

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 SECOND SET OF OBJECTIONS
TO EVIDENCE UNDER 37 C.F.R. § 42.64(b)(1)**

In accordance with 37 C.F.R. § 42.64(b)(1), Patent Owner MicroSurgical Technology, Inc. (“Patent Owner” or “MST”) objects to the admissibility of evidence submitted by Petitioner with Petitioner’s Reply to Patent Owner’s Response to Petition on August 31, 2021 (the “Reply”). Specifically, Patent Owner objects to Exhibits 1030-1038 cited by Petitioner in its Reply. Patent Owner also renews its objections to Exhibit 1004 on the grounds raised in Patent Owner’s First Set of Objections to Evidence, Paper No. 24. Patent Owner further objects to any reference to and reliance upon Exhibits 1030-1038 in Petitioner’s Reply and in Exhibit 1030, the Reply 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.”).

These objections are submitted within 5 business days from service of Petitioner’s evidence. Patent Owner lists the evidence objected to and provides grounds for its objections below. Patent Owner also objects to Petitioner’s reliance on or citation to any objected evidence in its papers.

I. Identification of Challenged Evidence and Grounds

A. Objections to Exhibit 1030 (Reply Declaration of Dr. Netland) and Any Reference to or Reliance on Exhibits 1004 and 1031-1038

Patent Owner objects to Exhibit 1030 under F.R.E. 703 to the extent it relies upon Exhibits 1004 and 1031-1038 because those Exhibits are inadmissible for the reasons below and therefore the probative value does not outweigh the prejudicial

effect. Patent Owner further objects to Exhibit 1030 under F.R.E. 602 for lack of personal knowledge to the extent that it fails to provide evidence sufficient to support a finding that Dr. Netland has personal knowledge of the matters to which his testimony pertains.

Patent Owner also objects to Exhibit 1030 under F.R.E. 702-703 and 37 C.F.R. § 42.65 because the testimony is not based on sufficient facts or data and for failing to disclose the underlying facts or data on which the opinions set forth are based. Throughout his declaration, Dr. Netland draws conclusions when there is no indication that the testimony is based on reliable facts or data. Moreover, there is no indication that the testimony will aid the Board in understanding the evidence or determining a fact in issue.

Patent Owner further objects to Exhibit 1030 under F.R.E. 801-802 as inadmissible hearsay to the extent Petitioner relies on the exhibits cited therein for the truth of the matter asserted.

B. Objections to Exhibits 1031-1033 (Reply Declaration Videos)

Patent Owner's grounds for objection include F.R.E. 401, 402 ("Relevance"), F.R.E. 403 ("Excluding Relevant Evidence for Prejudice, Confusion, Waste of Time, or Other Reasons"), F.R.E. 801, 802 ("Hearsay"), F.R.E. 702-703 (Expert Opinions), and 37 C.F.R. § 42.65. Patent Owner further objects to Exhibits 1031-1033 because

they consist of improper and inadmissible new evidence raised for the first time in a reply.

Exhibits 1031-1033 are irrelevant because they have no tendency to prove the matter sought to be proved. For example, Petitioner relies on Exhibits 1031-1033 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 these Exhibits are not prior art and they post-date Quintana as well as the undisputed priority date of the invention by decades. There is thus no relationship between Exhibits 1031-1033 and any issue properly before the Board in this matter.

Patent Owner also objects to Exhibits 1031-1033 under F.R.E. 702-703 and 37 C.F.R. § 42.65 because the demonstrations in the videos are not based on sufficient facts or data and do not disclose the underlying facts or data on which the opinions set forth are based. There is also no indication that the videos will aid the Board in understanding the evidence or determining a fact in issue.

Exhibits 1031-1033 are also hearsay. For example, Exhibits 1031-1033 contain multiple out of court "statements" or depictions purportedly relating to the procedure described in Quintana, Exhibit 1004, and Petitioner relies on these out of court statements for the truth of the matters asserted therein, *i.e.*, that if Exhibits 1031-1033, which were made many years after both Quintana and the undisputed

priority date, shows cutting strips of tissue from the TM, so does Quintana. Exhibits 1031-1033 are therefore inadmissible. F.R.E. 801, 802.

Exhibits 1031-1033 are also improper, inadmissible new evidence advanced for the first time in a reply in violation of 37 C.F.R. § 42.23 (a “reply may only respond to arguments raised in the corresponding opposition, patent owner preliminary response, or patent owner response”). To the extent that Petitioner purportedly relies on Exhibits 1031-1033 in an attempt to rebut Patent Owner’s expert, as Petitioner concedes, Patent Owner’s expert did not perform the procedure described in the Quintana reference. Reply, p. 13 n.3. Petitioner had every opportunity to prepare such videos in advance of filing the Petition. However, Petitioner never prepared, submitted, or discussed these Exhibits until filing the Reply. Because Patent Owner’s expert did not perform the procedure described in Quintana, there is no basis for Petitioner to have done so for the first time in reply. Further, to the extent Petitioner relied on Exhibits 1031-1033 in an attempt to rebut the Affidavit of Dr. Quintana, Ex. 2020, this Exhibit is currently the subject of a pending Motion to Strike, filed by Petitioner. To the extent the Board determines to strike the Affidavit of Dr. Quintana from evidence, then Exhibits 1031-1033 must also be stricken as must any reliance thereon in the Reply or in Exhibit 1030.

Furthermore, to the extent the Petition, Exhibit 1030, or any other submission of Petitioner purports to refer to or rely on Exhibits 1031-1033, Patent Owner objects

Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

Real-Time Litigation Alerts



Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

Advanced Docket Research



With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

Analytics At Your Fingertips



Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

LAW FIRMS

Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

FINANCIAL INSTITUTIONS

Litigation and bankruptcy checks for companies and debtors.

E-DISCOVERY AND LEGAL VENDORS

Sync your system to PACER to automate legal marketing.