooperate, and constant identification of new witnesses not having any testimony to give that is dependent on the Court's claim construction,

¹ All experts are necessarily on the issue of patent infringement, as that is the only defense left to defendants in view of the Court's Nov. 7, 2014 Order. (Dkt. No. 152). A copy of Michael Boyle's most recent revisions to the draft joint discovery report is attached hereto as Exhibit A.

Glas-Weld is submitting this report unilaterally in the hopes that the Court will narrow the number of deponents whose depositions are to be taken pursuant to the Court's November 7, 2014 Order.

The Court's Order of Nov. 7, 2014 states that the Court will "allow limited discovery as necessary to support or oppose the motion for partial summary judgment in light of the [C]ourt's construction of claims." (Doc. No. 152, at 30-31). "In other words, the [C]ourt will allow discovery regarding an issue of fact or law affected by the construction of claims." *Id.* "No other discovery shall be allowed." *Id.*

The parties now dispute who may properly be deposed pursuant to the Court's Nov. 7 Order.

A. Depositions That Have Been Agreed Upon By The Parties

The Parties appear to agree that Randy Mackey, Justin Price, Michael Boyle and Christopher Boyle should be deposed.

Glas-Weld does not oppose Michael Boyle's attempt to take the deposition of Maikel Van Daelen, but notes that Mr. Van Daelen is not a resident of the United States and under international law there is no manner to compel Mr. Van Daelen to appear for deposition within the time frame contemplated.

Glas-Weld also does not oppose taking the deposition of an additional expert on behalf of Defendants, in addition to Messrs. Michael Boyle, Christopher Boyle and John Waltosz. However, Glas-Weld believes that any more experts for Defendants on the issue of infringement would be excessive, duplicative, and wasteful of the Parties' and the Court's time and resources.

B. Depositions Sought By Plaintiff To Which Defendants Object

1. John Waltosz

Plaintiff's Position: Mr. Waltosz is Michael Boyle's former manufacturer, and submitted a declaration in support of Defendants' Opposition to Glas-Weld's Motion for Summary Judgment. (Doc. No. 109-2). Mr. Waltosz's declaration states opinions that

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are affected by the Court's Claim Construction Order. Accordingly Glas-Weld may properly depose Mr. Waltosz pursuant to the Court's Nov. 7, 2014 Order. Michael Boyle has also listed John Waltosz as an expert for Defendants, but subsequently removed him via email. Ex. A., p. 2.

Defendants' Position:

Mr. Waltosz's declaration and testimony states facts but not opinions that may affect the court's claim construction, accordingly defendants do not need Waltosz to be deposed.

See Exhibit A, at p. 2.

C. Depositions Sought By Defendants To Which Plaintiff Objects

1. Javier Sobrado, Esq.

Plaintiff's Position: Mr. Sobrado is Glas-Weld's attorney who submitted declarations in support of Glas-Weld's Motion for Partial Summary Judgment relating only to (1) chain of custody of the samples of the Accused Products in Glas-Weld's possession; and (2) his physical examination and manipulation of same. None of the statements made in Mr. Sobrado's declarations are affected by the Court's Order on Claim Construction. Any other testimony sought from Mr. Sobrado would be privileged under work-product doctrine or attorney-client communication privilege. Accordingly, Mr. Sobrado is not properly a deponent under the Court's November 7, 2014 Order.

Defendants' Position:

S[o]brado filed a declaration in support in the motion for Partial Summary Judgment which included his actions in removing set screw in accused device. In addition Sobrado also offered opinions relating to how the removal, losing or tightening of the set screw resulted in infringement of claim 1 of the 180. His actions and opinions were relied upon by experts Price and Mackey and formed the foundations of their opinions. The experts expressed in their in support of the Motion for Partial Summary Judgment Sobrado's action and opinions recited, [c]learly address fact or law affect by the court's claim construction. This is not protected by work product[.]

Exhibit A., at 3.

