

UNITED STATES PATENT AND TRADEMARK OFFICE

---

BEFORE THE PATENT TRIAL AND APPEAL BOARD

---

LANTZ MEDICAL, INC.,  
Petitioner,

v.

BONUTTI RESEARCH, INC.,  
Patent Owner.

---

Case IPR2015-00992  
Patent 7,955,286 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 claims 26–31 and 33 of U.S. Patent No. 7,955,286 B2 (Ex. 1001, “the ’286 patent”). Paper 4 (“Petition” or “Pet.”). Patent Owner, Bonutti Research, Inc., filed a Preliminary Response. Paper 9 (“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 claims. Accordingly, we do not authorize an *inter partes* review to be instituted as to any claim of the ’286 patent.

## I. BACKGROUND

### A. *The ’286 Patent (Ex. 1001)*

The ’286 patent, titled “Elbow Orthosis,” issued June 7, 2011, from U.S. Application No. 11/687,679, filed March 19, 2007. Ex. 1001. The ’286 patent relates to an adjustable range-of-motion (ROM) 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 1:13–17, 31–40. Figure 14 of the ’286 patent, below, illustrates an adjustable orthosis device.

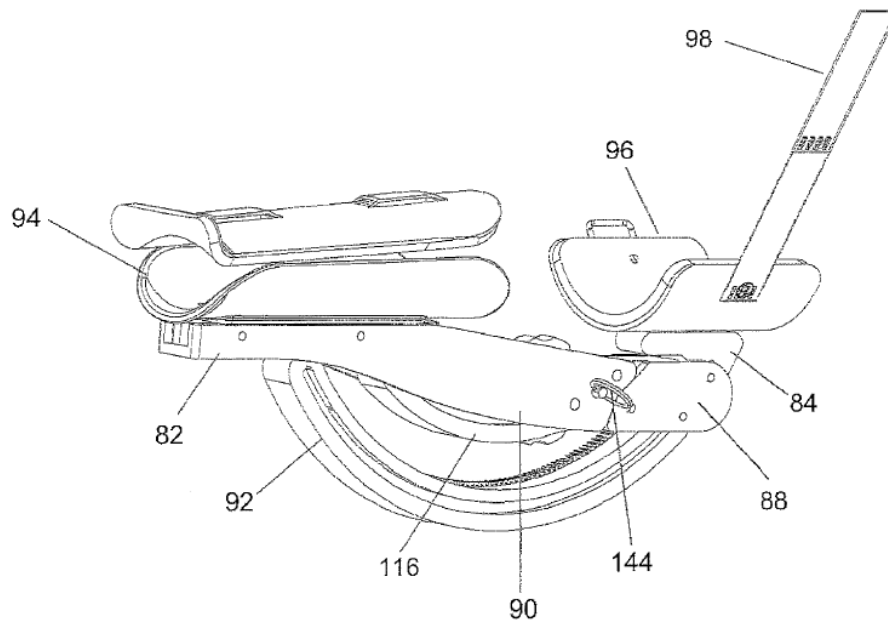


FIG. 14

Figure 14 of the '286 patent depicts an adjustable orthosis device for flexing and extending a patient's joint, such as an elbow joint, the device having first cuff 94 slidably supported on first arm member 82 for receiving a patient's forearm, and second cuff 96 supported on second arm member 84 for securing the patient's upper arm around the bicep. *Id.* at 2:62–65, 9:34–65, 10:6–7, 12:65–67. Also, third arm member 88 is affixed to first arm member 82 in such a manner that the first and third arm members move essentially in conjunction with the forearm and one another, and relative to the second arm member 84, thus “rotating the forearm about the elbow joint axis 86 stretching the joint.” *Id.* at 13:3–6.

*B. Illustrative Claim*

Claim 26 of the '286 patent is independent.

