EXHIBIT 3
(PART 4)

TO THE DECLARATION OF BRIAN J. NISBET IN SUPPORT OF DEFENDANTS' MOTION FOR SUMMARY JUDGMENT

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Paper 7
Date: February 13, 2014

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MEDTRONIC, INC.
Petitioner

v.

NUVASIVE, INC.
Patent Owner

Case No. IPR2013-00508
U.S. Patent No. 8,187,334 B2

Before SALLY C. MEDLEY, LORA M. GREEN, and STEPHEN C. SIU, *Administrative Patent Judges*.

SIU, *Administrative Patent Judge*.

DECISION
Institution of *Inter Partes* Review
37 C.F.R. § 42.108

I. BACKGROUND

A. Background

Medtronic, Inc. ("Petitioner") filed a petition requesting an *inter partes* review of claims 1-5, 10, 11, and 14-28 of U.S. Patent No. 8,187,334 B2 ("the '334 patent," Ex. 1115) pursuant to 35 U.S.C. §§ 311-319. Paper 1 ("Pet."). NuVasive, Inc. ("Patent Owner") filed a preliminary response ("Prelim. Resp."). Paper 6. We have jurisdiction under 35 U.S.C. § 314. The standard for instituting an *inter partes* review is set forth in 35 U.S.C. § 314 (a) which provides:

> THRESHOLD -- The Director may not authorize an inter partes review to be instituted unless the Director determines that 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.

We determine based on the record that Petitioner has shown, under 35 U.S.C. § 314(a), that there is a reasonable likelihood that it would prevail with respect to at least one of the challenged claims.

Petitioner relies on the following prior art:

US 2002/0165550 A1 (Frey)	Nov. 7, 2002	Ex. 1103
US 2003/0028249 A1(Baccelli)	Feb. 6, 2003	Ex. 1104
US 5,860,973 (Michelson)	Jan. 19, 1999	Ex. 1005

Synthes Vertebral Spacer – PR Brochure, Synthes Spine 2002 ("SVS"; Ex. 1106).

Medtronic Sofamor Daneek, Telamon, Verte-Stack PEEK Vertebral Body spacer (Ex. 1107); and Telamon, Posterior Impacted Fusion Devices, 2003 (Ex. 1108) (collectively, "Telamon").

Petitioner contends that the challenged claims are unpatentable under 35 U.S.C § 103(a) based on the following specific grounds (Pet. 3):

Reference(s)	Basis	Claims challenged
SVS and Frey, Baccelli, and/or Michelson or Telamon	§ 103	1-5, 10, 11, and 14-28
Telamon and Frey, Baccelli, and/or Michelson or SVS	§ 103	1-5, 10, 11, and 14-28

B. The '334 patent

The '334 patent describes a spinal fusion system, including a spinal fusion implant and an insertion instrument. Ex. 1115, col.5, ll. 6-9. The spinal fusion implant is introduced into the disc space via a lateral approach to the spine or via a posterior, anterior, antero-lateral, or postero-lateral approach, and is made from a radiolucent material, such as PEEK (poly-ether-ether-ketone). *Id.* at col.5, ll. 10-15 and 29-33. In one embodiment, the spinal fusion implant has a width ranging between 9 and 18 mm and a length ranging between 25 and 44 mm. *Id.* at col.5, ll. 17-19.

Claim 1 of the '334 patent is reproduced below:

> 1. A spinal fusion implant of non-bone construction positionable within an interbody space between a first vertebra and a second vertebra, said implant comprising:
> an upper surface including anti-migration elements to contact said first vertebra when said implant is positioned within the interbody space, a lower surface including anti-migration elements to contact said second vertebra when said implant is positioned within the interbody space, a distal wall, a proximal wall, a first sidewall and a second sidewall, said distal wall, proximal wall, first sidewall, and second sidewall comprising a radiolucent material;

wherein said implant has a longitudinal length greater than 40 mm extending from a proximal end of said proximal wall to a distal end of said distal wall;

wherein a central region of said implant includes portions of the first and second sidewalls positioned generally centrally between the proximal wall and the distal wall, at least a portion of the central region defining a maximum lateral width of said implant extending from said first sidewall to said second sidewall, wherein said longitudinal length is at least two and halftimes greater than said maximum lateral width;

at least a first fusion aperture extending through said upper surface and lower surface and configured to permit bone growth between the first vertebra and the second vertebra when said implant is positioned within the interbody space, said first fusion aperture having: a longitudinal aperture length extending generally parallel to the longitudinal length of said implant, and a lateral aperture width extending between said first sidewall to said second sidewall, wherein the longitudinal aperture length is greater than the lateral aperture width; and

at least three radiopaque markers; wherein a first of the at least three radiopaque markers is at least partially positioned in said distal wall, a second of said at least three radiopaque markers is at least partially positioned in said proximal wall, and a third of said at least three radiopaque markers is at least partially positioned in said central region.

According to the Petitioner, the '334 patent is presently the subject of co-pending district court litigation, *Warsaw Orthopedic, Inc. v. NuVasive, Inc.*, originally filed in the Northern District of Indiana, Case No. 3:12-cv-00438-JD-CAN on August 17, 2012, and transferred to the Southern District of California on November 8, 2012, as Case No. 3:12-cv-02738-CAB-MDD. *See* Pet. 1. Petitioner has filed a second petition seeking *inter partes* review of the '334 patent (IPR2013-00507) and two additional petitions seeking *inter partes* review of related U.S. Patent No. 8,361,156 B2 (IPR2013-00504 and IPR2013-00506).

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