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Paper No. 78
Date: June 3, 2022

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SURGALIGN SPINE TECHNOLOGIES, INC.,
Petitioner,

v.

LIFENET HEALTH,
Patent Owner.

IPR2019-00570
Patent 8,182,532 B2

Before GEORGE R. HOSKINS, CHRISTOPHER C. KENNEDY, and ALYSSA A. FINAMORE, *Administrative Patent Judges*.

HOSKINS, *Administrative Patent Judge*.

ORDER
Conduct of the Proceeding on Remand
37 C.F.R. § 42.5

I. DISCUSSION

The United States Court of Appeals for the Federal Circuit entered a judgment on April 11, 2022, which affirmed in part, reversed in part, and remanded the Board's Final Written Decision in this proceeding.[1] *See Surgalign Spine Techs., Inc., f/k/a RTI Surgical, Inc. v. Lifenet Health*, Nos. 2021-1117, 2021-1118, 2021-1236, 2022 WL 1073606 (Fed. Cir. Apr. 11, 2022) ("Federal Circuit Decision")[2]; Papers 71 & 74 (sealed and public versions of "Board Decision"). The Federal Circuit then issued its mandate on May 18, 2022.

"The Board has established a goal to issue decisions on remanded cases within six months of the Board's receipt of the Federal Circuit's mandate." PTAB Standard Operating Procedure 9 ("SOP 9"), 1.[3] "Parties in remanded **trial cases** are to contact the Board within **ten (10)** business days after the mandate issues to arrange a teleconference with the panel." *Id.* at 5. In preparation for this teleconference, "the Parties shall meet and confer in a reasonable and good faith attempt to propose a procedure on remand," including attempts to reach agreement on eleven potential remand procedures specified in SOP 9. *Id.* at 5–7.

The parties have conferred accordingly, and proffered via an email communication to the Board several periods of availability for a teleconference with the panel. The panel will hold a telephone conference

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[1] The Federal Circuit also affirmed the Board's Final Written Decision in a related proceeding, IPR2019-00569 concerning U.S. Patent No. 6,458,158 B1.

[2] This was a 2-1 decision by a three-judge panel. Our discussion refers to the two-judge, majority opinion.

[3] Available at https://www.uspto.gov/sites/default/files/documents/sop_9_%20procedure_for_decisions_remanded_from_the_federal_circuit.pdf.

with the parties on **June 14, 2022 at 10 a.m. Eastern Time**, using a telephone number and passcode that will be provided to the parties via email.

We have reviewed the Federal Circuit Decision and compared it with the Board Decision. Our preliminary views regarding what we must do on remand, subject to receiving the parties' input, are set forth below. We invite the parties to consider these preliminary views and determine whether they agree with them.

In this proceeding, Petitioner presented Grounds 1–9 of unpatentability. *See* Board Decision, 9–10. It appears that we must reconsider only Grounds 2 and 5 on remand.

Ground 1 posited the unpatentability of claims 12–21 of the '532 patent under 35 U.S.C. § 103(a) over Grooms, which the Board held was supported by a preponderance of the evidence. *See* Board Decision, 9, 29–45, 72. Patent Owner appealed from that decision to the Federal Circuit. *See* Paper 76. The Federal Circuit affirmed as to Ground 1. *See* Federal Circuit Decision, Section III. Therefore, we conclude we do not need to reconsider Ground 1 here on remand.

Ground 2 posited the unpatentability of claims 4 and 6–11 of the '532 patent under 35 U.S.C. § 103(a) over Grooms and McIntyre, and Ground 5 posited the unpatentability of claims 4, 6–9, and 11 of the '532 patent under 35 U.S.C. § 103(a) over Paul, McIntyre, and Coates. *See* Board Decision, 9. The Board held Petitioner had not demonstrated unpatentability in these two grounds. *See id.* at 46–49 (Ground 1), 51–53 (Ground 5), 72. Petitioner appealed from that decision to the Federal Circuit. *See* Paper 75.

The Federal Circuit reversed the Board Decision as to these two grounds, focusing on the Board's application of the "plate-like" claim limitation to Grooms and Paul. *See* Federal Circuit Decision, Section I. In particular, the Federal Circuit stated: "The evidence and arguments presented to the Board *support only one possible evidence-supported finding*: that substantial evidence does not support the Board's determination that Grooms and Paul do not teach 'plate-like' bone portions when the correct construction is employed," and "[o]n remand, the Board should proceed to analyze the remaining issues raised by Grounds 2 and 5." *Id.* at pg. 16 & n.6 (emphasis added).

Therefore, we conclude we need to reconsider Grounds 2 and 5 here on remand. Specifically, we must take as given that Grooms and Paul both disclose plate-like first and second cortical bone portions, as recited in '532 patent claim 4. Then, we must evaluate the remainder of Petitioner's case for unpatentability of claims 4 and 6–11 as set forth in Grounds 2 and 5, and Patent Owner's opposition to those grounds.

The Patent Owner Response appears to raise four arguments in opposition: [1] the Grooms and Paul cancellous bone portions are both not "disposed between" first and second cortical bone portions as required by claim 4; [2] Grooms and Paul both lack plate-like cortical bone portions; [3] Grooms and Paul both lack through-holes in a graft unit to accommodate one or more pins; and [4] secondary considerations of non-obviousness. *See* Paper 29, 14–26 (claim construction), 34–39 (Ground 2), 41–43 (Ground 5), 66–76 (secondary considerations). We preliminarily conclude the Federal Circuit Decision resolved the first argument against Patent Owner in Section III, and resolved the second argument against Patent Owner in

Section I. Thus, on remand, we will not consider Patent Owner's first and second arguments, but we will consider Patent Owner's third and fourth arguments.

As to Grounds 3, 4, 6, and 7, the Board Decision did not reach any of these grounds, because all of the claims subject to these grounds were also subject to Ground 1 in which Petitioner had prevailed in showing unpatentability. *See* Board Decision, 50–51 (Grounds 3 and 4), 54–55 (Grounds 6 and 7), 72–73. As discussed above, the Federal Circuit affirmed the Board Decision as to Ground 1. Therefore, we conclude we do not need to reconsider Grounds 3, 4, 6, and 7 on remand.

Grounds 8 and 9 posited obviousness theories based on Wolter as a leading prior art reference. *See* Board Decision, 10. The Board held Petitioner had not demonstrated unpatentability in these two grounds. *See, e.g.*, *id.* at 73. Petitioner appealed from that decision to the Federal Circuit. *See* Paper 75. The Federal Circuit affirmed as to these two grounds. *See* Federal Circuit Decision, Section II (affirming the Board Decision as to claims 4 and 6–11 of the '532 patent being "not unpatentable over several combinations where Wolter is the primary reference"). Therefore, we conclude we do not need to reconsider Grounds 8 and 9 on remand.

II. ORDER

In consideration of the foregoing, it is hereby:

ORDERED that the Board will hold a telephone conference with the parties on **June 14, 2022 at 10 a.m. Eastern Time**, using a telephone number and passcode that will be provided to the parties via email;

FURTHER ORDERED that, if either party desires to discuss any additional issues regarding this proceeding during the teleconference, the

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