

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ORTHOPEDIATRICS CORP.,
Petitioner,

v.
K2M, INC.,
Patent Owner.

Case IPR2018-00521
Patent 9,532,816 B2

Before LYNNE H. BROWNE, MICHAEL L. WOODS, and
ROBERT L. KINDER, *Administrative Patent Judges*.

BROWNE, *Administrative Patent Judge*.

DECISION
Institution of *Inter Partes* Review
35 U.S.C. § 314

I. INTRODUCTION

Orthopediatrics Corp., (“Petitioner”), on January 22, 2018, filed a Petition to institute *inter partes* review of claims 16, 18, 19, 21, and 22 of U.S. Patent No. 9,532,816 B2 (“the ’816 patent”). Paper 1 (“Pet.”). K2M, Inc. (“Patent Owner”) filed a Preliminary Response to the Petition on April 30, 2018. Paper 6 (“Prelim. Resp.”).

Under 35 U.S.C. § 314(a), an *inter partes* review may not be instituted unless 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.” For the reasons stated below, we determine that Petitioner has established a reasonable likelihood that it would prevail in showing the unpatentability of at least claim 16 of the ’816 patent. Accordingly, we institute an *inter partes* review as to all claims and all grounds.

A. *Related Proceedings*

The Petitioner indicates that the ’816 patent is the subject of *K2M, Inc. v. OrthoPediatrics Corp. & OrthoPediatrics US Distribution Corp.*, Case No. 1:17-cv-00061-GMS (D. Del.). Pet. 2.

Petitioner filed a previous petition requesting *inter partes* review also challenging claims 16, 18, 19, 21, and 22 of the ’816 patent. IPR2018-00429.

B. *The ’816 Patent*

The ’816 patent is directed to “to devices for stabilizing and fixing the bones and joints of the body. Particularly, the present invention relates to a manually operated device capable of reducing a rod into position in a rod receiving notch in the head of a bone screw with a controlled, measured

action.” Ex. 1101, 1:15–19. The device described in the ’816 patent achieves this objective by grasping “the head of a bone screw and reduc[ing] a rod into the rod receiving recess of the bone screw using a single manual control that can be activated in a controlled and measured manner.” *Id.* at 2:23–26.

Figure 4 reproduced below illustrates the device:

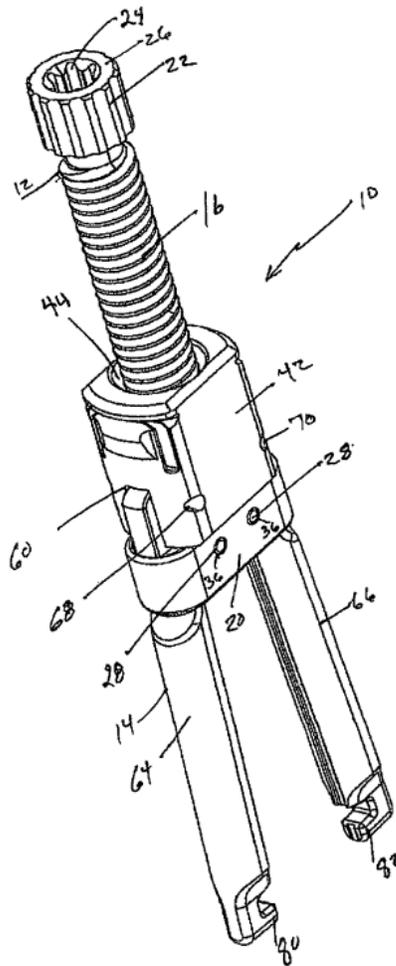


FIG 4

Figure 4 is an isometric view of the rod reducing device with the screw jack mechanism fully retracted and the two elongated grasping members in an open configuration. Ex. 1101, 3:27–30.

The '816 patent explains:

The device . . . is a rod **34** reduction device capable of reducing a rod into position in a rod receiving notch in the head of a bone screw with a controlled, measured action. The device is an elongated rod reduction device **10** that includes a screw jack mechanism **12** moveably engaged with an elongated grasping fork assembly **14**. The screw jack mechanism **12** includes an elongated threaded screw shaft **16** that terminates at its most proximal end with a controlling member **18** and terminates at its most distal end with a rod contact member **20**.

Id. at 3:63–4:5.

C. Illustrative Claim

Petitioner challenges claims 16, 18, 19, 21, and 22 of the '816 patent.

