

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

NEW WORLD MEDICAL, INC.,
Petitioner,

v.

MICROSURGICAL TECHNOLOGY, INC.,
Patent Owner.

IPR2020-01573, Patent 9,107,729 B2
IPR2020-01711, Patent 9,358,155 B2
IPR2021-00017, Patent 9,820,885 B2
IPR2021-00065, Patent 10,123,905 B2
IPR2021-00066, Patent 9,999,544 B2¹

Before JAMES A. TARTAL, JAMES A. WORTH,
ROBERT A. POLLOCK, RYAN H. FLAX, and
DEVON ZASTROW NEWMAN *Administrative Patent Judges*.

FLAX, *Administrative Patent Judge*.

ORDER

*Denying Petitioner's Motion to Exclude,
and Patent Owner's Motion to Exclude
37 C.F.R. §§ 42.5(a), 42.71(a)*

¹ Because this Order applies to each of these related *inter partes* review proceedings, we use this caption for efficiency. The parties are not authorized to follow this practice, but may request such authorization.

IPR2020-01573, Patent 9,107,729; IPR2020-01711, Patent 9,358,155;
IPR2021-00017, Patent 9,820,885; IPR2021-00065, Patent 10,123,905;
IPR2021-00066, Patent 9,999,544

I. INTRODUCTION

New World Medical, Inc. (“Petitioner”) filed a Petition for an *inter partes* review in: IPR2020-01573 regarding Patent 9,107,729; IPR2020-01711 regarding Patent 9,358,155; IPR2021-00017 regarding Patent 9,820,885; IPR2021-00065 regarding Patent 10,123,905; and IPR2021-00066 regarding Patent 9,999,544. *See, e.g.*, Paper 1 of IPR2020-01573.² MicroSurgical Technology, Inc. (“Patent Owner”) is the Patent Owner in these proceedings. Trial was instituted in each of these proceedings (*see, e.g.*, Paper 22 in IPR2020-01573).

In each proceeding, each party filed a motion to exclude the other’s evidence. Patent Owner filed a Motion to Exclude Exhibits 1020, 1021, and 1031–1033, as well as portions of Exhibits 1003 and 1030 (declarations) addressing these exhibits. Paper 51 (“Patent Owner’s Motion” or “PO Mot.”). Petitioner filed a Motion to Exclude portions of Exhibit 2019 (declaration). Paper 52 (“Petitioner’s Motion” or “Pet. Mot.”). Each party filed a respective Opposition to the other’s Motion (Paper 54, “Petitioner’s Opposition” or “Pet. Opp.”; Paper 53, “Patent Owner’s Opposition” or “PO Opp.”), and each party filed a respective Reply to the other’s Opposition (Paper 55, “Patent Owner’s Reply” or “PO Reply”; Paper 56, “Petitioner’s Reply” or “Pet. Reply”). Oral argument was heard at a final hearing on January 10, 2022, and each party addressed these Motions. Paper 62 (“Hr’g Tr.”).

² For efficiency, we cite to the record from IPR2020-01573; the records in the related proceedings are similar.

IPR2020-01573, Patent 9,107,729; IPR2020-01711, Patent 9,358,155;
IPR2021-00017, Patent 9,820,885; IPR2021-00065, Patent 10,123,905;
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The party moving to exclude evidence bears the burden of proving that it is entitled to the relief requested—namely, that the material sought to be excluded is inadmissible under the Federal Rules of Evidence (“FRE”). *See* 37 C.F.R. §§ 42.20(c), 42.62(a) (2019). Furthermore, as an initial matter in considering the parties’ motions, “[w]here, as here, the decision is by an administrative agency, rather than a jury, there is a diminished concern that [] exhibits [will] be prejudicial.” *Eli Lilly and Co., v. Teva Pharms. Int’l GMBH*, IPR2018-01710, Paper 69 at 161 (PTAB Mar. 31, 2020) (citing *Corning Inc. v. DSM IP Assets B.V.*, IPR2013-00053, Paper 66 at 19 (PTAB May 1, 2014)).

We have considered the parties’ Motions, related briefing, and arguments and, for the reasons below, we *deny* each Motion.

