

Linden, Paul J.

From: Trials <Trials@USPTO.GOV>
Sent: Tuesday, October 22, 2024 4:21 PM
To: Linden, Paul J.; Ulrich, Paul M.; Spears, Todd A.; Bennett, John F.; Bowden, Ava; Gurka, Jon; McElligott, Andrew; Fitzgerald, Ryan; Schigelone, Jason
Cc: Trials
Subject: RE: Catalyst OrthoScience Inc. v. Shoulder Innovations; Case PGR2024-00042 (PTAB) - Petitioner's request for leave to file reply to Patent Owner's preliminary response

Counsel,

Petitioner is authorized a five page reply to Patent Owner's Preliminary Response due Wednesday, October 30, only to address the issues of (1) the trial date in the parallel district court litigation; and (2) the effective filing dates of the Lefebvre and Frankle references. Patent Owner is similarly authorized a five page sur-reply to respond to Petitioner's reply, due Wednesday, November 6. The parties may file additional evidence relating only to these issues.

Regards,

Tina

From: Linden, Paul J. <plinden@fbtlaw.com>
Sent: Tuesday, October 22, 2024 12:59 PM
To: Trials <Trials@USPTO.GOV>
Cc: Ulrich, Paul M. <pulrich@fbtlaw.com>; Spears, Todd A. <tspears@fbtlaw.com>; Bennett, John F. <jbennett@fbtlaw.com>; Bowden, Ava <abowden@fbtlaw.com>; Gurka, Jon <JGurka@crowell.com>; McElligott, Andrew <AMcElligott@crowell.com>; Fitzgerald, Ryan <RFitzgerald@crowell.com>; Schigelone, Jason <JSchigelone@crowell.com>
Subject: RE: Catalyst OrthoScience Inc. v. Shoulder Innovations; Case PGR2024-00042 (PTAB) - Petitioner's request for leave to file reply to Patent Owner's preliminary response

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To the Honorable Board,

The parties did not meet and confer telephonically because Patent Owner confirmed in its October 16 email (highlighted below) that it would oppose Petitioner's request, thus making a telephonic meet and confer fruitless and unnecessary. Patent Owner does not and cannot argue otherwise.

After eliciting additional substantive explanation to an already robust request from Petitioner, Patent Owner baldly stated its conclusion that no good cause exists for the reply, that it would oppose Petitioner's request, and that Patent Owner was only willing to discuss its own proposal regarding item 3 (October 16 email below). Indeed, even in its October 21 email below, Patent Owner failed to identify any single issue that it might seriously consider consenting to if a telephonic meet and confer were to take place or what additional information Patent Owner needs at this juncture. As such, the addition of a telephonic meet and confer to this process would have been unproductive.

Respectfully submitted,

Paul J. Linden
Backup Counsel for Petitioner

Paul Linden

Attorney at Law | Frost Brown Todd LLP

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From: Schigelone, Jason <JSchigelone@crowell.com>

Sent: Monday, October 21, 2024 5:06 PM

To: Trials@USPTO.GOV

Cc: Ulrich, Paul M. <pulrich@fbtlaw.com>; Spears, Todd A. <tspears@fbtlaw.com>; Bennett, John F. <jbennett@fbtlaw.com>; Bowden, Ava <abowden@fbtlaw.com>; Gurka, Jon <JGurka@crowell.com>; McElligott, Andrew <AMcElligott@crowell.com>; Fitzgerald, Ryan <RFitzgerald@crowell.com>; Linden, Paul J. <plinden@fbtlaw.com>

Subject: RE: Catalyst OrthoScience Inc. v. Shoulder Innovations; Case PGR2024-00042 (PTAB) - Petitioner's request for leave to file reply to Patent Owner's preliminary response

To the Board,

Patent Owner writes in response to Petitioner's e-mail requesting leave to file a reply to Patent Owner's Preliminary Response (Paper 7).

Patent Owner objects to Petitioner's e-mail request as premature, as the parties have not yet met and conferred in accordance with the Board's July 26, 2024 Notice (Paper 3). As illustrated in the e-mail chain below, Patent Owner advised Petitioner of its intent to oppose a motion for leave on October 16, 2024. Since then, Patent Owner has offered numerous dates and times to meet and confer with Plaintiffs telephonically. Instead of meeting and conferring to try to reach an agreement, Petitioner opted to jump the gun by sending the below email, in violation of the Board's requirement that a party "certify that the parties have met and conferred telephonically or in person . . . or explain why such meet and confer did not occur." (Paper 3 at 3). No such meet and confer has occurred to date, and Petitioner provides no explanation in their e-mail for their refusal to do so. Patent Owner remains open to meeting and conferring with Petitioners, to try to avoid burdening the Board with a request for unnecessary briefing.

