UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

PAINTEQ, LLC,
Petitioner,

v.

ORTHOCISION, INC.,
Patent Owner.

Patent No. 11,083,511
Title: METHOD AND IMPLANT SYSTEM FOR SACROILIAC JOINT FIXATION AND FUSION

Inter Partes Review No. IPR2023-00477

PETITIONER'S EXPLANATION OF PARALLEL PETITIONS

Petitioner is requesting *inter partes* review ("IPR") of claims 1-23 of U.S. Patent No. 11,083,511 ("'511 Patent") in two parallel IPR petitions—IPR2020-00451 ("First Petition") and IPR2020-00477 ("Second Petition"). Petitioner submits this paper explaining why two petitions are necessary in this case, explaining the differences between the petitions, and setting forth the ranking of the petitions for the Board's consideration.

The Consolidated Trial Practice Guide defines "parallel petitions" as "[t]wo or more petitions filed against the same patent at or about the same time (e.g., before the first preliminary response by the patent owner)." PTAB Consolidated Trial Practice Guide (November 2019), p. 59. Here, Petitioner filed two IPR petitions only eight days apart and before a Notice of Filing Date has been entered for the First Petition. Thus, the two IPR petitions in this case are parallel.

With respect to parallel petitions challenging the same patent, the Consolidated Trial Practice Guide states that "the Board recognizes that there may be circumstances in which more than one petition may be necessary, including, for example, … when there is a dispute about priority date requiring argument under multiple prior art references." *Id*. As explained below, these are the exact circumstances that necessitated the filing of the two petitions in the present case.

As an initial matter, comparison and ranking of the two petitions is provided in a table below:

	IPR2023-00451	IPR2023-00477
Challenged claims	1-23	1-23
Prior art	U.S. 8,162,981 ("Vestgaarden-981") U.S. 8,882,818 (Vestgaarden-818") U.S. 2015/0088200 ("Lins") U.S. 8,029,512 ("Paltzer")	U.S. 2014/0207240 ("Stoffman") U.S. 2010/0191241 ("McCormack") U.S. 2009/0216238 ("Stark")
Ranking	#1	#2

Disputed Priority Date

The '511 Patent claims priority to U.S. Patent No. 10,993,757 ("Parent"), which was filed on March 25, 2015 and further claims priority to U.S. Patent No. 9,119,732 ("Grandparent"), which was filed on March 25, 2013. The First Petition presents arguments as to why the '511 Patent is not entitled to claim the benefit of the filing date of the Grandparent. However, in the litigation involving the '511 Patent, the plaintiff (Patent Owner's exclusive licensee) asserts that "[t]he '511 Patent issued on August 8, 2021 from an application having an effective filing date of Mach 15, 2013." Ex-1018, p. 2. Thus, there is a dispute about the priority date, which is material to the First Petition.

The Priority Date Dispute is Critical for the First Petition

The First Petition sets forth a single obviousness ground against each challenged claim of the '511 Patent based on a combination of prior art references that includes U.S. Publication No. 2015/0088200 ("Lins"). Lins was filed on

December 1, 2014 and published on March 26, 2015 and therefore its status as prior art against the '511 Patent hinges on the priority date of the '511 Patent. If, as Petitioner contends, the challenged claims of the '511 Patent are not entitled to the benefit of the filing date of the Grandparent, then Lins qualifies as prior art under 35 U.S.C. § 102(a)(2). However, if Patent Owner were to prevail in its position that the effective filing date of the '511 Patent is the filing date of the Grandparent, then Lins would not qualify as prior art.

Furthermore, even if the Board determines that the '511 Patent is not entitled to claim the benefit of the Grandparent's filing date, the '511 Patent also claims the benefit of the Parent's filing date, which is March 25, 2015. Accordingly, Lins qualifies as prior art against the '511 Patent only under 35 U.S.C. § 102(a)(2), and therefore Patent Owner could potentially present evidence during IPR trial contesting Lins's status as prior art—for example, by establishing that the subject matter in Lins was obtained from one of the inventors of the '511 Patent. Because at this point, Petitioner cannot foresee whether Patent Owner will produce such evidence, the Second Petition is necessary.

Analogously to the First Petition, the Second Petition also sets forth only a single ground against each challenged claim. However, unlike the First Petition, the prior art references cited in the Second Petition predate the Grandparent and

therefore are not contingent on the success of Petitioner's challenge with respect to the '511 Patent's priority date.

Relative Strengths and Weaknesses of the Petitions

The relative weakness of the First Petition is due to Lins's status as prior art being contingent upon Petitioner prevailing in the priority date dispute. However, other than its status as prior art, Lins is an incredibly strong reference against the '511 Patent and provides the following three compelling reasons as to why the Petitioner ranks the First Petition as the "number one." ***First***, Lins directly (and almost verbatim) discloses—"a guidance slot … for controlling the depth of advancement of surgical tools into said surgical channel and maintaining said surgical tools in proper orientation"—which was a key alleged point of novelty in Patent Owner's patentability arguments during prosecution of the '511 Patent. *See* Ex-1008 at 397-398, 405. ***Second***, Lins's specification directly references U.S. Patent No. 8,162,981 ("Vestgaarden-981"), which is the primary prior art reference in the First Petition, thereby establishing compatibility of these two references and a reason for their combination. IPR2023-00451, Ex-1011 at [0005]. ***Third***, on November 8, 2022, the same USPTO examiner who examined and allowed the '511 Patent rejected a continuation of the '511 Patent (U.S. Patent Application Serial No. 16/689,073) based on a rationale that included a finding that Lins teaches a

"guidance slot" for "controlling and guiding a depth of penetration of the surgical tools relative to the working channel." IPR2023-00451, Ex-1013 at 888.

Despite the strengths of the First Petition, Petitioner is compelled to file the Second Petition, which does not rely on Lins, because of the '511 Patent's disputed priority date. As explained above, each petition sets forth only a single invalidity ground against each challenged claim, and therefore the two parallel petitions do not impose an undue burden on the Board or Patent Owner. Finally, the reason why Petitioner challenges every claim of the '511 Patent, rather than only those asserted in the litigation, is because the litigation is still in its infancy, and therefore the plaintiff can amend its infringement contentions to include additional claims.

For the reasons set forth above, Petitioner believes that it met its burden of establishing that the circumstances in this case warrant two parallel IPR petitions and institution of two parallel IPR trials.

Dated: January17, 2023

Respectfully submitted,
Hill Ward Henderson, P.A.

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CERTIFICATE OF SERVICE

I hereby certify that on this 17th day of January 2023, a copy of the attached **EXPLANATION OF PARALLEL PETITIONS** was served in its entirety on the following:

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