

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

WRIGHT MEDICAL TECHNOLOGY, INC.,
Petitioner,

v.

THE UNIVERSITY OF NORTH CAROLINA,
Patent Owner.

Case IPR2014-00626
Patent 6,955,677 B2

Before JOSIAH C. COCKS, MITCHELL G. WEATHERLY, and
ZHENYU YANG, *Administrative Patent Judges*.

YANG, *Administrative Patent Judge*.

DECISION
Order Denying Petitioner's Request for Rehearing
37 C.F.R. § 42.71

I. INTRODUCTION

Wright Medical Technology, Inc. (“Petitioner”) filed a Petition to institute an *inter partes* review of numerous claims of U.S. Patent No. 6,955,677 B2 (“the ’677 patent,” Ex. 1001). Paper 3 (“Pet.”). The Board instituted a review of the patentability of claims 1–4, 9, 18, 21–25, 28, 30, 31, 39–42, 54–57, 60, 62, 63, 71, and 72, but denied to review claims 11, 12, 33, 34, 43, 44, 47, 48, 65, 66, 73, and 74 (“non-instituted claims”). Paper 9 (“Decision”). Petitioner requests that we reconsider our decision not to institute review of the non-instituted claims. Paper 11 (“Reh’g Req.”).

For the following reasons, we deny Petitioner’s request.

II. STANDARD OF REVIEW

When rehearing a decision on institution, the Board reviews the decision for an abuse of discretion. 37 C.F.R. § 42.71(c). An abuse of discretion occurs when a “decision was based on an erroneous conclusion of law or clearly erroneous factual findings, or . . . a clear error of judgment.” *PPG Indus. Inc. v. Celanese Polymer Specialties Co.*, 840 F.2d 1565, 1567 (Fed. Cir. 1988) (citations omitted). The request must identify, specifically, all matters the party believes the Board misapprehended or overlooked. 37 C.F.R. § 42.71(d).

III. DISCUSSION

The non-instituted claims require that the tappable contact region comprises “a plurality of protrusions extending generally radially inwardly from the inside surface and a plurality of interstices between the protrusions.” Petitioner proposed that we construe “protrusion” to mean “any protruding form not forming a thread.” Pet. 15. We, instead, agreed

with Patent Owner that “protrusion” additionally does not include a continuous lip or ridge. Decision 10. As a result, we were not persuaded that the asserted prior art—showing only a continuous lip in the tappable contact region—teaches or suggests “a plurality of protrusions.” *Id.* at 17.

In its Request for Rehearing, Petitioner contends that we erroneously construed the term “protrusion.” Reh’g Req. 1–2. According to Petitioner, we erred in two fact findings and misapplied the claim construction standard. *Id.*

Petitioner argues that we first erred in finding that “the identified examples of protrusions in the specification ‘include **only** pegs, bristles, and tines . . . all of which **suggests** a continuous lip does not constitute a protrusion.” *Id.* at 3 (quoting Decision 10, emphases added by Petitioner). We disagree. The ’677 patent discloses that protrusions “can be provided in any protruding form, such as pegs, bristles or tines.” Ex. 1001, 7:23-24. Petitioner does not point to any other form listed as an example of a protrusion. As a result, we see no error in our finding that the examples of protrusions in the Specification include only pegs, bristles, and tines. Petitioner contends that “[u]se of the phrase ‘such as’ clearly shows that the examples are not exhaustive” Reh’g Req. 3. Petitioner is correct here; and we did not decide otherwise. Instead of finding the example list conclusively demonstrates that a continuous lip does not constitute a protrusion, we merely stated that it “suggests” so. Decision 10. The list is one, but not the sole, piece of evidence we consider in the claim construction.

Indeed, we found that elsewhere, “the Specification explicitly excludes continuous ridges or grooves as protrusions” because it discloses

forming protrusions by “cutting transversely through the ridges to discretize the ridges into protrusions.” *Id.* (citing Ex. 1001, 7:54–56). Petitioner contends that we committed the second error in finding so. Reh’g Req. 5. According to Petitioner, we erroneously concluded that a protrusion does not include a continuous lip or ridge based on “the permissive language describing some of the embodiments.” *Id.* (citing Decision 10). Petitioner contends that the Specification does not include an express disclaimer and thus, we cannot limit the scope of “protrusion” in our claim construction. *Id.* at 5–6. We disagree.

Properly framed, the legal issue is not whether the ’677 patent disclaims a continuous lip or ridge. In the Decision, because excluding a thread or a continuous lip or ridge from the scope of “protrusion” was sufficient for analyzing the non-instituted claims, we did not further address the term. Decision 10. We couched our construction with the phrase “does not include;” but that does not mean the ’677 patent must limit the scope of “protrusion” through a disclaimer. In fact, the Specification affirmatively limits protrusions as “a porous matrix of protrusions.” *See* Ex. 1001, Abstract. *See also* Figs. 2A–2D (showing all the embodiments containing protrusions universally disclose the matrix of protrusions appearing as a porous surface). Therefore, a continuous lip or ridge does not satisfy the porous requirement and thus, is not a protrusion. *See C.R. Bard, Inc. v. U.S. Surgical Corp.*, 388 F.3d 858, 866 (Fed. Cir. 2004) (limiting “plug” as having a “pleated surface” in view of the abstract and preferred embodiments).

