

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

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

NUVASIVE, INC.
Petitioner

v.

WARSAW ORTHOPEDIC, INC.
Patent Owner

Patent Number: 8,444,696
Issue Date: May 21, 2013
ANATOMIC SPINAL IMPLANT HAVING
ANATOMIC BEARING SURFACES

Case IPR2013-00395

WARSAW'S OPPOSITION TO PETITIONER'S MOTION TO EXCLUDE

TABLE OF AUTHORITIES

Other Authorities

Fed. R. Evid. 10022, 5
Fed. R. Evid. 4012, 3
Fed. R. Evid. 4032, 4

EXHIBITS

- WARSAW2001 Affidavit of Mr. Luke Dauchot.
- WARSAW2002 Affidavit of Mrs. Nimalka Wickramasekera.
- WARSAW2003 U.S. Patent No. 4,834,757 to Brantigan
- WARSAW2004 U.S. Patent No. 5,425,772 to Brantigan
- WARSAW2005 Declaration of Dr. Charles L. Branch, Jr., M.D.
- WARSAW2006 Curriculum vitae of Dr. Charles L. Branch, Jr., M.D.
- WARSAW2007 Comparison of claim 1 of the '696 patent and claim 1 of the '430 patent.
- WARSAW2008 Comparison of claim 4 of the '696 patent and claim 5 of the '430 patent.
- WARSAW2009 Deposition transcript of Dr. John W. Brantigan, M.D. taken April 7, 2014.
- WARSAW2010 Declaration of Lori Ferrell, CPA, CGMA.
- WARSAW2011 CLYDESDALE® Spinal System Product Information.

I. INTRODUCTION.

Under 37 C.F.R. § 42.64, Patent Owner Warsaw Orthopedic, Inc. respectfully responds in opposition to Petitioner's Motion to Exclude ("Motion to Exclude"). In response, Patent Owner submits that Petitioner NuVasive's positions in the Motion to Exclude are not well founded. Patent Owner provided the claim comparisons (Exhibits 2007 and 2008) that NuVasive seeks to exclude for the convenience of the Board. The claim comparisons of Exhibits 2007 and 2008 provide a simple (but powerful) means for rebutting NuVasive's indication that the *inter partes* reexamination of U.S. Patent No. 8,021,430 ("430 patent") is somehow germane to the present *Inter Partes* Review.

II. BACKGROUND.

In the Corrected Petition for Inter Partes Review of July 9, 2013 ("Corrected Petition"), NuVasive (at page 5, line 19 to page 8, line 10) indicated that the *inter partes* reexamination (U.S. Control No. 95/002,380) of the '430 patent was somehow relevant to the claims of the '696 patent. In doing so, NuVasive discusses the rejections presented in the Request for *Inter Partes* Reexamination of the '430 patent at page 6, lines 8-16 of the Corrected Petition.

In response, Patent Owner provided the claim comparisons of Exhibits 2007 and 2008 with Patent Owner's Response of April 11, 2014 ("Patent Owner's Response"). Exhibit 2007 provides a comparison between independent claim 1 of

the '696 patent and independent claim 1 of the '430 patent, and Exhibit 2008 provides a comparison between independent claim 4 of the '696 patent and independent claim 5 of the '430 patent. The differences between the claims highlighted by the claim comparisons of Exhibits 2007 and 2008 illustrate that the rejections presented in the Request for *Inter Partes* Reexamination of the '430 patent are not germane to at least the patentability of independent claims 1 and 4 of the '696 patent.

III. ARGUMENT

NuVasive now complains that Exhibits 2007 and 2008 should be excluded under the Federal Rules of Evidence (FRE). According to NuVasive, Exhibits 2007 and 2008 are (1) not relevant under FRE 401, (2) prejudicial under FRE 403, and (3) not the best available evidence under FRE 1002. Patent Owner vehemently disagrees. It is noted that NuVasive does not challenge that Exhibits 2007 and 2008 provide an accurate comparison of independent claims 1 and 4 of the '696 patent with independent claims 1 and 5 of the '430 patent, respectively. Instead, it appears that NuVasive incorrectly believes that the Board is incapable of evaluating the probity of the claim comparisons. Patent Owner disagrees. Exhibits 2007 and 2008 serve to illustrate the differences between independent claims 1 and 4 of the '696 patent with independent claims 1 and 5 of the '430 patent, respectively, to show that the rejections presented in the Request for *Inter Partes*

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