

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 Reply In Support Of
Petitioner's Request For Rehearing**

Globus Medical, Inc. (“Petitioner”) submits this reply in support of its request for rehearing. Petitioner satisfied its burden of production when relying on the filing date of the provisional application for Panjabi 2005 under §§ 102(e) and 119. Petitioner prevails because: (1) Panjabi 2005 is deemed “as though filed on the date of the provisional application;” (2) Petitioner therefore carried its initial burden of production; and (3) Patent Owner did not challenge that production.

I. Section 119(e)(1) Sets The Priority Date For Panjabi 2005

The statute dictates that Panjabi 2005 receives the Panjabi 2004 filing date. Section 119(e)(1) states:

An application for patent filed under section 111(a) ... for an invention disclosed in the manner provided by the first paragraph of section 112 of this title in a provisional application filed under section 111(b) of this title ... shall have the same effect, as to such invention, as though filed on the date of the provisional application

Continuity of disclosure between Panjabi 2005 and Panjabi 2004 is a certainty, but also a separate issue that may need to be addressed post-institution, if Patent Owner attempts to show discontinuity. At this juncture, Petitioner met its initial burden of production that Panjabi 2005 is prior art pursuant to § 102(e) and § 119(e)(1), as of June, 2004.

II. Petitioner Met Its Burden of Production Under *Drinkware*

Dynamic Drinkware confirms that Panjabi 2005, filed as Exhibit 1002, meets the statutory requirement of prior art. *Dynamic Drinkware* at *7-8. As stated

supra, Petitioner has satisfied its initial burden of production by predating the challenged patent, based on a related provisional application under § 102(e) and § 119(e)(1). The provisional filing date, recorded on the face of Panjabi 2005, satisfies Petitioner's initial burden of production.¹ At this stage, and because Patent Owner has not shifted the burden of production back to Petitioner, Panjabi 2005 is entitled to the Panjabi 2004 filing date under § 119(e)(1). *Drinkware* at *7-8.

Patent Owner argues that a prior art patent is only entitled to its provisional date if the provisional supports a claim in the issued patent. PO Response at 4-5 (relying on *Drinkware* at *11). But that discussion in *Drinkware* concerned a Final Board Decision, following a trial, after burden shifts. *Drinkware* must be understood in the context of the controlling precedent *Yamaguchi* and *Giacomini*, each addressing a *prima facie* case of obviousness. *See* Pet. Recon. Req. at 4-8, 9-11. Like the instant proceeding, with no underlying challenge to the relied-on provisional priority dates in *Yamaguchi* and *Giacomini*, the burden of production did not shift back to the Examiners or Petitioner. To adopt Patent Owner's view² of

¹ A recent Board decision, citing *Dynamic Drinkware*, noted that Petitioner may satisfy its initial burden of production by relying "on a filing date recorded on the face of a patent." *Coalition for Affordable Drugs III LLC v. Jazz Pharmaceuticals, Inc.*, IPR2015-01018, Paper No. 17 at 13, fn. 4.

² PO's view also ignores "disclosed but previously unclaimed subject matter." *Johnson & Johnston Assocs. v. R.E. Service*, 285 F.3d 1046, 1055 (Fed. Cir. 2002).

Drinkware, the Board would be ignoring the statute, Federal Circuit precedent, and the Office's interpretation of the statute.³ Not to mention injecting downstream chaos in requiring a claim mapping for all Office Actions relying on an **unchallenged** provisional filing date to support a § 102(e) rejection. The USPTO Director, in contrast, explained how the Office interprets § 119 (and was affirmed):

a patent granted on a 35 U.S.C. 111(a) application which claimed the benefit of the filing date of a provisional application **has a 35 U.S.C. 102(e) prior art effect as of the filing date of the provisional application**" (Exhibit 1018 at 33) (Giacomini Director Br.).

III. Patent Owner Makes No Showing That Panjabi 2005 Is Not Prior Art

Even with two responses filed in the instant proceeding, there has been no showing of discontinuity between Panjabi 2005 and Panjabi 2004. And, unlike in *Drinkware*, priority support in Panjabi 2004 was addressed by the Office. Pet. Recon. Req. at 14. Further, *Drinkware* concerned a provisional not substantially similar to the challenged patent. *Giacomini* explained that until a priority date is challenged, § 102(e) prior art has the same "patent defeating effect" as though filed on the date of the provisional application. *Dynamic Drinkware* at 10-11 (quoting *Giacomini*, 612 F.3d at 1385). Petitioner's burden of production for Panjabi 2005 has been met, and is un rebutted. Petitioner is entitled to rely on the Panjabi 2004 filing date, making Panjabi 2005 prior art to the '057 patent.

³ See *In Re Ebata*, 19 USPQ.2d 1952, 1954-55 (BPAI 1991) (criticizing *Wertheim*).

Respectfully submitted,

/Jay Guiliano/

Novak Druce Connolly Bove + Quigg LLP

Jay Guiliano

(jay.guiliano@novakdruce.com)

1000 Louisiana Street, 53rd Floor
Houston, Texas 77002

P: 713-571-3400

F: 713-456-2836

Reg. No. 41,810

Margaux A. Savee

(margaux.savee@novakdruce.com)

Reg. No. 62,940

CERTIFICATE OF SERVICE

The undersigned hereby certifies that a copy of this **Petitioner's Reply In Support Of Petitioner's Request For Rehearing** has been served via electronic email on November 4, 2015 upon the following:

David R. Bailey
Adam J. Forman
Edward King
BAKER & HOSTETLER LLP
via IPR2015-00111@bakerlaw.com

/Jay Guiliano/