

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ZIMMER HOLDINGS, INC.
and ZIMMER, INC.,
Petitioner,

v.

BONUTTI SKELETAL INNOVATIONS LLC,
Patent Owner.

Case IPR2014-01080
Patent 7,806,896 B1

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

SAINDON, *Administrative Patent Judge*.

DECISION

Denial of Institution of *Inter Partes* Review
37 C.F.R. § 42.108

Dismissing Motion for Joinder
37 C.F.R. § 42.122

I. INTRODUCTION

Petitioner filed a petition (Paper 1, “Pet.”) requesting an *inter partes* review of claim 43 of U.S. Patent No. 7,806,896 B1 (Ex. 1001, “the ’896 patent”). Petitioner also timely filed a motion requesting joinder (Paper 3, “Mot. Join.”) of this proceeding to IPR2014-00321, in which we instituted an *inter partes* review of claims 40–42 and 44–47 of the ’896 patent, but denied review of claim 43. Mot. Join. 3. Patent Owner filed a preliminary response (Paper 16, “Prelim. Resp.”) and an opposition to Petitioner’s motion for joinder (Paper 8, “PO Opp. Mot. Join.”). We have jurisdiction under 35 U.S.C. § 314.

We have reviewed the aforementioned papers. For the reasons given below, we do not institute an *inter partes* review, and we dismiss as moot Petitioner’s motion for joinder.

A. Related Matters

Petitioner states that the ’896 patent has been asserted against it in the co-pending district court lawsuit *Bonutti Skeletal Innovations LLC v. Zimmer Holdings, Inc.*, 1:12-cv-01107-GMS (D. Del.). Pet. 2. Patent Owner identifies that lawsuit, as well as several other lawsuits against other entities, that may affect, or be affected by, a decision in this proceeding. Paper 7, 2.

Petitioner seeks to join this proceeding to *Zimmer, Inc. v. Bonutti Skeletal Innovations LLC*, Case IPR2014-00321 (PTAB) (hereinafter “*Zimmer*”), in which Petitioner challenged claims 40–47 of the ’896 patent, and on June 2, 2014, we instituted trial on claims 40–42 and 44–47 but did not institute trial on claim 43. Petitioner identifies itself as the petitioner in IPR2014-00191 (challenging U.S. Patent No. 7,837,736 B2) and IPR2014-00311 (challenging U.S. Patent No. 7,959,635 B1), as well as a petition, again challenging U.S. Patent No. 7,837,736

B2, filed the same day as the present Petition (IPR2014-01078). Pet. 2–3. Petitioner also is aware of IPR2013-00605, IPR2013-00620, and IPR2013-00621, brought by other petitioners, which are directed to other patents at issue in the above-identified lawsuit. *Id.*

B. The '896 Patent (Ex. 1001)

Claim 43 depends from independent claim 40 and is the sole claim challenged. Claim 40 is directed to a method for performing joint replacement surgery. An alignment guide is custom fabricated for a patient based on the patient's imaging information. Ex. 1001, 116:18–24. A cutting guide is referenced to the alignment guide, and using the cutting guide, a cut is made. *Id.* at 116:25–31. Claim 43 specifies that the guide surface of the cutting guide has a width less than the width of the cut portion of the bone. *Id.* at 116:38–39.

C. The Asserted Grounds and Prior Art

Petitioner asserts that claim 43 is unpatentable under 35 U.S.C. § 103 in view of Radermacher '157,¹ Radermacher Article,² and Androphy.³ Pet. 5, 25–33.

II. ANALYSIS

A. Background

In *Zimmer*, Petitioner asserted that claim 43 of the '896 patent was unpatentable in view of Radermacher '157, Radermacher Article, and Androphy. Pet. 1. We did not institute an *inter partes* review of claim 43 based on this ground

¹ Int'l Pub. No. WO 93/25157, published Dec. 23, 1993 (Ex. 1003).

² Klaus Radermacher et al., *Computer-Integrated Orthopaedic Surgery: Connection of Planning and Execution in Surgical Intervention*, in *Computer-Integrated Surgery* (Russell H. Taylor et al. eds., 1996) (“Radermacher Article”) (Ex. 1004).

