

1 IN RE: NuVASIVE

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4 CASE NO.: 2015-1672

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8 TRANSCRIPTION OF AUDIO RECORDED PROCEEDINGS

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10 RECORDING OF: Court Hearing

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12 TAKEN BEFORE: Judge Kimberly Ann Moore

Judge Richard Taranto

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Judge Evan Wallach

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15 COUNSEL FOR NUVASIVE: Michael T. Rosato, Esquire

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17 COUNSEL FOR INTERVENOR: Joseph Matal, Esquire

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P R O C E E D I N G S

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2 THE BAILIFF: The United States Court of Appeals
3 for the Federal Circuit is now open and in session.
4 God save the United States and this Honorable Court.

5 JUDGE MOORE: Please, be seated. Good morning.
6 Our first case for today is 2015-1672, in RE:
7 NuVasive. Mr. Rosato, please proceed.

8 MR. ROSATO: Thank you, Your Honor. And I had
9 reserved five minutes for rebuttal. May it
10 please the Court. As Your Honor noted, this is an
11 appeal from two inter partes reviews, the 2013 507,
12 508, both involving NuVasive's Patent No. 8187334,
13 directed to lateral spinal fusion implants.
14 Respectfully, the board's finding of unpatentability
15 should be reversed because the decision, both
16 decisions in both of the IPRs errored by crafting and
17 relying on new grounds of unpatentability in its final
18 written decisions, while explicitly refusing to give
19 NuVasive an opportunity to respond.

20 JUDGE MOORE: Well, is it really a new ground of
21 unpatentability? It's Figure 18, correct? Is that
22 what we're --

23 MR. ROSATO: Correct.

24 JUDGE MOORE: -- talking about? Of the same
25 reference that was the ground of patentability that

1 was being considered. At all times it was obviousness
2 of these particular references in combination. So why
3 is it a new ground of patentability?

4 MR. ROSATO: It's a new ground because the theory
5 of unpatentability and the thrust of the invention,
6 had completely changed. It changed from one theory
7 and a particular embodiment, to a completely different
8 embodiment that quite frankly addresses or presents a
9 type of implant that is fundamentally different, not
10 only from the embodiment of the Michaelson disclosure
11 that was originally relied upon, but every other
12 single implant that was addressed or presented in any
13 of the references.

14 JUDGE WALLACH: You're the one who, in your
15 response before PTAB included Michaelson 16, 19 and
16 20. And 16 and 19 are on the same page. And in
17 between them is 18. But you didn't include 18. Why
18 not? That says something to me.

19 MR. ROSATO: Well, okay. Well, I'm interested to
20 hear what that says. My explanation of that would be
21 Figure 18 and Figure 19 are describing the same
22 embodiment. Figure 18 shows one piece of a
23 multi-piece assembly implant. So the point that was
24 being made in the response, and it's a valid and
25 un rebutted point, Your Honor, is that all of the

1 implants in Michaelson are designed to be oversized,
2 both in length and width. And that was the point.

3 JUDGE WALLACH: What, you're interested in what
4 it says to me? It says when you exclude something
5 from the body of a document, and it turns out that
6 that information is relevant, then it tells me that if
7 I were at a trial level anywhere, I would immediately
8 say to myself, gee, what's in that hole.

9 MR. ROSATO: In the -- you know, it's a -- it's a
10 fair question to want to know what's there. I don't
11 think there was any intent to skip over things. The
12 point that was being made --

13 JUDGE WALLACH: Well, of course there was. You
14 left it out. It was left out. I mean --

15 MR. ROSATO: Well, I respectfully would submit
16 the intent was not to hide anything, Your Honor. The
17 point being made, and if you read the briefing on that
18 point, was taking the petitions --

19 JUDGE WALLACH: You can take it. We read the
20 briefing.

21 MR. ROSATO: Okay. I -- I feel very assured that
22 that is the case. But the -- the argument that was
23 being made was in response to what was presented in
24 the petition. The petition case was resize the
25 primary implants according to the dimensions of the

1 Michaelson implant. And there was one implant cited
2 in the petition. So taking that suggestion to its
3 logical conclusion was the argument.

4 JUDGE WALLACH: Why wasn't Hynes asked about 18?
5 Because you were permitted below to cross examine him
6 and file motions for observations and so on?

7 MR. ROSATO: So this gets to the issue of whether
8 observations on cross examination after reply
9 constitute an opportunity to respond. And they don't.

10 JUDGE TARANTO: Well, it's some opportunity. It
11 just may not be enough opportunity.

12 MR. ROSATO: True.

13 JUDGE TARANTO: You can't put in your own
14 evidence.

15 MR. ROSATO: Exactly.

16 JUDGE TARANTO: Right. So can I just focus on --
17 on this? In one of the two Medtronic petitions, there
18 is a reference to -- what is it, Column 10, which --
19 of -- of -- of Michaelson, which contains the
20 descriptions of 18 and 19. And let's just assume for
21 these purposes that 18 and 19 teach the same thing in
22 terms of a long and wide and narrow implant, each one
23 of them all by itself. Why was, just as to that,
24 which is -- is that the 507? That's the 507 IPR?

25 MR. ROSATO: I think it's the 507, right.

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