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UNITED STATES DISTRICT COURT
SOUTHERN DISTRICT OF CALIFORNIA

WARSAW ORTHOPEDIC, INC.;
MEDTRONIC SOFAMOR DANEK
U.S.A., INC., MEDTRONIC PUERTO
RICO OPERATIONS CO.; and
OSTEOTECH, INC.,

Plaintiffs,

v.

NUVASIVE, INC.,

Defendant.

Case No.: 3:12-cv-02738-CAB (MDD)

**ORDER TO SUBMIT JOINT
STATEMENT REGARDING
STATUS OF LITIGATION**

The Court hereby directs the parties to submit a joint statement regarding the status of this litigation by **March 31, 2016**. The Court last received a joint status report on April 28, 2015. [Doc. No. 260.] The docket currently reflects the following status of the various patents asserted in this litigation.

I. Warsaw’s Asserted Patents

Plaintiffs (collectively “Warsaw”) filed this action asserting infringement of four patents against defendant NuVasive: U.S. Patent Nos. 8,021,430; 8,251,997; 8,444,696 and 5,676,146.

1 On May 30, 2013, the Court entered a stay of the litigation as to Warsaw's '430
2 patent. The parties notified the Court that all claims of this patent were cancelled by the
3 PTO on August 26, 2013. As a result, this patent is dismissed from this litigation.

4 On October 30, 2013, the Court enter a stay of the litigation as to Warsaw's '997
5 patent in favor of IPR proceedings. The Court understands the final decisions of the PTO
6 are on appeal to the Federal Circuit.

7 On January 10, 2014, the Court enter a stay of the litigation as to Warsaw's '696
8 patent in favor of IPR proceedings. All asserted claims were found unpatentable by the
9 PTO and no appeal was taken. As a result, this patent is dismissed from this litigation.

10 On February 17, 2016, the Court entered an order of summary judgment of non-
11 infringement in favor of NuVasive on Warsaw's '146 patent. As a result, this patent is
12 dismissed from this litigation.

13 In light of the above, the parties are instructed to apprise the Court on the current
14 status of the '997 patent.

15 **II. NuVasive's Asserted Patents**

16 Defendant NuVasive filed counterclaims asserting infringement of eight patents
17 against Warsaw: U.S. Patent Nos. 8,000,782; 8,005,535; 8,016,767; 8,192,356;
18 8,187,334; 8,361,156; D652,922; and D666,294.

19 On September 3, 2013, the parties jointly moved to dismiss NuVasive's '294
20 patent from the litigation.

21 On October 20, 2015, the Court entered an order of summary judgment of non-
22 infringement in favor of Warsaw on NuVasive's '922 patent. As a result, this patent is
23 dismissed from this litigation.

24 On January 10, 2014, the Court enter a stay of the litigation as to NuVasive's
25 remaining patents in favor of IPR proceedings. As for April 28, 2015, the parties
26 reported the following status on these six patents:

- 27 • The PTO found all asserted claims of the '782, '535, '767, '334, and '156
28 patents unpatentable.

- IPR was not instituted as to asserted claims 25 and 26 of the '356 patent.

These claims depend from claim 21 which the PTO found unpatentable.

The 2015 status report indicated appellate review would be sought on the PTO final decisions. The parties are instructed to apprise the Court on the current status of the '782, '535, '767, '334, and '156 patents. With regard to the '356 patent, the parties should address whether continuation of the stay is appropriate.

IT IS SO ORDERED.

Dated: March 1, 2016



Hon. Cathy Ann Bencivengo
United States District Judge