

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ARTHREX, INC.,
Petitioner,

v.

MEDSHAPE, INC.,
Patent Owner.

IPR2025-00053
Patent 7,985,222 B2

Before JAMES A. TARTAL, TINA E. HULSE, and
MICHAEL A. VALEK, *Administrative Patent Judges*.

TARTAL, *Administrative Patent Judge*.

ORDER
Conduct of the Proceeding
37 C.F.R. § 42.5

Arthrex, Inc. (“Petitioner”) seeks leave to file a reply to the Preliminary Response of Medshape, Inc. (“Patent Owner”), along with two additional exhibits. Ex. 3001, 1. Petitioner seeks to address three issues in a reply limited to seven pages: discretionary denial under 35 U.S.C. § 314(a) and *Fintiv*, discretionary denial under 35 U.S.C. § 325(d), and whether claim 1 of the challenged patent, U.S. Patent No. 7,985,222 B2 (“the ’222 patent”), recites method steps to be performed in a particular order. *Id.* Petitioner also seeks to admit: (1) a copy of the median time-to-trial statistics for the Western District of Texas, and (2) a copy of the parties’ proposed claim constructions filed in the related district court litigation. *Id.* Petitioner argues as follows:

good cause exists, (1) on *Fintiv*, because Patent Owner’s argument does not address the median time-to-trial statistics, (2) on Section 325(d), because Patent Owner’s argument does not provide a comparison of the prosecution history references to the prior art applied, and (3) on claim construction, because there are contradictions between Patent Owner’s position that claim 1’s steps require a particular order and both (i) the prosecution history and (ii) Patent Owner’s litigation positions.

Id.

Patent Owner does not oppose Petitioner’s request to address issues of discretionary denial in a reply if limited to five pages, but opposes additional briefing on claim construction as well as the submission of any additional evidence. *Id.* Patent Owner seeks to likewise file a sur-reply. *Id.* In short, Patent Owner argues an absence of good cause for additional briefing on claim construction because Petitioner had the information it now seeks to address prior to filing a petition, but chose not to address it when it filed a petition and that Petitioner should not be permitted to revise its petition after reviewing Patent Owner’s preliminary response. *Id.*

In view of Petitioner's representations, we determine that additional briefing would be of assistance to the Board in the resolution of issues related to our determination of whether to institute *inter partes* review. We appreciate Patent Owner's agreement in regard to additional briefing concerning discretionary denial. In regard to claim construction, in light of the general presumption that method steps are not limited to the order in which they are recited, we find Petitioner's request for additional briefing warranted. We also find that the two additional exhibits Petitioner seeks to admit would be of benefit to the Board at this stage of the proceeding because they reflect pertinent, publicly available information and positions asserted by the Parties in district court.

Accordingly, it is:

ORDERED that Petitioner may file a Reply of no more than seven (7) pages, limited to the issues identified herein, on or before February 26, 2025;

FURTHER ORDERED that Patent Owner may file a Sur-reply of no more than seven (7) pages, limited to the issues identified herein, on or before March 5, 2025; and

FURTHERED ORDERED that Petitioner may file with its Reply: (1) a copy of the median time-to-trial statistics for the Western District of Texas, and (2) a copy of the parties' proposed claim constructions filed in the related litigation, and that no additional exhibits shall be filed with either the Reply or Sur-reply.

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