2. Thomas Spoo

Plaintiff's Position: Mr. Spoo is Glas-Weld's president. Mr. Spoo is not a technical expert for Glas-Weld and did not submit any declarations in support of Glas-Weld's Motion for Summary Judgment. Thus, Mr. Spoo does not have any testimony to give that is affected by the Court's Claim Construction Order. Accordingly, Mr. Spoo is not properly a deponent under the Court's November 7, 2014 Order. With respect to defendants' reference to Atlas Windshield Repair and Randy Dietz, this is a reference to art of record to the '372 Patent, and an attempt to revive invalidity theories that are precluded by the Court's November 7, 2014 Order because of Defendants' failure to respond to Glas-Weld's discovery requests. Nov. 7, 2014 Order, at 6.

Defendants' Position:

Thomas Spoo was directly involved in every patent decision during the defendant's tenure. The defendant served as a mid-level employee during the development of the 372 product. The defendant and Mr. Spoo had frequent conversations as to any and all patent designs and final decisions of the 372. Patent are well known by Mr. Spoo. Mr. Spoo has been involved with GlasWeld Systems for over 25 years. He is the last original surviving shareholder.

Mr. Spoo has intimate knowledge of the 180 patent as he was involved with Randy Mackey and Von Alexander. Mr. Alexander was the inventor of the original repair tool that the 180 embodies today. Mr. Spoo and Mr. Alexander related by the marriage of Sonia Alexander, now known as Sonia Spoo. Mr. Spoo worked closely with both of the mentioned individuals for over 20 years of patent and product design. The defendant is aware of this as he had long discussions with Mr. Spoo about products and patents over the 9 years the defendant's tenure. During the 3 other patents the defendant authored while President of GlasWeld systems, Mr. Spoo was in direct contact with the defendant and sometimes, Michael Cohen, the patent attorney for GlasWeld. The Corporate minutes kept by the secretary of board meetings should reflect these facts. Prior to the defendant's departure, corporate minutes were kept up to date as per the bylaws of the corporation. That being said, the defendant and Mr. Spoo fully understand the issue.

The Defendant was responsible for opening the GlasWeld East Coast office on the advice of Mr. Spoo. Mr. Spoo and his son were personally

trained in all aspects of the patented products in this litigation. Mr. Spoo was in charge of the training and sales office located just minutes from his home. Mr. Spoo worked an average of 30-40 hours weekly. This was a requirement that Mr. Spoo abided by in order to qualify for the company health plan that was not available to shareholders.

Mr. Spoo was intimately involved in a patent infringement suit GlasWeld was named in prior to my employ. Novus Glass repair filed an infringement suit on GlasWeld. Mr. Spoo is well aware of infringement issue as GlasWeld Settled with Novus. In a second patent case GlasWeld v. Canfield, Mr. Spoo directed the settlement over GlasWeld infringement of Canfields patent regarding long crack repair.

Mr. Spoo was directly involved in the relationship with Atlas Windshield Repair. The inventor of the first round curing light, much like the 372 patent. Randy Dietz, owner of Atlas Windshield Repair (prior art) was invited to a GlasWeld Convention in the year 2000. Unknown to Mr. Spoo, Mr. Dietz displayed and sold his invention. Mr. Spoo threw him Dietz out of the event as he was considered a competitor. Mr. Spoo then directed Mackey to attempt to license that product. That was the genesis of the 372 patent.

Mr. Spoo is the most qualified witness in the GlasWeld organization. The plaintiff's counsel has attempted to shield Mr. Spoo from any expose in this manner. Spoo has discoverable information that is relative to the Summary judgment and fact or law affected by claims construction. Mr. Spoo's testimony is vital in the defense of Patent infringement.

Exhibit A, at 4-5.

3. Don Gregor, Andre Segers, Thomas Inman, Eric Howe, and David Crosier

Plaintiff's Position: These individuals have been listed by Michael Boyle as potential experts for Defendants on the issue of infringement. If all of them are allowed to testify as experts, Defendants would effectively have eight experts on the issue of infringement (adding in John Waltosz, and Defendants Michael and Christopher Boyle). This is duplicative, inappropriate, and a waste of the Parties' and the Courts resources.

Defendants' Position: Defendant removed Eric Howe and David Crosier as experts, but continues to move forward with the rest.

