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17 **UNITED STATES DISTRICT COURT**
18 **SOUTHERN DISTRICT OF CALIFORNIA**

19 WARSAW ORTHOPEDIC, INC.;
20 MEDTRONIC SOFAMOR DANÉK
U.S.A., INC.; MEDTRONIC PUERTO
21 RICO OPERATIONS CO.; and
OSTEOTECH, INC.,

22 Plaintiffs,

23 vs.

24 NUVASIVE, INC.,

25 Defendant.

26 AND RELATED COUNTERCLAIMS.
27

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

**JOINT STATEMENT REGARDING
STATUS OF PATENTS IN
LITIGATION**

1 Pursuant to the Court’s March 1 and March 24, 2016 Orders, the Parties submit
2 this Joint Status Report as to the Patent and Trademark Office proceedings for U.S.
3 Patent Nos. 8,251,997; 8,000,782; 8,005,535; 8,016,767; 8,192,356; 8,187,334; and
4 8,361,156. (*See* Dkts. 272, 277.)

5 **1. Warsaw U.S. Patent No. 8,251,997 (“Method for inserting an
6 **artificial implant between two adjacent vertebrae along a coronal
7 **plane**”)****

8 As the Parties previously informed the Court, for Warsaw’s ’997 patent, both
9 NuVasive and Warsaw have appealed the PTAB’s final written decisions finding
10 some claims patentable and other claims unpatentable. Those appeals were
11 consolidated into one case. Appeal briefing concluded on February 12, 2016. The
12 case is now awaiting an oral argument date from the Federal Circuit.

13 **2. NuVasive U. S. Patent No. 8,000,782 (“System and methods for
14 **performing surgical procedures and assessments**”)**

15 As the Parties previously informed the Court, for NuVasive’s ’782 patent, the
16 PTAB issued its Final Written Decision finding all asserted claims unpatentable.
17 NuVasive has appealed and its opening briefing was filed in December 2015.
18 Medtronic, Inc.’s responsive brief is due April 27, 2016. The Parties expect briefing
19 to conclude in the late spring or early summer of 2016, with oral argument before the
20 Federal Circuit to follow shortly thereafter. The appeal on the ’782 patent is a
21 companion to appeals on the ’535, ’767, and ’356 patents as described herein and all
22 are proceeding on the same schedule.

23 **3. NuVasive U.S. Patent No. 8,005,535 (“System and methods for
24 **performing surgical procedures and assessments**”)**

25 As the Parties previously informed the Court, for NuVasive’s ’535 patent, the
26 PTAB issued its Final Written Decision finding all asserted claims unpatentable.
27 NuVasive has appealed and its opening briefing was filed in December 2015.
28 Medtronic, Inc.’s responsive brief is due April 27, 2016. The Parties expect briefing

1 to conclude in the late spring or early summer of 2016, with oral argument before the
2 Federal Circuit to follow shortly thereafter. The appeal on the '535 patent is a
3 companion to appeals on the '782, '767, and '356 patents as described herein and all
4 are proceeding on the same schedule.

5 **4. NuVasive U.S. Patent No. 8,016,767 (“Surgical access system and
6 related methods”)**

7 As the Parties previously informed the Court, for NuVasive’s '767 patent, the
8 PTAB issued its Final Written Decision finding all asserted claims unpatentable.
9 NuVasive has appealed and its opening appeal briefing was filed in December 2015.
10 Medtronic, Inc.’s responsive brief is due April 27, 2016. The Parties expect briefing
11 to conclude in the late spring or early summer of 2016, with oral argument before the
12 Federal Circuit to follow shortly thereafter. The appeal on the '767 patent is a
13 companion to appeals on the '782, '535, and '356 patents as described herein and all
14 are proceeding on the same schedule.

15 **5. NuVasive U.S. Patent No. 8,192,356 (“Surgical access system and
16 related methods”)**

17 As the Parties previously informed the Court, for NuVasive’s '356 patent, the
18 PTAB issued its Final Written Decision finding claims 21-22, 24, 30, and 33-37
19 unpatentable.¹ IPR was not instituted as to claim 25 (currently non-asserted)² and
20 claim 26 (currently asserted). NuVasive has appealed the Final Written Decision and
21 its opening appeal briefing was filed in December 2015. Medtronic, Inc.’s responsive
22 brief is due April 27, 2016. The Parties expect briefing to conclude in the late spring
23 or early summer of 2016, with oral argument before the Federal Circuit to follow
24 shortly thereafter. The appeal on the '356 patent is a companion to appeals on the
25 '782, '535, and '767 patents as described herein and all are proceeding on the same

26 ¹ The asserted claims from the '356 patent are 21, 26, 34, 35, and 37.

27 ² Claim 25 was originally asserted but dropped to reduce the number of claims
28 pursuant to court order.

1 schedule.

2 The Parties agree that continued stay of the '356 patent is appropriate, at least
3 until resolution of the current appeal pertaining to the '356 patent.³

4 **6. NuVasive U.S. Patent No. 8,187,334 (“System and methods for spinal
5 fusion”)**

6 As the Parties previously informed the Court, for NuVasive’s '334 patent, the
7 PTAB issued its Final Written Decision finding all currently asserted claims
8 unpatentable.⁴ The Parties also previously informed the Court that NuVasive
9 appealed and Medtronic, Inc. cross-appealed. In those appeals, briefing is in progress
10 and is likely to conclude in the late spring or early summer of 2016. The appeals on
11 the '334 patent are companion to the appeal on the '156 patent as described herein and
12 will be argued together.

13 **7. NuVasive U.S. Patent No. 8,361,156 (“Systems and methods for
14 spinal fusion”)**

15 As the Parties previously informed the Court, for NuVasive’s '156 patent, the
16 PTAB issued is Final Written Decision finding all asserted claims unpatentable. The
17 Parties also previously informed the Court that NuVasive appealed. Appeal briefing
18 has concluded and the Parties are currently awaiting an oral argument date from the
19 Federal Circuit.

20 **8. Plaintiffs’ Statement Regarding U.S. Patent No. 5,676,146.**

21 In the Court’s March 1, 2016 Order, it stated that the '146 patent is dismissed
22 from this litigation as a result of the Court’s order of summary judgment of non-
23 infringement. (Dkt. 272 at 2.) However, Plaintiffs believe dismissal at this time is

24 _____
25 ³ In reaching this agreement regarding a continued stay of the '356 patent,
26 NuVasive notes that it has relied upon Warsaw’s representations that a continued stay
of the '997 patent is similarly appropriate.

27 ⁴ The PTAB confirmed patentability of claim 18 of the '334 patent. The asserted
28 claims from the '334 patent are 1, 16, 22, 24 and 28. Claim 18 was originally asserted
but dropped to reduce the number of claims pursuant to court order.

1 premature in light of their pending motion for clarification and reconsideration of that
2 summary judgment order. (See Dkt. 273.)

3
4 DATED: April 12, 2016

Respectfully submitted,

KIRKLAND & ELLIS LLP

6 /s/ Sharre Lotfollahi

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14 MEDTRONIC, INC.; and MEDTRONIC
15 SOFAMOR DANEK DEGGENDORF,
16 GMBH; MEDTRONIC LOGISTICS, LLC;
17 MEDTRONIC XOMED, INC.; AND
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