

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent of: Michelson
U.S. Patent No.: 8,251,997 Attorney Docket No.: 13958-0112IP2
Issue Date: August 28, 2012
Appl. Serial No.: 13/306,583
Filing Date: November 29, 2011
Title: METHOD FOR INSERTING AN ARTIFICIAL IMPLANT BETWEEN TWO
ADJACENT VERTEBRAE ALONG A CORONAL PLANE

Mail Stop Patent Board

Patent Trial and Appeal Board
U.S. Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

**CORRECTED PETITION FOR *INTER PARTES* REVIEW OF UNITED STATES PATENT
NO. 8,251,997 PURSUANT TO 35 U.S.C. §§ 311–319, 37 C.F.R. § 42**

TABLE OF CONTENTS

I.	MANDATORY NOTICES UNDER 37 C.F.R § 42.8	1
	A.Real Party-In-Interest Under 37 C.F.R. § 42.8(b)(1)	1
	B.Related Matters Under 37 C.F.R. § 42.8(b)(2).....	1
	C.Lead And Back-Up Counsel Under 37 C.F.R. § 42.8(b)(3)	1
	D.Service Information	1
II.	PAYMENT OF FEES – 37 C.F.R. § 42.103	2
III.	REQUIREMENTS FOR IPR UNDER 37 C.F.R. § 42.104	2
	A.Grounds for Standing Under 37 C.F.R. § 42.104(a).....	2
	B.Challenge Under 37 C.F.R. § 42.104(b) and Relief Requested	2
	C.Claim Construction under 37 C.F.R. §§ 42.104(b)(3).....	3
	1. “a single elongated portion removably attached to said distal end of said third surgical instrument” (claim 9).....	4
	2. “positioning a single elongated portion removably attached to said distal end of said third surgical instrument over the disc space” (claim 9).....	4
	3. “positioning said third surgical instrument such that at least part of one of said at least two elongated portions is over one of the two adjacent vertebrae and at least part of another of said at least two elongated portions is over the other of the two adjacent vertebrae” (claim 17)	4
	4. “positioning said third surgical instrument such that the midpoint of the width of said first elongated portion is over the disc space and said second elongated portion is over one of the two adjacent vertebrae and said third elongated portion is over the other of the two adjacent vertebrae” (claim 24)	5
	5. “the length of said implant being sized to occupy substantially the full transverse width of the vertebral bodies of the two adjacent vertebrae, the length of said implant being greater than the depth of the disc space” (claims 9 and 17)	5
	6. “the length of said implant being sized to occupy the full transverse width of the vertebral bodies of the two adjacent vertebrae, the length of said implant being greater than the depth of the disc space” (claim 24)	6
IV.	SUMMARY OF THE `997 PATENT	7
	A.Brief Description	7
	B.Summary of the Prosecution History of the `997 Patent.....	7
V.	THERE IS A REASONABLE LIKELIHOOD THAT AT LEAST ONE CLAIM OF THE `997 PATENT IS UNPATENTABLE	8
VI.	[GROUND 1] – Claims 9 and 16 are obvious under §103 over Jacobson in view of Leu, McAfee, and Michelson `247	13

VII.	[GROUND 2] – Claims 10-15 are obvious under §103 over Jacobson in view of Leu, McAfee, Michelson ‘247, and Frey.....	21
VIII.	[GROUND 3] – Claims 17 and 23 are obvious under §103 over Jacobson in view of Leu and Brantigan	22
IX.	[GROUND 4] – Claims 18-22 are obvious under §103 over Jacobson in view of Leu, Brantigan, and Frey	30
X.	[GROUND 5] – Claims 24 and 30 are obvious under §103 over Jacobson in view of Leu and Michelson ‘247.....	31
XI.	[GROUND 6] – Claims 25-29 are obvious under §103 over Jacobson in view of Leu, Michelson ‘247, and Frey	40
XII.	[GROUND 7] – Claims 9-16 are obvious under §103 over Michelson ‘661 in view of McAfee and Lynn	41
XIII.	[GROUND 8] – Claims 17-30 are obvious under §103 over Michelson ‘661 in view of Lynn.....	50
XIV.	CONCLUSION	60

