

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SMITH & NEPHEW, INC. and
ARTHROCARE CORP.,
Petitioners,

v.

ARTHREX, INC.,
Patent Owner.

Case IPR2017-00275
Patent 9,179,907 B2

Before WILLIAM V. SAINDON, BARRY L. GROSSMAN, and
TIMOTHY J. GOODSON, *Administrative Patent Judges*.

GOODSON, *Administrative Patent Judge*.

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

I. INTRODUCTION

Petitioners filed a Petition (Paper 1, “Pet.”) requesting *inter partes* review of claims 1, 4, 8, 10–12, 15, 16, 18, 25–28, and 30 of U.S. Patent No. 9,179,907 B2 (Ex. 1001, “the ’907 patent”). Patent Owner filed a Preliminary Response to the Petition. Paper 6 (“Prelim. Resp.”).

We have jurisdiction under 35 U.S.C. § 314, which provides that an *inter partes* review may not be instituted “unless . . . there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.” We decide whether to institute an *inter partes* review on behalf of the Director. Upon consideration of the Petition and Patent Owner’s Preliminary Response, we institute an *inter partes* review on claims 1, 4, 8, 10–12, 16, 18, and 25–28 of the ’907 patent.

Our factual findings and conclusions at this stage of the proceeding are preliminary, and based on the evidentiary record developed thus far. This is not a final decision as to the patentability of claims for which *inter partes* review is instituted. Our final decision will be based on the record as fully developed during trial.

A. Related Matters

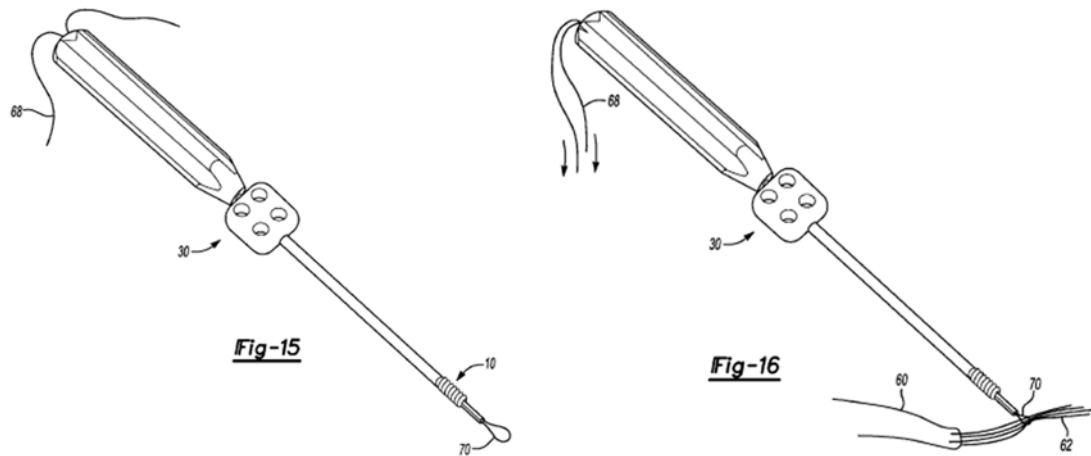
Patent Owner is asserting the ’907 patent against Petitioners in a civil action in the U.S. District Court for the Eastern District of Texas, *Arthrex, Inc. v. Smith & Nephew, Inc.*, Consolidated Civil Action Nos. 2:15-cv-01047 and 2:15-cv-01756. Pet. 7–8; Paper 3, 1.¹

¹ Petitioners assert, and Patent Owner does not dispute, that Petitioners were first served with a complaint alleging infringement of the ’907 patent on November 20, 2015, which is less than a year before they filed the Petition in this proceeding. Pet. 8 n.4 (citing Ex. 1021).

