

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

WARSAW'S MOTION TO EXCLUDE PURSUANT TO 37 C.F.R. § 42.64

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I. INTRODUCTION

Pursuant to 37 C.F.R. § 42.64(c), Warsaw Orthopedic, Inc. (“Patent Owner” or “Warsaw”) hereby moves to exclude the following evidence submitted by NuVasive, Inc. (“NuVasive” or “Petitioner”) in the above-captioned *inter partes* review (“IPR”). Much of petitioner’s evidence is inadmissible as irrelevant or outside the permissible scope of an IPR proceeding. By way of example, Petitioner submitted several exhibits in support of its petition and reply that were not cited in these documents. In other instances, Petitioner presents irrelevant and improper evidence of alleged prior public use, such as Dr. Jacobson’s alleged surgeries, that find no place in this proceeding because they do not bear on what prior art patents and printed publications disclose to a person of ordinary skill in the art. *See* 35 U.S.C. § 311 (“A petitioner in an inter partes review may request to cancel 1 or more claims of a patent . . . only on the basis of prior art consisting of patents and printed publications.”). NuVasive’s improper attempt to broaden the scope of this IPR should be recognized as such and denied.

II. PROCEDURAL HISTORY

NuVasive filed a petition for *inter partes* review on March 22, 2013 (Paper 1), Warsaw filed a preliminary response on June 25, 2013 (Paper 11), and the Board instituted trial on September 23, 2010 (Paper 17). On October 7, 2013, Warsaw timely filed its objections to Petitioner’s evidence submitted in the preliminary proceedings on this matter. (Paper 20.) Warsaw then filed its Patent

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