

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 IPR2014-01078
Patent No. 7,837,736

**PETITIONER'S REPLY TO PATENT OWNER'S OPPOSITION TO
PETITIONER'S MOTION FOR JOINDER**

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37 C.F.R. § 42.1(b)1

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Patent Owner Bonutti agrees with essentially all the facts in Petitioner's motion for joinder, including the substantial overlap with IPR2014-00191 ("the '191 IPR"). Nonetheless, it opposes joinder. But Bonutti's arguments should be rejected, especially when the joined proceedings will involve only three additional claims (dependent claims 23-25), and joinder will not unduly delay but instead help "secure the just, speedy, and inexpensive resolution" of the proceedings. *See* 37 C.F.R. § 42.1(b); *see also* 35 U.S.C. § 316(b).

I. PETITIONER'S MOTION FOR JOINDER WAS TIMELY FILED

Petitioner timely filed its motion for joinder under 37 C.F.R. § 42.122(b), which states that "[a]ny request of joinder must be *filed* . . . no later than one month after the institution date of an *inter partes review* for which joinder is requested." (Emphasis added). As the motion was filed on June 30, 2014, within one month after the institution in the '191 IPR, the motion was timely.

Bonutti argues that the motion was filed after the one month date based on a service issue. *See* Paper 8 at 3. Specifically, when Petitioner filed its petition and motion for joinder, it served Bonutti's IPR counsel of record in the '191 IPR, and inadvertently did not serve the correspondence address associated with the patent. When Petitioner became aware of this issue, Petitioner served another copy at the correspondence address. *See* Paper 4. Based on the supplemental service, the petition was accorded a filing date of July 10, 2014. *See* Paper 5. Bonutti now

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