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 October 22, 2013, Patent Owner submitted new exhibits WARSAW 2020 though WARSAW 2028 in the present *inter partes* review proceeding, and stated in an "Objection to Evidence" paper (submitted also on October 22, 2013) that the exhibits were being submitted in response to Petitioner's October 7, 2013 objections and constituted "supplemental evidence being submitted pursuant to 37 C.F.R. § 42.64(b)(2)." Although the new exhibits were submitted with an accompanying "Objection to Evidence" paper, no authorized paper was submitted with the new exhibits that "cited" to them, as is required under 37 C.F.R. § 42.6(c). 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, nearly all the exhibits are not single documents, but rather are compilations of multiple different documents including prior witness testimony, along with new documents, many of which were never previously made of record in this proceeding (for example, many of the documents in the new exhibits are not referenced in the Patent Owner's Preliminary Response), or are different versions of documents previously made of record in this proceeding. Further yet, many of the exhibits include new or different versions of exhibits that were previously submitted, with no explanation as to whether prior exhibits were being withdrawn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)).

Objection to Unauthorized Submission of Exhibits

Accordingly, Petitioner objects to the improper submission of all of the newly submitted exhibits—namely, WARSAW 2020 through WARSAW 2028—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. § 42.69(c). These new exhibits were not referenced in the Preliminary Response previously submitted, and a Patent Owners Response under 37 C.F.R. § 42.120 has yet to be submitted in this proceeding. In addition, no authorization was sought or obtained to make this submission under 37 C.F.R. § 42.120.

In addition, 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. § 42.69(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 WARSAW2020 through WARSAW2028, as well as all of the documents compiled in these exhibits, under Fed. R. Evid. 401 and 402 (relevance), 403 (Prejudice, Confusion, Waste of Time, or Other Reasons), 802 (hearsay) and 901 (authentication). Furthermore, several of the exhibits involve prior testimony from proceedings in which Petitioner was not a party (namely, WARSAW 2020, WARSAW 2022, WARSAW 2023, WARSAW 2025 and WARSAW 2028), and thus do not fall within an exception to the hearsay rule for unavailable witnesses under Fed. R. Evid. 804(b)(1).

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: October 29, 2013

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CERTIFICATE OF SERVICE

Pursuant to 37 CFR §§ 42.6(e)(4) and 42.205(b), the undersigned certifies that on October 29, 2013, 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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