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PUERTO RICO OPERATIONS CO.; OSTEOTECH,
9 INC.; MEDTRONIC, INC.; MEDTRONIC
SOFAMOR DANEK DEGGENDORF, GMBH;
10 MEDTRONIC LOGISTICS, LLC; MEDTRONIC
XOMED, INC.; and SPINALGRAFT
11 TECHNOLOGIES, LLC

12
13 **UNITED STATES DISTRICT COURT**
14 **SOUTHERN DISTRICT OF CALIFORNIA**

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

18 Plaintiffs,

19 vs.

20 NUVASIVE, INC.,

21 Defendant.

22
23 AND RELATED COUNTERCLAIMS.

) CASE NO. 3:12-cv-02738-CAB (MDD)

) **MEMORANDUM OF POINTS AND**
) **AUTHORITIES IN SUPPORT OF**
) **MOTION FOR CLARIFICATION**
) **AND RECONSIDERATION OF**
) **ORDER GRANTING DEFENDANT’S**
) **MOTION FOR SUMMARY**
) **JUDGMENT OF NON-**
) **INFRINGEMENT OF THE ’146**
) **PATENT**

) Date: April 12, 2016
) Judge: Hon. Cathy Ann Bencivengo
) Courtroom: 4C

) PER CHAMBERS, NO ORAL
) ARGUMENT UNLESS ORDERED BY
) THE COURT

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1 **I. INTRODUCTION**

2 On February 17, 2016, the Court granted NuVasive's Motion for Summary
3 Judgment of Non-Infringement of the '146 patent.¹ (Doc. 271 ("Summary Judgment
4 Order").)² In doing so, the Court revised its earlier *Markman* Order (Doc. 143)
5 construction of claim terms because of arguments that Warsaw made during parallel
6 '146 patent reexamination proceedings before the United States Patent and Trademark
7 Office ("PTO"). Warsaw asks for reconsideration of the Court's Summary Judgment
8 Order in three respects:³ (1) reconsideration of the Court's interpretation of Warsaw's
9 arguments to the PTO; (2) clarification of the Court's revised claim construction; and
10 (3) reopening of discovery to address material differences between the Court's revised
11 construction on summary judgment and its original *Markman* Order construction.

12 Generally speaking, the '146 patent captures the benefits of demineralized and
13 mineralized allograft bone in an implant that both promotes bone growth and can
14 serve as a marker after surgical implantation. Demineralized allograft bone promotes
15 superior bone growth, but lacks structural support and does not appear in a radiograph
16 because it is radiolucent; mineralized allograft bone was used in certain circumstances
17 to provide structural support, but is not as effective as demineralized bone at
18 promoting bone growth. In the prior art, mineralized allograft bone was typically
19 placed into the surgical site, followed separately by the addition of demineralized
20 allograft bone in the form of a glycerol gel that was injected into the site using a
21 syringe. Dr. Scarborough, the '146 patent inventor, recognized that although
22 mineralized allograft bone was not as effective at promoting bone growth, it can be
23 seen in a radiograph because it is radiopaque, and can thus act as a "marker." By
24

25 ¹ U.S. Patent No. 5,676,146.

26 ² All citations to the record are based on original e-filing docket numbers.

27 ³ Warsaw takes issue with other aspects of the Court's Summary Judgment
28 Order, such as its consideration and treatment of facts, but does not address them on
reconsideration. Of course, depending on any clarification of the Court's claim
construction, Warsaw may ask the Court to revisit its assessment of the discovery
record.

1 claiming a combination of the two that is either “uniformly distributed” or a
2 “substantially uniform admixture” (the “Uniformity Limitations”), the ’146 patent
3 yields a mixture that promotes better bone growth and can serve as a marker for the
4 implant as a whole.

5 After this suit was filed, the PTO reexamined the ’146 Patent at NuVasive’s
6 request. NuVasive submitted prior art combinations of mineralized and demineralized
7 bone it claimed invalidated the patent. Warsaw and its expert Dr. Barton Sachs
8 differed. Warsaw pointed out that none of the prior art of record taught any mixing of
9 mineralized and demineralized bone, or reasonably suggested combining the art in any
10 manner that would achieve the claimed uniformity. They maintained that, even if the
11 prior art taught mixing of mineralized and demineralized bone—and it did not—any
12 teaching of mixing *without an additional disclosure* of mixing to the point of a
13 uniform or substantially uniform mixture—or any indication of what the final result of
14 the mixing would be—would not teach the Uniformity Limitations because mixing
15 alone does not *necessarily* yield a uniform mixture.⁴ Expressly acknowledging that
16 the ’146 claims are agnostic to how the Uniformity Limitations are created, the PTO
17 agreed: “[t]he ’146 patent specification mentions a grid pattern for the uniform
18 distribution; while this grid pattern is not claimed and the prior art is not required to
19 disclose a grid or any other configuration, the term mixing alone does not achieve a
20 uniformly distributed arrangement of one type of particle relative to the other type of
21 particle.” (Doc. 229-6, Ex. 62 (PTO Notice of Intent to Issue Reexamination
22 Certificate) at 239; *see also* Declaration of Nimalka Wickramasekera in Support of

23 ⁴ Indeed, the law of invalidity provides that prior art does not inherently disclose
24 a claimed feature unless that claimed feature is *necessarily* present: “[A] prior art
25 reference may anticipate without disclosing a feature of the claimed invention if that
26 missing characteristic is necessarily present, or inherent, in the single anticipating
27 reference.” *Verizon Servs. Corp. v. Cox Fibernet Virginia, Inc.*, 602 F.3d 1325, 1337
28 (Fed. Cir. 2010) (citation omitted); *see also In re Armodafinil Patent Litig. Inc.*, 939
F. Supp. 2d 456, 465 (D. Del. 2013) (“A reference includes an inherent characteristic
if that characteristic is the ‘natural result’ flowing from the reference’s explicitly
explicated limitations. The mere fact that a certain thing may result from a given set
of circumstances is not sufficient.”) (internal citations omitted).

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