

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

FUSION ORTHOPEDICS, LLC,
Petitioner,

v.

EXTREMITY MEDICAL, LLC,
Patent Owner.

IPR2023-00894
Patent 11,298,166 B2

Before JEFFREY N. FREDMAN, ROBERT A. POLLOCK, and
JAMIE T. WISZ, *Administrative Patent Judges*.

POLLOCK, *Administrative Patent Judge*.

ORDER
Conduct of the Proceeding
37 C.F.R. § 42.5

On January 23, 2024, a conference call was held with Judges Fredman, Pollock, and Wisz, and counsel for the parties to discuss requests by Extremity Medical, LLC (“Patent Owner”) relating to the issues discussed below.

I. MOTION TO AMEND

Patent Owner requested a conference call, in part, for the purpose of complying with 37 CFR § 42.121(a), which provides that a motion to amend may be filed “only after conferring with the Board.” We determine that Patent Owner has complied with 37 CFR § 42.121(a) and is authorized to file a motion to amend.

Motions to amend are authorized by 35 U.S.C. § 316(d) and further regulated in 37 C.F.R. § 42.121. The parties should also be familiar with the Board’s additional guidance on motions to amend, as set forth in the Consolidated Trial Practice Guide¹ and the Board’s precedential decisions on this topic.² Briefing deadlines are set forth in the Scheduling Order entered in this proceeding. Paper 16. Page limits are set forth in the Consolidated Trial Practice Guide.

This case is eligible for the Motion to Amend Pilot Program that began on March 15, 2019.³ The parties should note that preliminary

¹ Available at <https://www.uspto.gov/TrialPracticeGuideConsolidated>.

² See *Hunting Titan, Inc. v. DynaEnergetics Europe GmbH*, IPR2018-00600, Paper 67 (PTAB July 6, 2020); *Amazon.com, Inc. v. Uniloc Luxembourg S.A.*, IPR2017-00948, Paper 34 (PTAB Jan. 18, 2019); *Lectrosonics, Inc. v. Zaxcom, Inc.*, IPR2018-01129, -01130, Paper 15 (PTAB Feb. 25, 2019). These decisions are available at <https://www.uspto.gov/patents/ptab/precedential-informative-decisions>.

³ Notice Regarding a New Pilot Program Concerning Motion To Amend

guidance provided under that program will be limited to limitations added by Patent Owner's motion and will not address the patentability of the originally challenged claims. If Patent Owner requests preliminary guidance and also files a revised motion to amend, the Board will issue a new scheduling order to accommodate the additional briefing.

II. MOTION FOR SANCTIONS

During the call, counsel for Patent Owner requested leave to file a motion for sanctions against Fusion Orthopedics, LLC ("Petitioner") to address the manner in which Petitioner's expert witness, Leonel Dominguez, testified at his deposition. According to Patent Owner, Mr. Dominguez failed to comply with the Testimony Guidelines appended to the Consolidated Trial Practice Guide at 127–130 (App. D, Testimony Guidelines) by providing evasive or non-responsive testimony in response to some of Patent Owner's questions during the deposition. Specifically, Patent Owner indicated that some, but not all, of Mr. Dominguez's testimony amounted to recapitulating information from his expert declaration.

Counsel for Petitioner argued that Mr. Dominguez relied on his expert declaration because it represents the "clearest expression of his opinions," and stemming from a desire to avoid being "led astray" by Patent Owner's questions.

Practice and Procedures in Trial Proceedings Under the America Invents Act Before the Patent Trial and Appeal Board, 84 FR 9497 (March 15, 2019); Extension of the Patent Trial and Appeal Board Motion To Amend Pilot Program, 87 FR 60134 (Oct. 4, 2022); *see also* Consolidated Trial Practice Guide at 67.

Having considered the parties' positions, we determine that Mr. Dominguez's manner of testimony and reliance on his declaration during the deposition is not a sanctionable offense. We, therefore, deny Patent Owner's request to file a motion for sanctions. Patent Owner may, nevertheless, choose to highlight portions of Mr. Dominguez's testimony in its pleadings as evidence of the credibility and weight we should accord his opinions.

III. ORDER

Accordingly, in consideration of the foregoing, it is hereby:

ORDERED that Patent Owner has satisfied its obligation, pursuant to 37 C.F.R. § 42.121(a), to confer with the Board prior to filing a motion to amend; and

ORDERED that Patent Owner's request to file a motion for sanctions is *denied*.

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