

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GLOBUS MEDICAL, INC.,
Petitioner,

v.

BONUTTI SKELETAL INNOVATIONS LLC,
Patent Owner.

IPR2015-01345
Patent 6,423,063 B1

Before MEREDITH C. PETRAVICK, ERICA A. FRANKLIN, and
BENJAMIN D. M. WOOD, *Administrative Patent Judges*.

PETRAVICK, *Administrative Patent Judge*.

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

I. INTRODUCTION

A. Background

Globus Medical, Inc. (“Petitioner”) filed a Corrected Petition requesting *inter partes* review of claims 1, 8, and 34 (“the challenged claims”) of U.S. Patent No. 6,423,063 B1 (Ex. 1001, “the ’063 patent”) pursuant to 35 U.S.C. §§ 311–319. Paper 6 (“Pet.”). Bonutti Skeletal Innovations LLC (“Patent Owner”) filed a Preliminary Response to the Petition. Paper 8 (“Prelim. Resp.”).

We have jurisdiction under 35 U.S.C. § 314(a), which provides that an *inter partes* review may not be instituted “unless . . . the information presented in the petition . . . shows that there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.”

We determine that Petitioner has not demonstrated that there is a reasonable likelihood that it would prevail with respect to any of the challenged claims. For the reasons described below, we do not institute an *inter partes* review of claims 1, 8, and 34.

B. Related Proceedings

The parties indicate that the ’063 patent is related to other U.S. patents, which are also the subjects of petitions for *inter partes* review, as indicated in the table below. Pet. 3–4; Paper 5, 1–2.

U.S. Patent No.	Proceeding
7,001,385	IPR2015-01339
6,099,531	IPR2015-01346
8,486,066	IPR2015-01335

U.S. Patent No.	Proceeding
8,795,363	IPR2015-01333

In addition, both parties state that '063 patent is at issue in *Bonutti Skeletal Innovations LLC v. Globus Medical Inc.*, Case No. 2:14-cv-6650-WB in the U.S. District Court for the Eastern District of Pennsylvania. Pet. 3; Paper 5, 1. Patent Owner further states¹ that the '063 patent is at issue in *Bonutti Skeletal Innovations LLC v. DePuy Synthes Sales Inc.*, Case No. 1:14-14680-GAO in the U.S. District Court for the District of Massachusetts and *Biomet, Inc. v. Bonutti Skeletal Innovations LLC*, Case 3:13-cv-00176 in the U.S. District Court for the Northern District of Indiana. Paper 5, 1. Patent Owner identifies multiple U.S. patent and U.S. patent applications that claim priority to the '063 patent. *Id.* at 1–3.

C. The '063 Patent

The '063 patent is titled “Changing Relationship Between Bones” and issued on July 23, 2002. Ex. 1001, [45], [54]. The '063 patent discloses a wedge member that is used to change the orientation of bones. *Id.* at Abstract. Figures 5 and 7 of the '063 patent depict one embodiment of the wedge member and are reproduced below.

¹ Patent Owner argues that we should deny institution of *inter partes* review because the Corrected Petition fails to identify other alleged related matters. Prelim. Resp. 22–25. Patent Owner’s argument is moot in view of our analysis below.

