

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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LANTZ MEDICAL, INC.,  
Petitioner,

v.

BONUTTI RESEARCH, INC.,  
Patent Owner.

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Case IPR2015-00995  
Patent 7,404,804 B2

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Before HYUN J. JUNG, SCOTT A. DANIELS, and JAMES A. TARTAL,  
*Administrative Patent Judges.*

TARTAL, *Administrative Patent Judge.*

DECISION

Denying Institution of *Inter Partes* Review  
*37 C.F.R. § 42.108*

Petitioner, Lantz Medical, Inc., filed a Revised Petition requesting an *inter partes* review of claim 1 of U.S. Patent No. 7,404,804 B2 (“the ’804 patent”). Paper 4 (“Pet.”). Patent Owner, Bonutti Research, Inc., filed a Preliminary Response. Paper 9 (“Prelim. Resp.”). We have jurisdiction under 35 U.S.C. § 314(a), which provides that an *inter partes* review may not be instituted “unless . . . the information presented in 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.”

Upon consideration of the Petition and the Preliminary Response, we conclude the information presented does not show a reasonable likelihood that Petitioner would prevail in showing the unpatentability of the challenged claim. Accordingly, we do not authorize an *inter partes* review to be instituted as to any claim of the ’804 patent.

## I. BACKGROUND

### A. *The ’804 Patent (Ex. 1001)*

The ’804 patent, titled “Finger Orthosis,” issued July 29, 2008, from U.S. Application No. 11/181,238, filed July 14, 2005. Ex. 1001. The ’804 patent describes a splint with an adjustable finger support for a joint of the finger. Ex. 1001, 1:23–24.

Figure 1 of the '804 patent is reproduced below.