To the extent the Board wishes to consider a motion for leave from Petitioner at this time, Patent Owner hereby objects. Petitioner has identified no good cause to warrant additional briefing here. The issues raised by Petitioner below, including foreign-language priority documents admittedly "**identified on the respective faces**" of the prior art Lefebvre and Frankle references to rebut an earlier effective filing date **identified on the face** of the challenged patent (Topic 4), are issues that Petitioner could have (and should have) developed in its Petition and/or issues that the Board is well-equipped to assess without further briefing during the preliminary phase of the proceeding (Topics 1, 2, and 5). With respect to Topic #3, moreover, the parties are discussing a neutral submission to introduce D.I. 51 (amended scheduling order in the parallel district court proceeding) into the record, thereby mooted Petitioner's request regarding that issue. (See October 21 Email from Linden to Schigelone).

Patent Owner is not available for a telephone call with the Board on Tuesday (10/22) 12p-3p ET or Wednesday (10/23) 12p-3p ET. Patent Owner can be available Thursday (10/24) 12p-5p ET; Monday (10/28) 12p-5p ET; and Tuesday (10/29) 12p-5p ET. In addition, Patent Owner can be available on Wednesday (10/30) from 1p-5p ET; Thursday (10/31) from 12p-5p ET; and Friday (11/1) from 12p-5p ET.

Respectfully submitted,

Jason W. Schigelone
Backup Counsel for Patent Owner

Jason W. Schigelone

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From: Linden, Paul J. <plinden@fbtlaw.com>
Sent: Monday, October 21, 2024 12:50 PM
To: Trials@USPTO.GOV
Cc: Ulrich, Paul M. <pulrich@fbtlaw.com>; Spears, Todd A. <tspears@fbtlaw.com>; Bennett, John F. <jbennett@fbtlaw.com>; Bowden, Ava <abowden@fbtlaw.com>; Gurka, Jon <JGurka@crowell.com>; McElligott, Andrew <AMcElligott@crowell.com>; Fitzgerald, Ryan <RFitzgerald@crowell.com>; Schigelone, Jason <JSchigelone@crowell.com>
Subject: Catalyst OrthoScience Inc. v. Shoulder Innovations; Case PGR2024-00042 (PTAB) - Petitioner's request for leave to file reply to Patent Owner's preliminary response

To the Honorable Board,

Petitioner in the above-referenced proceeding respectfully requests leave to file a reply to Patent Owner's preliminary response.

Good cause exists for the Board to grant leave under 37 CFR § 42.208(c) so that Petitioner may address what it views as inaccurate, incomplete, or misleading statements from Patent Owner's preliminary response, which, if left un rebutted, would prejudice Petitioner.

Petitioner seeks leave:

- (1) To rebut inaccurate statements Patent Owner made in its preliminary response regarding Mr. Fallin's qualifications, including Patent Owner's erroneous assertion that "Fallin identifies zero personal experience designing joint replacement systems for medical patients," which, according to Patent Owner, excludes Mr. Fallin from the definition of a POSITA and entitles his opinion to zero weight.
- (2) To rebut misleading statements Patent Owner made in its preliminary response that the April 19, 2024 Notice of Proposed Rulemaking does not include in the proposed rule itself that, under *Advanced Bionics*, Section 325(d) discretionary denial is appropriate where the same or substantially the same prior art was previously meaningfully addressed, which, as defined in the proposed rule itself, means that the Office has evaluated the art or arguments and articulated its consideration of the art or arguments in the record of the patent or the application from which the patent issues.
- (3) To complete incomplete information Patent Owner provided about the trial date in the parallel district court proceeding suggesting, with respect to the *Fintiv* factors, that the trial date could occur earlier than March 2026 without also informing the Board that the court has removed the trial date from the case schedule at this time. (*Patent Owner has proposed a neutral submission regarding this issue. Petitioner*

has rejected that idea because counsel for the parties have a poor track record of preparing joint submissions and Petitioner anticipates that the Board will allow Patent Owner to file a surreply if the Board permits Petitioner to file a reply on this issue).

- (4) To rebut Patent Owner's contention that the claimed invention should be afforded an earlier effective filing date than the Lefebvre and Frankle references and demonstrate, as it is Petitioner's right to do under *Dynamic Drinkware, LLC v. Nat'l Graphics, Inc.*, 800 F.3d 1375, 1379-80 (Fed. Cir. 2015), that these references themselves have earlier effective filing dates than the claimed invention.
- (5) To rebut Patent Owner's inaccurate statement that the petition never addresses whether Orphanos discloses the limitation that the glenosphere central channel extends from the convex articular side to the medial side of the glenosphere.

