

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

NEW WORLD MEDICAL, INC.,
Petitioner,

v.

MICROSURGICAL TECHNOLOGY, INC.,
Patent Owner.

Case IPR2020-01573

U.S. Patent No. 9,107,729

**PATENT OWNER'S FIRST SET OF
OBJECTIONS TO PETITIONER'S EXHIBITS**

Pursuant to 37 C.F.R. § 42.64(b)(1), the undersigned, on behalf of and acting in a representative capacity for Patent Owner Microsurgical Technology, Inc. (“MST”), hereby submits the following objections to Petitioner New World Medical, Inc.’s (“NWM”) Exhibits 1004, 1005, 1007-1014, 1018, 1020 and 1021, and any reference to/reliance on the foregoing, including without limitation citations to Exhibits 1004, 1005, 1007-1014, 1018, 1020 and 1021 in Petitioner’s Petition (Paper 1) and Exhibit 1003 (Declaration of Dr. Peter Netland, Petitioner’s Expert). As required by 37 C.F.R. § 42.62, Patent Owner’s objections below apply the Federal Rules of Evidence (“F.R.E.”).

1. Objections to Exhibit 1020 and Any Reference to/Reliance Thereon

Patent Owner’s grounds for objection include F.R.E. 401, 402 (“Relevance”), F.R.E. 801, 802 (“Hearsay”); F.R.E. 901 (“Authenticating or Identifying Evidence”); and F.R.E. 403 (“Excluding Relevant Evidence for Prejudice, Confusion, Waste of Time, or Other Reasons”).

Exhibit 1020 is irrelevant because Exhibit 1020 has no tendency to prove the matter sought to be proved. For example, Petitioner relies on Exhibit 1020 in an attempt to explain what Petitioner’s lead prior art reference (Quintana, Ex. 1004) purports to teach to a person of skill in the art at the time of the invention. Specifically, Petitioner relies on Exhibit 1020 for the proposition that “Quintana’s surgical procedure would result in cutting ‘strips of tissue’ from the TM.” Petition

at p. 34 (citing Ex. 1003, ¶¶98-100). But Exhibit 1020 post-dates Quintana by 34 years. Exhibit 1020 also post-dates the undisputed priority date of the invention by 16 years. There is thus no relationship between Exhibit 1020 and any issue properly before the Board in this matter.

Exhibit 1020 also is hearsay. For example, Exhibit 1020 contains multiple out of court statements purportedly relating to “bent ab interno needle goniectomy” (“BANG”). *See* Ex. 1020. In the Petition, Petitioner relies on these out of court statements in support of the following:

Shute (Ex.1020) describes a procedure called “bent ab interno needle goniectomy” (“BANG”) that involves, like Quintana, using a standard needle having a bent tip to “completely excise a segment of TM” and in which the needle’s “cutting edges” create a “double blade” “capable of excising tissue en bloc.”

Petition at pp. 34-35 (citing Ex. 1020, 1; Ex. 1003, ¶98). Petitioner thus relies on the out of court statements in Exhibit 1020 for the truth of the matters asserted therein, *i.e.*, that if Exhibit 1020, which was published many years after both Quintana and the undisputed priority date, shows cutting strips of tissue from the TM, so does Quintana. Exhibit 1020 is therefore inadmissible. F.R.E. 801, 802.

Moreover, Petitioner fails to provide for Exhibit 1020 the authentication required by F.R.E. 901. “To satisfy the requirement of authenticating or identifying an item of evidence, the proponent must produce evidence sufficient to support a finding that the item is what the proponent claims it is.” F.R.E. 901(a). On its face,

Exhibit 1020 purports to be a poster abstract published at the American Glaucoma Society 24th Annual Meeting. But Petitioner provides nothing that would authenticate Exhibit 1020, like testimony of a witness with knowledge (*see* F.R.E. 901(b)(1)) or other evidence that satisfies the requirement. It is also not self-authenticating, because it is not a public document, official publication by a public authority, or other material that requires “no extrinsic evidence of authenticity in order to be admitted” (*see* F.R.E. 902). Petitioner thus improperly cites to Exhibit 1020 without providing any authenticating evidence sufficient to support a finding that the item is what Petitioner claims it is, in violation of F.R.E. 901.

Furthermore, to the extent the Petition, Exhibit 1020, or any other submission of Petitioner purports to refer to or rely on Exhibit 1020, Patent Owner objects to such reference to/reliance on evidence that is also misleading and unfairly prejudicial under F.R.E. 403.

2. Objections to Exhibit 1021 and Any Reference to/Reliance Thereon

Patent Owner’s grounds for objection include F.R.E. 401, 402 (“Relevance”), F.R.E. 801, 802 (“Hearsay”); F.R.E. 901 (“Authenticating or Identifying Evidence”); and F.R.E. 403 (“Excluding Relevant Evidence for Prejudice, Confusion, Waste of Time, or Other Reasons”).

Exhibit 1021 is irrelevant because, like Exhibit 1020, Petitioner relies on Exhibit 1021 in an attempt to explain what Petitioner’s lead prior art reference

(Quintana, Ex. 1004) purports to teach to a person of skill in the art at the time of the invention. But Exhibit 1021 post-dates Quintana by 32 years. Exhibit 1021 also post-dates the undisputed priority date of the invention by 14 years. There is thus no relationship between Exhibit 1021 and any issue properly before the Board in this matter. As such, Exhibit 1021 has no tendency to prove the matter sought to be proved and is irrelevant.

Exhibit 1021 also is hearsay. For example, Exhibit 1021 is an out-of-court video purportedly showing a surgeon performing the BANG procedure on a patient's eye. *See* Ex. 1021. In the Petition, Petitioner relies on Exhibit 1021 for the proposition that, when using the BANG procedure on a patient's eye, it results in "a strip of TM tissue adher[ing] to the needle tip after being cut from the TM." Petition at p. 35 (citing Ex. 1021; Ex. 1003, ¶¶99-100). Petitioner thus relies on the out of court statements in Exhibit 1021 for the truth of the matters asserted therein, *i.e.*, that if Exhibit 1021, which was published many years after both Quintana and the undisputed priority date, shows cutting strips of tissue from the TM, so does Quintana. Exhibit 1021 is therefore inadmissible. F.R.E. 801, 802.

Moreover, Petitioner also fails to authenticate Exhibit 1021 as required by F.R.E. 901. On its face, Exhibit 1021 purports to be a video showing a surgeon performing the BANG procedure, but Petitioner provides nothing that would authenticate Exhibit 1021, like testimony of a witness with knowledge (*see* F.R.E.

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