

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

STRYKER CORPORATION and
WRIGHT MEDICAL TECHNOLOGY, INC.,
Petitioner,

v.

OSTEOMEDLLC,
Patent Owners.

IPR2021-01450 (Patent 8,529,608 B2)
IPR2021-01451 (Patent 9,351,776 B2)
IPR2021-01452 (Patent 9,763,716 B2)
IPR2021-01453 (Patent 10,245,085 B2)¹

Before SHERIDAN K. SNEDDEN, RICHARD H. MARSCHALL, and
JAMIE T. WISZ, *Administrative Patent Judges*

SNEDDEN, *Administrative Patent Judge*.

ORDER
Denying Patent Owner's Motion to Submit Supplemental Information
37 C.F.R. § 42.123(b)

¹ This Order addresses overlapping issues in the cases listed above. Therefore, we issue one Order to be filed in each case. The parties, however, are not authorized to use this style of filing.

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I. INTRODUCTION

Patent Owner requested authorization to file a motion to submit supplemental information under 37 C.F.R. § 42.123(b) on Wednesday, January 25, 2023 via email. The relevant portion of the email reads as follows:

In connection with IPR2021-01450, -1451, -1452, -1453, Patent Owner seeks authorization to file a motion to submit as supplemental information pursuant to 37 C.F.R. § 42.123(b), the deposition transcripts of Petitioners' experts (Mr. Leinsing and Dr. Holmes) from two other IPRs between the parties (IPR2022-00487 and IPR2022-00488).

In connection with IPR2022-00189, -190, -191, Patent Owner seeks authorization to file a motion to submit as supplemental information pursuant to 37 C.F.R. § 42.123(b), the deposition transcript of Dr. Holmes only.

These depositions took place last week (January 18 and 20, 2023 respectively) and the final transcripts were received on January 23, 2023, and could not have been submitted earlier. The testimony relates to prior art and issues that relevant to these proceedings, and the Board previously authorized Petitioners to submit in these proceedings declarations from Patent Owner's expert, Michael Sherman, from IPR2022-00487 and IPR2022-00488. Patent Owner also seeks authorization to file a short paper (5 pages) in each proceeding to detail the relevance of the supplemental exhibits should the motion for leave be granted.

Petitioners oppose Patent Owner's request and believe that the above text improperly contains substantive argument. Petitioners will address the above substance during any teleconference on the matter.

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A telephone conference was held on January 27, 2023 among respective counsel for the parties and Judges Snedden, Marschall, and Wisz to discuss Patent Owner’s request. During the call, we granted Patent Owner request to submit its motion for supplemental information and granted Petitioner’s request for an opposition. Subsequently, Patent Owner filed a Motion to Submit Supplemental Information (Paper 43; “Mot.”) and Petitioner filed an Opposition (Paper 44; “Opp.”).

In its Motion, Patent Owner proposes to submit, as supplemental information, Deposition Transcripts of Karl R. Leinsing (Proposed Ex. 2008) and Dr. George B. Holmes, Jr. (Proposed Ex. 2009) taken as part of IPR2022–00487 and IPR2022–00488 proceedings (“Stryker Patent IPRs”). Mot. 1. Patent Owner explains that they deposed Petitioner’s experts on January 18 and 20, and received the transcripts on January 23, 2023. *Id.* at 2. On the same day, January 23, 2023, Patent Owner informed Petitioner of their intent to file the current motion. *Id.* Patent Owner argues their request is timely because they “could not have moved more swiftly.” *Id.*

Patent Owner contends that the supplemental information provides the Board with a complete view of the parties’ positions regarding the prior art relied upon in this proceeding and the credibility of Petitioner’s experts. Mot. 2. First, Patent Owner contends that Mr. Leinsing, Petitioner’s expert in the Stryker Patent IPRs, contradicted Petitioner’s arguments in the current case regarding the Arnould disclosure and that this inconsistency should be considered in assessing Petitioner’s patentability challenge in this case. *Id.* at 3–4. In particular, Patent Owner that Mr. Leinsing the “leg of Arnould is

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‘in a different plane, and it’s offset and its axis to the hole is not in any relation to the main part of the Arnould plate,’ which is where the spine is located. *Id.* at 4 (quoting Prop. Ex. 2008, 151:18–20).

Second, Patent Owner contends that Dr. Holmes undermines his own credibility because he discussed how a surgeon would know to use the Falkner plate but when asked about similar language regarding Slater in the Stryker Patent IPRs, he refused to answer whether Slater could be used. *Id.* at 4–5. In Patent Owner’s view, “Dr. Holmes’ demeanor, understanding of reference disclosures, and inability to testify from his surgical perspective in the Stryker Patent IPRs stands in stark contrast to his expansion of Falkner well beyond any of its explicit teachings.” Mot. 5.

In its Opposition, Petitioner first contends that Patent Owner fails to identify how Dr. Holmes’ testimony in the Stryker Patent IPRs is relevant to the current proceeding. *Id.* Petitioner explains that Dr. Holmes’ testimony in this proceeding is directed solely to Falkner and that his testimony in the Stryker Patent IPRs related to Slater has no bearing on his testimony in the current proceeding. *Id.* at 1–2. “Rather, Patent Owner’s argument with respect to Dr. Holmes is based entirely on the issue of credibility, not relevance.” *Id.* at 1. Further, Petitioner provides various examples that explain the differences in context and why Dr. Holmes’ responses were different in this case versus the Stryker Patent IPRs.

In its second argument, Petitioner contends that Mr. Leinsing’s deposition from the Stryker Patent IPRs is not relevant to the current proceeding because the claim language is different in both cases. *Id.* at 3. For example, Petitioner contends that

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The challenged claims [in these proceedings] require “a transfixation screw hole disposed along the spine” yet in IPR2022-00488, the challenged claims require a “third hole located between said first hole and said second hole.” EX1026, ¶¶263-264. The claim term “between” is subject to claim construction in IPR2022-00488. Prop. EX2008, 151:21–152:8. Mr. Leinsing’s testimony regarding “between” in IPR2022-00488 is wholly irrelevant to, and stands in stark contrast with, the term “elongate spine” which includes the entirety of the bone plate

Opp. 3.

Lastly, Petitioner contends that Patent Owner’s late submission is highly prejudicial because Petitioner has no ability to respond. *Id.* at 5.

Upon consideration of the documents and the parties’ arguments, and for the reasons stated below, Patent Owner’s motion is denied.

II. LEGAL FRAMEWORK

As the moving party, Patent Owner bears the burden of proving that it is entitled to the requested relief. Under 37 CFR § 42.123(a)(1), a request for the authorization to file a motion to submit supplemental information must be made within one month of the date the trial is instituted. We instituted trial on March 11, 2022. The Patent Owner sought authorization on Wednesday, January 25, 2023, beyond one month of the date institution. We consider Patent Owner’s Motion as a “late submission” under 37 C.F.R. § 123(b).

Section 123(b) states: “A party seeking to submit supplemental information more than one month after the date the trial is instituted, . . . must show why the supplemental information reasonably could not have

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