

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

NUVASIVE, INC.
Petitioner

v.

WARSAW ORTHOPEDICS, INC.
Patent Owner

Case IPR2013-00206
Patent 8,251,997

**PETITIONER'S RESPONSE TO THE MOTION FOR OBSERVATION REGARDING
CROSS-EXAMINATION OF DR. McAFEE**

Response to the Introduction

This paper responds to Patent Owner's motion for observation regarding cross-examination of Dr. McAfee, filed Apr. 22, 2014. Patent Owner states in its introductory paragraph that it filed its observations based on "Dr. McAfee's prior sworn testimony" "[i]n lieu of taking additional depositions." However, Petitioner made Dr. McAfee and declarants Mr. Miles, Dr. Brantigan, and Dr. Jacobson available to Patent Owner for depositions. It was Patent Owners choice to comment on Dr. McAfee's prior testimony and to forgo a deposition in which Dr. McAfee could explain that the supposed inconsistencies do not exist. Petitioner disagrees with Patent Owner's characterization of Dr. McAfee's prior testimony as explained below.

Response to Observation No. 1

In Observation No. 1, Patent Owner identifies previous testimony by Dr. McAfee discussing the meaning of the term "lateral." The line of questioning in Exhibit 1040 on page 38 line 11 to page 39 line 1 is directed to the meaning of "the term 'lateral' generally, depending on the particular circumstances and context." Dr. McAfee, however, was not asked about of the meaning of the term "lateral" as that term is used in the Jacobson patent. Dr. McAfee's declaration testimony that "the term 'lateral' can have different meanings in other contexts" but that "a person of skill in the art during the early 1990s would clearly recognize that that *the use of the word 'lateral' as used in the context of Jacobson refers to*

a direct lateral approach” is entirely consistent with his deposition testimony and with the teachings of the Jacobson patent. See Ex. 1029, ¶ 36 (emphasis in original); see also ¶ 39.

Response to Observation No. 2

In Observation No. 2, Patent Owner identifies previous testimony by Dr. McAfee regarding spinal nerves. There is nothing inconsistent between the identified testimony and Dr. McAfee’s declaration testimony. See Ex. 1029, ¶ 42.

Response to Observation No. 3

In Observation No. 3, Patent Owner identifies the same testimony by Dr. McAfee as identified in Observation No. 1. The line of questioning in Exhibit 1040 on page 38 line 11 to page 39 line 1 is directed to the meaning of “the term ‘lateral’ generally, depending on the particular circumstances and context.” There were no questions regarding the meaning of the term “lateral” in the context of the Brantigan ‘327 patent. This general testimony is consistent with Dr. McAfee’s declaration testimony regarding the meaning of the term “lateral” in the specific context of the Brantigan ‘327 patent. See Ex. 1029, ¶¶ 59-64.

Response to Observation No. 4

In Observation No. 4, Patent Owner identifies testimony by Dr. McAfee regarding what the Michelson ‘247 patent states. In Exhibit 1040 on page 45, lines 6-16, counsel asked and the witness testified about what the ‘247 patent “actually states.” All parties agree that the Michelson ‘247 patent does not state the words identified in counsel’s

deposition question. Dr. McAfee's deposition testimony, however, is not inconsistent with his declaration testimony, which is directed to what the Michelson '247 patent's text and figures (specifically excluded from the question posed to Dr. McAfee in deposition) *do* state, show, and suggest to a person of ordinary skill in the art. See Ex. 1029, ¶¶ 83-84.

Respectfully submitted,

Date: May 9, 2014

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