

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

LANTZ MEDICAL, INC.,
Petitioner,

v.

BONUTTI RESEARCH, INC.,
Patent Owner.

Case IPR2015-00991
Patent 7,112,179 B2

Before HYUN J. JUNG, SCOTT A. DANIELS, and JAMES A. TARTAL,
Administrative Patent Judges.

DANIELS, *Administrative Patent Judge.*

DECISION

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

Petitioner, Lantz Medical, Inc., filed a Revised Petition requesting an *inter partes* review of claim 26 of U.S. Patent No. 7,112,179 B2 (Ex. 1001, “the ’179 patent”). Paper 4 (“Petition” or “Pet.”). Patent Owner, Bonutti Research, Inc., filed a Preliminary Response. Paper 10 (“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.”

Upon consideration of the Petition and the Preliminary Response, we conclude the information presented does not show a reasonable likelihood that Petitioner would prevail in showing the unpatentability of the challenged claim. Accordingly, we do not authorize an *inter partes* review to be instituted as to any claim of the ’179 patent.

I. BACKGROUND

A. *The ’179 Patent (Ex. 1001)*

The ’179 patent, titled “Orthosis,” issued September 26, 2006, from U.S. Application No. 10/795,892, filed March 8, 2004. Ex. 1001. The ’179 patent relates to an adjustable orthosis device used in physical rehabilitative therapy for stretching tissue around a joint in the human body, particularly in the case of an injured joint, to reduce scar tissue formation from the injury and provide for an increased range of motion of the joint. *Id.* at 1:5–9, 1:24–33. Figure 9 of the ’179 patent, below, illustrates an adjustable orthosis device useful in rehabilitation of, for example a wrist joint.

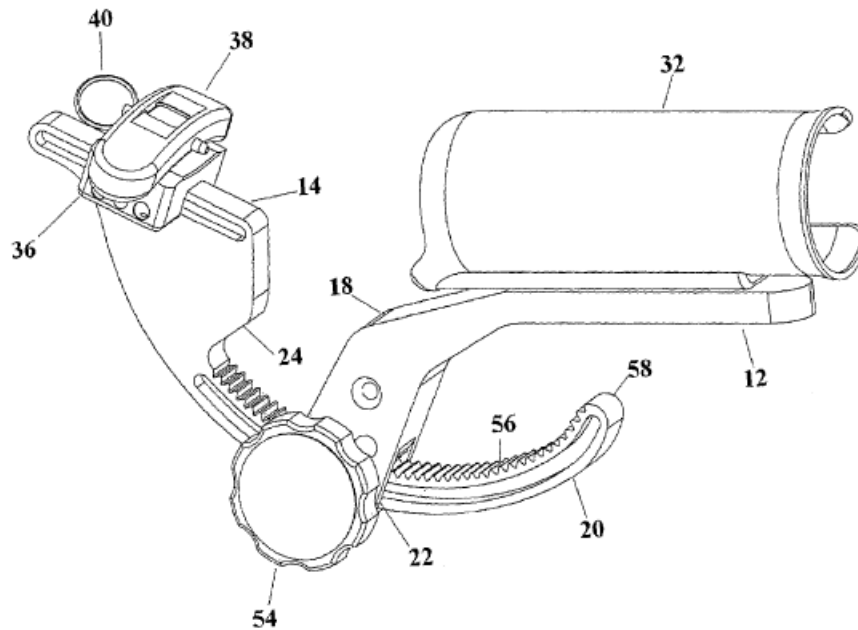


FIG. 9

Figure 9 of the '179 patent depicts an adjustable orthosis device having cuff 32 supported on first arm member 12 for receiving a patient's forearm, and hand pad 38 supported on second arm member 14 for securing the patient's hand. *Id.* at 9:2–11. In use, relative rotation of the first and second arm members “rotat[es] the hand about the wrist joint axis [] stretching the wrist joint.” *Id.* at 9:10–11.

B. Illustrative Claim

Claim 26 of the '179 patent is independent.

26. An orthosis for stretching tissue around a joint of a patient between first and second relatively pivotable body portions, comprising:

 a first arm member affixable to the first body portion and including a first extension member extending therefrom;

a second arm member affixable to the second body portion and including a second extension member having an arcuate shape extending therefrom, the second extension member is operatively connected to the first extension member and travels along an arcuate path through the first extension member when the second arm member is moved from a first position to a second position relative to the first arm member; and

a hand pad attached to the second arm member, wherein the hand pad is slidably mounted to the second arm member.

Id. at 13:32–48.

C. Related Proceedings

The parties indicate that the '179 patent is a subject of the following civil action: *Bonutti Research, Inc. v. Lantz Medical, Inc.*, No. 1:14-cv-00609 (S.D. Ind.). Pet. 5; Paper 8, 2.

