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Paper 6
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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MAKO SURGICAL CORP.,
Petitioner,

v.

BLUE BELT TECHNOLOGIES, INC.,
Patent Owner.

Case IPR2015-00629
Patent 6,757,582 B2

Before SALLY C. MEDLEY, KEVIN F. TURNER, and WILLIAM M. FINK, *Administrative Patent Judges.*

MEDLEY, *Administrative Patent Judge.*

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

I. INTRODUCTION

Petitioner, Mako Surgical Corporation, filed a Petition requesting an *inter partes* review of claims 1, 3, 5–14, 16–30, 34–42, and 47–58 of U.S. Patent No. 6,757,582 B2 (Ex. 1501, "the '582 patent"). Paper 1 ("Pet."). Patent Owner, Blue Belt Technologies, Inc. did not file a Preliminary

Response. We have jurisdiction under 35 U.S.C. § 314, 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."

For the reasons that follow, we institute an *inter partes* review of claims 1, 3, 5–9, 11, 13, 14, 16, 17, 21–30, 34–42, and 47–58 of the '582 patent.

A. Related Proceeding

The '582 patent is involved in the following lawsuit: *Mako Surgical Corp. v. Blue Belt Technologies, Inc.*, No. 0:14-cv-61263-MGC (S.D. Fla.). Pet. 1.

B. The '582 Patent

The '582 patent relates to a method and system for providing control to a cutting tool. Ex. 1001, Abstract. The specification of the '582 patent describes a workpiece (e.g., a bone) that includes a target shape. *Id.* at 1:22–37. Markers can be associated with or otherwise affixed to the cutting tool and workpiece. *Id*. at 9:5–6. The markers may be tracked using the system, resulting in tracking data that can be used to provide a control for the cutting tool. *Id*. at 9:54–61.

C. Illustrative Claim

Claims 1, 17, and 24 are independent claims. Claims 3, 5–14, and 16 directly or indirectly depend from claim 1; claims 18–23 directly or indirectly depend from independent claim 17; and claims 25–30, 34–42, and

47–58 directly or indirectly depend from claim 24. Claim 1 is reproduced below.

> 1. A system, comprising:
>
> a cutting tool;
>
> a workpiece that includes a target shape;
>
> a tracker to provide tracking data associated with the cutting tool and the workpiece, where the tracker includes at least one of: at least one first marker associated with the workpiece, and at least one second marker associated with the cutting tool; and
>
> a controller to control the cutting tool based on the tracking data associated with the cutting tool and the tracking data associated with the workpiece.

Ex. 1001, 20:37–47.

D. Asserted Grounds of Unpatentability

Petitioner asserts that claims 1, 3, 5–14, 16–30, 34–42, and 47–58 are unpatentable based on the following grounds:

References	**Basis**	**Challenged Claims**
Taylor[1]	§ 102(b)	1, 5, 6, 8–10, 12–14, 16, 17, 21–30, 34–42, 47, and 50–58
Taylor and Glassman[2]	§ 103(a)	3 and 18–20
Taylor and Delp[3]	§ 103(a)	48 and 49
Taylor	§ 103(a)	11
Taylor and DiGioia[4]	§ 103(a)	7
Burghart[5]	§ 102(a)/(b)	1, 3, 5–9, 12–14, 16, 17, 24, 37–39, 47, 53–55, and 58
Burghart and Taylor[6]	§ 103(a)	10, 11, 18–23, 25–30, 34–36, 40–42, 48–52, 56, and 57

[1] Taylor, et al., "An Image-Directed Robotic System for Precise Orthopaedic Surgery," IEEE TRANSACTIONS ON ROBOTICS AND AUTOMATION, Vol. 10, No. 3, June 1994 (Ex. 1008) ("Taylor").
[2] U.S. Patent No. 5,408,409, issued Apr. 18, 1995 (Ex. 1009) ("Glassman").
[3] Delp, et al., "An Interactive Graphics-Based Modeil of the Lower Extremity to Study Orthopaedic Surgical Procedures," IEEE TRANSACTIONS ON BIOMEDICAL ENGINEERING, Vol. 37, No. 8, August 1990 (Ex. 1011) ("Delp").
[4] U.S. Patent No. 6,205,411, issued Mar. 20, 2001 (Ex. 1010) ("DiGioia").
[5] Burghart, et al., "Robot Controlled Osteotomy in Craniofacial Surgery," 1st International Workshop on Haptic Devices in Medical Applications Proceedings, pp. 12–22, June 23, 1999 (Ex. 1012) ("Burghart").
[6] A table in the Petition at page 35 indicates that Delp is combined with Burghart, however, there does not appear to be such a combination in the text of the Petition.