³ US Patent No. 4,567,885, issued Feb. 4, 1986 (Ex. 1005).

in *Zimmer*:

With respect to claim 43, Petitioner asserts that it would have been obvious to include teachings from Androphy or Casey into the disclosures of the individual templates in Radermacher '157 and the Radermacher Article because these references “all relate to total knee replacement instruments.” Pet. 34. As above, arguing that references are analogous art is insufficient, by itself, to show it would have been obvious to combine the teachings of those references in a particular manner to arrive at the claimed invention. As such, we determine that Petitioner has not demonstrated a reasonable likelihood of prevailing in its contention that the subject matter of claim 43 would have been obvious in view of Radermacher '157, the Radermacher Article, and either Androphy or Casey.

Zimmer, Case IPR2013-00321, slip op. at 9 (PTAB June 2, 2014) (Paper 13).

Accordingly, we denied institution with respect to claim 43 because Petitioner did not provide a sufficient reason to combine the teachings of Radermacher '157, Radermacher Article, and Androphy. *Id.* Indeed, Petitioner merely alleged that the prior art references were analogous art. *Id.*

To bolster the prior reasoning that we deemed insufficient, Petitioner, in this proceeding, “ha[s] more fully articulated the reasons why it would have been obvious to a person of ordinary skill in the art to combine these references.” Pet. 32; *see also id.* at 30–32 (presenting Petitioner’s reasons). We do not reach the merits of Petitioner’s additional reasoning. Instead, for the reasons discussed below, we exercise our discretion under 35 U.S.C. § 325(d) to deny institution of *inter partes* review in this proceeding.

B. Principles of Law

A petitioner is not entitled to unlimited challenges against a patent:

In determining whether to institute or order a proceeding under . . . chapter 31, the Director may take into account whether, and reject the petition or request because, the same or substantially the same prior art or arguments previously were presented to the Office.

35 U.S.C. § 325(d). Further, in construing our authority to institute *inter partes* review under 37 C.F.R. § 42.108, we are mindful of the guidance provided in § 42.1(b): “[37 C.F.R. § 42] shall be construed to secure the just, speedy, and inexpensive resolution of every proceeding.”

C. Analysis

The sole difference between what Petitioner presents in this proceeding and what Petitioner presented in *Zimmer* with respect to the challenge of claim 43 of the '896 patent is that Petitioner now provides further reasoning in support of the same combination of prior art. Pet. 32; Mot. Join. 4; PO Opp. Mot. Join. 2–3. Therefore, the “same prior art” was “previously presented” to the Board, with respect to the same claim. *See* 35 U.S.C. § 325(d).

Petitioner is requesting, essentially, a second chance to address claim 43. In this proceeding, however, we are not apprised of a reason that merits a second chance. Petitioner simply presents an argument now that it could have made in *Zimmer*, had it merely chosen to do so. Petitioner discusses the public policy consideration of invalidating what Petitioner believes to be an “invalid patent,” but does not address the key issue here, namely, whether a second petition to bolster an inadequate argument from a first petition is warranted. Mot. Join. 11–12.

In addition, we are not persuaded that a second chance, under the facts of this case, would help “secure the just, speedy, and inexpensive resolution of every

proceeding.” 37 C.F.R. § 42.1(b). Permitting second chances in cases like this one ties up the Board’s limited resources; we must be mindful not only of this proceeding, but of “every proceeding.” *Id.*; see also *ZTE Corp. v. ContentGuard Holdings, Inc.*, Case IPR2013-00454, slip op. at 5–6 (PTAB Sept. 25, 2013) (Paper 12) (“The Board is concerned about encouraging, unnecessarily, the filing of petitions which are partially inadequate.”); cf. *Ariosa Diagnostics v. Isis Innovation, Ltd.*, Case IPR2013-00250, slip op. at 3 (PTAB 2013) (Paper 4) (granting joinder when a new product was launched, leading to a threat of new assertions of infringement); *Microsoft Corp. v. Proxyconn, Inc.*, Case IPR2013-00109, slip op. at 3 (PTAB 2014) (Paper 15) (granting joinder when additional claims had been asserted against petitioner in concurrent district court litigation).

In view of the above, we exercise our discretion under 35 U.S.C. § 325(d) to deny the Petition and decline to institute *inter partes* review with respect to the challenge asserted in the Petition, because it presents merely “the same or substantially the same prior art or arguments” presented to us in *Zimmer*. As a consequence, Petitioner’s motion for joinder is dismissed as moot.

III. ORDER

In view of the foregoing, it is hereby:

ORDERED that no trial is instituted; and

FURTHER ORDERED that Petitioner’s motion for joinder is dismissed.

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