

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

PAINTEQ, LLC,
Petitioner,

v.

ORTHOCISION, INC.,
Patent Owner.

IPR2023-00477
Patent 11,083,511 B2

Before ZHENYU YANG, JAMES A. WORTH, and
MICHAEL A. VALEK, *Administrative Patent Judges*.

VALEK, *Administrative Patent Judge*.

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

I. INTRODUCTION

In IPR2023-00451, PainTEQ, LLC (“Petitioner”) filed a petition (IPR2023-00451, Paper 1, “451 Petition”), seeking *inter partes* review of claims 1–23 of U.S. Patent No. 11,083,511 B2 (Ex. 1001, “the ’511 patent”). The petition filed in this proceeding (Paper 1, “477 Petition”) challenges the same claims of the same patent. *See* 477 Pet. 12. In its explanation of multiple petitions, Petitioner ranks the 451 Petition ahead of the 477 Petition. Paper 3, 2 (“Ranking”).

Concurrently with this decision, we have issued a decision in IPR2023-00451, instituting *inter partes* review of claims 1–23 of the ’511 patent based on the grounds in the 451 Petition. We have authority to determine whether to institute a *inter partes* review. *See* 35 U.S.C. § 314; 37 C.F.R. § 42.4(a). For the reasons provided below, we exercise our discretion under 35 U.S.C. § 314 to deny institution of *inter partes* review in this proceeding.

II. BACKGROUND

A. Real Parties in Interest

The parties identify themselves and Patent Owner’s exclusive licensee, Omnia Medical, LLC, as the only real parties-in-interest. Pet. 1; Paper 6, 1.

B. Related Matters

The parties identify *Omnia Medical, LLC v. PainTEQ, LLC*, Case No. 8:22-cv-00145-VMC-TGW (M.D. Fla.) as a related matter involving the ’511 patent. Pet. 2; Paper 6, 1.

The parties identify IPR2023-00451, which involves the same parties and challenges the same claims of the ’511 patent. 477 Pet. 9; Paper 5, 1.

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The parties also identify IPR2022-00335 as a proceeding involving the same parties and challenging related U.S. Patent No. 10,426,539. Pet. 1–2; Paper 6, 1.

Petitioner identifies U.S. Patent Nos. 10,993,757 and 9,119,732 as patents related to the '511 patent. 477 Pet. 8. In addition, the parties collectively identify the following related applications: U.S. Patent Application Nos. 17/364,906 (abandoned), 16/689,073, 17/864,367, and 17/745,896. 477 Pet. 8; Paper 5, 2.

C. The '511 Patent

The '511 patent issued on August 10, 2021 and is a continuation of an application filed on March 25, 2015 that issued as U.S. Patent No. 10,993,757 B2, which in turn is a continuation-in-part of an application filed on March 15, 2013 that issued as U.S. Patent No. 9,119,732 B2 (“Grandparent”) Ex. 1001, codes (45), (63).

The '511 patent is directed to “[a]n improved method of fusing the sacroiliac joint and tools for accomplishing the same.” Ex. 1001, Abstr. Figure 55 illustrates the sacroiliac joint (“SI joint”) and an implant used to fuse the joint and is reproduced below. *Id.* at 7:45–48.

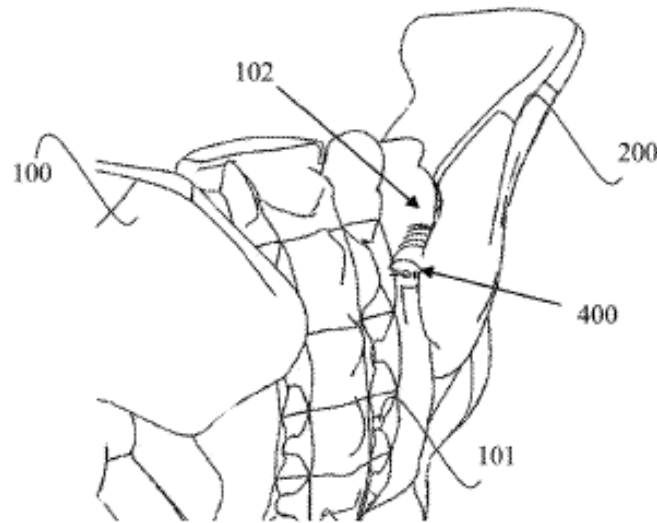


FIG. 55

Figure 55, above, “is an oblique, posterior view of the sacroiliac joint with a fusion implant having helical fixation elements placed in the sacroiliac joint through a posterior approach.” *Id.* In particular, Figure 55 depicts ilium or iliac wing (100), sacrum (101), iliac crest (200), sacroiliac joint (102) defined between the ilium and the sacrum, and fusion implant (400) in its desired operative position in the sacroiliac joint. *Id.* at 12:56–63, 24:4–6.

