

From: Dorsky, Jason M. <JMDorsky@Venable.com>
Sent: Thursday, February 13, 2025 2:20 PM
To: Trials <Trials@USPTO.GOV>
Cc: Woodworth, Megan S. <MSWoodworth@Venable.com>; Oliver, Justin J. <JOliver@Venable.com>; Tapparo, Robert C. <RCTapparo@Venable.com>; Holloway, Clay <CHolloway@ktslaw.com>; Morlock, Michael <MMorlock@ktslaw.com>; Alemanni, John <jalemanni@ktslaw.com>; Koballa, Kasey <KKoballa@ktslaw.com>; Damitio, Chris <CDamitio@ktslaw.com>
Subject: Arthrex v. Medshape, IPR2025-00053 (US 7,985,222)

To the Board,

Petitioner Arthrex, Inc. respectfully seeks leave to file a reply to the POPR in IPR2025-00053.

Arthrex proposes a reply limited to seven (7) pages, and addressing only Patent Owner's arguments concerning (1) *Fintiv*, (2) Section 325(d), and (3) a claim construction that would require claim 1's method steps to be performed in a particular order.

Petitioner also requests leave to file two exhibits: (1) a copy of the median time-to-trial statistics for the W.D. of Texas, and (2) a copy of the parties' proposed claim constructions filed in the related litigation.

Petitioner can address good cause for the reply during a conference call. However, to summarize, 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.

Counsel for Petitioner has conferred with counsel for Patent Owner. Patent Owner's position is:

Petitioner cannot establish good cause for the preliminary reply of the scope it seeks. Petitioner does not address that fact that Patent Owner explained to Petitioner that it does not oppose Petitioner's request for a preliminary reply of five pages and limited to Patent Owner's Arguments regarding (1) *Fintiv* and (2) Section 325(d), provided Petitioner (1) agrees not to submit any new evidence with the preliminary reply, and (2) does not oppose Patent Owner receiving a sur-reply of similar length. Petitioner declined this offer and instead seeks a preliminary reply that will include new evidence and argument regarding claim construction. Petitioner cannot establish good cause for submitting such new evidence or argument. Petitioner received infringement contentions in the corresponding litigation on June 20, 2024, and the parties exchanged claim construction positions in September 2024. Petitioner chose not to address either when it filed the Petition on October 18, 2024. Similarly, Petitioner chose not to propose any term for construction in its Petition. See Paper 1 at 12-13. In any event, Patent Owner has consistently urged in briefing to the District Court and in its preliminary response that the claims require an order of steps. Thus, there is no good cause for Petitioner to revise its Petition to include new evidence and argument now, after Petitioner reviewed Patent Owner's preliminary response.

The parties are available at the following times: February 14 from 12pm to 2pm ET, February 18 from 9am to 10:30am ET, and February 20 from 10am to 12pm ET.

Respectfully,

Jason M. Dorsky
Counsel for Petitioner

Jason M. Dorsky, Esq. | Venable LLP

t 202.721.5435 | **f** 202.344.8300

600 Massachusetts Avenue, NW, Washington, DC 20001

JMDorsky@Venable.com | www.Venable.com

This electronic mail transmission may contain confidential or privileged information. If you believe you have received this message in error, please notify the sender by reply transmission and delete the message without copying or disclosing it.
