

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.

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P R O C E E D I N G S

(1:00 p.m.)

JUDGE MEDLEY: Good afternoon.

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

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

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

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

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

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

JUDGE MEDLEY: Okay. Are there any remaining 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.

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