

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

**PARTIES' JOINT SUBMISSION OF THE TRANSCRIPT OF
THE MAY 31, 2024 TELECONFERENCE**

Pursuant to the Board's directive made during the May 31, 2024
teleconference, the parties hereby jointly submit the transcript of the May 31, 2024
teleconference, which is attached hereto as Exhibit A. *See* Ex. A at 4:19-23.

Dated: June 7, 2024

Respectfully submitted,

By: <u>/Jennifer R. Brinkerhoff/</u> Jennifer R. Brinkerhoff (Reg. No. 78,696) <i>Counsel for Petitioner</i> <i>Fusion Orthopedics, LLC</i>	By: <u>/Vincent M. Ferraro/</u> Vincent M. Ferraro (Reg. No. 79,197) <i>Counsel for Patent Owner</i> <i>Extremity Medical, LLC</i>
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CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.6(e)(4), I hereby certify that on June 7, 2024, 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 Petitioner's Revised Mandatory Notices (Paper 18):

Jennifer Brinkerhoff	Jen@FusionOrthopedics.com
Scott E. Kamholz	sek@toolpat.com
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Dated: June 7, 2024

By: /Vincent M. Ferraro/
Vincent M. Ferraro, Reg. No. 79,197

EXHIBIT A

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UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE PATENT TRIAL AND APPEAL BOARD

_____	)	
FUSION ORTHOPEDICS LLC,	)	
	)	
Petitioner,	)	
	)	IPR NO. 2023-00894
v.	)	PATENT 11,298,166 B2
	)	
EXTREMITY MEDICAL LLC,	)	
	)	
Patent Owner.	)	
_____	)	

TELEPHONIC HEARING

DATE: May 31, 2024

REPORTED BY: MICHAEL FRIEDMAN, CCR

1 A P P E A R A N C E S:

2 TOOLPAT PLLC
3 3600 North Potomac Street
4 Arlington, VA 22213
5 BY: SCOTT KAMHOLZ, ESQ.
6 Attorneys for Petitioner

7 KELLY DRYE
8 One Jefferson Road
9 Parsippany, NJ 07054
10 BY: VINCENT FERRARO, ESQ.
11 Attorneys for Patent Owner

12 ALSO PRESENT: JUDGE ROBERT POLLACK
13 JUDGE JAMIE WISZ
14 JUDGE JEFFREY FREDMAN

15 * * * * *

1 This hearing is being held via
2 telephonic remote dial in.

3 The reporter will do his/her level
4 best to capture the proceeding
5 accurately, but errors or omissions may
6 occur resulting from faults in
7 transmission, speaker identification,
8 and simultaneous crosstalk.

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1 MR. POLLACK: We are on the record.
2 This conference call is for IPR 2023 –
3 00894 involving Petitioner Fusion
4 Orthopedics LLC and Patent Owner
5 Extremity Medical LLC.

6 I'm Judge Pollack. With me are
7 Judges Wisz and Fredman. Who is on the
8 line for Patent Owner Extremity Medical?

9 MR. FERRARO: Hi, good morning.
10 This is Vincent Ferraro on behalf of
11 Patent Owner, Extremity Medical LLC.

12 MR. POLLACK: Good morning. Who is
13 on the line for Petitioner, Fusion
14 Orthopedics?

15 MR. KAMHOLZ: Good morning, this is
16 Scott Kamholz, backup counsel for Fusion
17 Orthopedics. I'm joined by lead
18 counsel, Jennifer Brinkerhoff.

19 MR. POLLACK: Thank you. I
20 understand there's a court reporter on
21 the line, so the parties shall submit a
22 transcript of this call, which shall
23 serve as the record of the proceeding.

24 According to its May 28 e-mail,
25 Patent Owner seeks to extend Due Date 3,

1 but it does not specify how this will
2 entail further compression of schedule.

3 Due Date 8, oral argument for
4 question, was moved from August 15 to
5 September 6, pushing it close to the
6 statutory deadline for entry of a final
7 decision.