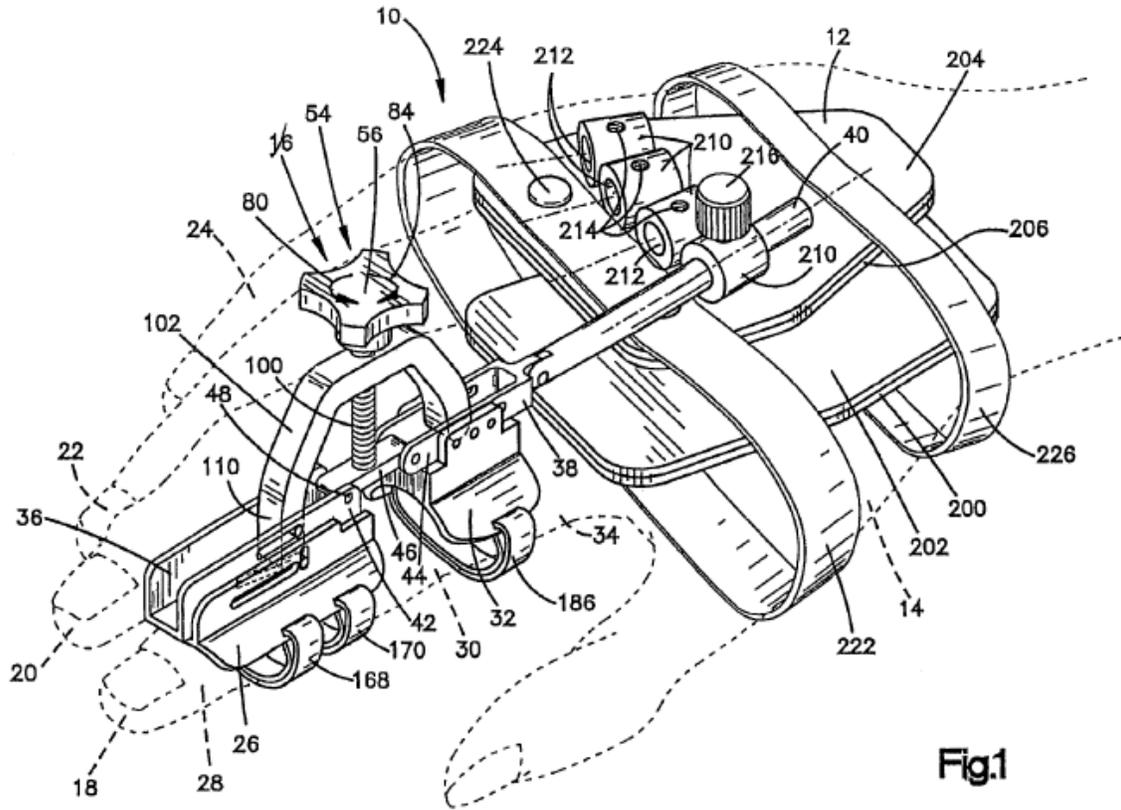


Fig1

Figure 1 shows orthosis 10, including handcuff 12 and bending mechanism 16, operable to move a joint of a finger. Ex. 1001, 2:12–15. Finger cuffs 26 and 32 connect to first and second portions of finger 18. *Id.* at 21–25. Actuator mechanism 54 transmits force to pivot simultaneously cuff arms 36 and 38 about pivot connections 48 and 50 and to move finger cuffs 26 and 32 along the cuff arms. *Id.* at 48–51.

*B. Illustrative Claims*

Claim 1 of the '804 patent is independent and provides as follows.

1. A finger orthosis for positioning a joint in a finger on a hand of a patient, the finger orthosis comprising:  
a hand cuff positionable on the hand of the patient: and  
a bending mechanism removably attachable to the finger  
and selectively attachable to the hand cuff, and including  
first and second bending portions and a force transmitting  
mechanism connected to and interposed between  
the first and second bending portions.

Ex. 1001, 9:2–9.

*C. Related Proceedings*

The parties indicate that the '804 patent is a subject of the following civil action: *Bonutti Research, Inc., v. Lantz Medical, Inc.*, Case No. 1:14-cv-00609 (S.D. Ind.). Pet. 4; Paper 8, 2.

*D. Asserted Grounds of Unpatentability*

Petitioner contends that claim 1 of the '804 patent is unpatentable as “anticipated pursuant to 35 U.S.C. §102(a) and (b) by U.S. Patent 5,683,351 ([“Kaiser,”] Exhibit 1008), issued November 4, 1997; and by the JACE H440, Hand-CPM Softgoods Splint Kit (Exhibit 1009) on sale at least as early as 1994 – and the JACE H440’s brochure.” Pet. 6–7. Exhibit 1009 is apparently referred to in the Petition as both the “JACE H440’s brochure” and the “JACE H440 operating manual.” See Pet. 14.

## II. ANALYSIS

### A. *Claim Construction*

The Board interprets claims of an unexpired patent using the broadest reasonable construction in light of the specification of the patent in which they appear. 37 C.F.R. § 42.100(b); *see In re Cuozzo Speed Techs., LLC*, 793 F.3d 1268, 1278 (Fed. Cir. 2015) (“We conclude that Congress implicitly approved the broadest reasonable interpretation standard in enacting the AIA.”).

Petitioner proposes an express construction for “orthosis.” Pet. 9. Patent Owner disputes Petitioner’s proposed construction as overly broad and unsupported by the specification. Prelim. Resp. 4. The term “orthosis” appears only in the preamble to claim 1. “If . . . the body of the claim fully and intrinsically sets forth the complete invention, including all of its limitations, and the preamble offers no distinct definition of any of the claimed invention’s limitations, . . . then the preamble is of no significance to claim construction because it cannot be said to constitute or explain a claim limitation.” *Pitney Bowes, Inc. v. Hewlett-Packard Co.*, 182 F.3d 1298, 1305 (Fed. Cir. 1999) (citations omitted). The body of claim 1 fully and intrinsically sets forth the complete invention; therefore, the use of “orthosis” in the preamble does not serve as a limitation and need not be construed.

Petitioner further contends that the broadest reasonable construction of various terms is “at least as broad as what the Patentee is asserting in the pending litigation.” Pet. 9. Patent Owner agrees. Prelim. Resp. 4–5. We determine that no express construction of any claim term is necessary.

