

Filed on behalf of: BONUTTI SKELETAL INNOVATIONS LLC Paper ___
Date: September 12, 2014

By: Cary Kappel, Lead Counsel
William Gehris, Backup Counsel
Davidson, Davidson & Kappel, LLC
485 Seventh Avenue
New York, NY 10018
Telephone (212) 736-1257
(212) 736-2015
Facsimile (212) 736-2427
E-mail: ckappel@ddkpatent.com
wgehris@ddkpatent.com

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: IPR2014-001078

Patent 7,837,736

PATENT OWNER'S PRELIMINARY RESPONSE

Pursuant to 35 U.S.C. §313 and 37 C.F.R. §42.107, Patent Owner, Bonutti

Skeletal Innovations, LLC ("Bonutti"), submits the following Patent Owner's Preliminary Response in response to a Petition for *inter partes* review filed by Zimmer Holdings, Inc. and Zimmer Inc. ("Zimmer") concerning claims 23, 24 and 25 of U.S. Patent No. 7,837,736 ("the '736 patent") (Ex. 1001).

Petitioner contends under Ground 1 that claim 25 is anticipated by Walker et al. U.S. Patent 5,755,801 ("Walker") (Ex. 1002); and contends under Ground 2 that claims 23-25 are obvious over Walker in view of Buechel et al. U.S. Patent 4,340,978 ("Buechel") (Ex. 1012). (See Petition, Paper 1, pp. 26-30, 30-34).

Petitioner previously challenged the validity of claims 23 and 24 in IPR2014-00191, and the Board rejected Petitioner's challenge finding that "Petitioner has not demonstrated a reasonable likelihood of prevailing on its contention that the subject matter of claims 23 and 24 would have been obvious over (i) Walker and Insall '658 or (ii) Walker, Insall '658, and Insall '283. See Zimmer v. Bonutti Skeletal Innovations, LLC, IPR2014-00191, Institution Decision, Paper 12, p. 16 (Pat. App. 2014). Petitioner also challenged the validity of claim 25 in IPR2014-00191 on multiple grounds, including anticipation by Walker, all of which were rejected because "Petitioner has failed to provide the claim construction analysis required by 37 C.F.R. § 42.104(b) (3) for the means-plus function limitation recited in claim 25." (Id. at 13).

Petitioner was served with a complaint alleging infringement of the '736

patent on January 4, 2013, more than a year prior to the July 10, 2014 filing date of the Petition (Petitioner's Motion for Joinder, Paper 3, p. 1). Accordingly, the Petition is barred under 37 C.F.R. § 42.102(b) absent joinder with IPR2014-00191 under 37 C.F.R. § 42.122(b). Patent Owner opposed the Petitioner's Motion for Joinder (Paper 3) on the grounds that it is untimely and not an appropriate mechanism to seek reconsideration of a denial of an inter partes review of claims, particularly in this case where the Petitioner seeks review on the identical claims previously denied. (See Patent Owner Opposition to Joinder, Paper 8).

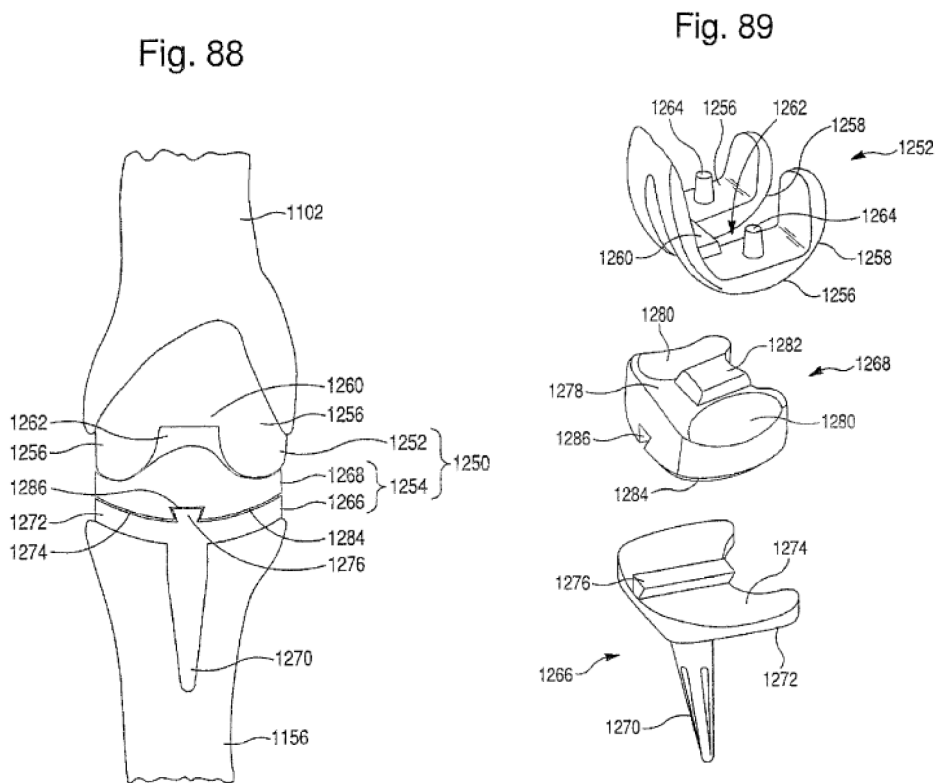
For at least¹ the reasons set forth herein, Petitioner has, for a second time, failed to meet its burden to establish a reasonable likelihood that claim 25 is anticipated by Walker or that claims 23-25 are unpatentable as obvious over of Walker in view of Buechel, and thus, the inter partes review of claims 23-25 of the '736 patent should again be denied under 35. U.S.C. § 314(a).