References	Basis	Challenged Claims
DiGioia	§ 102(a)/(b)/(e)	1, 3, 5–10, 12–14, 16–20, 24, 34, 37–39, 47, 54, 55, and 58
DiGioia and Taylor[7]	§ 103(a)	8, 10–12, 18, 21–23, 25–30, 35, 36, 40–42, and 48–58

II. ANALYSIS

A. Claim Interpretation

In an *inter partes* review, claim terms in an unexpired patent are given their broadest reasonable construction in light of the specification of the patent in which they appear. 37 C.F.R. § 42.100(b); *see also In re Cuozzo Speed Techs., LLC*, No. 2014-1301, 2015 WL 4097949, *7-8 (Fed. Cir. July 8, 2015) ("Congress implicitly approved the broadest reasonable interpretation standard in enacting the AIA," and "the standard was properly adopted by PTO regulation."). Under the broadest reasonable construction standard, claim terms are given their ordinary and customary meaning, as would be understood by one of ordinary skill in the art in the context of the entire disclosure. *In re Translogic Tech., Inc.*, 504 F.3d 1249, 1257 (Fed. Cir. 2007).

Petitioner proposes constructions for the following claim terms: "means to register" (claims 10 and 18), "means to provide at least one image" (claim 11), "means to transform tracking data" (claim 12), "the tuning tool image" (claim 24), and "4-D image" (claim 24). Pet. 9–12.

[7] The Petition at page 47 indicates that Delp is combined with DiGioia, however, there does not appear to be such a combination in the text of the Petition.

Claims with Means Plus Function Limitations

Section 112, ¶ 6[8] permits an element in a claim for a combination to be expressed as a means for performing a specified function without the recital of structure in support thereof, but with the provision that "such claim shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof." "[T]he corresponding structure for a § 112 ¶ 6 claim for a computer-implemented function is the algorithm disclosed in the specification." *Aristocrat Techs. Austl. Party. Ltd. vs. Int'l Game Tech*., 521 F.3d 1328, 1333 (Fed. Cir. 2008) (quoting *Harris Corp. v. Ericsson Inc*., 417 F.3d 1241, 1249 (Fed. Cir. 2005)).

Petitioner argues, and we agree, that dependent claims 10, 11, 12, and 18 recite means-plus-function limitations under 35 U.S.C. § 112, ¶ 6. Pet. 9. Claim 11 depends from claim 1 and recites "means to provide at least one image associated with the workpiece, and means to provide at least one image associated with the cutting tool." The specification of the '582 patent describes that the means for providing an image associated with the workpiece and the means to provide an image associated with the cutting tool can include Computer Aided Design (CAD), CT, MRI, X-Ray, fluoroscopy and/or ultrasound. Ex. 1001, 4:16–21. Petitioner contends (Pet. 10), and we agree, based on the record before us, that the means to provide the image recited in claim 11 is a CAD, CT, MRI, X-Ray, fluoroscopy and/or ultrasound, and equivalent structures.

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[8] Section 4(c) of the Leahy-Smith America Invents Act, Pub. L. No. 112-29, 125 Stat. 284 (2011) ("AIA"), re-designated 35 U.S.C. § 112, ¶ 6 as 35 U.S.C. § 112(f). Because the '582 patent has a filing date before September 16, 2012 (effective date of AIA), we use the citation § 112, ¶ 6.

Petitioner argues that claims 10, 12, and 18 lack corresponding structure as required under 35 U.S.C. § 112, ¶ 6. Pet. 9, 10. Claim 12 depends from claim 1 and recites "means to transform the tracking data to at least one of: at least one workpiece image and at least one cutting tool image." The specification of the '582 patent describes that the system can update images with tracking data using means to transform the tracking data between different coordinate systems and that such transformations can be mathematically effectuated. We are persuaded by Petitioner's arguments that the specification of the '582 patent only describes the use of computers and processors to execute instructions, but describes no specific structure, such as an algorithm that performs the transformation of the tracking data to at least one of a workpiece image or cutting tool image. *Id.* at 10 (citing, e.g., Ex. 1001, 19:35–65).

