

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 IPR2014-00191
Patent 7,837,736 B2

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

I. INTRODUCTION

Zimmer Holdings, Inc. and Zimmer, Inc. (“Petitioner”) filed a corrected Petition (Paper 8, “Pet.”) requesting an *inter partes* review of claims 15-28 and 31-36 of U.S. Patent No. 7,837,736 B2 (Ex. 1001, “the ’736 Patent”). The owner of the ’736 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.

Based upon this standard, we determine that the information presented in the Petition establishes that there is a reasonable likelihood that Petitioner would prevail with respect to claims 15-22, 26-28, and 31-36, but not claims 23-25 of the ’736 Patent. Accordingly, pursuant to 35 U.S.C. § 314, we authorize an *inter partes* review to be instituted only as to claims 15-22, 26-28, and 31-36.

A. Related Proceeding

Petitioner represents that the ’736 Patent is asserted by Patent Owner against Petitioner in litigation titled *Bonutti Skeletal Innovations, LLC v. Zimmer Holdings, Inc.*, No. 1:12-cv-01107-GMS (D. Del). Pet. 1; *see* Paper 5, 2.

B. The '736 Patent (Ex. 1001)

The '736 Patent, titled "MINIMALLY INVASIVE SURGICAL SYSTEMS AND METHODS," issued on November 23, 2010, based on U.S. Patent Application No. 11/928,898, filed on October 30, 2007. The '736 Patent claims priority to U.S. Patent Application No. 10/681,526, filed on October 8, 2003, which is a continuation of U.S. Patent Application No. 10/191,751, filed on July 8, 2002. The '736 Patent also claims priority to a number of earlier-filed U.S. patent applications.

Figure 90 of the '736 Patent, which is reproduced below, depicts rotating platform knee implant 1290.

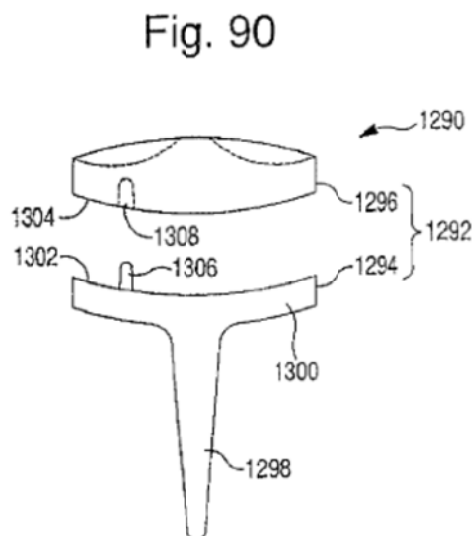


Figure 90 is a schematic illustration of tibial component 1292 of rotating platform knee implant 1290.

As depicted in Figure 90, tibial component 1292 includes tray 1294 and bearing insert 1296. Ex. 1001, 101:14-15. Tray 1294 includes tapered spike 1298 and plate member 1300. *Id.* at 101:15-16. The specification discloses that plate

member 1300 has a concave, spherically-shaped plateau surface (superior surface 1302). *Id.* at 101:18-20. Superior surface 1302 is provided with post 1306. *Id.* at 101:28-29. As described in the specification, post 1306 cooperates with recess 1308 located on bearing insert 1296 to permit rotation of bearing insert 1296 with respect to tibial tray 1294. *Id.* at 101:28-31.

Post 1306 is offset medially toward the medial compartment of the knee. *Id.* at 101:56-57; fig. 90. “In prior art rotating platform designs,” according to the specification, “the post is substantially in line with the central keel.” *Id.* at 101:58-59. The ’736 Patent discloses that “[o]ffsetting post 1306 more toward the medial compartment of the knee recreates the natural pivoting motion o[f] the knee, with less translation medially, a more stable joint medially, and more rotational arc or more movement laterally.” *Id.* at 101:63-67.

C. Illustrative Claims

Claims 15 and 31 are independent. Claims 16-28 depend directly or indirectly from claim 15, and claims 32-36 depend directly from claim 31. Claims 15 and 23 are reproduced below:

15. A device to replace an articulating surface of a first side of a joint in a body, the joint having first and second sides, comprising:

a base component, including a bone contacting side connectable with bone on the first side of the joint, and a base sliding side on an opposite side of said base component relative to said bone contacting side;

a movable component, including a movable sliding side, said movable sliding side being matably positionable in sliding engagement with said base sliding side, and an articulating side on an opposite side of said

movable component relative to said movable sliding side, shaped to matingly engage an articulating surface of the second side of the joint;

a protrusion extending from one of said base sliding side or movable sliding side, said protrusion substantially offset with respect to a midline of the first side of a joint;

a recess sized to receive said protrusion, disposed in the other of said base sliding side or movable sliding side, said protrusion and recess matable to constrain movement of said first and second components relative to each other, thereby promoting movement of the joint within desired anatomical limits.

23. The device of claim 15, wherein said protrusion is a dovetail pin and said recess is a dovetail tail, together forming a dovetail joint.

D. The Asserted Prior Art

Petitioner contends that the “priority date” (earliest effective filing date) for the challenged claims of the ’736 Patent is July 8, 2002. Pet. 14. Petitioner relies upon the following prior art references (*id.* at 4):

Walker	US 5,755,801	May 26, 1998 (filed July 18, 1994)	Ex. 1002
Insall ’283	US 6,319,283 B1	Nov. 20, 2001 (filed July 2, 1999)	Ex. 1003
Insall ’658	US 6,068,658	May 30, 2000 (filed Mar. 9, 1998)	Ex. 1004

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