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Paper 9
Entered: February 13, 2014

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MEDTRONIC, INC.
Petitioner

v.

NUVASIVE, INC.
Patent Owner

Case IPR2013-00506
Patent 8,361,156

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

Medtronic, Inc. ("Medtronic") filed a petition ("Pet.") requesting an *inter partes* review of claims 1–14, 19, 20, and 23–27 of U.S. Patent No. 8,361,156 (Ex. 1115), "the '156 patent") on August 14, 2013. Paper 1. Patent Owner, NuVasive, Inc. ("NuVasive"), filed a preliminary response on November 25, 2013. Paper 8. 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 Medtronic has established a reasonable likelihood that it would prevail with respect to claims 1–14, 19, 20, and 23–27 of the '156 patent. Accordingly, we grant the Petition, and institute an *inter partes* review of claims 1–14, 19, 20, and 23–27 of the '156 patent.

A. Related Proceedings

Medtronic indicates that it has filed concurrently another petition for an *inter partes* review of the '156 patent. Pet. 2. Medtronic indicates further that it is a named counterclaim-defendant in the litigation titled *Warsaw Orthopedic, Inc. v.*

NuVasive Inc., Case No: 3:12-cv-02738-CAB-MDD (S.D. Cal.), which also involves the '156 patent. Pet. 1.

B. The '156 Patent (Ex. 1115)

The '156 patent is drawn to a spinal implant, and methods of spinal fusion using the implant. '156 patent, col. 1, ll. 20–24. A spinal fusion procedure generally involves removing some or all of a diseased spinal disc, and inserting an intervertebral implant into the disc space. *Id.* at col. 1, ll. 30–33. The spinal fusion implant is introduced into the disc space via a lateral approach to the spine, or via a posterior, anterior, antero-lateral, or postero-lateral approach. *Id.* at col. 5, ll. 29–35. As taught by the '156 patent, the implant is made from a material "having suitable radiolucent characteristics," such as PEEK (poly-ether-ether-ketone). *Id.* at col.5, ll. 10-15.

C. Representative Claim

Medtronic challenges claims 1–14, 19, 20, and 23–27 of the '156 patent. Claims 1 is the only independent claim, and reads as follows:

1. A spinal fusion implant of non-bone construction positionable within an interbody space between a first vertebra and a second vertebra, said implant comprising:

> an upper surface including anti-migration elements to contact said first vertebra when said implant is positioned within the interbody space, a lower surface including anti-migration elements to contact said second vertebra when said implant is positioned within the interbody space, a distal wall, a proximal wall, a first sidewall, and a second sidewall generally opposite from the first sidewall, wherein said distal wall, proximal wall, first sidewall, and second sidewall comprise a radiolucent material;

wherein said implant has a longitudinal length extending from a proximal end of said proximal wall to a distal end of said distal wall, said implant has a maximum lateral width extending from said first sidewall to said second sidewall along a medial plane that is generally perpendicular to said longitudinal length, and said longitudinal length is greater than said maximum lateral width;

at least a first fusion aperture extending through said upper surface and lower surface and configured to permit bone growth between the first vertebra and the second vertebra when said implant is positioned within the interbody space, said first fusion aperture having: a longitudinal aperture length extending generally parallel to the longitudinal length of said implant, and a lateral aperture width extending between said first sidewall to said second sidewall, wherein the longitudinal aperture length is greater than the lateral aperture width; and

at least first and second radiopaque markers oriented generally parallel to a height of the implant, wherein said first radiopaque marker extends into said first sidewall at a position proximate to said medial plane, and said second radiopaque marker extends into said second sidewall at a position proximate to said medial plane.

D. Prior Art Relied Upon

Medtronic relies upon the following prior art references:

Michelson ("Michelson"), US 5,860,973, issued January 19, 1999 (Ex. 1105).

Frey *et al.* ("Frey"), U.S. Patent Appl. Pub. No. 2002/0165550 A1, published November 7, 2002 (Ex. 1103).

Baccelli *et al.* ("Baccelli"), U.S. Patent Appl. Pub. No. 2003/0028249 A1, published February 6, 2003 (Ex. 1104).

Synthes Vertebral Spacer–PR Brochure, Synthes Spine 2002 ("SVS"; Ex. 1106).

Medtronic Sofamor Danek, Telamon, Verte-Stack PEEK Vertebral Body spacer (Ex. 1107); and Telamon, Posterior Impacted Fusion Devices, 2003 (Ex. 1108) (collectively, "Telamon").

The Asserted Grounds of Unpatentability

Medtronic challenges the patentability of the claims of the '156 patent on the following grounds. Pet. 14, 37–38.

Reference(s)	Basis	Claims challenged
SVS and Baccelli	§ 103	1–4, 7, 8, 11, 12, 14, 19, 20, 23, 24, and 26
SVS, Baccelli, and Frey or Michelson	§ 103	5–8
SVS, Baccelli, and Michelson	§ 103	9
SVS and Baccelli with or without Frey	§ 103	10 and 27
SVS and Baccelli, with or without Frey or Michelson	§ 103	13
SVS, Baccelli, and Telamon or Frey	§103	25
Telamon and Baccelli	§103	1, 2, 4, 7, 10–14, 19, 20, and 23–27
Telamon and Baccelli, with or without Frey	§103	3
Telamon, Baccelli, and Frey or Michelson	§103	5–7
Telamon, Baccelli, Frey, and Michelson or SVS	§103	8
Telamon, Baccelli, and Michelson	§103	9

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