

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

**PATENT OWNER'S MOTION TO EXCLUDE EVIDENCE
PURSUANT TO 37 C.F.R. § 42.64**

I. INTRODUCTION

Pursuant to 37 C.F.R. § 42.64(c), the Parties' Joint Request to Enter Agreed Revised Schedule (Paper 40), and the Federal Rules of Evidence, Patent Owner Extremity Medical, LLC ("Patent Owner") hereby moves to exclude certain exhibits submitted by Petitioner Fusion Orthopedics, LLC ("Petitioner"), namely, portions of Exhibit 1054 and 1018, as well as Exhibits 1034-1038, 1045-1050, and 1064 in their entirety. This evidence is inadmissible under at least Federal Rules of Evidence ("FRE") 401-403, as explained below.

II. ARGUMENT

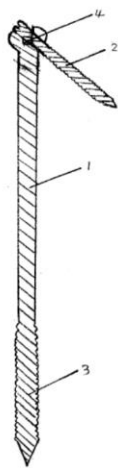
A. The Portions of Exhibit 1054 That Rely on the Purported Model of Zhang's Assembly Should Be Excluded

Petitioner relies on the Zhang reference (Exs. 1058 and 1059) in its Opposition to Patent Owner's Revised Contingent Motion to Amend (Paper 49). Paragraphs [002] and [022]-[024] of Exhibit 1054 contain expert opinions that refer to and/or are based on a three-dimensional model (hereinafter, the "Zhang Interpretation Model") purportedly of the assembly shown in the single figure in the Zhang reference and created at Petitioner's request. Patent Owner timely objected to these paragraphs of Exhibit 1054. See Paper 52, pp. 1-2.

First, these opinions should be excluded as inadmissible because the Zhang Interpretation Model is irrelevant to the issues in this case under Federal Rules of Evidence 401 and 402. See Fed. R. Evid. 401, 402. Any information contained in

the Zhang Interpretation Model that goes beyond the actual figure in the Zhang reference is, by definition, not part of Zhang, and therefore, is speculative and irrelevant to any issue in the proceedings. *Second*, even if the model is found to have some probative value, the related opinions should be excluded under Federal Rule of Evidence 403 because any such value is substantially outweighed by the danger of unfair prejudice to Patent Owner and confusing the issues. *See* Fed. R. Evid. 403.

Under FRE 401 and 402, the Zhang Interpretation Model is irrelevant to the issues in this case. In making its determinations as to patentability, the Board focuses on what a prior art reference discloses. The model does not help the Board make these determinations because it adds a significant amount of speculative detail not provided in the Zhang reference itself. The model does this in at least three ways, which are readily apparent from a side-by-side comparison of the two:



Zhang Interpreted Model

Zhang Reference (Exhibit 1058), Figure

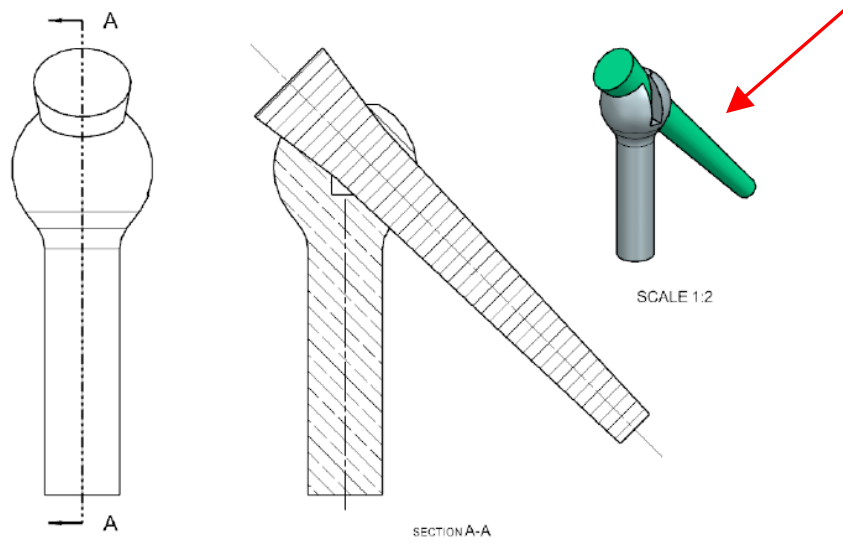
First, the Zhang Interpretation Model literally adds an entire dimension to Zhang's figure, thereby adding detail that Zhang's two-dimensional figure, by definition, cannot and does not provide. *Second*, the model provides much higher resolution than Zhang's figure, and focuses on the miniscule head portion of Zhang's nail on which Petitioner contends an aperture is formed, despite the fact that Zhang's low-resolution figure shows the entire nail without focusing on the head portion. *Third*, Zhang's singular figure shows only one perspective (*i.e.*, a cross-sectional view), which alone is not enough to create an accurate three-dimensional model.

