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28 UNITED STATES DISTRICT COURT
SOUTHERN DISTRICT OF CALIFORNIA

29
30 MEDTRONIC SOFAMOR DANEK
31 USA, INC.; WARSAW
32 ORTHOPÉDIC, INC.; MEDTRONIC
33 PUERTO RICO OPERATIONS CO.;
34 and MEDTRONIC SOFAMOR
35 DANEK DEGGENDORF, GmbH,
36
37 Plaintiffs,
38
39 v.
40
41 NUVASIVE, INC.
42
43 Defendant.

Case No.: 3:08-cv-01512-LAB-AJB
FIRST AMENDED COMPLAINT
FOR PATENT INFRINGEMENT
JURY TRIAL DEMANDED

1 Plaintiffs Medtronic Sofamor Danek USA, Inc. (“Medtronic USA”), Warsaw
2 Orthopedic, Inc. (“Warsaw”), Medtronic Puerto Rico Operations Co. (“Medtronic
3 Puerto Rico”), and Medtronic Sofamor Danek Deggendorf, GmbH (“Medtronic
4 Deggendorf”) bring this First Amended Complaint against defendant NuVasive, Inc.
5 (“NuVasive”), alleging as follows:

6 **PARTIES, JURISDICTION, AND VENUE**

7 1. Plaintiff Medtronic USA is a Tennessee corporation, with its principal
8 place of business in Memphis, Tennessee. Medtronic USA is a leading distributor of
9 medical devices and instruments for use in the spine, including spinal implants.

10 2. Plaintiff Warsaw is an Indiana corporation, with its principal place of
11 business in Winona Lake, Indiana.

12 3. Plaintiff Medtronic Puerto Rico is a Cayman Islands corporation, with its
13 principal place of business in Villalba, Puerto Rico.

14 4. Plaintiff Medtronic Deggendorf is a German corporation, with its principal
15 place of business in Deggendorf, Germany.

16 5. Defendant NuVasive is a Delaware corporation, with its principal place of
17 business in San Diego, California. NuVasive manufactures and markets various
18 medical devices and instruments for use in the spine, including spinal implants.

19 6. This action arises under the patent laws of the United States, Title 35 of
20 the United States Code.

21 7. This Court has subject matter jurisdiction over the action pursuant to 28
22 U.S.C. §§ 1331 and 1338(a) in that this action arises under the Acts of Congress
23 relating to patents.

24 8. Upon information and belief, NuVasive transacts business in this judicial
25 district by manufacturing, selling, or offering to sell products that infringe, by
26 contributing to the infringement of the patents at issue in this action, or by conducting
27 other business within this judicial district.
28

1 9. Venue is proper in this district pursuant to 28 U.S.C. §§ 1391(b), 1391(c)
2 and/or 1400(b).

3 **COUNT I**

4 10. Paragraphs 1-9 are incorporated into this count by reference.

5 11. United States Patent No. 5,860,973 (the "'973 patent," a copy of which is
6 attached hereto as Exhibit A), entitled "Translateral Spinal Implant," issued on January
7 19, 1999. Plaintiff Warsaw is the owner of the '973 patent by assignment, as recorded
8 at the United States Patent and Trademark Office, Reel 018883, Frame 0400. Plaintiffs
9 Medtronic USA, Medtronic Puerto Rico, and Medtronic Deggendorf are co-exclusive
10 licensees of the '973 patent from Plaintiff Warsaw and, together with Plaintiff Warsaw,
11 share the exclusive right to bring suit for infringement of the patent.

12 12. NuVasive is infringing and has infringed the '973 patent by making,
13 selling, offering for sale, and using infringing products, including but not limited to its
14 CoRoent XL product, within the United States.

15 13. NuVasive's infringement of the '973 patent has caused and will continue
16 to cause Plaintiffs substantial damages, and has caused and will continue to cause
17 Plaintiffs irreparable harm for which there is no adequate remedy at law.

18 **COUNT II**

19 14. Paragraphs 1-9 are incorporated into this count by reference.

