

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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SMITH & NEPHEW, INC.,  
Petitioner,

v.

CONFORMIS, INC.,  
Patent Owner.

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Case IPR2017-00511  
Patent No. 7,981,158 B2

Before PATRICK R. SCANLON, JAMES A. WORTH, and  
AMANDA F. WIEKER, *Administrative Patent Judges*.

WIEKER, *Administrative Patent Judge*.

ORDER  
Granting Joint Motion to Limit the Petition  
*37 C.F.R. § 42.20*

In this proceeding, we instituted an *inter partes* review as to claims 66–72 and 81, under 35 U.S.C. § 103(a), as unpatentable over CAOS, Woolson, and Alexander. Paper 9 (“Dec. on Inst.”), 27. We did not institute an *inter partes* review as to claims 73–80, under 35 U.S.C. § 103(a), as unpatentable over CAOS, Woolson, Alexander, and Radermacher. However, subsequent to the decision of the U.S. Supreme Court in *SAS Institute Inc. v. Iancu*, 138 S. Ct. 1348 (2018), we modified our Decision on Institution to include the ground challenging claims 73–80. Paper 42 (modifying the Decision on Institution to include all claims and all grounds presented in the Petition).

On May 11, 2018, with our prior authorization, the parties filed a Joint Motion to Limit the Petition. Paper 44; *see also* Paper 43, 6. Specifically, the parties “jointly request that the Board remove claims 73–80 and Ground 2 from the Petition.” Paper 44, 1 (citing Pet. 56–77). Removing grounds from dispute, pursuant to a joint request of the parties, serves our overarching goal of resolving this proceeding in a just, speedy, and inexpensive manner. 37 C.F.R. § 42.1(b); *see, e.g., Apotex Inc., v. OSI Pharms., Inc.*, Case IPR2016-01284 (PTAB Apr. 3, 2017) (Paper 19) (granting, after institution, a joint motion to limit the petition by removing a patent claim that was included for trial in the institution decision); *SAS*, 138 S. Ct. at 1357.

Accordingly, we *grant* the Joint Motion to Limit the Petition. As such, the challenge to claims 73–80 is removed from dispute in this proceeding. The sole ground of unpatentability remaining in dispute is the challenge to claims 66–72 and 81, based on obviousness under 35 U.S.C. § 103(a), over CAOS, Woolson, and Alexander. The supplemental briefing

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schedule ordered for claims 73–80 is moot. Paper 43, 6.

In consideration of the foregoing, it is hereby:

ORDERED that the Joint Motion to Limit the Petition is *granted*;

FURTHER ORDERED that the Petition is limited to the ground of unpatentability asserted against claims 66–72 and 81, based on obviousness under 35 U.S.C. § 103, over CAOS, Woolson, and Alexander.

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