

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.

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Case IPR2013-00208 (Patent 8,251,997 B2)

On January 31, 2014, a conference call was held between counsel for the respective parties and Judges Medley, Green, and Siu. The purpose of the call was to discuss certain exhibits filed by the Patent Owner in support of its Patent Owner Response and in response to objections served by the Petitioner. Another purpose of the conference call was for Petitioner to seek authorization to file a motion for additional discovery.

Exhibits marked private by the Patent Owner

On December 20, 2013, Patent Owner filed a Patent Owner Response. Paper 32.² On the same day, Patent Owner filed several exhibits. Some of these were uploaded into the Patent Review Processing System (PRPS) as private documents, e.g., sealed documents, unable to be viewed by the public. No accompanying motion to seal was filed as required per 37 C.F.R. § 42.14.

The record files for an *inter partes* review shall be made available to the public, except that a document filed with a motion to seal shall be treated as sealed until the motion is decided. 35 U.S.C. § 316(a)(1); 37 C.F.R. § 42.14. A party may file a motion to seal where the motion contains a proposed protective order, such as the default protective order set forth in the Office Patent Trial Practice Guide. The standard for granting a motion to seal is good cause. 37 C.F.R. § 42.54(a).

A protective order governs the treatment of confidential portions of documents, testimony and other information designated as confidential, as well as

² References are to IPR2013-00206.

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the filing of confidential documents or discussion of such information in papers filed with the Board. The Board has the authority to enforce the terms of a protective order entered in a proceeding. *Office Patent Trial Practice Guide*, 77 Fed. Reg. 48756, 48770 (Aug. 14, 2012). Because of the above, it is important that the Board understands and agrees to the terms of any proposed protective order filed with the Board. As such, the Board has a default protective order that the parties may follow. When a party deviates from the default protective order, the party should explain the differences. A protective order that deviates from the Board's default protective order must nonetheless include certain terms as outlined in the Office Practice Guide. *Id.* (“The Protective Order shall include the following terms:”).

As explained during the call, Patent Owner has until February 7, 2014 to file a motion to seal along with a protective order. If no motion to seal is filed, the sealed exhibits will be expunged from the record. 37 C.F.R. § 42.7.

Certain Exhibits to be expunged

Petitioner objected to several of Patent Owner's exhibits. In response, Patent Owner served and filed supplemental evidence. Based on the facts of this case, the supplemental evidence should not have been filed, but only served. *See* 37 C.F.R. § 42.64(b)(2). The Board proposed to expunge exhibits 2057-2062 and neither party objected.

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Exhibits 2046 and 2047

Patent Owner relied on Exhibits 2046 and 2047 in support of its Patent Owner Response. Patent Owner requests to substitute those exhibits with two other exhibits. Petitioner does not object. Based on the facts presented, good cause was shown to authorize Patent Owner to substitute “corrected Exhibit 2046” and “corrected Exhibit 2047” for original Exhibits 2046 and 2047. Accordingly, original Exhibits 2046 and 2047 will be expunged from the record. Patent Owner is authorized to submit corrected Exhibit 2046 and corrected Exhibit 2047 no later than February 7, 2014.

Motion for Additional Discovery

Petitioner requested authorization to file a motion for additional discovery. In preparation for that discussion, Petitioner filed a list of the discovery it seeks from Patent Owner. Based on the discussion had, the parties indicated that they would work together to possibly agree to, at least some of, the discovery Petitioner seeks from the Patent Owner. As the Board explained, the parties may agree to additional discovery between themselves. 37 C.F.R. § 42.51(b)(2). The Board appreciates the parties willingness to work together to reach an agreement, thereby facilitating the Board’s goal of resolving these *inter partes* reviews in a just, speedy and inexpensive manner. 37 C.F.R. § 42.1(b).

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Order

It is

ORDERED that Patent Owner shall file a motion to seal and protective order by February 7, 2014;

FURTHER ORDERED that Patent Owner shall file “corrected Exhibit 2046” and “corrected Exhibit 2047” by February 7, 2014;

FURTHER ORDERED that Exhibits 2046, 2047, 2057-2062 shall be expunged from the record; and

FURTHER ORDERED that Petitioner is not authorized to file a motion for additional discovery at this time.

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