

Filed on behalf of: Zimmer Holdings, Inc. & Zimmer, Inc.

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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 No. 7,837,736

**PETITIONER'S REPLY UNDER 37 C.F.R. § 42.23
TO PATENT OWNER'S RESPONSE**

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I. Introduction

Zimmer Holdings, Inc. and Zimmer, Inc. (collectively, “Petitioner”) submit this reply to Bonutti Skeletal Innovations, LLC’s (“Patent Owner”) response to the Board’s Decision instituting an *inter partes* review of U.S. Patent No. 7,837,736 (“the ’736 patent”). The Board found that “there is a reasonable likelihood that Petitioner would prevail in its challenge of claims 15-22, 26-28, and 31-36 of the ’736 patent” based on U.S. Patent No. 5,755,801 to Walker (“Walker”). Paper 12 (“Decision”) at 17. Following the Decision, Patent Owner filed a statutory disclaimer under 37 C.F.R. § 1.321(a) with respect to claims 15-20 and 26-28, Exhibit 2005, and a response addressing the patentability of claims 21, 22, and 31-36, Paper 26 (“Response”). In its Response, Patent Owner makes essentially three arguments in an attempt to salvage the validity of claims 21, 22, and 31-36. But as discussed below, all three arguments lack merit and should be rejected.

Patent Owner’s first two arguments turn on the meaning of the terms “pin,” “post,” “hole,” and “cavity” in claims 22 and 31. Patent Owner argues that Walker does not disclose these features. *See* Response at 7-18. As confirmed by the cross-examination of Patent Owner’s expert, Dr. Scott D. Schoifet, however, Patent Owner has not applied the broadest reasonable interpretation in light of the specification (37 C.F.R. § 42.100(b)) to these terms. *See e.g.*, Ex. 1022 at 97:19-21 (defining cavity); 137:18-19 (defining hole). Under the broadest reasonable

construction and as the Board found in its Decision, Walker's abutment 50 is the claimed pin/post and recess 51 is the claimed hole/cavity. *See* Decision at 11-12.

Patent Owner also argues that Walker cannot anticipate claims 21 and 31 because meniscal component 44 does not rotate about "an axis of rotation" located at abutment 50. *See* Response at 18-20. Claims 21 and 31, however, have no such requirement, reciting only that rotation occurs "about an axis of [a] protrusion" (claim 22) or "about [a] post" (claim 31). Under the broadest reasonable construction and as the Board found in its Decision, Walker's meniscal component 44 rotates about an axis of or about abutment 50. *See* Decision at 11-12.

Because Walker discloses element-for-element all that is required in claims 21, 22, and 31-36 of the '736 patent, and Patent Owner's arguments disregard the claim language and the disclosure of Walker, the Board should issue a final decision cancelling claims 21, 22, and 31-36 of the '736 patent.

II. Walker Discloses the Claimed "Pin"/"Post"

Relying on the Petition and supporting evidence, the Decision found that Walker discloses the "pin" of claim 21 and the "post" of claim 31. Decision at 11-12 (citing to Paper 8 ("Corrected Petition") at 28-35). Specifically, Walker expressly discloses a "semi-circular abutment 50 which is upstanding at a medial side of the platform," and explains that "meniscal component can be fitted to the

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