

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 ROBERT A. POLLOCK, TIMOTHY G. MAJORS, and
JAMIE T. WISZ, *Administrative Patent Judges*.

POLLOCK, *Administrative Patent Judge*.

ORDER
Conduct of proceeding
37 C.F.R. § 42.5

On June 28, 2024, in response to the parties' emails from June 25, 2024 (Exs. 3013), Judges Pollock, Majors, and Wisz conducted a conference call with counsel for both parties to discuss Petitioner's request to file a motion to strike the following:

1. Patent Owner's Revised Motion to Amend (rMTA) (Paper 44);
2. The portion of Mr. Leonel Dominguez's deposition transcript relied upon in Patent Owner's Revised Motion to Amend and surrounding related testimony (Ex. 2022, 110:3–114:24);
3. The first full paragraph on page 8 of Patent Owner's Sur-Reply (Paper 43) and Exhibits 2024–2027 cited therein; and
4. Footnote 3 on page 6 of Patent Owner's Sur-Reply (Paper 43) and Exhibits 2032–2036 cited therein.

In the alternative, Petitioner requested that the Board issue an order to Patent Owner to show cause as to why the above-listed items should not be stricken. Patent Owner opposed Petitioner's requests and declined to withdraw any of the above-listed items. Our analysis of each of Petitioner's requests is below.¹

1. Patent Owner's Revised Motion to Amend

Petitioner contends that Patent Owner's Revised Motion to Amend (Paper 44) is improper because Patent Owner abandoned its proposed amendments from the Motion to Amend (Paper 26) in favor of a second set of amendments unrelated to issues raised in the Board's Preliminary Guidance on Patent Owner's Motion to Amend (Paper 32) and Petitioner's Opposition to Patent Owner's Motion to Amend (Paper 29). According to

¹ We also addressed the standards of courtesy and decorum applicable to all aspects of these proceedings. *See* 37 CFR 42.1(c).

Petitioner, Patent Owner's Revised Motion to Amend thus violates the terms of the Motion to Amend Pilot program because "[a] revised MTA must provide amendments, arguments, and/or evidence in a manner that is responsive to issues raised in the preliminary guidance and/or petitioner's opposition" and "[a] revised MTA may not include amendments, arguments, and/or evidence that are unrelated to issues raised in the preliminary guidance and/or petitioner's opposition to the MTA." Ex. 3013 (citing Notice Regarding a New Pilot Program Concerning Motion to Amend Practice and Procedures in Trial Proceedings under the America Invents Act before the Patent Trial and Appeal Board, 84 Fed. Reg. 9,497, 9500 (Mar. 15, 2019)).

We do not find Petitioner's arguments persuasive and denied Petitioner's request to file a motion to strike Patent Owner's Revised Motion to Amend and denied Petitioner's request to enter an order to show cause. In short, we agree with Patent Owner that its second set of amendments seeks to address written description issues raised in the Board's Preliminary Guidance and Petitioner's Opposition to Patent Owner's Motion to Amend. At Petitioner's request, however, we authorized Petitioner to revisit its arguments in its Opposition to Patent Owner's Revised Motion to Amend.

2. The portion of Mr. Leonel Dominguez's deposition transcript relied upon in Patent Owner's Revised Motion to Amend and surrounding related testimony

In light of our decision to deny Petitioner's request to file a motion to strike Patent Owner's Revised Motion to Amend and Petitioner's request to enter an order to show cause, Petitioner withdrew its request to file a motion to strike the portion of Mr. Leonel Dominguez's deposition transcript relied

upon in Patent Owner's Revised Motion to Amend and surrounding related testimony.

3. *The first full paragraph on page 8 of Patent Owner's Sur-Reply and Exhibits 2024–2027 cited therein, and Footnote 3 on page 6 of Patent Owner's Sur-Reply and Exhibits 2032–2036 cited therein*

Petitioner seeks to file a motion to strike the first full paragraph on page 8 of Patent Owner's Sur-Reply (Paper 43) and Exhibits 2024–2027 cited therein, and footnote 3 on page 6 of Patent Owner's Sur-Reply and Exhibits 2032–2036 cited therein as new arguments and evidence violating 37 CFR § 42.23(b). Petitioner contends the exhibits are not part of Mr. Dominguez's expert declaration and were not part of the record prior to Patent Owner filing its Sur-Reply. Patent Owner contends the exhibits and arguments are responsive to arguments in Petitioner's Reply (Paper 28).

During the call, we discussed giving Petitioner the option of substantively responding to the allegedly new arguments and evidence in Patent Owner's Sur-Reply in, for example, a subsequent brief that would be filed by Petitioner, and further inquired whether Petitioner believed any further discovery would be needed in support of any such written filing. In response, Petitioner instead requested leave to address Patent Owner's arguments during the upcoming oral argument currently set for September 13, 2024.

We denied Petitioner's request to file a motion to strike and denied Petitioner's request to enter an order to show cause, but granted Petitioner's request to address the first full paragraph on page 8 of Patent Owner's Sur-Reply (Paper 43) and Exhibits 2024–2027 cited therein, and footnote 3 on page 6 of Patent Owner's Sur-Reply and Exhibits 2032–2036 cited therein

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during the oral argument. We also provided that Petitioner may, at its discretion, file a Sur-Sur-Reply of no more than three pages to preview its arguments regarding these issues no later than August 7, 2024.

ORDER

Accordingly, it is:

ORDERED that Petitioner's requests to file a motion to strike are *denied*;

FURTHER ORDERED that Petitioner's requests that the Board issue an order to Patent Owner to show cause are *denied*;

FURTHER ORDERED that Petitioner may address the first full paragraph on page 8 of Patent Owner's Sur-Reply (Paper 43) and Exhibits 2024–2027 cited therein, and footnote 3 on page 6 of Patent Owner's Sur-Reply and Exhibits 2032–2036 cited therein during the oral argument currently set for September 13, 2024;

FURTHER ORDERED that Petitioner may file a Sur-Sur-Reply of no more than three (3) pages to preview its arguments regarding the first full paragraph on page 8 of Patent Owner's Sur-Reply (Paper 43) and Exhibits 2024–2027 cited therein, and footnote 3 on page 6 of Patent Owner's Sur-Reply and Exhibits 2032–2036 cited therein no later than August 7, 2024. Any such paper shall not introduce new evidence.

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