

**IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF DELAWARE**

ROGER P. JACKSON, M.D.,

Plaintiff,

v.

ZIMVIE INC.,

Defendant.

C.A. No. 22-891-RGA

STIPULATION REGARDING INVALIDITY CONTENTIONS

ZimVie Inc. (“ZimVie”) and Zimmer Biomet Spine, Inc. (“ZBS”) (collectively, “Petitioners”) hereby submit this stipulation regarding invalidity contentions.

In the Complaint filed June 30, 2022 (D.I. 1), Plaintiff Roger P. Jackson, M.D., (“Jackson” or “Plaintiff”) asserts that ZimVie infringes U.S. Patent No. 8,911,479 (“the ’479 Patent”), U.S. Patent No. 10,548,641 (“the ’641 Patent”), U.S. Patent No. 10,898,233 (“the ’233 Patent”), and U.S. Patent No. 11,129,646 (“the ’646 Patent”). ZimVie waived service of summons on September 29, 2022. (D.I. 6.) Before September 29, 2023, Petitioners will file petitions for *inter partes* review (“IPR”) challenging Claims 1-22 of the ’479 Patent, Claims 1-28 of the ’641 Patent, Claims 1-7 and 13-20 of the ’233 Patent, and Claims 1-20 of the ’646 Patent. The petitions assert the following grounds of invalidity:

Patent	Grounds
'479 Patent	Ground 1: Claims 1, 5, 10, 14, and 18-21 of the '479 Patent are anticipated or obvious in view of U.S. Patent No. 7,857,834 ("Boschert") Ground 2: Claims 2-4, 6, 7, 11-13, 15, and 16 of the '479 Patent are obvious in view of Boschert in combination with U.S. Patent Application Publication No. 2005/0267477 ("the '477 Publication") Ground 3: Claim 9 and 22 of the '479 Patent are obvious in view of Boschert in combination with U.S. Patent Application Publication No. 2006/0069391 ("the '391 Publication") Ground 4: Claims 8 and 17 of the '479 Patent are obvious in view of Boschert in combination with U.S. Patent Application Publication No. 2007/0088357 ("Johnson")
'641 Patent	Ground 1: Claims 1, 3-19, and 21-28 of the '641 Patent are obvious in view of the '477 Publication in combination with Boschert Ground 2: Claim 2 of the '641 Patent is obvious in view of the '477 Publication in combination with Boschert and the '391 Publication Ground 3: Claim 20 of the '641 Patent is obvious in view of the '477 Publication in combination with Boschert and Johnson
'233 Patent	Ground 1: Claims 1-7, 13, and 15-20 of the '233 Patent are obvious in view of the '477 Publication, U.S. Patent Application Publication No. 2010/0312287 ("the '287 Publication"), and Boschert Ground 2: Claim 14 of the '233 Patent is obvious in view of the '477 Publication in combination with the '287 Publication, Boschert, and Johnson
'646 Patent	Ground 1: Claims 1-2 and 4-9 of the '646 Patent are anticipated or obvious in view of the '477 Publication Ground 2: Claims 1-2 and 4-9 of the '646 Patent are obvious in view of the '477 Publication in combination with U.S. Patent No. 8,801,761 ("Kirschman") Ground 3: Claims 10 and 11 of the '646 Patent are obvious in view of the '477 Publication, alone or in combination with Kirschman, in combination with Johnson Ground 4: Claims 3, 12-18, and 20 of the '646 Patent are obvious in view of the '477 Publication in combination with Boschert Ground 5: Claims 3, 12-18, and 20 of the '646 Patent are obvious in view of

Patent	Grounds
	the '477 Publication in combination with Boschert and Kirschman Ground 6: Claim 19 of the '646 Patent is obvious in view of the '477 Publication in combination with Boschert, alone or further in combination with Kirschman, in combination with Johnson

For each of the above identified petitions, Petitioners hereby stipulate that if the Patent Trial and Appeal Board (“PTAB”) grants institution of Petitioners’ IPR petition, then Petitioners will not pursue before this Court the same grounds asserted in the instituted petition or any other ground that could have reasonably been raised before the PTAB in the instituted petition (*i.e.*, any ground that could be raised under §§ 102 or 103 solely on the basis of prior art patents or printed publications). This stipulation is not intended to, and should not be construed to, limit Petitioners’ ability to assert invalidity of the challenged claims of the '479 Patent, the '641 Patent, the '233 Patent, or the '646 Patent before this Court on any other ground, regardless of whether an IPR is instituted.

Dated: September 20, 2023

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***Attorney for ZimVie Inc. and Zimmer Biomet Spine,
Inc.***

CERTIFICATE OF SERVICE

I hereby certify that on the 20th day of September, 2023, I caused to be served the foregoing **STIPULATION REGARDING INVALIDITY CONTENTIONS**, via CM/ECF, on all counsel of record.

FAEGRE DRINKER BIDDLE & REATH LLP

s/ Thatcher A. Rahmeier

Thatcher A. Rahmeier