8 In the event Patent Owner were to
9 file a revised motion to amend the date,
10 it would be further pushed to the week
11 of September 13, internal schedules
12 permitting.

13 At our request, Patent Owner has
14 proposed one- and two-week extension
15 scenarios with and without any revised
16 motion to amend.

17 Petitioner has not opined on
18 whether any of these specific proposals
19 links to Patent Owner's request to
20 extend due dates.

21 Petitioner seeks leave to strike or
22 quash notices of deposition served on
23 Jacobsen and Dominguez on May 28 and
24 June 11, and Kamholz set for June 12.

25 Based on our initial review of the

1 parties' correspondence, each of these
2 notices appear to be issued in violation
3 of at least the spirit, if not the
4 letter of the rules, specifically the
5 implicit meet and confer requirement of
6 37 CFR 42.53 D1, and the inherently
7 related 37 CFR 42.53 D2, which by our
8 calculation includes an expectation that
9 cross examination of Petitioner's
10 witnesses would be completed by June 5,
11 i.e., more than a week before Due Date
12 3.

13 I realize that the two issues
14 before us are necessarily linked, but we
15 need to start somewhere, so let's begin
16 with the due date issue.

17 Mr. Ferraro, would you please begin
18 with why you believe an extension of due
19 dates is necessary, and how this may be
20 alleviated by your proposed schedules.

21 First, with respect to the
22 multiplicity of proposed schedules, can
23 Patent Owner presently commit to either
24 filing or not filing a revised motion to
25 amend, such that we can take some of

1 these off the table? Mr. Ferraro?

2 MR. FERRARO: Yes, so good morning,
3 your Honors. We view this as sort of a
4 straightforward request for an extension
5 in terms of, we don't believe it will
6 affect -- materially affect the
7 schedule.

8 It's -- the deadline, the extension
9 is requested, as I stated in our e-mail,
10 to give us the appropriate amount of
11 time to review the extensive amount of
12 materials that Petitioner filed with its
13 reply, which is really an unusual amount
14 of documents.

15 I think it was over 35 additional
16 new exhibits, including three new
17 declarations, and it's also to -- the
18 extension is also necessitated by
19 counsel's scheduling conflicts and
20 travelings that it did in May, as well
21 as coming up in June.

22 So we think the two weeks is
23 necessitated for those two reasons, and
24 we don't believe it will affect --
25 materially affect the schedule as

1 outlined in our four proposals.

2 With respect to the revised motion
3 to amend, is the question whether we are
4 going to file one, or are foregoing one?
5 I just want to be clear as to what
6 you're looking on that front.

7 MR. POLLACK: That is my question.
8 Are you -- can you commit to you will
9 file one, or can you commit to you will
10 not file one, so that we can talk about
11 two out of these four instead of all
12 four of them?

13 MR. FERRARO: So, excuse me, if --
14 being totally --

15 MR. POLLACK: I don't care which
16 way you're going, but tell me which one.
17 It will help.

18 MR. FERRARO: We didn't make a
19 final decision on that. We are
20 amenable.

21 I will say we are amenable if the
22 board is willing to agree to the
23 extension, if we, say, don't revise,
24 that's something that we would be
25 agreeable to here in order to get the

1 extension.

2 But we haven't affirmatively
3 said — I'm sorry, not said, but didn't
4 decide whether we are going to revise
5 the motion to amend or not, but we are
6 willing to potentially forego it should
7 that assist the board in making their
8 determination on an extension.

9 MR. POLLACK: All right. Before we
10 move onto the deposition issue,
11 Mr. Kamholz, would you like to respond?

12 MR. KAMHOLZ: Yes, Judge. Thank
13 you.

14 In Petitioner's view, the Patent
15 Owner manufactured this crisis. It
16 waited three weeks to ask Petitioner for
17 an extension.

