

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**

TABLE OF CONTENTS

I.	MANDATORY NOTICES UNDER 37 C.F.R. § 42.8	1
A.	Real Party-in-Interest Under 37 C.F.R. § 42.8(b)(1)	1
B.	Related Matters Under 37 C.F.R. § 42.8(b)(2)	1
C.	Lead and Back-Up Counsel Under 37 C.F.R. § 42.8(b)(3)	3
D.	Service Information	3
II.	PAYMENT OF FEES – 37 C.F.R. § 42.103	3
III.	REQUIREMENTS FOR IPR UNDER 37 C.F.R. § 42.104	3
A.	Grounds for Standing Under 37 C.F.R. § 42.104(a)	3
B.	Challenge Under 37 C.F.R. § 42.104(b) and Relief Requested	4
C.	Claim Construction under 37 C.F.R. §§ 42.104(b)(3)	5
1.	Distal Wall / Proximal Wall	5
2.	Releasably Mate	6
3.	Extend Generally Perpendicular to Said Longitudinal Length	6
4.	Elongate Body	7
5.	Generally Rectangular and Generally Oblong in Shape	7
6.	A Lateral Width of the Distal End of Said Distal Wall/A Lateral Width of Said Proximal End of Said Proximal Wall	8
7.	Oriented Generally Parallel to a Height of the Implant	8
IV.	SUMMARY OF THE ‘156 PATENT	8
A.	Overview of the ‘156 Patent	8
B.	Summary of the Prosecution History of the ‘156 Patent	10

C.	Legal Standard for Obviousness	12
V.	THE CHALLENGED CLAIMS ARE UNPATENTABLE	13
A.	Ground 1 – Claims 1-8, 10-14, 19, 20 and 23-27 Are Obvious Under § 103 over Frey in View of Baccelli	13
B.	Ground 2 – Claims 1-8, 10-14, 19, 20, and 23-27 Are Obvious Under § 103 over Frey in view of Baccelli and Messerli	37
C.	Ground 3 – Claims 1-14, 19, 20, and 23-27 Are Obvious Under § 103 over Frey in view of Baccelli and Michelson	38
D.	Ground 4 – Claims 1-8, 10-14, 19, 20, and 23-27 Are Obvious Under § 103 over Frey in view of Baccelli and Moret	43
E.	Ground 5 – Claims 1-8, 10-14, 19, 20, and 23-27 Are Obvious Under § 103 over Baccelli in view of Frey and/or Michelson	45
VI.	CONCLUSION	60

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. 8,361,156
- 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
- MSD 1014 – Gray, H., *Gray's Anatomy* 489 (Peter L. Williams et al. eds., 37th ed. 1989)

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). This Petition presents new arguments and provides new evidence to cure any noted deficiencies in Petitioner’s previously filed petition for IPR, now styled *Medtronic, Inc. v. NuVasive, Inc.*, Case No. IPR2013-00504 (LMG) (the “‘504 IPR”). In light of this newly offered information, 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

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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