

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

VETERINARY ORTHOPEDIC IMPLANTS, INC.,
Petitioner,

v.

DEPUY SYNTHES PRODUCTS, INC.,
Patent Owner.

IPR2019-01331
Patent 8,523,921 B2

Before HYUN J. JUNG, CHRISTOPHER G. PAULRAJ, and
TIMOTHY G. MAJORS, *Administrative Patent Judges*.

MAJORS, *Administrative Patent Judge*.

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

I. INTRODUCTION

Veterinary Orthopedic Implants, Inc. (“Petitioner”),¹ on July 15, 2019, filed a Petition to institute *inter partes* review of claims 1–11 of U.S. Patent No. 8,523,921 (Ex. 1001, “the ’921 patent”). Paper 2 (“Pet.”). DePuy Synthes Products, Inc. (“Patent Owner”) filed a Preliminary Response to the Petition. Paper 7 (“Prelim. Resp.”). We granted (Paper 11) Petitioner’s request to file a pre-institution Reply to Patent Owner’s Preliminary Response. Paper 12. We also permitted Patent Owner to file a Sur-Reply to Petitioner’s authorized Reply. Paper 14.

Patent Owner disclaimed claims 10, 11, and 15–18 of the ’921 patent. *See* Ex. 2023, 1; Prelim. Resp. 9 n.2; 37 C.F.R. § 42.107(e) (2019); 35 U.S.C. § 253; *Vectra Fitness, Inc. v. TWNK Corp.*, 162 F.3d 1379, 1383 (Fed. Cir. 1998) (“This court has interpreted the term ‘considered as part of the original patent’ in section 253 to mean that the patent is treated as though the disclaimed claims never existed.”). Among the claims challenged in this Petition, claims 10 and 11 are disclaimed and, thus, *inter partes* review cannot be instituted on those claims. *See* 37 C.F.R. § 42.107(e) (“No *inter partes* review will be instituted on disclaimed claims.”); *see, e.g., Paragon 28, Inc. v. Wright Med. Tech., Inc.*, IPR2019-00894, Paper 17 at 29 (PTAB Sept. 25, 2019) (instituting review on some claims but not those that were disclaimed because “we conclude we cannot institute a trial on claims that have been disclaimed, and, thus, no longer exist”); *Gen. Elec. Co. v. United Techs. Corp.*, IPR2017-00491, Paper 9 at 2–3 (PTAB July 6, 2017)

¹ Petitioner identifies itself as the real party-in-interest. Pet. 68.

(precedential) (determining review cannot be instituted where all claims are disclaimed).

Under 35 U.S.C. § 314(a), *inter partes* review may not be instituted unless the Petition “shows that there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.” For reasons discussed below, we do not institute review of claims 1–9 of the ’921 patent.

A. Related Proceedings

The ’921 patent issued September 3, 2013, from U.S. Patent Application No. 11/361,245 (“the ’245 Application”), filed February 24, 2006. Ex. 1001, at [21], [22], [45]. Petitioner identifies the following related applications:

US Patent Application No. 13/538,407, filed June 29, 2012 (hereafter “the ’407 Application”), which is a child application to the ’921 patent; and

US Patent Application No. 16/031,792, filed July 10, 2018 (hereafter “the ’792 Application”), which is a grand-child application to the ’921 patent.

Pet. 10, 15–20. Both of the above related applications are pending before the U.S. Patent and Trademark Office. *Id.* at 15–20. In addition, Petitioner identifies U.S. Design Patent Application No. 29/656,918, which issued July 2, 2019. *Id.* at 69; *see also* Prelim. Resp. 13 (identifying U.S. Patent No. D852957).

Petitioner further states that it is a defendant in a pending litigation concerning the ’921 patent: *Depuy Synthes Products, Inc. v. Veterinary*

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Orthopedic Implants, Inc., 3:18-cv-01342-HES-PDB (M.D. Fla.). Pet. 68.

Patent Owner, for its part, also identifies a separate lawsuit between Petitioner and Patent Owner on the related and above-noted design patent. Prelim. Resp. 13; Ex. 2020 (Complaint for Design Patent Infringement, Case No. 3:19-cv-00801-MMH-JRK (M.D. Fla., filed July 3, 2019)). According to Patent Owner, Petitioner has since agreed to have judgment taken against it for infringement of the design patent, including an injunction barring further manufacture and sale of Petitioner's infringing designs. Prelim. Resp. 15; Ex. 2021 (notice of the executed offer of judgment).

Petitioner concurrently filed two additional petitions for *inter partes* review of the '921 patent (IPR2019-01332 (challenging claims 12–18) and IPR2019-01333 (challenging claims 19 and 20)). *See* Prelim. Resp. 1.

B. Asserted Grounds of Unpatentability

Petitioner asserts two grounds of unpatentability in this Petition (Pet. 1–3), which are identified in the table below:

Claims Challenged	35 U.S.C. §	References
1–11 ²	103(a) ³	Young, ⁴ Forstein, ⁵ O’Driscoll ⁶
1–11	103(a)	Weaver, ⁷ Forstein, O’Driscoll, Young

Petitioner also relies on the declarations of Dr. Jeffrey N. Peck and Troy D. Drewry, among other evidence. Ex. 1005 (“Peck Decl.”); Ex. 1027 (“Drewry Decl.”). Patent Owner, in its Preliminary Response, cites the declarations of Dr. Michael P. Kowaleski and Timothy Horan, among other evidence. Ex. 2022 (“Kowaleski Decl.”); Ex. 2112 (“Horan Decl.”).

² Claims 10 and 11 are disclaimed as noted above.

³ The Leahy-Smith America Invents Act, Pub. L. No. 112-29, 125 Stat. 284 (2011) (“AIA”), amended 35 U.S.C. §§ 102 and 103. Because the claims of the ’921 patent have an effective filing date before the effective date of the applicable AIA amendments, we refer to the pre-AIA version of 35 U.S.C. § 103 throughout this Decision.

⁴ Young, US 2005/0015089 A1, published Jan. 20, 2005 (Ex. 1008, “Young”).

⁵ Forstein, US 2006/0173458 A1, published Aug. 3, 2006 (Ex. 1006, “Forstein”).

⁶ O’Driscoll, WO 2004/024009 A1, published Mar. 25, 2004 (Ex. 1012, “O’Driscoll”).

⁷ Weaver, WO 01/19267 A1, published Mar. 22, 2001 (Ex. 1010, “Weaver”). Petitioner states that a counterpart (U.S. Patent No. 6,623,486) to Weaver was cited during prosecution of the ’921 patent. Pet. 11.

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