

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SMITH & NEPHEW, INC.
Petitioner

v.

BONUTTI SKELETAL INNOVATIONS LLC
Patent Owner

Case IPR2013-00605
Patent 7,749,229 B1

Before WILLIAM V. SAINDON, MICHAEL R. ZECHER, and
RICHARD E. RICE, *Administrative Patent Judges*.

RICE, *Administrative Patent Judge*.

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

An initial conference call for the above-identified proceeding was held on March 20, 2014, between respective counsel for Petitioner and Patent Owner, and Judges Saindon, Zecher, and Rice. The purpose of the call was to discuss Petitioner's request (*see* Paper 12) for authorization to file a motion requesting a final written decision in view of Patent Owner's disclaimer of claim 23 of U.S. Patent No. 7,749,229 B1 ("the '229 patent") (*see* Paper 11), which is the only claim challenged in this proceeding. During the call, Patent Owner opposed Petitioner's request.

Petitioner's counsel argued during the call that, because Patent Owner filed its disclaimer after receiving the Board's Institution Decision, any Order entering judgment in this proceeding based on the disclaimer should be denominated a final written decision. Petitioner's counsel argued that denominating an Order entering judgment as a final written decision would enhance the estoppel effect of the Order in the event Patent Owner seeks a claim that is not patentably distinct from claim 23 in another patent application pending before the Office. Upon inquiry from the Board, Counsel for Petitioner also stated, however, that Petitioner does not oppose entry of judgment in this proceeding based on Patent Owner's disclaimer of claim 23.

Under 37 C.F.R. § 42.73(b)(2), a party may request judgment against itself *at any time* during a proceeding. Actions construed to be a request for adverse judgment include disclaimer of a claim such that the party has no remaining claim in the trial. There is no dispute that claim 23 of the '229 patent is the only claim challenged in this proceeding. There also is no dispute that the disclaimer of claim 23 was filed "during" this proceeding, as provided in 37 C.F.R. § 42.73(b)(2). Accordingly, we construe Patent

Owner's disclaimer of claim 23 as a request for adverse judgment. As Petitioner does not oppose entry of judgment based on the disclaimer, we will enter judgment under 37 C.F.R. § 42.73 in a separate Order, thus, disposing of the proceeding.

Accordingly, it is hereby

ORDERED that Petitioner's request for authorization to file a motion requesting a final written decision in view of Patent Owner's disclaimer of claim 23 of the '229 patent is denied.

Case IPR2013-00605

Patent 7,749,229 B1

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