IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re patent of: BONUTTI, et al.	§	
	§	
U.S. Patent No. 8,784,343	§	Petition for *Inter Partes* Review
	§	
Issued: July 22, 2014	§	
	§	Attorney Docket No.: 026027.0000
Title: RANGE OF MOTION SYSTEM	§	Customer No.: 111393
	§	Real Party in Interest: Lantz Medical, Inc.
	§	

REVISED PETITION FOR INTER PARTES REVIEW

Pursuant to the provisions of 35 U.S.C. §§ 311-319, Lantz Medical, Inc. ("Petitioner") hereby petitions the Patent Trial and Appeal Board to institute an *inter partes* review of Claims 1-4 of United States Patent No. 8,784,343 ("the '343 Patent") (Exhibit 1001) that issued on July 22, 2014 to Peter M. Bonutti, Glen A. Phillips, and Justin E. Beyers, resulting from U.S. Patent Application No. 13/194,496, filed on July 29, 2011. According to USPTO records, the '343 Patent is currently assigned to Bonutti Research, Inc. ("Patentee").

I. COMPLIANCE WITH REQUIREMENTS FOR A PETITION FOR INTER PARTES REVIEW

A. Certification that U.S. Patent No. 8,784,343 May Be Contested by Petitioner

Petitioner certifies it is not barred or estopped from requesting *inter partes* review ("IPR") of U.S. Patent No. 8,784,343 (the '343 patent) (Exhibit 1001). Neither Petitioner, nor any party in privity with Petitioner, has filed a civil action challenging the validity of any claim of the '343 patent. The '343 patent has not been the subject of a prior IPR by Petitioner or a privy of Petitioner.

Petitioner also certifies this petition for IPR is filed within one year of the date of service of an Amended Complaint (Exhibit 1004) alleging infringement of a patent. Petitioner was served with an Amended Complaint alleging infringement of the '343 patent on July 22, 2014, which amended the Complaint filed on April 18, 2014 (Exhibit 1003) in Civil Action No. 1:14-cv-00609 in the United States District Court, Southern District of Indiana. The '343 patent was not included in the original Complaint.

Because the date of this petition is less than one year from July 22, 2014, this petition complies with 35 U.S.C. § 315(b).

B. Fee for Inter Partes Review (§ 42.15(a))

The Director is authorized to charge the fee specified by 37 CFR § 42.15(a) to Carson Boxberger LLP's Deposit Account No. 506567.

C. Mandatory Notices (37 CFR § 42.8(b))

1. Real Party in Interest (§ 42.8(b)(1))

The real party in interest of this petition pursuant to § 42.8(b)(1) is Lantz Medical, Inc. ("Lantz") located at 7750 Zionsville Road, #800, Indianapolis, Indiana 46268.

2. Other Proceedings (§ 42.8(b)(2))

The '343 patent is not the subject of any civil actions other than Civil Action No. 1:14-cv-00609. However, Petitioner is contemporaneously filing requests for IPR of U.S. Patent Nos. 7,112,179 (Claim 26); 7,955,286 (Claims 26-31, 33); and 7,404,804 (Claim 1).

3. Designation of Lead and Backup Counsel

	Lead Counsel	Backup Counsel
Name	Jacque R. Wilson	Cedric D'Hue
U.S.P.T.O. Reg. No.	48,038	58,241
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4. Service Information (§42.8(b)(4))

Service on Petitioner may be made by mail or hand delivery to Lead Counsel, Jacque R. Wilson at Carson Boxberger LLP, 301 W. Jefferson Blvd., Suite 200, Fort Wayne, IN 46802. Mr. Wilson's fax number is (260) 423-4329.

Service may be made by mail or hand delivery to Backup Counsel, Cedric D'Hue at D'Hue Law LLC, P.O. Box 421972, Indianapolis, IN 46242-1972. Mr. D'Hue's fax number is (202) 446-2951.

II. RELIEF REQUESTED

Petitioner requests IPR of Claims 1-4 of the '343 patent on the grounds set forth below and requests that the Claims be found unpatentable. An explanation of how each Claim is unpatentable is provided below, including where each element can be found in the prior art publications and the relevant prior art references.