The Specification describes that the method is performed using a “working channel . . . for guiding other surgical tools for use in repairing an SI joint.” Ex. 1001, 13:49–50. Figure 30, reproduced below, show an embodiment of this working channel.

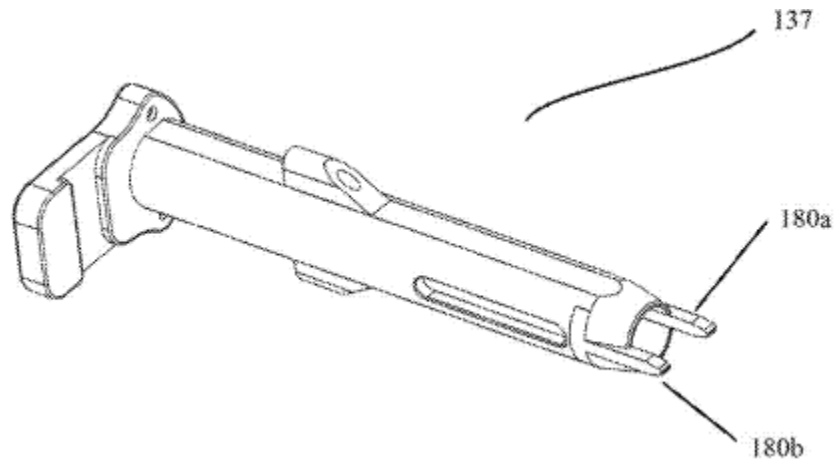


Figure 30, above, depicts a working channel with tangs 180a and 180b extending from its distal, insertable end to “allow the working channel to be more easily centered on the SI joint (e.g., with the tangs aligned along the plane between the articular surfaces of the SI joint)” and “to help stabilize the position of the working channel in the SI joint.” *Id.* at 15:25–35. The working channel has a hollow barrel as shown in Figure 29, which is reproduced below.

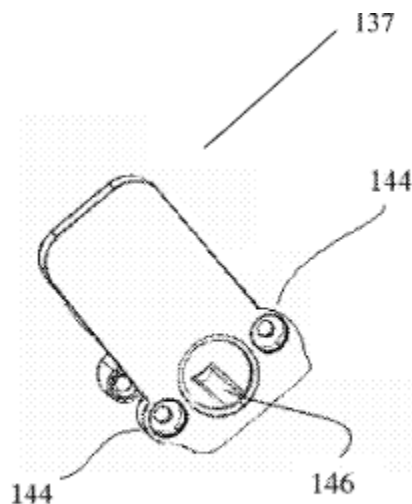


FIG. 29

Figure 29 shows a view of working channel 137 from the top with a hollow barrel that allows surgical tools to be inserted down the channel. The

working channel depicted in Figure 29 has a slot 146 on the interior of the barrel. *Id.* at 14:44–50. According to the Specification, tools used with the working channel “may have a protrusion that is complementary to the slot 146, such that the slot is effective in controlling a dept to which the surgical implement can be inserted” and to “ensure that such surgical implements . . . are and remain properly oriented in the hollow barrel of the working channel.” *Id.* at 14:50–57.

D. Challenged Claims

The 477 Petition challenges claims 1–23. Independent claim 1 is illustrative for purposes of this decision and is reproduced below with the same bracketed annotations Petitioner uses to identify particular limitations.

1. [1 pre] A method for repairing a sacroiliac joint of a patient, comprising:
 - [1 a] creating a first incision proximal to the patient’s sacroiliac joint;
 - [1 b.1] inserting a working channel into said first incision,
 - [1 b.2] said working channel having a hollow barrel
 - [1 b.3] with an interior guidance slot in an interior diameter of the hollow barrel that does not traverse an outer diameter of said hollow barrel for controlling the advancement of surgical tools passed through said working channel, and
 - [1 b.4] having at least one tang on a distal end thereof;
 - [1 c] creating a void in said sacroiliac joint; and
 - [1 d.1] inserting a fusion implant into said void,
 - [1 d.2] wherein said fusion implant includes at least one protrusion that engages with bone tissue in an articular surface of at least one of the sacrum and the ilium of said sacroiliac joint thereby preventing pullout of the fusion implant.

