

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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NUVASIVE, INC.  
Petitioner

v.

WARSAW ORTHOPEDIC, INC.  
Patent Owner

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Case IPR2013-00396  
Patent 8,444,696

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Before SALLY C. MEDLEY, LORA M. GREEN, and STEPHEN C. SIU,  
*Administrative Patent Judges.*

GREEN, *Administrative Patent Judge.*

DECISION  
Institution of *Inter Partes* Review  
*37 C.F.R. § 42.108*

## I. BACKGROUND

NuVasive, Inc. (“NuVasive”) filed a corrected petition (“Pet.”) requesting an *inter partes* review of claims 7–12 of U.S. Patent No. 8,444,696 (Ex. 1102, the “’696 patent”) on July 9, 2013. Paper 5. Patent Owner, Warsaw Orthopedic, Inc. (“Warsaw”), did not file a preliminary response. We have jurisdiction under 35 U.S.C. §§ 6(b) and 314.

The standard for instituting an *inter partes* review is set forth in 35 U.S.C. § 314(a), which states:

THRESHOLD. The Director may not authorize an *inter partes* review to be instituted unless the Director determines that the information presented in the petition filed under section 311 and any response filed under section 313 shows that there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.

*Inter partes* review is instituted only if the petition supporting the ground demonstrates “that there is a reasonable likelihood that at least one of the claims challenged in the petition is unpatentable.” 37 C.F.R. § 42.108(c).

Upon consideration of the petition, we conclude that NuVasive has established a reasonable likelihood that it would prevail with respect to claims 7–12 of the ’696 patent. Accordingly, we grant the petition, and institute an *inter partes* review of claims 7–12 of the ’696 patent.

### A. *Related Proceedings*

NuVasive indicates that it has concurrently filed another petition for an *inter partes* review of the ’696 patent. Pet. 1. NuVasive indicates further that Warsaw has asked the court for permission to add the ’696 patent to the litigation styled

*Warsaw Orthopedic, Inc. v. NuVasive Inc.*, Case No: 3:12-cv-02738-CAB (S.D. Cal.). *Id.*

*B. The '696 Patent (Ex. 1102)*

The '696 patent is drawn to an interbody spinal fusion implant, which is “configured to restore and maintain two adjacent vertebrae of the spine in correct anatomical angular relationship.” Ex. 1102, 1:20–23. The spinal implants are sized to fit within the disc space that is created when the disc material between two adjacent vertebrae is removed, and conform “wholly or in part to the disc space created.” *Id.* at 1:61–64. The implants have upper and lower surfaces that form a support structure for the adjacent vertebrae, and the upper and lower surfaces “are disposed in a converging angular relationship to each other such that the implants of the present invention have an overall ‘wedged-shape’ in an elevational side view.” *Id.* at 1:67–2:4.

As taught by the '696 patent, the various faces of the implant may be curved to allow the implant “to conform to the shape of the vertebral surfaces.” *Id.* at 2:23–25. That is, “the upper and/or lower surfaces may be convex, and/or the front and/or rear surfaces may be convex.” *Id.* at 2:26–27.

Figure 14 of the '696 patent is reproduced below:

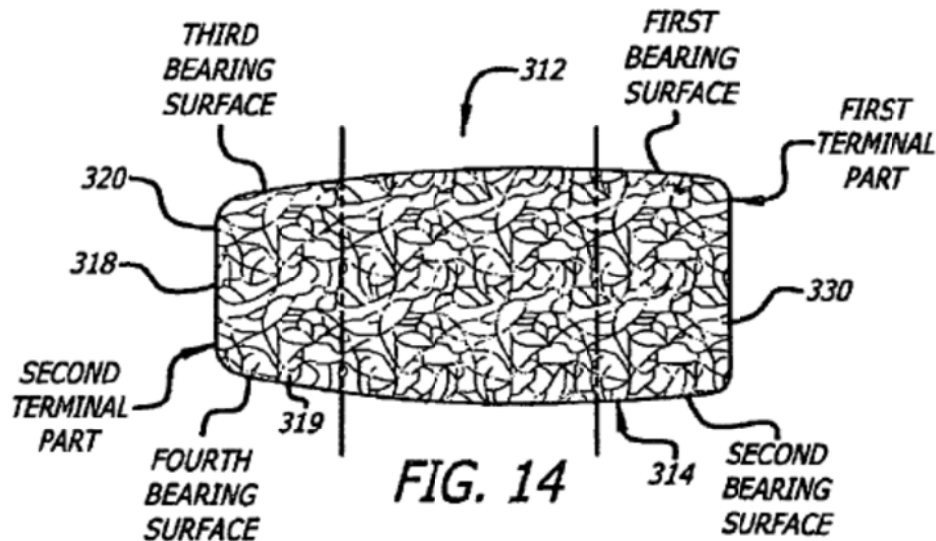


Figure 14, above, is a left side elevational view of a lordotic interbody spinal fusion implant. *Id.* at 5:11–12.

The implant shown in Figure 14 has insertion end 320 and trailing end 330.

*Id.* at 9:18–19. In addition,

the implant 300 includes a first terminal part defining a first bearing surface adapted to bear against an endplate of the vertebrae  $V_1$ , and an opposite second bearing surface adapted to bear against an endplate of the vertebrae  $V_2$ . The implant 300 also includes a second terminal part opposite the first terminal part. The second terminal part defines a third bearing surface adapted to bear against the endplate of the vertebrae  $V_1$  and a fourth bearing surface adapted to bear against the endplate of the vertebrae  $V_2$ .

*Id.* at 9:20–29.

The '696 patent teaches further, that when a posterior lumbar interbody fusion is performed, it is not possible to replace the removed portions of the disc with a single, large implant. *Id.* at 2:35–38. In such cases, a “modular implant” may be used. *Id.* at 2:40–42. The modular implants are as long as the length of the disc material that is removed, but are narrower, and thus, can be “introduced into

the disc space from the posterior aspect to either side of the dural sac, and then aligned side to side within the disc space so that a number of them each having a length consistent with the depth of the disc removed in that area would in combination have a width equal to the width of the disc material removed.” *Id.* at 2:42–50.

According to the ’696 patent, the disc spaces in the lumbar spine are generally lordotic, and thus the modular implants would be taller at the insertion end than the trailing end. *Id.* at 2:55–58. As the insertion of such implants may be problematic, the implant may incorporate a mechanism that engages an insertion instrument at its trailing end, such as a box and threaded opening, which allows the modular implant to be rotated ninety degrees to its fully upright position after insertion. *Id.* at 2:59–62, 3:7-26.

### C. Representative Claims

NuVasive challenges claims 7–12 of the ’696 patent. Claims 7 and 10 are independent claims. Claim 7 is representative, and reads as follows:

7. A lordotic spinal fusion implant for insertion between a first vertebra and a second vertebra adjacent the first vertebra, the first vertebra having a generally vertically extending first peripheral wall and a first endplate and the second vertebra having a generally vertically extending second peripheral wall and a second endplate, wherein the implant comprises:

a first terminal part defining a trailing face, a first bearing surface adapted to bear against a portion of the first endplate, and an opposite second bearing surface adapted to bear against a portion of the second endplate, said trailing face extending between said first bearing surface and second bearing surface;

a second terminal part opposite said first terminal part, said second terminal part having an insertion face extending

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