

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.

IPR2014-00191 (Patent 7,837,736 B2)
IPR2014-00321 (Patent 7,806,896 B1)
IPR2014-01078 (Patent 7,837,736 B2)
IPR2014-01080 (Patent 7,806,896 B1)¹

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

SAINDON, *Administrative Patent Judge*.

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

¹ We exercise our discretion to issue one Order to be filed in each case. The parties are not authorized to use this style heading for any subsequent papers.

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On July 29, 2014, a conference call was held between respective counsel of the parties and Judges Saindon, Zecher, and Rice. The call was to discuss IPR2014-00191 and IPR2014-00321,² and IPR2014-01078 and IPR2014-01080.³

Petitioner requested the call. Petitioner provided a court reporter and indicated that it would file the transcript of the call as an exhibit in each of the above-identified proceedings.

The following topics were discussed.

Change in Petitioner's Counsel

Petitioner first noted that, on July 23, 2014, Petitioner filed a new Power of Attorney in each of these proceedings designating Messrs. Modi and Palys as lead and back-up counsel, respectively. IPR2014-00191, Paper 20; IPR2014-00321, Paper 22; IPR2014-01078, Paper 9; IPR2014-01080, Paper 9. Of these two attorneys, prior to that date, only Mr. Modi was listed as back-up counsel, and that was only in IPR2014-00191 and IPR2014-00321. IPR2014-00191, Paper 16; IPR2014-00321, Paper 18. Petitioner wished to clarify the status of lead and back-up counsel in each of these proceedings.

We advised Petitioner's counsel present on the call, Mr. Modi, that we considered his status to be back-up counsel for Petitioner in each of these four proceedings, as we have not received a motion from Petitioner's lead counsel (or any other counsel) to withdraw. Notably, in each of these

² We instituted *inter partes* review in these two proceedings on June 2, 2014.

³ In these two proceedings, Petitions were filed after our June 2, 2014 institution decisions in IPR2014-00191 and IPR2014-00321; those later-filed petitions challenge the same patents as the earlier-filed proceedings.

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proceedings, the lead counsel and back-up counsel indicated by Petitioner in the Petition, as well as counsel *pro hac vice* in IPR2014-00191 and IPR2014-00321, are from a different law firm than Messrs. Modi and Palys. During the call, we authorized Petitioner to file, in each proceeding, a motion under 37 C.F.R. § 42.10(e) requesting withdrawal of lead counsel and substitution of new lead counsel. Further, we directed Petitioner to indicate in that motion which attorney(s) are back-up counsel so as to clarify the record. Patent Owner did not request permission to file an opposition to this motion. As such, we do not authorize Patent Owner to file an opposition at this time.

Petitioner's Request to Move Forward Patent Owner's Preliminary Response Period

The due date for Patent Owner's Preliminary Response in IPR2014-01078 and IPR2014-01080 is currently October 15, 2014, three months after the mailing of the Board's Notice of Filing Date Accorded. IPR2014-01078, Paper 5; IPR2014-01080, Paper 5. Petitioner requested we shorten Patent Owner's time period to file its Preliminary Response in IPR2014-01078 and IPR2014-01080 in order to expedite these proceedings to align them more closely with IPR2014-00191 and IPR2014-00321. The two latter-filed IPRs—namely, IPR2014-01078 and IPR2014-01080—only challenge claims on which we denied institution in IPR2014-00191 and IPR2014-00321. Petitioner made similar arguments in its Motion for Joinder. IPR2014-01078, Paper 3; IPR2014-01080, Paper 3.

Patent Owner indicated that it opposed Petitioner's Motion for Joinder and it opposed Petitioner's request to expedite the latter IPRs. Nevertheless,

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Patent Owner represented that it intended to file its Patent Owner Preliminary Response by September 12, 2014.

We will issue our ruling on Petitioner's Motion for Joinder in the event we institute an *inter partes* review in IPR2014-01078 or IPR2014-01080, which we will decide in due course.

Petitioner's Request to Discuss Petitioner's Filing Date of IPR2014-01078 and IPR2014-01080

Petitioner indicated that, while a Petition was filed with the Board on June 30, 2014 for IPR2014-01078 and IPR2014-01080, Petitioner did not serve Patent Owner with a copy of the Petitions until July 10, 2014. IPR2014-01078, Paper 4; IPR2014-01080, Paper 4. Based on that service date, the Board accorded Petitioner a filing date of July 10, 2014, in both of these proceedings. IPR2014-01078, Paper 5; IPR2014-01080, Paper 5.

Petitioner noted that Patent Owner argues, in its Oppositions to Petitioner's Motion for Joinder in these two proceedings (IPR2014-01078, Paper 8; IPR2014-01080, Paper 8), that Petitioner's Motions for Joinder are untimely, as the Petitioner was accorded a filing date of July 10, 2014 in the latter-filed proceedings, whereas the two earlier proceedings were instituted on June 2, 2014. *See* 37 C.F.R. § 42.122(b) ("Any request for joinder must be filed . . . no later than one month after the institution date of any *inter partes* review for which joinder is requested."). Petitioner indicated that it intended to discuss this issue in its Reply to Patent Owner's Opposition to Petitioner's Motion for Joinder. We noted that a Reply is the proper avenue to respond to Patent Owner's argument that the Motions for Joinder are untimely. *See* 37 C.F.R. § 42.23(b) ("A reply may only respond to

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arguments raised in the corresponding opposition or patent owner response.”).

Patent Owner’s Potential Disclaimer of Claims or Motion to Cancel Claims by Amendment in IPR2014-00191 and IPR2014-00321

Patent Owner noted its duty to confer with the Board before filing any Motion to Amend under 37 C.F.R. § 42.121(a), and stated that it may seek to cancel one or more claims in one or more of these proceedings by amendment. We advised Patent Owner that its duty to confer with the Board prior to filing a motion to amend is met to the extent it seeks to file a motion canceling one or more claims by amendment. We also note that Patent Owner may disclaim one or more claims under 35 U.S.C. § 253(a) and 37 C.F.R. § 1.321(a), in the manner described therein, which would not require the filing of a motion to amend. *See, e.g.*, IPR2014-00321, Paper 15 (Notice of Filing of Disclaimer of claim 40).

ORDER

In consideration of the foregoing, it is:

ORDERED Petitioner is authorized, in IPR2014-00191, IPR2014-00321, IPR2014-01078, and IPR2014-01080, to file a Motion to Withdraw Lead Counsel by August 6, 2014;

FURTHER ORDERED that, in its Motion to Withdraw Lead Counsel, Petitioner will designate one attorney as lead counsel and will list all attorneys that are back-up counsel.

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