26. An orthosis for stretching tissue around a joint of a patient connecting a first body portion and a second body portion, the orthosis comprising:

a first arm member for coupling to the first body portion and defining a curved path;

a second arm member for coupling to the second body portion and operatively coupled to the first arm member, the second arm member movable along the curved path, to rotate the second body portion about an axis of rotation of the joint; and

an extension member movably coupled to the first arm member, wherein the extension member is configured to at least one of increase and decrease a range of motion of the orthosis.

Ex. 1001, 16:48–61.

*C. Related Proceedings*

The parties indicate that the '286 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. 6; Paper 8, 2.

*D. Asserted Grounds of Unpatentability*

Petitioner contends that claims 26–31 and 33 of the '286 patent are unpatentable as “anticipated pursuant to 35 USC § 102(a) and (b) by U.S. Patent No. 2,832,334, issued: April 29, 1958 (Exhibit 1008); U.S. Patent No. 5,399,154, issued on March 21, 1995 (Exhibit 1009); and the TenoStretch device (Exhibit 1010) which was sold by Robert Kaiser to three companies at least as early as November 21, 2003 (Exhibit 1010).” Pet. 8.<sup>1</sup>

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. 12. Patent Owner disputes Petitioner’s proposed construction as overly broad and unsupported by the specification. Prelim. Resp. 3–4. The term “orthosis” appears 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

---

<sup>1</sup> U.S. Patent No. 2,832,334 and U.S. Patent No. 5,399,154 are referred to in this Decision as “the '334 patent” and “the '154 patent,” respectively.

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 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. 12–14. Patent Owner agrees. Prelim. Resp. 4–5. We determine that no express construction of any claim term is necessary.

*B. Anticipation by the '334 patent*

Petitioner contends claims 26–31 and 33 of the '286 patent are anticipated by the '334 patent. Pet. 16. Petitioner provides virtually no discussion of the '334 patent apart from stating that “U.S. Patent No. 2,832,334 (Exhibit 1008) discloses a ‘therapeutic device for use in manipulative treatment of joints of the human body.’” *Id.* (citing Ex. 1008, Title). Instead, Petitioner provides a series of statements pertaining to each element of the claims. *Id.* at 17–22. For example, the Petition states:

Claim 26 of the '286 patent further recites “a first arm member for coupling to the first body portion and defining a curved path.” Using Patentee’s analysis of this Claim (Exhibit 1007), the '334 patent (Exhibit 1008) discloses this element of Claim 26 of the '286 patent at Fig. 1 (10)(17)(29). (Exhibit 1011, ¶ 21) *Id.* at 17.

Petitioner also provides a claim chart which, for the same claim limitation, simply states “U.S. Patent 2,832,334, Fig. 1(10)(17)(29).” *Id.* at 14.

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 claims. 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 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. 1011 ¶ 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 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 claims 26–31 and 33 are anticipated by the ’334 patent.

*C. Anticipation by the ’154 patent*

Petitioner contends claims 26–31 and 33 of the ’286 patent are anticipated by the ’154 patent. Pet. 22. Petitioner provides virtually no discussion of the ’154 patent apart from stating that “U.S. patent no. 5,399,154 (Exhibit 1009) discloses a ‘range-of-motion splint.’” *Id.* (citing Ex. 1009, Abstract). Instead, Petitioner provides a series of conclusory statements pertaining to each element of the claim. *Id.* at 23–27. For example, the Petition states:

Claim 26 of the ’286 patent further recites “a first arm member for coupling to the first body portion and defining a curved path.” Using Patentee’s analysis of this Claim (Exhibit 1007), the ’154 patent (Exhibit 1009) discloses this element of Claim 26 of the ’286 patent at Fig. 1 (16)(20)(108). (Exhibit 1011, ¶ 46)

*Id.* at 23.



Petitioner also provides a claim chart which, for the same claim limitation, simply states “U.S. Patent 5,399,154, Fig. 1 (16) (20)(108).” *Id.* at 14.

