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12 UNITED STATES DISTRICT COURT
 13 SOUTHERN DISTRICT OF CALIFORNIA
 14 SAN DIEGO DIVISION

15	NUVASIVE, INC., a Delaware) Case No. 18-cv-00347-CAB-MDD
16	corporation,)
17	Plaintiff,) MEMORANDUM OF POINTS AND
18	v.) AUTHORITIES IN SUPPORT OF
19) NUVASIVE, INC.’S MOTION TO
20	ALPHATEC HOLDINGS, INC., a) STRIKE ALPHATEC’S
21	Delaware corporation, and ALPHATEC) INVALIDITY CONTENTIONS
22	SPINE, INC., a California corporation,) PER CHAMBERS RULES, NO ORAL
23	Defendants.) ARGUMENT UNLESS SEPARATELY
24) ORDERED BY THE COURT
25)
26) Judge: Hon. Cathy Ann Bencivengo
27) Magistrate Judge: Mitchell D. Dembin
28)

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1 **I. INTRODUCTION**

2 Nearly two years ago on January 16, 2019, Alphatec successfully sought a
3 stay of proceedings regarding NuVasive’s U.S. Patent Nos. 8,361,156 (“the ’156
4 patent”) and 8,187,334 (“the ’334 patent”) (collectively, the “implant patents”) in
5 view of Alphatec’s then pending *inter partes* review (“IPR”) petitions seeking to
6 invalidate those patents.¹ In arguing for a stay, Alphatec made clear that that the
7 division of labor between the Court and the PTAB would promote efficiency by
8 allowing the PTAB to address whether the asserted claims were “valid and
9 enforceable.”

10 Most notably, should the PTAB institute IPR, no matter what the
11 outcome of the proceedings, **a stay would promote the efficient use of**
12 **this Court’s and the parties’ resources by allowing the PTAB to**
13 **assess whether the asserted claims of the ’156 and ’334 patents are**
14 **valid and enforceable.**

15 Doc. No. 142-1 at 12 (emphasis added). Alphatec also argued that a stay would
16 simplify the issues in this case “given the high likelihood that the PTAB both
17 institutes IPR *and* invalidates the asserted claims of the ’156 and ’334 patents.” *Id.*
18 (emphasis in original). And, finally, Alphatec assured the Court that, “even if the
19 asserted claims are upheld, the issues for trial will still be streamlined because
20 statutory estoppel would bind Alphatec in this action.” *Id.* at n.1.

21 In light of Alphatec’s representations in its Motion for Stay, NuVasive did not
22 oppose Alphatec’s motion, and the Court entered a stay of the implant patents on
23 February 6, 2019. Doc. No. 156 at 2 ¶ 5. Although the IPR Petitions were instituted
24 in July of 2019, Alphatec’s efforts to invalidate the asserted claims of the ’156 and
25 ’334 patents were largely unsuccessful. Doc. No. 288 at 2-3 and 288-1, -2, -3 Exs.

26 ¹ The ’156 and ’334 patents are based on the same application and have the same
27 specification. A provisional patent application was filed on March 29, 2004; and a
28 non-provisional application was filed on March 29, 2005. ’156 Patent at 1; ’334
Patent at 1. The ’156 patent was part of the original complaint filed in this action.
Doc. No. 1 (“2/13/18 Compl.”) The ’334 patent was added in the First Amended
Complaint filed in September of 2018. Doc. No. 110 (“FAC”).

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