*B. Anticipation by Kaiser*

Petitioner contends claim 1 of the '804 patent is anticipated by Kaiser. Pet. 12. Petitioner provides virtually no discussion of Kaiser. Instead, Petitioner provides a series of conclusory statements pertaining to each element of the claim. *Id.* at 12–14. For example, the Petition states:

Claim 1 of the '804 patent further recites “a bending mechanism removably attachable to the finger.” Using Patentee’s analysis of this Claim (Exhibit 1007), the '351 patent (Exhibit 1008) discloses this element of Claim 1 of the '804 patent at Col. 4, Lines 35–49; Figs. 12–14 (100). (Exhibit 1010, ¶ 22).

Pet. 13. Petitioner also provides a claim chart which, for the same claim limitation, simply states “U.S. Patent 5,683,351 (Col. 4, ll.35–49 and Figs. 12–14 (100)).” Pet. 11.

Petitioner’s unexplained allegations fall far short of demonstrating a reasonable likelihood that Petitioner would prevail in showing the unpatentability of the challenged claim. A petition for *inter partes* review must identify how the construed claim is unpatentable under the statutory grounds on which the petitioner challenges the claims. 37 C.F.R. § 42.104(b)(4). Furthermore, 37 C.F.R. § 42.22(a)(2) states that each petition must include “[a] full statement of the reasons for the relief requested, including a detailed explanation of the significance of the evidence including material facts, and the governing law, rules, and precedent.”

We will not speculate as what is meant in the Petition by “[u]sing Patentee’s analysis of this Claim,” but note that Petitioner’s apparent reliance only on a citation to Exhibit 1007 is improper as “[a]rguments must

not be incorporated by reference from one document into another document.” 37 CFR § 42.6(a)(3). Further, the Declaration of Renee D. Rogge, Ph.D., cited in the Petition (Exhibit 1010, ¶ 22) with respect to the limitation discussed above, simply repeats the text that appears in the Petition with no additional explanation. Providing broad notice of Petitioner’s allegations with virtually no supporting evidence or explanation is generally not sufficient to institute trial in an *inter partes* review proceeding as it leaves both the Board and Patent Owner in the untenable position of either evaluating or responding to incompletely formed arguments and arguably ambiguous assertions. The patent rules promulgated for AIA post-grant proceedings, including those pertaining to institution, are “construed to secure the just, speedy, and inexpensive resolution of every proceeding.” 37 C.F.R. § 42.1(b); *see also* 35 U.S.C. § 316(b) (regulations for AIA post-grant proceedings take into account “the efficient administration of the Office” and “the ability of the Office to timely complete [instituted] proceedings”). The timeframe of an *inter partes* review does not afford Petitioner the luxury of supporting and explaining what it broadly alleges in its Petition later in the proceeding.

In the absence of any sufficient explanation of the significance of the evidence asserted by Petitioner, Petitioner has not demonstrated a reasonable likelihood that it would prevail in showing that claim 1 is anticipated by Kaiser.

C. *Anticipation by the JACE H440, Hand-CPM Softgoods Splint Kit or the “JACE H440 operating manual” (Exhibit 1009)*

Petitioner contends that claim 1 of the ’804 patent is invalid as anticipated “in view of the JACE H440 and its operating manual.” Pet. 15.

The scope of an *inter partes* review is limited. In particular, 35 U.S.C. § 311(b) provides:

SCOPE.—A petitioner in an inter partes review may request to cancel as unpatentable 1 or more claims of a patent only on a ground that could be raised under section 102 or 103 and only on the basis of prior art consisting of patents or printed publications.

Accordingly, to the extent Petitioner relies on a device, the JACE H440, Hand-CPM Softgoods Splint Kit, as an anticipatory reference, Petitioner fails to set forth a ground of unpatentability for purposes of *inter partes* review.

With respect to Petitioner’s contention that claim 1 is anticipated by JACE H440 operating manual, Petitioner’s unexplained allegations again fall far short of demonstrating a reasonable likelihood that Petitioner would prevail in showing the unpatentability of the challenged claim.