Ex. 1001, 41:64–42:13.

E. Asserted Grounds of Unpatentability

Petitioner asserts the following grounds of unpatentability:

Claim(s) Challenged	35 U.S.C. §	Reference(s)/Basis
1–5, 8, 9	103	Stoffman, ¹ McCormack ²
6, 7, 10–23	103	Stoffman, McCormack, and Stark ³

Petitioner further relies on the declaration of Dr. Christopher J. Bovinet (Ex. 1002).

III. DISCRETION UNDER 35 U.S.C. § 314(a)

Institution of *inter partes* review is discretionary. *See* 35 U.S.C. § 314(a); *SAS Inst. Inc. v. Iancu*, 138 S. Ct. 1348, 1356 (2018) (explaining that section “314(a) invests the Director with discretion on the question whether to institute review”) (emphasis omitted). Our discretionary determination whether to institute review takes into consideration guidance in the Patent Trial and Appeal Board Consolidated Trial Practice Guide November 2019 (“Trial Practice Guide”⁴).

The Trial Practice Guide addresses the situation here where the same petitioner has filed parallel petitions challenging the same claims of the same patent. *See* Trial Practice Guide, 59–61. It explains that:

[b]ased on the Board’s experience, one petition should be sufficient to challenge the claims of a patent in most situations. Two or more petitions filed against the same patent at or about the same time (e.g., before the first preliminary response by the patent owner) may place a substantial and unnecessary burden on the Board and the patent owner and could raise fairness, timing, and efficiency concerns. *See* 35 U.S.C. § 316(b). In

¹ US 2014/0207240 A2, published July 24, 2014 (Ex. 1005) (“Stoffman”).

² US 2010/0191241 A1, published July 29, 2010 (Ex. 1006) (“McCormack”).

³ US 2009/0216238 A1, published Aug. 27, 2009 (Ex. 1007) (“Stark”).

⁴ Available at <https://www.uspto.gov/sites/default/files/documents/tpgnov.pdf>.

addition, multiple petitions by a petitioner are not necessary in the vast majority of cases.

Trial Practice Guide, 59 (emphasis omitted). The Trial Practice Guide recognizes that “there may be circumstances in which more than one petition may be necessary, including, for example, when the patent owner has asserted a large number of claims in litigation or when there is a dispute about priority date requiring arguments under multiple prior art references.” *Id.* However, it notes that such circumstances are “rare.” *Id.*

“To aid the Board in determining whether more than one petition is necessary,” the petitioner should provide: “(1) a ranking of the petitions in the order in which it wishes the Board to consider the merits” and “(2) a succinct explanation of the differences between the petitions, why the issues addressed by the differences are material, and why the Board should exercise its discretion to institute additional petitions if it identifies one petition that satisfies petitioner’s burden under 35 U.S.C. § 314(a).” Trial Practice Guide, 60. The patent owner may then respond, indicating “among other issues . . . whether the differences identified by the petitioner are directed to an issue that is not material or not in dispute.” *Id.* “For example, the patent owner may seek to avoid additional petitions by proffering a stipulation . . . that certain references qualify as prior art.” *Id.* at 61. We then consider these submissions in determining whether to exercise discretion under 35 U.S.C. § 314(a). *Id.*

Per our guidance, Petitioner here provides an “Explanation of Parallel Petitions” that ranks the 451 Petition ahead of the 477 Petition. Ranking, 2. However, Petitioner asserts that there is a priority date dispute that is critical for the 451 Petition because it governs whether one of the

references asserted there—Lins—qualifies as prior art to the challenged claims. *Id.* According to Petitioner,

[t]he relative weakness of the [451] Petition is due to Lins’s status as prior art being contingent upon Petitioner prevailing in the priority date dispute. However, other than its status as prior art, Lins is an incredibly strong reference against the ’511 Patent and provides . . . three compelling reasons as to why the Petitioner ranks the [451] Petition as the “number one.”

Id. at 4. Nevertheless, Petitioner contends it “is compelled to file the [477] Petition, which does not rely on Lins, because of the ’511 Patent’s disputed priority date.” *Id.* at 5.

