

Filed on behalf of: BONUTTI SKELETAL INNOVATIONS LLC Paper _____
Date: July 18, 2014

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ZIMMER HOLDINGS, INC.,
ZIMMER INC.

Petitioner,

v.

BONUTTI SKELETAL INNOVATIONS LLC

Patent Owner

Case: IPR2014-01080

Patent 7,806,896

PATENT OWNER'S OPPOSITION TO PETIONER'S

I. Introduction

Patent Owner respectfully opposes the Motion for Joinder filed by Petitioner (Paper 3).

Petitioner, having waited until the last day of its one year deadline before filing IPR204-0321 on the '896 patent ('321 IPR), and having failed to move for reconsideration of the Board's Decision not to institute review of claim 43 of the '896 patent, seeks to use the joinder provisions of 37 C.F.R. § 42.122 to reargue the same grounds previously denied, with a new 35 page Petition, and a new 60 page Expert Declaration. In order to accommodate their extraordinary request, and after taking full advantage of the time periods allowed by the rules for filing its two petitions and its motion for joinder, Petitioner argues that the schedule in the '321 IPR need not be delayed because Patent Owner can simply be ordered to file its Patent Owner Preliminary Response and its Patent Owner Response to Petitioner's 95 page submission in a fraction of the time contemplated by the rules.

Joinder under these facts is not warranted under 35 U.S.C. § 315(c). First, joinder is untimely under 37 C.F.R. § 42.122(b). The instant petition and motion were accorded a filing date of July 10, 2014, more than one month after the June 2, 2014 Institution Decision in IPR2014-00321. Second, the Board has repeatedly denied joinder in cases where the Petitioner sought review of claims which had previously been denied review, and should do so in this case as well. See Microsoft Corp. v. Surfcast Inc., IPR2014-00271, Paper 20 (denying joinder as "not justified")

where "Petition does not identify any new grounds of unpatentability" but "[i]nstead . . . reasserts two grounds of unpatentability previously asserted"); Shaw Industries Group v. Automated Creel Sys. Inc., IPR2013-00584, Paper 20 (denying joinder).

Further, as set forth in more detail below, joinder would be highly prejudicial to Patent Owner, leaving it with a Hobson's choice: either agree to respond to the instant IPR 2014-00180 in a fraction of the time contemplated by the rules, thereby substantially prejudicing its ability to defend its patent claims; or delay the hearing in the '321 IPR by five or more months, while its litigation, already 18 months old and under a stay at Petitioner's request, is delayed for at least another year. Patent Owner should not be placed in this position to accommodate Petitioner's extraordinary request for a second review of grounds previously denied by this Board.

II. Response to Petitioner's Statement of Facts

With one exception that is not germane to this motion,¹ Patent Owner does not dispute the facts set forth in Petition's Motion for Joinder. Rather, Patent Owner believes that the facts compel denial of Petitioner's Motion for Joinder.

Petitioner admits that it filed the '321 IPR on the 364th day of its one year deadline under 35 U.S.C. § 315(b) (Motion for Joinder, Paper 3, Fact 3); admits that its Petition raises the same grounds of unpatentability that it previously raised in the

¹ Patent Owner denies paragraph 5 of Petitioner's Statement of Facts. As a non-limiting example, Zimmer was provided with a presentation setting forth Patent Owner's basis for alleging infringement of claim 40 in May 2013

'321 IPR (Id., Facts 9-16), and admits that it knows no more about Patent Owner's infringement contentions that it did when it filed the '321 IPR (Id., Facts 4-5).

Petitioner admits that it has filed its new petition and new evidence to "directly address the issue that caused the Board to decline to institute trial on claim 43 in IPR 2014-00321" (Id., Fact 15). Petitioner does not contend that the new petition or new declaration contain information that was unknown or unavailable to Petitioner when it filed the '321 IPR.

Rather, Petitioner's complaint is that the Board was unconvinced by Petitioner's arguments regarding claim 43 in the '321 IPR, so they would like to try again, with a new 35 page Petition, and a new 60 page Expert Declaration, directed solely to claim 43 (Id., Facts 13-18).

III. Petitioner's Motion for Joinder is Untimely

Petitioner's Motion for Joinder should be denied as untimely under 37 C.F.R. § 42.122(b). The instant petition and motion were accorded a filing date of July 10, 2014, more than one month after the June 2, 2014 Institution Decision in IPR2014-00321.

IV. Joinder Is Not An Appropriate Mechanism To Seek

Reconsideration of a Denial of Inter Partes Review of a Claim

Joinder may only be authorized when *warranted*, and the burden is on the Petitioner to establish entitlement to joinder. See Shaw Industries Group, IPR2013-00584, Paper 20 at p. 3. Further, the decision to grant joinder is *discretionary* and

when exercising that discretion, "the Board is mindful that patent trial regulations

including the rules for joinder, must be construed to secure the *just*, speedy, and inexpensive resolution of every proceeding. " *Id.* (emphasis added).

Allowing joinder in this proceeding is not warranted, and would be neither just nor speedy.

A. 35 U.S.C. § 315(c) Does not Provide for Joinder of Multiple Proceedings Brought by the Same Party Where no New Grounds are Advanced

The Board should not grant Petitioner's motion for joinder because the plain language of 35 U.S.C. § 315(c) does not provide for joinder in the case of a later proceeding that involves the *same* parties (and no additional parties) as the proceeding that is sought to be joined, and surely not where no new grounds of invalidity are advanced.

35 U.S.C. § 315(c) ("JOINDER") states (emphasis added):

If the Director institutes an inter partes review, the Director, in his or her discretion, may join *as a party* to that inter partes review any person who properly files a petition under section 311 that the Director, after receiving a preliminary response under section 313 or the expiration of the time for filing such a response, determines warrants the institution of an inter partes review under section 314.

The instant petition and the '321 IPR involve the same two parties. Accordingly, Petitioner in the instant proceeding cannot be joined "as a party" to the '321 IPR because it is already a party to that proceeding. Further, Petitioner is advancing no new grounds of invalidity in the instant proceeding that would warrant joinder with the '321 IPR. To the contrary, it is advancing the same grounds that were denied in

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