III. IDENTIFICATION OF CLAIMS BEING CHALLENGED

(§ 42.104(b))

Claims 1-4 of the '343 patent are unpatentable. Each Claim is 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).

The TenoStretch was, thus, sold more than a year before the earliest effective filing date of the ‘343 patent, and Patentee did not cite this reference during prosecution of the ‘343 patent.

Petitioner’s proposed construction of the contested Claims, the evidence relied upon, and the precise reasons why the Claims are unpatentable are provided below. The evidence relied upon in this petition is attached and listed in the attached Exhibit List.

IV. BACKGROUND INFORMATION ON THE ‘343 PATENT

The ‘343 patent issued from U.S. Patent Application Serial Number 13/194,496. The earliest effective filing date of the ‘343 patent is August 12, 2005. The ‘343 patent includes one independent claim and three dependent claims. The independent claim at issue is Claim 1.

Claims 1 through 4 of the‘343 patent read as follows:

> 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.

2. A device for increasing the range of motion of a tissue in a body of a patient set forth in claim 1, wherein the drive assembly imparts movement of the spring relative to the first cuff in response to operation of the drive assembly in driving movement of the second cuff with respect to the first cuff.

3. A device for increasing the range of motion of a tissue in a body of a patient set forth in claim 1, wherein the drive assembly comprises a worm and a gear engaging the worm.

4. A device for increasing the range of motion of a tissue in a body of a patient set forth in claim 1, wherein the drive assembly is

operable to drive movement of the second cuff with respect to the first cuff in a first direction, and wherein the spring is configured to selectively apply the spring force to the second cuff to urge movement of the second cuff relative to the first cuff in the first direction.

V. DEFINITION OF A PERSON OF ORDINARY SKILL IN THE ART

"A person of ordinary skill in the art at the time of the invention of the . . . ['343 patent] . . . would be an occupational therapist, physical therapist, mechanical engineer, and/or biomedical engineer with three to five years of experience designing or evaluating the design of orthotics." (Exhibit 1005, page 4)

VI. LEGAL STANDARD FOR CONSTRUCTION OF CLAIM TERMS IN IPR

A claim subject to IPR is given its "broadest reasonable construction in light of the specification of the patent in which it appears." 37 C.F.R. § 42.100(b). The broadest reasonable construction should be determined, in part, by taking into account the subject matter Patentee contends infringes the claims and the constructions Patentee has advanced in litigation. Also, if Patentee contends terms in the claims should be read to have a special meaning, those contentions should be disregarded unless Patentee also amends the claims compliant with 35 U.S.C. § 112 to make them expressly correspond to those contentions. *See* 77 Fed. Reg.

48764 at II.B.6 (August 14, 2012); cf. *In re Youman*, 679 F.3d 1335, 1343 (Fed. Cir. 2012).

Thus, Petitioner suggests, for the sake of rational analysis only, that the "broadest reasonable" construction to be applied in this proceeding for these limitations is at least as broad as what Patentee is asserting in the pending litigation. Patentee's proposed claim construction is shown below.

VII. CONSTRUCTION OF CLAIM TERMS IN THE '343 PATENT

A. "lockout element"

In the '343 Patent, the claim term "lockout element" is found in independent Claim l and, by extension, in dependent Claims 2, 3, and 4.

Patentee's expert in the above referenced litigation argues that, to the extent construction of the phrase is required, "the definition of 'lockout element' should be "an element that is designed or constructed to inhibit the relative movement of another element or part.'" (Exhibit 1006, pages 44-45)

VIII. CLAIM CHART FOR PATENT '343

Claim/Element	Prior Art
1. A device for increasing the range of motion of a tissue in a body of a patient, the device comprising:	• TenoStretch (Exhibit 1008 at Exhibit K)

a first cuff configured to couple to a first body portion;	• TenoStretch (Exhibit 1008 at Exhibit K, element 1)
a second cuff configured to couple to a second body portion;	• TenoStretch (Exhibit 1008 at Exhibit K, element 2)
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;	• TenoStretch (Exhibit 1008 at Exhibit K, element 3)
a first arm member operatively connecting the first cuff to the drive assembly;	• TenoStretch (Exhibit 1008 at Exhibit K, element 4)
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;	• TenoStretch (Exhibit 1008 at Exhibit K, element 5)
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	• TenoStretch (Exhibit 1008 at Exhibit K, element 6)

