

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

NUVASIVE, INC.
Petitioner

v.

WARSAW ORTHOPEDIC, INC.
Patent Owner

Cases IPR2013-00206 (Patent 8,251,997 B2)
IPR2013-00208 (Patent 8,251,997 B2)¹

Before SALLY C. MEDLEY, LORA M. GREEN, and STEPHEN C. SIU,
Administrative Patent Judges.

MEDLEY, *Administrative Patent Judge.*

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

¹ This order addresses issues that are generally the same in both cases. Therefore, we exercise discretion to issue one order to be filed in each of case. The parties, however, are not authorized to use this style heading in subsequent papers since doing so may cause confusion.

On March 25, 2014, a conference call was held involving counsel for the respective parties and Judges Medley, Green, and Siu. The purpose of the conference call was for Patent Owner to request that the Board dismiss without prejudice Petitioner's reply (IPR2013-00206, Paper 43 and IPR2013-00208, Paper 40). Petitioner opposed the request.

According to Patent Owner, Petitioner's reply, in each case, fails to comply with several provisions, including (1) improper incorporation by reference under 37 C.F.R. § 42.6(a)(3); (2) exceeding the scope of the reply under 37 C.F.R. § 42.23(b); and (3) exceeding the scope of prior art available in an *inter partes* review under 35 U.S.C. § 311. Patent Owner requested that the Petitioner's replies be dismissed and re-filed. Petitioner disagrees that the replies fail to comply with the provisions outlined by Patent Owner.

The request to dismiss the replies is denied. As explained during the call, whether a reply contains arguments or evidence that is outside the scope of a proper reply under 37 C.F.R. § 42.23(b) is left to the determination of the Board. Specifically, the Board will determine whether a reply and evidence are outside the scope of a proper reply and evidence when the Board reviews all of the parties' briefs and prepares the final written decision. If there are improper arguments and evidence presented with a reply, the Board may exclude the reply and related evidence, for example. Moreover, if a party improperly incorporates by reference material into another paper, the party runs the risk that such incorporated material will not be considered. For all of these reasons, the Board will take under

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consideration any alleged violations in due course, upon considering the record at the end of the trial.

As further discussed, Patent Owner is permitted to cross-examine reply declarants, and if necessary, Patent Owner may file a motion for observation regarding cross-examination of a reply witness during DUE DATE 4. As noted, in the Scheduling Order (IPR2013-00206, Paper 18; IPR2013-00208, Paper 17), a motion for observation on cross-examination is a mechanism to draw the Board's attention to relevant cross-examination testimony of a reply witness. The observation must be a concise statement of the relevance of precisely identified testimony to a precisely identified argument or portion of an exhibit (including another part of the same testimony). An observation is not an opportunity to raise new issues, to re-argue issues, or to pursue objections. Each observation should be in the following form:

In exhibit ____, on page ____, lines ____, the witness testified ____. That testimony is relevant to the ____ [stated or argued] on page ____, lines ____ of ____. The testimony is relevant because ____.

Each observation should not exceed one short paragraph, and the entirety of the observations is limited to five pages. The Board may decline consideration or entry of argumentative observations.

It is

ORDERED that Patent Owner's request for the Board to dismiss without prejudice Petitioner's reply in each case is *denied*; and

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FURTHER ORDERED that Patent Owner is authorized to file a motion for observation on cross-examination by DUE DATE 4.

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