Claim 16, reproduced below, is the challenged independent claim.

16. A rod reducing device comprising:
a housing defining a longitudinal axis, the housing including first and second grasping members configured to grasp a portion of a bone anchor therebetween, the first and second grasping members defining a plane;
a rotatable member extending through the housing along the longitudinal axis; and
a rod contact member positioned at a distal end of the rotatable member, the rod contact member translatable along the longitudinal axis in response to rotation of the rotatable member about the longitudinal axis, wherein the rod contact member and the rotatable member are translatable within the plane defined by the first and second grasping members.

Ex. 1101, 10:22–35.

D. References Relied Upon

The Petitioner relies in relevant part on the following references (Pet. 3):

Name	Reference	Ex. No.
Whipple	US 2006/0293692 A1, published Dec. 28, 2006	1102
Runco	US 2006/0079909 A1, published Apr. 13, 2006	1103
Varieur	US 2005/0149053 A1, published July 7, 2005	1104
Jackson	US 2005/0192570 A1, published Sept. 1, 2005	1105
Trudeau	US 2006/0089651 A1, published Apr. 27, 2006	1106

E. The Asserted Grounds of Unpatentability

Petitioner asserts the challenged claims are unpatentable on the following grounds:

Reference(s)	Basis	Claim(s) challenged
Whipple (Fig. 11A)	§ 102(e)	16, 18, 19, 21, and 22
Whipple (Fig. 11A) and Runco	§ 103(a)	22
Whipple (Fig. 11C)	§ 102(e)	16, 18, 19, 21, and 22
Whipple (Fig. 11C) and Runco	§ 103(a)	16, 18, 19, 21, and 22
Varieur	§ 102(b)	16, 18, 19, and 21
Varieur and Runco	§ 103(a)	22
Jackson	§ 102(b)	16, 18, 19, 21, and 22
Jackson and Trudeau	§ 103(a)	18

Pet. 3. Petitioner supports its challenge with the Declaration of Ottie Pendleton, dated January 22, 2018 (“Pendleton Declaration”) (Ex. 1107).

II. ANALYSIS

A. *Discretion under 35 U.S.C. § 314*

The Board has discretion not to institute an *inter partes* review. *See* 35 U.S.C. § 314(a) (authorizing institution of an *inter partes* review under particular circumstances, but not requiring institution under any circumstances); *Harmonic Inc. v. Avid Tech, Inc.*, 815 F.3d 1356, 1367 (Fed. Cir. 2016) (explaining that under § 314(a), “the PTO is permitted, but never compelled, to institute an IPR proceeding”).

Patent Owner contends that “the Board should not institute *inter partes* review on both of IPR2018-00429 and IPR2018-00521” because these Petitions are redundant. Prelim. Resp. 22. In support of this contention, Patent Owner argues that these petitions “embody the type of resource-squandering approach that the Board criticized in its recent decision in *General Plastic Industries Co., Ltd. v. Canon Kabushiki Kaisha*, No. IPR2016-01357 (PTAB Sept. 6, 2017) (precedential).” *Id.* at 21.

In *General Plastic*, the Board identified seven nonexclusive factors that bear on the issue of whether the Board should invoke its discretion, based on a follow-on petition on the same patent, under 35 U.S.C. §314(a) and 37 C.F.R. § 42.108(a):

1. Whether the same petitioner previously filed a petition directed to the same claims of the same patent;
2. Whether at the time of filing of the first petition the petitioner knew of the prior art asserted in the second petition or should have known of it;
3. Whether at the time of filing of the second petition the petitioner already received the patent owner’s preliminary response to the first petition

or received the Board's decision on whether to institute review in the first petition;

4. The length of time that elapsed between the time the petitioner learned of the prior art asserted in the second petition and the filing of the second petition;

5. Whether the petitioner provides adequate explanation for the time elapsed between the filings of multiple petitions directed to the same claims of the same patent;

6. The finite resources of the Board; and

7. The requirement under 35 U.S.C. § 316(a)(11) to issue a final determination not later than 1 year after the date on which the Director notices institution of review.

Gen. Plastic, slip op. at 9–10, 16.

In this case we do not find Patent Owner's contention persuasive. Although, the first two factors enumerated *supra* weigh on the side of denying institution of the instant Petition,¹ the remaining factors do not.