B. The '907 Patent

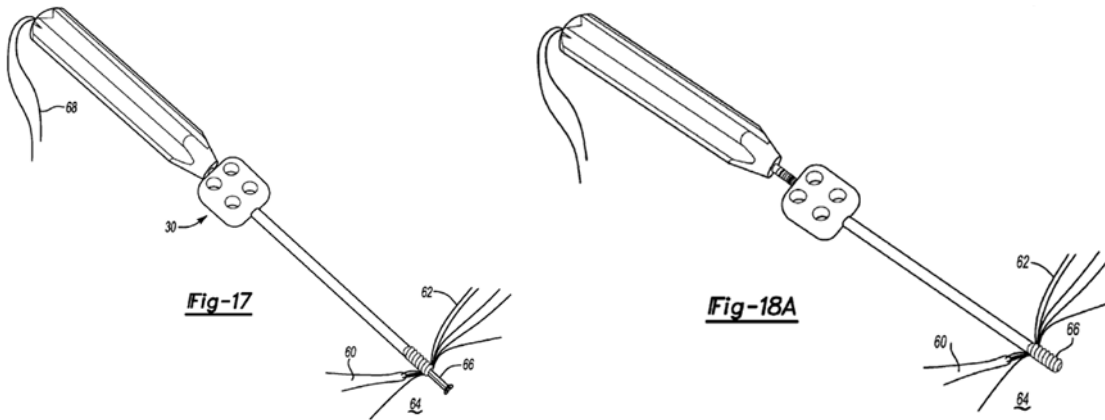
The '907 patent describes a knotless suture securing assembly. Ex. 1001, at [54], [57]. The Background explains that suture anchors are one type of fixation device that can be used for reattaching soft tissue that has become detached from bone. *Id.* at 1:20–33. A drawback of prior art suture anchors, however, is that a surgeon is “generally require[d] . . . to tie knots in the suture to secure the tissue to the bone, which is tedious and time-consuming.” *Id.* at 1:33–36. The Summary section states that the disclosed embodiments “are useful for securing soft tissue to bone with excellent pull-out strength without requiring a surgeon to tie suture knots to secure the suture in place or to secure the tissue to the bone.” *Id.* at 1:43–46.

Figures 15 and 16 of the '907 patent are reproduced below:



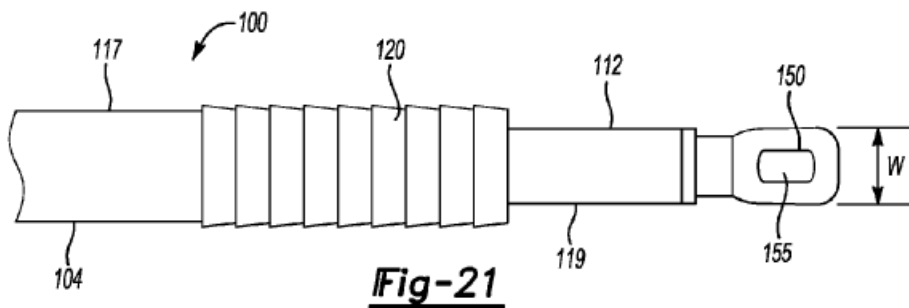
In the embodiment shown in Figures 15 and 16, driver 30 is pre-loaded with screw 10, and traction suture 68 is passed into the cannula of driver 30 until looped end 70 is exposed at the distal end. *Id.* at 5:48–53. Sutures 62, which are attached to graft 60, are passed through traction suture loop 70. *Id.* at 5:53–55. By drawing on traction suture 68, suture loop 70 is tightened and tension is applied to graft sutures 62. *Id.* at 5:62–64. Driver 30 is

positioned such that screw 10 engages bone 64 at the edge of hole 66, as shown in Figure 17, reproduced below:



Rotating driver 30 causes screw 10 to be inserted into hole 66 until fully installed, as shown in Figure 18A, reproduced above. *Id.* at 6:8–13. In that position, “sutures 62 or the graft 60 [is] pinned and/or wound between the base and sidewall of socket 66 and interference screw 10.” *Id.* at 6:13–15. Driver 30 can then be removed. *Id.* at 6:18–19.

Figure 21, reproduced below, shows another embodiment, which includes driver 100, interference device 120, and eyelet implant 150. *Id.* at 6:47–55, 7:4–5.



As shown in Figure 21, eyelet implant 150 includes “aperture 155 for receiving a suture attached to a graft to pass through the eyelet implant 150.” *Id.* at 7:12–14. Interference device 120 can be a screw or an interference plug, and is “preferably formed of a bioabsorbable material such as PLLA.”

Id. at 6:55–57. “[E]yelet implant 150 is made of a material similar to that of the interference device 120.” *Id.* at 7:10–12. Figures 24, 25, and 27 are reproduced below:

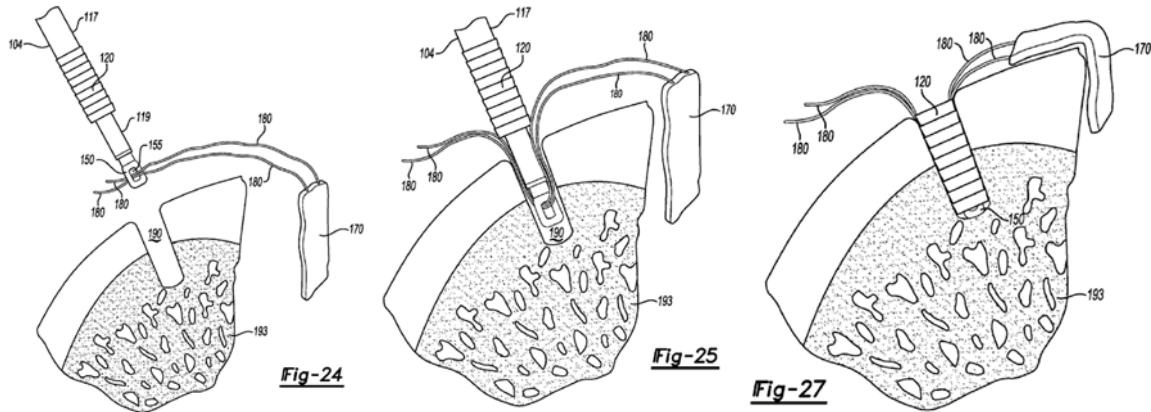


Figure 24 depicts suture 180, which is attached to graft 170, passing through aperture 155. *Id.* at 7:44–49. Implant 150 is then inserted into bone socket 190, as shown in Figure 25. *Id.* at 7:50–53. As can be seen in Figure 27, “interference device 120 is then impacted into the pilot hole 190 so that the interference device 120 advances toward the distal end 112 of driver 100 and securely engages and locks in the eyelet implant 150 with the sutures 180.” *Id.* at 7:59–63. The driver is removed and the suture ends are clipped, “leaving the graft 170 securely fastened to bone 193.” *Id.* at 7:64–67.

C. Challenged Claims

The Petition challenges claims 1, 4, 8, 10–12, 15, 16, 18, 25–28, and 30. Of these, claims 1 and 16 are independent. After the Petition was filed, Patent Owner disclaimed claims 15 and 30. *See* Ex. 2001; Prelim. Resp. 20 n.6, 65. Claim 1 is reproduced below, with italics emphasizing the language on which the parties’ dispute focuses:

1. A suture securing assembly, comprising:
 - an inserter including a distal end, a proximal end, and a longitudinal axis between the distal end and the proximal end;
 - a first member including an eyelet* oriented to thread suture across the longitudinal axis, the first member being situated near the distal end of the inserter, the first member being configured to be placed in bone; and
 - a second member situated near the distal end of the inserter, the second member being moveable by a portion of the inserter relative to the first member in the distal direction toward the eyelet into a suture securing position where the second member locks suture in place.

Ex. 1001, 10:21–34 (emphasis added).

D. Cited References

The Petition relies on the following references:

ElAttrache	US 2002/0013608 A1	Jan. 31, 2002	Ex. 1010
Martinek	WO 02/21999 A2	Mar. 21, 2002	Ex. 1011

E. Alleged Grounds of Unpatentability

Petitioners assert the following grounds of unpatentability:

Reference	Basis	Claims Challenged
ElAttrache	§ 102	1, 4, 8, 10–12, 16, 18, and 25–28
Martinek	§ 102	1, 15, 16, and 30

Petitioners also rely on the declaration of David R. McAllister, M.D. (Ex. 1019).

II. ANALYSIS

A. Claim Construction

We interpret the claims of an unexpired patent using the broadest reasonable interpretation in light of the specification of the patent. 37 C.F.R. § 42.100(b); *Cuozzo Speed Techs. LLC v. Lee*, 136 S. Ct. 2131, 2144–46 (2016). Under that standard, a claim term generally is given its ordinary and customary meaning, as would be understood by one of ordinary skill in the art in the context of the entire disclosure. *See In re Translogic Tech., Inc.*, 504 F.3d 1249, 1257 (Fed. Cir. 2007). Petitioners argue that “[l]ittle construction is needed here” because the reference on which Petitioners rely for most of its challenges has substantial overlap with the disclosure of the ’907 patent. Pet. 17. Similarly, Patent Owner argues that for purposes of this Decision, “the Board does not need to resolve any claim interpretation issues.” Prelim. Resp. 18. Based on the current record, resolution of the disputed issues at this stage of the proceeding does not require an express interpretation of any claim term. *See Vivid Techs., Inc. v. Am. Sci. & Eng’g, Inc.*, 200 F.3d 795, 803 (Fed. Cir. 1999) (“[O]nly those terms need be construed that are in controversy, and only to the extent necessary to resolve the controversy.”).

B. Statutory Disclaimer of Claims 15 and 30

Claims 15 and 30 are among the claims that the Petition challenges as being anticipated by Martinek. *See* Pet. 59. On February 28, 2017, the same day Patent Owner filed its Preliminary Response, Patent Owner filed a Disclaimer Under 37 C.F.R. § 1.321(a) that disclaimed claims 15 and 30. *See* Ex. 2001; Prelim. Resp. 20 n.6, 65. Our rule pertaining to preliminary responses in *inter partes* review proceedings provides that “[t]he patent

owner may file a statutory disclaimer under 35 U.S.C. 253(a) in compliance with § 1.321(a) of this chapter, disclaiming one or more claims in the patent. No *inter partes* review will be instituted based on disclaimed claims.” 37 C.F.R. § 42.107(e). Accordingly, we do not institute an *inter partes* review based on claims 15 or 30, and our decision on institution is “based solely on the remaining claims” that are challenged in the Petition. Office Patent Trial Practice Guide, 77 Fed. Reg. 48,756, 48,764–65 (Aug. 14, 2012). For convenience, our references to the “challenged claims” in the remainder of this Decision refer only to claims 1, 4, 8, 10–12, 16, and 25–28 and do not include disclaimed claims 15 and 30.

