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On behalf of **Smith & Nephew, Inc.**

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SMITH & NEPHEW, INC.,
Petitioner,

v.

CONFORMIS, INC.,
Patent Owner.

IPR2017-00778

IPR2017-00779

IPR2017-00780¹

Patent 8,062,302 B2

**SMITH & NEPHEW'S SUPPLEMENTAL REPLY TO
CONFORMIS'S SUPPLEMENTAL PATENT OWNER RESPONSE**

¹ Pursuant to the Decision instituting trial, a word-for-word identical paper is filed in each proceeding identified in the caption. Each petition is identified herein as Pet1, Pet2, and Pet3, respectively.

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I. CLAIMS 13, 18, AND 38 ARE UNPATENTABLE

Claims 13 and 18 are crucial because they are the only newly instituted claims that ConforMIS asserts in the co-pending litigation. Despite the importance of those claims, ConforMIS elected not to file any evidence to attempt to show that these claims are patentable. Instead, ConforMIS relies entirely on attorney argument and the Board's *preliminary* findings in its Institution Decision and its Decision Denying Smith & Nephew's Request for Rehearing (collectively, the "Preliminary Decisions").

ConforMIS's reliance on the Preliminary Decisions is misplaced for several reasons. First, those decisions did not address the threshold issue of whether the additional limitations would have been obvious in view of Radermacher. That argument was fully explained in the petition and supported by the testimony of Dr. Mabrey. Moreover, ConforMIS's expert, Dr. Clark, *admitted that these limitations would have been obvious in view of Radermacher alone*. Thus, both experts agree, and the only evidence of record conclusively establishes, that these claims are unpatentable.

Second, ConforMIS's Supplemental POR hinges on the Board's *preliminary* findings regarding a purported lack of motivation to combine Radermacher and Kenna. But the Board now has the benefit of a full record and a better understanding of ConforMIS's patent, the prior art, and the proposed combination. As the

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