At the time of the filing of the instant Petition (January 22, 2018), Petitioner had not received Patent Owner's preliminary response (filed April 18, 2018) in the first petition. The instant Petition was filed less than two weeks after the filing of the first petition on January 8, 2018. Petitioner explains that "[t]he grounds set forth in the present petition rely on different prior art, different combinations of prior art, different arguments regarding the asserted prior art, and different expert declaration testimony than those

¹ Both Petitions are directed to the same claims and at the time of filing the Petition, Petitioner should have known about the prior art asserted in the instant Petition

relied upon” in the first Petition. Pet. 1–2 (emphasis omitted). Granting of the instant Petition, filed eleven days after the first petition, would not overly tax the resources of the Board as the number of challenged claims and the number of grounds raised in each petition is reasonable. *See* IPR2018-00429, Paper 1 (Petition), 3; Pet. 4. Granting of the instant Petition would not impact the ability of the Board to issue a final determination not later than 1 year after the date on which the Director notices institution of review for the same reason.

In view of the foregoing, we determine that a weighing of the *General Plastic* factors does not support a discretionary denial of the Petition. Accordingly, we decline to deny the Petition under § 314(a).

B. Claim Construction

Petitioner contends that no “specific claim terms of the Challenged Claims require construction for the purposes of this petition.” Pet. 5. Whereas, Patent Owner asserts that the terms “extending through the housing” and “grasping” require construction. *See* Prelim. Resp. 9–21. For purposes of this decision we need only construe “extending through the housing.” *See, e.g., Vivid Techs., Inc. v. Am. Sci. & Eng’g, Inc.*, 200 F.3d 795, 803 (Fed. Cir. 1999) (only those terms that are in controversy need to be construed, and only to the extent necessary to resolve the controversy).

1. “extending through the housing”

Noting that “the term ‘housing’ is not used explicitly in the Specification of the ’816 Patent except in reference to the bone screw,” Patent Owner contends that the claimed “housing” corresponds to the body 42 of the fork assembly 14. Prelim. Resp. 13. In support of this contention, Patent Owner explains that “the specification describes fork assembly body

42, which ‘defines a body through passage 44 that is sized and complimentary [sic] configured to permit passage of the elongated threaded screw shaft 16 of the screw jack mechanism 12.’” *Id.* (citing Ex. 1101, Fig. 4, 5:5–9). Acknowledging that “[c]laim 16 recites that ‘the housing includ[es] first and second grasping members,’” Patent Owner nevertheless contends that “[b]ased on the specification of the ’816 Patent, however, it is clear that the housing itself does not include the first and second grasping members; instead, the first and second grasping members are merely attached to the housing as separate features.”” *Id.* at 14 (citations omitted).

With this construction of “housing” in mind, Patent Owner contends that “[e]xtending through the housing’ should be construed to mean ‘extending *entirely* through the housing’ consistent with Patent Owner’s proposed claim construction of ‘extending through the housing’ in the district court litigation.” *Id.* at 12 (citing Ex. 2004, 13–14; Ex. 2006, 19–20) (emphasis added). “Patent Owner proposes this construction as the only construction that is consistent with, and informed by, the claims, the specification, and the prosecution history of the ’816 Patent.” *Id.*

The Specification of the ’816 patent describes a rod reduction device 10 including “a screw jack mechanism 12 movably engaged with an elongated grasping fork assembly 14,” which includes “an elongated threaded screw shaft 16.” Ex. 1101, 3:67–4:3. In view of this description in the Specification, we understand the claimed “rotatable member” to correspond to the described screw shaft 16. As discussed *supra*, the Specification states that the fork assembly includes a “fork assembly body 42 [that] defines a body *through* passage 44 that is sized and complimentary configured *to permit passage* of the elongated threaded screw shaft 16 of the

screw jack mechanism 12.” *Id.* at 5:5–9 (original emphasis omitted, new emphases added). In the concurrent District Court proceeding cited *supra*, the United States District Court for the District of Delaware construed the claim language at issue. Ex. 2100, 3–4. The District Court noted that as the screw shaft 16 moves through the fork assembly body through passage 44, both the fork assembly body 42 and the body through passage 44 do not move. *See id.* at 4. In view of this lack of movement and Patent Owner’s proffered definition of housing as a “rigid casing,” the District Court concluded “that ‘housing’ should be construed as ‘the fixed portion of the rod reducing device that defines the body through passage.’” *Id.* Based on the current record before us, we agree with the District Court’s construction of the claim term “housing” and adopt it as our own at this stage of the proceeding.