C. Anticipation Ground Based on ElAttrache

Petitioners argue that claims 1, 4, 8, 10–12, 16, 18, and 25–28 are anticipated by ElAttrache. Pet. 45–59.

ElAttrache is the published version of one of the applications to which the '907 patent claims priority. Ex. 1010, at [21]; Ex. 1001, 1:13–14; Pet. 46; Prelim. Resp. 62. Whether ElAttrache qualifies as prior art to the challenged claims is discussed in Section II.E. below. ElAttrache describes a knotless suture anchor. Ex. 1010 ¶¶ 6–7. Figures 14–19 and the accompanying disclosure in ElAttrache are similar, if not identical, to the figures and description of the suture loop embodiment of the '907 patent, summarized above. *Compare* Ex. 1010 ¶¶ 45–48 *with* Ex. 1001, 5:35–6:22.

Petitioners argue that ElAttrache discloses every limitation of the challenged claims. For example, with respect to claim 1, Petitioners assert that ElAttrache's driver 30 corresponds to the “insertor,” ElAttrache's traction suture 68 and suture loop 70 corresponds to the “first member,” and ElAttrache's screw 10 corresponds to the “second member.” Pet. 47–49.

Petitioners also provide a detailed explanation of how ElAttrache discloses the limitations of the other challenged claims. *Id.* at 50–59.

In the Preliminary Response, Patent Owner disputes that ElAttrache qualifies as prior art, but does not challenge Petitioners’ contention that ElAttrache discloses the subject matter of the challenged claims. Prelim. Resp. 62.

For purposes of this Decision, Petitioners have adequately explained how ElAttrache discloses each limitation of claims 1, 4, 8, 10–12, 16, 18, and 25–28. As discussed in Section II.E. below, we also determine that Petitioners have made a sufficient threshold showing that ElAttrache qualifies as prior art to the challenged claims. It is not inconsistent for Petitioners to maintain, in their arguments regarding priority, that the application that published as ElAttrache fails to provide sufficient written description support under § 112 for the challenged claims while also arguing that ElAttrache discloses each limitation of the challenged claims under § 102. *See* Pet. 46 (arguing that ElAttrache does not support the challenged claims but that it does disclose the flexible loop species, which anticipates the claims). This is because “the description of a single embodiment of broadly claimed subject matter constitutes a description of the invention for anticipation purposes . . . , whereas the same information in a specification might not alone be enough to provide a description of that invention for purposes of adequate disclosure.” *In re Lukach*, 442 F.2d 967, 970 (CCPA 1971). Based on the current record, Petitioners have demonstrated a reasonable likelihood that they will prevail in showing that claims 1, 4, 8, 10–12, 16, 18, and 25–28 are anticipated by ElAttrache.

D. Anticipation by Martinek

Petitioners argue that claims 1 and 16 are anticipated by Martinek.
Pet. 59–65.

Martinek describes a knotless suture anchor. Ex. 1011, 2. Figure 8 of Martinek is reproduced below:

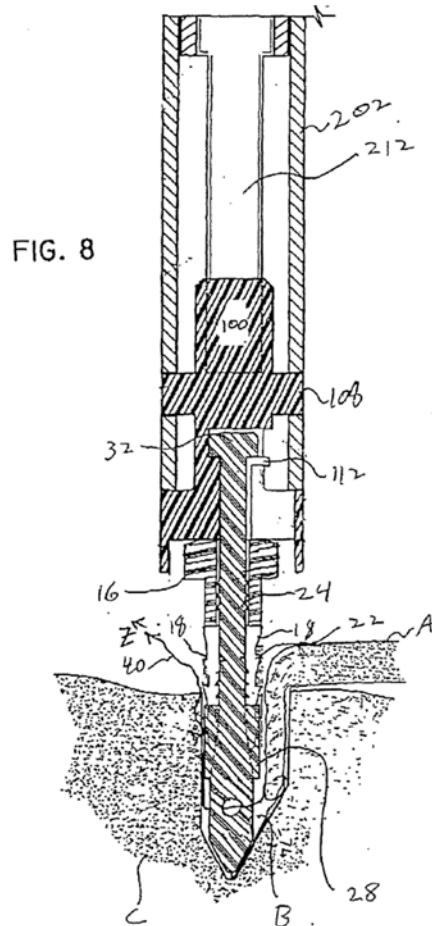


Figure 8 depicts a cross-sectional view of implantation apparatus 200 positioned in bore B drilled in shoulder bone C, with tissue section A secured to setting pin 24. *Id.* at 6, 12. Once in position, apparatus 200 is actuated, driving expandable member 12 distally and causing the distal ends of legs 18 to be driven radially outward by setting pin 24. *Id.* at 12–13. “As

legs 18 are driven radially outward, barbs 22 engage and secure a portion of suture 40 against the bone C within bore B.” *Id.* at 13.

