

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent of: Curran et al.

U.S. Patent No.: 8,361,156

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**PETITION FOR *INTER PARTES* REVIEW OF UNITED STATES
PATENT NO. 8,361,156 PURSUANT TO 35 U.S.C. §§ 311-319, 37 C.F.R. § 42**

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EXHIBITS

- MSD 1001 – Declaration of Richard Hynes, M.D. Regarding U.S. Patent No. 8,187,334
- MSD 1002 – Declaration of Steven D. DeRidder Regarding U.S. Patent Application Publication No. 2002/0165550
- MSD 1003 – U.S. Patent Application Publication No. 2002/0165550
- MSD 1004 – U.S. Patent Application Publication No. 2003/0028249
- MSD 1005 – U.S. Patent No. 5,860,973
- MSD 1006 – U.S. Patent Application Publication No. 2003/0100950
- MSD 1007 – U.S. Patent Application Publication No. 2003/0139813
- MSD 1008 – Prosecution History of U.S. Patent No. 8,187,334
- MSD 1009 – Prosecution History of U.S. Patent No. 7,918,891
- MSD 1010 – First Amended Complaint, filed on October 6, 2008, and Judgment Following Jury Verdict, entered on September 29, 2011, in *Warsaw Orthopedics, Inc. v. NuVasive, Inc.*, Case No. 3:08-CV-01512, Southern District of California
- MSD 1011 – *Curriculum Vitae* of Richard Hynes, M.D.
- MSD 1012 – S.H. Zhou et al., *Geometrical Dimensions of the Lower Lumbar Vertebrae – Analysis of Data from Digitised CT Images*, 9 EUR SPINE J 242, 244 (2000)
- MSD 1013 – U.S. Patent No. 8,361,156

Medtronic, Inc. (“Petitioner”) petitions for *Inter Partes* Review (“IPR”) under 35 U.S.C. §§ 311-319 and 37 C.F.R. § 42 of claims 1-14, 19, 20, and 23-27 of U.S. Patent No. 8,361,156 (the “‘156 patent”) (Exhibit MSD 1013). As set forth below, Petitioner demonstrates there is a reasonable likelihood of prevailing in its challenge of at least one of claims 1-14, 19, 20, and 23-27 identified in this petition as being unpatentable.

I. MANDATORY NOTICES UNDER 37 C.F.R. § 42.8

A. Real Party-in-Interest Under 37 C.F.R. § 42.8(b)(1)

Petitioner is the real party-in-interest for the instant petition.¹

B. Related Matters Under 37 C.F.R. § 42.8(b)(2)

Petitioner is not aware of any reexamination certificates or pending prosecution concerning the ‘156 patent. Petitioner is a named counterclaim-defendant in litigation concerning the ‘156 patent, *Warsaw Orthopedic, Inc. et al. v. NuVasive, Inc.*, originally filed in the Northern District of Indiana as Case No. 3:12-cv-00438-JD-CAN on August 17, 2012, and transferred to the Southern District of California on November 8, 2012, as case No. 3:12-cv-02738-CAB-MDD. The ‘156 patent was added by counterclaim filed on March 7, 2013.

¹ Other parties that have an interest in the instant petition include Petitioner’s co-counterclaim defendants in Case No. 3:12-cv-00438-JD-CAN; including: Medtronic Sofamor Danek U.S.A., Inc. and Medtronic Sofamor Danek Deggendorf, GmbH.

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