

From: [Trials](#)
To: [Ferraro, Vincent M.](#); [Trials](#)
Cc: [Zinna, Michael](#); ["Jennifer Brinkerhoff"](#); ["Corby Vowell"](#); ["Ross Culpepper"](#); ["Sam Rocereta"](#); [Scott E. Kamholz](#)
Subject: RE: IPR2023-00894 Fusion Orthopedics, LLC v. Extremity Medical, LLC -- Patent Owner's Opposed Request to Extend Due Date 3
Date: Wednesday, May 29, 2024 10:23:57 AM

Counsel,

From the Board –

This communication relates to Patent Owner's email of May 28 regarding a request to extend Due Dates, Petitioner's email of May 29 requesting leave to strike notices of deposition as in violation of 37 CFR 42.53(d)(1)-(2), and Patent Owner's responsive email of May 29.

A call will be scheduled for **Friday May 31 at 11:00 am (ET)**. Patent Owner shall provide a court reporter for the call.

The dial-in number is: [REDACTED] and the passcode is: [REDACTED]

With respect to an extension of Due Dates, we note that Patent Owner reserves the right to file a revised motion to amend (rMTA) at Due Date 3. This [link](#) to our "Due Date Appendix Generator v2 (MTA Pilot Revised SO for RMTA)" indicates a revised Due Date 8 (Oral Argument if requested) of September 13, 2024.

At least 2 hours prior to the call, Patent Owner shall provide, by email to the Trials mailbox, schedules of proposed revised Due Dates under the following scenarios.

1. A one-week extension of Due Date 3 (no rMTA); no change to Due Date 8 (September 6, 2024 (originally August 15, 2024)).
2. A two-week extension of Due Date 3 (no rMTA); no change to Due Date 8 (September 6, 2024 (originally August 15, 2024)).
3. A one-week extension of Due Date 3 (with rMTA); Due Date 8 no later than September 13, 2024.
4. A two-week extension of Due Date 3 (with rMTA); Due Date 8 no later than September 13, 2024.

Although we recognize that Patent Owner's request to extend Due Date 3 is opposed, Petitioner is also welcome to propose one or more revised schedules. Neither party shall include substantive argument in an email.

With respect to Petitioner's request for leave to strike (or quash pursuant to 37 CFR 42.53(d)(6)), the panel strongly suggests that, prior to the call, Patent Owner provide Petitioner with alternate deposition dates at least one week prior to Due Date 3 as currently scheduled.

Regards,

Esther Goldschlager

Supervisory Paralegal Specialist
Patent Trial & Appeal Board
U.S. Patent & Trademark Office

From: Ferraro, Vincent M. <VFerraro@KelleyDrye.com>

Sent: Wednesday, May 29, 2024 8:55 AM

To: Trials <Trials@USPTO.GOV>

Cc: Zinna, Michael <MZinna@KelleyDrye.com>; 'Jennifer Brinkerhoff' <jen@fusionorthopedics.com>; 'Corby Vowell' <corby@vowelllawfirm.com>; 'Ross Culpepper' <ross@allianceip.com>; 'Sam Rocereta' <sam@fusionorthopedics.com>; Scott E. Kamholz <sek@toolpat.com>

Subject: RE: IPR2023-00894 Fusion Orthopedics, LLC v. Extremity Medical, LLC -- Patent Owner's Opposed Request to Extend Due Date 3

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Dear Honorable Board,

We write to briefly respond to Petitioner's email.

- 37 CFR 42.53(d)(1) does not require Patent Owner to confer with Petitioner before filing deposition notices. Rather, it requires that the parties agree on a time and place "[p]rior to the taking of deposition testimony," which we intended to do.
- There is no deadline to complete the noticed depositions under 37 CFR 42.53(d)(2) or any other rule. 37 CFR 42.53(d)(2) states that "[c]ross-examination should ordinarily take place ... more than a week before the filing date for any paper in which the cross-examination testimony is expected to be used," but does not set an absolute deadline. The situation here is not ordinary because Petitioner served an unusually large number of exhibits (37 to be exact) with its reply and opposition to the motion to amend that needed to be reviewed before Patent Owner could determine its deposition needs.
- It would seem that Petitioner's counsel's own schedule would be benefited by the two-week extension that Patent Owner requests, yet Petitioner inexplicably opposes it.
- Lastly, while Patent Owner remains willing to consider Petitioner's counsel's scheduling needs in accordance with 37 CFR 42.53(d)(1) (particularly with the greater flexibility we will be afforded if our extension request is granted), we note that Mr. Kamholz is back-up counsel and there are several other members of Petitioner's team who could presumably handle these depositions, were they to proceed as noticed.

