

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MEDTRONIC, INC.,
Petitioner,

v.

NUVASIVE, INC.,
Patent Owner.

Case IPR2014-00487
Patent 8,361,156 B2

Before SALLY C. MEDLEY, LORA M. GREEN, and STEPHEN C. SIU,
Administrative Patent Judges.

GREEN, *Administrative Patent Judge.*

DECISION

Denying Institution of *Inter Partes* Review
37 C.F.R. § 42.108

I. BACKGROUND

Medtronic, Inc. (“Medtronic”) filed a Petition (“Pet.”) requesting an *inter partes* review of claims 1–14, 19, 20, and 23–27 of U.S. Patent No. 8,361,156 B2 (Ex. 1013, “the ’156 patent”) on March 5, 2014. Paper 1. Patent Owner, NuVasive, Inc. (“NuVasive”), filed a Patent Owner Preliminary Response (“Prelim. Resp.”). Paper 6. We have jurisdiction under 35 U.S.C. §§ 6(b) and 314.

Inter partes review is instituted only if the petition supporting the ground demonstrates “that there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.” 35 U.S.C. § 314(a); *see also* 37 C.F.R. § 42.108(c) (noting that *inter partes* review is only instituted if the petition demonstrates “that there is a reasonable likelihood that at least one of the claims challenged in the petition is unpatentable”).

Based on the circumstances in this case, we exercise our discretion under 35 U.S.C. § 325(d) to deny the Petition, and, therefore, decline to institute *inter partes* review.

A. Related Proceedings

Petitioner states it is a named counterclaim-defendant in a district court case involving the ’156 patent, *Warsaw Orthopedic, Inc. v. NuVasive Inc.*, Case No: 3:12-cv-02738-CAB-MDD (S.D. Cal.). Pet. 1–2.

Petitioner also indicates that it previously filed two other petitions for *inter partes* review of the ’156 patent on August 14, 2013: “the ’504 Petition” in IPR2013-00504 and “the ’506 Petition” in IPR2013-00506. Pet. 2. Petitioner notes that the Board instituted trial as to the ’506 Petition as claims 1–14, 19, 20, and 23–27 of the ’156 patent (“the ’506 Proceeding”), but denied the ’504 Petition. *Id.* According to Petitioner, the instant Petition remedies the deficiencies of the ’504 Petition, and also “adds new arguments and evidence as to the length disclosure of U.S. Patent Appl. Pub. No. 2002/0165550 to Frey.” *Id.*

B. The '156 Patent (Ex. 1013)

The '156 patent is drawn to a spinal implant, and methods of spinal fusion using the implant. '156 patent, col. 1, ll. 20–24. A spinal fusion procedure generally involves removing some, or all, of a diseased spinal disc, and inserting an intervertebral implant into the disc space. *Id.* at col. 1, ll. 30–33. The spinal fusion implant is introduced into the disc space via a lateral approach to the spine, or via a posterior, anterior, antero-lateral, or postero-lateral approach. *Id.* at col. 5, ll. 29–35. As taught by the '156 patent, the implant is made from a material “having suitable radiolucent characteristics,” such as poly-ether-ether-ketone (PEEK). *Id.* at col. 5, ll. 10–15.

C. Representative Claim

Medtronic challenges claims 1–14, 19, 20, and 23–27 of the '156 patent. Claim 1 is the only independent claim, and reads as follows (emphasis added):

1. A spinal fusion implant of non-bone construction positionable within an interbody space between a first vertebra and a second vertebra, said implant comprising:

an upper surface including anti-migration elements to contact said first vertebra when said implant is positioned within the interbody space, a lower surface including anti-migration elements to contact said second vertebra when said implant is positioned within the interbody space, a distal wall, a proximal wall, a first sidewall, and a second sidewall generally opposite from the first sidewall, wherein said distal wall, proximal wall, first sidewall, and second sidewall comprise a radiolucent material;

wherein said implant has a longitudinal length extending from a proximal end of said proximal wall to a distal end of said distal wall, *said implant has a maximum lateral width extending from said first sidewall to said second sidewall along a medial plane that is generally perpendicular to said longitudinal length, and said longitudinal length is greater than said maximum lateral width;*

at least a first fusion aperture extending through said upper surface and lower surface and configured to permit bone growth between the first vertebra and the second vertebra when said implant is positioned within the interbody space, said first fusion aperture having: a longitudinal aperture length extending generally parallel to the longitudinal length of said implant, and a lateral aperture width extending between said first sidewall to said second sidewall, wherein the longitudinal aperture length is greater than the lateral aperture width; and

at least first and second radiopaque markers oriented generally parallel to a height of the implant, wherein said first radiopaque marker extends into said first sidewall at a position proximate to said medial plane, and said second radiopaque marker extends into said second sidewall at a position proximate to said medial plane.

D. Prior Art Relied Upon

Medtronic relies upon the following prior art references:

Frey *et al.*, US Patent Appl. Pub. No. 2002/0165550 A1, published November 7, 2002 (Ex. 1003) (“Frey”).

Bacelli *et al.*, US Patent Appl. Pub. No. 2003/0028249 A1, published February 6, 2003 (Ex. 1004) (“Bacelli”).

Michelson, US 5,860,973, issued January 19, 1999 (Ex. 1005) (“Michelson”).

Moret, US Patent Appl. Pub. No. 2003/0100950 A1, published May 29, 2003 (Ex. 1006) (“Moret”).

Messerli *et al.*, US Patent Appl. Pub. No. 2003/0139813 A1, published July 24, 2003 (Ex. 1007) (“Messerli”).

E. The Asserted Grounds of Unpatentability

Medtronic challenges the patentability of claims of the ’156 patent on the following grounds. Pet. 4.

Reference(s)	Basis	Claims challenged
Frey and Baccelli	§ 103	1–8, 10–14, 19, 20, and 23–27
Frey, Baccelli, and Messerli	§ 103	1–8, 10–14, 19, 20, and 23–27
Frey, Baccelli, and Michelson	§ 103	1–14, 19, 20, and 23–27
Frey, Baccelli, and Moret	§ 103	1–8, 10–14, 19, 20, and 23–27
Baccelli and Frey and/or Michelson	§ 103	1–8, 10–14, 19, 20, and 23–27

II. ANALYSIS

Patent Owner argues that Petitioner is seeking *inter partes* review of claims 1–14, 19, 20, and 23–27 of the ’156 patent for a third time. Prelim. Resp. 1. According to Patent Owner, the instant Petition “is essentially a duplicate of its previously denied petition in the ’504 IPR.” *Id.* at 2.

As set forth in 35 U.S.C. § 325(d):

In determining whether to institute or order a proceeding under this chapter, chapter 30, or chapter 31, the Director may take into account whether, and reject the petition or request because, the same or

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.