The Specification further describes a “rod contact member 20, which is attached to the distal end of the elongated threaded screw shaft 16.” Ex. 1101, 6:27–29. The Specification explains that the rod contact member 20 is “forced downward along the length of the opposing first and second grasping members 64, 66 of the grasping fork assembly 14” such that “the rod contact member will be brought to bear against a rod positioned over the screw, which is firmly grasped by the grasping elements 80, 82 of the device.” *Id.* at 6:29–31, 41–44. Although the rod and bone screw are not illustrated in this figure, Figure 2 of the ’816 patent (reproduced below) illustrates the screw jack mechanism in its lowermost position where the rod contact member 20 would bear against a rod positioned over the bone screw. *See id.*

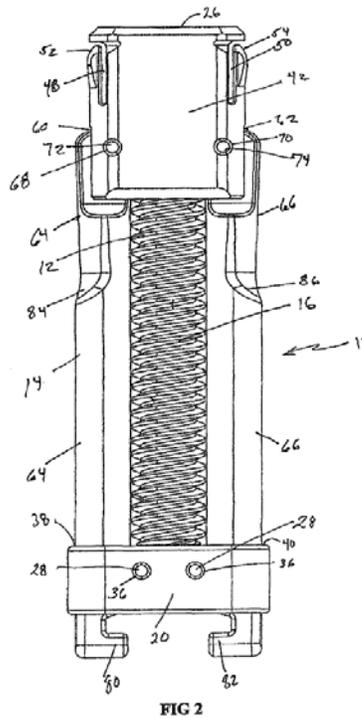


Figure 2 of the '816 patent is “a front view of the novel rod reducing device in an activated configuration.” Ex. 1101, 3:23–24. As shown in Figure 2, screw shaft 16 *does not* extend past the distal end of the housing despite being in its lowermost position. *See id.* at 6:29–31, 41–44. As such, the rotatable member as shown and described in the '816 patent does not extend entirely through the housing. Rather, as noted by the District Court, “[t]he inclusion of the term ‘entirely’ or ‘entire’ would exclude the preferred embodiments and would read out portions of the specification.” Ex. 2100, 4. Accordingly, we also agree with the District Court’s construction of “the entire claim phrase to mean, ‘extending through the fixed portion of the rod reducing device that defines the body through passage.’” *Id.*²

² The parties are given notice that the United States Patent and Trademark Office published a proposed rules package that would change the standard for construing unexpired and proposed amended claims in trials under the America Invents Act. *See* 83 Fed. Reg. 21221 (May 9, 2018) (available at:

C. *Principles of Law*

To establish anticipation, each and every element in a claim, arranged as recited in the claim, must be found in a single prior art reference. *Net MoneyIN, Inc. v. VeriSign, Inc.*, 545 F.3d 1359, 1369 (Fed. Cir. 2008); *Karsten Mfg. Corp. v. Cleveland Golf Co.*, 242 F.3d 1376, 1383 (Fed. Cir. 2001). “A reference anticipates a claim if it discloses the claimed invention ‘such that a skilled artisan could take its teachings in combination with his own knowledge of the particular art and be in possession of the invention.’” *In re Graves*, 69 F.3d 1147, 1152 (Fed. Cir. 1995) (internal citation and emphasis omitted). Moreover, “it is proper to take into account not only specific teachings of the reference but also the inferences which one skilled in the art would reasonably be expected to draw therefrom.” *In re Preda*, 401 F.2d 825, 826 (CCPA 1968).

A patent claim is unpatentable under 35 U.S.C. § 103(a) if the differences between the claimed subject matter and the prior art are such that the subject matter, as a whole, would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 406 (2007). The question of obviousness is resolved on the basis of underlying factual determinations including: (1) the scope and content of the prior art; (2) any differences between the claimed subject matter and the prior art; (3) the level of ordinary skill in the art; and, when presented, (4) objective

<https://www.gpo.gov/fdsys/pkg/FR-2018-05-09/pdf/2018-09821.pdf>). We provide a preliminary claim construction for the sole purpose of determining whether to institute trial. We emphasize that any final claim construction shall be based on the full record developed during trial.

evidence of nonobviousness. *Graham v. John Deere Co.*, 383 U.S. 1, 17–18 (1966).