Petitioner conferred with Patent Owner regarding this request via the email exchanges below. Patent Owner has indicated that it opposes Petitioner's request.

If a hearing is necessary for the Board to weigh Petitioner's request, counsel for Petitioner is available Tuesday (10/22) 12p-3p ET; Wednesday (10/23) 12p-3p ET; Thursday (10/24) 12p-5p ET; Monday (10/28) 12p-5p ET; Tuesday (10/29) 12p-5p ET. Petitioner could be available other dates if the Board would prefer.

Despite efforts over that past 10 days to obtain Patent Owner's availability to meet with the Board, Patent Owner has not provided its availability. Counsel for Patent Owner is copied and Petitioner anticipates that Patent Owner will provide dates of availability directly to the Board.

Respectfully submitted,

Paul J. Linden
Backup Counsel for Petitioner

Paul Linden

Attorney at Law | **Frost Brown Todd LLP**

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From: Linden, Paul J.

Sent: Monday, October 21, 2024 1:47 PM

To: Schigelone, Jason <JSchigelone@crowell.com>

Cc: Ulrich, Paul M. <pulrich@fbtlaw.com>; Spears, Todd A. <tspears@fbtlaw.com>; Bennett, John F.

<jbennett@fbtlaw.com>; Bowden, Ava <abowden@fbtlaw.com>; Gurka, Jon <JGurka@crowell.com>; Fitzgerald, Ryan

<RFitzgerald@crowell.com>; McElligott, Andrew <AMcElligott@crowell.com>

Subject: RE: Catalyst OrthoScience Inc. v. Shoulder Innovations, Inc., PGR-2024-00042 (PTAB) - request for leave to file reply

Counsel,

Your continued pursuit of the "neutral submission" proposal that we have already rejected, coupled with your refusal over the last 10 days to provide dates when you are available to meet with the Board about our request for leave to file a reply, smack of dilatory gamesmanship.

We will seek leave today to file our reply on the issues we identified in our initial October 11, 2024 email to you on this matter and will provide the Board with dates we are available. You may follow up our communication directly with the Board to provide dates you are available.

Regarding the neutral submission, we will consider any draft of a neutral submission you provide and subsequently identify when we are free to meet and confer about it. If the parties can agree on a neutral submission before any reply the Board allows us to file, we will replace our discussion of issue 3 with the neutral submission.

All the best,

Paul Linden

Attorney at Law | Frost Brown Todd LLP

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From: Schigelone, Jason <JSchigelone@crowell.com>

Sent: Friday, October 18, 2024 4:06 PM

To: Linden, Paul J. <plinden@fbtlaw.com>

Cc: Ulrich, Paul M. <pulrich@fbtlaw.com>; Spears, Todd A. <tspears@fbtlaw.com>; Bennett, John F. <jbennett@fbtlaw.com>; Gurka, Jon <JGurka@crowell.com>; Fitzgerald, Ryan <RFitzgerald@crowell.com>; McElligott, Andrew <AMcElligott@crowell.com>; Bowden, Ava <abowden@fbtlaw.com>

Subject: RE: Catalyst OrthoScience Inc. v. Shoulder Innovations, Inc., PGR-2024-00042 (PTAB) - request for leave to file reply

Counsel,

We do not understand Catalyst's basis for refusing to consider a neutral submission to introduce D.I. 51 into the record, particularly as such a submission would achieve Catalyst's stated goals of "introduc[ing] the amended scheduling order (D.I. 51)" into the record and "complet[ing] [allegedly] incomplete information SI provided about the trial date," without burdening the Board (and SI) with a request for unnecessary briefing. SI remains willing to work with Catalyst to discuss a neutral submission regarding Topic 3.

We have not heard back from you regarding Catalyst's availability for a meet and confer. We are available to meet and confer on Monday October 21 from 10:30 am – 12:30 pm CT, and from 1:30 pm – 3:30 pm CT. Please let us know if either of these times work for you, or propose alternative dates/times.

We will get back to you regarding our availability to meet with the Board.

