

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 IPR2014-00321
Patent 7,806,896 B1

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

SAINDON, *Administrative Patent Judge*.

DECISION

Final Written Decision
35 U.S.C. § 318(a) and 37 C.F.R. § 42.73

I. INTRODUCTION

We have jurisdiction under 35 U.S.C. § 6(c). This Final Written Decision is entered pursuant to 35 U.S.C. § 318(a) and 37 C.F.R. § 42.73.

With respect to the grounds asserted in this trial, we have considered the papers submitted by the parties and the evidence cited therein. For the reasons discussed below, we determine that claim 42, the only remaining challenged claim of U.S. Patent No. 7,806,896 B1 (Ex. 1001, “the ’896 patent”), is unpatentable.

A. Procedural History

Zimmer Holdings, Inc. and Zimmer, Inc. (“Petitioner”) filed a corrected Petition requesting an *inter partes* review of claims 40–47 of the ’896 patent. Paper 7 (“Pet.”). Petitioner included a Declaration of Dr. Arthur G. Erdman, Ph.D. Ex. 1002. Bonutti Skeletal Innovations, LLC (“Patent Owner”) elected not to file a Preliminary Response to the Petition. Paper 12.

In our Decision Instituting *Inter Partes* Review, we granted review as to some of the challenged claims, namely, claims 40–42 and 44–47, but not claim 43. Paper 13 (“Dec. Inst.”). Patent Owner filed a Response to the Petition (Paper 28, “PO Resp.”). Patent Owner also filed notices indicating that it disclaimed claims 40, 41, and 44–47, leaving only claim 42 remaining of the challenged claims. Papers 15, 27; Exs. 2001, 2002. Petitioner then filed a Reply to the Response (Paper 31, “Pet. Reply”).

B. Related Matters

Petitioner states that the ’896 patent is involved in a co-pending district court proceeding titled *Bonutti Skeletal Innovations LLC v. Zimmer*,

Inc., 1:12-cv-01107-GMS (D. Del.). Paper 19, 1. The '896 patent also is discussed in a Final Written Decision determining claim 1 of the '896 patent to be unpatentable. *Smith & Nephew, Inc. v. Bonutti Skeletal Innovations LLC*, Case IPR2013-00629, slip op. at 35 (PTAB Feb. 18, 2015) (Paper 31).¹

C. The '861 Patent

The '896 patent, titled “KNEE ARTHROPLASTY METHOD,” issued October 5, 2010 from U.S. Patent Application No. 10/722,102, filed November 25, 2003. Ex. 1001, [54], [45], [21], [22]. The '896 patent is a continuation of U.S. Patent Application No. 10/191,751, filed July 8, 2002, now U.S. Patent No. 7,104,996, and is a continuation-in-part of a number of earlier-filed applications. *Id.* at [63].

Claim 42 is the sole remaining claim challenged, and depends from independent claim 40. Independent claim 40 is directed to a method for performing joint replacement surgery. An alignment guide is custom fabricated for the patient based on patient imaging information. Ex. 1001, 116:18–24. A cutting guide is referenced to the alignment guide, and using the cutting guide, a cut is made. *Id.* at 116:25–31. Claim 42 specifies how the “referencing” step is performed. *Id.* at 116:34–37.

D. Challenged Claim

Claim 42, which depends from claim 40, is the sole remaining challenged claim. Claims 40 and 42 of the '896 patent are reproduced below:

¹ *Wright Medical Group, Inc. v. Bonutti Skeletal Innovations LLC*, Case IPR2014-00354, was joined to IPR2013-00629.

40. A method of replacing at least a portion of a joint in a patient, the method comprising the steps of:
obtaining an alignment guide positionable on a bone using references derived independently of an intramedullary device, wherein the alignment guide is custom fabricated for the patient based on patient imaging information;
positioning the alignment guide in relation to the surface of an unresected bone of the joint;
referencing a cutting guide with respect to the alignment guide; and
cutting the unresected bone of the joint for the first time, by moving a cutting tool along a guide surface of the cutting guide.
42. The method of claim 40, wherein referencing the cutting guide includes positioning a pin into the bone to secure the cutting guide to the bone and wherein the pin position is determined by the alignment guide.

Ex. 1001, 116:18–31, 34–37.

E. Asserted Grounds and Prior Art

The sole remaining ground in this proceeding is whether claim 42 is obvious in view of Radermacher '157² and the Radermacher Article.³

² WO 93/25157, published Dec. 23, 1993 (Ex. 1003).

³ Klaus Radermacher et al., *Computer-Integrated Orthopaedic Surgery: Connection of Planning and Execution in Surgical Intervention*, in *Computer-Integrated Surgery* (Russell H. Taylor et al. eds., 1996) (“Radermacher Article”) (Ex. 1004).

II. ANALYSIS

A. Claim Construction

We interpret the claims of an unexpired patent using the broadest reasonable interpretation in light of the specification of the patent. 37 C.F.R. § 42.100(b); *In re Cuozzo Speed Techs., LLC*, 778 F.3d 1271, 1281–82 (Fed. Cir. 2015). Under the broadest reasonable interpretation standard, claim terms are given their ordinary and customary meaning, as would be understood by one of ordinary skill in the art, in the context of the entire disclosure. *In re Translogic Tech. Inc.*, 504 F.3d 1249, 1257 (Fed. Cir. 2007). Any special definition for a claim term must be set forth with reasonable clarity, deliberateness, and precision. *In re Paulsen*, 30 F.3d 1475, 1480 (Fed. Cir. 1994).

Claim 40 includes a step of “positioning” an alignment guide “in relation to the surface of an unresected bone.” Ex. 1001, 116:25–26. The claim also includes a step of “referencing” a cutting guide with respect to the alignment guide. *Id.* at 116:27–28. Claim 42 further defines the “referencing” step, specifying that the step “includes positioning a pin into the bone to secure the cutting guide to the bone,” wherein the pin position is “determined by the alignment guide.” *Id.* at 116:34–37. A dispositive issue in this proceeding turns on the proper construction of these limitations.

Petitioner argues that the above limitations read on a procedure wherein an alignment guide is secured to the bone using pins and then a cutting guide is secured to the alignment guide, the pins thus securing the cutting guide to the bone via the alignment guide. *See* Pet. Reply 3–5. Patent Owner argues that the above limitations do not read on such a procedure, and that these limitations require that the cutting guide is secured

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