

1 Luke L. Dauchot (S.B.N. 229829)
luke.dauchot@kirkland.com
2 Alexander F. MacKinnon (S.B.N. 146883)
alexander.mackinnon@kirkland.com
3 Nimalka R. Wickramasekera (S.B.N. 268518)
nimalka.wickramasekera@kirkland.com
4 Kirkland & Ellis LLP
333 South Hope Street
5 Los Angeles, California 90071
Telephone: (213) 680-8400
6 Facsimile: (213) 680-8500

7 Attorneys for Plaintiffs/Counterclaim Defendants,
WARSAW ORTHOPEDIC, INC.; MEDTRONIC
8 SOFAMOR DANEK U.S.A., INC.; MEDTRONIC
PUERTO RICO OPERATIONS CO.; OSTEOTECH,
9 INC.; MEDTRONIC, INC.; and MEDTRONIC
10 SOFAMOR DANEK DEGGENDORF, GMBH

11 **UNITED STATES DISTRICT COURT**
12 **SOUTHERN DISTRICT OF CALIFORNIA**

13 WARSAW ORTHOPEDIC, INC.;
14 MEDTRONIC SOFAMOR DANEK
U.S.A., INC.; MEDTRONIC PUERTO
15 RICO OPERATIONS CO.; and
OSTEOTECH, INC.,

16 Plaintiffs,

17 vs.

18 NUVASIVE, INC.,

19 Defendant.

20 AND RELATED COUNTERCLAIMS.

) CASE NO. 3:12-cv-02738-CAB (MDD)

) **PLAINTIFFS' DISCLOSURE OF**
) **ASSERTED CLAIMS AND**
) **INFRINGEMENT CONTENTIONS**
) **RE U.S. PATENT NO. 8,444,696**

1 In accordance with Patent L.R. 3.1 and 3.2, Plaintiffs Warsaw Orthopedic, Inc.,
2 Medtronic Sofamor Danek U.S.A., Inc., Medtronic Puerto Rico Operations Co., and
3 Osteotech, Inc. (collectively “Plaintiffs”) provide the following Disclosure of Asserted
4 Claims and Infringement Contentions and document production accompanying
5 disclosure for U.S. Patent No. 8,444,696 (the “’696 patent”). At this time, discovery
6 is in its early stages, and Plaintiffs’ investigation regarding the disclosed and other
7 potential grounds for infringement is ongoing. Defendant NuVasive, Inc.
8 (“NuVasive”) has only recently begun producing documents and things and has not
9 provided deposition testimony or other formal discovery to Plaintiffs. This Patent
10 Local Rule disclosure is therefore based upon information Plaintiffs have been able to
11 obtain to-date and is given without prejudice to Plaintiffs’ right to supplement or
12 amend their disclosure as additional facts are ascertained, analyses are made, research
13 is completed, contentions are made, and claims are construed. These disclosures are
14 also based at least in part upon Plaintiffs’ present understanding of the meaning and
15 scope of the claims in the absence of claim construction proceedings or discovery.
16 Plaintiffs reserve the right to amend or supplement these disclosures if their
17 understanding of the claims changes, including any modification to the claims’
18 interpretation following the Court’s claim construction.

19 **I. Patent L.R. 3.1(a), (b), (c), and (e)**

20 Based on the information presently available, Plaintiffs state that NuVasive’s
21 CoRoent XL Standard, CoRoent XL Wide Standard, CoRoent XL Thoracic, CoRoent
22 XL Lordotic, CoRoent XL Wide Lordotic, CoRoent XL Coronal Tapered Standard,
23 CoRoent XL Coronal Tapered Lordotic, CoRoent XL Keeled, CoRoent XL Fixation,
24 CoRoent Large Narrow, CoRoent Large Wide, and CoRoent Large Tapered
25 (“Accused Implants”) directly infringe the claims of the ’696 patent under 35 U.S.C.
26 § 271(a) as follows:
27
28

Accused Implant	Claims
CoRoent XL Standard	1-6
CoRoent XL Wide Standard	1-6
CoRoent XL Thoracic	1, 3-4, and 6
CoRoent XL Lordotic	1-6
CoRoent XL Wide Lordotic	1-6
CoRoent XL Coronal Tapered Standard	1-6
CoRoent XL Coronal Tapered Lordotic	1-6
CoRoent XL Keeled	1-6
CoRoent XL Fixation	4-6
CoRoent Large Narrow	10 and 12
CoRoent Large Wide	10 and 12
CoRoent Large Tapered	7 and 9

Attachments A through L contain claim charts showing infringement of the '696 patent by the Accused Implants.

II. Patent L.R. 3.1(f)

The priority date of the '696 patent is at least June 7, 1995, which is the filing date of Application No. 08/482,146. All asserted claims of the '696 patent are entitled

1 to this priority date.

2 **III. Patent L.R. 3.1(g)**

3 Plaintiffs assert that its Clydesdale, Capstone, and Capstone-L implants embody
4 Claims 1, 3, 4, and 6 of the '696 patent.

5 **IV. Patent L.R. 3.2(a) and (b)**

6 Documents relevant to each discussion with, disclosure to, or other manner of
7 providing to a third party, or sale of or offer to sell, the claimed inventions prior to the
8 date of application for the '696 patent can be located at the production numbers listed
9 below. Further, the documents relevant to the conception, reduction to practice,
10 design, and development of the '696 patent, which were created on or before the date
11 of application for the '696 patent or the priority dates identified pursuant to Patent
12 L.R. 3.1(e) can be located at production numbers listed below.

13

Patent	Conception, Reduction to Practice, Design, and Development Documents at Bates Range	Pre-filing Disclosures Documents at Bates Range
8,444,696	MNUV5045994–6433	MNUV5046074–6075; MNUV5046080–6113; MNUV5046123–6433

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20 **V. Patent L.R. 3.2(c)**

21 The file history for the '696 patent and file histories for each application to
22 which a claim for priority is made for Plaintiffs' '696 patent can be located at
23 production numbers listed below.

24

Patent	Application No.	Bates Range
8,444,696	08/482,146	MNUV5042333–2579
	08/813,283	MNUV5042579–3466

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	09/412,090	MNUV5043467-4305
	10/237,751	MNUV5044306-5512
	10/926,766	MNUV5045513-5840
	12/807,489	MNUV5045841-5993
	13/235,998	MNUV5042071-2332

VI. Patent L.R. 3.2(d)

Documents sufficient to evidence ownership of the '696 patent are available at production numbers MNUV3002661-2872.

VII. Patent L.R. 3.2(e)

Documents sufficient to show the operation of Plaintiffs' embodying products with respect to the '696 patent may be found at production numbers listed below.

Patent	Medtronic Product(s)	Bates Nos.
8,444,696	Clydesdale, Capstone, and Capstone-L implants.	MNUV3002873-2876; MNUV3002921-2924; MNUV5046434-6441

DATED: May 23, 2013

Respectfully submitted,

KIRKLAND & ELLIS LLP

/s/ Nimalka W. Wickramasekera

Luke L. Dauchot

Alexander F. MacKinnon

Nimalka R. Wickramasekera

Attorneys for Plaintiffs/Counterclaim Defendants, WARSAW ORTHOPEDIC, INC.; MEDTRONIC SOFAMOR DANEK U.S.A., INC.; MEDTRONIC PUERTO RICO OPERATIONS CO.; OSTEOTECH, INC.; MEDTRONIC, INC.; and MEDTRONIC SOFAMOR DANEK DEGGENDORF, GMBH

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