

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

substantially the same prior art or arguments previously were presented to the Office.

Petitioner argues that while it “is mindful of 35 U.S.C. § 325(d), the denial of the ’504 Petition has no bearing on this Petition.” Pet. 2.

According to Petitioner, it is responding to “a noted deficiency,” and is providing new evidence and argument as to how the previously supplied prior art renders the challenged claims obvious. *Id.* at 2–3. Petitioner argues further that the grounds presented in the instant Petition are not redundant to those that were instituted in the ’506 Proceeding, as “those grounds are based on different prior art references and different arguments.” *Id.* at 3.

Trial was instituted in the ’506 Proceeding on February 13, 2013. That proceeding involves the same patent, as well as the same claims, for which Petitioner is requesting *inter partes* review in the instant Proceeding. While Petitioner argues that the grounds are not redundant to those instituted on in the ’506 Proceeding, Petitioner does not provide any specific reasoning to support that argument, other than to state that the grounds are based on different prior art references. Oral argument is currently scheduled for November 18, 2014, in the ’506 proceeding.

Moreover, the instant Petition presents the same prior art previously presented in the ’504 Petition, and the proposed challenges to the claims are nearly identical to the proposed challenges in the ’504 Petition. *Compare* Pet. 4, *with* ’504 Petition 3 (same claims are challenged over the same prior art references). As in the ’504 Petition, in the instant proceeding Petitioner is relying on Frey (Ex. 1003) for teaching, or suggesting, the limitation of claim 1 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, and said longitudinal length is greater than said maximum lateral width.” Pet. 19, 48 (discussion of element “Claim 1 [E]”); *see also* IPR2013-00504, Paper 7, 6 (noting that Frey is relied upon as to all the asserted challenges to teach the recited limitation).

We have considered the papers filed in this proceeding, as well as the Petition and papers filed in the request for *inter partes* review in IPR2013-00504. Petitioner has not provided any persuasive reasoning as to why we should institute *inter partes* review over “the same or substantially the same prior art or arguments” that were presented by the ’504 Petition. In addition, Petitioner is involved in the ’506 Proceeding, which involves all of the same claims challenged here. Based on the totality of the facts before us, we exercise our discretion under 35 U.S.C. § 325(d), and deny the Petition in this proceeding.

III. ORDER

In consideration of the foregoing, it is hereby:

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

Case IPR2014-00487

Patent 8,361,156

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