

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MAKO SURGICAL CORP.,
Petitioner,

v.

BLUE BELT TECHNOLOGIES, INC. and
CARNEGIE MELLON UNIVERSITY,
Exclusive Licensee and Patent Owner.

IPR2015-00630

U.S. Patent No. 6,205,411 B1

MOTION TO EXCLUDE EVIDENCE

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I. Introduction

Patent Owner Carnegie Mellon University and Exclusive Licensee Blue Belt Technologies, Inc. (collectively, “PO”) move to exclude the redirect testimony of Petitioner Mako Surgical Corp.’s expert, Dr. Howe. Deposition Transcript of Dr. Robert Howe, Ex. 2006 (“Howe Dep.”) at 86:22–91:3. Dr. Howe’s redirect testimony introduces, for the first time, concepts that could have been included in the Petition and/or Dr. Howe’s Declaration. But having limited the Petition and Dr. Howe’s Declaration to conclusory allegations, Petitioner cannot now overhaul its original obviousness rationale via redirect testimony from Dr. Howe.¹ Rather, the scope of Dr. Howe’s redirect testimony exceeds that of his cross-examination, which was limited to Dr. Howe’s Declaration, and thus should be excluded as outside the permissible scope under 37 C.F.R. § 42.53(d)(5)(ii).

II. Summary of Relevant Facts

Independent claims 1 and 10 of U.S. Patent No. 6,205,411 (“the ’411 Patent”) recite that “the pre-operative kinematic biomechanical simulator outputs a position for implantation of the artificial component.” In ¶ 38 of his Declaration,

¹ Patent Owner does not concede that Dr. Howe’s redirect testimony, which is also conclusory, establishes obviousness.

Dr. Howe alleged the following to support his argument that it would have been obvious to modify DiGioia² to meet this limitation:

Claims 1 and 10 require the use of feedback from a simulator to output a position for implantation of the artificial component. Similarly, claim 7 requires the simulator to be responsive to the geometric model and output an implant position. The DiGioia system discloses that feedback from the simulator can aid the surgeon in determining optimal implant placement. (Ex. 1005 at 2.) It would have been obvious to one of skill in the art to utilize the feedback as suggested by DiGioia, re-run the simulation to determine optimal positioning of the component, and have the simulator output that position. In fact, this is suggested by Figure 3 in DiGioia, which depicts bi-directional communication between the pre-operative planner and the range of motion simulator.

Declaration of Robert D. Howe, Ex. 1004 (“Howe Decl.”), ¶ 38. On cross-examination, PO asked Dr. Howe questions relating to the following topics:

- Whether DiGioia explicitly describes a system that outputs an implant location (Howe Dep. at 56:4–10, 64:4–65:12);

² A.M. DiGioia et al., *HipNav: Pre-operative Planning and Intraoperative Navigational Guidance for Acetabular Implant Placement in Total Hip Replacement Surgery*, 2nd CAOS Symposium, 1996, Ex. 1005.

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