II. PATENT OWNER’S MOTION

As noted above, Patent Owner’s Motion requests that we exclude Exhibits 1020, 1021, and 1031–1033. PO Mot. 1. Exhibit 1020 is indicated on its face to be a poster abstract by Thomas Shute, Wesley Green, James Liu, and Arsham Sheybani, related to the American Glaucoma Society’s 29th Annual Meeting, which Patent Owner indicates is purported to explain an eye surgery technique called bent *ab interno* needle goniotomy (“BANG”). Ex. 1020; PO Mot. 2. Exhibit 1021 is a 43 second video, having a fixed caption reading “Arsham Sheybani MD,” showing manipulation of the tip of a needle followed by a surgical procedure, which Patent Owner explains is purported to show the aforementioned BANG procedure. Ex. 1021; PO Mot. 2. Exhibits 1031–1033 are three videos titled “Netland Reply Declaration Video” “1,” “2,” and “3,” which show Petitioner’s witness,

IPR2020-01573, Patent 9,107,729; IPR2020-01711, Patent 9,358,155; IPR2021-00017, Patent 9,820,885; IPR2021-00065, Patent 10,123,905; IPR2021-00066, Patent 9,999,544

Dr. Netland, performing a surgical procedure on cadaver eyes using three bent needles. Ex. 1030 ¶¶ 16–23 (Dr. Netland’s Declaration describing these exhibits); Ex. 1031–1033; PO Mot. 2. Patent Owner argues that none of the aforementioned exhibits are printed publications or prior art and that they are, therefore, “irrelevant” and should be excluded pursuant to FRE 401–402. PO Mot. 2. Patent Owner also argues that Exhibits 1020 and 1021 are not authenticated and should be excluded under FRE 901. *Id.*

Regarding relevancy, Patent Owner asserts that Exhibits 1020, 1021, and 1031–1033 are not contemporaneous with Petitioner’s Quintana reference (Ex. 1004), asserted by Petitioner to be an anticipatory and obviousness-rendering reference with respect to the challenged claims, and that the exhibits are not prior art, so they are not relevant. PO Mot. 2–4. Patent Owner argues that Petitioner has not met its burden of showing that these exhibits are printed publications, so they cannot be considered by the Board. *Id.* at 4. Patent Owner also argues that the BANG procedure, which is the subject of Exhibits 1020 and 1021, was not yet developed as of Quintana’s publication, and that Exhibit’s 1031–1033 depict a “striking[ly] similar[] procedure,” and, thus, all these exhibits are “not ‘of consequence in determining the action’” here, and so are not relevant. *Id.* at 4–5.

Regarding Exhibits 1020 and 1021, Patent Owner also argues they are unauthenticated by Petitioner because Petitioner has not established when the evidence was “published,” or if the evidence constituted true and correct copies. PO Mot. 5–6. Patent Owner argues that these exhibits are not self-authenticating under FRE 901(b)(4) or 902. *Id.* at 6.

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In response, Petitioner argues that Exhibits 1020 and 1021 are relevant as background information (and that they do relate to the BANG procedure) on how a bent needle surgical procedure as taught by Quintana would work. Pet. Opp. 2. Petitioner argues that Exhibits 1031–1033 are relevant as its expert’s efforts to replicate the surgical procedure taught by Quintana and are responsive to Patent Owner’s arguments over the reference. *Id.* Petitioner argues that these exhibits should remain in evidence because, even though they post-date the challenged patent’s effective date, they educate the fact finder regarding the technology at issue and what is taught by the prior art. *Id.* at 3 (citing *In re Baxter Travenol Labs.*, 952 F.2d 388, 390 (Fed. Cir. 1991); *Hospira, Inc. v. Fresenius Kabi USA, LLC*, 946 F.3d 1322, 1329–31 (Fed. Cir. 2020); *Monsanto Tech. LLC v. E.I. DuPont de Nemours & Co.*, 878 F.3d 1336, 1345 (Fed. Cir. 2018); *Schering Corp. v. Geneva Pharm., Inc.*, 339 F.3d 1373, 1377 (Fed. Cir. 2003)). Petitioner argues that it does not assert this evidence to fill any gaps in Quintana’s disclosure. *Id.* at 4.

Regarding the printed-publication status of Exhibits 1020, 1021, and 1031–1033, Petitioner argues that it is not relying on this evidence as the basis for its grounds for unpatentability, but, rather, as mere supporting evidence. *Id.* at 4–5 (citing 37 C.F.R. § 42.104(b); *Yeda Res. v. Mylan Pharms. Inc.*, 906 F.3d 1031, 1041 (Fed. Cir. 2018)). In other words, Petitioner does not assert any of Exhibits 1020, 1021, or 1031–1033 as a basis for unpatentability, but instead submits that they inform the fact finder on the practical teachings of the prior art that *is* so asserted, for example, “what the Quintana reference actually teaches.” *Id.* at 5-6. As such, argues

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