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4. Mark Blackwell

Plaintiff's Position: Mr. Blackwell was first listed as a potential deponent in the draft of Michael Boyle's edits to the joint discovery report provided on December 16, 2014. Glas-Weld believes that Mr. Blackwell was listed on Michael Boyle's initial disclosures as having knowledge of "original designer of patent Patent No. 6,898,372, and aware of prior art." Mr. Blackwell submitted no declarations in support or opposition of Glas-Weld's Motion for Partial Summary Judgment. Michael Boyle intends to call Mr. Blackwell in an attempt to revive invalidity theories that are precluded by the Court's November 7, 2014 Order because of Defendants failure to respond to Glas-Weld's discovery requests. Mr. Blackwell is not listed as an expert for Defendants, and therefore does not have any testimony to give that is affected by the Court's Claim Construction Order. Accordingly, Mr. Blackwell is not a proper deponent pursuant to the November 7, 2014 Order.

Defendants' Position: None provided at this time.

5. Randy Dietz

Plaintiff's Position: Mr. Blackwell was first listed as a potential deponent by email on December 8, 2014. Michael Boyle intends to call Mr. Dietz in an attempt to revive invalidity theories that are precluded by the Court's November 7, 2014 Order because of Defendants failure to respond to Glas-Weld's discovery requests. Mr. Dietz is not listed an expert for Defendants, and therefore does not have any testimony to give that is affected by the Court's Claim Construction Order. Accordingly, Mr. Dietz is not a properly a deponent pursuant to the November 7, 2014 Order. Defendants' revisions to the joint discovery report appear to exclude Mr. Dietz, and thus it appears that as of Dec. 17, 2014 they no longer seek to depose him.

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Defendants' Position: None.

6. Dana Schriener

Plaintiff's Position: Ms. Schriener is a Glas-Weld employee. She is not a technical expert for Glas-Weld, and did not submit any declarations in support of Glas-Weld's Motion for Summary Judgment. Thus Ms. Schriener does not have any testimony to give that is affected by the Court's Claim Construction Order. Accordingly, Ms. Schriener is not properly a deponent under the Court's November 7, 2014 Order. Defendants' revisions to the joint discovery report appear to exclude Ms. Schriener, and thus it appears that as of Dec. 17, 2014 they no longer seek to depose her.

Defendants' Position: None.

7. Shiloh Spoo

Plaintiff's Position: Shiloh Spoo was added as a potential deponent by Michael Boyle via email on December 11, 2014, but does not appear listed in Michael Boyle's edits to the joint discovery report. Accordingly it appears Michael Boyle no longer seeks to depose him. Shiloh Spoo is an officer of Glas-Weld, but is not a technical expert for Glas-Weld in this matter, and did not submit any declarations in support of Glas-Weld's Motion for Partial Summary Judgment. Thus Shiloh Spoo does not have any testimony to give that is affected by the Court's Claim Construction Order, and is not properly a defendant under the Court's November 7, 2014 Order.

Defendants' Position: None.

8. Robert Beveridge

Plaintiff's Position: Mr. Beveridge has not submitted any declarations in support or opposition to Glas-Weld's Motion for Summary Judgment, and the declarations that he may submit are not affected by the Court's Claim Construction Order. This witness is not an expert witness for Defendants and therefore does not have testimony that is affected by the Court's Claim Construction Order. Accordingly, Mr. Beveridge is not properly deponents under the Court's November 7, 2014 Order.

Defendants' revisions to the joint discovery report appear to exclude Mr. Beveridge, and thus it appears that as of Dec. 17, 2014 they no longer seek to depose him.

Defendants' Position: None.

D. Michael Boyle's Supplemental Response to Interrogatory No. 8

Plaintiff's Position: Michael Boyle's supplemental Response to Interrogatory No. 8 (Dkt. No. 165) should be stricken because Michael Boyle inappropriately includes defenses precluded by the Court's November 7, 2014 Order. The Court's November 7, 2014 Order allows Defendants to supplement their responses to Glas-Weld's interrogatories with respect to their non-infringement defense only. (Dkt. No. 152, at 7). Michael Boyle's supplemental exhibit, advances non-infringement theories precluded by the Court's claim construction (such as the term "helical groove" requiring a constant pitch – Defendants' proposed construction which was rejected by the Court), and adds new theories not disclosed or developed during discovery. Specifically Michael Boyle argues invalidity based on estoppel or mismarking because of Glas-Weld's marking of its EcoVac product with the '180 Patent and claim that it is new evidence. However Defendants have known about this since at least February of 2014 – before the close of fact discovery –and nevertheless did not put forth any invalidity theory based on this fact until December 11, 2014. Mr. Boyle also raises a new invalidity theory for the '372 Patent based on the Atlas Windshield Repair / Randy Dietz lamp. However, Defendants have been aware of that prior art since the inception of this lawsuit, as "Dietz Light" is art of record to the '372 Patent, and Randy Dietz is listed in both of Defendants' initial disclosures. The supplemental answers are also untimely as Michael Boyle did not serve them on Glas-Weld until December 11, 2014, the day before Glas-Weld's expert reports were due, precluding Glas-Weld from addressing same in the expert reports. Accordingly, Michael Boyle's Supplemental Response to Interrogatory No. 8 should be stricken, because they violate the Court's November 7, 2014 Order restricting Defendants to non- infringement defenses only.