EXHIBITS

NUVASIVE 1001	Declaration of Dr. McAfee, M.D., M.B.A.
NUVASIVE 1002	U.S. Patent No. 8,251,997 to Michelson (“997 patent”)
NUVASIVE 1003	Select Prosecution History of the ‘997 patent
NUVASIVE 1004	U.S. Pat. No. 4,545,374 to Jacobson (“Jacobson”)
NUVASIVE 1005	Leu et al., <i>Percutaneous Fusion of the Lumbar Spine</i> , Spine Vol. 6, No. 3, pp. 593-604 (September 1992) (“Leu”)
NUVASIVE 1006	U.S. Pat. No. 5,192,327 to Brantigan (“Brantigan”)
NUVASIVE 1007	U.S. Pat. No. 4,917,704 to Frey et al. (“Frey”)
NUVASIVE 1008	U.S. Pat. No. 5,015,247 to Michelson (“Michelson ‘247”)
NUVASIVE 1009	U.S. Pat. No. 5,569,290 to McAfee (“McAfee”)
NUVASIVE 1010	U.S. Pat. No. 5,772,661 to Michelson (“Michelson ‘661”)
NUVASIVE 1011	U.S. Pat. No. 8,343,224 to Lynn et al. (“Lynn”)

NuVasive, Inc. (“Petitioner”) petitions for *Inter Partes* Review (“IPR”) under 35 U.S.C. §§ 311–319 and 37 C.F.R. § 42 of claims 9-30 of U.S. Patent No. 8,251,997. Below, NuVasive demonstrates there is a reasonable likelihood of prevailing (“RLP”) in its challenge of at least one of claims 9-30 identified in this petition as being unpatentable.

I. MANDATORY NOTICES UNDER 37 C.F.R § 42.8

A. Real Party-In-Interest Under 37 C.F.R. § 42.8(b)(1)

NuVasive, Inc. is the real party-in-interest for the instant petition.

B. Related Matters Under 37 C.F.R. § 42.8(b)(2)

Petitioner is not aware of any reexamination certificates or pending prosecution concerning the ‘997 patent, and is aware of a Certificate of Correction. Petitioner is a named defendant in litigation concerning the ‘997 patent, *Warsaw Orthopedic, Inc. et al. v. NuVasive, Inc.* (originally filed in N.D. Ind. as Case No. 3:12-cv-00438-JD-CAN on Aug. 17, 2012, and transferred to S.D. Cal. on Nov. 8, 2012, as Case No. 3:12-cv-02738-CAB (MDD)). The ‘997 patent was added by amended complaint filed Aug. 28, 2012, served on Petitioner that same day. Petitioner is concurrently filing an IPR petition for claims 1-8 of the ‘997 patent.

C. Lead And Back-Up Counsel Under 37 C.F.R. § 42.8(b)(3)

LEAD COUNSEL	BACK-UP COUNSEL
Stephen R. Schaefer, Reg. No. 37,927 3200 RBC Plaza 60 South Sixth Street Minneapolis, MN 55402	Michael T. Hawkins, Reg. No. 57,867 3200 RBC Plaza 60 South Sixth Street Minneapolis, MN 55402

D. Service Information

Please address all correspondence and service to both counsel listed above. Peti-

Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

Real-Time Litigation Alerts



Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

Advanced Docket Research



With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

Analytics At Your Fingertips



Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

LAW FIRMS

Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

FINANCIAL INSTITUTIONS

Litigation and bankruptcy checks for companies and debtors.

E-DISCOVERY AND LEGAL VENDORS

Sync your system to PACER to automate legal marketing.