

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. 7,806,896
Filing Date: November 25, 2003
Issue Date: October 5, 2010
Title: KNEE ARTHROPLASTY METHOD

Inter Partes Review No. Unassigned

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

TABLE OF CONTENTS

I.	STATEMENT OF RELIEF REQUESTED	1
II.	STATEMENT OF MATERIAL FACTS	1
III.	LEGAL STANDARDS AND APPLICABLE RULES	6
IV.	ARGUMENT.....	7
A.	Multiple Reasons Show that Joinder Is Appropriate	7
1.	Considerations of Efficiency Support Joinder	7
2.	Lack of Undue Prejudice to Patent Owner Supports Joinder	11
3.	Public Policy Considerations Support Joinder	11
B.	Apart from Further Addressing the Motivation to Combine Prior Art References, There Are No New Grounds of Unpatentability in Zimmer’s New Petition	13
C.	Joinder Would Not Unduly Delay the Resolution of Either Proceeding and Any Delay Could Be Ameliorated Through Consolidation of Due Dates, Briefing, and Discovery.....	13
V.	CONCLUSION.....	15

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 claim 43 of U.S. Patent No. 7,806,896 (the “New Petition” involving the “’896 Patent” (Ex. 1001)), filed contemporaneously herewith, joined with the instituted *inter partes* review, *Zimmer Holdings, Inc. & Zimmer, Inc. v. Bonutti Skeletal Innovations LLC*, IPR2014-00321 (instituted June 2, 2014) (Ex. 1009), which involves claims 40-42 and 44-47 of the ’896 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 IPR2014-00321.

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, including the ’896 Patent, 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. With respect to the '896 Patent, Zimmer's one-year deadline under 35 U.S.C. § 315(b) and 37 C.F.R. § 42.101(b) was January 4, 2014.

4. On January 3, 2014, Zimmer filed a petition seeking IPR of claims 40-47 of the '896 Patent. (*See* IPR2014-00321, Paper 1.¹)

5. At the time Zimmer filed its petition in IPR2014-00321, Zimmer was—and at present remains—unaware of the claims of the '896 Patent that Bonutti intends to assert against Zimmer in the Concurrent Litigation. Zimmer drafted its petition in IPR2014-00321 without certainty regarding which claims of the '896 Patent Bonutti may, in the future, attempt to assert against Zimmer.

6. 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 '896 Patent. (*See* Concurrent Litigation, Dkt. No. 36 (Ex. 1011).)

7. On April 7, 2014, the Court granted the joint motion to stay the Concurrent Litigation, (*see id.* Dkt. No. 45 (Ex. 1012)), and, as such, the Concurrent Litigation is presently stayed.

¹ On January 24, 2014, pursuant to the Board's Notice, (*see* IPR2014-00321, Paper 4, at 2), Zimmer filed a corrected petition, (*see id.*, Paper 7), which the Board subsequently accepted, (*see id.*, Paper 9). Going forward, citations herein to Zimmer's "petition" will be citations to the corrected petition.

8. 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. 1012, at 7 (citations omitted).)

9. On June 2, 2014, the Board instituted IPR in IPR2014-00321 for claims 40-42 and 44-47—but not claim 43—of the ’896 Patent. (See Ex. 1009, IPR2014-00321, Paper 13, at 2, 10-11.)

10. Claim 43 depends from independent claim 40.

11. Among other grounds, Zimmer’s petition in IPR2014-00321 sought review of claim 40 on the ground that it was obvious, under 35 U.S.C. § 103, over PCT International Publication No. WO 93/25157 to Radermacher (the “Radermacher ’157 Publication”) (Ex. 1003) in view of Radermacher et al., *Computer-Integrated Orthopaedic Surgery: Connection of Planning and Execution in Surgical Intervention* (the “Radermacher Article”) (Ex. 1004). (See IPR2014-00321, Paper 7, at 4.) And, among other grounds, Zimmer sought review of claim 43 on the grounds that it was obvious under 35 U.S.C. § 103 over either (a) the Radermacher ’157 Publication in combination with either or both U.S.

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