

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MEDTRONIC, INC.,
Petitioner,

v.

NUVASIVE, INC.,
Patent Owner.

Cases IPR2013-00506 (Patent 8,361,156)
IPR2013-00507 (Patent 8,187,334)
IPR2013-00508 (Patent 8,187,334)

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

On September 22, 2014, a conference call was held between counsel for the respective parties and Judges Medley, Green, and Siu. The purpose of the conference call was for Patent Owner to seek authorization to file a

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ten page surreply in each proceeding. Another purpose of the call was for the parties to seek a Board order authorizing a deposition to occur outside of the United States.

Motion to file Surreply or alternatively to Strike

Patent Owner requested authorization to file a ten page surreply to Petitioner's reply in each proceeding. Patent Owner alternatively requested authorization to file a motion to strike the Petitioner's replies and certain evidence filed in the three proceedings. Petitioner opposed the requests.

Patent Owner's requests to file a surreply, or to file a motion to strike the replies and certain exhibits in connection with the replies is denied. As explained during the call, whether a reply contains arguments or evidence that is outside the scope of a proper reply under 37 C.F.R. § 42.23(b) is left to the determination of the Board. The Board will determine whether the Petitioner's reply and evidence are outside the scope of a proper reply and evidence when the Board reviews all of the parties' briefs and prepares the final written decision. If there are improper arguments and evidence presented with a reply, the Board may exclude the reply and related evidence, for example. For all of these reasons, the Board will take under consideration any alleged violations in due course with respect to Petitioner's replies and evidence submitted in support of the replies, upon considering the record at the end of the trial.

Motion for observation

As discussed, Patent Owner is permitted to cross-examine reply declarants, and if necessary, Patent Owner may file a motion for observation regarding cross-examination of a reply witness during DUE DATE 4. As

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noted, in the Scheduling Order (*see, e.g.*, IPR2013-00506, Paper 10), a motion for observation on cross-examination is a mechanism to draw the Board's attention to relevant cross-examination testimony of a reply witness. The observation must be a concise statement of the relevance of precisely identified testimony to a precisely identified argument or portion of an exhibit (including another part of the same testimony). An observation is not an opportunity to raise new issues, to re-argue issues, or to pursue objections. Each observation should be in the following form:

In exhibit ____, on page ____, lines ____, the witness testified ____.
That testimony is relevant to the ____ [stated or argued] on
page ____, lines ____ of _____. The testimony is relevant because
_____.

Each observation should not exceed one short paragraph. The Board may decline consideration or entry of argumentative observations. In accordance with the Scheduling Order, Petitioner may file a response to any motion for observation by DUE DATE 5.

Deposition testimony of Mr. Loic Josse

The parties have agreed to take the deposition testimony telephonically of Mr. Loic Josse who will be in London, England at the time of the deposition. *See, e.g.*, IPR2013-00506, Paper 30. The parties are permitted to do so. *See* 37 C.F.R. § 42.53(b)(3).

Miscellaneous

Petitioner relied on certain excerpts from the deposition testimony of Patent Owner's witness in support of its replies. In doing so, Petitioner made the certain excerpts an exhibit, as opposed to the entire deposition transcript. Patent Owner inquired whether the entire transcript should be

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made of record. We indicated that it should. The parties agreed to work together to file a copy of the entire transcript in each proceeding.

It is

ORDERED that Patent Owner's request to file a surreply, or alternatively, a motion to strike is *denied*; and

FURTHER ORDERED that Patent Owner is authorized to file, in each proceeding, a motion for observation on cross-examination by DUE DATE 4 consistent with this order;

FURTHER ORDERED that Petitioner is authorized to file, in each proceeding, a response to any motion for observation by DUE DATE 5 consistent with this order.

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For PETITIONER:

Jeff Schwartz

jeschwartz@foxrothschild.com

Seth Kramer

skramer@foxrothschild.com

For PATENT OWNER:

Stephen Schaefer

schaefer@fr.com

Michael Hawkins

hawkins@fr.com

Stuart Nelson

IPR13958-0116IP2@fr.com