

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GLOBUS MEDICAL, INC.,
Petitioner,

v.

DEPUY SYNTHES PRODUCTS, LLC,
Patent Owner.

Case IPR2015-00111
Patent 8,623,057 B2

Before BENJAMIN D. M. WOOD, SCOTT E. KAMHOLZ, and
MITCHELL G. WEATHERLY, *Administrative Patent Judges*.

WEATHERLY, *Administrative Patent Judge*.

DECISION

Denying Institution of *Inter Partes* Review
35 U.S.C. § 314(c) and 37 C.F.R. §§ 42.4, 42.108

I. INTRODUCTION

A. *Background*

Globus Medical, Inc. (“Globus”) filed a corrected petition (Paper 6, “Pet.”) to institute an *inter partes* review of claims 23–32 and 46–55 (the “challenged claims”) of U.S. Patent No. 8,623,057 B2 (Ex. 1001, “the

'057 patent"). 35 U.S.C. § 311. DePuy Synthes Products, LLC ("Synthes") timely filed a Preliminary Response. Paper 8 ("Prelim. Resp."). Institution of an *inter partes* review is authorized by statute when "the information presented in the petition filed under section 311 and any response filed under section 313 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." 35 U.S.C. § 314(a); *see* 37 C.F.R. § 42.108.

Globus contends that the challenged claims are unpatentable under 35 U.S.C. § 103 as obvious in view of U.S. Patent No. 7,931,675 B2 (iss. Apr. 26, 2011) ("Panjabi") (Ex. 1002) and U.S. Patent Pub. No. 2004/0143264 A1 ("McAfee") (Ex. 1005). Pet. 13–56. Generally, Synthes contends that the Petition should be denied in its entirety. For the reasons described below, we decline to institute an *inter partes* review of any of the challenged claims.

B. Related Proceedings

Globus identified as a related proceeding the co-pending district court proceeding of *DePuy Synthes Products, LLC v. Globus Medical, Inc.*, Case Number, C.A. No. 14-11-RGA (D. Del.), filed January 7, 2014. Pet. 2.

II. ANALYSIS

As a threshold matter, we must determine whether Globus has established that Panjabi is prior art to the challenged claims. On the record before us and for the reasons stated below, we conclude that Globus fails to do so.

Globus asserts that Panjabi is prior art but does not state expressly the effective date of Panjabi as prior art under 35 U.S.C. § 102(e). Pet. 3. Panjabi issued from U.S. App. No. 11/159,471 filed June 23, 2005, which

claims priority to U.S. Provisional App. No. 60/581,716 filed June 23, 2004 (“the ’716 Provisional”). Ex. 1001, cover page, 1:8–10. Under 35 U.S.C. § 102(e), “an applicant is not entitled to a patent if another’s patent discloses the same invention, which was carried forward from an earlier U.S. provisional application or U.S. non-provisional application.” *In re Giacomini*, 612 F.3d 1380, 1383 (Fed. Cir. 2010); *Ex parte Yamaguchi*, 88 USPQ2d 1606 (BPAI 2008) (precedential). Accordingly, the effective date of Panjabi as prior art under § 102(e) is the date on which an application in Panjabi’s priority chain was filed that discloses the information relied upon to prove unpatentability of the challenged claims.

Globus neither analyzes whether the ’716 Provisional discloses the subject matter recited in the challenged claims nor provides a copy of the ’716 Provisional for the record in this proceeding. *See generally*, Pet. (failing to cite any portion of ’716 Provisional or refer to an Exhibit that is a copy of ’716 Provisional). Therefore, for purposes of this decision, we accord June 23, 2005, the filing date of the application that issued as Panjabi, rather than the earlier filing date of the provisional application to which Panjabi claims priority, as the date on which Panjabi is effective as prior art under 35 U.S.C. § 102(e).

Globus states that “the earliest effective filing date for the claim[ed] inventions within the ’057 Patent is March 3, 2005.” Pet. 3 (citing Ex. 1003, U.S. App. No. 11/072,886 filed March 3, 2005). As Synthes argues, it is therefore undisputed that the challenged claims have priority no later than March 3, 2005. Prelim. Resp. 13. Because, on the current record, the priority of the challenged claims predates June 23, 2005, Globus has failed to establish that Panjabi is prior art to the challenged claims.

Globus relies upon the combination of Panjabi and McAfee as the basis for all its challenges to the patentability of the challenged claims. Pet. 13–56. Because Globus has failed to establish that Panjabi is prior art, Globus has failed to set forth a reasonable likelihood of prevailing in demonstrating that any of the challenged claims are unpatentable. Accordingly, we deny the Petition and do not institute an *inter partes* review of the challenged claims.

III. ORDER

For the reasons given, it is:

ORDERED that the Petition is *denied* and an *inter partes* review is not instituted with respect to any challenged claim.

IPR2015-00111
Patent 8,623,057 B2

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