18 Patent Owner has not given a
19 consistent explanation either for why it
20 waited three weeks from Petitioner's
21 opposition to motion to amend to ask us
22 for an extension.

23 When patent owner first reached out
24 to Petitioner on May 24 at 3~o'clock in
25 the afternoon before Memorial Day

1 weekend, it said only that it needed an
2 extension due to scheduling conflicts.

3 But four days later, Patent Owner
4 instead chose to tell the board that it
5 needed the extension to review the
6 unusually extensive amount of new
7 material.

8 I submit that it is fundamentally
9 dishonest of Patent Owner to give
10 Petitioner one explanation and to give
11 the board another.

12 That aside, Patent Owner has been
13 on notice of the schedule since trial
14 was instituted in November. Patent
15 Owner chose to engage the motion to
16 amend preliminary guidance procedure
17 back in February.

18 Patent Owner therefore knew that a
19 serious schedule crunch could be coming,
20 and that time would be of the essence.

21 Patent Owner knew that a revised
22 motion to amend could add another
23 potential three briefs and two discovery
24 periods to the schedule.

25 So even if Patent Owner had a large

1 amount of new evidence and material to
2 consider, it was entirely unjustified in
3 sitting on its hands for three weeks.

4 Is this a truly unmanageable amount
5 of material? From my experience
6 spanning hundreds of IPRs, it doesn't
7 seem so.

8 The board managed to analyze 50
9 pages of briefing on the motion to
10 amend, considered two expert declaration
11 and other pieces of evidence in support
12 of those briefs, and issued preliminary
13 guidance on a motion to amend, all
14 within four business days.

15 Granted, the board did not have to
16 consider the Petitioner's reply brief,
17 but the brief and its evidence is not so
18 much more material to be unmanageable in
19 the time allotted.

20 Patent Owner, in suggesting that
21 all we're talking about is a two-week
22 extension here, is also somewhat
23 ingenuous, because patent owner will be
24 able to submit new declarations with its
25 reply.

1 And if so, Petitioner will require
2 time to take those depositions, which
3 means that Petitioner will require an
4 extension of time on its deadlines as
5 well.

6 So we are actually talking about
7 pushing dates back by at least four
8 weeks.

9 Now, it's ultimately the board's
10 decision how much time it needs to
11 render a final written decision, but I
12 think the proposal that the Patent Owner
13 put out are all unreasonable.

14 In light of that, we can get into
15 the details before we move on, if you
16 wish.

17 MR. POLLACK: Please.

18 MR. KAMHOLZ: With regards to
19 proposal number 1 — actually, if I may
20 back up and say as a preface, we're all
21 busy professionals on this line, of
22 course, and we all have to manage
23 professional obligations as well as
24 personal obligations.

25 We all recognize that deadlines in

1 contested matters is really -- in any
2 kind of work has to move, but we also
3 have to have a certain degree of
4 certainty.

5 There's one particular issue that
6 Ms. Brinkerhoff brought to my attention,
7 namely that her son will be undergoing
8 surgery on August 9, and that she
9 specifically chose that date to schedule
10 the surgery so as to be outside all of
11 the deadlines so that she could give her
12 full attention to this matter and then
13 give her full attention to her son.

14 Any of the proposed schedule
15 changes will involve impingement on that
16 date. For that reason alone, Petitioner
17 is opposed to all of the schedule
18 changes.

19 But with more particularity to the
20 four proposals, proposal number 1 moves
21 back Due Date 5 by one week without
22 giving Petitioner any extra time.

23 Therefore, Patent Owner has an
24 additional week for its reply, and
25 Petitioner has no additional time.

1 Now Petitioner can agree to this
2 schedule if Patent Owner agrees that it
3 will file no more than one declaration
4 with its reply in support of its motion
5 to amend, otherwise Petitioner requests
6 that Due Date 5 be adjusted to August 9.

7 Due Date 6 and 7 can be left as is.
8 It's not clear how this will affect the
9 timing of events leading up to the
10 hearing, for example, the due dates for
11 exchanging demonstratives or having a
12 prehearing conference to address any
13 objections to those.

