

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

NUVASIVE, INC.
Petitioner

v.

WARSAW ORTHOPEDICS, INC.
Patent Owner

Case IPR2013-00208
Patent 8,251,997

**PETITIONER OBJECTIONS TO UNAUTHORIZED SUBMISSION
AND EVIDENCE**

Introduction

On January 14, 2014, Patent Owner submitted new exhibits WARSAW2057 through WARSAW2062 in the present *inter partes* review proceeding, and stated in a “Notice of Supplemental Evidence” paper (submitted also on January 14, 2014) that the exhibits were being submitted in response to Petitioner’s December 30, 2013 objections—purportedly as “supplemental evidence pursuant to 37 C.F.R. § 42.64(b)(2).” Contrary to 37 C.F.R. § 42.6(c), no authorized paper was submitted with the new exhibits that “cited” to them. In addition, no explanation accompanying the exhibit submission provided what, if any, portions of the exhibits are relevant, and to what issues in the proceedings the exhibits are relevant.

Furthermore, at least new WARSAW2060 is not a single document but rather a compilation of two different documents including prior witness testimony taken during different days of a trial. None of WARSAW2057-2062 was previously made of record in this proceeding (for example, not referenced in the Patent Owner’s Preliminary Response or the Patent Owner’s Response).

To the extent any of WARSAW2057-2060 is somehow a different version of documents previously made of record in this proceeding, there is no explanation as to whether prior exhibits were being withdrawn and no explanation addressing this Board’s rule that exhibits are not to be resubmitted (*see* 37 C.F.R. § 42.6(d)).

Regarding WARSAW2061-2062 in particular, Warsaw has represented that these two documents are intended to replace withdrawn Exhibits WARSAW2046-2047, which were improperly submitted in violation of a protective order from the District Court of the Southern District of California. These newly submitted Exhibits WARSAW2061-2062, however, are different from the withdrawn Exhibits WARSAW2046-2047 and thus reflect an attempt to add evidence in violation of 37 C.F.R. § 42.6(c).

Objection to Unauthorized Submission of Exhibits

Accordingly, Petitioner objects to the improper submission of all of the newly submitted exhibits—namely, WARSAW2057 through WARSAW2062—into the record of the present proceeding without authorization by the Board and without citation in a document explaining the relevance of the exhibits (as required under 37 C.F.R. § 42.6(c)). These new exhibits were not referenced in the Patent Owner’s Response previously submitted in December 2013 or the earlier Preliminary Response. In addition, no authorization was sought or obtained to make this submission under 37 C.F.R. § 42.120.

Also, Petitioner submits that while 37 C.F.R. § 42.64(b)(2) provides for the “service” of supplemental evidence in response to a timely made objection under 37 C.F.R. § 42.64(b)(1), the rules of the Board, including 37 C.F.R. § 42.64(b)(2), do not authorize the submission of the supplemental exhibits into the evidence of

record in the proceeding separate and independent from any proper submission in the proceeding. The unauthorized submission of exhibits is further improper here given that Warsaw has not referenced these exhibits in any properly submitted paper or explained the relevance of the submitted exhibits. *See* 37 C.F.R. § 42.6(c).

Objections to Evidence under 37 C.F.R. 42.64(b)(1)

In addition, Petitioner further objects, under 37 C.F.R. 42.64(b)(1), to exhibits WARSAW2061-2062 under Fed. R. Evid. 401 and 402 (relevance), 403 (Prejudice, Confusion, Waste of Time, or Other Reasons), 802 (hearsay) and 901 (authentication). In addition, Petitioner notes that WARSAW2059 is insufficient to overcome the previous evidentiary objections for WARSAW2050-2052 (as provided in Petitioner's December 30, 2013 objections).

These objections are being timely served within five business days of Patent Owner's service of the exhibits, in accordance with Bd. R. 42.64(b)(1).

Respectfully submitted,

Date: Jan. 22, 2014

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CERTIFICATE OF SERVICE

Pursuant to 37 CFR §§ 42.6(e)(4) and 42.205(b), the undersigned certifies that on January 22, 2014, a complete and entire copy of this Petitioner Objections to Unauthorized Submission and Evidence was provided via email to the Patent Owner by serving the correspondence email addresses of record as follows:

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