

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

WRIGHT MEDICAL TECHNOLOGY, INC.,
Petitioner,

v.

ORTHOPHOENIX, LLC,
Patent Owner

Case IPR2014-00908
Patent 6,440,138 B1

Before BENJAMIN D. M. WOOD, MICHAEL J. FITZPATRICK, and
BARRY L. GROSSMAN, *Administrative Patent Judges*.

FITZPATRICK, *Administrative Patent Judge*.

DECISION
Denying Request for Rehearing
37 C.F.R. §§ 42.71(c), (d)

I. INTRODUCTION

Petitioner, Wright Medical Technology, Inc., filed a Request for Rehearing (Paper 10, “Reh’g Req.”) of our Decision Denying Institution of *Inter Partes* Review (Paper 9, “Decision” or “Dec.”).

“When rehearing a decision on petition, a panel will review the decision for an abuse of discretion.” 37 C.F.R. § 42.71(c). “The burden of showing a decision should be modified lies with the party challenging the decision[,]” which party “must specifically identify all matters the party believes the Board misapprehended or overlooked, and the place where each matter was previously addressed in a motion, an opposition, or a reply.” 37 C.F.R. § 42.71(d).

The Request for Rehearing is *denied*.

II. ANALYSIS

The Request for Rehearing mischaracterizes the Decision as based on an erroneous construction for “a cannula having an axis establishing a percutaneous path leading to inside bone” recited in independent claim 1 and for a similar limitation recited in independent claim 11. Reh’g Req. 3 (asserting that “the Board erroneously concludes that the claims ‘require that the cannula extend inside bone.’”).

In fact, our Decision was based on Petitioner’s failure to meet its burden, under 37 C.F.R. § 42.104(b)(2) and (3), to identify how the challenged claims are to be construed and how those claims, as construed, are unpatentable. Dec. 12

(citing 37 C.F.R. § 42.104(b)(2) and (3)).

Our Decision stated that Petitioner “does not persuade us that the Kuslich^[1] cylinder has an axis that establishes ‘a percutaneous path leading to inside bone,’ as required by claims 1 and 11.” Dec. 11. In particular, we stated:

The Petition does not . . . expressly articulate a construction for “a cannula having an axis establishing a percutaneous path leading to inside bone” of claim 1 (or the similar limitation of claim 11) that encompasses Kuslich’s device. Instead, the Petition merely notes that the “broadest reasonable construction in light of the specification” applies.

Id. (citing Pet. 10).

Our Decision noted that, in embodiments of the specification of the challenged U.S. Patent No. 6,440,138 B1 (“the ’138 patent”), a hole is drilled through cortical bone and the cannula is inserted partially into the bone. Dec. 11. We did not, however, construe the claims to require the cannula to be inserted into bone. Instead, we viewed Petitioner’s failure to articulate and support a construction that is met by the asserted prior art as irremediable particularly given the stark contrast between placement of the cannula in bone-oriented embodiments of the ’138 patent and placement of the cannula in the asserted embodiment of Kuslich.

¹ Petitioner’s sole ground of unpatentability was that claims 1–12 are unpatentable as obvious over U.S. Patent No. 5,015,255, issued May 14, 1991, to Kuslich (Ex. 1026). See Paper 6, “Pet.”

On rehearing, Petitioner also argues that, with respect to the system claims (i.e., independent claim 1 and dependent claims 2–10), the limitation “a cannula having an axis establishing a percutaneous path leading to inside bone” (recited in base claim 1) should not have been given patentable weight. Reh’g Req. 10–12. The Request for Rehearing, however, does not identify where this argument was made previously. *See* 37 C.F.R. § 42.71(d) (“The request [for rehearing] must specifically identify all matters the party believes the Board misapprehended or overlooked, and the place where each matter was previously addressed . . .”).

In fact, Petitioner did not present that argument in its Petition. Instead, it expressly stated that all claim terms, save “movement within and along the axis” and “within and about the axis of the cannula,” should be “given their broadest reasonable interpretation in light of the specification as commonly understood by those of ordinary skill in the art.” Pet. 11–12. Indeed, the Petition asserted that Kuslich teaches the specific limitation that Petitioner now argues is not really a limitation. Pet. 18.

Petitioner’s argument on rehearing that “a cannula having an axis establishing a percutaneous path leading to inside bone” should not be given patentable weight could not have been misapprehended or overlooked previously because it was not presented in the Petition.

III. CONCLUSION

Petitioner has not carried its burden of demonstrating that the Board's Decision should be modified. *See* 37 C.F.R. § 42.71(d).

IV. ORDER

Petitioner's Request for Rehearing is DENIED.

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