14 I think the board would have to
15 work that out, as well, as part of
16 resolving this proposal.

17 As for proposal number 2, which is
18 a two-week extension without a revised
19 motion to amend, Petitioner considers
20 this proposal completely untenable, even
21 if Due Date 5 is adjusted to say
22 August 16, 2024, and Patent Owner agrees
23 it will file no more than one
24 declaration with its reply because of
25 the conflict I mentioned earlier

1 concerning Ms. Brinkerhoff.

2 If the board were of a mind to
3 adopt this proposal, we would request at
4 least August 16 as the adjustment for
5 Due Date 5, and that Patent Owner be
6 limited to one declarant and also that
7 Patent Owner be required to identify in
8 its service e-mail with that submission
9 at least six dates on which its sole
10 declarant would be available for
11 deposition between July 11 and August 8
12 so that we have a fair opportunity to
13 schedule that deposition without the
14 added pressure of real time
15 negotiations.

16 Petitioner will undertake to select
17 one of those dates within five business
18 days of service in order to minimize
19 uncertainty to Patent Owner's declarant.

20 As for proposal number 3, which is
21 a one-week extension in the context of a
22 revised motion to amend, Petitioner
23 considers Patent Owner's proposal
24 entirely unreasonable because it has not
25 given even six weeks for the opposition

1 to the revised motion to amend.

2 Patent Owner's revised motion to
3 amend will by definition raise new
4 issues that Petitioner will have to
5 explore in deposition of Patent Owner's
6 new declarants, however many there are,
7 and also a new declaration by
8 Petitioner.

9 Patent Owner then gives itself
10 three weeks for its reply to the revised
11 motion to amended, again, with the
12 possibility of new declarations.

13 But it gives Patent Owner a scant
14 week, that is five business days, to
15 conduct any and all depositions and to
16 draft a reply.

17 Petitioner submits this is
18 fundamentally unreasonable, and
19 Petitioner cannot be expected to
20 accomplish all that in five business
21 days.

22 The motion to amend pilot program
23 notice suggests equal time for each
24 briefing paper. The problem, however,
25 is that there is not enough time left in

1 the schedule to accommodate that
2 briefing schedule, because it would push
3 everything very close to the oral
4 hearing and would probably have to push
5 the oral hearing itself uncomfortably
6 close to the final written decision
7 deadline.

8 I reiterate this urgency and time
9 crunch are entirely the fault of Patent
10 Owner for having sat on its hands for
11 three weeks after receiving the
12 opposition to the motion to amend, and
13 over two weeks, even after the board's
14 preliminary guidance.

15 Furthermore, if Patent Owner is
16 going to file a revised motion to amend,
17 then Petitioner submits it's unnecessary
18 for them to take depositions of
19 Mr. Jacobsen or Mr. Kamholz because
20 their evidence relates entirely to the
21 new issue in the motion to amend, nor
22 should they need to take Mr. Dominguez's
23 testimony -- D-O-M-I-N-G-U-E-Z -- on the
24 abandoned motion to amend because that
25 subject matter will be moot in view of

1 the revised motion.

2 But Petitioner simply does not see
3 how a revised motion to amend can be
4 reasonably accommodated in the schedule
5 without significant limitations on what
6 the parties can do.

7 And so I -- for those reasons,
8 proposal 4, I think, is completely
9 beyond even consideration, because of
10 the effect on the schedule.

11 That's all I have.

12 MR. POLLACK: All right,
13 Mr. Ferraro, response? Mr. Ferraro, are
14 you on mute?

15 MR. FERRARO: I'm sorry, I was on
16 mute. I apologize.

17 I will take it from the top here.
18 I will try to go in order of -- in
19 response to Mr. Kamholz, but I just
20 think as an initial matter, to
21 characterize that we sat on our hands or
22 there's any foul play going on here just
23 is not correct.