We analyze the asserted grounds of unpatentability in accordance with the above-stated principles.

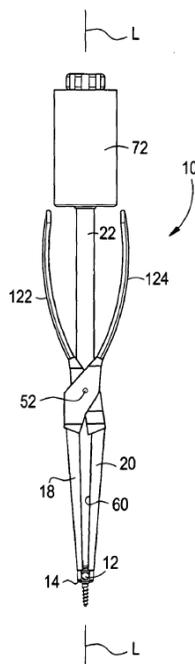
D. Anticipation of Claims 16, 18, 19, 21 and 22 by Whipple (Fig. 11A)

Petitioner asserts that in the embodiment illustrated by Figure 11A, Whipple discloses each and every limitation of claims 16, 18, 19, 21, and 22. Pet. 10–26.

1. Whipple (Fig. 11A)

Whipple is directed to “instruments and methods for manipulating a spinal fixation element, such as a spinal rod, relative to a bone anchor.” Ex. 1102 ¶ 5. Figure 2, reproduced below, illustrates one embodiment of Whipple’s instrument:

FIG. 2



Whipple's Figure 2 is a front view of the instrument. *Id.* ¶ 11. The instrument 10 shown in Figure 2 is configured to manipulate “a spinal fixation element 12, such as, for example, a spinal rod, a plate, a tether or cable or combinations thereof, relative to a bone anchor 14.” *Id.* ¶ 26 (emphases omitted). Whipple's instrument 10 has a “bone anchor grasping mechanism 18 . . . includ[ing] a first arm 24 having a distal end 26” and “first adjustment mechanism 20 . . . includ[ing] a second arm 50 that is pivotally connected to the first arm 24.” *Id.* ¶¶ 28, 31 (emphases omitted). The instrument 10 also includes a “second adjustment mechanism 22 . . . coupled to the first arm 24 and/or the second arm 50” comprising “an elongated tubular body 60 having a proximal end 62 and a distal end 64 and a lumen 66 extending between the proximal end 62 and the distal end 64.” *Id.* ¶ 34 (emphases omitted).

2. *Petitioner's Challenge*

Petitioner maps elements from Whipple to each limitation of claims 16, 18, 19, 21, and 22. Pet. 10–26. For example in challenging independent claim 16, Petitioner submits that:

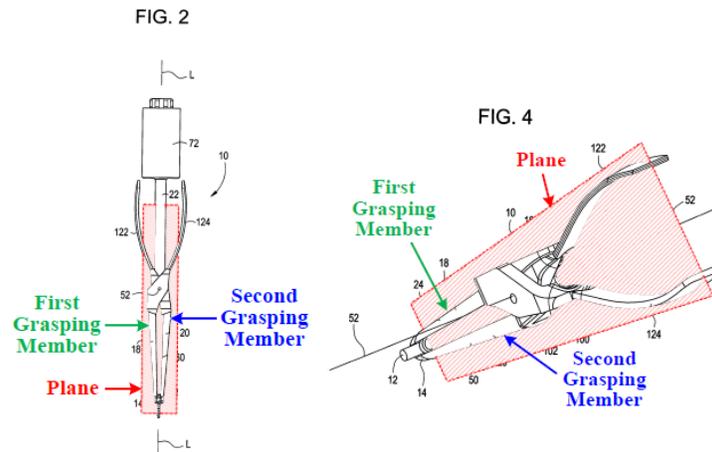
- a. Whipple's instrument 10 corresponds to the claimed rod reducing device. Pet. 11–12.
- b. Whipple's coupling mechanism 100 corresponds to the claimed housing. *Id.* at 12–13.
- c. Whipple's first arm 24 and second arm 50 correspond to the claimed first and second grasping members. *Id.* at 13–14.
- d. Whipple's tube 60 corresponds to the claimed rotatable member. *Id.* at 15–16.

- e. Whipple's distal end 64 corresponds to the claimed rod contact member. *Id.* at 16–17.
- f. In Whipple, the rod contact member and the rotatable member are translatable within a plane defined by the first and second grasping members. *Id.* at 19–21.