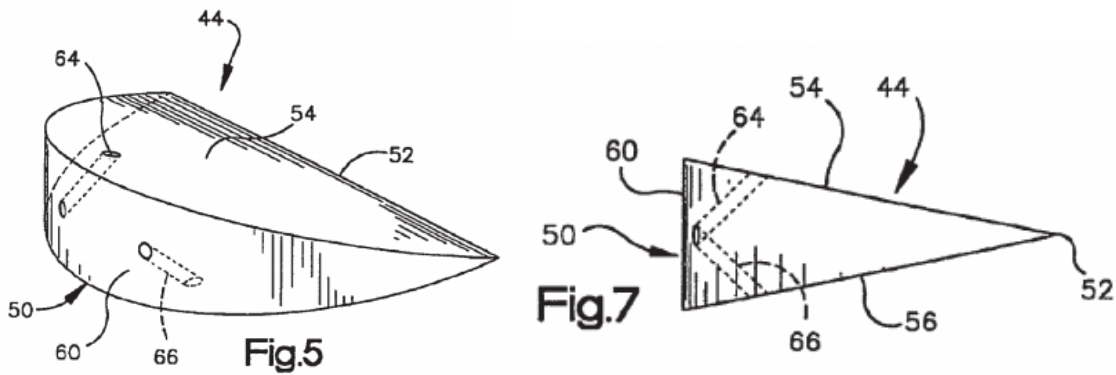


Figure 5 depicts a schematic view and Figure 7 depicts a side view of wedge member 44. *Id.* at col. 2, ll. 58–63. Wedge member 44 tapers from thick end portion 50 to thin end portion 52 and has upper major side surface 54, lower major side surface 56, and outer side surface 60. *Id.* at col. 5, l. 59–col. 6, l. 3. Wedge member 44 may be connected to one or more bones by screws passing through passages 64 and 66. *Id.* at col. 7, ll. 45–67.

Figure 3 of the '063 patent is reproduced below.

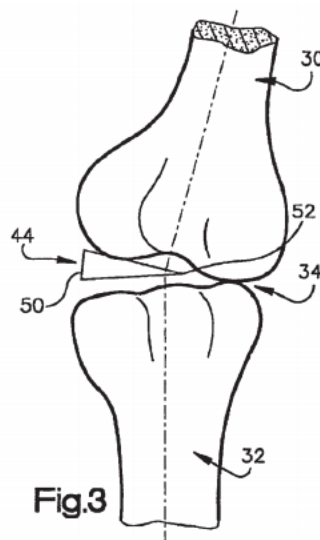


Figure 3 depicts wedge member 44 being inserted into a joint, causing joint expansion and changing the orientation of bones 30 and 32. *Id.* at col. 2, ll. 50–; *see id.* at col. 8, l. 3–col. 9, l. 31 (further describing the insertion). As thin leading end portion 52 of wedge member 44 moves into joint 34,

upper and lower major side surface 54 and 56 apply force against bones 30 and 32 and expand joint 34. *Id.* at col. 8, ll. 55–59.

Claim 1, reproduced below, is illustrative of the '063 patent.

1. A method comprising the steps of changing a spatial relationship between first and second bones which are []inter connected at a joint in a patient's body, said step of changing a spatial relationship between the first and second bones includes moving a wedge member which is at least partially formed of biodegradable material into the joint between the first and second bones, said step of moving the wedge member into the joint between the first and second bones includes moving the second bone from a first orientation relative to the first bone to a second orientation relative to the first bone [u]nder the influence of force applied against the second bone by the wedge member as the wedge member moves into the joint between the first and second bones, thereafter, transmitting force between the first and second bones through the wedge member while the second bone is in the second orientation relative to the first bone, and, thereafter, degrading biodegradable material of the wedge member.

D. Asserted Grounds of Unpatentability

Petitioner asserts the following grounds of unpatentability:

Ground	Claim(s)	Prior Art
§ 103	1 and 8	Wagner ²
§ 103	34	Wagner and Weiner ³
§ 103	34	Wagner and Brantigan ⁴

² U.S. Patent No. 5,306,309 (issued Apr. 26, 1994) (Ex. 1003).

³ Bradley K. Weiner & Robert D. Fraser, *Spine Update Lumbar Interbody Cages*, 23 SPINE 634 (1998) (Ex. 1004).

⁴ U.S. Patent No. 5,192,327 (issued Mar. 9, 1993) (Ex. 1005).

Petitioner proffers a Declaration of Dr. Jorge A. Ochoa to support its analysis in the Corrected Petition. Ex. 1006 (“Ochoa Decl.”).

II. ANALYSIS

A. Claim Construction

In an *inter partes* review, the Board interprets claim terms in an unexpired patent according to the broadest reasonable construction in light of the specification of the patent in which they appear. 37 C.F.R. § 42.100(b); *In re Cuozzo Speed Techs., LLC*, 793 F.3d 1268, 1278–79 (Fed. Cir. 2015). Under that standard, and absent any special definitions, we give claim terms their ordinary and customary meaning, as they would be understood by one of ordinary skill in the art at the time of the invention. *In re Translogic Tech., Inc.*, 504 F.3d 1249, 1257 (Fed. Cir. 2007). Any special definitions for claim terms must be set forth with reasonable clarity, deliberateness, and precision. *In re Paulsen*, 30 F.3d 1475, 1480 (Fed. Cir. 1994).

Based on our review of the record before us no explicit construction of any claim term is needed.