Best regards,

Jason

Jason W. Schigelone

Pronouns: he/him/his

Crowell & Moring LLP

jschigelone@crowell.com

From: Linden, Paul J. <plinden@fbtlaw.com>
Sent: Thursday, October 17, 2024 11:06 AM
To: Schigelone, Jason <JSchigelone@crowell.com>
Cc: Ulrich, Paul M. <pulrich@fbtlaw.com>; Spears, Todd A. <tspears@fbtlaw.com>; Bennett, John F. <jbennett@fbtlaw.com>; Gurka, Jon <JGurka@crowell.com>; Fitzgerald, Ryan <RFitzgerald@crowell.com>; McElligott, Andrew <AMcElligott@crowell.com>; Bowden, Ava <abowden@fbtlaw.com>
Subject: RE: Catalyst OrthoScience Inc. v. Shoulder Innovations, Inc., PGR-2024-00042 (PTAB) - request for leave to file reply

Counsel,

We did not propose, and are not interested in preparing, a “neutral submission” regarding D.I. 51 at least because counsel for the parties do not have a good track record preparing joint submissions in the past and because we anticipate the Board will permit SI a surreply for any issues it grants Catalyst leave to file a reply. Accordingly, if the Board allows Catalyst to address issue 3 in a reply, SI may discuss its position on D.I. 51 in a surreply.

Please provide dates of availability to discuss our request for leave with the Board, if necessary, during the weeks of October 14 and October 21.

All the best,

Paul Linden

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From: Schigelone, Jason <JSchigelone@crowell.com>
Sent: Wednesday, October 16, 2024 5:20 PM
To: Linden, Paul J. <plinden@fbtlaw.com>
Cc: Ulrich, Paul M. <pulrich@fbtlaw.com>; Spears, Todd A. <tspears@fbtlaw.com>; Bennett, John F. <jbennett@fbtlaw.com>; Gurka, Jon <JGurka@crowell.com>; Fitzgerald, Ryan <RFitzgerald@crowell.com>; McElligott, Andrew <AMcElligott@crowell.com>; Bowden, Ava <abowden@fbtlaw.com>
Subject: RE: Catalyst OrthoScience Inc. v. Shoulder Innovations, Inc., PGR-2024-00042 (PTAB) - request for leave to file reply

Counsel,

We disagree that good cause exists to warrant a reply here. SI will oppose Catalyst’s motion, but we are willing to discuss a neutral submission of D.I. 51 into the record. We are available to meet and confer tomorrow after 10:00 am CT, and on Friday from 10:00 am – 2:00 pm CT.

Best regards,

Jason

Jason W. Schigelone

Pronouns: he/him/his

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From: Linden, Paul J. <plinden@fbtlaw.com>

Sent: Tuesday, October 15, 2024 3:50 PM

To: Schigelone, Jason <JSchigelone@crowell.com>

Cc: Ulrich, Paul M. <pulrich@fbtlaw.com>; Spears, Todd A. <tspears@fbtlaw.com>; Bennett, John F. <jbennett@fbtlaw.com>; Gurka, Jon <JGurka@crowell.com>; Fitzgerald, Ryan <RFitzgerald@crowell.com>; McElligott, Andrew <AMcElligott@crowell.com>; Bowden, Ava <abowden@fbtlaw.com>

Subject: RE: Catalyst OrthoScience Inc. v. Shoulder Innovations, Inc., PGR-2024-00042 (PTAB) - request for leave to file reply

Counsel,

With respect to issue 3 below, we intend to introduce the amended scheduling order (D.I. 51) from the parallel district court proceeding, which had not been entered by the district court and, therefore, was not available at the time we filed our petition.

Also, with respect to issue 4 below, we intend to introduce priority documents identified on the respective faces of Lefebvre and Frankle to establish earlier effective filing dates for those references, as is Catalyst's right to do under *Dynamic Drinkware, LLC v. Nat'l Graphics, Inc.*, 800 F.3d 1375, 1379-80 (Fed. Cir. 2015), in response to SI's arguments in the preliminary response, which had not been made at the time we filed our petition.

For the remaining issues, no additional evidence will be introduced but we intend to address inaccurate, incomplete, or misleading statements SI made in its preliminary response, identified below, which we could not have anticipated SI would make at the time we filed our petition.

Catalyst will be prejudiced if it is not given an opportunity to address the items below. Decisions supporting our request are legion. See, e.g., *Lab. Corp. of Amer. Holdings v. Quest Diag. Invest. LLC*, IPR2019-00738, 2019 WL 2711250 (PTAB June 27, 2019); *SweeGen, Inc. v. PureCircle SDN BHD*, PGR2020-00070, 2020 WL 6694405 (PTAB Nov. 12, 2020); *Syngenta Crop Protection AG v. Plantlab Groep B.V.*, PGR2021-00061, 2021 WL 2944088 (PTAB July 13, 2021).

Please let us know whether SI consents to or opposes Catalyst's seeking leave from the Board to file a reply.

