

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

NUVASIVE, INC.
Petitioner

v.

WARSAW ORTHOPEDICS, INC.
Patent Owner

Case IPR2013-00395
Patent No. 8,444,696

PETITIONER'S MOTION TO EXCLUDE

TABLE OF AUTHORITIES

Fed. R. Evid. 401 1, 2
Fed. R. Evid. 403 1, 2
Fed. R. Evid. 1002 1, 3

I. INTRODUCTION

Under 37 C.F.R. § 42.64(c), NuVasive, Inc. moves to exclude Exhibits 2007 and 2008 submitted by Warsaw Orthopedic, Inc. in the above-captioned *inter partes* review. Warsaw's exhibits are inadmissible under Federal Rules of Evidence 401 and 403, and the best evidence rule (FRE 1002). The Exhibits contain Warsaw's attorneys' comparison of two claims from the '696 patent to two claims from the parent case of the '696 patent, U.S. Patent No. 8,021,430 ("the '430 patent," attached hereto as Appendix A). These exhibits are not evidence. These exhibits are also confusing and prejudicial because they compare only a limited number of the independent claims from the '430 and '696 patents, and conveniently ignore the fact that the rejected dependent claims of the '430 patent are strikingly similar to the independent claims of the '696 patent. If Warsaw truly wanted the Board to compare the claims from both patents it would have submitted the best evidence—the '430 patent and its reexamination certificate—for the Board's review. Warsaw's improper attempt to submit misleading attorney argument in the guise of evidence should be recognized as such and excluded.

II. PROCEDURAL HISTORY

NuVasive filed a corrected petition for *inter partes* review on July 9, 2013 (Paper 7), and the Board granted the petition on December 20, 2013 (Paper 12). In

its Corrected Petition, NuVasive explained the similarity of issues presented in a prior *inter partes* reexamination proceedings on the parent '430 patent (which eventually led to the issuance of a reexamination certificate canceling all claims of the '430 patent on August 26, 2013), and the issues in the present proceeding on the '696 patent. *See* Corrected Petition, Paper 7, pp. 5-6; Exhibit 1010 (excerpts from the '430 *inter partes* reexamination prosecution history). Warsaw then filed its Patent Owner response on April 11, 2014 (Paper 24), and NuVasive replied on June 2, 2014 (Paper 25). On April 18, 2014, NuVasive timely served upon Warsaw's counsel its objections to Warsaw's evidence that was filed concurrently with its April 11, 2014 response, under 37 C.F.R. § 42.64(b)(1). NuVasive's objections are attached hereto as Appendix B.

III. **ARGUMENT**

Warsaw's Exhibits 2007 and 2008 are claims comparisons presumably created by Warsaw's attorney. *See* Patent Owner Response, Paper 24, p. 10. These Exhibits are not evidence. They are not testimony of a witness. They are not printed publications or other documentary evidence. Accordingly, Exhibits 2007 and 2008 are inadmissible under FRE 401 for lack of relevance.

Exhibits 2007 and 2008 should also be excluded under FRE 403 because their probative value is substantially outweighed by their prejudice and confusion of the issues. These exhibits are simply attorney argument comparing only a

limited number of the claims from the '430 patent (claims 19 and 26) with claims from the '696 patent (claims 7 and 10). *See* Patent Owner Response, Paper 24, p. 10. The Exhibits ignore the fact that the rejected dependent claims of the '430 patent have strong similarities to the independent claims of the '696 patent. *See, e.g.,* claims 20-21, 24-25, 27-28, 31-32 of the '430 patent. Warsaw likely submitted these misleading comparisons, rather than the '430 patent itself, because the similar dependent claims from the '430 patent were all rejected during the *inter partes* reexamination of that patent. *See* Corrected Petition, Paper 7, pp. 5-6.; *see also* Exhibit 1010 ('430 reexamination file history), pp. 92-108. In fact, the CRU rejected those claims on seven separate and independent grounds, including four anticipation grounds based on prior art that was of record in the original prosecution and thus presumably considered by the original examiner. *Id.* Indeed, even further amended versions of the original claims were rejected. *See* Exhibit 1010, pp. 8-64.

Finally, Exhibits 2007 and 2008 also violate the best evidence rule (FRE 1002). A copy of the '430 patent (and its reexamination certificate) are printed publications and therefore were readily available to Warsaw as of August 26, 2013, the date the reexamination certificate issued. *See* '430 patent with reexamination certificate, attached hereto as Appendix A. Thus, the '696 patent and the '430

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