Respectfully submitted,

/Vincent M. Ferraro/

Vincent M. Ferraro, Reg. No. 79,197

Lead Counsel for Patent Owner

VINCENT FERRARO

Special Counsel

Kelley Drye & Warren LLP

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Email: vferraro@kelleydrye.com

From: Scott E. Kamholz <sek@toolpat.com>

Sent: Tuesday, May 28, 2024 6:09 PM

To: Trials@uspto.gov

Cc: Zinna, Michael <MZinna@KelleyDrye.com>; Ferraro, Vincent M. <VFerraro@KelleyDrye.com>; 'Jennifer Brinkerhoff' <jen@fusionorthopedics.com>; 'Corby Vowell' <corby@vowelllawfirm.com>; 'Ross Culpepper' <ross@allianceip.com>; 'Sam Rocereta' <sam@fusionorthopedics.com>

Subject: RE: IPR2023-00894 Fusion Orthopedics, LLC v. Extremity Medical, LLC -- Patent Owner's Opposed Request to Extend Due Date 3

CAUTION: This message originated outside of Kelley Drye and was sent by: sek@toolpat.com
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To the Board,

Petitioner Fusion Orthopedics, LLC, requests leave from the Board to file a motion to strike the three notices of deposition filed today by Patent Owner Extremity Medical, LLC in this proceeding. Copies of those notices are attached. Patent Owner's counsel has refused to withdraw the notices.

Petitioner objects to these notices because Patent Owner unilaterally selected a time and place for taking testimony in each deposition without conferring with Petitioner, as required by 37 CFR 42.53(d)(1), and because the depositions will not be completed before the deadline for their completion, as required by 37 CFR 42.53(d)(2). Additionally, I am not available to defend or sit for a deposition on the days Patent Owner selected due to personal commitments (my wife is a physician and is on call June 11, so I have unavoidable child care responsibilities; two of our children are graduating on June 12 and 13, respectively; and we have an extended family gathering celebrating them through June 14).

As Patent Owner's conduct in this regard is wound up with its request below to extend Due Date 3, Petitioner suggests that both matters be addressed in the conference call Patent Owner has requested.

Respectfully submitted,

/Scott Kamholz/

Scott Kamholz, Reg. No. 48,543

Backup Counsel for Petitioner

Scott E. Kamholz, M.D., Ph.D.

Registered Patent Attorney

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From: Ferraro, Vincent M. <VFerraro@KelleyDrye.com>

Sent: Tuesday, May 28, 2024 4:12 PM

To: Trials@uspto.gov

Cc: Zinna, Michael <MZinna@KelleyDrye.com>; Scott E. Kamholz <sek@toolpat.com>; 'Jennifer Brinkerhoff' <jen@fusionorthopedics.com>; 'Corby Vowell' <corby@vowelllawfirm.com>; 'Ross Culpepper' <ross@allianceip.com>; 'Sam Rocereta' <sam@fusionorthopedics.com>

Subject: IPR2023-00894 Fusion Orthopedics, LLC v. Extremity Medical, LLC -- Patent Owner's Opposed Request to Extend Due Date 3

Dear Honorable Board:

Patent Owner Extremity Medical, LLC in case IPR2023-00894 respectfully requests the Board to extend Due Date 3 (Patent Owner's sur-reply to Petitioner's reply to the response to the Petition, and Patent Owner's reply to Petitioner's opposition to Patent Owner's motion to amend (or Patent Owner's revised motion to amend)) by two weeks from June 13, 2024 to June 27, 2024. Patent Owner requests this extension so that it has sufficient time to fully review the unusually extensive amount of new material Petitioner filed with its reply to the response to the Petition and its opposition to Patent Owner's motion to amend – over 30 new exhibits, including 3 new declarations – as well as in light of Patent Owner's counsels' scheduling conflicts.

The parties have conferred, and Petitioner has indicated that it opposes Patent Owner's request.

The parties are available any time this week for a call with the Board.

We thank the Board for its consideration of Patent Owner's request.

Respectfully submitted,

/Vincent M. Ferraro/

Vincent M. Ferraro, Reg. No. 79,197

Lead Counsel for Patent Owner

VINCENT FERRARO

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