

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 proceeding
37 C.F.R. § 42.5

On May 31, 2024, in response to the parties' emails from May 28, 2024 and May 29, 2024 (Exs. 3006–3009), Judges Fredman, Pollock, and Wisz conducted a conference call with counsel for both parties to discuss Patent Owner's request to extend Due Date 3 by two weeks and Petitioner's request to file a motion to strike (or quash pursuant to 37 C.F.R. § 42.53(d)(6)) certain deposition notices filed by Patent Owner. A court reporter was present and the transcript will serve as the official record of the call.

Patent Owner seeks a two-week extension of Due Date 3 so Patent Owner will have “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.” Ex. 3006. At our request (*see* Ex. 3009, 1), Patent Owner submitted four proposed schedules under one- and two-week extension scenarios, with and without any revised motion to amend (Ex. 3010). During the call, Petitioner opposed each of Patent Owner's four proposed schedules, but indicated that it could be amenable to proposed schedules 1–3 provided Patent Owner would agree to certain conditions such as only filing one declaration in its Reply to Petitioner's Opposition to the Motion to Amend (Due Date 3), providing at least 5 deposition dates for cross-examination, and adjusting certain due dates. Patent Owner did not agree to Petitioner's conditions during the call.

Petitioner seeks authorization to file a motion to strike (or quash pursuant to 37 C.F.R. § 42.53(d)(6)) Patent Owner's Notice of Deposition of Leonel Dominguez (Paper 34), Notice of Deposition of Eli Jacobson (Paper

35), and Notice of Deposition of Scott Kamholz (Paper 36) “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).” Ex. 3007, 1.

In response, Patent Owner disagrees with Petitioner’s interpretation of 37 C.F.R. § 42.53(d)(1) and (2). Patent Owner contends 37 C.F.R. § 42.53(d)(1) does not require parties to meet and confer before filing deposition notices, but requires parties to *agree* on a time and place prior to the taking of deposition testimony. Patent Owner further contends 37 C.F.R. § 42.53(d)(2) does not require that cross-examination must 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 instead merely *suggests* the same by saying 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” (emphasis added). During the call, we agreed with Petitioner’s interpretation of 37 C.F.R. § 42.53(d)(1)–(2) as implicitly requiring the parties to meet and confer and, absent special circumstances not evident here, imposing a one-week deadline for cross-examination before the filing date for any paper in which the cross-examination testimony is expected to be used. Despite their disagreement, the parties indicated that they are currently negotiating deposition dates for Mr. Dominguez, Mr. Jacobson, and Mr. Kamholz for June 5th and June 6th.

Having heard the parties' respective arguments regarding Due Dates, we instructed the parties to meet and confer to determine whether they can agree to one of Patent Owner's proposed schedules, subject to Petitioner's conditions. However, the Board will not extend Due Date 8, presently scheduled for September 6, 2024, and presumptively extended to the week of September 12 in the event Patent Owner elects to pursue a revised motion to amend. If the parties are able to reach an agreement, they may request that the Board enter a new scheduling order subject to the agreed-upon dates and conditions. The present schedule shall remain in effect, until and unless the parties agree on a revised schedule. *See* Paper 16 (original scheduling order); Paper 19 (resetting Due Date 8 to September 6, 2024).

Given that the parties are actively negotiating deposition dates for Mr. Dominguez, Mr. Jacobson, and Mr. Kamholz, and those negotiations appear to be advancing, we need not involve the panel at this time.

ORDER

In accord with the above, it is:

ORDERED that Patent Owner's request for a two-week extension of Due Date 3 is *denied* at this time;

FURTHER ORDERED that the parties meet and confer to determine whether they can agree to one of Patent Owner's proposed schedules (Ex. 3010), subject to Petitioner's conditions, and without adjustment to Due Date 8;

FURTHER ORDERED that Petitioner's request for authorization to file a motion to strike (or quash pursuant to 37 C.F.R. § 42.53(d)(6)) Patent Owner's Notice of Deposition of Leonel Dominguez (Paper 34), Notice of Deposition of Eli Jacobson (Paper 35), and Notice of Deposition of Scott Kamholz (Paper 36) is *denied* at this time.

IPR2023-00894
Patent 11,298,166 B2

FOR PETITIONER:

Jennifer Brinkerhoff
FUSION ORTHOPEDICS
jen@fusionorthopedics.com

Scott Kamholz
TOOLPAT PLLC
sek@toolpat.com

Ross Culpepper
ALLIANCE IP, LLC
ross@allianceip.com

FOR PATENT OWNER:

Vincent Ferraro
Michael Zinna
KELLEY DRYE & WARREN LLP
vferraro@kelleydrye.com
mzinna@kelleydrye.com