We also agree with Petitioner that claims 10 and 18 lack corresponding structure in the specification as required under 35 U.S.C. § 112, ¶ 6. Claims 10 and 18 are similar and recite "means to register" ("image registration means") a workpiece to at least one image associated with the workpiece and an image associated with the cutting tool. The specification of the '582 patent describes that the means to register (registration means) "can include a probe that can be calibrated prior to registration." Ex. 1001, 4:12–13. Petitioner argues, and we agree, that a probe alone cannot perform the function of registering a workpiece to an image, for example. Pet. 9. Some type of algorithm would be required to complete the function of registration, which is missing from the description of the '582 patent.

For all of these reasons, we agree with Petitioner that dependent claims 10, 12, and 18 lack corresponding algorithms as required for computer-implemented functions. Thus, we are unable to interpret dependent claims 10, 12 and 18 (and claims 19 and 20, which depend from claim 18) due to the lack of disclosed structures. A lack of sufficient disclosure of structure under 35 U.S.C. § 112, sixth paragraph renders a claim indefinite, and thus not amenable to construction. *See In re Aoyama*, 656 F.3d 1293, 1298 (Fed Cir. 2011) (quoting *Enzo Biochem, Inc. v. Applera Corp*., 599 F.3d 1325, 1332 (Fed. Cir. 2010) ("If a claim is indefinite, the claim, by definition, cannot be construed.")).

Tuning Tool Image

Petitioner contends that the "tuning tool image" recited in claim 24 is an error and should be construed as the "cutting tool image." Pet. 11. In particular, Petitioner directs attention to the final amendment that included "cutting tool image" and not "tuning tool image." Ex. 1005, 109. The Office, nonetheless, printed the claim to include "tuning tool image." We construe claim 24 as containing an obvious error such that "tuning tool image" is construed as "cutting tool image." *See Novo Indus., L.P. v. Micro Molds Corp.*, 350 F.3d 1348, 1354 (Fed. Cir. 2003) (holding a claim can be construed to resolve obvious errors only if (1) the correct construction is not subject to reasonable debate based on consideration of the claim language and the specification and (2) the prosecution history does not suggest a different interpretation of the claims).

4-D Image

Petitioner argues that the recitation of "4-D image" is indefinite because a person of ordinary skill in the art would not be able to determine if

4-D was intended, or 3-D was intended. Pet. 11–12. In essence, Petitioner argues that the term "4-D" that was added per amendment lacks written description support in the originally filed application. *Id.* ("The specification refers only to '3-D images' and discusses only three dimensions, with no suggestion of what 'fourth dimension' is purportedly addressed in claim 24.")

We are not persuaded by Petitioner's arguments. Petitioner does not argue, for example, that the claim with the term "4-D image" is not discernible as to the meaning of the term. Indeed, Petitioner points out that Patent Owner, in the related district court case, asserted that the term "4-D" in the context of the claim means updating in real-time, and Petitioner does not suggest or explain that such an interpretation is incorrect. Pet. 12. Rather, Petitioner argues that the claim is indefinite, or lacks written description support. *Inter partes* reviews are not a vehicle for making such challenges to claims. 35 U.S.C. § 311(b).

B. Principles of Law

Anticipation requires the disclosure in a single prior art reference of each and every element of the claimed invention, arranged as in the claim. *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 1458 (Fed. Cir. 1984).

A patent claim is unpatentable under 35 U.S.C. § 103(a) if the differences between the claimed subject matter and the prior art are such that the subject matter, as a whole, would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. *KSR Int'l Co. v. Teleflex Inc*., 550 U.S. 398, 406 (2007). The question of obviousness is resolved on the basis of underlying

factual determinations including: (1) the scope and content of the prior art; (2) any differences between the claimed subject matter and the prior art; (3) the level of ordinary skill in the art; and (4) objective evidence of nonobviousness. *Graham v. John Deere Co.*, 383 U.S. 1, 17–18 (1966).

In that regard, an obviousness analysis "need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ." *KSR*, 550 U.S. at 418; *see Translogic*, 504 F.3d at 1259. A prima facie case of obviousness is established when the prior art itself would appear to have suggested the claimed subject matter to a person of ordinary skill in the art. *In re Rinehart*, 531 F.2d 1048, 1051 (CCPA 1976).

The level of ordinary skill in the art is reflected by the prior art of record. *See Okajima v. Bourdeau*, 261 F.3d 1350, 1355 (Fed. Cir. 2001); *In re GPAC Inc.*, 57 F.3d 1573, 1579 (Fed. Cir. 1995); *In re Oelrich*, 579 F.2d 86, 91 (CCPA 1978).

