

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

STRYKER CORPORATION and
WRIGHT MEDICAL TECHNOLOGY, INC,
Petitioner,

v.

OSTEOMED LLC,
Patent Owner.

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
TIMOTHY G. MAJORS, *Administrative Patent Judges*.

MAJORS, *Administrative Patent Judge*.

ORDER

Granting Petitioner's Motion to Submit Supplemental Information
37 C.F.R. § 42.123(a)

¹ We exercise our discretion to issue one Order to be filed in each case. The parties are not authorized to use this style of heading for subsequent papers.

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I. INTRODUCTION

With our authorization, Petitioner filed a Motion to Submit Supplemental Information (Paper 11, “Motion” or “Mot.”). Patent Owner filed an Opposition to the Motion (Paper 13, “Opposition” or “Opp.”). We also permitted Petitioner and Patent Owner to file, respectively, a Reply and Sur-Reply related to the Motion. Paper 17 (“Mot. Reply”); Paper 18 (“Mot. Sur-Reply”). The parties filed substantially similar motion papers in the other three related proceedings (IPR2021-01451, 1452, and 1453). In this Order, we cite the papers filed in IPR2021-01450 for convenience.

II. BACKGROUND

On March 11, 2022, we instituted *inter partes* review of claims 1–6, 8–14, and 17 of U.S. Patent 8,529,608 B2 (“the ’608 patent”). Paper 6 (“Institution Decision” or “Inst. Dec.”). The ’608 patent relates to a system for securing two bones together across a joint—specifically, a bone plate and related hardware, such as bone screws for fixing the plate to the relevant bones. Inst. Dec. 3–7. We instituted trial on all grounds in the Petition filed August 30, 2021. *Id.* at 41–42. Those grounds include, *inter alia*, Petitioner’s challenges to the claims as anticipated by the Slater or Faulkner references, and as obvious over a combination of the Arnould reference with Slater. *Id.* at 8.

We instituted trial notwithstanding Patent Owner’s preliminary arguments that the challenged claims are not anticipated or obvious. Patent Owner argued, for example, that Slater failed to disclose a system for securing two discrete bones together across a joint, as recited in the challenged claims, and that the Arnould-Slater combination failed to

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disclose a transfixation screw hole disposed along the elongate spine of a bone plate, as also claimed. Paper 5, 11–14, 33–36. At the time of institution, Patent Owner had not submitted documentary or testimonial evidence in support of its arguments on the '608 patent.

About five months after the filing of the Petition in this case, Patent Owner filed petitions for *inter partes* review of certain of Petitioner's (Stryker's) patents that are at issue in related litigation between the parties, which litigation also involves the '608 patent. Mot. 1–2.² Patent Owner's petitions were filed on January 28, 2022, and rely on some of the same prior art asserted by Petitioner here, namely Slater and Arnould. *Id.* (citing filings in IPR2022-00487 and IPR2022-00488). In addition to the overlap of prior art, Petitioner contends there is subject-matter overlap with the parties' respective patents that are challenged—"both sets of patents are directed to bone plates for securing a first bone and a second bone together across a joint . . . and an angled hole that allows for a fixation member to extend through the first bone into the second bone." *Id.* at 2–3. In support of its challenge to Petitioner's patents, Patent Owner submitted testimony from Michael Sherman, a declarant retained by Patent Owner. Paper 12 (attaching Proposed Exhibits 1022 and 1023 (the "Sherman Declarations")). Whether the Sherman Declarations should be entered as supplemental information in this proceeding is the subject of this Motion.

² Petitioner contends its patents were asserted against Patent Owner in infringement counterclaims in a district court lawsuit pending in the Northern District of Illinois, and that Patent Owner identified Slater and Arnould in invalidity contentions served February 5, 2022. Mot. 1–2, n.3.

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III. ANALYSIS

With prior authorization, a party may file a motion to submit supplemental information after trial has been instituted in accordance with the following requirements: (1) a request for the authorization to file a motion to submit supplemental information is made within one month of the date the trial has been instituted; and (2) the supplemental information must be relevant to a claim for which the trial has been instituted. 37 C.F.R. § 42.123(a) (“Rule 123”). In short, the request for authorization must be timely, and the supplemental information relevant.

Meeting those two requirements of Rule 123 does not, however, guarantee that a motion to submit supplemental information will be granted. *Redline Detection, LLC v. Star Envirotech, Inc.*, 811 F.3d 435, 445 (Fed. Cir. 2015) (rejecting that “the PTAB must accept supplemental information if timely submitted and relevant”). The Board is also guided by, *inter alia*, the need to ensure efficient administration of the Office and the ability to complete IPR proceedings in a timely manner. *Id.* Moreover, “the PTAB has discretion to grant or deny motions as it sees fit.” *Id.* at 446–447 (citing 37 C.F.R. § 42.5(a), (b)). And, we do not treat Rule 123 as offering a routine avenue for a petitioner to bolster deficiencies in a petition called out by patentee—it is not a “wait-and-see” opportunity to fix what could and should have been addressed when the petition was filed. *Id.* at 448 (citing *Pac. Mkt. Int’l, LLC v. Ignite USA, LLC*, IPR2014-00561, Paper 23 at 4 (PTAB Dec. 2, 2014)). The Board also sometimes cites prejudice to the non-moving party as a reason for denying submission of supplemental information. *See, e.g., Polycom, Inc. v. DirectPacket Research, Inc.*,

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IPR2019-01235, Paper 56 at 4 (PTAB Sept. 14, 2020) (“Petitioner has persuaded us that it would be prejudiced by introduction of [Patent Owner’s] new evidence and arguments at this late stage of the proceeding because Petitioner would not have an opportunity to respond.”).³

As the moving party, Petitioner must persuade us that it is entitled to the requested relief. 37 C.F.R. § 42.20(c). Petitioner contends, with no dispute from Patent Owner, that it timely sought authorization to file this Motion. Mot. 3–4. We agree because Petitioner’s request for authorization was made within 30 days of our institution decision. See **Ex. 3001** (email from Petitioner’s counsel dated April 5, 2022).

Petitioner further argues that the Sherman Declarations are relevant to the instituted claims of the ’608 patent. Mot. 3–8. Petitioner contends that the declarations address the knowledge of a person of ordinary skill in the art (“POSA”) “during the same time period for the same technological field” and address “the same prior art references (Slater and Arnould) with respect to similar claim limitations.” *Id.* at 4. In both respects, Petitioner contends the Sherman Declarations contradict positions taken previously by Patent Owner related to the patentability of the ’608 patent’s claims, such as in Patent Owner’s Preliminary Response. *Id.* at 4–8. We discuss in detail below.

³ In *Polycom*, the Board also considered the fact that Patent Owner had been aware and in possession of the supplemental information it sought to submit (certain standards documents) over a year before it filed its motion as evidenced by the filing of those documents in a related IPR between the same parties. *Polycom*, Paper 56 at 3–4.

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