

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 7,837,736 B2

Before WILLIAM V. SAINDON, MICHAEL R. ZECHER, and
RICHARD E. RICE, *Administrative Patent Judges*.

RICE, *Administrative Patent Judge*.

DECISION

Denying Institution of *Inter Partes* Review
37 C.F.R. § 42.108

Denial of Motion for Joinder
37 C.F.R. § 42.122

I. INTRODUCTION

Zimmer Holdings, Inc. and Zimmer, Inc. (collectively, “Petitioner”) filed a Petition (Paper 1, “Pet.”) requesting an *inter partes* review of claims 23–25 of U.S. Patent No. 7,837,736 B2 (Ex. 1001, “the ’736 Patent”) and a Motion for Joinder (Paper 3) seeking to join this case with Case IPR2014-00191. Bonutti Skeletal Innovations LLC (“Patent Owner”) filed a Preliminary Response (Paper 16, “Prelim. Resp.”) and an Opposition to the Motion for Joinder (Paper 8). We have jurisdiction under 35 U.S.C. § 314, which provides that an *inter partes* review may not be instituted “unless . . . there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.” 35 U.S.C. § 314(a). Taking into account the arguments presented in Patent Owner’s Preliminary Response, we determine that the information presented in the Petition does not establish that there is a reasonable likelihood that Petitioner would prevail with respect to at least one of challenged claims 23–25 of the ’736 Patent. Accordingly, we do not authorize an *inter partes* review as to any of the claims of the ’736 Patent challenged in this case. As a result, we deny Petitioner’s Motion for Joinder as moot.

A. *Related Proceedings*

The ’736 Patent is the subject of a patent infringement lawsuit titled *Bonutti Skeletal Innovations, LLC v. Zimmer Holdings, Inc.*, No. 1:12-cv-01107-GMS (D. Del.). Pet. 2–3; Patent Owner’s Mandatory Notices, Paper 7, 2. Petitioner also has filed four related Petitions in the following

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cases: IPR2014-00191 (the '736 Patent), IPR2014-00311 (U.S. Patent No. 7,959,635 B1), IPR2014-00321 (U.S. Patent No. 7,806,896 B1), and IPR2014-01080 (U.S. Patent No. 7,806,896 B1). Pet. 3.

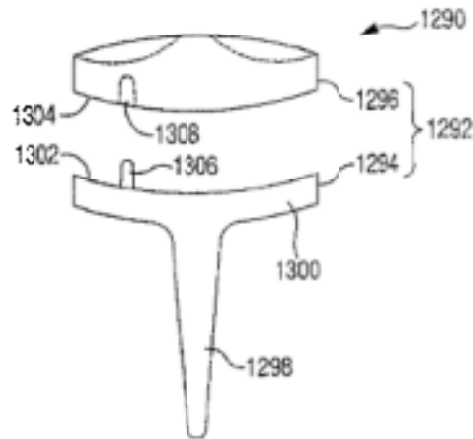
In Case IPR2014-00191, we authorized an *inter partes* review to be instituted as to claims 15–22, 26–28, and 31–36 of the '736 Patent, but not claims 23–25. *Zimmer Holdings, Inc. v. Bonutti Skeletal Innovations, LLC*, Paper 12, 2, Case IPR2014-00191 (PTAB June 2, 2014). Petitioner again challenges claims 23–25 in the present case.

B. The '736 Patent (Ex. 1001)

The '736 Patent, titled “MINIMALLY INVASIVE SURGICAL SYSTEMS AND METHODS,” relates to, *inter alia*, knee implants and knee implant surgery, including implants that can be used in other joints of the human body. *See. e.g.*, Ex. 1001, 9:51–53, 63–67; 97:33–98:5; 99:34–102:4; Figs. 80, 81, 88–90.

Figure 90 of the '736 Patent is reproduced below.