24 I mean, as Mr. Kamholz
25 acknowledges, we're all professionals

1 here. We're all working within tight
2 timelines.

3 To suggest there's nefarious
4 motives here or a lack of diligence is I
5 think improper and really not called for
6 here.

7 But we will move along from that.
8 The first couple weeks, just to give
9 some background, your Honor, the first
10 week or two of receiving the reply, both
11 myself and backup counsel had some
12 extensive travel.

13 So while we were reviewing --
14 starting to review the materials, we
15 were set back a little bit at the
16 get-go.

17 Then after having reviewed all of
18 the extensive amount of materials is
19 when we realized we're going to need a
20 short extension here. That's how we got
21 to where we are.

22 In connection with his --
23 Mr. Kamholz's objections to the
24 schedule, you know, as an initial
25 matter, I will say we submitted our

1 schedule and Mr. Kamholz certainly had
2 an opportunity to submit his own
3 schedule as invited by the board, or
4 even reply to ours as we submitted it
5 last night, so he certainly had
6 sufficient time to sort of set forth his
7 positions beforehand.

8 I will also say that the August 9
9 date argument from Mr. Kamholz is sort
10 of belied by the rest of his argument,
11 where he even, in connection with the
12 first schedule, the first proposal,
13 he's -- Mr. Kamholz suggested to move
14 one of Petitioner's dates to August 9.

15 So there's just a total
16 contradictory -- total contradiction
17 there.

18 We didn't -- we didn't put in any
19 additional time outside of what is
20 normally required for Petitioner.

21 We felt that if Petitioner needed
22 the additional time, they would ask for
23 it, and as I guess he's doing on the
24 call, I also -- it's not clear to me how
25 Petitioner would know they need more

1 time before seeing anything.

2 They're inherently asking for
3 extensions before they have seen what
4 has been filed to know whether they
5 actually need an extension.

6 They're just asking for an
7 extension because we may be getting an
8 extension. I'm not saying we're opposed
9 to that, but I want to point that out to
10 the judges.

11 MR. POLLACK: Our schedule is
12 fixed. We have a statutory deadline.

13 Whatever gets packed into the time
14 before oral hearing gets packed in. I
15 cannot fault Mr. Kamholz for making sure
16 that he doesn't get squeezed because you
17 need more time.

18 MR. FERRARO: Understood. I guess
19 my response to that would just be that
20 our proposals gave him the same amount
21 of time.

22 We didn't squeeze Petitioner's
23 time. We didn't give them any extension
24 before anything has been filed. But --
25 let me see.

1 I think the -- I'm just looking at
2 the rest of the proposals. I don't
3 necessarily agree that we would have to
4 acquiesce to sort of one declarant, as
5 Petitioner is asking, for in connection
6 with proposal 2.

7 I'm not sure -- to be frank, I'm
8 not sure we need more than one
9 declarant, but it seems kind of an
10 abusive request to try to limit how many
11 declarants we can use beforehand.

12 As for the revised motion to amend
13 schedules, I note that we -- we did
14 provide six weeks for Petitioner to
15 respond or oppose the revised motion to
16 amend.

17 I acknowledge, though, that there
18 is only one week. So, for example, for
19 proposal 3, certainly we would be
20 amenable to giving them extra time.

21 I recognize that that one week -- I
22 think that was just an oversight. All
23 this is just to say Patent Owner is
24 willing to have a back and forth with
25 the board and Petitioner to try to make

1 this all work, and we would appreciate
2 if the board would consider the
3 extension.

4 MR. POLLACK: All right. We will
5 let that sit for a minute.

6 Let's go on to the related issue of
7 the deposition notices. As I read our
8 rules, cross examination of Petitioner's
9 witnesses should have been completed by
10 June 5, and it sounds like on May 28
11 they were served with notices that
12 hadn't been discussed beforehand for
13 June 11 and 12, well passed the expected
14 date.

