

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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SMITH & NEPHEW, INC.  
Petitioner

v.

BONUTTI SKELETAL INNOVATIONS, LLC  
Patent Owner

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Case IPR2013-00605  
Patent 7,749,229 B1

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

RICE, *Administrative Patent Judge*.

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

S&N EXHIBIT 1027

## I. INTRODUCTION

Smith & Nephew, Inc. (“Petitioner”) filed a petition (Paper 3, “Pet.”) requesting an *inter partes* review of claim 23 of U.S. Patent No. 7,749,229 B1 (Ex. 1001, “the ’229 Patent”). The owner of the ’229 Patent, Bonutti Skeletal Innovations LLC (“Patent Owner”), did not file a preliminary response. We have jurisdiction under 35 U.S.C. § 314.

The standard for instituting an *inter partes* review is set forth in 35 U.S.C. § 314(a), which provides as follows:

THRESHOLD -- The Director may not authorize an *inter partes* review to be instituted unless the Director determines that the information presented in the petition filed under section 311 and any response filed under section 313 shows that there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.

We determine that the information presented in the petition establishes that there is a reasonable likelihood that Petitioner would prevail in its challenge of claim 23 of the ’229 Patent as unpatentable. Accordingly, pursuant to 35 U.S.C. § 314, we institute an *inter partes* review for claim 23 of the ’229 Patent.

### A. *Related Proceeding*

The ’229 Patent is involved in co-pending litigation styled *Bonutti Skeletal Innovations LLC v. Smith & Nephew, Inc.*, D. Del. Case No. 12-1111-GMS. Pet. 1.

*B. The '229 Patent*

The '229 Patent, titled “Total Knee Arthroplasty Through Shortened Incision,” issued on July 6, 2010, based on U.S. Patent Application Serial No. 11/170,969, filed on June 30, 2005. The '229 Patent is a continuation of U.S. Patent Application Serial No. 10/191,751 (“the '751 Application”), filed on July 8, 2002. The '751 Application is a continuation-in-part of U.S. Patent Application Serial No. 09/976,396, filed Oct. 11, 2001, and a continuation-in-part of U.S. Patent Application Serial No. 09/941,185 (“the '185 Application”), filed Aug. 28, 2001. The '751 Application is also a continuation-in-part of a number of earlier-filed applications that are not relevant to our decision.

The '229 Patent uses the term “total knee arthroplasty” in claim 23 and the abstract. Claim 23 recites “[a] method of performing *total knee arthroplasty* through a primary incision having a length of less than thirteen (13) centimeters . . . .” (Emphasis added).

The abstract of the '229 Patent states that “[a] method is provided for performing *total knee arthroplasty*.” Ex. 1001, Abstr. 1 (emphasis added). The abstract states that the method includes “making a primary incision,” “cutting medial and lateral condyles of the femur of the leg,” “moving a femoral component of a total knee implant through the primary incision,” and “positioning the femoral component with respect to the . . . femoral cut surface.” *Id.* at Abstr. 2-8. The abstract also states that “[t]he primary incision has a length of less than thirteen (13) centimeters.” *Id.* at Abstr. 8-9.

The term “total knee arthroplasty” does not appear in the specification other than the claims. Rather, the specification uses, interchangeably, the terms “total

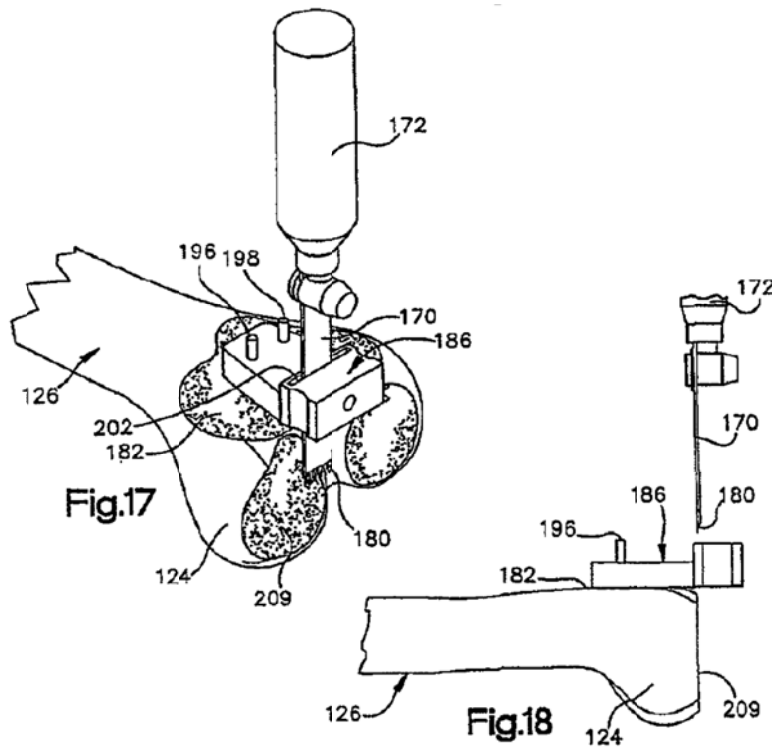
knee joint replacement,” “total knee replacement,” and “full knee replacement” (all being hereinafter referred to as “total knee replacement”). *See, e.g., id.* at 1:47, 58; 11:22-28; 37:14-15.

The specification describes a method for performing total knee replacement through an incision of less than 13 centimeters. *See, e.g., id.* at 14:54-61; 18:40-44; 26:26-34; 30:26-28; 49:2-19, 44-57; 105:47-55. As described, the method requires cutting and shaping both the femoral and tibial sides of the knee joint, and installing an implant comprising femoral and tibial components. *See, e.g., id.* at 30:26-28; 31:48–32:37. Total knee replacement may, or may not, involve work on the patella. *See id.* at 29:59–30:7.

The specification describes making a cut across anterior portions of the lateral and medial condyles of the femur, such that the anterior portion of the lateral and medial epicondyles are cut away and flat anterior cut surface 182 is disposed on distal end portion 124 of femur 126. *See id.* at 20:21-23; 22:4-7; figs. 13, 14, & 15.

After making the anterior cut, distal resection guide 186 is positioned on flat anterior cut surface 182 (*see, e.g., id.* at 23:8-9; figs 16 & 17), and distal femoral cut is made by moving saw blade 170 along guide surface 202 of the resection guide (*see, e.g., id.* at 23:57-59; figs. 17 & 18). “When the distal femoral cut is completed, a flat distal end surface **209** extends across the distal end of the femur **126**,” and “[t]he trochlear groove of the femur extends through the distal end surface **209**.” *Id.* at 24:34-35, 41-42; figs. 17 & 18.

Figures 17 and 18 of the '229 Patent is reproduced below:



Figures 17 and 18 depict the manner in which the distal femur cut is made.

The method of total knee replacement described in the specification, therefore, involves cutting and shaping the two condyles of the femur and the distal end portion of the femur. *See, e.g., id.* at 20:18-25; 24:34-42; figs. 13 & 17; *see also id.* at 75:45-46 (explaining that, in contrast with total knee replacement, “[w]hen a partial knee replacement is to be made, only one of the two condyles . . . is cut”). The method of total knee replacement described in the specification also involves cutting and shaping the proximal end portion of the tibia. *See, e.g., id.* at 27:19-30; fig. 21. After the femoral and tibial cuts have been made, and any work on the patella has been performed, a tibial component is mounted on the proximal

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