Petitioners contend that Martinek discloses every limitation of claims 1 and 16. Specifically, Petitioners argue that Martinek’s implantation apparatus 200 corresponds to the “inserter” of claim 1 and the “driver” of claim 16. Pet. 62, 64. Petitioners correlate Martinek’s setting pin 24 to the “first member” of claims 1 and 16, and Martinek’s expandable body 12 to the “second member” of claims 1 and 16. *Id.* at 62–64.

Patent Owner’s Preliminary Response does not identify any limitation in claims 1 or 16 that is not disclosed in Martinek. Instead, Patent Owner argues that Martinek is not prior art, and that we should exercise our discretion to decline to institute on this ground under 35 U.S.C. § 325(d) because Martinek was overcome during prosecution when Patent Owner argued that Martinek is not prior art. Prelim. Resp. 62–64. As discussed in Section II.E. below, Petitioners have made a sufficient threshold showing that Martinek qualifies as prior art to claims 1 and 16.

We also do not deem it appropriate to deny institution under § 325(d) in the circumstances of this case. The prosecution history indicates that after the Examiner rejected the claims as anticipated by Martinek, Patent Owner conducted a telephonic interview with the Examiner and filed a Response in which it argued that Martinek is not prior art because “Applicant’s filing date is earlier [than the earliest filing date of the Martinek reference]. This application claims the benefit of U.S. Provisional Application No. 60/213,263, which was filed June 22, 2000.” Ex. 1002, 221–25, 271. In the next Office Action, the Examiner did not comment on Patent Owner’s arguments and applied different references to reject the claims. *Id.* at 295–

302. Patent Owner's Preliminary Response does not point to, and we do not find, any submission by Patent Owner or any analysis by the Examiner during the prosecution detailing why the subject matter of claims 1 and 16 is adequately supported by the June 2000 provisional application or any other document in the priority chain.

Under § 325(d), "the Director may take into account whether, and reject the petition . . . because, the same or substantially the same prior art or arguments previously were presented to the Office." The permissive language in the statute signals that we are not required to reject a petition, or a particular ground presented in a petition, simply because it relies on art that was before the Office previously. We decline to do so in this case because we cannot assess from the record before us the complete basis for any determination by the Examiner that Martinek does not constitute prior art to claims 1 and 16 of the '907 patent.

Based on the current record, Petitioners have demonstrated a reasonable likelihood that they will prevail in showing that claims 1 and 16 are anticipated by Martinek.

E. Priority Date of the Challenged Claims

The '907 patent claims priority to a chain of five applications reaching back to June 2001, as well as a provisional application filed in June 2000. The priority claim in the '907 patent is reproduced below:

