UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE PATENT TRIAL AND APPEAL BOARD
MEDTRONIC, INC. Petitioner
V.
NUVASIVE, INC. Patent Owner

Case IPR2013-00504 Patent 8,361,156

PATENT OWNER NUVASVE INC.'S PRELIMINARY RESPONSE



TABLE OF CONTENTS

I.	INTRODUCTION1		
II.	STRU	156 PATENT CLAIMS AN IMPLANT WITH A UNIQUE COMBINATION OF JCTURES PARTICULARLY SUITED FOR A LATERAL, TRANS-PSOAS ROACH	3
III.	STAN	IDARD FOR GRANTING INTER PARTES REVIEW	7
IV.	DISCI	PRIOR ART CITED BY MEDTRONIC UNDER ALL GROUNDS 1-5 FAILS TO LOSE OR SUGGEST THE CLAIMED MAXIMUM LATERAL WIDTH ENDING ALONG A MEDIAL PLANE, AS RECITED IN CLAIM 1	8
	A.	The references advanced in Ground 1 fail to disclose or suggest the claimed maximum lateral width extending along a medial plane, as required by independent claim 1	
	В.	The references advanced in Ground 2 fail to disclose or suggest the claimed maximum lateral width extending along a medial plane, as required by independent claim 1	
	C.	The references advanced in Ground 3 fail to disclose or suggest the claimed maximum lateral width extending along a medial plane, as required by independent claim 1	
	D.	The references advanced in Ground 4 fail to disclose or suggest the claimed maximum lateral width extending along a medial plane, as required by independent claim 1	
	E.	The references advanced in Ground 5 fail to disclose or suggest the claimed maximum lateral width extending along a medial plane, as required by independent claim 1	
V.	THE PRIOR ART CITED BY MEDTRONIC UNDER ALL GROUNDS 1-5 FAILS TO DISCLOSE OR SUGGEST THE CLAIMED IMPLANT WHERE THE LONGITUDINA LENGTH IS GREATER THAN 40 MM, AS RECITED IN CLAIM 5		
	A.	The references advanced in Grounds 1-2 and 4-5 fail to disclose or suggest the claimed implant having a longitudinal length greater than 40 mm, as required by independent claim 5	9



	B.	The "alternative" argument in Ground 3 relies upon an improper modification to Frey's implant, and the resulting combination of references in Ground 3 would not provide the claimed implant having a longitudinal length greater than 40 mm, as required by independent claim 5	
VI.	DISCL LOWE	RIOR ART CITED BY MEDTRONIC UNDER ALL GROUNDS 1-5 FAILS TO OSE OR SUGGEST THE CLAIMED IMPLANT WHERE THE UPPER AND R SURFACES ARE GENERALLY PARALLEL TO ONE ANOTHER, AS ED IN CLAIM 12	
VII.		RONIC FAILED TO SHOW WHY PROPOSED GROUNDS 1-5 ARE NOT NDANT WITH ONE ANOTHER	. 30
VIII.	REDU	RONIC FAILED TO SHOW WHY PROPOSED GROUNDS 1-5 ARE NOT NDANT WITH THE OTHER GROUNDS SET FORTH IN THE TERPART IPR CASE NO. IPR2013-00506	. 32
IX.	CONC	LUSION	. 34
	CERTI	FICATE OF SERVICE	



TABLE OF AUTHORITIES

Case Law

Kinetic Concepts, Inc. v. Smith & Nephew, Inc., 688 F.3d 1342 (Fed. Cir	. 2012)7
Schering Corp. v. Geneva Pharm., Inc., 339 F.3d 1373 (Fed. Cir. 2003)	22
Bettcher Indus., Inc. v. Bunzl USA, Inc., 661 F.3d 629 (Fed. Cir. 2011)	22
In re Oelrich, 666 F.2d 578 (CCPA 1981)	22
In re Gordon, 733 F.2d 900, 902 (Fed. Cir. 1984)	18, 24, 27
In re Ratti, 270 F.2d 810, 813 (CCPA 1959)	18, 27, 28
Decisions of the Patent Trial and Appeal Board	
MicroStrategy, Inc. v. Zillow, Inc., IPR2013-00034, (PTAB Apr. 2, 2013)	31, 32
Liberty Mut. Ins. Co. v. Progressive Cas. Ins. Co., CBM2012-00003, (PTAB Oct. 25, 2012)	31, 32
<u>Statutes</u>	
35 U.S.C. § 103 (2012)	7, 11, 14, 15, 16, 17
35 U.S.C. § 314 (2012)	7
35 U.S.C. § 316 (2012)	7
Rules and Regulations	
37 C.F.R. § 42.108 (2013)	7
Office Patent Trial Practice Guide, 77 Fed. Reg. 48.756 (Aug. 14, 2012)	



Patent No. 8,361,156 Preliminary Response

Case IPR2013-00504 Attorney Docket No: 13958-0116IP1

EXHIBITS

Ex. #	Exhibit Description
NUVA 2001	U.S. Patent No. 7,905,840 to Pimenta et al.



DOCKET A L A R M

Explore Litigation Insights



Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

Real-Time Litigation Alerts



Keep your litigation team up-to-date with **real-time** alerts and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

Advanced Docket Research



With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

Analytics At Your Fingertips



Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

LAW FIRMS

Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

FINANCIAL INSTITUTIONS

Litigation and bankruptcy checks for companies and debtors.

E-DISCOVERY AND LEGAL VENDORS

Sync your system to PACER to automate legal marketing.