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Defendants' Position: Michael Boyle has taken the position that his Supplemental Interrogatory Response is within the scope of what is allowed by the Court's November 7, 2014 Order.

E. Location of Depositions

Plaintiff's Position: Through prior order (Dkt. No. 67, at 6), the Court has allowed Glas-Weld to select the locations of its witnesses' depositions. For security reasons Glas-Weld has agreed to conduct all depositions in either the Eugene or Portland Courthouses. To maximize efficiency and minimize cost, the Parties have been trying to coordinate conducting all of the depositions the week of January 26, 2015. To facilitate this all of the depositions should be held in the same location. Michael Boyle vacillates as to whether to agree to conduct certain depositions at the Eugene Courthouse, but has been adamant that Thomas Inman and Andre Segers depositions will be conducted elsewhere or by video. For expert witnesses, it is necessary that the experts be able to manipulate the accused products and to answer questions regarding the products in their various states. Accordingly, Defendants should make their experts available for depositions in either Eugene or Portland. Notwithstanding Michael Boyle's representation below, he has scheduled the deposition of Mark Blackwell in Eugene on January 27, 2014 and suggested scheduling the deposition of Thomas Inman in Minneapolis on January 26, 2014.

Defendants' Position:

The defendant (Michael Boyle) has attempted in good faith to abide by the court order executed on November 7th, 2014. The plaintiffs have been unable to schedule depositions for several reasons several times. The defendant has postponed major surgery to attempt to work with the plaintiff's counsel (see unopposed motion exhibit A).

Now the defendant is almost completely disabled as far as travel is concerned, surgery will now be performed February 6th. For reason stated above, the defendant request that depositions be held in Bend Oregon. That is where most of the subjects live with the exception of Mr. Inman.

Mr., Boyle will be confined to a wheel chair by the end of January, therefore request depositions are held locally.

Ex. A, at 6-7.

F. Product inspection.

Plaintiff's Position: This issue is the subject of a motion to compel by Michael Boyle (Doc. No. 163). Glas-Weld has filed its opposition to same noting that the product inspection can be accomplished immediately before the depositions on the week of January 26, 2014 at no prejudice to Defendants.

Defendants' Position:

The defendant has been essentially banned by the plaintiff's counsel to inspect accused infringing products. This is vital for the expert reports. Defendants cannot properly educate experts on the facts at hand without a thorough inspection, imaging and video of the accused product. Plaintiffs have had the product at their disposal for well over one year.

The plaintiff has informed the defendant that the only way to inspect the products prior to depositions is to fly to their office in Miami, Florida. This has seriously prejudiced the defendants. The defendant asks the court to command plaintiff's counsel to expedite the delivery and inspection of said products at Schwabe, Williamson & Wyatt in Bend Oregon no later than December 22nd. SW&W is the firm of record for several business needs including patent and IP work for the plaintiff's.

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If the defendant is unable to inspect the altered injectors, and verify that the accused infringing products are in fact products of Surface Dynamix, the ability for the defendants to properly prepare for expert reports and depositions is in question. The Plaintiffs' counsel is aware of the serious medical condition the defendant's family member is suffering from. the defendant is unable to travel until January 6th.

The defendant would like to inspect the accused infringing product no latter then December 22nd...

Ex. A, at 6.

DATED: December 19, 2014

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CERTIFICATE OF SERVICE

I hereby certify that I served a true and correct copy of the **DISCOVERY**

REPORT on the date indicated below by:

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I further certify that said copy was delivered as indicated above and addressed to said attorneys and defendant at the addresses listed below:

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