

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

NUVASIVE, INC.
Petitioner

v.

WARSAW ORTHOPEDIC, INC.
Patent Owner

Patent Number: 8,251,997 B2

Issue Date: August 28, 2012

METHOD FOR INSERTING AN ARTIFICIAL IMPLANT BETWEEN TWO
ADJACENT VERTEBRAE ALONG A CORONAL PLANE

Case IPR2013-00206

PETITIONER'S REPLY TO PATENT OWNER'S RESPONSE

TABLE OF CONTENTS

I.	Introduction	1
II.	Claim Interpretations	1
	A. “Coronal plane” path to spine (claims 1, 9, 17 and 24)	1
	B. “Elongated portion” (claims 9, 17 and 24)	1
	C. Implant length/vertebrae width ratio: “Substantially the full traverse width (claims 1, 9 and 17) and the “full transverse width” (claim 24)	2
III.	Jacobson discloses a direct lateral approach that meets the “coronal plane” path limitation and teaches the insertion of a fusion implant (Claims 9-30: Ground 6)	6
IV.	Brantigan ‘327 discloses the lateral insertion of an implant, and even if it didn’t, that is not necessary for obviousness (Claims 17-23: Grounds 3-4)	7
V.	Brantigan ‘327 meets the “substantially the full transverse width of the vertebrae” claim limitation (at least Claims 17-23: Grounds 3-4)	9
VI.	Michelson ‘247, when inserted laterally according to the teachings of Jacobson, would meet the “substantially” or “full” transverse width limitations (at least Claims 9-16 and 24-30: Grounds 1-2 and 5-6)	10
VII.	Claims 24-30: If this Board interprets the claim 24 limitation of “full transverse width” different from claims 9 and 17, then either Michelson ‘247 meets claim 24 (under Grounds 5-6) or the validity of claims 24-30 under Ground 8 should be considered	11
VIII.	The claimed “elongated portions”	12
IX.	The “non-combinable” arguments of Warsaw have no merit	12
X.	Warsaw’s secondary considerations arguments for patentability cannot pass scrutiny	13
XI.	Conclusion	15

EXHIBITS

NUVASIVE 1001	Declaration of Dr. McAfee, M.D., M.B.A.
NUVASIVE 1002	U.S. Patent No. 8,251,997 to Michelson (“997 patent”)
NUVASIVE 1003	Select Prosecution History of the ‘997 patent
NUVASIVE 1004	U.S. Pat. No. 4,545,374 to Jacobson (“Jacobson”)
NUVASIVE 1005	Leu et al., <i>Percutaneous Fusion of the Lumbar Spine</i> , Spine Vol. 6, No. 3, pp. 593-604 (September 1992) (“Leu”)
NUVASIVE 1006	U.S. Pat. No. 5,192,327 to Brantigan (“Brantigan”)
NUVASIVE 1007	U.S. Pat. No. 4,917,704 to Frey et al. (“Frey”)
NUVASIVE 1008	U.S. Pat. No. 5,015,247 to Michelson (“Michelson ‘247”)
NUVASIVE 1009	U.S. Pat. No. 5,569,290 to McAfee (“McAfee”)
NUVASIVE 1010	U.S. Pat. No. 5,772,661 to Michelson (“Michelson ‘661”)
NUVASIVE 1011	U.S. Pat. No. 8,343,224 to Lynn et al. (“Lynn”)
NUVASIVE 1012	Affidavit of Mr. Frank E. Scherkenbach in support of Petitioner’s Motion for <i>Pro Hac Vice</i> Admission
NUVASIVE 1013	Resume of Mr. Frank E. Scherkenbach, provided as an exhibit to Petitioner’s Motion for <i>Pro Hac Vice</i>

- NUVASIVE 1014 Cover page and Affidavit of Henry Vernon Crock, AO, MD, MS, FRCS, FRACS, FRCS Ed (Hon), D. Sc (Honoris causa), of Melbourne, Australia, made September 11, 2012
- NUVASIVE 1015 Exhibit HVC-1 to Affidavit of Henry Vernon Crock, being a copy of Federal Court of Australia Practice Note CM7
- NUVASIVE 1016 Exhibit HVC-2 to Affidavit of Henry Vernon Crock, being a copy of the curriculum vitae of Henry Vernon Crock
- NUVASIVE 1017 Exhibit HVC-3 to Affidavit of Henry Vernon Crock, being a copy of Crock, "Observations on the Management of Failed Spinal Operations," in The Journal of Bone and Joint Surgery, Vol. 58-B, No. 2, pp. 193-199, May 1976
- NUVASIVE 1018 Exhibit HVC-4 to Affidavit of Henry Vernon Crock, being a copy of Crock, "Anterior Lumbar Interbody Fusion – Indications for its Use and Notes on Surgical Technique," in Clinical Orthopedics and Related Research, No. 165, May 1982
- NUVASIVE 1019 Exhibit HVC-5 to Affidavit of Henry Vernon Crock, being a copy of Fujimaki et al., "The Results of 150 Anterior Lumbar Interbody Fusion Operations Performed by Two Surgeons in Australia," in in Clinical Orthopedics and Related Research, No. 165, May 1982
- NUVASIVE 1020 Exhibit HVC-6 to Affidavit of Henry Vernon Crock, being a copy of Crock, A Practice of Spinal Surgery, Springer-Verlag, Wein, New York, Revised 1st Edition, 1983

...

NUVASIVE 1021	Exhibit to HVC-7 Affidavit of Henry Vernon Crock, being a copy of Crock, <u>A Short Practice of Spinal Surgery</u> , Springer-Verlag, Wein, New York, Revised 2 nd Edition, 1993
NUVASIVE 1022	Reserved – no exhibit
NUVASIVE 1023	Reserved – no exhibit
NUVASIVE 1024	Reserved – no exhibit
NUVASIVE 1025	Reserved – no exhibit
NUVASIVE 1026	Reserved – no exhibit
NUVASIVE 1027	Page 29 of NUVASIVE 1003, hand-annotated by Dr. Sachs during Feb. 25, 2014 Deposition
NUVASIVE 1028	Transcript of Deposition of Dr. Barton Sachs, Conducted Feb. 25, 2014
NUVASIVE 1029	Second Declaration of Dr. Paul McAfee, M.D., M.B.A.
NUVASIVE 1030	Declaration of Dr. Robert Jacobson, M.D.
NUVASIVE 1031	Declaration of Dr. John Brantigan, M.D.
NUVASIVE 1032	Declaration of Patrick Miles
NUVASIVE 1033	U.S. Patent No. 6,241,770 to Michelson
NUVASIVE 1034	U.S. Patent No. 5,397,364 to Kozak et al.
NUVASIVE 1035	U.S. Patent No. 5,792,044 to Foley et al.

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.