Regarding FRE 403, *first*, weighing the probative value against potential dangers the rule is meant to prevent, the Zhang Interpretation Model's probative value (if any) is very limited. Zhang's figure speaks for itself. To the extent Petitioner relies on the model to demonstrate what Zhang's figure shows, Petitioner could have simply argued (and more properly should have argued) what Zhang's actual figure allegedly shows. Petitioner did not do this, of course, because Zhang's figure does not show what Petitioner would like it to show. The Board can and should consider Zhang's figure alone for what it shows. The Board need not and should not consider extrinsic evidence for this purpose.

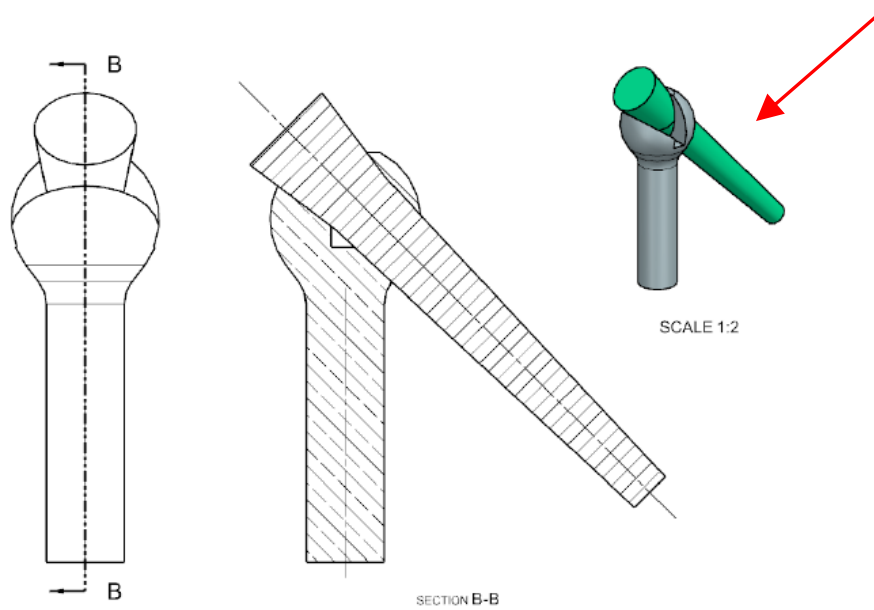
Second, any possible probative value of the Zhang Interpretation Model is substantially outweighed by a danger of unfair prejudice to Patent Owner and a

danger of confusing the issues. Petitioner misleadingly wants the Board to believe that the Zhang Interpretation Model is *the* factually correct model of Zhang's assembly. Not so. It is not only totally speculative that the Zhang Interpretation Model shows how Zhang would look *if* we had a 3-D model of it in the patent, but also very unlikely. As Patent Owner's expert Dr. Eric Ledet opined, there are, in fact, many possible interpretations of Zhang's figure, and no one 3-D model can claim to be the correct one. Ex. 2037, ¶ 44.