Regarding the dependent claims, Petitioner submits that:

- a. Whipple's distal end 26 of first arm 24 corresponds to the first claimed grasping feature and the distal end 56 of second arm 50 corresponds to the second claimed grasping feature. Pet. 21.
- b. In Whipple, movement of the rod contact member (distal end 64) urges the rods towards the distal ends of the grasping members (arms 24, 50) as required by claim 19. *Id.* at 22–23.
- c. In Whipple, the rod contact member (distal end 64) is positioned between the grasping members (arms 24, 50) as required by claim 21. *Id.* at 24–25.
- d. In Whipple, the rod contact member (distal end 64) is attached to the distal end of the rotatable member (tube 60). *Id.* at 25.

In support of these submissions, Petitioner provides numerous figures including annotated figures to illustrate the different elements of Whipple. Pet. 11–25. For easy reference, annotated Figures 2 and 4 are reproduced below with color added by Petitioner:



Annotated Figure 2 is a front view of the instrument with the elements Petitioner considers to correspond to the claimed first grasping member, second grasping member, and plane. *See Whipple* ¶ 11. Annotated Figure 4 is a top perspective view illustrating the same features. *See id.* ¶ 13.

3. Patent Owner's Response

In response to Petitioner's challenge, Patent Owner presents the following arguments.³

- a. Whipple fails to disclose the claimed rod reducing device. Prelim. Resp. 27–35.
 - i. Petitioner improperly relies on two distinct embodiments of Whipple. Prelim. Resp. 28–31.
 - ii. Whipple fails to disclose a rod contact member positioned at the distal end of the rotatable member. *Id.* at 31–33.
 - iii. Whipple fails to disclose a rod contact member and rotatable member that are translatable within the plane defined by the first and second grasping members. *Id.* at 33–35.

³ In the interest of brevity we do not reproduce all of Patent Owner's arguments verbatim. We do, however, address them *infra*.

b. Petitioner fails to demonstrate that Whipple’s Figure 11A teaches a rod contact member and rotatable member that are translatable within the plane defined by the first and second grasping members.

Id. at 36.

i. Figure 11A of Whipple does not include a rotatable member.

Id. at 36–39.

ii. Figure 11A of Whipple does not disclose that the rod contact member and rotatable member are translatable within the plane defined by the first and second grasping members. *Id.*

at 39–41.

Patent Owner does not present arguments addressing the dependent claims. *See generally* Prelim. Resp. Rather, Patent Owner takes the position that none of the proposed grounds “invalidate any of the dependent claims in the ’816 Patent . . . [b]ecause the grounds fail to invalidate independent Claim 16.” *Id.* at 69.

4. Analysis

a. Alleged Failure to Disclose a Rod Reducing Device

i. Reliance on Two Distinct Embodiments

At this stage in the proceeding, we are not persuaded that Petitioner improperly relies on two distinct embodiments of Whipple. Patent Owner alleges that the embodiment illustrated by Whipple’s Figure 9 is distinct from the embodiment illustrated by Whipple’s Figures 1–6 and 13. *See* Prelim. Resp. 28.

Whipple describes Figure 9 as “a side view of another exemplary embodiment of an instrument for manipulating a spinal fixation element relative to a bone anchor, illustrating the coupling mechanism integrated into

an arm of the instrument.” Whipple ¶ 18. Further review of Whipple reveals that the alternative embodiments described therein refer to alternative embodiments of particular features such as the collar 102 and the handles 130, 132 of the instrument (features which are not relied upon in the challenge) rather than alternative embodiments of the entire instrument. *See, e.g., id.* ¶¶ 38, 43. Thus, it was reasonable for Petitioner to rely on Whipple’s Figure 9 for its teachings of how the rotatable member (tube 60) translates with respect to the plane defined by the first (arm 24) and second (arm 50) grasping members, as Figure 9 does not illustrate distinct embodiments of these features. *See* Pet. 19–20; *see also* Whipple ¶ 38 (describing alternative configurations of the collar 102 that do not appear to change the translation of the tube 60). Thus, Patent Owner’s argument is unconvincing.

ii. Alleged Failure to Disclose a Rod Contact Member

At this stage of the proceeding, Petitioner establishes a reasonable likelihood that Whipple discloses a rod contact member at the distal end of the rotatable member. Patent Owner states that “[c]laim 16 requires ‘a rod contact member positioned at a distal end of the rotatable member’ and a separate ‘rod contact member positioned at a distal end of the rotatable member.’” Prelim. Resp. 31. The distinction Patent Owner is attempting to identify is not clear on the record before us.