First, Petitioner provides no explanation or evidence to support the contention that the JACE H440 operating manual is a printed publication, stating only that the JAC H440 “was on sale at least as early as 1992 – the date of publication of the operating manual.” Pet. 14.

The determination of whether a given reference qualifies as a prior art “printed publication” involves a case-by-case inquiry into the facts and circumstances surrounding the reference’s disclosure to members of the public. *In re Klopfenstein*, 380 F.3d 1345, 1350 (Fed. Cir. 2004). The key inquiry is whether the reference was made “sufficiently accessible to the public interested in the art” before the critical date. *In re Cronyn*, 890 F.2d 1158, 1160 (Fed. Cir. 1989); *In re Wyer*, 655 F.2d 221, 226 (CCPA 1981). “A given reference is ‘publicly accessible’ upon a satisfactory showing that

such document has been disseminated or otherwise made available to the extent that persons interested and ordinarily skilled in the subject matter or art exercising reasonable diligence, can locate it.” *Bruckelmyer v. Ground Heaters, Inc.*, 445 F.3d 1374, 1378 (Fed. Cir. 2006) (citation omitted).

Although Petitioner contends that JACE H440 was on sale more than one year before the earliest effective filing date of the ’804 patent, Petitioner has not provided sufficient evidence to support a threshold showing that the JACE H440 operating manual is a printed publication before the critical date.

Second, Petitioner provides virtually no discussion of the JACE H440 operating manual. Instead, Petitioner provides a series of conclusory statements pertaining to each element of the claim. Pet. 15–16. For example, the Petition states:

Claim 1 of the ’804 patent further recites “a bending mechanism removably attachable to the finger.” Using Patentee’s analysis of this Claim (Exhibit 1007), the JACE H440 (Exhibit 1009) discloses this element of Claim 1 of the ’804 patent at Figures 10, 11, 12, and 13. (Exhibit 1010, ¶ 30).

Pet. 15. Petitioner also provides a claim chart which, for the same claim limitation, simply states “JACE H440, Hand-CPM Softgoods/Splint Kit 1992 Operating Manual (Figs. 10, 11, 12, and 13).” *Id.* at 11.

For the same reasons explained above with respect to the asserted ground based on Kaiser, Petitioner has not provided the required “detailed explanation of the significance of the evidence,” and, to the contrary, provides virtually no explanation at all. *See* 37 C.F.R. § 42.22(a)(2). Petitioner’s apparent attempt to incorporate Exhibit 1007 is also improper.

Finally, the Declaration of Renee D. Rogge, Ph.D., cited in the Petition (Exhibit 1010, ¶ 30) with respect to the limitation discussed above simply repeats the text that appears in the Petition with no additional explanation.

In the absence of any sufficient explanation of the significance of the evidence asserted by Petitioner, Petitioner has not demonstrated a reasonable likelihood that it would prevail in showing that claim 1 is anticipated by the JACE H440 operating manual.

### III. CONCLUSION

For the foregoing reasons, the information presented in the Petition and accompanying evidence does not establish a reasonable likelihood that Petitioner would prevail in showing the unpatentability of any claim of the '804 patent.

### IV. ORDER

In consideration of the foregoing, it is hereby:

ORDERED that the Petition is *denied* and no trial is instituted.

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PETITIONER:

Jacque R. Wilson  
Carson Boxberger LLP  
wilson@carsonboxberger.com

Cedric D'Hue  
D'Hue Law LLC  
cedric.dhue@dhuelaw.com

PATENT OWNER:

Elizabeth E. Fabick  
Michael J. Hartley  
Robert M. Evans, Jr.  
Senninger Powers LLP  
100 North Broadway, Suite 1700  
Saint Louis, MO 63102

Steven D. Groth  
Bose McKinney & Evans, LLP  
111 Monument Circle, Suite 2700  
Indianapolis, IN 46204

Paul D. Bianco  
Bonutti Research, Inc.  
21355 East Dixie Highway, Suite 115  
Miami, FL 33180