

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SMITH & NEPHEW, INC.,
Petitioner,

v.

CONFORMIS, INC.,
Patent Owner.

Case IPR2017-00778 (Patent 8,062,302 B2)
Case IPR2017-00779 (Patent 8,062,302 B2)
Case IPR2017-00780 (Patent 8,062,302 B2)¹

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

SCANLON, *Administrative Patent Judge*.

DECISION

Denying Patent Owner's Request for Rehearing
37 C.F.R. § 42.71

¹ We exercise our discretion to issue a common paper in each proceeding with a joint caption. The parties are not authorized to do the same.

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I. INTRODUCTION

In each of these proceedings, on August 7, 2017, we issued a Decision on Institution instituting an *inter partes* review as to claims 1–3, 5–8, 11, 20, 21, 24, 25, 28–37, 39–43, 47, and 95–125 of U.S. Patent No. 8,062,302 B2 (Ex. 1001², “the ’302 patent”). Paper 7 (“Dec.”). In our Decision on Institution, we determined that Petitioner had established a reasonable likelihood of prevailing in its challenge of claims 1–3, 5–8, 11, 20, 21, 24, 25, 28–37, 39–43, 47, and 95–125 under 35 U.S.C. § 103(a) as unpatentable over Radermacher, Alexander, and Woolson. Dec. 40. We did not institute an *inter partes* review as to claims 13, 18, and 38, under 35 U.S.C. § 103(a), as unpatentable over Radermacher, Alexander, Woolson, and Kenna; claims 1–3, 5–8, 11, 13, 18, 20, 21, 24, 25, 28, 29, 34–38, and 47 as unpatentable over Radermacher, Fell, Woolson, and Kenna; claims 9, 10, and 12 as unpatentable over Radermacher, Alexander, and Woolson; claims 14–17 and 19 as unpatentable over Radermacher, Alexander, Woolson, Kenna, and Hofmann; claims 9, 10, 12, 14–17, 19, 30–33, and 39–43 as unpatentable over Radermacher, Fell, Woolson, Kenna, and Hofmann; and claims 95–125 as unpatentable over Radermacher, Fell, and Woolson. *Id.* at 21–24, 26–32, 39.

On April 27, 2018, the panel entered, for each of these proceedings, an Order that modified the Decision on Institution to include review of all challenged claims and all grounds presented in the Petition, in accordance

² As the pertinent papers in all three proceedings are the same or substantially similar, we refer herein to the papers filed in IPR2017-00778 for convenience.

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with the U.S. Supreme Court’s decision in *SAS Institute Inc. v. Iancu*, 138 S. Ct. 1348 (2018). Paper 36. On May 18, 2018, after a conference call held between the panel and counsel for the parties, the panel entered, for each of these proceedings, a subsequent Order that authorized the parties to conduct supplemental activity (including a Supplemental Patent Owner Response and a Supplemental Reply) with respect to the newly added challenges. Paper 39. On May 24, 2018, following another conference call between the panel and counsel for the parties, the panel entered, for each of these proceedings, an additional Order that altered the schedule and some parameters for the supplemental activity. Paper 40.

On June 1, 2018, Patent Owner requested rehearing, in each of these proceedings, of our Orders of May 18, 2018, and May 24, 2018.³ Paper 43 (“Rehearing Request” or “Reh. Req.”). Petitioner requested, via email, authorization to file a response to Patent Owner’s Rehearing Requests. This request is denied because additional briefing on this issue is not necessary.

For the reasons set forth below, Patent Owner’s Rehearing Request is *denied*.

II. STANDARD OF REVIEW

A party requesting rehearing bears the burden of showing the decision should be modified. 37 C.F.R. § 42.71(d). In particular, “[t]he request must specifically identify all matters the party believes the Board misapprehended or overlooked, and the place where each matter was previously addressed in a motion, an opposition, or a reply.” *Id.* When considering a request for

³ For convenience, we will adopt Patent Owner’s convention and refer to these two Orders as the “Additional Briefing Orders.” *See* Reh. Req. 1.

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rehearing of a *decision on petition* (i.e., a decision on whether to institute trial), the Board reviews its decision for an abuse of discretion. 37 C.F.R. § 42.71(c). An abuse of discretion may arise if the decision is based on an erroneous interpretation of law, if a factual finding is not supported by substantial evidence, or if an unreasonable judgment is made in weighing relevant factors. *Star Fruits S.N.C. v. U.S.*, 393 F.3d 1277, 1281 (Fed. Cir. 2005); *Arnold P'ship v. Dudas*, 362 F.3d 1338, 1340 (Fed. Cir. 2004); *In re Gartside*, 203 F.3d 1305, 1315–16 (Fed. Cir. 2000).

III. ANALYSIS

Patent Owner's Rehearing Request largely relies on its assertion that the Additional Briefing Orders misinterpret the SAS decision, causing the Board to abuse its discretion by:

(1) instituting grounds that the Board already found fail the statutory requirements, thereby giving Petitioner a third opportunity to argue in favor of grounds the Board has already twice rejected as deficient in violation of 37 C.F.R. § 42.23(b); (2) untimely instituting review in violation of 35 U.S.C. § 314(b); and (3) instituting redundant grounds not required by SAS.

Reh. Req. 1; *see also id.* at 5 (making similar argument that the Board improperly instituted grounds that were previously not instituted).

Although Patent Owner ostensibly requests rehearing of the Additional Briefing Orders, each of the actions by the Board that Patent Owner asserts to be abuses of discretion relate to our post-SAS decision to modify our Decision on Institution to institute on all of the claims and grounds presented in the Petition. This decision, however, was made in our Order of April 27, 2018, and not in either of the Additional Briefing Orders.

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Should Patent Owner have wished to file a request for rehearing of our Order of April 27, 2018, Patent Owner must have filed such a request within 14 days of the entry of that Order. 37 C.F.R. § 42.71(d)(1). Accordingly, the due date for any request for rehearing of our Order of April 27, 2018, was May 11, 2018. As no extension of time was requested or granted, Patent Owner's Rehearing Request filed on June 1, 2018, to the extent it seeks review of our decision to modify our Decision on Institution to institute on all of the claims and grounds presented in the Petition, is untimely.

In addition to disputing our April 27, 2018 decision to modify our Decision on Institution, Patent Owner argues that "the Board compounded its abuse of discretion by granting Petitioner a 'Supplemental Reply' that permits Petitioner to 'respond to preliminary findings made by the Board in the Decision on Institution,' without citing any authority allowing for this significant departure from its own regulatory requirements." Reh. Req. 11 (citing Paper 39, 5). Patent Owner contends the Supplemental Reply violates 37 C.F.R. § 42.23(b). *Id.* at 12.

As a first point, Patent Owner asserts that "[r]equests for rehearing are reviewed for abuse of discretion." *Id.* at 5 (citing 37 C.F.R. § 42.71(c)). As noted above, however, § 42.71(c) provides that the abuse of discretion standard applies when rehearing *a decision on whether to institute trial*. The Additional Briefing Orders are not decisions on institution. Thus, to the extent that Patent Owner seeks review of the Additional Briefing Orders, Patent Owner's Rehearing Request is subject to 37 C.F.R. § 42.71(d), but not § 42.71(c). Patent Owner's Rehearing Request, however, does not

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