B. Grounds of Unpatentability

i. Obviousness over Wagner

Petitioner contends that claim 1 and claim 8, dependent therefrom, would have been obvious over Wagner. Pet. 11–23.

Independent claim 1 recites a method of changing a spatial relationship between first and second bones, which includes a step of moving a wedge member into a joint between the first and second bones.

Ex. 1001, col. 22, ll. 27–33. Claim 1 requires that the moving step includes “moving the second bone from a first orientation relative to the first bone . . . [u]nder the influence of force applied against the second bone by the wedge member as the wedge member moves into the joint between the first and second bones.” *Id.* at col. 22, ll. 34–39.

Petitioner argues that Wagner teaches this limitation. Pet. 14–19. According to Petitioner, Wagner’s discloses inserting a wedge-shaped implant into an intervertebral joint between first and second vertebrae by striking an implant delivery tool with a hammer and, thus, forcing the vertebrae to move from a first orientation relative to the other vertebrae. *Id.* at 15–16. Petitioner states that “[a]s the implant advances posteriorly in the intervertebral space, the wedge shaped body engages the faces of the vertebrae at which the device is implanted (end plates), forcing the intervertebral space open and moving the vertebrae apart.” Pet. 18 (citing Ochoa Decl. ¶ 36, testimony parroting Petitioner’s argument).

Patent Owner argues that Wagner does not teach this limitation, because according to Patent Owner, Wagner discloses that the vertebrae are spread apart during the surgical procedure, prior to implantation and that the wedge member has no mechanical interaction with the vertebrae until after the implantation procedure is complete. Prelim. Resp. 6–8 (citing Ex. 1003, col. 9, ll. 1–2, 32–34).

Wagner is titled “Spinal Disk Implant and Implantation Kit.” Ex. 1003, [54]. Wagner discloses inserting an implant 50 between two vertebrae using an implant delivery tool 100 and reusable handle 114. *Id.* at col. 8, l. 65–col. 9, l. 43. The delivery tool and handle are illustrated in Figures 12–14, reproduced below:

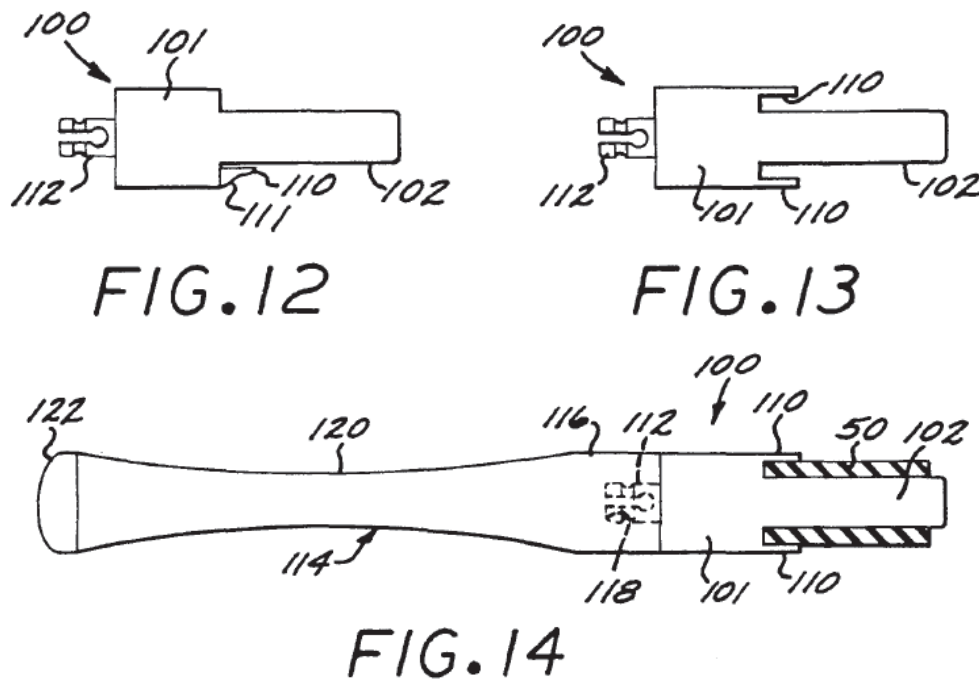


Figure 12 is an elevational view of one form of the implant delivery tool, and Figure 13 is another form of the delivery tool. *Id.* at col. 4, ll. 51–54. Figure 14 is a plan view of the implant delivery tool shown in Figure 13, with an attached reusable handle 114. *Id.* at col. 4, ll. 55–56. Wagner describes the delivery tool as having a pair of flexible opposed arms 102 spaced apart and dimensioned “to releasably grasp and hold the implant 50 therebetween.” *Id.* at col. 7, ll. 46–50. As can be seen in Figure 14, the arms 102 extend beyond forward edge of implant 50.

