

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*.

ZECHER, *Administrative Patent Judge*.

ORDER
Conduct of the Proceeding
37 C.F.R. § 42.5

An initial conference call in the above proceeding was held on June 30, 2014, between respective counsel for Petitioner and Patent Owner, and Judges Saindon, Zecher, and Rice. Petitioner provided a court reporter and agreed to file a transcript of the call separately as an exhibit. The purpose of the call was to discuss any proposed changes to the Scheduling Order (Paper 13), and any motions that the parties intend to file. Prior to the call, Petitioner and Patent Owner each filed a list of proposed motions. Papers 14 and 15. The following issues were discussed.

1. Scheduling Order

The parties indicated that they have no issues with the current Scheduling Order. Petitioner, however, noted that it was in the process of filing another petition that requests an *inter partes* review of certain dependent claims of U.S. Patent No. 7,837,736 B2, as well as a motion for joinder under 37 C.F.R. § 42.122(b) that requests joinder of the new proceeding with this proceeding. Petitioner indicated that, once the new petition was accorded a filing date, it would confer with Patent Owner to see if there were certain efficiencies that could be achieved by shortening the time period to file a Patent Owner Preliminary Response. Petitioner further indicated that, after conferring with Patent Owner, it may contact us to request a revision to the due dates established for the preliminary stages of the new proceeding. In response, Patent Owner indicated that it was not ready to discuss any revisions to due dates established for the preliminary stages of a proceeding that it was just made aware of and that had yet to be accorded a filing date. We indicated that, after a filing date was accorded to the new petition, and the parties had an opportunity to confer, the parties may schedule another conference call with us to discuss this matter further.

2. Motion to Amend

Patent Owner indicated that it is still contemplating whether to file a motion to amend. Patent Owner also indicated that, although it was aware of the requirement to confer with us prior to filing a motion to amend under 37 C.F.R. § 42.121(a), it wasn't clear whether it was still required to confer with us if its motion to amend only cancelled some of the challenged claims. We indicated that, even if Patent Owner decided to file a motion to amend that only cancels some of the challenged claims, Patent Owner still must confer with us prior to filing its motion to amend.

3. Additional Considerations

Except as provided otherwise, the parties are reminded to seek prior authorization from us before filing a motion in this proceeding. 37 C.F.R. § 42.20(b).

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