

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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NUVASIVE, INC.  
Petitioner

v.

WARSAW ORTHOPEDIC, INC.  
Patent Owner

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Case IPR2013-00206  
Patent 8,251,997 B2

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

MEDLEY, *Administrative Patent Judge.*

ORDER  
Conduct of the Proceeding  
*37 C.F.R. § 42.5*

On July 10, 2014, the Board issued a Final Written Decision in accordance with 37 C.F.R. § 42.73. Paper 65 (“Final Dec.”). The Board concluded that Petitioner had shown by a preponderance of the evidence that claims 17–23 of the

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'997 patent are unpatentable over the combination of Jacobsen<sup>1</sup>, Leu<sup>2</sup>, and Brantigan<sup>3</sup>, but had not shown by a preponderance of the evidence that claims 9–16 and 24–30 of the '997 patent are unpatentable. Final Dec. 31, 36. Both parties appealed the decision to the United States Court of Appeals for the Federal Circuit, but Petitioner subsequently withdrew its appeal and is no longer a party to the proceeding.

With respect to the claims involved in this proceeding, the Federal Circuit vacated the Board's decision that claims 17–23 are unpatentable over Jacobson, Leu, and Brantigan and remanded the case for additional explanation. *In Re Warsaw Orthopedic, Inc.*, 832 F.3d 1327 (Fed. Cir. 2016). In particular, the Federal Circuit remanded the case for the Board to provide additional explanation regarding our finding that Jacobson's anchor wires positioned over adjacent vertebrae meet the claim 17 "elongated portions" limitation.

On November 15, 2016, a conference call was held involving counsel for Patent Owner, and Judges Medley, Green, and Siu.<sup>4</sup> Based on the discussion had during the conference call regarding the Federal Circuit remand, we determine that additional briefing is warranted. In particular, Patent Owner is authorized to file a brief limited to ten pages for the sole purpose of addressing the "elongated

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<sup>1</sup> U.S. Patent No. 4,545,374 (issued Oct. 8, 1985) (Ex. 1004) ("Jacobson").

<sup>2</sup> Hansjörg F. Leu and Adam Schreiber; *Percutaneous Fusion of the Lumbar Spine: A Promising Technique*, 6(3) SPINE: STATE OF THE ART REVIEWS 593 (Sept. 1992) (Ex. 1005) ("Leu").

<sup>3</sup> U.S. Patent No. 5,192,327 (issued Mar. 9, 1993) (Ex. 1006) ("Brantigan").

<sup>4</sup> Counsel for Petitioner also attended but did not otherwise participate in the call, and verified that Petitioner was no longer a party to the matter.

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portions” limitation of claim 17. Patent Owner may file as exhibits briefs presented to the Federal Circuit, and may also cite to evidence of record. Patent Owner is not otherwise authorized to file any new evidence.

Accordingly, it is

ORDERED that Patent Owner is authorized to file a paper in accordance with this order, not to exceed ten pages, no later than December 9, 2016.

**PETITIONER:**

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**PATENT OWNER:**

Thomas Martin  
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