C. Claims 10, 12, and 18–20

As discussed above in the claim construction section, claims 10, 12, 18, as well as claims 19 and 20, by way of their dependency from claim 18, recite means-plus-function limitations that we are unable to construe because these claims lack corresponding disclosed structure. For this reason, we decline to institute as to claims 10, 12, and 18–20. *See Aoyama*, 656 F.3d at 1298.

D. Anticipation of Claims over Taylor

Petitioner contends that claims 1, 5, 6, 8, 9, 13, 14, 16, 17, 21–30, 34–42, 47, and 50–58 are anticipated by Taylor. Pet. 12–34. To support its

contentions, Petitioner provides detailed explanations as to how Taylor meets each claim limitation. *Id*. Petitioner also relies upon a Declaration of Robert D. Howe, who has been retained as an expert witness by Petitioner for the instant proceeding. Ex. 1004.

Taylor describes an image-directed robotic system to augment the performance of surgeons in precise bone machining procedures in orthopaedic surgery. Ex. 1008, 261. The system consists of an interactive CT-based presurgical planning component and a surgical system consisting of a robot, redundant motion monitoring, and man-machine interface components. *Id.*

Taylor describes a cutting tool, for example a ball probe cutter bit inserted into collet of a cutting tool affixed to the robot end effector. *Id.* at 263. The system further includes a workpiece that includes a target shape, for example a model of prosthesis shape relative to patient's anatomy. *Id.* at 267. Taylor also describes IO hardware to track position and orientation of a robot end effector and possible shifts of bone. *Id.* at 265.

To enable tracking of bone, titanium pins are implanted in a patient's femur and a CT scan is made of the patient's leg. *Id.* at 262. To enable tracking of the cutting tool, Taylor describes using a Northern Digital Optotrak™ 3D digitizer, which is capable of tracking light emitting diodes that may be affixed to the robot's wrist so that the cutting tool may be registered and tracked. *Id.* at 270. Taylor also describes a wrist-mounted force sensor that computes forces and torques at the cutter tip. *Id.* Taylor describes a robot controller that controls the cutting tool by using the pin location information to compute an appropriate transformation from CT coordinates to robot coordinates. *Id.* at 263. Taylor also describes that the

system monitors the position of the robot's cutting tool relative to the shape that it is to cut and stops cutting if the robot strays out of the desired area. *Id.* at 264. Taylor describes a redundant motion monitoring subsystem that checks to verify that the cutter tool never strays more than a specified amount outside a defined implant volume. It also monitors strain gauges that can detect possible shifts of bone. If either condition is detected, a freeze motion signal is sent to the robot controller. *Id.* at 265.

The present record supports the contention that Taylor describes a system that includes a cutting tool and a workpiece that includes a target shape. Pet. 21; Ex. 1008, 263, 267. The present record also supports the contention that Taylor describes markers associated with the workpiece (e.g., titanium pins implanted into patient's leg) and associated with the cutting tool (e.g., LEDs attached to robot's wrist and a tracker to provide tracking data associated with the cutting tool and the workpiece). Pet. 22; Ex. 1008, 262, 263, 270. Lastly, the record supports the contention that Taylor describes a controller to control the cutting tool based on the tracking data associated with the cutting tool and tracking data associated with the workpiece. Pet. 22–23; Ex. 1008, 264–65. We are persuaded, at this juncture of the proceeding, that Petitioner has established a reasonable likelihood that Petitioner would prevail in its challenge to independent claims 1, 17, and 24.

Petitioner also asserts that dependent claims 5, 6, 8, 9, 13, 14, 16, 21–23, 25–30, 34–42, 47, and 50–58 are anticipated by Taylor. Pet. 23–34. We have reviewed the Petition and the contentions made, and are persuaded, at this juncture of the proceeding, that Petitioner has established a reasonable

likelihood that Petitioner would prevail in its challenge to dependent claims 5, 6, 8, 9, 13, 14, 16, 21–23, 25–30, 34–42, 47, and 50–58.

For example, claim 13 depends directly from claim 1 and recites wherein the workpiece comprises at least one of: bone, cartilage, tendon, ligament, muscle, connective tissue, fat, neuron, hair, skin, a tumor, and an organ. The present record supports the contention that Taylor's description of the surgical procedure involving the femur of a patient as meeting this limitation. Pet. 25; Ex. 1008, 262.

As another example, several of the dependent claims, such as claims 21, 22, 26–30, 40–42, 52, and 56 recite classifying, distinguishing between, and color coding voxels used to represent the workpiece. The present record supports the contention that Taylor describes that the CT scan made of the workpiece (femur) is generated using voxels (Ex. 1008, 266) and that the system tracks the changes of the voxels throughout the surgery procedure. Pet. 15–16.

