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Paper 11
Entered: October 21, 2015

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

LANTZ MEDICAL, INC.,
Petitioner,

v.

BONUTTI RESEARCH, INC.,
Patent Owner.

Case IPR2015-00993
Patent 8,784,343 B2

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

TARTAL, *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 1–4 of U.S. Patent No. 8,784,343 B2 (Ex. 1001, "the '343 patent"). Paper 4 ("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 '343 patent.

I. BACKGROUND

A. The '343 Patent (Ex. 1001)

The '343 patent, titled "Range of Motion System," issued July 22, 2014, from U.S. Application No. 13/194,496, filed July 29, 2011. Ex. 1001. The '343 patent relates to an adjustable orthosis for stretching tissue in the human body, particularly using principles of stress relaxation and creep for stretching tissue such as ligaments, tendons, or muscles around a joint during flexion or extension of the joint. *Id*. at 1:12–17.

B. Illustrative Claims

Claim 1 of the ’343 patent is independent. Claims 2–4 depend from claim 1.

Claim 1 is illustrative of the claims at issue:

> 1. A device for increasing the range of motion of a tissue in a body of a patient, the device comprising:
> a first cuff configured to couple to a first body portion;
> a second cuff configured to couple to a second body portion;
> a drive assembly operatively connected to the first and second cuffs and operable to drive movement of the second cuff with respect to the first cuff to adjust a position of the second cuff relative to the first cuff;
> a first arm member operatively connecting the first cuff to the drive assembly;
> a second arm member operatively connecting the second cuff to the drive assembly, the second arm member movable with respect to the first arm member in response to the operation of the drive assembly to adjust a position of the second arm member relative to the first arm member;
> a force element operatively connected to the second arm member, the force element comprising a spring configured to apply a spring force to the second arm member to urge movement of the second arm member relative to the first arm member; and
> a lockout element having a locking position and configured to selectively inhibit the spring from urging movement of the second arm member relative to the first arm member when in the locking position,
> wherein the drive assembly is configured to selectively operate to drive movement of the second arm member with respect to the first arm member independent of the spring when the lockout element is in the locking position.

Ex. 1001, 22:55–23:17.

C. Related Proceedings

The parties indicate that the ’343 patent is a subject of the following civil action: *Bonutti Research, Inc., v. Lantz Medical, Inc*. Case No. 1:14-cv-00609 (S.D. Ind.). Pet. 4; Paper 8, 2.

D. Asserted Grounds of Unpatentability

Petitioner contends that claims 1–4 of the ’343 patent are unpatentable as “anticipated pursuant to 35 U.S.C. § 102(a) and (b) by the Kaiser Medical TenoStretch, which was sold by Robert Kaiser at least as early as November 21, 2003 (Exhibit 1008).” Pet. 6. Exhibit 1008 is the Declaration of Robert Kaiser, President and Vice President of Kaiser Medical, Inc., indicating that Kaiser Medical, Inc., designed and offered for sale the TenoStretch.

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 does not propose an express construction for any claim term. Instead, Petitioner contends that the broadest reasonable construction of “lockout element,” as recited in claim 1, is at least as broad as the construction provided by an expert retained by Patent Owner in the district court proceeding. Pet. 10. We determine that no express construction of any claim term is necessary.

B. Anticipation by the TenoStretch Orthosis Device

According to Petitioner "the TenoStretch orthosis device is previously undisclosed prior art to the '343 patent at least pursuant to 35 U.S.C. § 102 (a) and (b)." Pet. 15. Petitioner further contends that "Claims 1–4 of the '343 patent are invalid in view of the TenoStretch device which, as demonstrated below, anticipates every element of Claims 1–4 of the '343 patent." *Id*.

Petitioner provides a claim chart that purportedly shows how the TenoStretch anticipates each element of claims 1–4 of the '343 patent. Pet. 10–13. Petitioner's claim chart cites to various elements shown in Exhibit K of Exhibit 1008, which consists of four photos of the TenoStretch. For example, with respect to the recitation in claim 1 of "a drive assembly operatively connected to the first and second cuffs and operable to drive movement of the second cuff with respect to the first cuff to adjust a position of the second cuff relative to the first cuff," Petitioner's claim chart states "TenoStretch (Exhibit 1008 at Exhibit K, element 3)." Pet. 11. Regarding the same element of claim 1, Petitioner also asserts that "[u]sing Patentee's analysis of this Claim (Exhibit 1007), the TenoStretch (Exhibit 1008) discloses this element of Claim 1 of the '343 patent at Exhibit K element 3 (Exhibit 1009, ¶ 23)." Pet. 16. Petitioner provides virtually no additional explanation of Exhibit 1007. Further, the Declaration of Renee D. Rogge, Ph.D., cited in the Petition (Exhibit 1009 ¶ 23) simply repeats the text that appears in the Petition with no additional explanation.

For the reasons that follow, we conclude that 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 '343 patent. 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 a device, 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 1008 or Exhibit 1008, itself, constitute a "printed publication." *See also* Prelim. Resp. 6–22 (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 deny the Petition.

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 any claim of the '343 patent.

IV. ORDER

In consideration of the foregoing, it is hereby:

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

PETITIONER

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