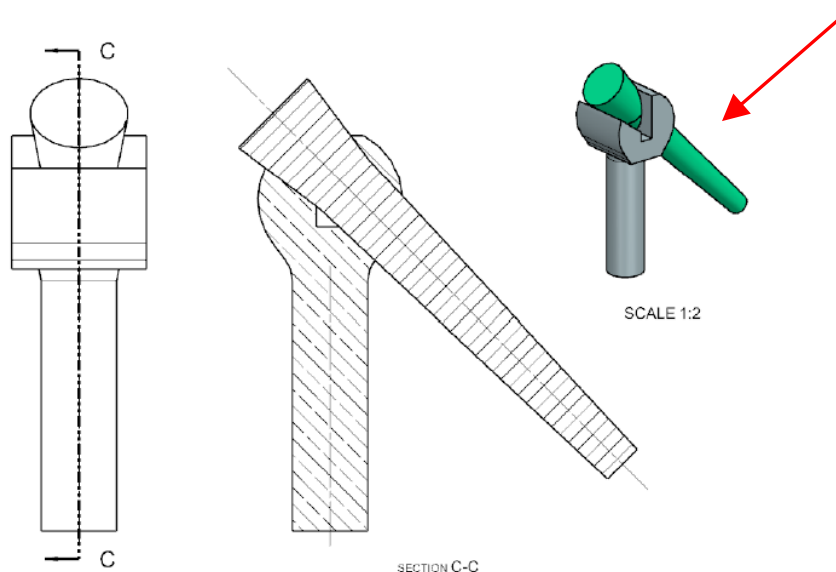
To illustrate this point, Dr. Ledet had three-dimensional models prepared in a manner similar to the one in which the Zhang Interpretation Model was prepared, but according to three alternative potential designs that are equally plausible. *Id.* As seen in the below screenshots of those models, the cross-sectional view for each of the three models (*i.e.*, "Section A-A," "Section B-B," and "Section C-C") looks exactly the same, despite the models comparatively having very different geometries in the head portion (as shown in the right-most figure for each model indicated by the red arrows). *Id.*



Ex. 2039 (First Alternative Zhang Model)



Ex. 2039 (Second Alternative Zhang Model)



Ex. 2039 (Third Alternative Zhang Model)

In short, a single (and not particularly clear) cross sectional view like the one in Zhang cannot be used to accurately extrapolate with any accuracy what the head in Zhang would look like. Indeed, it is impossible to know exactly what the head portion of Zhang's assembly actually looks like based on Zhang's actual figure alone. The Zhang Interpretation Model and Dr. Ledet's models show that there are several possibilities, and the Zhang Interpretation Model is not even necessarily the most likely one. The risk in giving any credence to the Zhang Interpretation Model, then, is that the Zhang Interpretation Model will be considered a substitute for Zhang's figure—which it is indisputably not – or in conjunction with Zhang's figure, which is not appropriate because it is not part of Zhang and shows much more than Zhang discloses. It cannot properly be used to plug the holes Petitioner is trying to plug in Zhang. Again, the reference speaks for itself.

Accordingly, paragraphs [002] and [022]-[024] of Exhibit 1054 should be excluded.

B. Exhibits 1034-1038, 1045-1050, and 1064 and the Portions of Exhibit 1054 That Relies on the Same Should Be Excluded

Exhibits 1034-1038, 1045-1050, and 1064 all concern three-dimensional models purportedly based on: (1) Figure 18 of U.S. Pat. No. 11,298,166 (the subject patent in this proceeding, hereinafter “the ’166 Patent”) and (2) Figures 9-11 of the ’166 Patent (collectively, the “’166 Patent Interpretation Models”) and created at Petitioner’s request. *See generally* Paper 30; Ex. 1051. Patent Owner timely objected to these exhibits. *See* Paper 33, pp. 3-4; Paper 52, p. 3.