For all of the above reasons, we are persuaded, at this juncture of the proceeding, that Petitioner has established a reasonable likelihood that Petitioner would prevail in its challenge to claims 1, 5, 6, 8, 9, 13,14, 16, 17, 21–30, 34–42, 47, and 50–58 as anticipated by Taylor.

E. Obviousness of Claim 3 over Taylor and Glassman

Petitioner contends that claim 3 is unpatentable under 35 U.S.C. § 103(a) as obvious over Taylor and Glassman. Pet. 18–19, 23. To support its contention, Petitioner provides detailed explanations as to how the prior art meets each claim limitation of claim 3. *Id*. Petitioner also relies upon the Declaration of Robert D. Howe for support. Ex. 1004.

Glassman describes a robotic surgical system that includes a multiple degree of freedom manipulator arm having a surgical tool. Ex. 1009, Abstract. The surgical tool is described as a cylindrical high-speed (65,000 rpm) pneumatic surgical cutting tool. *Id.* at 3:32–36.

Claim 3 depends directly from claim 1 and specifies that the cutting tool includes at least one cutting element, and where the cutting element comprises at least one of: at least one blade, at least one rotatable blade, at least one retractable blade, at least one water jet, at least one particulate jet, at least one lithotripter, and at least one ultrasonic lithotripter.

Petitioner relies on Glassman for its description of a cylindrical high-speed (65,000 rpm) pneumatic surgical cutting tool, which Petitioner characterizes as a drill or rotatable blade. Pet. 18–19, 23; Ex. 1004 ¶ 37. Petitioner concludes that it would have been obvious to modify the ball cutter in Taylor with other known cutting elements, such as the one described in Glassman. *Id.*

We have reviewed the proposed ground of obviousness over Taylor and Glassman against claim 3, and we are persuaded, at this juncture of the proceeding, that Petitioner has established a reasonable likelihood that Petitioner would prevail in its challenge to claim 3 on this ground.

F. Obviousness of Claims over Taylor and Delp

Petitioner contends that claims 48 and 49 are unpatentable under 35 U.S.C. § 103(a) as obvious over Taylor and Delp. Pet. 20–21, 32. To support its contentions, Petitioner provides detailed explanations as to how the prior art meets each claim limitation. *Id*. Petitioner also relies upon the Declaration of Robert D. Howe for support. Ex. 1004.

Delp describes an interactive graphics-based model of a lower extremity to study orthopaedic surgical procedures. Ex. 1011, 757. Delp describes a user interface for developing and using the lower extremity model. Four software tools help the user to modify and analyze the musculoskeletal model. *Id.* at 761. A view controller allows the user to rotate, scale, and translate the model into any viewing perspective. *Id.*

Claim 48 depends from independent claim 24 and recites a control that includes increasing the size of the cutting tool image to determine whether the increased size cutting tool image intersects with the target shape in the workpiece image. Claim 49 depends from claim 48 and recites that increasing the size includes at least one of increasing the size by a fixed amount, and increasing the size based on tracking data associated with the cutting tool.

Petitioner relies on Delp for its description of allowing the user to rotate, scale, and translate the model into any viewing perspective and concludes that it would have been obvious to combine Delp with Taylor to produce the predictable result of a cutting tool image that can be scaled or rotated for better visualization of the procedure. Pet. 20–21; Ex. 1004 ¶ 50.

We have reviewed the proposed ground of obviousness over Taylor and Delp against claims 48 and 49, and we are persuaded, at this juncture of the proceeding, that Petitioner has established a reasonable likelihood that Petitioner would prevail in its challenge to claims 48 and 49 on this ground.

G. Obviousness of Claim 7 over Taylor and DiGioia

Petitioner contends that claim 7 is unpatentable under 35 U.S.C. § 103(a) as obvious over Taylor and DiGioia. Pet. 19–20. To support its contention, Petitioner provides detailed explanations as to how the prior art

meets each claim limitation of claim 7. *Id*. Petitioner also relies upon the Declaration of Robert D. Howe for support. Ex. 1004.