Wagner discloses a stabilizing lip 110 extending outwardly from an edge of the base 101 and engaging the proximate end of the implant 50 to prevent it from tilting or sliding in an end-to-end fashion. *Id.* at col. 8, ll. 12–16. Stabilizing lip 110 may also be provided with stop 111 that “engages the anterior edge of one of the vertebra when the implant has reached the proper position.” *Id.* at col.8, ll. 16–23. As can be seen in Figure 14, without the stop 111, the stabilizing lips 110 form the outer edge of the

delivery tool.

Wagner states that the “butt end 122 of the handle 114 is rounded so that a surgeon may strike it with a hammer if necessary to urge the implant 50 into place between two vertebrae that have been slightly spread apart from their normal spacing during the surgical procedure.” *Id.* col. 8, l. 65–col. 9, l. 2.

As can be seen from the above and contrary to Petitioner’s assertion and that of its declarant Dr. Ochoa, Wagner does not disclose moving the second bone from a first orientation relative to the first bone under the influence of force applied against the second bone by the wedge member as the wedge member moves into the joint between the first and second bones. Rather, the joint between the bones is expanded prior to striking the handle with a hammer to urge the implant into place. *Id.* at col. 9, ll. 1–2, 32–34. Indeed, as discussed, the implant is situated in a somewhat recessed position within the stabilizing lips 110 and between the opposed arms 102, such that striking the handle with a hammer would cause the forward portion of the arms 102 and/or the outward portion of the stabilizing lips 110 to encounter the spaced apart vertebrae, rather than the implant itself.

Consequently, based on the information presented, Petitioner has not established sufficiently that Wagner teaches or suggests every limitation of independent claim 1. On this record, we determine Petitioner fails to demonstrate a reasonable likelihood that it would prevail in showing that independent claim 1, or its dependent claim 8, would have been obvious over Wagner.

*ii. Obviousness over Wagner and Weiner and Obviousness over
Wagner and Brantigan*

Petitioner contends that claim 34 is obvious over Wagner and Weiner and obvious over Wagner and Brantigan. Pet. 23–41.

Similar to claim 1, independent claim 34 recites a method of changing a spatial relationship between first and second bones, which includes a step of moving a wedge member into a joint between first and second bones. Ex. 1001, col. 26, ll. 38–40, 47–49. Claim 34 requires that the moving step includes “engaging the abraded portion of the first bone with the wedge member and engaging the abraded portion of the second bone with the wedge member.” *Id.* at col. 26, ll. 50–55.

As with claim 1 above, Petitioner asserts here that Wagner teaches this limitation. Pet. 32–37. For the same reason as discussed above, we determine that Wagner does not disclose a step of moving a wedge member into a joint between first and second bones that includes engaging the abraded portion of the first bone with the wedge member and engaging the abraded portion of the second bone with the wedge member. On this record, Petitioner fails to demonstrate a reasonable likelihood that claim 34 is obvious over Wagner and Weiner or obvious over Wagner and Brantigan. Petitioner does not rely upon Weiner or Brantigan to cure the deficiency of Wagner. *See id.*; Prelim. Resp. 15, 18–19.

III. CONCLUSION

On this record, we determine that Petitioner fails to demonstrate a reasonable likelihood of prevailing on any of the asserted grounds.

IV. ORDER

In consideration of the foregoing, it is hereby:

ORDERED that institution of *inter partes* review is *denied* as to all challenged claims of the '063 patent.

IPR2015-01345
Patent 6,423,063 B1

PETITIONER:

George Moustakas
David Utykowski
HARNESS, DICKY & PIERCE, P.L.C.
gdmoustakas@hdp.com
dutykowski@hdp.com

PATENT OWNER:

Kevin K. McNish
Andrew G. Heinz
DESMARAIS LLP
BSIIPRService@desmaraisllp.com
kmcnish@desmaraisllp.com
aheinz@desmaraisllp.com