D. Asserted Grounds of Unpatentability

Petitioner contends that independent claim 26 of the '179 patent is unpatentable as “anticipated pursuant to 35 U.S.C. § 102(a) and (b), in view of U.S. Patent No. 5,759,165 (Exhibit 100[8]), issued on June 2, 1998; and U.S. Patent No. 2,832,334 (Exhibit 100[9]), issued on April 29, 1958.” Pet. 6–7.¹

II. ANALYSIS

A. Claim Construction

The Board interprets claims of an unexpired patent using the broadest reasonable construction in light of the specification of the patent in which they appear. 37 C.F.R. § 42.100(b); *see In re Cuozzo Speed Techs., LLC*, 793 F.3d 1268, 1278 (Fed. Cir. 2015) (“We conclude that Congress implicitly approved the broadest reasonable interpretation standard in enacting the AIA.”).

Petitioner proposes an express construction for “orthosis.” Pet. 10. Patent Owner disputes Petitioner’s proposed construction as overly broad and unsupported by the specification. Prelim. Resp. 3–4. The term “orthosis” appears only in the preamble to claim 26. “If . . . the body of the claim fully and intrinsically sets forth the complete invention, including all of its limitations, and the preamble offers no distinct definition of any of the claimed invention’s limitations, . . . then the preamble is of no significance to claim construction because it cannot be said to constitute or explain a claim limitation.” *Pitney Bowes, Inc. v. Hewlett-Packard Co.*, 182 F.3d

¹ U.S. Patent No. 5,759,165 and U.S. Patent No. 2,832,334 are referred to in this Decision as “the ’165 patent” and “the ’334 patent,” respectively.

1298, 1305 (Fed. Cir. 1999). The body of claim 26 fully and intrinsically sets forth the complete invention; therefore, the use of “orthosis” in the preamble does not serve as a limitation and need not be construed.

Petitioner notes certain claim constructions proffered by Patent Owner in the underlying lawsuit. Pet. 10–11. Patent Owner agrees. Prelim. Resp. 5. Patent Owner additionally provides a construction for the term “hand pad” as recited in claim 26 meaning “a thin, cushionlike mass of soft material attachable to the hand of a user.” *Id.* at 4–5. We determine that no express construction of any claim term is necessary.

B. Anticipation by the '165 patent

Petitioner contends claim 26 of the '179 patent is anticipated by the '165 patent (Ex. 1008). Pet. 13. Petitioner provides virtually no discussion of the '165 patent. Instead, Petitioner provides a series of brief statements pertaining to each element of the claim. *Id.* at 14–16. For example, the Petition states:

Claim 26 of the '179 patent recites “a first arm member affixable to the first body portion.” Using Patentee’s analysis of this Claim (Exhibit 1007), the '165 patent (Exhibit 1008) discloses this element of Claim 26 of the '179 Patent at Col. 3, Lines 20-21 and in Fig. 3(20) **OR** at Col. 3, lines 26-27; Fig. 3(46)(48), Fig. 4(44), Fig. 5(44), and Fig. 6(44). (Exhibit 1010, ¶ 21)

Pet. 14.

Petitioner also provides a claim chart which, for the same claim limitation, simply states “U.S. Patent 5,759,165 (Col. 3, Lines 20-21; Fig. 3(20) OR Col. 3, lines 26-27, Fig. 3(46)(48), Fig. 4(44), Fig. 5(44), Fig. 6(44)).” *Id.* at 12.

Petitioner's unexplained allegations and conclusory statements fall far short of demonstrating a reasonable likelihood that Petitioner would prevail in showing the unpatentability of the challenged claim. A petition for *inter partes* review must identify how the construed claim is unpatentable under the statutory grounds on which the petitioner challenges the claims.

37 C.F.R. § 42.104(b)(4). Furthermore, 37 C.F.R. § 42.22(a)(2) states that each petition must include “[a] full statement of the reasons for the relief requested, including a detailed explanation of the significance of the evidence including material facts, and the governing law, rules, and precedent.”

We will not speculate as to what is meant in the Petition by “[u]sing Patentee’s analysis of this Claim,” but note that Petitioner’s apparent reliance only on a citation to Exhibit 1007 is improper as “[a]rguments must not be incorporated by reference from one document into another document.” 37 C.F.R. § 42.6(a)(3). Further, the Declaration of Renee D. Rogge, Ph.D., cited in the Petition (Ex. 1010 ¶ 21) with respect to the limitation discussed above, simply repeats the text that appears in the Petition with no additional explanation. Providing broad notice of Petitioner’s allegations with virtually no supporting evidence or explanation is not sufficient to institute trial in an *inter partes* review proceeding as it leaves both the Board and Patent Owner in the untenable position of either evaluating or responding to incompletely formed arguments and arguably ambiguous assertions. The patent rules promulgated for AIA post-grant proceedings, including those pertaining to institution, are “construed to secure the just, speedy, and inexpensive resolution of every proceeding.”

