

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

WRIGHT MEDICAL TECHNOLOGY, INC.,
Petitioner,

v.

BIOMEDICAL ENTERPRISES, INC.,
Patent Owner.

Case IPR2015-00786
Patent 8,584,853 B2

Before MEREDITH C. PETRAVICK, JEREMY M. PLENZLER, and
TIMOTHY J. GOODSON, *Administrative Patent Judges*.

PLENZLER, *Administrative Patent Judge*.

ORDER
Granting Patent Owner's Request to File Sur-Reply
37 C.F.R. § 42.5(a)

A conference call in the above proceeding was held on January 20, 2016 amongst respective counsel for Petitioner, Wright Medical Technology, Inc., and Patent Owner, Biomedical Enterprises, Inc., and Judges Petravick, Plenzler, and Goodson. Patent Owner initiated the call to request authorization to file a sur-reply in response to alleged new arguments in the Petitioner's Reply (Paper 17¹) and to address proposed changes to Due Dates 4–6.

With respect to the requested sur-reply, Patent Owner requests five pages of additional briefing in lieu of observations on the testimony of Petitioner's reply declarant. Alternatively, Patent Owner agrees that 3 pages would be sufficient for its sur-reply if observations were filed separately. Patent Owner argues that Petitioner presents a new claim construction argument in its Reply in response to Patent Owner's contentions regarding antedating. The parties indicated that the claim language at issue is claim 15's recitation of "such that the implant stores a compressive force."

Based on the specific facts of this case, we are persuaded that Patent Owner should be allowed to file the requested sur-reply. The sur-reply is due by February 5, 2016 and is limited to addressing the construction of "such that the implant stores a compressive force" in claim 15 and the application of that construction to Patent Owner's evidence of antedating. To the extent Patent Owner contends that the construction of the claim language at issue is its ordinary and customary meaning, Patent Owner should state specifically what that meaning is.

No response by Petitioner to the sur-reply is authorized.

¹ Paper 17 is a confidential version of Petitioner's Reply. Paper 18 is a redacted public version of Petitioner's Reply.

During the call, the parties were authorized to modify Due Dates 4–6, changing Due Date 4 from January 22 to February 5 and Due Date 5 from January 29 to February 8. Due Date 6 is no longer applicable, as the parties agreed that no motions to exclude will be filed in this proceeding. The parties indicated that they will file a joint stipulation to the new due dates. During the call, the parties inquired as to whether the due date for requesting oral argument will remain at Due Date 4. The deadline for requesting oral argument will remain at Due Date 4, which will be February 5 after the filing of the joint stipulation.

Accordingly, it is:

ORDERED that Patent Owner may file a sur-reply, not to exceed three (3) pages, on or before February 5, 2016, as detailed above.

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