15 Mr. Ferraro, do you want to address
16 why this is so?

17 MR. FERRARO: Yes. So they're sort
18 of related to what we were talking
19 about.

20 We took the tack of reviewing
21 everything first and seeing if we needed
22 to take depositions, and so we served
23 them once we realized we needed them.

24 We didn't think we violated any
25 rules, the actual letters of the rules.

1 As you noted earlier in the call, D2, 37
2 CFR 42.53 D2 says ordinarily shall be
3 completed, so it's not a hard deadline
4 in our view.

5 And D1 says they should be -- that
6 the actual date and time are actually
7 negotiated, but they don't have to be
8 negotiated before any deposition notices
9 are served -- or filed, rather.

10 We didn't think we violated any
11 rules. And we also -- the reason why,
12 how this came about, as I just
13 explained, we wanted to review the
14 extensive amount of material and then
15 make the determination rather than kind
16 of shoot from the hip and then ask
17 questions later.

18 I recognize, and we appreciate that
19 we certainly could have done that. It
20 might have been good to do that as well.
21 We felt we were being reasonable in our
22 approach, as well.

23 MR. POLLACK: Mr. Kamholz?

24 MR. KAMHOLZ: I have nothing to
25 add.

1 MR. POLLACK: We're going to put
2 you on mute --

3 MR. FERRARO: Your Honor, I'm sorry
4 to jump in.

5 I wanted you to be aware, we did
6 ask for the board's request -- per the
7 board's request, we're in the process of
8 negotiating dates for that -- that would
9 fit within the deadline that you're
10 suggesting under D2, 37 CFR 42.53 D2.

11 So we asked for deposition dates
12 that would fit within the time frame.
13 We were negotiating that with
14 Mr. Kamholz just before the call.

15 MR. POLLACK: Excellent. All
16 right. Putting you on hold for now,
17 unless there's anything from
18 Mr. Kamholz?

19 MR. KAMHOLZ: I confirm that Mr.
20 Ferraro and I have been discussing those
21 dates. In Petitioner's view, we will
22 not make our witnesses available for
23 deposition unless the board indicates
24 that those depositions should be taken,
25 but I think Mr. Ferraro and I are near

1 agreement on what the dates would be if
2 the board is so inclined.

3 MR. POLLACK: All right. Just for
4 reference, what dates are -- are at
5 least on the table right now?

6 MR. KAMHOLZ: June 5 and June 6.

7 MR. POLLACK: All right. Thank
8 you.

9 (Brief recess taken.)

10 MR. POLLACK: All right. The panel
11 has conferred.

12 We find Patent Owner provided four
13 proposed revised Due Date schedules.
14 Petitioner is amenable to schedules
15 numbers 1 through 3, with certain
16 conditions.

17 The parties are instructed to meet
18 and confer to determine whether they can
19 agree on one of those proposals, subject
20 to Petitioner's conditions.

21 If so, they may request that the
22 board enter a new scheduling order,
23 subject to the agreed upon conditions.

24 In any event, Due Date 8 will not
25 be extended, absent agreement. The

1 present schedule will remain in effect.

2 The panel notes that the parties
3 are negotiating deposition dates for
4 June 5 and 6.

5 As this negotiation appears to be
6 advancing, the panel need not involve
7 themselves at this time. Are there any
8 other matters or questions that we
9 should deal with now?

10 MR. FERRARO: This is Vin Ferraro.
11 None that I can think of at the moment.

12 MR. POLLACK: Mr. Kamholz?

13 MR. KAMHOLZ: Nothing from me.

14 MR. POLLACK: All right. Thank you
15 gentlemen, this call is concluded.

16 (Proceeding concluded at 11:35
17 a.m.)

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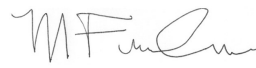
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C E R T I F I C A T E

I, MICHAEL FRIEDMAN, a Certified Court
Reporter of the State of New Jersey, certify that
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Dated: June 1, 2024