

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ARTHREX, INC.,
Petitioner,

v.

BONUTTI SKELETAL INNOVATIONS, LLC,
Patent Owner.

Case IPR2013-00631
Patent 5,921,986

Before MICHAEL R. ZECHER, BENJAMIN D. M. WOOD, and
MITCHELL G. WEATHERLY, *Administrative Patent Judges*.

WEATHERLY, *Administrative Patent Judge*.

DECISION
Request for rehearing
37 C.F.R. § 42.71(d)

I. INTRODUCTION

Patent Owner, Bonutti Skeletal Innovations LLC (“Bonutti”), filed a Request for Rehearing (Paper 17 (the “Request for Rehearing” or “Reh’g Req.”)) seeking reconsideration of our grant of the motion to correct petition and to maintain the filing date of September 27, 2013, filed by petitioner, Arthrex, Inc. (“Arthrex”) (Paper 12 (the “Motion to Correct”). For the reasons set forth below, we deny the Request for Rehearing. Briefly, we determine that the requirements for obtaining a filing date are defined by regulation, not statute, and that Arthrex satisfied the requirements for obtaining a filing date on September 27, 2013, by identifying all patents upon which its challenges were based and supplying copies of those references, or a translation of the references, to Bonutti. Because the filing date required no change, the failure of supplying copies of the missing foreign-language patents amounted to clerical error that Arthrex properly sought to correct in the Motion to Correct. We, therefore, conclude that our grant of the Motion to Correct and our consideration of Arthrex’s petition to institute *inter partes* review was not error.

A. Background

On September 27, 2013, Arthrex filed a petition (Paper 1) to institute an *inter partes* review of claims 64, 65, 67, 69, 70, 72–76, 80, 82, and 83 in U.S. Patent No. 5,921,986 (“the challenged claims”). On October 1, 2013, the Board accorded a filing date of September 27, 2013, to the Petition and noted errors relating to exhibit numbering in the Notice of Filing Date Accorded to Petition. Paper 4, 1–2. Arthrex filed a corrected petition on October 11, 2013, that addressed all errors noted in the Board’s Notice of Filing Date Accorded to Petition. Paper 6 (“Pet.” or “Petition”). In the

Patent Owner's Preliminary Response filed December 4, 2013 (Paper 9, "Prelim. Resp."), Bonutti argued that the Board could not consider the Petition because it failed to meet the statutory requirements for a complete petition under 35 U.S.C. § 312(a). Prelim. Resp. 3–5. Bonutti also contended that Arthrex had failed to comply with the requirements of 37 C.F.R. §§ 42.6, 42.63, 42.104, 42.105, and 42.106. *Id.* at 5–9. Bonutti's argument rested upon Arthrex's failure to provide copies of two foreign patents, one French and one German, that formed at least a part of the evidentiary basis for a number of Arthrex's challenges to the patentability of the challenged claims. *Id.* at 4.

Arthrex filed the Petition with Exhibits 1002 and 1006, which were English-language translations of the two foreign patents at issue. *See* Ex. 1002 (translating French Patent No. 2,696,338 ("Perrin")) and Ex. 1006 (translating German Patent No. 9002844.9 ("Giers")). Arthrex identified Perrin and Giers by their respective patent numbers, but it failed to supply copies of Perrin and Giers in their original French- and German-language forms. Pet. 4 (citing Exs. 1002 and 1006). On December 13, 2013, Arthrex moved to correct its petition and to maintain the filing date of September 27, 2013. Motion to Correct. Arthrex concurrently filed Exhibits 1016 and 1017, which were the original forms of Perrin and Giers, along with the English-language translations that were supplied as Exhibits 1002 and 1006 with the Petition. Paper 12, 3; *see* Exs. 1016 and 1017. On December 17, 2013, Bonutti opposed the Motion to Correct, arguing that the Board may not grant the Motion to Correct because doing so would impermissibly waive the statutory requirements set forth in 35 U.S.C. § 312(a)(3)(A) and (a)(5). Paper 13, 1–2 (the "Opposition"). We granted

the Motion to Correct in our decision to institute entered on March 3, 2014. Paper 15, 4–6. Bonutti timely filed the Request for Rehearing on March 14, 2014.¹

B. *Analysis*

When rehearing a decision on a petition to institute an *inter partes* review, the Board “will review the decision for an abuse of discretion.” 37 C.F.R. § 42.71(c). The Federal Circuit has held that “[a]n abuse of discretion occurs where the decision is based on an erroneous interpretation of the law, on factual findings that are not supported by substantial evidence, or represents an unreasonable judgment in weighing relevant factors.” *Gose v. United States Postal Serv.*, 451 F.3d 831, 836 (Fed. Cir. 2006) (internal quotations omitted). The party requesting rehearing has the burden of showing the decision should be modified, and “[t]he request must specifically identify all matters the party believes the Board misapprehended or overlooked, and the place where each matter was previously addressed in a motion, an opposition, or a reply.” 37 C.F.R. § 42.71(d).

In the Request for Rehearing, Bonutti largely reiterates its arguments from the Opposition. *Compare generally* Reh’g Req. 2–9 *with* Opposition 2–5. Bonutti argues that we impermissibly waived the requirements of 35 U.S.C. § 312 when we granted the Motion to Correct and permitted Arthrex to maintain its original filing date of September 27, 2013. Reh’g Req. 3–4. Bonutti contends that “[a] petition that does not comply with the statutory requirements of 35 U.S.C. § 312 cannot be properly accorded a filing date.” *Id.* at 4. Contrary to Bonutti’s contention, § 312

¹ Bonutti filed the Request for Rehearing within 14 days of the entry of our decision to institute as permitted under 37 C.F.R. § 42.71(d)(1).

does not expressly address the standards by which the Board accords a filing date to a petition. Instead, 35 U.S.C. § 312 specifies the requirements that a petition must meet so that it “may be considered” by the Board. 35 U.S.C. § 312(a).