First, these exhibits should be excluded as inadmissible because the ’166 Patent Interpretation Models are irrelevant to the issues in this case under Federal Rules of Evidence 401 and 402. *See* Fed. R. Evid. 401, 402. Any information contained in the models that goes beyond the actual figures in the ’166 Patent is, by definition, not part of the ’166 Patent, and therefore, is speculative and irrelevant here. *Second*, even if the models are found to have some probative value, they (and the related exhibits) should be excluded under Federal Rule of Evidence 403 because their value is substantially outweighed by a danger of unfair prejudice to Patent Owner and confusing the issues. *See* Fed. R. Evid. 403.

Under FRE 401 and 402, the ’166 Patent Interpretation Models are irrelevant to the issues in this case. In making its determinations as to patentability, the

Board should focus on what the '166 Patent discloses. But the models do not help the Board make these determinations because they add a significant amount of speculative detail not provided in the '166 Patent itself. Specifically, and similar to the Zhang Interpretation Model, the '166 Patent Interpretation Models add an entire dimension to the '166 Patent's figures.

Regarding the weighing of probative value against potential dangers under FRE 403, *first*, the '166 Patent Interpretation Models' probative value (if any) is very limited. The '166 Patent's figures speak for themselves. To the extent Petitioner relies on the models to demonstrate what the '166 Patent's figures show, Petitioner could have simply argued (and more properly should have argued) what the actual figures allegedly show. Again, the fact that Petitioner did not do this underscores that the '166 Patent's figures do not show what Petitioner needs them to show in order to prevail. On the other hand, to the extent Petitioner relies on the models to demonstrate what the '166 Patent's figures allegedly *do not* show, again, Petitioner could have simply argued what the actual figures allegedly do not show. The Board can and should consider the '166 Patent's figures alone for what they show. The Board need not and should not consider extrinsic evidence for this purpose.

Second, any alleged probative value of the '166 Patent Interpretation Models is substantially outweighed by a danger of unfair prejudice to Patent Owner and a

danger of confusing the issues. The risk is that the models will be considered substitutes for the '166 Patent's figure—which they are indisputably not – or in conjunction with the '166 Patent's figures, which is not appropriate because they are not part of the '166 Patent.

For the same reasons that 1034-1038, 1045-1050, and 1064 should be excluded, all portions of Exhibit 1054 that rely on those exhibits should also be excluded, including at least paragraphs [008], [023], and [024] of Exhibit 1054.

Accordingly, Exhibits 1034-1038, 1045-1050, and 1064 and at least paragraphs [008], [023], and [024] of Exhibit 1054 should be excluded.

C. Portions of Exhibit 1018 That Rely on Exhibits 1049-1050 Should Be Excluded

Paragraphs [071]-[079] of Exhibit 1018, which are responsive only to Patent Owner's *original* Motion to Amend (Paper 26), also rely on the '166 Patent Interpretation Models (and at least Exhibits 1049 and 1050). Patent Owner did not object to these portions of Exhibit 1018 earlier because, at the time Petitioner submitted Exhibit 1018, Patent Owner's original Motion to Amend was pending. Since that time, Patent Owner replaced its original Motion to Amend with its Revised Motion to Amend (Paper 44), which, in turn, rendered paragraphs [071]-[079] of Exhibit 1018 irrelevant to any issues still in this case, and therefore, inadmissible under FRE 401 and 402.

Accordingly, paragraphs [071]-[079] of Exhibit 1018 should be excluded.

III. CONCLUSION

The Board should exclude the above-identified evidence.

Respectfully submitted,

Dated: August 29, 2024

By: /Abhishek Bapna/

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CERTIFICATE OF SERVICE

I hereby certify that on August 29, 2024, a copy of the foregoing document was served via electronic mail to the following addresses for counsel for Petitioner as indicated in Petitioner's Revised Mandatory Notices (Paper 18):

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