Petitioner’s unexplained allegations fall far short of demonstrating a reasonable likelihood that Petitioner would prevail in showing the unpatentability of the challenged claims. 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 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 CFR § 42.6(a)(3). Further, the Declaration of Renee D. Rogge, Ph.D., cited in the Petition (Ex. 1011 ¶ 46) 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, or its dependent claims 27–31 and 33, are anticipated by the ’154 patent.

*D. Anticipation by the TenoStretch Orthosis Device*

Petitioner contends claims 26–31 and 33 of the ’286 patent are anticipated by the TenoStretch device. Pet. 28. Petitioner provides essentially no description of the device itself, but explains that

Kaiser Medical offered the device for sale to the public at least as early as the Annual Meeting for the American Academy of Orthopedic Surgeons (“AAOS”) from February 5-9, 2003 . . . and delivered actual products to at least two companies no later than March 2004. (Exhibit 1010, ¶18). One of the companies to whom Kaiser Medical delivered the TenoStretch device, Omni Motion, included a photograph of the TenoStretch device in a sales brochure (Exhibit 1010, ¶ 21 and 22) distributed in at least Nevada and California.

*Id.*

Petitioner provides a claim chart that purportedly shows how the TenoStretch device anticipates each element of claims 26–31 and 33 of the ’286 patent. *Id.* at 14–16. Petitioner’s claim chart cites to various elements shown in Exhibit K of Exhibit 1010, which consists of three photos of the TenoStretch device. For example, with respect to the recitation in claim 26 of “a first arm member for coupling to the first body portion and defining a curved path,” Petitioner’s claim chart states “Kaiser Medical TenoStretch (Exhibit 1010 at Exhibit K, element 1).” *Id.* at 14. Regarding the same element of claim 26, Petitioner also asserts that “[u]sing Patentee’s analysis of this Claim (Exhibit 1007), the TenoStretch (Exhibit 1010) discloses this element of Claim 26 of the ’286 patent at Exhibit K, element 1. (Exhibit 1011, ¶ 71).” *Id.* at 30. Petitioner provides virtually no additional explanation of Exhibit 1010. Further, the Declaration of Renee D. Rogge, Ph.D., cited in the Petition (Ex. 1011 ¶ 71) simply repeats the text that appears in the Petition with no additional explanation.

Petitioner has failed to present sufficient information to show a reasonable likelihood that Petitioner would prevail in showing the unpatentability of any challenged claim of the ’286 patent in view of the TenoStretch device. The scope of an *inter partes* review is limited. In particular, 35 U.S.C. § 311(b) provides:

SCOPE.—A petitioner in an inter partes review may request to cancel as unpatentable 1 or more claims of a patent only on a ground that could be raised under section 102 or 103 and only on the basis of prior art consisting of patents or printed publications.

Petitioner's reliance on the TenoStretch orthosis device as an anticipatory reference fails to set forth a ground of unpatentability for purposes of *inter partes* review. Petitioner identifies no patent or printed publication upon which the contentions of the Petition are based. Nor does Petitioner assert that the photos of the device in Exhibit K of Exhibit 1010, or Exhibit 1010 itself, constitute a "printed publication." *See also* Prelim. Resp. 21–33 (arguing that the TenoStretch device is not prior art and other evidentiary deficiencies). Because Petitioner's allegations of anticipation by a device are beyond the scope of *inter partes* review, we do not institute on this ground.

### 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 claims 26–31 and 33 of the '286 patent.

### IV. ORDER

In consideration of the foregoing, it is hereby:

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

IPR2015-00992  
Patent 7,955,286 B2

PETITIONER:

Jacque R. Wilson  
CARSON BOXBERGER LLP  
wilson@carsonboxberger.com

Cedric D'Hue  
D'HUE LAW LLC  
cedric.dhue@dhuelaw.com

PATENT OWNER:

Robert M. Evans, Jr.  
Michael J. Hartley  
Jason H. Conway  
SENNIGER POWERS LLP  
revans@senniger.com  
mhartley@senniger.com  
jconway@senniger.com