

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 October 14, 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 Petitioner to seek authorization to file a motion

IPR2013-00506 (Patent 8,361,156)

IPR2013-00507 (Patent 8,187,334)

IPR2013-00508 (Patent 8,187,334)

to expunge Patent Owner's motions for observations filed in each case (*see, e.g.*, IPR2014-00506, Papers 35 and 36) along with a motion to exclude evidence filed with Patent Owner's motions for observations. Alternatively, Petitioner requests the Board dismiss the motions on observations. Patent Owner opposes the requests. The parties also sought guidance regarding the upcoming November 18, 2014 hearing.

Motion for Observation on Cross-Examination

Parties are permitted to cross-examine reply declarants. If necessary, a party may file a motion for observation regarding cross-examination of a reply witness during DUE DATE 4. As 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 and should not contain arguments. The Board may decline consideration or entry of argumentative observations. In accordance with the Scheduling Order, an

IPR2013-00506 (Patent 8,361,156)

IPR2013-00507 (Patent 8,187,334)

IPR2013-00508 (Patent 8,187,334)

opposing party may file a response to any motion for observation by DUE DATE 5. The response should not be argumentative. An excessively long or argumentative response may not be considered. In considering whether a motion for observation, or a response, is improper, the entire motion or response may be dismissed and not considered if there is even one excessively long or argumentative observation or response.

During the conference call, counsel for Petitioner argued that Patent Owner's motions for observations filed in the three proceedings violated the guidance set forth in the Scheduling Order and the Trial Practice Guide. In particular, Petitioner represented that the motions for observations contained new arguments and new evidence, essentially constituting a surreply to Petitioner's Replies filed in each proceeding. Counsel for Patent Owner responded that Patent Owner followed the guidance provided in the Scheduling Order and Trial Practice Guide and that the motions on observations did not violate the proper format for presenting observations.

As explained during the call, the motions for observations contain arguments and are excessively long, and, thus, improper. As an example, we discussed Observation #4 in the Motion for Observation Regarding the Cross-Examination of Dr. Richard A. Hynes. *See, e.g.*, IPR2013-00506, Paper 31, 6–7. In particular, Observation #4 cites several pages of Dr. Hynes' testimony, as opposed to one portion of his testimony, and proceeds to present an argument that the testimony is relevant "because the description of a Vertebral Body Replacement in Ex. 2034 shows that the size of fusion implants disclosed in Michelson, SVS-PR, and Telamon cannot possibly be used for a vertebral body replacement as falsely implied in

IPR2013-00506 (Patent 8,361,156)

IPR2013-00507 (Patent 8,187,334)

IPR2013-00508 (Patent 8,187,334)

Petitioner's Reply." *Id.* The sentence that follows also contains argument and is improper. Because we have found at least one such violation in each motion for observation filed in each proceeding, we dismiss the motions without prejudice.¹ In addition to dismissing the motions for observations, the evidence filed in support of the observations will be expunged. Patent Owner is authorized to file corrected motions for observations by October 16, 2014, and only relevant evidence in support of the motion for observations.²

The guidelines provided here equally apply to any response Petitioner files.

Trial Hearing

The parties agreed that the hearing for the three proceedings should be consolidated, whereby each party has a total of 90 minutes to present arguments. We indicated that the hearing will take place the afternoon of November 18, 2014, and that an order setting forth the procedure for the hearing will be made in due course.

It is

ORDERED that Patent Owner's Motions for Observation Regarding Cross-Examination of Dr. Hynes and Mr. Josse are *dismissed* without

¹For the Motion for Observation Regarding the Cross-Examination of Mr. Loic Josse, the parties are directed to Observation #3 lines 5-11 as an example of what is not permitted. *See, e.g.*, IPR2013-00506, Paper 36. There, Patent Owner makes arguments regarding the propriety of the testimony in connection with claim language.

²We would expect only the testimony from the cross examination. Anything beyond that would be questionable. For example, it was not proper to submit Exhibit 2036 which is a transcript of a different declarant in connection with the motion for observation.

IPR2013-00506 (Patent 8,361,156)

IPR2013-00507 (Patent 8,187,334)

IPR2013-00508 (Patent 8,187,334)

prejudice; and

FURTHER ORDERED that Exhibits 2031-2040 be expunged from the record of each of the three proceedings;

FURTHER ORDERED that Patent Owner is authorized to file corrected motions for observations, no later than October 16, 2014, consistent with this order; and

FURTHER ORDERED that Petitioner is authorized to file responses to the motions for observations, no later than October 21, 2014, consistent with this order.³

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

³ DUE DATE 5 is not otherwise altered.