

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

NUVASIVE, INC.
Petitioner

v.

WARSAW ORTHOPEDICS, INC.
Patent Owner

Case IPR2013-00208
Patent 8,251,997

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

Response to the Introduction

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

Response to Observation No. 1

In Observation No. 1, Patent Owner identifies prior testimony by Mr. Miles discussing NuVasive's CoRoent XL implant. In Exhibit 2064 at page 420, line 17 to page 421, line 9, Mr. Miles testified to the importance of the group of technologies that comprise the XLIF procedure to the safety and reproducibility of the procedure. In Exhibit 2064 at page 421, lines 8-9, Mr. Miles testified that "It is an assembled group of things that makes the thing successful." In Exhibit 2064 at page 422:21-423:2, Mr. Miles agreed with the testimony of Dr. Smith that the CoRoent implant was innovative. In Exhibit 2064 at page 423, lines 3-7, Mr. Miles explained that "there's many elements that make it [the CoRoent implant] innovative." In fact, Mr. Miles never testified that the length of the CoRoent XL implant "is

innovative because it spans the entire width of the vertebral body” as Patent Owner contends. Rather, Mr. Miles’ previous testimony is entirely consistent with his declaration testimony that there are many elements that make the CoRoent implant innovative, including “a patented fusion implant design that, unlike the implants disclosed in the '997 patent, does not require the removal of portions of the adjacent vertebrae (see, e.g., U.S. Patent Nos. 8,187,334 and 8,361,156, Exhibits 1065 and 1066).” Ex. 1032, ¶ 9.

Response to Observation No. 2

In Observation No. 2, Patent Owner identifies previous testimony by Mr. Miles discussing two different procedures at Medtronic referred to by the acronym “ELIF.” In Exhibit 2064 at page 447, lines 7-10, Mr. Miles testified that in the ELIF procedure he worked on, ELIF stood for “**endoscopic** lumbar interbody fusion.” (Emphasis added). Mr. Miles testified at page 474, lines 20-23 that ELIF “looked nothing like a lateral approach.” In Exhibit 2064 at page 433, line 5 to page 434, line 6, Mr. Miles testified that a document he was shown referencing a procedure where the E in ELIF stood for “extreme” was dated after Mr. Miles left Medtronic. In Exhibit 2064 on page 450, lines 8-10, Mr. Miles testified that he did not copy anything from Medtronic Sofamor Danek in his work at NuVasive. This is all consistent with Mr. Miles’ declaration testimony that he did not copy the ELIF name or technology. See Ex. 1032, ¶¶ 14-16.

Respectfully submitted,

Date: May 9, 2014

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