

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent of: Michelson

U.S. Patent No.: 8,444,696

Attorney Docket No.: 13958-0113IP2

Issue Date: May 21, 2013

Appl. Serial No.: 13/235,998

Filing Date: September 19, 2011

Title: ANATOMIC SPINAL IMPLANT HAVING ANATOMIC BEARING SURFACES

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PETITION FOR *INTER PARTES* REVIEW OF UNITED STATES PATENT NO. 8,444,696
PURSUANT TO 35 U.S.C. §§ 311–319, 37 C.F.R. § 42

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EXHIBITS

NUVASIVE1101	Declaration of Dr. John W. Brantigan, M.D.
NUVASIVE1102	U.S. Patent No. 8,444,696 to Michelson (“the ‘696 patent”)
NUVASIVE1103	Select Prosecution History of the ‘696 patent (Serial No. 13/235,998)
NUVASIVE1104	U.S. Pat. No. 5,607,424 to Tropiano (“Tropiano”)
NUVASIVE1105	U.S. Pat. No. 5,015,247 to Michelson (“Michelson ‘247”)
NUVASIVE1106	PCT Pub. No. WO89/009035 to Brantigan (“Brantigan ‘035”)
NUVASIVE1107	PCT Pub. No. WO95/008306 to Beckers and certified English translation thereof (“Beckers”)
NUVASIVE1108	U.S. Pat. No. 5,443,514 to Steffee (“Steffee”)
NUVASIVE1109	PCT Pub. No. 90/00037 to Michelson (“Michelson ‘037”)
NUVASIVE1110	U.S. Patent No. 5,645,596 to Kim et al. (“Kim”)
NUVASIVE1111	Select prosecution history of <i>inter partes</i> reexamination proceedings on U.S. Patent No. 8,021,430 (Control No. 95/002,380)
NUVASIVE1112	Plaintiffs’ Disclosure of Asserted Claims and Infringement Contentions re U.S. Patent No. 8,444,696, from <i>Warsaw Orthopedic, Inc. et al. v. NuVasive</i> , S.D. Cal., Case No. 3:12-cv-02738-CAB (MDD)

NuVasive, Inc. (“Petitioner”) petitions for *Inter Partes* Review (“IPR”) under 35 U.S.C. §§ 311–319 of claims 7-12 of the ‘696 patent, and below demonstrates there is a reasonable likelihood of prevailing (“RLP”) in its validity challenge against at least one claim.

I. MANDATORY NOTICES UNDER 37 C.F.R § 42.8

A. Real Party-In-Interest Under 37 C.F.R. § 42.8(b)(1)

NuVasive, Inc. is the real party-in-interest for this Petition.

B. Related Matters Under 37 C.F.R. § 42.8(b)(2)

Petitioner is not aware of any reexamination certificate for the ‘696 patent; there is a certificate of correction. Petitioner is concurrently filing another IPR petition for claims 1-6 of the ‘696 patent. A parent patent (US 8,021,430) is engaged in *inter partes* reexamination in which all claims stand rejected in a Right of Appeal Notice. See NUVASIVE1110. The Patent Owner has asked the Court for permission to add the ‘696 patent in an ongoing patent lawsuit against the Petitioner (*Warsaw Orthopedic, Inc. et al. v. NuVasive, Inc.*, S.D. Cal., Case No. 3:12-cv-02738-CAB (MDD)), but the Patent Owner’s request remains pending and the ‘696 patent has not yet been added to the lawsuit.

C. Lead And Back-Up Counsel Under 37 C.F.R. § 42.8(b)(3)

Petitioner provides the following designation of counsel.

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D. Service Information

Please address all correspondence and service to the address of both counsel listed above. Petitioner also consents to electronic service by email at APSI@fr.com (referencing No. 13958-0113IP2 and cc'ing schaefer@fr.com and hawkins@fr.com).

II. PAYMENT OF FEES – 37 C.F.R. § 42.103

Petitioner authorizes the Patent and Trademark Office to charge Deposit Account No. 06-1050 for the petition fee set in 37 C.F.R. § 42.15(a) and for any other required fees.

III. REQUIREMENTS FOR IPR UNDER 37 C.F.R. § 42.104

A. Grounds for Standing Under 37 C.F.R. § 42.104(a)

Petitioner certifies that the '696 patent is eligible for IPR and that Petitioner is not barred or estopped from requesting IPR.

B. Challenge Under 37 C.F.R. § 42.104(b) and Relief Requested

Petitioner requests IPR of claims 7-12 of the '696 patent on the grounds listed in the table below. In support, this Petition includes claim charts for each of these grounds and a supporting evidentiary declaration of Dr. John W. Brantigan, M.D. (NUVASIVE1001).

Ground	'696 Claims	Basis for Rejection
1	7-8 and 10-11	Obvious under § 103 by Tropiano in view of Michelson '247 and Brantigan '035
2	9 and 12	Obvious under § 103 by Tropiano in view of Michelson '247, Brantigan '035, and Beckers
3	7-12	Obvious under § 103 by Beckers in view of Michelson '247 and Brantigan '035
4	7-12	Obvious under § 103 by Steffee in view of Michelson '037 and Kim

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