DiGioia describes an apparatus for facilitating the implantation of an artificial component in, for example, a hip joint. The apparatus includes a pre-operative geometric planner and a pre-operative geometric kinematic biomechanical simulator in communication with the pre-operative geometric planner. Ex. 1010, 4:59–65. During intra-operative stages, a computer system is used to display relative locations of the objects being tracked with a tracking device. The tracking device uses markers that may be attached to bones, tools or other objects to provide precision tracking of the objects. The markers are described as including any of emitter/detector systems including optic, acoustic, video-based, mechanical, electromagnetic and radio frequency (RF) systems, and one embodiment describes using a camera to track light emitting from light emitting diodes. *Id.* at 6:24–43.

Claim 7 depends indirectly from claim 1 and specifies the claimed markers include at least one of an infrared source, RF source, ultrasound source, and transmitter.

Petitioner relies on DiGioia for its description of infrared markers. Pet. 19–20, 23; Ex. 1004 ¶ 47. Petitioner concludes that it would have been obvious to substitute the titanium pin markers in Taylor for other known markers, such as the ones described in DiGioia. *Id.*

We have reviewed the proposed ground of obviousness over Taylor and DiGioia against claim 7, and we are persuaded, at this juncture of the proceeding, that Petitioner has established a reasonable likelihood that Petitioner would prevail in its challenge to claim 7 on this ground.

H. Obviousness of Claim 11 over Taylor

Petitioner contends that claim 11 is unpatentable under 35 U.S.C. § 103(a) as obvious over Taylor. Pet. 20, 24–25. To support its contention, Petitioner provides detailed explanations as to how the prior art meets each claim limitation of claim 11. *Id.* Petitioner also relies upon the Declaration of Robert D. Howe for support. Ex. 1004.

Claim 11 depends directly from claim 1 and recites means to provide at least one image associated with the workpiece, and means to provide at least one image associated with the cutting tool. As discussed above in the claim construction section, the corresponding structure for the means in both instances is a CAD, CT, MRI, X-Ray, fluoroscopy and/or ultrasound, and equivalent structures.

Petitioner argues that while Taylor describes providing an image of the workpiece using CT, Taylor does not expressly describe any of the structures to provide an image of the cutting tool. Pet. 20. Petitioner concludes that it would have been obvious to a person having ordinary skill in the art to modify Taylor and use a CAD model for the cutting tool in order to accurately track cutting progress that is described in Taylor. Pet. 20; Ex. 1004 ¶ 48.

We have reviewed the proposed ground of obviousness over Taylor against claim 11, and we are persuaded, at this juncture of the proceeding, that Petitioner has established a reasonable likelihood that Petitioner would prevail in its challenge to claim 11 on this ground.

I. Remaining Grounds Challenging the Claims of the '582 Patent

Pursuant to 35 U.S.C. § 316(b), rules for *inter partes* proceedings were promulgated to take into account the "regulation on the economy, the integrity of the patent system, the efficient administration of the Office, and the ability of the Office to timely complete proceedings." The promulgated rules provide that they are to "be construed to secure the just, speedy, and inexpensive resolution of every proceeding." 37 C.F.R. § 42.1(b). As a result, and in determining whether to institute an *inter partes* review of a patent, the Board, in its discretion, may "deny some or all grounds for unpatentability for some or all of the challenged claims." 37 C.F.R. § 42.108(b).

We exercise our discretion and decline to institute review based on any of the other asserted grounds advanced by Petitioner that are not identified below as being part of the trial. 37 C.F.R. § 42.108(a).

III. CONCLUSION

For the foregoing reasons, we determine that the information presented establishes a reasonable likelihood that Petitioner would prevail in showing that claims 1, 3, 5–9, 11, 13, 14, 16, 17, 21–30, 34–42, and 47–58 of the '582 patent are unpatentable. At this stage of the proceeding, the Board has not made a final determination with respect to the patentability of the challenged claims.

IV. ORDER

For the foregoing reasons, it is

ORDERED that pursuant to 35 U.S.C. § 314(a), an *inter partes* review is hereby instituted for the following grounds of unpatentability:

Claims	**Basis**	**References**
1, 5, 6, 8, 9, 13, 14, 16, 17, 21–30, 34–42, 47, and 50–58	§ 102(b)	Taylor
3	§ 103(a)	Taylor and Glassman
48 and 49	§ 103(a)	Taylor and Delp
7	§ 103(a)	Taylor and DiGioia
11	§ 103(a)	Taylor

FURTHER ORDERED that no other ground of unpatentability asserted in the Petition is authorized for this *inter partes* review; and

FURTHER ORDERED that pursuant to 35 U.S.C. § 314(c) and 37 C.F.R. § 42.4, notice is hereby given of the institution of a trial; the trial will commence on the entry date of this decision.

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