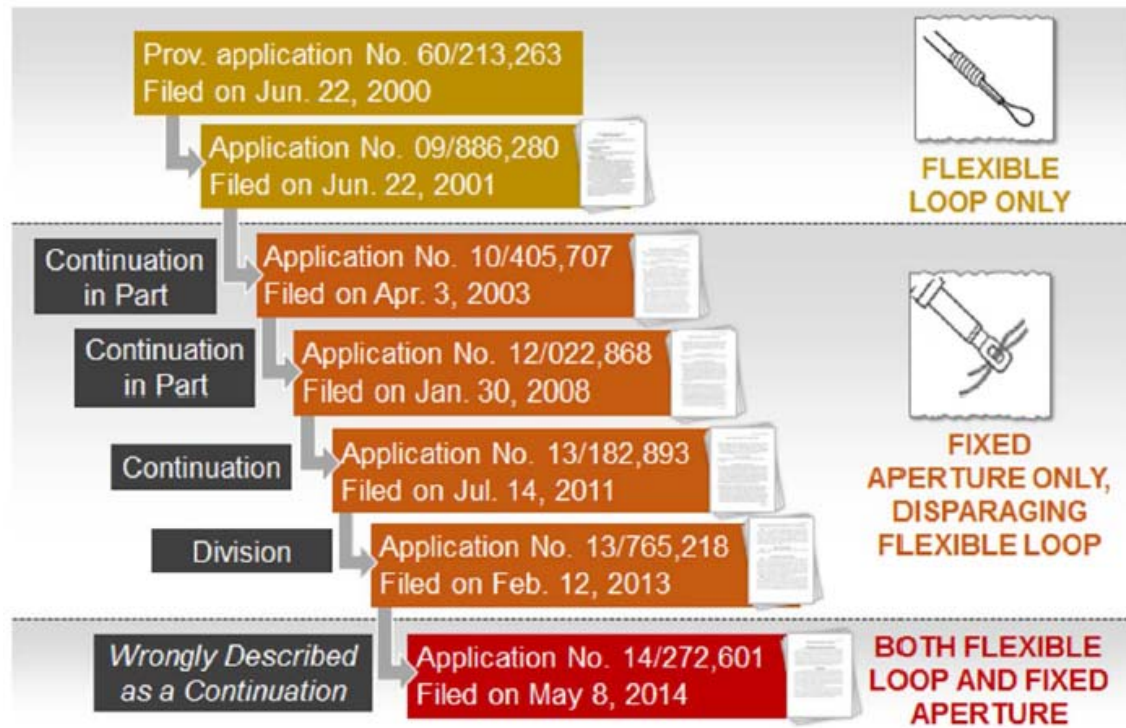
This is a continuation of U.S. patent application Ser. No. 13/765,218 filed Feb. 12, 2013, which is a divisional of U.S. application Ser. No. 13/182,893, filed Jul. 14, 2011, now U.S. Pat. No. 8,430,909, which is a continuation of U.S. application Ser. No. 12/022,868, filed Jan. 30, 2008, now U.S. Pat. No. 7,993,369, which is a continuation-in-part of U.S. application Ser. No. 10/405,707, filed Apr. 3, 2003, now U.S. Pat. No. 7,329,272, which is a continuation-in-part of U.S. application Ser. No. 09/886,280, filed Jun. 22, 2001, now U.S. Pat. No. 6,544,281, which claims the benefit of U.S. Provisional Application No. 60/213,263, filed Jun. 22, 2000.

Ex. 1001, 1:6–16. The ElAttrache and Martinek references that form the bases for Petitioners’ challenges were published in January 2002 and March 2002, respectively. *See* Ex. 1010, at [43]; Ex. 1011, at [43]. Petitioners argue that these references qualify as “pre-AIA § 102(b) and post-AIA § 102(a)(1) prior art”² to the challenged claims unless the claims have an effective filing date at least as early as June 22, 2001, which is the filing date of the earliest nonprovisional application in the priority chain. Pet. 15, 45, 59. Petitioners contend that the challenged claims are not entitled to priority to any of the priority documents, as discussed below.

² Petitioners’ position is that the first-inventor-to-file provisions of the AIA apply because the challenged claims are not entitled to priority to any date before May 8, 2014, the actual filing date of the application that issued as the ’907 patent. Pet. 15 n.5. However, Petitioners contend that the cited references would qualify as prior art under either the pre-AIA or post-AIA version of § 102. *Id.* Patent Owner’s Preliminary Response does not take a position on which version of § 102 applies to the ’907 patent. Thus, at this stage of the proceeding, neither party contends that the version of § 102 that applies materially affects the analysis of Petitioners’ asserted grounds of unpatentability. As such, for purposes of this Decision, we need not determine whether or not the ’907 patent is subject to the first-inventor-to-file provisions of the AIA.

Because Patent Owner seeks to antedate the allegedly anticipatory references cited in the Petition, Patent Owner bears the burden to argue or produce evidence that the challenged claims of the '907 patent are entitled to the benefit of a filing date that pre-dates those references. *See Dynamic Drinkware, LLC v. National Graphics, Inc.*, 800 F.3d 1375, 1379–80 (Fed. Cir. 2015); *Research Corp. Technologies, Inc. v. Microsoft Corp.*, 627 F.3d 859, 870–71 (Fed. Cir. 2010). For a claim in a later-filed application to be entitled to the filing date of an earlier application, the earlier application must provide written description support for the claimed subject matter. *Anascape, Ltd. v. Nintendo of America Inc.*, 601 F.3d 1333, 1337 (Fed. Cir. 2010). Moreover, when a priority claim involves a chain of priority documents, “each application in the chain leading back to the earlier application must comply with the written description requirement of 35 U.S.C. § 112.” *Lockwood v. American Airlines, Inc.*, 107 F.3d 1565, 1571 (Fed. Cir. 1997). To satisfy the written description requirement, “the disclosure of the earlier application, the parent, must reasonably convey to one of skill in the art that the inventor possessed the later-claimed subject matter at the time the parent application was filed.” *Tronzo v. Biomet, Inc.*, 156 F.3d 1154, 1158 (Fed. Cir. 1998).

