

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ZIMMER HOLDINGS, INC.
ZIMMER, INC.
Petitioners

v.

BONUTTI SKELETAL INNOVATIONS LLC
Patent Owner

Patent No. 7,837,736
Filing Date: October 30, 2007
Issue Date: November 23, 2010
Title: MINIMALLY INVASIVE SURGICAL SYSTEMS AND METHODS

Inter Partes Review No. Unassigned

**MOTION FOR JOINDER TO RELATED
INSTITUTED *INTER PARTES* REVIEW (37 C.F.R. § 42.122(b))**

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I. STATEMENT OF RELIEF REQUESTED

Pursuant to 35 U.S.C. § 315(c) and 37 C.F.R. § 42.122(b), Petitioners Zimmer Holdings, Inc. and Zimmer, Inc. (collectively, “Zimmer” or “Petitioners”) seek with this Motion to have their Petition for *Inter Partes* Review (“IPR”) of claims 23-25 of U.S. Patent No. 7,837,736 (the “New Petition” involving the “’736 Patent” (Ex. 1001)), filed contemporaneously herewith, joined with the instituted *inter partes* review, *Zimmer Holdings, Inc. & Zimmer, Inc. v. Bonutti Skeletal Innovations LLC*, IPR2014-00191 (instituted June 2, 2014) (Ex. 1011), which involves claims 15-22, 26-28, and 31-36 of the ’736 Patent. If the Board deems it a necessary concurrent measure in granting this Motion, pursuant to 35 U.S.C. § 315(d) and 37 C.F.R. § 42.122(a), Zimmer further requests that the Board consolidate the matter involving the New Petition with IPR2014-00191.

II. STATEMENT OF MATERIAL FACTS

1. On September 10, 2012, Patent Owner, Bonutti Skeletal Innovations LLC (“Bonutti” or “Patent Owner”), filed a lawsuit against Zimmer involving three patents generally related to knee implants and implantation methods, *Bonutti Skeletal Innovations LLC v. Zimmer Holdings, Inc. & Zimmer, Inc.*, No. 1:12-cv-01107-GMS (D. Del.) (the “Concurrent Litigation”).

2. Zimmer received service of Bonutti’s Complaint in the Concurrent Litigation on January 4, 2013.

3. On January 15, 2013, Bonutti filed an Amended Complaint in the Concurrent Litigation, which included claims directed to three additional patents generally related to knee implants and implantation methods, including the '736 Patent.

4. Zimmer received service of Bonutti's Amended Complaint in the Concurrent Litigation on the same day it was filed, January 15, 2013.

5. With respect to the '736 Patent, Zimmer's one-year deadline under 35 U.S.C. § 315(b) and 37 C.F.R. § 42.101(b) was January 15, 2014.

6. On November 22, 2013, Zimmer filed a petition seeking IPR of claims 15-28 and 31-36 of the '736 Patent. (*See* IPR2014-00191, Paper 1.)

7. At the time Zimmer filed its petition in IPR2014-00191, Zimmer was—and at present remains—unaware of the claims of the '736 Patent that Bonutti intends to assert against Zimmer in the Concurrent Litigation. Zimmer drafted its petition in IPR2014-00191 without certainty regarding which claims of the '736 Patent Bonutti may, in the future, attempt to assert against Zimmer.

8. On January 22, 2014, Zimmer and others adverse to Bonutti in the Concurrent Litigation jointly moved to stay the litigation pending the outcome of various IPR petitions involving patents asserted in the Concurrent Litigation, including the '736 Patent. (*See* Concurrent Litigation, Dkt. No. 36 (Ex. 1016).)

9. On April 7, 2014, the Court granted the joint motion to stay the Concurrent Litigation, (*see id.* Dkt. No. 45 (Ex. 1017)), and, as such, the Concurrent Litigation is presently stayed.

10. In granting the stay, the Court found that “[d]espite the Defendants’ requests for specificity, Bonutti did not clearly state before the IPR deadline which of the hundreds of claims in its multiple patents it intended to assert against the Defendants. Under the circumstances, the Defendants’ use of the year-long period [after being served with Bonutti’s complaint, under 37 C.F.R. § 42.101(b),] to attempt to determine exactly which claims Bonutti would ultimately assert was reasonable.” (Ex. 1017, at 7 (citations omitted).)

11. On June 2, 2014, the Board instituted IPR in IPR2014-00191 for claims 15-22, 26-28, and 31-36—but not claims 23-25—of the ’736 Patent. (*See* Ex. 1011, IPR2014-00191, Paper 12, at 2, 17.)

12. Claims 23 and 25 each depend from independent claim 15, and claim 24 further depends from claim 23.

13. Among other grounds, Zimmer’s petition in IPR2014-00191 sought review of claim 15 on the ground that it was anticipated by U.S. Patent No. 5,755,801 to Walker et al. (“Walker”) (Ex. 1002) under 35 U.S.C. § 102(b). (*See* IPR2014-00191, Paper 1, at 3-4.) In addition, Zimmer sought review of claims 23-25 on the basis of various grounds, several of which included Walker. (*Id.*)

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