Patent Owner did not file a Preliminary Response and did not initially respond to Petitioner’s Ranking. We issued an order observing that it was “unclear whether there is a dispute as to the status of Lins as prior art to the challenged claims” because the only basis for Petitioner’s assertion that there was such a dispute was a statement “made by Patent Owner’s licensee [that] does not clearly take a position as to whether the challenged claims are entitled to the benefit of the earlier filing date” necessary to antedate Lins. IPR2023-00451, Paper 8, 2. Accordingly, we asked “Patent Owner to file a response to Petitioner’s Ranking, indicating whether it disputes Petitioner’s argument that Lins qualifies as prior art to the challenged claims.” *Id.* at 3. Patent Owner timely responded to our order with a single-sentence response stipulating that Patent Owner “will not dispute that [Lins] qualifies as prior art.” IPR2021-00451, Paper 9, 1.⁵

⁵ Petitioner subsequently sought authorization to file a reply brief to Patent Owner’s response, asserting that it “believes that the guidance provided by the USPTO Director Katherine Vidal in *CommScope Techs. LLC v. Dali Wireless, Inc.* [IPR2022-01242, Paper 23, 4] applies not only to parallel

In view of the present circumstances, Petitioner has not persuaded us that this is one of those “rare” circumstances when the institution of two concurrently filed parallel petitions challenging the same claims is warranted. *See* Trial Practice Guide, 59. The Trial Practice Guide acknowledges that “when there is a dispute about priority date . . . two petitions by a petitioner may be needed,” but that is not the case here. The only reason Petitioner offers for why we should institute a second proceeding is the possibility that Patent Owner could demonstrate that Lins does not qualify as prior art. *See* Ranking, 2–4. However, as explained in our decision granting institution of the 451 Petition, we agree with Petitioner’s showing that none of the challenged claims are entitled to claim the benefit of the March 15, 2013 filing date of the Grandparent of the ’511 patent, and thus Lins qualifies as prior art. Moreover, Patent Owner has stipulated that it will not dispute that Lins qualifies as prior art. IPR2023-00451, Paper 9, 1. Thus, there is no dispute regarding the priority date that might affect the status of Lins or any of the other references in IPR2023-00451 as prior art.⁶

district court litigation but also to parallel IPR petitions” and that “the Board should apply the compelling merits test to the parallel petition filed in IPR2023-00477.” Ex. 3001, 1. We denied Petitioner’s request for several reasons: (1) the decision Petitioner cites addresses parallel district court litigation and not the present circumstances, (2) Petitioner has already had an opportunity to explain why it believes a second petition is needed, and (3) the additional briefing Petitioner sought would go well beyond replying to the single-sentence stipulation in Patent Owner’s response. *See id.* (noting that “good cause for additional briefing has not been shown”).

⁶ All of the other references asserted in the 451 Petition predate the filing of the Grandparent application.

Moreover, Petitioner has given us no reason to think that it would prevail on the 477 Petition in the event Petitioner is unsuccessful in proving the grounds in the 451 Petition. Aside from the question of Lins's status as prior art, which has now been fully resolved in Petitioner's favor, Petitioner does not identify any substantive difference between the petitions that it believes favors the 477 Petition. *See* Ranking, 4–5. To the contrary, Petitioner asserts that the 451 Petition is its “number one” petition precisely because it considers Lins to be an “incredibly strong reference.” *Id.* at 4. Based on the current record, we agree with Petitioner's assessment of the relative strength of its two petitions.

Petitioner's argument that its “two parallel petitions do not impose an undue burden” because “each petition sets forth only a single invalidity ground against each challenged claim” is unavailing. Ranking, 5. It is beyond dispute that instituting a second IPR proceeding will result in additional burden on Patent Owner and the Board. *See* Trial Practice Guide, 59. The question is whether that additional burden is warranted by the circumstances. Given that the only rationale Petitioner offers for filing the 477 Petition is now moot, we are not persuaded to undertake the burden of a second trial proceeding between the same parties challenging the same patent claims. *See* Trial Practice Guide at 59 (“[O]ne petition should be sufficient to challenge the claims of a patent in most situations. Two or more petitions filed against the same patent at or about the same time . . . may place a substantial and unnecessary burden on the Board and the patent owner.”).

For the foregoing reasons, Petitioner has not sufficiently justified the need for two petitions. In light of the totality of the circumstances, including

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that we are concurrently instituting review of the same challenged patent claims in IPR2023-00451, we exercise our discretion to decline institution in this proceeding. 35 U.S.C. § 314(a).

IV. CONCLUSION

Pursuant to 35 U.S.C. § 314(a), we decline to institute this proceeding.

V. ORDER

In consideration of the foregoing, it is hereby:

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

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