

UNITED STATES PATENT AND TRADEMARK OFFICE

---

BEFORE THE PATENT TRIAL AND APPEAL BOARD

---

NUVASIVE, INC.  
Petitioner

v.

WARSAW ORTHOPEDIC, INC.  
Patent Owner

---

Cases IPR2013-00206 and IPR2013-00208  
Patent 8,251,997 B2

---

RECORD OF ORAL HEARING

Held: June 5, 2014

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

The above-entitled matter came on for hearing on Thursday, June 5, 2014 at 1:00 p.m,  
in Courtroom A at the U.S. Patent and Trademark Office, 600 Dulany Street, Alexandria,  
Virginia.

1 APPEARANCES:

2 ON BEHALF OF THE PETITIONER:

3 FRANK SCHERKENBACH, ESQ.

4 Fish & Richardson P.C.

5 One Marina Park Drive

6 Boston, Massachusetts 02210

7 617-542-5070

8

9 STEPHEN R. SCHAEFER, ESQ.

10 Fish & Richardson P.C.

11 3200 RBC Plaza

12 60 South Sixth Street

13 Minneapolis, Minnesota 55402

14

15 ON BEHALF OF THE PATENT OWNER:

16 LUKE L. DAUCHOT, ESQ.

17 NIMALKA WICKRAMASEKERA, ESQ.

18 Kirkland & Ellis LLP

19 333 South Hope Street

20 Los Angeles, California 90071

21

22 THOMAS H. MARTIN, ESQ.

23 Martin & Ferraro LLP

24 1557 Lake O'Pines Street, N.E.

25 Hartville, Ohio 44632

1 PROCEEDINGS

2 (1:00 p.m.)

3 JUDGE MEDLEY: Good afternoon.

4 This is the hearing for IPR2013-00206 and 00208  
5 between Petitioner, NuVasive, and Patent Owner, Warsaw  
6 Orthopedic.

7 Before we proceed, we would like to memorialize on  
8 the record that a conference call was held on June 4th  
9 between counsel for the respective parties and the Panel.

10 The purpose of the conference call was to discuss  
11 certain objections the Petitioner had with respect to Patent  
12 Owner's demonstratives that were filed on June 3rd.

13 During the call the Panel ruled that the Patent  
14 Owner could not rely on slides 12 and 14 of its June 3rd  
15 demonstrative, and we further encouraged the parties to work  
16 out their differences regarding Petitioner's remaining  
17 objections to Patent Owner's June 3rd demonstrative.

18 Just prior to noon today the Board received  
19 another set of Patent Owner's demonstratives. We assume that  
20 this set replaces the June 3rd demonstratives and we plan to  
21 exclude the June 3rd demonstratives, if that is amenable to  
22 everyone.

23 MR. DAUCHOT: That's fine, Your Honor.

24 JUDGE MEDLEY: Okay. Are there any remaining  
25 issues regarding the demonstratives?

1 MR. SCHERKENBACH: No, Your Honor.

2 MR. DAUCHOT: No.

3 JUDGE MEDLEY: We appreciate the parties willing  
4 to work it out and not to involve us beyond what was  
5 necessary.

6 At this time we would like the parties to please  
7 introduce counsel, beginning with Petitioner.

8 MR. SCHERKENBACH: Thank you, Your Honor.

9 Good afternoon. Frank Scherkenbach of Fish &  
10 Richardson on behalf of Petitioner, NuVasive.

11 Also, Stephen Schaefer is with me and may address  
12 certain discrete issues depending on whether they come up.

13 JUDGE MEDLEY: Okay. Counsel for Patent Owner.

14 MR. DAUCHOT: Good afternoon, Your Honor. Luke  
15 Dauchot on behalf of the Patent Owner.

16 And with me here today is Nimalka Wickramasekera,  
17 who will be sharing the argument. And with us as well today  
18 is Tom Martin, lead trial -- or lead counsel.

19 JUDGE MEDLEY: Okay. Thank you.

20 As you know, per our May 9 order from the Board  
21 each party will have 60 minutes of total time to present  
22 arguments for the two cases.

23 Because the two cases involve the same patent with  
24 similar issues, Petitioner, you will proceed first to state  
25 your case with respect to all of the challenged claims and

1 grounds for which the Board instituted trial for both cases.

2 And thereafter, Patent Owner, you may have time to  
3 respond to the presentation for both cases.

4 Petitioner, you may reserve rebuttal time if you  
5 would like.

6 So we will begin with the Petitioner. And would  
7 you like to reserve rebuttal time?

8 MR. SCHERKENBACH: I would, Your Honor. I would  
9 like to reserve 20 minutes.

10 JUDGE MEDLEY: Okay. Thank you.

11 MR. SCHERKENBACH: Thank you.

12 I structured my remarks today around what  
13 Petitioner sees is three primary points of dispute or  
14 assumptions that underlie many of the discrete issues that  
15 remain between the parties.

16 One of those is regarding Jacobson and whether it  
17 teaches lateral or posterolateral approach in either  
18 discectomy or fusion.

19 That issue underlies many of Warsaw's other  
20 arguments. So I will deal with that one first.

21 Just by way of a brief introduction, obviously in  
22 its decisions instituting this proceeding, the Board, of  
23 course, agreed preliminarily that Jacobson was lateral and  
24 not posterolateral. We think the plain teaching of Jacobson  
25 is clear on this issue.

# 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.