

DOCKET NO.: 0286868-00188

Filed on behalf of Smith & Nephew, Inc.

By: David L. Cavanaugh, Reg. No. 36,476

Michael H. Smith, Reg. No. 71,190

Wilmer Cutler Pickering Hale and Dorr LLP

1875 Pennsylvania Ave., NW

Washington, DC 20006

Tel: (202) 663-6000

Email: David.Cavanaugh@wilmerhale.com

MichaelH.Smith@wilmerhale.com

UNITED STATES PATENT AND TRADEMARK OFFICE

---

**BEFORE THE PATENT TRIAL AND APPEAL BOARD**

---

SMITH & NEPHEW, INC.

Petitioner

v.

Patent Owner of

U.S. Patent No. 7,806,896 to Peter M. Bonutti

IPR Trial No. TBD

**PETITION FOR *INTER PARTES* REVIEW OF**

**U.S. PATENT NO. 7,806,896**

**UNDER 35 U.S.C. § 312 AND 37 C.F.R. § 42.104**

**TABLE OF CONTENTS**

I. MANDATORY NOTICES ..... 1

    A. Real Party-in-Interest ..... 1

    B. Related Matters ..... 1

    C. Counsel..... 1

    D. Service Information..... 2

II. CERTIFICATION OF GROUNDS FOR STANDING ..... 2

III. OVERVIEW OF CHALLENGE AND RELIEF REQUESTED ..... 2

    A. Prior Art Patents and Printed Publications..... 2

    B. Grounds for Challenge ..... 4

IV. CLAIM CONSTRUCTION ..... 5

V. OVERVIEW OF KNEE ANATOMY AND KNEE REPLACEMENT ..... 7

    A. Anatomical Terms of Location ..... 8

    B. Relevant Knee Anatomy ..... 8

    C. Knee Replacement Surgery..... 9

    D. Computer Assisted Knee Surgery ..... 14

VI. SUMMARY OF THE '896 PATENT AND RELEVANT FILE HISTORY ..... 15

    A. The Challenged Claims of the '896 Patent ..... 16

    B. Summary of Portion of the Specification Related to Challenged Claim..... 18

    C. The Effective Filing Date of the '896 Issued Claims ..... 21

    D. Summary of the Prosecution History of the '896 Patent ..... 21

VII. THE PRIOR ART RENDERS THE CHALLENGED CLAIMS UNPATENTABLE.....	22
A. The References.....	23
1. Delp Article.....	23
2. Delp '018.....	24
3. Stulberg.....	24
4. Radermacher '157.....	25
5. Radermacher Article.....	25
6. Turner.....	26
7. Scorpio.....	26
VIII. IDENTIFICATION OF HOW THE CHALLENGED CLAIMS ARE UNPATENTABLE.....	26
A. Independent Claim 1.....	27
1. Claim 1 is Obvious Over the Delp Article in View of Any One of Turner or Scorpio.....	27
2. Claim 1 is Obvious Over Delp '018 in View of Any One of Turner or Scorpio.....	37
3. Claim 1 is Obvious Over Stulberg in View of Any One of Turner or Scorpio.....	43
B. Independent Claim 13.....	47
1. Claim 13 is Anticipated by Radermacher '157.....	47
2. Claim 13 is Obvious Over the Radermacher Article in View of Any One of Turner or Scorpio.....	53
IX. CONCLUSION.....	60

**TABLE OF AUTHORITIES**

	<b>Page(s)</b>
<b>FEDERAL CASES</b>	
<i>In re ICON Health and Fitness, Inc.</i> , 496 F.3d 1374 (Fed. Cir. 2007) .....	5
<b>STATUTES</b>	
35 U.S.C. § 102 .....	4
35 U.S.C. § 102(b) .....	3, 4
35 U.S.C. § 103 .....	4
35 U.S.C. § 112 .....	5
35 U.S.C. § 314(a) .....	4
<b>OTHER AUTHORITIES</b>	
Rule 42.22(a)(1) .....	2
Rule 42.100(b) .....	5
Rule 42.104(a) .....	2
Rule 42.104(b)(4)-(5) .....	26
Rule 42.104(b)(1)-(2) .....	2
77 Fed. Reg. 48764 (Aug. 14, 2012) .....	5

**I. MANDATORY NOTICES**

**A. Real Party-in-Interest**

Smith & Nephew, Inc. (“Petitioner”) is the real party-in-interest and submits this *inter partes* review Petition (“Petition”) for review of certain claims of U.S. Patent No. 7,806,896 (“the ’896 patent”).

**B. Related Matters**

The following litigation matter would affect or be affected by a decision in this proceeding: *Bonutti Skeletal Innovations LLC v. Smith & Nephew, Inc.*, Civil Action No. 12-1111-GMS (D. Del.). The litigation involves six patents: the ’896 patent and U.S. Patent Nos. 5,980,559; 6,702,821; 7,087,073; 7,749,229; and 8,133,229. The ’896 patent is the subject of this Petition. Separate petitions for *inter partes* review of the other patents above are also being filed. Because the technology and disclosure in the patents are similar and for the sake of administrative efficiency and consistent outcome, Petitioner requests that the Patent Trial and Appeals Board (“PTAB”) have a single Administrative Panel address these *inter partes* reviews.

**C. Counsel**

Lead Counsel: David L. Cavanaugh (Registration No. 36,476)

Backup Counsel: Michael H. Smith (Registration No. 71,190)

# Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

## Real-Time Litigation Alerts



Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

## Advanced Docket Research



With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

## Analytics At Your Fingertips



Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

## API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

## LAW FIRMS

Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

## FINANCIAL INSTITUTIONS

Litigation and bankruptcy checks for companies and debtors.

## E-DISCOVERY AND LEGAL VENDORS

Sync your system to PACER to automate legal marketing.