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NUVASIVE, INC.

UNITED STATES DISTRICT COURT

SOUTHERN DISTRICT OF CALIFORNIA

WARSAW ORTHOPEDIC, INC.,

Plaintiff,

v.

NUVASIVE, INC.,

Defendant.

NUVASIVE, INC.,

Counterclaimant,

v.

MEDTRONIC SOFAMOR DANEK USA, INC.,

Counterclaim Defendant.

AND RELATED COUNTERCLAIMS.

Case No. 3:08-CV-1512 MMA (MDD)

NUVASIVE, INC.'S REPLY IN SUPPORT OF ITS RENEWED MOTION FOR JUDGMENT AS A MATTER OF LAW OR A NEW TRIAL

Date: January 24, 2012
Time: 2:30 p.m.
Judge: Hon. Michael M. Anello
Courtroom: 5, 3rd floor

implant" imposes those requirements.[1] Warsaw's validity case, which was built solely on contradicting the Court's construction, (*e.g.*, Tr. at 679:2-15), fails as a matter of law.

C. Warsaw Doesn't Dispute the Claims Are Invalid Under a Proper Construction.

It is telling that Warsaw's opposition cannot identify any differences between the Brantigan commercial implants and the asserted claims of the '973 patent under the proper claim construction. Instead, Warsaw's analysis focuses only on where and how the devices may have been implanted. That is wrong as a matter of law. The dimensions of the Brantigan implants—42 mm x 28 mm x 14 mm and 35 mm x 24 mm x 15 mm implants—are undisputed. The pictures in NuVasive's opening brief at p. 12 (which come from admitted evidence) show the dimensions are identical to what is claimed. And Warsaw never disputes they are prior art. Nothing more is required to show that the Brantigan implants anticipate all claims as a matter of law under the right construction.

Warsaw argues the Brantigan implants were not capable of being inserted translaterally because they lack an "engagement means."[2] (Doc. No. 422 at 12-13.) But Dr. Sachs admitted that a translateral spinal implant does not turn into something else simply because a doctor uses his fingers to insert it rather than holes in the side. (Tr. at 2209:17-2210:16.) Warsaw also argues the Brantigan implants do not have the claimed "length." (Doc. No. 422 at 13-14.) But the cited testimony is irrelevant under the correct construction because the "lengths" of the Brantigan implants are necessarily 42 mm and 35 mm because that is the greatest dimension. It also does not matter whether the length of the implant used with JC was not substantially greater than the depth of JC's vertebrae where the implant was placed because the claims do not require actual insertion.

Warsaw tries the same trick with the Brantigan '327 patent, but it never contests that Brantigan '327 discloses an implant that fits within the dimensions of the properly construed claims. That is all that is required to anticipate claims 24, 57, and 61. Brantigan '327 also repeatedly states that its implants are suitable for "anterior, posterior or ***lateral*** placement." (DTX-5909 at 2:56-65,

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[1] The *NTP*, *Eaton* and *Goldenberg* cases, cited by Warsaw, are irrelevant. The issue here is not whether the term "said implant" refers to "translateral spinal implant"—it is what the term "translateral spinal implant" means. The *Markman* order correctly holds the term imposes no additional structural limitations. Warsaw's cases are silent on that issue.

[2] Warsaw's attacks on Dr. Brantigan are unfounded, but, more importantly, irrelevant because the claims do not require actual insertion—only that the claimed dimensions be met. It is

5:31, 6:65-66). Even if "lateral" in Brantigan '327 meant something other than it says, this is irrelevant. The implant is thus capable of being inserted from a lateral approach (translaterally). Warsaw's non-obviousness arguments for claims 41 and 42 fail, as discussed in the opening brief.

Finally, for Michelson '247, Warsaw's arguments about the terms "translateral spinal implant" and "length" are again irrelevant under proper constructions of those terms. Warsaw protests that Michelson '247 does not disclose the "height for contacting" limitation, but Warsaw admitted in the pre-trial order that it does, (Doc. No. 338 at ¶ 96; JTX-1 at ¶ 92), which is binding.

II. JMOL OF NON-INFRINGEMENT OF THE '933 IS APPROPRIATE

There is no infringement of the '933 as a matter of law for three independent reasons. First, vitiation bars Warsaw from saying the enclosed three-blade working channel in NuVasive's retractors is equivalent to the claimed "working channel being closed by said first portion and said second portion." Second, if Warsaw is permitted to say that all three blades of NuVasive's retractors are the "said first portion and said second portion" in the part of the claims addressing the "closed" working channel, then it must also show all three blades meet the other requirements the claim sets forth for that same structure—namely, that the "working channel is enlargeable by laterally moving ***each*** of said first and second portions away from one another and pivoting ***each*** of said distal ends of the first and second portions away from one another." Warsaw cannot do so because it is undisputed that only two of NuVasive's three blades (*i.e.*, not "each") laterally move and pivot. Third, and relatedly, Warsaw never identified what part of the NuVasive products satisfies the laterally moving and pivoting requirement.

Warsaw's response to the first point (vitiation) is to argue about the trial presentations. (Doc. No. 422 at 21-23.) But vitiation is a legal question that is separate from the trial evidence, the specification, and prosecution history disclaimer. *DePuy Spine, v. Medtronic Sofamor Danek*, 567 F.3d 1314, 1323 (Fed. Cir. 2009) (holding that vitiation is "to be determined by the Court . . . on a motion for judgment as a matter of law at the close of the evidence and after the jury verdict"). Warsaw tries to concoct a concession from Dr. van Dam, but he was not testifying about vitiation.

Warsaw also argues that "using two components to accomplish what is claimed as one component does not vitiate or constitute antithetical structure." (Doc. No. 422 at 22.) But neither

Dated: December 23, 2011

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that a true and correct copy of the above and foregoing document has been served on December 23, 2011 to all counsel of record who are deemed to have consented to electronic service via the Court's CM/ECF system per Civ LR 5.4(d). Any other counsel of record will be served by U.S. mail or hand delivery.

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