I. The '736 Patent

The '736 patent describes a number of surgical techniques, surgical instruments, and implants. Claims 23-25 are directed to an embodiment of the '736

¹ This paper sets forth Patent Owner's *preliminary* response to the petition under 37 C.F. R. § 42.107(a). Patent Owner expressly reserves the right to contest any ground of patentability for which review is instituted, and to contest any and all factual and legal contentions asserted in the Petition.

patent, which can be illustrated with Figures 88-89, reproduced below:



Figures 88-89 illustrate a mobile bearing implant 1250 including a femoral component 1252 and a tibial component 1254. (*Id.*, col. 99, ll. 36-38). The tibial component 1254, in turn, is comprised of a tibial tray 1266 and a bearing insert 1268. Tray 1266 includes a tapered spike 1270 and a plate member 1272. (*Id.*, col. 99, ll. 50-51). Plate member 1272 has a superior surface 1274 which is shown as "a concave, spherically shaped plateau surface." (*Id.*, col. 99, ll. 53-54). Bearing insert 1268 has a spherically shaped inferior surface 1284 so that the interface between tibial tray 1266 and bearing insert 1268 enables sliding motions along these inferior (1284) and superior (1274) surfaces. (*Id.*, col. 99, ll. 56-60).

The superior surface of the bearing insert 1268 interfaces with the femoral

component 1252. In this regard, the superior surface of the bearing insert includes a pair of depressions (1280 in Figure 89) that form bearing surfaces for the condyles surfaces of the femoral component. (Id., col. 100, ll. 6-8).

The bearing insert 1268 includes a recess in the form of a dovetail shaped groove 1286 which mates with a protrusion in the form of a dovetail pin shaped track 1276. Although "shown centrally located, track 1276 can be located elsewhere along superior surface 1274 . . ." (Id., Figures 88-89. col. 99, l. 62 to col. 100, l. 1).

Although Figures 88-89 depict the protrusion 1276 on the tray 1266 and the recess 1268 on the bearing insert 1268, this arrangement can be switched so that the protrusion is on the bearing insert and the recess is on the tray. (Id., col. 100, ll. 2-5).

Further, although this self-centering mobile bearing implant is illustrated with reference to total knee replacement, it can also be "applied to . . . partial knee replacement." (Id., col. 102, ll. 1-4).

II. Claims 23-25 Of The '736 Patent

Claims 23-25 depend from claim 15.² Claims 15, 23-25 are set forth below:

15. A device to replace an articulating surface of a first side of a joint in a body, the joint having first and second sides, comprising:

² A statutory disclaimer has previously been filed with regard to Claim 15. See Zimmer v. Bonutti Skeletal Innovations, LLC, IPR2014-00191, Paper 26.

Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

Real-Time Litigation Alerts



Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

Advanced Docket Research



With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

Analytics At Your Fingertips



Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

LAW FIRMS

Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

FINANCIAL INSTITUTIONS

Litigation and bankruptcy checks for companies and debtors.

E-DISCOVERY AND LEGAL VENDORS

Sync your system to PACER to automate legal marketing.