

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MAKO SURGICAL CORP.,
Petitioner

v.

BLUE BELT TECHNOLOGIES, INC.,
Patent Owner

IPR2015-00629
U.S. Patent No. 6,757,582 B2

PATENT OWNER RESPONSE

Mail Stop **Patent Board**
Patent Trial and Appeal Board
U.S. Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

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I. Introduction

Patent Owner Blue Belt Technologies, Inc. (hereinafter, “Patent Owner”) respectfully submits this Patent Owner Response under 35 U.S.C. §§311-319 and 37 C.F.R. §42.120. It is being timely filed by November 10, 2015 pursuant to the parties’ stipulation on due dates filed as Paper No. 9 on October 8, 2015.

The Patent Trial and Appeal Board (hereinafter the “Board” or “PTAB”) instituted review on the following grounds: (1) claims 1, 5, 6, 8, 9, 13, 14, 16, 17, 21-30, 34-42, 47, and 50-58 of U.S. Patent No. 6,757,582 (hereinafter, Ex. 1001 or the “’582 Patent”) being anticipated under 35 U.S.C. §102(b) over Taylor (Ex. 1008), (2) claim 3 of the ’582 Patent being obvious under §103(a) over Taylor in view of Glassman (Ex. 1009), (3) claims 48-49 of the ’582 Patent being obvious under §103(a) over Taylor in view of Delp (Ex. 1011), (4) claim 7 of the ’582 Patent being obvious under §103(a) over Taylor in view of DiGioia (Ex. 1010), and (5) claim 11 of the ’582 Patent being obvious under §103(a) over Taylor as a single reference. Institution Decision at 19.

“In an *inter partes* review instituted under this chapter, the petitioner shall have the burden of proving a proposition of unpatentability by a preponderance of the evidence.” 35 U.S.C. §316(e). Petitioner’s proposition of unpatentability fails to meet that burden with respect to any of the claims of the ’582 Patent instituted for review by the Board.

A. Statement Of Relief Requested

Pursuant to 35 U.S.C. §316, Patent Owner respectfully requests that the Board find that Claims 1, 3, 5, 6-9, 11, 13, 14, 16, 17, 21-30, 34-42, and 47-58 (the “Instituted ’582 Patent Claims”) are patentable in view of the instituted grounds of unpatentability under consideration by the Board.

B. Overview Of United States Patent No. 6,757,582

The USPTO issued the ’582 Patent, entitled “Methods And Systems To Control A Shaping Tool,” on June 29, 2004. The ’582 Patent generally relates to systems and methods for providing 3-D and 4-D imaging of a workpiece and a shaping tool, using tracking data to determine a relationship between the workpiece and shaping tool, and controlling the shaping tool based on such relationship. Practice of these claims can occur in a variety of applications in the medical field, for example, where surgical systems and robotic surgical systems may be used for high-precision bone repair and joint replacement operations.

The ’582 Patent discloses novel systems and methods for controlling a shaping or cutting tool used to shape a workpiece (such as a bone), including the use of manual or robotic cutting tools used in the medical field for orthopedic surgical procedures. Ex. 1001 at 1:13-50. Prior systems suffered from numerous drawbacks, including for example, the necessity to fix the target bone in place using screws or clamps in order to achieve precise cutting. Bone fixation

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