

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

FUSION ORTHOPEDICS, LLC,
Petitioner,

v.

EXTREMITY MEDICAL, LLC,
Patent Owner.

Case IPR2023-00894
U.S. Patent No. 11,298,166

PATENT OWNER'S PRELIMINARY SUR-REPLY

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TABLE OF EXHIBITS

Exhibit No.	Exhibit Description
2001	Declaration of Michael J. Zinna in Support of Patent Owner's Motion For Pro Hac Vice Admission Pursuant To 37 C.F.R. § 42.10(c)
2002	Complaint from Parallel District Court Case: <i>Extremity Medical, LLC vs. Fusion Orthopedics, LLC</i> , Case No. 2:22-cv-00723-PHX-GMS (D. Ariz.) (ECF 1)
2003	Case Management Order from Parallel District Court Case (ECF 49)
2004	July 10, 2023 Scheduling Order from Parallel District Court Case (ECF 74)
2005	July 28, 2023 Scheduling Order from Parallel District Court Case (ECF 76)
2006	Patent Owner's infringement contentions served in the Parallel District Court Case
2007	Petitioner's invalidity contentions served in the Parallel District Court Case and Exhibits A2 and A6 thereto
2008	<i>Markman</i> Order issued by the Court in the Parallel District Court Case (ECF 73)
2009	Printout from www.docketnavigator.com
2010	July 15, 2021 "List of References cited by applicant and considered by examiner" for U.S. Patent Application No. 17/323,923
2011	Selected Pages of the Transcript from the June 7, 2023 Deposition of Leonel Dominguez

I. Introduction

Patent Owner Extremity Medical, LLC respectfully submits the following Preliminary Sur-Reply authorized by the Board on September 11, 2023. *See* Ex. 3001. As explained below, Petitioner's Preliminary Reply ("Reply", Paper 13) does not cure the fatal flaws in the Petition. For the reasons explained herein and in Patent Owner's Preliminary Response, the Board should deny institution.

II. Petitioner's Reply Fails to Show Cognet Discloses a Bore Extending From a First Aperture at a Terminal End, to a Second Aperture on an Exterior Surface of the Third Member

As explained in Patent Owner's Preliminary Response, and particularly in view of Petitioner's construction of the term "bore" as a "cylindrical hole," Cognet does not disclose "a first bore extending along a first bore axis from the first aperture [at a terminal end,] to a second aperture on an exterior surface of the third member." *See* Paper 12 at 20-25. The "tunnel" disclosed in Cognet that Petitioner identifies as the "first bore" is, in fact, composed of two adjacent bores, not one. Cognet therefore does not disclose a single bore extending from (1) the first aperture, (2) to the second aperture, (3) where the second aperture is on the exterior surface of the third member. *Id.* Because Petitioner should be held to the construction it cited for the Petition, and because Petitioner's newly submitted evidence does not show Cognet discloses a single bore extending from the first aperture to the second aperture on the exterior surface of the third member, the

Board should reject the grounds of invalidity premised on Cognet. The arguments in Petitioner's Reply concerning Cognet are addressed in turn below.

First, Petitioner attempts to walk back the definition of the term “bore” it relied upon in the Petition. Petitioner's expert unequivocally stated that “[a] bore *is* a cylindrical hole. . . .” Ex. 1002, ¶ 58 (emphasis added). However, since Patent Owner explained that Cognet's “tunnel,” identified as a bore by Petitioner, is not *a* bore under that definition—it is two bores—Petitioner's Reply now argues that “[n]either the Petition nor the expert contended that a cylindrical shape is the *only* possible configuration.” Paper 13 at 3-4 (emphasis in original). But that argument is belied by the clear language of Petitioner's own expert's opinion that a bore “*is*” a cylindrical hole. Ex. 1002, ¶ 58.

Second, Petitioner seeks to introduce statements made by Patent Owner during prosecution of a related application (but from which U.S. Patent No. 11,298,166 does not claim priority), to deflect from its definition of “bore.” See Paper 13 at 2-3 (citing Ex. 1016). But this is a red herring because it is *Petitioner's construction* that controls here. Patent Owner is entitled to rely upon, and Petitioner should be held to, the construction advanced in the Petition. The Board should not allow Petitioner to offer new evidence for a new construction now. See 35 U.S.C. §312(a)(3); *Henny Penny Corp. v. Frymaster LLC*, 938 F.3d 1324, 1330 (Fed. Cir. 2019) (“[i]t is of the utmost importance that petitioners in the IPR

proceedings adhere to the requirement that the initial petition identify “with particularity” the “evidence that supports the grounds for the challenge to each claim.””) (citations omitted).

