

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

VETERINARY ORTHOPEDIC IMPLANTS, INC.,
Petitioner,

v.

DEPUY SYNTHES PRODUCTS, INC.,
Patent Owner.

IPR2019-01331 (Patent 8,523,921 B2)
IPR2019-01332 (Patent 8,523,921 B2)
IPR2019-01333 (Patent 8,523,921 B2)¹

Before HYUN J. JUNG and TIMOTHY G. MAJORS,
Administrative Patent Judges.

MAJORS, *Administrative Patent Judge.*

ORDER
Conduct of the Proceeding
37 C.F.R. § 42.5

¹ We exercise our discretion to issue one Order to be filed in each of the above-listed proceedings. Parties are not authorized to use this format absent permission of the Board.

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On November 14, 2019, the Board held a conference call with the parties pursuant to Petitioner's request for such conference, which request was made in an email dated November 8, 2019. A court reporter was also present, and the Board instructed the parties to file a transcript of the conference when available.

As indicated during the conference, Petitioner requests authorization to file a Reply to the Patent Owner's Preliminary Response in each of the above-captioned proceedings. *See* 37 C.F.R. § 42.108(c). According to Petitioner, it seeks to respond to several issues raised in Patent Owner's Preliminary Response. Those issues are, in general, the following: whether the Petition complies with 37 C.F.R. § 42.104(b)(3) in setting forth "[h]ow the challenged claim[s] [are] to be construed;" the priority date of certain prior art and evidence purporting to show that the claimed subject matter antedates that prior art; Patent Owner's citation to objective indicia of nonobviousness; and why Petitioner filed three petitions on the same patent.

Rule 42.108(c) states as follows: "A petitioner may seek leave to file a reply to the preliminary response in accordance with §§ 42.23 and 42.24(c). Any such request must make a showing of good cause." *Id.*

After hearing from the parties, good cause exists here. Although a close call on whether Petitioner should have foreseen, and sought to preempt, Patent Owner's particular challenges to the Petition on the above-

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noted issues,² we conclude on this record that the Board may benefit from further argument from Petitioner to explain why trial should be instituted notwithstanding those challenges. Accordingly, Petitioner will be given an opportunity to address briefly, and in writing, the above issues including, *inter alia*, to explain its position on whether the Petition advances a claim construction that complies with Rule 42.104(b)(3) and whether the Petition meets the burden at this stage in setting forth the priority dates of the relied-upon references, particularly the Forstein reference. We emphasized during the conference call, and do so again here, that Petitioner's Reply should focus on the sufficiency of the Petition—on the record as it is—in justifying institution of trial. Patent Owner is also permitted a brief written response to Petitioner's authorized Reply. Neither party is permitted to submit new evidence with the Reply or Sur-Reply.

The authorized Reply and Sur-Reply, along with the argument and evidence addressed in the Petition and Patent Owner's Preliminary Response will comprise the full record of points raised by the parties that the Board will consider in deciding whether *inter partes* review will be instituted. Contentions made by the parties during the November 14 conference, except

² On the filing of multiple petitions, we accept Petitioner's representation that the petitions were filed either before or without Petitioner's awareness of more recent guidance from the Office, which indicates that an explanation should be provided from Petitioner (in the Petition itself, or a separate paper) on why multiple, parallel petitions are necessary. *See* Office Trial Practice Guide July 2019 Update referenced at 84 Fed. Reg. 33,925 (July 16, 2019), at 26–28 (citing 35 U.S.C. § 316(b)).

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to the extent addressed in the written briefing, will not be considered for purposes of the Board deciding if institution is appropriate.

It is

ORDERED that Petitioner's request to file a Reply to the Patent Owner's Preliminary Response is *granted* as provided above;

FURTHER ORDERED that Petitioner is authorized to file, on or before November 21, 2019, a Reply in IPR2019–01331, IPR2019–01332, and IPR2019–01333, and each of Petitioner's Replies shall be limited to five (5) pages;

FURTHER ORDERED that Patent Owner is authorized to file, on or before December 3, 2019, a Sur-Reply to Petitioner's Reply in IPR2019–01331, IPR2019–01332, and IPR2019–01333, and any such Sur-Reply shall be limited to five (5) pages.

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