

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

NUVASIVE, INC.

Petitioner

v.

WARSAW ORTHOPEDIC, INC.

Patent Owner

Case IPR2013-00206

Patent No. 8,251,997

**PATENT OWNER'S OBJECTIONS UNDER 37 C.F.R. § 42.64 TO
EVIDENCE SUBMITTED IN SUPPORT OF PETITIONER'S REPLY**

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U.S. Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

Pursuant to 37 C.F.R. § 42.64(b)(1), Patent Owner (“Warsaw”) submits the following objections to evidence cited in support of Petitioner’s (“NuVasive”) Reply in the above-captioned *inter partes* review. Petitioner filed its Reply on March 11, 2014. These objections are being served within five business days of receipt of NuVasive’s Reply and supporting evidence and, therefore, are timely. *See* 37 C.F.R. § 42.64(b)(1).

Exhibit 1014. Patent Owner objects to this exhibit on the following grounds: Federal Rules of Evidence (“FRE”) 401–402 (relevance); FRE 403 (probative value outweighed by prejudice, confusing of issues, wasting time); FRE 802 (hearsay); FRE 901 (authentication); 37 C.F.R. § 42.6(a)(3) (improper incorporation by reference); 37 C.F.R. § 42.22 (petition must include full statement of the reasons for the relief requested); 37 C.F.R. § 42.104 (petition must specify where each element of the claim is found in the prior art patents or printed publications relied upon); 77 Fed. Reg. 48680, 48697 (Aug. 14, 2012) (discussing rules 42.22 and 42.104 and stating “[i]f corroborating evidence is necessary to show unpatentability of a challenged claim, the evidence must be included with the petition to meet the requirements of the rules”); 37 C.F.R. § 42.23 (reply may only respond to arguments raised in patent owner response); 77 Fed. Reg. 48612, 48620 (Aug. 14, 2012) (reply evidence must be responsive and not merely new evidence that could have been presented earlier); 77 Fed. Reg. 48756, 48767 (Aug. 14,

2012) (improper submission of new evidence that could have been presented in petition); 37 C.F.R. § 42.24 (reply limited to 15 pages); 37 C.F.R. § 42.53 (improper uncompelled testimony taken outside the United States); 35 U.S.C. § 311 (scope of *inter partes* review limited to patents and printed publications); 35 U.S.C. § 312 (petition must include all evidence that supports the grounds for the challenge to each claim); Institution Decision, Paper 17 (outside scope of authorized grounds).

Exhibits 1015–21. Patent Owner objects to these exhibits on the following grounds: FRE 401–402 (relevance); FRE 403 (probative value outweighed by prejudice, confusing of issues, wasting time); FRE 802 (hearsay); FRE 901 (authentication); 37 C.F.R. § 42.22 (petition must include full statement of the reasons for the relief requested); 37 C.F.R. § 42.104 (petition must specify where each element of the claim is found in the prior art patents or printed publications relied upon); 77 Fed. Reg. 48680, 48697 (Aug. 14, 2012) (discussing rules 42.22 and 42.104 and stating “[i]f corroborating evidence is necessary to show unpatentability of a challenged claim, the evidence must be included with the petition to meet the requirements of the rules”); 37 C.F.R. § 42.23 (reply may only respond to arguments raised in patent owner response); 77 Fed. Reg. 48612, 48620 (Aug. 14, 2012) (reply evidence must be responsive and not merely new evidence that could have been presented earlier); 77 Fed. Reg. 48756, 48767 (Aug. 14,

2012) (improper submission of new evidence that could have been presented in petition); 35 U.S.C. § 311 (scope of *inter partes* review limited to patents and printed publications); 35 U.S.C. § 312 (petition must include all evidence that supports the grounds for the challenge to each claim); Institution Decision, Paper 17 (outside scope of authorized grounds).

Exhibit 1027. Patent Owner objects to this exhibit on the following grounds: FRE 401-402 (relevance).

Exhibit 1028. Patent Owner objects to this exhibit on the following grounds: FRE 401-402 (relevance).

Exhibit 1029. Patent Owner objects to this exhibit on the following grounds: FRE 401–402 (relevance); FRE 403 (probative value outweighed by prejudice, confusing of issues, wasting time); FRE 702 (unreliable testimony); FRE 802 (hearsay); FRE 901 (authentication); 37 C.F.R. § 42.6(a)(3) (improper incorporation by reference); 37 C.F.R. § 42.22 (petition must include full statement of the reasons for the relief requested); 37 C.F.R. § 42.104 (petition must specify where each element of the claim is found in the prior art patents or printed publications relied upon); 77 Fed. Reg. 48680, 48697 (Aug. 14, 2012) (discussing rules 42.22 and 42.104 and stating “[i]f corroborating evidence is necessary to show unpatentability of a challenged claim, the evidence must be included with the petition to meet the requirements of the rules”); 37 C.F.R. § 42.23 (reply may only

respond to arguments raised in patent owner response); 77 Fed. Reg. 48612, 48620 (Aug. 14, 2012) (reply evidence must be responsive and not merely new evidence that could have been presented earlier); 77 Fed. Reg. 48756, 48767 (Aug. 14, 2012) (improper submission of new evidence that could have been presented in petition); 37 C.F.R. § 42.24 (reply limited to 15 pages); 35 U.S.C. § 311 (scope of *inter partes* review limited to patents and printed publications); 35 U.S.C. § 312 (petition must include all evidence that supports the grounds for the challenge to each claim); Institution Decision, Paper 17 (outside scope of authorized grounds).

Exhibit 1030. Patent Owner objects to this exhibit on the following grounds: FRE 401–402 (relevance); FRE 403 (probative value outweighed by prejudice, confusing of issues, wasting time); FRE 702 (unreliable testimony); FRE 802 (hearsay); FRE 901 (authentication); 37 C.F.R. § 42.6(a)(3) (improper incorporation by reference); 37 C.F.R. § 42.22 (petition must include full statement of the reasons for the relief requested); 37 C.F.R. § 42.104 (petition must specify where each element of the claim is found in the prior art patents or printed publications relied upon); 77 Fed. Reg. 48680, 48697 (Aug. 14, 2012) (discussing rules 42.22 and 42.104 and stating “[i]f corroborating evidence is necessary to show unpatentability of a challenged claim, the evidence must be included with the petition to meet the requirements of the rules”); 37 C.F.R. § 42.23 (reply may only respond to arguments raised in patent owner response); 77 Fed. Reg. 48612, 48620

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