Fig. 90

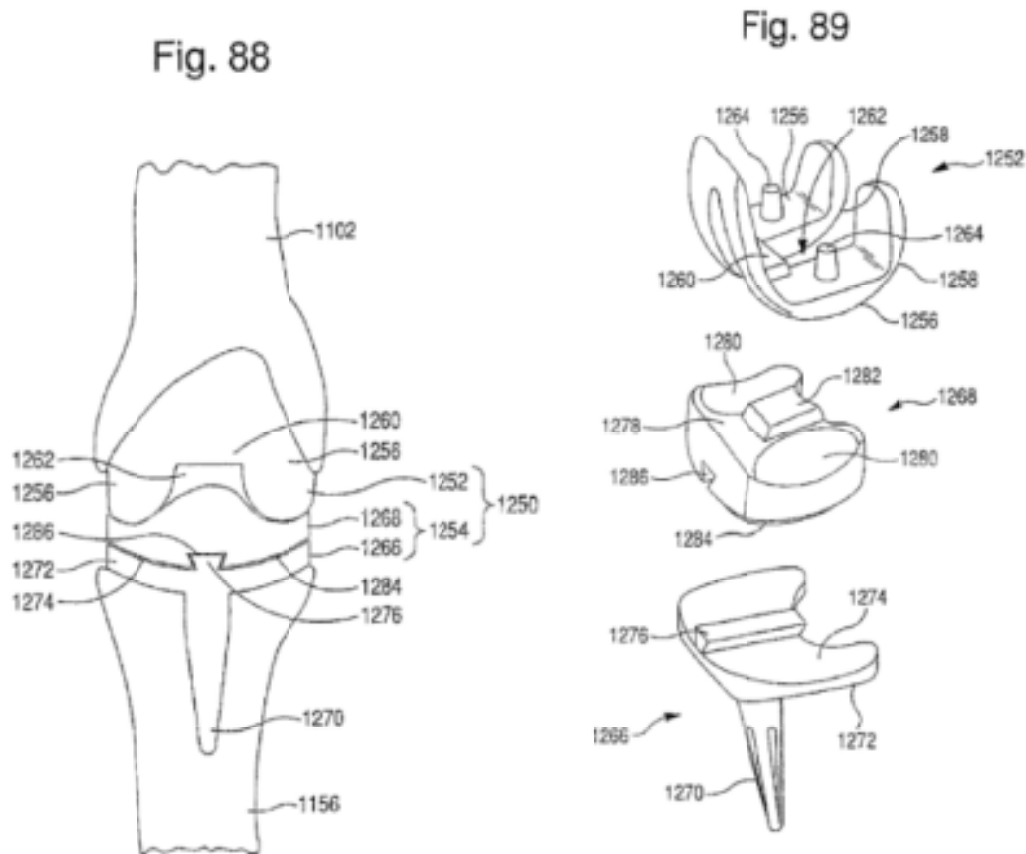


Ex. 1001, Fig. 90.

Figure 90 depicts rotating platform knee implant 1290, including tibial component 1292 with plate member 1300, tray 1294, tapered spike 1298, and rotatable bearing insert 1296. *Id.* at 101:14–16, 28–31. Plate member 1300 has a concave, spherically-shaped plateau surface (superior surface 1302). *Id.* at 101:18–20. Superior surface 1302 is provided with post 1306, which cooperates with recess 1308 located on bearing insert 1296 to permit rotation of bearing insert 1296 with respect to tray 1294. *Id.* at 101:28–31. Post 1306 is not located over the center of the tibia, but rather “offset medially toward the medial compartment of the knee.” *Id.* at 101:55–57, Fig. 90. According to the Specification of the ’736 Patent, “[i]n prior art rotating platform designs, the post is substantially in line with the central keel.” *Id.* at 101:58–59. “Offsetting post 1306 more toward the medial compartment of the knee recreates the natural pivoting motion of [f]

the knee, with less translation medially, a more stable joint medially, and more rotational arc or more movement laterally.” *Id.* at 101:63–67.

Figures 88 and 89 of the '736 Patent are reproduced below.



Ex. 1001, Figs. 88 & 89.

Figures 88 and 89 illustrate mobile bearing implant 1250 with femoral component 1252 and tibial component 1254, the latter comprising bearing tray 1266, insert 1268, tapered keel or spike 1270, and plate member 1272. Ex. 1001, 99:35–38, 49–51. Plate member 1272 includes superior surface 1274, which has a concave, spherically shaped plateau surface. *Id.* at 99:54–55. As described in the Specification, track 1276 in plate member 1272

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