The procedures for according a filing date are set forth in regulations promulgated pursuant to 35 U.S.C. § 316(a)(4), which states: “(a) *Regulations.*—The Director shall prescribe regulations— . . . (4) establishing and governing inter partes review under this chapter” 35 U.S.C. § 316(a)(4). Therefore, we review our rules to determine whether we properly permitted Arthrex to supply foreign-language copies of Perrin and Graf after it filed the Petition, while still maintaining the previously accorded filing date of September 27, 2013. In considering our grant of the Motion to Correct under 37 C.F.R. § 42.104(c), we keep in mind that § 104(c)

only allow[s] for a motion to correct due to clerical or typographical mistakes without a change in filing date. There is no provision allowing for the correction of a mistake that is not clerical or typographical in nature without a change in filing date. Furthermore, *when determining whether to grant a motion to correct a petition, the Board will consider any substantial substantive effect, including any effect on the patent owner’s ability to file a preliminary response.*

77 Fed. Reg. 48,680, 48,699 (Aug. 14, 2012) (emphasis added). Bonutti has not presented credible or sufficient evidence that Arthrex’s failure to supply copies of the French version of Perrin and the German version of Giers with its petition had a material effect on Bonutti’s ability to file its Patent Owner Preliminary Response. The substance of Perrin and Giers was revealed completely in the English-language translations supplied as Exhibits 1002 and 1006. Arthrex providing copies of Perrin and Giers as Exhibits 1016

and 1017 along with its Motion to Correct added nothing material to aid Bonutti in filing its Patent Owner Preliminary Response. Nonetheless, we examine whether our regulations require filing a copy of such a reference to obtain a filing date in order to determine whether Arthrex's error was merely clerical and, thus, subject to correction under § 42.104(c).

The Board accords a filing date to a petition pursuant to 37 C.F.R. § 42.106(a), which states:

(a) *Complete petition.* A petition to institute *inter partes* review will not be accorded a filing date until the petition satisfies all of the following requirements:

- (1) complies with § 42.104;
- (2) Effects service of the petition on the correspondence address of record as provided in § 42.105(a); and
- (3) Is accompanied by the fee to institute required in § 42.15(a).

37 C.F.R. § 42.106(a). Therefore, the Board will only accord a filing date to a petition when it meets the requirements of §§ 42.15, 104, and 105(a). In this instance, Arthrex's original petition filed on September 27, 2013, satisfied all three requirements, which we address in turn.

First, no dispute exists regarding whether Arthrex timely paid the fee that was required under 37 C.F.R. § 42.15(a). Arthrex paid the fee on September 27, 2013.

Second, § 42.104 states, in pertinent part:

the petition must set forth: . . .

(b) *Identification of challenge.* Provide a statement of the precise relief requested for each claim challenged. The statement must *identify* the following:

* * *

(2) The specific statutory grounds under 35 U.S.C. 102 or 103 on which the challenge to the claim is based and *the patents or printed publications relied upon for each ground.*

37 C.F.R. § 42.104 (second and third emphases added). Arthrex identified 35 U.S.C. §§ 102 and 103 as the statutory grounds for its challenges based in whole or in part upon Perrin. Paper 1, 5. Arthrex identified 35 U.S.C. § 103 as the statutory basis for its challenge based in part upon Giers. *Id.* Arthrex identified Perrin and Giers as the patents relied upon by listing their respective patent numbers (Paper 1, 4) and by supplying an English-language translation of both references (Exs. 1002 and 1006). Official commentary relating to 37 C.F.R. § 42.104(b) explains that “[t]he rule provides an efficient means for identifying the legal and factual basis for satisfying the threshold for instituting *inter partes* review and provides the patent owner with notice as to the basis for the challenge to the claims.” 77 Fed. Reg. 48,680, 48,688 (Aug. 14, 2012). No dispute exists whether the manner in which Arthrex identified Perrin and Giers provided Bonutti “with notice as to the basis for the challenge to the claims.”

Third, § 42.105(a) states, in pertinent part that “[t]he petition and supporting evidence must be served on the patent owner” No dispute exists regarding whether Arthrex served copies of the English-language translations of Perrin and Giers upon Bonutti on September 27, 2013. *See also* Paper 1, 62 (certifying that Exhibits 1002 and 1006 were served via Federal Express on patent owner of record at correspondence address).

Arthrex’s original petition filed September 27, 2013, met all the regulatory requirements to obtain a filing date. The original petition did not, however, meet the statutory requirement of supplying copies of the foreign-

language versions of Perrin and Giers under 35 U.S.C. § 312(a)(3)(A). This statutory defect did not preclude the Board from according a filing date of September 27, 2013, to Arthrex's original petition. Additionally, curing this statutory defect was permitted under 37 C.F.R. § 42.104(c) because it resulted from clerical error, the correction of which had no material effect on the Bonutti's ability to file its Patent Owner Preliminary Response. Arthrex sought to cure the statutory defect in its petition by serving foreign-language copies of Perrin and Giers along with its Motion to Correct. The defect was cured upon our grant of the Motion to Correct. Therefore, the petition met all the requirements of 35 U.S.C. § 312 before we considered it to determine whether Arthrex had met the threshold requirements for instituting this *inter partes* review.

II. CONCLUSION

For these reasons, we are not persuaded that we abused our discretion in granting the Motion to Correct and considering the Petition.

III. ORDER

For the reasons given, it is:

ORDERED that Bonutti's Request for Rehearing is *denied*.

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Patent 5,921,986

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