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,	• TenoStretch (Exhibit 1008 at Exhibit K, element 7)
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.	• TenoStretch (Exhibit 1008 at Exhibit K where there is shown a black crank that forces the arm members to move relative to each other)
2. A device for increasing range of motion of a tissue in a body of a patient set forth in claim 1, wherein the drive assembly imparts movement of the spring relative to the first cuff in response to operation of the drive assembly in driving movement of the second cuff with respect to the first cuff.	• TenoStretch (Exhibit 1008 at Exhibit K, element 3)
3. A device for increasing the range of motion of a tissue in a body of a patient set forth in claim 1, wherein the drive assembly comprises a worm and a gear engaging the worm.	• TenoStretch (Exhibit 1008 at Exhibit K, elements 8 and 9)

4. A device for increasing the range of motion of a tissue in a body of a patient set forth in claim 1, wherein the drive assembly is operable to drive movement of the second cuff with respect to the first cuff in a first direction, and wherein the spring is configured to selectively apply the spring force to the second cuff to urge movement of the second cuff relative to the first cuff in the first direction.	• TenoStretch (Exhibit 1008 at Exhibit K) functions in this manner

IX. PRECISE REASONS FOR RELIEF

A. Background of the TenoStretch Device

Kaiser Medical developed the TenoStretch orthosis device at least as early as June 2002. (Exhibit 1008, ¶ 3, 5, and 6). 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 (Exhibit 1008, ¶ 7). Kaiser Medical, in fact, sold the TenoStretch device to at least three companies from November 2003 to December 2003 (Exhibit 1008, ¶ 10, 12, and 15) and delivered actual TenoStretch products to at least two companies no later than March 2004. (Exhibit 1008, ¶18). One of the companies to whom Kaiser Medical delivered the TenoStretch device, Omni Motion, Inc., included a photograph of the

TenoStretch device in a sales brochure (Exhibit 1008, ¶ 21 and 22) distributed in at least Nevada and California.

Patentee's counsel took Robert Kaiser's deposition on April 7, 2015. In his deposition, Mr. Kaiser gave testimony (1) that further established the existence of the TenoStretch more than one year before the earliest effective filing date of the '343 patent; (2) that demonstrates the TenoStretch was offered for sale and/or sold more than one year before the earliest effective filing date of the '343 patent; and (3) that shows the TenoStretch was ready for patenting more than one year before the earliest effective filing date of the '343 patent. (Exhibit 1010, Kaiser Deposition pages 167-169 w/ April 6, 2004 Akin Gump letter).

Patentee's counsel took Lantz Medical's CEO Ted Brown's deposition on April 8, 2015. In his deposition, Mr. Brown gave testimony (1) that further established the existence of the TenoStretch more than one year before the earliest effective filing date of the '343 patent; (2) that demonstrates the TenoStretch was offered for sale and/or sold more than one year before the earliest effective filing date of the '343 patent; and (3) that shows Mr. Brown purchased the TenoStretch on behalf of US Medical more than one year before the earliest effective filing date of the '343 patent. (Exhibit 1011, Brown Deposition pages 57-58 and 66-75 w/ check stub for TenoStretch check).

Thus, the TenoStretch orthosis device is previously undisclosed prior art to the ‘343 patent at least pursuant to 35 U.SC. § 102 (a) and (b). Moreover, 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.

B. The TenoStretch Anticipates Claim 1 of the ‘343 Patent.

Claim 1 of the ‘343 patent recites “A device for increasing the range of motion of a tissue in a body of a patient, the device comprising.” Using Patentee’s analysis of this Claim (Exhibit 1007), the TenoStretch (Exhibit 1008) discloses such a device. (Exhibit 1009, ¶ 20)

Claim 1 of the ‘343 patent further recites “a first cuff configured to couple to a first body portion.” Using 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 1. (Exhibit 1009, ¶ 21)

Claim 1 of the ‘343 patent further recites “a second cuff configured to couple to a second body portion.” Using 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 2. (Exhibit 1009, ¶ 22)

