

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SMITH & NEPHEW, INC.,
WRIGHT MEDICAL GROUP, INC.,
and WRIGHT MEDICAL TECHNOLOGY, INC.,
Petitioners,

v.

BONUTTI SKELETAL INNOVATIONS LLC,
Patent Owner.

Case IPR2013-00629
Case IPR2014-00354¹
Patent 7,806,896 B1

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

SAINDON, *Administrative Patent Judge*.

DECISION GRANTING
JOINT MOTION FOR JOINDER
37 C.F.R. § 42.122(b)

¹ A copy of this Decision is being filed in IPR2014-00354 so that the record indicates that it has been joined to IPR2013-00629. The parties are not authorized to use this style of heading.

I. INTRODUCTION

On June 26, 2014, Judges Saindon, Zecher, and Rice held a conference call with counsel for Patent Owner and Petitioners.² Patent Owner requested the call to request our authorization to file a motion for joinder of IPR2014-00354 and IPR2013-00629.

Background

This joinder involves two proceedings that address the same claims of the same patent using the same grounds. In IPR2013-00629 (“the ’629 IPR”), we instituted an *inter partes* review of claim 1 of U.S. Patent No. 7,806,896 (“the ’896 patent”) as unpatentable over two separate obviousness grounds asserted by Smith & Nephew. *See* ’629 IPR, Paper 10. In IPR2014-00354 (“the ’354 IPR”), we instituted an *inter partes* review of claim 1 of the ’896 patent as unpatentable over the same two obviousness grounds as in the ’629 IPR, but this time asserted by Wright. *See* ’354 IPR, Paper 10.³

The Parties’ Request for Joinder

Patent Owner requested a conference call to discuss the issue of joinder. During the call, Patent Owner indicated that the parties have reached an agreement regarding a proposed joinder. The parties wished to join the ’354 IPR to the ’629 IPR, and to maintain the ’629 IPR schedule.

² We refer to all petitioners jointly as “Petitioners.” “Wright” will be used to separately refer to Wright Medical Group, Inc. and Wright Medical Technology, Inc., as necessary, and “Smith & Nephew” will be used to separately refer to Smith & Nephew, Inc., as necessary.

³ The ’354 IPR originally included a ground directed to claim 40 but Patent Owner subsequently disclaimed claim 40. *See* ’354 IPR, Paper 12 and Exhibit 2004.

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The parties agreed to a “single deposition” of Patent Owner’s expert, Dr. Scott D. Schoifet. Regarding Petitioners’ expert, the declaration filed with the petition in the ’354 IPR is essentially the same as the declaration filed with the petition in the ’629 IPR. *Compare* ’629 IPR, Ex. 1002 *with* ’354 IPR, Ex. 1002. That declarant, Dr. Jay D. Mabrey, already has been deposed in the ’629 IPR, and the parties agreed another deposition was unnecessary. Lastly, the parties asked that Smith & Nephew be allowed to file the Reply to Patent Owner’s Response and that Wright be allowed a 5-page supplemental Reply.

Standards for Joinder

The America Invents Act (AIA) created new administrative trial proceedings, including *inter partes* review, as an efficient, streamlined, and cost-effective alternative to district court litigation. The AIA permits the joinder of like proceedings. The Board, acting on behalf of the Director, has the discretion to join an *inter partes* review with another *inter partes* review.

35 U.S.C. § 315. Section 315(c) provides (emphasis added):

JOINDER.—If the Director institutes an inter partes review, the Director, in his or her discretion, may join as a party to that inter partes review any person who properly files a petition under section 311 that the Director, after receiving a preliminary response under section 313 or the expiration of the time for filing such a response, determines warrants the institution of an inter partes review under section 314.

Thus, joinder may be authorized when warranted, but the decision to grant joinder is discretionary. *See* 35 U.S.C. § 315(c); 37 C.F.R. § 42.122. The Board will determine whether to grant joinder on a case-by-case basis, taking into account the particular facts of each case, substantive and procedural issues, and other considerations. *See* 157 CONG. REC. S1376

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(daily ed. Mar. 8, 2011) (statement of Sen. Kyl) (when determining whether and when to allow joinder, the Office may consider factors including “the breadth or unusualness of the claim scope” and claim construction issues). When exercising its discretion, the Board is mindful that patent trial regulations, including the rules for joinder, must be construed to secure the just, speedy, and inexpensive resolution of every proceeding. *See* 35 U.S.C. § 316(b); 37 C.F.R. § 42.1(b).

When considering whether to grant a motion for joinder, the Board considers many factors, including: (1) the differences in the grounds asserted in the proceedings; (2) time and cost considerations, including the impact joinder would have on the trial schedule; and (3) how briefing and discovery may be simplified. *See* Order Authorizing Motion for Joinder (Paper 15) at 4, *Kyocera Corp. v. SoftView, LLC.*, IPR2013-00004 (PTAB Apr. 24, 2013).

II. DECISION

During the conference call, the parties set forth several reasons why joinder is appropriate. We consider the parties’ combined request during the call as a joint motion for joinder.

All parties involved agree joinder would be beneficial, and have agreed to a schedule and procedures that simplify briefing and discovery. There are no differences in the grounds asserted in the proceedings. The schedule of the joined proceedings will be the same as that of the ’629 IPR, the earlier-filed IPR. Duplicative briefing on the same issues, as well as duplicative depositions of experts, will be eliminated. In this light, we see substantial efficiencies and savings gained by the Board and the parties from

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joining these proceedings, and we grant the parties' joint motion for joinder.

Guidance as to how the joined proceedings will operate is as follows. Filings will be made in the '629 IPR only, and the joined proceeding will be referred to as "IPR2013-00629" only. The '354 IPR, having been joined to the '629 IPR, will be considered terminated under 37 C.F.R. § 42.72.

To streamline and simplify the proceeding, Petitioners will not file separate papers, unless filing a paper that does not involve the other petitioner (e.g., mandatory notices). Thus, each paper filed by the Petitioners will be filed as a single, consolidated paper and will be identified as "consolidated." A single, consolidated paper is required even if one petitioner wishes to speak separately from the other petitioner. In that event, the paper shall identify when a petitioner is speaking separately, and ensure it is clear which petitioner is speaking separately. In recognition that there are now two petitioners joined in this proceeding, we will allow a total of 20 pages for the Consolidated Reply to Patent Owner's Response. Other papers, filed by any party, remain subject to the page limit requirements set forth in 37 C.F.R. § 42.24, unless the party receives prior authorization from the Board.

Regarding the schedule of the '629 IPR, we note that the original Scheduling Order of the '629 IPR (Paper 11) has been modified via stipulation (Paper 16). As we explained during the conference call, the parties are permitted to stipulate to further changes to Due Dates 1-5.

Regarding the deposition of Patent Owner's expert, the Petitioners are allowed a single deposition. The parties are encouraged to agree as to the format for this deposition early and to contact us if any issues arise.

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