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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MUSCULOSKELETAL TRANSPLANT FOUNDATION,
Petitioner,

v.

MIMEDX GROUP, INC.,
Patent Owner.

Cases IPR2015-00664
Patent 8,372,437 B2

Before LORA M. GREEN, SUSAN L. C. MITCHELL, and CHRISTOPHER G. PAULRAJ, *Administrative Patent Judges.*

GREEN, *Administrative Patent Judge*.

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

A conference call was held was held on Thursday, March 3, 2016, among John Kim and Ralph Selitto, counsel for Petitioner; Keith Broyles and Matthew Howell, counsel for Patent Owner; and Administrative Patent Judges Green, Mitchell, and Paulraj. Patent Owner requested the call to discuss Petitioner's Reply, as well as the exhibits filed with the Reply.

First, according to Patent Owner, Petitioner's Reply and associated evidence went beyond the scope of a proper Reply, and thus violated 37 C.F.R. § 42.23(b). According to Patent Owner, the Reply referenced approximately sixteen (16) new scientific articles not previously made of record, to which Patent Owner does not have an opportunity to respond. Petitioner responded that the Reply and evidence submitted constitute appropriate rebuttal to Patent Owner's Response, and thus do not exceed the scope of a proper Reply.

In response, we noted that whether a reply contains arguments or evidence that is outside the scope of a proper reply under 37 C.F.R. § 42.23(b) is left to the determination of the Board. That is, we will determine whether the Petitioner's Rely and evidence are outside the scope of a proper reply and rebuttal evidence when we review the parties' briefs and prepare the final written decision. If there are improper arguments or evidence, we may exclude the Reply and related evidence. In addition, if it so chooses, Patent Owner may discuss during oral argument which sections of the Petitioner's Reply, as well as the related evidence, exceed the scope of a proper Reply.

Second, Patent Owner argues that Petitioner violated Federal Rule of Evidence ("FRE") 106, which is a rule of completeness. Patent Owner argues that Petitioner filed the brief's relating to claim construction from the

related district court litigation, but failed to file the transcript of the *Markman* hearing or the court's claim construction order. Petitioner responded that it had filed the complete district court briefing, which reflected Patent Owner's position as to claim construction up until the point of the *Markman* hearing.

In response, we noted that Patent Owner could file the transcript of the *Markman* hearing as an exhibit, and it could address that evidence in the oral hearing.

Third, Patent Owner requested authorization to file additional evidence to provide appropriate context to certain of the evidence filed by Petitioner with its Reply. Petitioner responded that the evidence to which Patent Owner was referring were to a book chapter authored by Patent Owner's expert, as well as certain publications cited therein. Thus, Petitioner asserted, FDE 106 only applied to submission of other portions of the book. We declined to authorize Patent Owner's request to submit this additional evidence at this late stage of the proceeding.

Finally, Petitioner requested authorization to file its objections to Patent Owner's evidence that were timely served on Patent Owner, but not filed with the Board. Patent Owner did not oppose. Petitioner's request was granted.

Accordingly, it is:

ORDERED that Patent Owner is authorized to file the transcript of the *Markman* hearing in the related litigation as an exhibit;

FURTHER ORDERED that Patent Owner is not authorized to filed any additional evidence; and

FURTHER ORDERED that Petitioner is authorized to file its objections to Patent Owner's evidence.

PETITIONER:

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