37 C.F.R. § 42.1(b); *see also* 35 U.S.C. § 316(b) (regulations for AIA *inter partes* proceedings take into account “the efficient administration of the Office” and “the ability of the Office to timely complete [instituted] proceedings”). The timeframe of an *inter partes* review does not afford Petitioner the luxury of supporting and explaining what it broadly alleges in its Petition later in the proceeding.

In the absence of any sufficient explanation of the significance of the evidence asserted by Petitioner, Petitioner has not demonstrated a reasonable likelihood that it would prevail in showing that claim 26 is anticipated by the ’165 patent.

C. Anticipation by the ’334 patent

Petitioner contends claim 26 of the ’179 patent is anticipated by the ’334 patent (Ex. 1009). Pet. 16. Petitioner provides no substantive discussion of the ’334 patent apart from stating that “U.S. Patent No. 2,832,334 (Exhibit 1009) discloses a ‘[t]herapeutic device for use in manipulative treatment of joints of the human body.’” *Id.* (citing Ex. 1009, Title). Instead, Petitioner provides a series of conclusory statements pertaining to each element of the claim. *Id.* at 16–18. For example, the Petition states:

Claim 26 of the ’179 patent further recites “a first arm member affixable to the first body portion.” Using Patentee’s analysis of this Claim (Exhibit 1007), the ’334 patent (Exhibit 1009) discloses this element of Claim 26 of the ’179 patent at Col.2, Lines 14-15 and Fig. 1(11) **OR** Col. 2, lines 1-3 and Fig. 1(10), Fig. 2(10), Fig. 3(10) and Fig. 4(10). (Exhibit 1010, ¶ 30)

Pet. 17.

Petitioner also provides a claim chart which, for the same claim limitation, simply states “U.S. Patent 2,832,334 (Col. 2, Lines 14-15; Fig. 1(11) **OR** Col. 2, lines 1-3 and Fig. 1(10), Fig. 2(10), Fig. 3(10), Fig. 4(10)).” *Id.* at 12.

Petitioner’s unexplained allegations fall far short of demonstrating a reasonable likelihood that Petitioner would prevail in showing the unpatentability of the challenged claim. A petition for *inter partes* review must identify how the construed claim is unpatentable under the statutory grounds on which the petitioner challenges the claims. 37 C.F.R. § 42.104(b)(4). Furthermore, 37 C.F.R. § 42.22(a)(2) states that each petition must include “[a] full statement of the reasons for the relief requested, including a detailed explanation of the significance of the evidence including material facts, and the governing law, rules, and precedent.”

As above, we will not speculate as to what is meant in the Petition by “[u]sing Patentee’s analysis of this Claim,” but note that Petitioner’s apparent reliance only on a citation to Exhibit 1007 is improper as “[a]rguments must not be incorporated by reference from one document into another document.” 37 C.F.R. § 42.6(a)(3). Further, the Declaration of Renee D. Rogge, Ph.D., cited in the Petition (Ex. 1010 ¶ 30) with respect to the limitation discussed above, simply repeats the text that appears in the Petition with no additional explanation. Providing broad notice of Petitioner’s allegations with virtually no supporting evidence or explanation is generally not sufficient to institute trial in an *inter partes* review proceeding as it leaves both the Board and Patent Owner in the untenable

position of either evaluating or responding to incompletely formed arguments and arguably ambiguous assertions. The patent rules promulgated for AIA post-grant proceedings, including those pertaining to institution, are “construed to secure the just, speedy, and inexpensive resolution of every proceeding.” 37 C.F.R. § 42.1(b); *see also* 35 U.S.C. § 316(b) (regulations for AIA *inter partes* proceedings take into account “the efficient administration of the Office” and “the ability of the Office to timely complete [instituted] proceedings”). The timeframe of an *inter partes* review does not afford Petitioner the luxury of supporting and explaining what it broadly alleges in its Petition later in the proceeding.

In the absence of any sufficient explanation of the significance of the evidence asserted by Petitioner, Petitioner has not demonstrated a reasonable likelihood that it would prevail in showing that claim 26 is anticipated by the ’334 patent.

III. CONCLUSION

For the foregoing reasons, the information presented in the Petition and accompanying evidence does not establish a reasonable likelihood that Petitioner would prevail in showing the unpatentability of claim 26 of the ’179 patent.

IV. ORDER

In consideration of the foregoing, it is hereby:

ORDERED that the Petition is *denied* and no trial is instituted.

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