The '677 patent discloses:

Protrusions 87 can be formed by any suitable means, such as growing protrusions 87 by material deposition, forming protrusions 87 by coating, welding protrusions 87 to inside surface 81, or forming ridges or grooves and subsequently cutting transversely through the ridges to discretize the ridges into protrusions 87.

Ex. 1001, 7:51–56. Petitioner is correct that the permissive language “can be formed” shows that the '677 patent does not exclude other methods to form protrusions. Reh’g Req. 5–6. But because protrusions exist as a porous matrix, without the subsequent transverse cutting to discretize the ridges, merely “forming ridges or grooves” would not form protrusions.

Petitioner also argues that we should not limit a claim term based on a particular embodiment. Reh’g Req. 7. Petitioner correctly recites the law on claim construction. But there is a fine line between construing the claims in light of the specification and improperly importing a limitation from the specification into the claims. *Phillips v. AWH Corp.*, 415 F.3d 1303, 1323–24 (Fed. Cir. 2005) (en banc). In our effort to construe the claims, we strive to capture the scope of the actual invention, rather than allow the claim language to become divorced from what the specification conveys is the invention. *Id.* at 1324.

The facts in this case are similar to those in *Watts v. XL Systems Inc.*, 232 F.3d 877 (Fed. Cir. 2000). In *Watts*, the Federal Circuit limited “sealingly connected” to “structures utilizing misaligned taper angles” even though the “preferred embodiment uses permissive language in describing the use of misaligned taper angles.” *Id.* at 882–83. The court concluded so because “[t]he specification does not explicitly discuss an embodiment without misaligned taper angles and . . . actually limits the invention to

embodiments with misaligned taper angles.” *Id.* at 883. Here, the ’677 patent discloses protrusions appearing as a porous surface in all the embodiments containing protrusions. Moreover, the Abstract—which summarizes the invention, not just an embodiment—also describes a matrix of porous protrusions. Again, because a continuous lip or ridge does not satisfy the porous requirement, it is not a protrusion.

Petitioner argues that the ’677 patent describes the protrusions broadly. Reh’g Req. 4, 6–7. For example, according to Petitioner, “the specification explicitly teaches that the density of the protrusions is ***not limited*** and could reach 100%.” *Id.* at 4 (citing Ex. 1001, 7:37–50). Petitioner contends that “a plurality of protrusions packed with a density of 100% in the radial direction would form a continuous ring or lip.” *Id.* We disagree. The protrusions, as described in the ’677 patent, do not exist in isolation. Instead, they define, and are defined by, the interstices between the protrusions. *See* Ex. 1001, 7:21–23. In fact, all the non-instituted claims recite “a plurality of interstices between the protrusions.” But if the plurality of protrusions were to cover 100% of the tappable contact region, as Petitioner asserts, the recited interstices would be missing. Thus, while Petitioner seeks an expansive construction, the Specification and the claims actually limit the scope of “protrusion.”

Petitioner alleges that we failed to apply the broadest-reasonable-interpretation standard for claim construction. Reh’g Req. 2. The proper standard requires that our construction be not only “broadest” but also “reasonable” in light of the specification of the patent in which it appears. 37 C.F.R. § 42.100(b). Indeed, the Federal Circuit has instructed repeatedly that any claim construction under this standard must be consistent with the

specification to avoid being unreasonably broad. *In re Suitco Surface, Inc.*, 603 F.3d 1255, 1260 (Fed. Cir. 2010); *In re Bond*, 910 F.2d 831, 833 (Fed. Cir. 1990). As explained above, consistent with the '677 patent Specification, a protrusion does not include a continuous lip or ridge. We see no clear error in our fact findings or conclusions of law. Petitioner has not demonstrated that we abused our discretion in denying institution of an *inter partes* review of claims 11, 12, 33, 34, 43, 44, 47, 48, 65, 66, 73, and 74 of the '677 patent.

IV. ORDER

Accordingly, it is

ORDERED that Petitioner's Request for Rehearing is *denied*.

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FOR PETITIONER:

Samuel Apicelli
swapicelli@duanemorris.com

Jarrad Gunther
jmgunther@duanemorris.com

Christopher Kroon
cskroon@duanemorris.com

FOR PATENT OWNER:

Joseph Zito
jzito@dnlzito.com

Benjamin Deming
bdemin@dnlzito.com

Paul Grandinetti
mail@levygrandinetti.com