

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GLOBUS MEDICAL, INC., Petitioner

v.

DEPUY SYNTHES PRODUCTS, LLC Patent Owner

Case IPR2015-00111

Patent 8,623,057 B2

**Petitioner's Memorandum of Supplemental Authority
Concerning Request for Rehearing Pursuant to 37 C.F.R. § 42.13**

LIST OF EXHIBITS

Exhibit Numbers	Contents
1023	<i>Dynamic Drinkware, LLC v. National Graphics, Inc.</i> , Appeal No. 15-1214 (Sept. 4, 2015 Fed. Cir.) for IPR2013-00131

Memorandum of Supplemental Authority

On September 4, 2015, the Federal Circuit issued a decision in *Dynamic Drinkware, LLC v. National Graphics, Inc.*, No. 15-1214 (Ex. 1023), directed to the evidentiary burden for an IPR Petition relying on a § 102(e) priority date for a patent citing to a provisional application under § 119(e):

As discussed *supra*, Dynamic did not have the burden of producing evidence relating to the Raymond provisional application until after National Graphics made its argument regarding reduction to practice. As a result, **it was not necessary for Dynamic to prove in its petition that Raymond was entitled to the filing date of its provisional application.**

Dynamic Drinkware at 11 (emphasis added). The evidentiary burden involving a provisional date is the exact same issue raised in the Rehearing Request:

The Board erred that the Petition must (1) include a copy of Panjabi 2004 and (2) show how Panjabi 2004 compares with Panjabi 2005. The statute, Federal Circuit precedent, and USPTO interpretations make clear that the § 102(e) file date of Panjabi 2005 is June 23, 2004, the filing date of Panjabi 2004.

Rehearing Request at 3 (Paper No. 13, May 22, 2015).

In reaching its conclusion, the Federal Circuit first noted that, unlike the burden of persuasion, the burden of production shifts between the parties.

Dynamic Drinkware at 5-6 (Ex. 1023). The Federal Circuit explained how a Petition may satisfy the initial burden of production by showing an earlier priority

date and only if the opposing party produces rebuttal evidence does the burden of production shift back to the Petitioner to provide additional evidence. Specifically, the Federal Circuit resolved the issue as follows:

Dynamic also had the initial burden of production, and it satisfied that burden by arguing that Raymond anticipated the asserted claims of the ‘196 patent under § 102(e)(2).

The burden of production then shifted to National Graphics to argue or produce evidence...National Graphics produced evidence that the invention claimed in the ‘196 patent was reduced to practice prior to the filing date of Raymond...

As a result, the burden of production returned to Dynamic...

Dynamic Drinkware at 7-8 (Ex. 1023).

The Federal Circuit also provided a detailed discussion of *In re Giacomini*, 612 F.3d 1380 (Fed. Cir. 2010), a case cited by Petitioner. *See* Rehearing Request at 4-9. The Federal Circuit explained that under *Giacomini*, until a prior art priority date is challenged, a § 102(e) prior art patent has the same “patent defeating effect” as though it was filed on the date of the provisional application. *Dynamic Drinkware* at 10-11 (Ex. 1023) (quoting *Giacomini*, 612 F.3d at 1385). In the instant IPR proceeding, only the sufficiency of the evidence has been challenged and not whether Panjabi is entitled to its provisional date. However, the burden of evidence production for an IPR petition that relies on a provisional filing date is met by the patent itself, and the provisional application is not required.

Respectfully submitted,

/Jay Guiliano/

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that a copy of this **Petitioner's Memorandum of Supplemental Authority Concerning Request for Rehearing Pursuant to 37 C.F.R. § 42.13** has been served via electronic email on September 18, 2015 upon the following:

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