Petitioners argue that claims 1–13 and 16–28 of the '907 patent are not entitled to the filing date of any of the priority documents because none of them support a generic “first member” that can be either a flexible loop or a rigid implant. Pet. 20. Petitioners provide the following diagram that summarizes their position on the '907 patent's priority claim:



Id. at 4. The diagram illustrates the relationship of seven patent applications to which the '907 patent claims priority. As indicated in the diagram, Petitioners contend that “Patent Owner’s applications in 2000 and 2001 described only the flexible loop embodiment, whereas subsequent applications in 2003, 2008, 2011, and 2013 described only the rigid implant embodiment and *disparaged* the suture loop as a problematic prior concept.” *Id.* at 20. Petitioners further assert that the application filed in 2014, which is the application that issued as the '907 patent, is inaccurately denominated as a continuation because it made substantial changes to the disclosure of the applications between 2003 and 2013, including additional description of the flexible loop approach and deletion of the criticism of the flexible loop approach. *Id.* at 1–3, 22–23.

With these general assertions as background, Petitioners present four reasons why claims 1–13 and 16–28 are not entitled to priority. First,

Petitioners contend that the provisional application filed in 2000 and U.S. Application No. 09/886,280 (Ex. 2004, “the ’280 Application”) filed in 2001 disclose only the flexible loop species and do not support generic claims that would cover both the flexible loop species and the rigid implant species. Pet. 24–28 (citing Ex. 1003; Ex. 1004). According to Petitioners, the disclosure in these applications of a flexible loop species does not support claims to a generic “first member” because an ordinarily skilled artisan would not “readily discern that other [species] of the genus would perform similarly to the disclosed members.” *Id.* at 25 (quoting *Synthes USA, LLC v. Spinal Kinetics, Inc.*, 734 F.3d 1332, 1344–45 (Fed. Cir. 2013)). In support of that position, Petitioners rely on disclosure from Patent Owner’s subsequent applications in the priority chain that the rigid implant improves on the flexible loop eyelet because “suture attached to the graft is allowed to freely slide through the aperture of the eyelet implant to allow precise advancement and guiding of the plug or screw.” *Id.* at 27 (quoting Ex. 1005 ¶ 29).

In response to Petitioners’ first argument, Patent Owner argues that disclosure of a species generally provides adequate support for a later filed claim directed to the genus, particularly in the predictable field of the mechanical arts. Prelim. Resp. 25–26 (citing *Bilstad v. Wakapoulos*, 386 F.3d 1116, 1125–26 (Fed. Cir. 2004)). Patent Owner presents evidence that by the time of the provisional application, both soft and hard eyelets were known for suture anchors, and these eyelets “perform[ed] similarly by capturing tissue-securing suture to facilitate soft tissue repair or reattachment to bone.” *Id.* at 27; *see also id.* at 14–17 (citing Ex. 2002; Ex. 2004; Ex. 2003). Patent Owner further argues that the ’280 Application as filed

disclosed a genus broader than the suture loop species by virtue of its original claims. *Id.* at 37–40.

Petitioners’ second argument focuses on Application No. 10/405,707 (Ex. 1005, “the ’707 Application”) filed in 2003. Petitioners argue that the ’707 Application only supports claims to the rigid implant species, not the flexible loop species or genus claims that would encompass the flexible loop species, because it disparages the flexible loop species. Pet. 28–39.

Petitioners contend that based on the disclosure of the ’707 Application, an ordinarily skilled artisan would have understood the flexible loop configuration as problematic prior art that the inventors had moved beyond. *Id.* at 30. According to Petitioners, “a specification that criticizes a prior art configuration in the Background and never otherwise discusses it does not support generic claims encompassing the very same configuration that the Background criticizes as ‘undesirable.’” *Id.* at 31 (citing *Anascape*, 601 F.3d at 1340; *Tronzo*, 156 F.3d at 1159).

Patent Owner counters Petitioners’ second argument on the basis that “mere recognition in the specification that an aspect of a prior art system is ‘inconvenient’ does not constitute ‘disparagement’ sufficient to limit the described invention. . . .” Prelim. Resp. 50 (quoting *ScriptPro LLC v. Innovation Assocs.*, 833 F.3d 1336, 1341 (Fed. Cir. 2016)). Further, Patent Owner points out that the ’707 Application claims priority to the ’280 Application and incorporates it by reference, and Patent Owner argues that there would have been no reason to do so if the inventors were leaving the soft eyelet species behind. *Id.* at 47–49. Additionally, Patent Owner relies on original claim 1 of the ’280 Application, which recites “an aperture provided at the distal end of the driver.” *Id.* at 42 (quoting Ex. 1005, 11).

According to Patent Owner, “[t]hat claimed aperture is a generic expression of a first member including an eyelet” and “the generic way in which an eyelet was included in the originally filed claims . . . demonstrates the inventors had possession of an eyelet genus.” *Id.* at 42, 43.