20 15. United States Patent No. 5,772,661 (the "'661 patent," a copy of which is
21 attached hereto as Exhibit B), entitled "Methods and Instrumentation for the Surgical
22 Correction of Human Thoracic and Lumbar Spinal Disease from the Antero-Lateral
23 Aspect of the Spine," issued on June 30, 1998. Plaintiff Warsaw is the owner of the
24 '661 patent by assignment, as recorded at the United States Patent and Trademark
25 Office, Reel 018323, Frame 0173. Plaintiffs Medtronic USA, Medtronic Puerto Rico,
26 and Medtronic Deggendorf are co-exclusive licensees of the '661 patent from Plaintiff
27
28

1 Warsaw and, together with Plaintiff Warsaw, share the exclusive right to bring suit for
2 infringement of the patent.

3 16. On information and belief, NuVasive has contributed to acts of
4 infringement of the '661 patent, such acts having been committed in the United States.
5 Such acts of infringement have been committed by at least Doctors Burak M. Ozgur,
6 Henry E. Aryan, Luiz Pimenta, and William R. Taylor as evidenced by the technical
7 report entitled "Extreme Lateral Interbody Fusion (XLIF): a novel surgical technique
8 for anterior lumbar interbody fusion," published in The Spine Journal 6, in 2006, and
9 attached as Exhibit C.

10 17. By selling, offering to sell, and promoting and teaching the use of at least
11 its CoRoent XL product, NuVasive has contributed to the infringement and continues
12 to contribute to the infringement of the '661 patent, under 35 U.S.C. § 271(c), by
13 selling, offering to sell, and promoting and teaching components and/or materials that
14 are especially made or especially adapted for use in direct infringement of at least one
15 of the methods claimed in the '661 patent, and are not a staple article suitable for
16 substantial non-infringing use.

17 18. NuVasive's contributory infringement of the '661 patent has caused and
18 will continue to cause Plaintiffs substantial damages, and has caused and will continue
19 to cause Plaintiffs irreparable harm for which there is no adequate remedy at law.

20 COUNT III

21 19. Paragraphs 1-9 are incorporated into this count by reference.

22 20. United States Patent No. 6,936,051 B2 (the "'051 patent," a copy of which
23 is attached hereto as Exhibit D), entitled "Multilock Anterior Cervical Plating System,"
24 issued on August 30, 2005. Plaintiff Warsaw is the exclusive licensee of the '051
25 patent. Plaintiffs Medtronic USA, Medtronic Puerto Rico, and Medtronic Deggendorf
26 are co-exclusive sub-licensees of the '051 patent from Plaintiff Warsaw and, together
27 with Plaintiff Warsaw, share the right to bring suit for infringement of the patent.
28

1 21. NuVasive is infringing and has infringed the '051 patent by making,
2 selling, offering for sale, and using infringing products, including but not limited to its
3 Gradient product, within the United States.

4 22. NuVasive's infringement of the '051 patent has caused and will continue
5 to cause Plaintiffs substantial damages, and has caused and will continue to cause
6 Plaintiffs irreparable harm for which there is no adequate remedy at law.

7 **COUNT IV**

8 23. Paragraphs 1-9 are incorporated into this count by reference.

9 24. United States Patent No. 6,936,050 B2 (the "'050 patent," a copy of which
10 is attached hereto as Exhibit E), entitled "Multilock Anterior Cervical Plating System,"
11 issued on August 30, 2005. Plaintiff Warsaw is the exclusive licensee of the '050
12 patent. Plaintiffs Medtronic USA, Medtronic Puerto Rico, and Medtronic Deggendorf
13 are co-exclusive sub-licensees of the '050 patent from Plaintiff Warsaw and, together
14 with Plaintiff Warsaw, share the right to bring suit for infringement of the patent.

15 25. NuVasive is infringing and has infringed the '050 patent by making,
16 selling, offering for sale, and using infringing products, including but not limited to its
17 Gradient product, within the United States.

18 26. NuVasive's infringement of the '050 patent has caused and will continue
19 to cause Plaintiffs substantial damages, and has caused and will continue to cause
20 Plaintiffs irreparable harm for which there is no adequate remedy at law.

21 **COUNT V**

22 27. Paragraphs 1-9 are incorporated into this count by reference.

23 28. United States Patent No. 6,916,320 B2 (the "'320 patent," a copy of which
24 is attached hereto as Exhibit F), entitled "Anterior Cervical Plate System," issued on
25 July 12, 2005. Plaintiff Warsaw is the owner of the '320 patent by assignment, as
26 recorded at the United States Patent and Trademark Office, Reel 018207, Frame 0410.
27 Plaintiffs Medtronic USA, Medtronic Puerto Rico, and Medtronic Deggendorf are co-
28

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