Patent Owner further states that “[t]he rod contact member is a term that is specifically recited in the claims as a component of the rod reduction device. Indeed, the rod contact member is listed as a separate claim element from the rotatable member . . . and these two elements ‘logically cannot be one and the same.’” *Id.* (citing *Engel Indus., Inc. v. Lockformer Co.*, 96 F.3d

1398, 1404–05 (Fed. Cir. 1996)). Thus, we understand Patent Owner to argue that the challenge relies on the same element in Whipple to meet two separate limitations of claim 16. Specifically, Patent Owner asserts that that “distal end 64 (*i.e.*, the alleged rod contact member) of the tube 60 (*i.e.*, the alleged rotatable member) and tube 60 are the same component.” Prelim. Resp. 32.

Patent Owner’s argument is unconvincing because claim 16 merely requires “a rod contact member positioned at a distal end of the rotatable member.” Ex. 1101, 10:30–31. Claim 16 does not preclude a rod contact member that is part of the rotatable member. Accordingly, at this stage of the proceeding, we are persuaded that Whipple meets the limitations pertaining to the rod contact member and rotatable member.

iii. Alleged Failure to Disclose a Rod Contact Member and Rotatable Member Translatable in a Plane as Claimed

At this stage of the proceeding, Petitioner establishes a reasonable likelihood that Whipple discloses a rod contact member and rotatable member that are translatable within a plane defined by the first and second grasping members. The claim language at issue encompasses more than one plane. For example, as shown in the annotated versions of Whipple’s Figures 2 and 4 reproduced *supra*, Whipple’s first and second grasping members define a plane in which Whipple’s rod contact member (distal end 64) and rotatable member (tube 60) are translatable. Patent Owner’s arguments otherwise are unconvincing based on the record before us.

b. Allegation that Whipple Fails to Teach Rotatable Member and Rod Contact Member Translatable Within a Plane Defined by the First and Second Grasping Members

i. Alleged Failure of Whipple's Figure 11A to Include a Rotatable Member

At this stage of the proceeding, Petitioner establishes a reasonable likelihood that Whipple discloses a rotatable member. Patent Owner argues that Whipple's Figure 11A fails to disclose a rotatable member. Prelim. Resp. 36–39. Patent Owner's argument is inapposite, as the challenge identifies Whipple's tube 60 as corresponding to the claimed rotatable member and tube as shown, for example, in Whipple's Figure 2. We are unaware of any requirement that every feature discussed in a challenge be shown in every figure relied upon in that challenge. Thus, Appellant's argument is unconvincing.

ii. Alleged Failure of Whipple's Figure 11A to Show that the Rod Contact Member and Rotatable Member are Translatable in the Plane as Claimed

At this stage of the proceeding, Petitioner establishes a reasonable likelihood that Whipple discloses a rod contact member and rotatable member translatable in a plane defined by the first and second grasping members. Prelim. Resp. 39–41. As discussed *supra*, we are unaware any requirement that every claimed feature be shown in every figure relied upon in Petitioner's challenge. Further, as the Petitioner indicates which features are relied upon to meet this limitation, we are not persuaded Petitioner improperly relied upon the Declaration as alleged by Patent Owner. *See* Prelim. Resp. 39; *see also* Pet. 14–15. We are also not persuaded that, as

argued by Patent Owner, Whipple's Figure 11A shows that the rod contact member translates in a plane perpendicular to the plane claimed. *See* Prelim. Resp. 40–41. As discussed *supra*, the claim language at issue encompasses more than one plane. Accordingly, Patent Owner's arguments are unconvincing.

For the foregoing reasons, we are persuaded at this stage of the proceeding by Petitioner's submission that Whipple (specifically including the embodiment shown in Figure 11A) discloses each and every limitation of claim 16. Further, Patent Owner does not present arguments with respect to dependent claims 18, 19, 21, and 22, and we are also persuaded that Petitioner establishes a reasonable likelihood that this embodiment of Whipple discloses each and every limitation of these claims as well.

III. CONCLUSION

Having concluded that Petitioner has demonstrated a reasonable likelihood that it will prevail at least with regards to its challenge with respect to at least claim 16 on the first proposed ground, we exercise our discretion and institute review on all claims and all grounds. We remind the parties that we have not yet made a final determination as to the patentability of any challenged claims.

IV. 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 as to claims 16, 18, 19, 21, and 22 on all grounds raised in the Petition; and

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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.

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