All the best,

Paul Linden

Attorney at Law | **Frost Brown Todd LLP**

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From: Schigelone, Jason <JSchigelone@crowell.com>

Sent: Monday, October 14, 2024 4:08 PM

To: Linden, Paul J. <plinden@fbtlaw.com>

Cc: Ulrich, Paul M. <pulrich@fbtlaw.com>; Spears, Todd A. <tspears@fbtlaw.com>; Bennett, John F. <jbennett@fbtlaw.com>; Gurka, Jon <JGurka@crowell.com>; Fitzgerald, Ryan <RFitzgerald@crowell.com>; McElligott, Andrew <AMcElligott@crowell.com>

Subject: RE: Catalyst OrthoScience Inc. v. Shoulder Innovations, Inc., PGR-2024-00042 (PTAB) - request for leave to file reply

Counsel,

Thank you for your e-mail. In order to assess your request, we need to understand the basis for Catalysts' assertion that good cause exists here. For each of the issues that Catalyst seeks leave to address, please provide a detailed explanation why Catalyst believes good cause exists to warrant a reply, including: (1) any new evidence or arguments Catalyst seeks to address in a reply, (2) why such evidence or arguments could not have been addressed in the Petition, and (3) any decisions supporting Catalyst's assertion that good cause exists here.

Best regards,

Jason

Jason W. Schigelone

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From: Linden, Paul J. <plinden@fbtlaw.com>

Sent: Friday, October 11, 2024 1:50 PM

To: Gurka, Jon <JGurka@crowell.com>; Fitzgerald, Ryan <RFitzgerald@crowell.com>; McElligott, Andrew <AMcElligott@crowell.com>; Schigelone, Jason <JSchigelone@crowell.com>

Cc: Ulrich, Paul M. <pulrich@fbtlaw.com>; Spears, Todd A. <tspears@fbtlaw.com>; Bennett, John F. <jbennett@fbtlaw.com>

Subject: Catalyst OrthoScience Inc. v. Shoulder Innovations, Inc., PGR-2024-00042 (PTAB) - request for leave to file reply

Counsel,

Catalyst OrthoScience intends to seek leave from the Board to file a reply brief in the PGR proceeding identified above.

Good cause exists for the Board to grant leave under 37 CFR § 42.208(c) so that Catalyst may address what it views as inaccurate, incomplete, or misleading statements from Shoulder Innovations' ("SI") patent owner's preliminary response, which, if left un rebutted, would prejudice Catalyst.

Catalyst intends to seek leave:

- (1) To rebut inaccurate statements SI made in its preliminary response regarding Mr. Fallin's qualifications, including SI's erroneous assertion that "Fallin identifies zero personal experience designing joint replacement systems for medical patients," which, according to SI, excludes Mr. Fallin from the definition of a POSITA and entitles his opinion to zero weight.

- (2) To rebut misleading statements SI made in its preliminary response that the April 19, 2024 Notice of Proposed Rulemaking does not include in the proposed rule itself that, under *Advanced Bionics*, Section 325(d) discretionary denial is appropriate where the same or substantially the same prior art was previously meaningfully addressed, which, as defined in the proposed rule itself, means that the Office has evaluated the art or arguments and articulated its consideration of the art or arguments in the record of the patent or the application from which the patent issues.
- (3) To complete incomplete information SI provided about the trial date in the parallel district court proceeding suggesting, with respect to the *Fintiv* factors, that the trial date could occur earlier than March 2026 without also informing the Board that the court has removed the trial date from the case schedule at this time.
- (4) To rebut SI's contention that the claimed invention should be afforded an earlier effective filing date than the Lefebvre and Frankle references and demonstrate, as it is Catalyst's right to do under *Dynamic Drinkware, LLC v. Nat'l Graphics, Inc.*, 800 F.3d 1375, 1379-80 (Fed. Cir. 2015), that these references themselves have earlier effective filing dates than the claimed invention.
- (5) To rebut SI's inaccurate statement that the petition never addresses whether Orphanos discloses the limitation that the glenosphere central channel extends from the convex articular side to the medial side of the glenosphere.

We intend to email the Board to request leave no later than close of business Tuesday, October 15, 2024.

Please advise before then whether SI consents to or opposes Catalyst's request for leave. If SI intends to oppose, please provide us dates and times you are available to discuss this request with the Board during the weeks of October 14 and October 21, if necessary, so that we may include those dates in our email to the Board requesting leave.

We are available to meet and confer on Monday or Tuesday regarding this issue if necessary.

Sincerely yours,

Paul Linden
Attorney at Law



Mansfield Rule TM Certified Plus 2023-2024

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