Petitioners’ third argument is based on U.S. Application No 14/272,601 (“the ’601 Application”), which was filed in 2014 and issued as the ’907 patent. Petitioners contend that the ’601 Application broadened the disclosure of the preceding applications in order to support the generic claims, such that any generic claims are not entitled to priority before the filing of the ’601 Application. *Id.* at 39–41. Petitioners cite a redline comparison between the ’601 Application and the immediately prior application in the priority chain that Petitioners say shows deletion of the criticism of the suture loop approach and other revisions. *Id.* at 39 (citing Ex. 1009). According to Petitioners, these changes to the ’601 Application constitute new matter, like the deletion of criticism of prior art in *Anascape*. *Id.* at 39–40 (citing *Anascape*, 601 F.3d at 1336–37). Because the applications before the ’601 Application attribute unique properties to the rigid implant species as compared to the flexible loop species, Petitioners urge that Patent Owner is not entitled to a priority date for the genus any earlier than the filing date of the ’601 Application. *Id.* at 41 (citing *In re Curtis*, 354 F.3d 1347, 1356–57 (Fed. Cir. 2004)).

Responding to this third argument, Patent Owner argues that the removal of the criticism of the suture loop species in the Background was not new matter because the deleted material was commentary on the inventors’ own work, which was not prior art. Prelim. Resp. 58–60. With respect to other changes in the Specification, Patent Owner explains that

these changes are consistent with the different subject matter claimed in the '601 Application compared to the earlier applications. *Id.* at 60–61.

Finally, Petitioners' fourth argument is that affording claims 1–13 and 15–28 a priority date of June 2000 would allow Patent Owner to improperly evade prior art disclosing rigid implants. Pet. 41–45. Relying on a disclosure from the parallel district court litigation, Petitioners assert that Patent Owner claims a priority date of June 2000 for the broad genus claims of the '907 patent, but only claims priority to April 2003 for dependent claims 15 and 30. *Id.* at 42 (citing Ex. 1018). Claims 15 and 30 are the now-disclaimed dependent claims that recited that “the first member is a rigid implant defining the eyelet.” Ex. 1001, 11:16–17, 12:42–43; Ex. 2001. Petitioners argue that the June 2000 priority date for the genus claims would disqualify certain references that are prior art to the narrower rigid implant claims from being prior art to the broader genus claims. *Id.* at 44–45. Thus, according to Petitioners, “Patent Owner’s approach would allow for the paradoxical result of a dependent claim being anticipated or obvious without the corresponding independent claim also necessarily being invalid.” *Id.* at 45.

On this fourth argument, Patent Owner responds that priority is evaluated on a claim-by-claim basis, and as a consequence, “it is entirely possible to have intervening prior art between the effective filing dates rendering the later-filed claims invalid while leaving those with the earlier effective filing date valid.” Prelim. Resp. 63.

After considering the evidence and arguments summarized above, the priority issue in this case presents a close question. Both parties have offered some factual and legal support for their positions. At this juncture of

the proceeding, we need only decide whether there is a reasonable likelihood that Petitioners would prevail in their challenge to at least one claim. 35 U.S.C. § 314; *see also* Office Patent Trial Practice Guide, 77 Fed. Reg. 48,756, 48,765 (Aug. 14, 2012) (“The ‘reasonable likelihood’ standard is a somewhat flexible standard that allows the Board room to exercise judgment.”). Prevailing in the priority dispute is a predicate to the success of any of Petitioners’ challenges. On the current record, we determine that Petitioners have made a sufficient threshold showing that ElAttrache and Martinek both qualify as prior art to the challenged claims. We will make our final determination regarding the disputed priority issue based on the full record of evidence and arguments developed during trial.

III. ORDER

In consideration of the foregoing, it is hereby:

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

Whether claims 1, 4, 8, 10–12, 16, 18, and 25–28 are anticipated by ElAttrache; and

Whether claims 1 and 16 are anticipated by Martinek;

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 commencing on the entry date of this decision; and

FURTHER ORDERED that the trial is limited to the grounds identified above.

IPR2017-00275
Patent 9,179,907 B2

PETITIONERS:

Michael N. Rader
Jason M. Honeyman
Richard F. Giunta
Randy J. Pritzker
WOLF, GREENFIELD & SACKS, P.C.
MRader-PTAB@wolfgreenfield.com
jhoneyman-ptab@wolfgreenfield.com
rgiunta-ptab@wolfgreenfield.com
rpritzker-ptab@wolfgreenfield.com

PATENT OWNER:

Anthony P. Cho
Timothy J. Murphy
CARLSON, GASKEY & OLDS, P.C.
acho@cgolaw.com
tmurphy@cgolaw.com