

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

¹This 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.

IPR2013-00206 and IPR2013-00208
Patent 8,251,997 B2

On October 10, 2013, the initial conference call² was held between counsel for the respective parties and Judges Medley, Green, and Siu.

Motions

Neither party seeks authorization to file a motion at this time. A general discussion was had regarding motions to amend. As explained, if Patent Owner determines that it will file a motion to amend, Patent Owner must arrange a conference call soon thereafter with the Board and opposing counsel to discuss the proposed motion to amend. *See* 37 C.F.R. § 42.121(a). For guidance on motions to amend, Patent Owner is directed to the *Office Patent Trial Practice Guide* motion to amend guidelines, along with the guidelines provided in *Idle Free Systems, Inc. v. Bergstrom, Inc.*, IPR2012-00027, Paper 26 (June 11, 2013).

The parties were reminded that if they seek authorization to file a motion not contemplated per the Scheduling Order, the party requesting such authorization must arrange a conference call with opposing counsel and the Board.

Schedule

Counsel for the respective parties indicated that they have no issues with the Scheduling Orders entered September 23, 2013.

² The initial conference call is held to discuss the Scheduling Order and any motions that the parties anticipate filing during the trial. *Office Patent Trial Practice Guide*,

Objections to evidence

Both parties served objections to evidence. *See, e.g.*, IPR2013-00206, Papers 19 and 20. Per conference call discussion, Patent Owner intends to rely on evidence it could not have relied on during the preliminary proceeding (e.g., “new testimonial evidence”) in support of its Patent Owner Response. Patent Owner believes that the new testimonial evidence will cure the original objection(s). A “party relying on evidence to which an objection is timely served may respond to the objection by serving supplemental evidence within ten business days of service of the objection.” 37 C.F.R. § 42.64 (b)(2). Thus, a party need not serve supplemental evidence, but if it will rely on such supplemental evidence, it need serve the evidence within the required deadline. Patent Owner sought guidance as to whether it must serve the new testimonial evidence within ten days of service of the objection under 37 C.F.R. § 42.64 (b)(2). Patent Owner does not believe it needs to, but Petitioner does.

Unlike a petitioner, who must set forth its case in its entirety when it files a petition (35 U.S.C. § 312), the patent owner has an opportunity to file a preliminary response (35 U.S.C. § 313), and if a trial is instituted, the patent owner may then file a patent owner response (35 U.S.C. § 316(a)(8)). A patent owner may rely on new testimonial evidence in support of its patent owner response; evidence that it could not have submitted in support of its preliminary response. 37 C.F.R. § 42.107(c). Accordingly, objections made to patent owner evidence in connection with the patent owner preliminary response may become moot, because the patent owner may file a full response with additional evidence once a trial is instituted. The arguments and

77 *Fed. Reg.* 48756, 48765 (Aug. 14, 2012).

evidence that a patent owner makes and relies on for its full response may be quite different from the arguments and evidence it relied on during the preliminary proceeding. This is in contrast to petitioner's petition and evidence. Once a trial is instituted, a petitioner is not automatically afforded another opportunity to brief its case or to submit evidence that it should have submitted in support of its petition.³ Thus, a petitioner that seeks to cure an objection would need to do so within ten business days, because the patent owner would need to know what substitute evidence it needs to respond to in its patent owner response. In contrast, a patent owner may not necessarily need to cure an objection that was made to evidence submitted during the preliminary proceeding, because the objection may become moot in light of the patent owner's full response.

Based on the facts of this case, Patent Owner need not serve the new testimonial evidence in response to the service of the objection. 37 C.F.R. § 42.5 (a) and (b). Here, the potential prejudice to Patent Owner (e.g., submitting its new testimonial evidence several weeks prior to the due date for patent owner response) outweighs any potential prejudice to Petitioner. If Petitioner is of the impression that the original objection is not cured upon receiving the Patent Owner Response, Petitioner may file a motion to exclude at the appropriate time.

³ While a petitioner may seek to file supplemental evidence, it must do so by way of a motion and it must seek authorization to file such a motion. 37 C.F.R. § 42.123.

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Order

It is

ORDERED that no motions are authorized at this time.

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