Claim 1 of the ‘343 patent further recites “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." Using 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)

Claim 1 of the '343 patent further recites "a first arm member operatively connecting the first cuff to the drive assembly." Using 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 4. (Exhibit 1009, ¶ 24)

Claim 1 of the '343 patent further recites "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." Using 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 5. (Exhibit 1009, ¶ 25)

Claim 1 of the '343 patent further recites "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." Using 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 6. (Exhibit 1009, ¶ 26)

Claim 1 of the ‘343 patent further recites “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.” Using 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 7. (Exhibit 1009, ¶ 27)

Claim 1 of the ‘343 patent further recites “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.” Using 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 where there is shown a black crank that forces the arm members to move relative to each other. (Exhibit 1009, ¶ 28)

As shown in the attached Exhibit 1007, this anticipation analysis of Claim 1 of the ‘343 patent is identical to the analysis proposed by Patentee to demonstrate that Petitioner’s commercial product is covered by Claim 1 of the ‘343 patent. (Exhibit 1009, ¶ 29)

C. The TenoStretch Anticipates Claim 2 of the ‘343 Patent.

Claim 2 of the ‘343 patent further recites “[a] device for increasing the range of motion of a tissue in a body of a patient set forth in claim 1, wherein the drive assembly imparts movement of the spring relative to the first cuff in response to operation of the drive assembly in driving movement of the second cuff with respect to the first cuff.” Using Patentee’s analysis of this Claim (Exhibit 1007), the TenoStretch (Exhibit 1008) discloses this element of Claim 2 of the ‘343 patent in Exhibit K element 3. (Exhibit 1009, ¶ 31)

As shown in the attached Exhibit 1007, this anticipation analysis of Claim 2 of the ‘343 patent is identical to the analysis proposed by Patentee to demonstrate that Petitioner’s commercial product is covered by Claim 2 of the ‘343 patent. (Exhibit 1009, ¶ 32)

D. The TenoStretch Anticipates Claim 3 of the ‘343 Patent.

Claim 3 of the ‘343 patent further recites “[a] device for increasing the range of motion of a tissue in a body of a patient set forth in claim 1, wherein the drive assembly comprises a worm and a gear engaging the worm.” Using Patentee’s analysis of this Claim (Exhibit 1007), the TenoStretch (Exhibit 1008) discloses this element of Claim 3 of the ‘343 in Exhibit K elements 8 and 9. (Exhibit 1009, ¶ 34)

As shown in the attached Exhibit 1007, this anticipation analysis of Claim 3 of the ‘343 patent is identical to the analysis proposed by Patentee to demonstrate that Petitioner’s commercial product is covered by Claim 3 of the ‘343 patent. (Exhibit 1009, ¶ 35)

E. The TenoStretch Anticipates Claim 4 of the ‘343 Patent.

Claim 4 of the ‘343 patent further recites “[a] device for increasing the range of motion of a tissue in a body of a patient set forth in claim 1, wherein the drive assembly is operable to drive movement of the second cuff with respect to the first cuff in a first direction, and wherein the spring is configured to selectively apply the spring force to the second cuff to urge movement of the second cuff relative to the first cuff in the first direction.” Using Patentee’s analysis of this Claim (Exhibit 1007), the TenoStretch (Exhibit 1008) functions in exactly this manner. (Exhibit 1009, ¶ 37)

As shown in the attached Exhibit 1007, this anticipation analysis of Claim 4 of the ‘343 patent is identical to the analysis proposed by Patentee to demonstrate that Petitioner’s commercial product is covered by Claim 4 of the ‘343 patent. (Exhibit 1009, ¶38)

X. CONCLUSION

Because a reasonable likelihood exists that Petitioner will prevail in its challenge of at least one claim of the '334 patent in light of the above-referenced prior art, the USPTO should initiate IPR proceedings and find Claims 1-4 of the '334 patent invalid pursuant to 35 USC § 102 (a) and/or (b).

Respectfully submitted,

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CERTIFICATE OF SERVICE

I hereby certify that on this 21st day of April, 2015 a true and complete copy of the above and foregoing was served via certified mail/return receipt requested:

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