Third, Petitioner presents a strawman argument based on a mischaracterization of Patent Owner's position. Contrary to Petitioner's claim, Patent Owner did not argue that a bore must have an *unvarying diameter*. See Paper 13 at 1-2; Paper 12 at 20-25. As noted above, Patent Owner explained that Cognet's “tunnel,” identified by Petitioner as one bore, actually constitutes two bores (i.e., two cylindrical holes), each having a different diameter. Patent Owner took no position on varying diameters of a singular bore. Petitioner also cites to statements in the '166 Patent as indicating that a bore may “taper[] along its length.” Paper 13 at 2. However, Petitioner does not allege that the bores which make up Cognet's tunnel (or the tunnel overall) are tapered, so it is unclear what the concept of tapering has to do with Petitioner's argument.

Fourth, Petitioner fails to show that statements made by Patent Owner during prosecution of a related application support Petitioner's invalidity grounds. The cited statements concerning the Dierks reference, which Petitioner did not submit as evidence, identify a bore as including a “recess 8 that tapers” and a “hole 10 of uniform diameter.” But Petitioner does not allege that Cognet's “tunnel” constitutes a tapered recess and a hole, or that a tapered recess and a hole are

equivalent to Cognet's tunnel, so the statements about Dierks are not sufficiently connected to Petitioner's actual arguments. Petitioner therefore has not met its burden to show that Cognet's tunnel is a bore, even in view of the cited statements.

For the reasons set forth above and in Petitioner's Preliminary Response, the Board should reject the grounds of invalidity premised on Cognet.

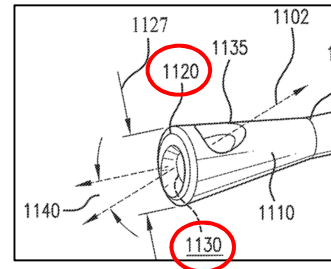
III. Petitioner's Reply Does Not Cure the Deficiencies Related to Simon

As a threshold matter, for the Simon reference, Petitioner's Reply addresses only the term "at a terminal end"; it does not address Petitioner's failure to show that Simon discloses a first member comprising "*a head portion*," recited in both independent claims, as explained in Patent Owner's Preliminary Response. *See* Paper 12 at 26-32. For this reason alone, the Board should reject the grounds of invalidity premised on Simon. *Id.*

Petitioner's Reply also does not cure Petitioner's failure to show Simon discloses "a first aperture *at a terminal end of the first end* of the third elongated body." Ex. 1001 at 15:11-18, 16:24-31 (emphasis added). As explained in Patent Owner's Preliminary Response, the Petition does not argue that Simon discloses a first aperture "at" a terminal end. Instead, the Petition argues, based on an unsupported expert opinion, that the term "at" should be construed as "near." *See* Paper 12 at 32-36. Petitioner now seeks to bolster its expert's opinion with statements made by Patent Owner during prosecution of related U.S. Patent

Application 12/658,680 (“the ’680 Application”), but those statements were not cited by Petitioner’s expert and therefore cannot form the basis of his opinion.

Also, when the entire record is considered, it is clear that the cited statements do not support Petitioner’s position. Petitioner cites the statement made by Patent Owner during prosecution of the ’680 Application that “first aperture 1130 [is] at a terminal end 1120. . . .” Ex. 1015 at 109:10-11. Petitioner asserts that statement indicates the term, “at a terminal end”, includes “*some distance away from* a terminal end” because Figure 11 of the ’166 Patent (partially copied at right with annotations) allegedly shows aperture 1130 some distance away from



terminal end 1120. Paper 13 at 4-5. However, the ’166 Patent explicitly states that aperture 1130 is part of terminal end 1120. See Ex. 1001 at 9:46-47 (“first end 1120 has a tapered aperture 1130.”). Accordingly, aperture 1130 is not “some distance away” from terminal end 1120, it is part of the terminal end. Therefore, the cited statements are not a basis for construing “at” as “near,” and Petitioner has not shown Simon discloses a first aperture “at” a terminal end of the first end.

IV. Conclusion

For the reasons explained herein and in Patent Owner’s Preliminary Response, Patent Owner respectfully requests that the Board decline to institute review.

Respectfully submitted,

Dated: September 22, 2023

By: /David G. Lindenbaum/
David G. Lindenbaum
Michael J. Zinna
KELLEY DRYE & WARREN LLP
One Jefferson Road
Parsippany, NJ 07054
Telephone: (212) 808-7800
Facsimile: (212) 808-7897
E-mail: dlindenbaum@kelleydrye.com
E-mail: mzinna@kelleydrye.com

*Attorneys for Patent Owner Extremity
Medical, LLC*

CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.6(e)(4), I hereby certify that on September 22, 2023, I caused a copy of the foregoing document to be served via electronic mail to the following addresses for counsel for Petitioner as indicated in the Petition:

Jennifer Brinkerhoff	Jen@FusionOrthopedics.com
Corby Vowell	corby@vowelllawfirm.com
Samuel Rocereta	sam@fusionorthopedics.com

By: /David G. Lindenbaum/
David G. Lindenbaum, Reg. No. 51,951