

BIN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF DELAWARE

NUVASIVE, INC.,

Plaintiff and
Counterclaim-Defendant,

v.

GLOBUS MEDICAL, INC.,

Defendant and
Counterclaim-Plaintiff.

C. A. No. 1:10-CV-00849-LPS

[REDACTED]

REDACTED VERSION

**NUVASIVE, INC.'S ANSWERING BRIEF IN OPPOSITION TO
GLOBUS MEDICAL, INC.'S MOTIONS FOR PARTIAL SUMMARY JUDGMENT**

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Dated: October 29, 2013

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TABLE OF AUTHORITIES

CASES

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