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Paper 8
Entered: February 13, 2014

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MEDTRONIC, INC.
Petitioner

v.

NUVASIVE, INC.
Patent Owner

Case IPR2013-00504
Patent 8,361,156

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 (Ex. 1013, "the '156 patent") on August 14, 2013. Paper 3. Patent Owner, NuVasive, Inc. ("NuVasive"), filed a preliminary response on November 25, 2013. Paper 7. We have jurisdiction under 35 U.S.C. §§ 6(b) and 314.

The standard for instituting an *inter partes* review is set forth in 35 U.S.C. § 314(a), which states:

> THRESHOLD. – The Director may not authorize an inter partes review to be instituted unless the Director determines that the information presented in the petition filed under section 311 and any response filed under section 313 shows that there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.

Inter partes review is instituted only if the petition supporting the ground demonstrates "that there is a reasonable likelihood that at least one of the claims challenged in the petition is unpatentable." 37 C.F.R. § 42.108(c).

Upon consideration of the Petition, we conclude that Medtronic has not established a reasonable likelihood that it would prevail with respect to any of the challenged claims of the '156 patent. Accordingly, we deny the Petition, and decline to institute *inter partes* review.

A. Related Proceedings

Medtronic indicates that it has filed concurrently another petition for an *inter partes* review of the '156 patent. Pet. 2. Medtronic indicates further that it is a named counterclaim-defendant in the litigation titled *Warsaw Orthopedic, Inc. v.*

NuVasive Inc., Case No: 3:12-cv-02738-CAB-MDD (S.D. Cal.), which also involves the '156 patent. Pet. at 1.

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 PEEK (poly-ether-ether-ketone). *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:

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

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

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

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

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

E. The Asserted Grounds of Unpatentability

Medtronic challenges the patentability of claims of the '156 patent on the following grounds. Pet. 3.

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	§ 103	1–8, 10–14, 19, 20, and 23–27

II. ANALYSIS

A. Claim Construction

In an *inter partes* review, claim terms in an unexpired patent are given their broadest reasonable construction in light of the specification of the patent in which they appear. 37 C.F.R. § 42.100(b). Under the broadest reasonable construction standard, claim terms are given their ordinary and customary meaning in view of the specification as would be understood by one of ordinary skill in the art at the time of the invention. *In re Translogic Tech., Inc.*, 504 F.3d 1249, 1257 (Fed. Cir. 2007). Any special definition for a claim term must be set forth in the specification with reasonable clarity, deliberateness, and precision. *In re Paulsen*, 30 F.3d 1475, 1480 (Fed. Cir. 1994). For purposes of this Decision, we interpret

the claim language consistently with its plain and ordinary meaning, when read in view of the Specification.

B. Obviousness Challenges.

Claim 1 requires (emphasis added):

> 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*.

All of the challenges asserted by Medtronic in this proceeding rely on Frey (Ex. 1003) to teach the above limitation. Frey is drawn to implants that may be inserted into the spinal disc space, as well as techniques for insertion of the implant using a posterior lateral approach. Ex. 1003, ¶¶ [0002] and [0006].

According to Medtronic:

> Frey provides that the implant has a longitudinal length that extends from the proximal wall to the distal wall and a maximum lateral width extending from the first side wall to the second sidewall. As shown in Figure 63 of Frey, the longitudinal length is perpendicular to, and greater than, the maximum lateral width.

Pet. 18; *see id.* at 37, 38, 43, and 48.

Medtronic (Pet. 18) provides the following annotated reproduction of Figure 63 of Frey:

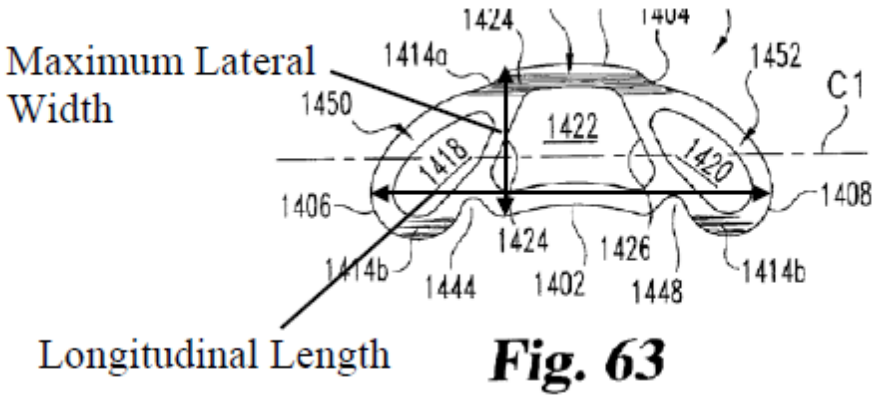

Fig. 63

Figure 63 of Frey shows an elevational view of an implant of Frey. Ex. 1003 ¶¶ 0071, 0075.

As asserted by NuVasive, however, Medtronic does not address the limitation that the "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," as required by claim 1. Prelim. Resp. 9-10. That is, while Medtronic identifies the longitudinal length, as well as the maximum lateral width, Medtronic does not specify how the maximum lateral width extends between the two sidewalls along the medial plane of the implant.

Moreover, Medtronic provides the following annotated reproduction of Figure 59 of Frey (Pet. 20):

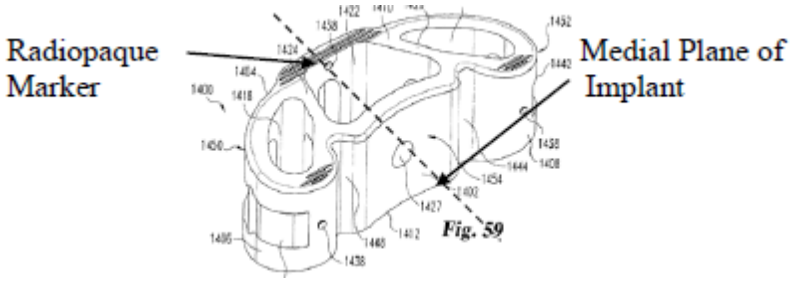

Figure 59 is a perspective view of an implant taught by Frey. Ex. 1003 ¶ 0071.

As can be seen from annotated Figure 59, Medtronic recognizes that the medial plane of the implant would be a plane that intersects the implant approximately at the midpoint of the longitudinal length. The maximal lateral width, as shown in annotated Figure 63, is not at the midpoint of the longitudinal length, but is closer to one end of the implant than the other. Stated differently, Medtronic does not explain how the maximum lateral width of the implant is along a medial plane that is generally perpendicular to the longitudinal length, as required by independent claim 1.

Thus, Medtronic has not demonstrated a reasonable likelihood that it will prevail on any of its challenges.

III. CONCLUSION

For the foregoing reasons, we determine that Medtronic has not demonstrated a reasonable likelihood that it will prevail on its challenges of claims 1–14, 19, 20, and 23–27 of the '156 patent. We, therefore, do not institute an *inter partes* review on any of the asserted grounds as to any of the challenged claims.

IV. ORDER

In consideration of the foregoing, it is hereby:

ORDERED that the Petition is *denied* as to all challenged claims of the '156 patent.

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