

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

NUVASIVE, INC.

Petitioner

v.

WARSAW ORTHOPEDIC, INC.

Patent Owner

Case IPR2013-00206

Patent No. 8,251,997

**BRIEF IN RESPONSE TO REMAND FROM
THE U.S. COURT OF APPEALS FOR THE FEDERAL CIRCUIT**

Mail Stop "PATENT BOARD"
Patent Trial and Appeal Board
U.S. Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

TABLE OF CONTENTS

I. Disclosure of the “at least two elongated portions” in the ‘997 patent.2

II. Jacobson does not disclose the “positioning...over” recitation of independent claim 17.4

III. The reasoning articulated in the Petition with respect to Jacobson is flawed.6

IV. Conclusion.....8

TABLE OF AUTHORITIES

Statutes

35 U.S.C. § 103(a)5, 7

LIST OF NEW EXHIBITS

- WARSAW2065 *In re: Warsaw Orthopedic, Inc.*, Decision of U.S. Court of Appeals for the Federal Circuit, Appeal Nos. 2015-1049 and 2015-1050, decided August 9, 2016.
- WARSAW2066 Warsaw Orthopedic, Inc.'s Opening and Response Brief, Appeal Nos. 2015-1049, -1050, and -1058, dated May 29, 2015.
- WARSAW2067 NuVasive's Corrected Opening Brief, Appeal Nos. 2015-1049, -1050, -1058, dated February 19, 2015.
- WARSAW2068 Corrected Brief for Intervenor – Director of the U.S. Patent and Trademark Office, Appeal Nos. 2015-1049, -1050, -1058, dated July 14, 2015.

...

In a Decision dated August 9, 2016 (attached hereto as Exhibit WARSAW2065), the U.S. Court of Appeals for the Federal Circuit (“Federal Circuit”) has remanded claims 17-23 (including independent claim 17) of U.S. Patent No. 8,251,997 (“’997 patent”) to the Board for further consideration in light of U.S. Patent No. 4,545,374 to Jacobson (“Jacobson”).

The Federal Circuit indicated that it cannot be readily discerned “that the PTAB’s decision as to the ‘elongated portions’ limitation in claim 17 followed the proper path” to making its decision, because “[t]he PTAB’s affirmative narrative in support of its finding that Jacobson discloses the subject limitation in claim 17 consists of a single sentence,” and “[t]he PTAB’s conclusory assertion that Figure 5 of Jacobson ‘appears to’ support its finding does not equate to the reasoned explanation needed to support its conclusion.” (Exhibit WARSAW2065 at page 13.) As such, the Federal Circuit indicated that this issue is remanded “to the PTAB for additional explanation.” (Exhibit WARSAW2065 at page 14.)

In an Order dated November 16, 2016 (“November 2016 Order”), the Board determined that additional briefing was warranted in view of the remand from the Federal Circuit, and indicated that “Patent Owner is authorized to file a brief limited to ten pages for the sole purpose of addressing the ‘elongated portions’ limitation of [independent] claim 17,” and “Patent Owner may file as exhibits briefs presented to the Federal Circuit, and may also cite to evidence of record.”

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.