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Paul Hastings Team Secures IPR Trial Win for Zimmer Biomet Holdings, Inc.

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On March 10, 2017, the Patent Trial and Appeal Board (“PTAB”) issued a decision in favor of Paul Hastings’ client Zimmer Biomet Holdings, Inc. (“Zimmer”), ruling that all challenged claims of U.S. Patent No. 8,821,582 (“the ‘582 patent”) are unpatentable.¹ The ‘582 patent, which is owned by Four Mile Bay, LLC (“FMB”), relates to hip implants with a porous metal structure that allows for bone ingrowth.

Zimmer filed a petition for *inter partes* review (“IPR”) challenging the asserted claims of the ‘582 patent on October 2, 2015.² The petition for IPR was filed after FMB filed a complaint asserting several claims of the ‘582 patent against Zimmer in the District Court for the Northern District of Indiana.³ The product accused of infringement in the district court action is Zimmer’s Trabecular Metal Primary Hip Prosthesis.

On April 1, 2016, the PTAB instituted review of all of the challenged claims based on several combinations of references including: (1) U.S. Patent No. 5,018,285 to Zolman (“the Zolman patent”) and U.S. Patent No. 3,906,550 to Rostoker (“the Rostoker patent”); and (2) the Zolman patent and J.D. Bobyn et al., “Characteristics of Bone Ingrowth and Interface Mechanics of a New Porous Tantalum Biomaterial,” *Journal of Bone and Joint Surgery*, Vol. 81-B, No. 5 (Sept. 1999) (“the Bobyn article”).⁴ After briefing and oral argument, the PTAB issued its final written decision finding that Zimmer had shown by a preponderance of the evidence that all of the challenged claims were obvious.⁵

For claims 1-5, 8-11, 14, 15, and 17-20, the PTAB held that, under its claim construction, the combination of the Zolman patent and the Rostoker patent disclosed a porous metal structure with a size and shape that “emulates” the size and shape of the porous structure of natural human bone.⁶ The PTAB also held that claims 1-5, 8-11, 13-15, and 17-20 were obvious based on a combination of the Zolman patent and the Bobyn article.⁷ Specifically, the PTAB found that “a [person having ordinary skill in the art] would have been motivated to use Bobyn’s porous tantalum material in Zolman’s porous pad in order to obtain the advantages of porous tantalum as taught by Bobyn.”⁸

The Paul Hastings team was led by Naveen Modi, Young J. Park, and Paromita (Mita) Chatterjee.





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¹ *Zimmer Biomet Holdings, Inc. v. Four Mile Bay LLC*, IPR2016-00012, Paper 34 (P.T.A.B. March 10, 2017).

² *Id.* at 2.

³ *Four Mile Bay LLC v. Zimmer Biomet Holdings, Inc.*, Civil Action No. 3:15-cv-00063(N.D. Ind.) (PPS)-(MGG).

⁴ IPR2016-00012, Paper 34 at 2.

⁵ *Id.* at 47.

⁶ *Id.* at 19-35.

⁷ *Id.* at 38-46.

⁸ *Id.* at 42.

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