

EXHIBIT D
TO DASHE DECLARATION

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16 Attorneys for Defendants
ALPHATEC HOLDINGS, INC. AND ALPHATEC SPINE, INC.

17 **UNITED STATES DISTRICT COURT**
18 **SOUTHERN DISTRICT OF CALIFORNIA – SAN DIEGO DIVISION**
19

20 NUVASIVE, INC., a Delaware
corporation,

21 Plaintiff,

22 v.

23 ALPHATEC HOLDINGS, INC., a
24 Delaware corporation and ALPHATEC
25 SPINE, INC., a California corporation,

26 Defendants.
27

Case No. 3:18-CV-00347-CAB-MDD

[Assigned to Courtroom 4C – Honorable
Cathy Ann Bencivengo]

**DEFENDANTS’ FINAL INVALIDITY
CONTENTIONS FOR U.S. PATENT
NOS. 8,361,156 AND 8,187,334**

Complaint Filed: February 13, 2018
Amended Complaint Filed: September 13,
2018

Jury Trial Demanded

1 **DEFENDANTS’ FINAL INVALIDITY CONTENTIONS FOR**
2 **U.S. PATENT NOS. 8,361,156 AND 8,187,334**

3 In accordance with the applicable rules of this Court, defendants Alphatec
4 Holdings, Inc. and Alphatec Spine, Inc. (collectively, “Alphatec” or “Defendants”)
5 hereby provide the following Final Invalidation Contentions for the following patents and
6 claims asserted by plaintiff NuVasive, Inc. (“NuVasive” or “Plaintiff”) in its Final
7 Invalidation Contentions served on November 6, 2020 (“Invalidation Contentions”):

- 8 • Claims 1, 5, 10, 18, and 24 of U.S. Patent No. 8,361,156 (the “’156 patent”);
9 • Claims 16 and 18 of U.S. Patent No. 8,187,334 (the “’334 patent”) (collectively,
10 the “Asserted Claims” of the “Implant Patents”).

11 Defendants’ Final Invalidation Contentions specifically address the above-listed claims of
12 the Implant Patents. Defendants contend that each of the Asserted Claims is invalid as
13 demonstrated herein. Defendants expressly reserve the right to disclose invalidity
14 contentions with respect to other claims of these patents and/or other patents, and to
15 respond to or rebut NuVasive’s arguments for claims asserted or arguments made
16 following its Invalidation Contentions. Defendants incorporate all previous invalidity
17 contentions, including their contentions in the Joint Discovery Plan (Doc. No. 292).

18 **I. GENERAL STATEMENT AND RESERVATION OF RIGHTS**

19 These invalidity contentions are based upon information currently available to
20 Defendants, prior to completion expert discovery related to the Implant Patents.
21 Therefore, Defendants reserve the right to amend or supplement these Final Invalidation
22 Contentions, including pursuant to the Court’s Scheduling Order (Doc. No. 293).
23 Further, additional facts, documents, and things, whether known or unknown to
24 Defendants, may become relevant to Defendants’ defenses. Accordingly, Defendants
25 reserve their right to revise, supplement, or amend these Final Invalidation Contentions as
26 additional grounds or evidence of invalidity are identified in this case, in response to
27 any of Plaintiff’s arguments, and/or to address any additional patents or claims that are
28 asserted hereafter.

1 Defendants take no position here regarding the appropriate construction of any
2 claim term, if any. For example, statements purporting to describe claim limitations are
3 not to be taken as admissions that such terms are definite or comply with 35 U.S.C. §
4 112. Defendants maintain that Plaintiff's Infringement Contentions are insufficient to
5 show infringement of any asserted claim under any claim construction. These Final
6 Invalidity Contentions shall not be treated as an admission that any of Defendants'
7 accused products infringe the Asserted Claims or as an admission to the scope of any
8 of the Asserted Claims.

9 Defendants object to the disclosure of information and/or documents that are
10 protected by the attorney-client privilege, attorney work-product doctrine, or any other
11 applicable privilege or immunity. Defendants reserve the right to object as to the
12 admissibility of these Final Invalidity Contentions or the information contained herein.

13 **II. PRIORITY DATE**

14 **A. Priority Date of the '156 Patent**

15 In its Infringement Contentions, Plaintiff contends that the '156 patent is entitled
16 to a priority date at least as early as March 29, 2004, which is the filing date of U.S.
17 Provisional Application No. 60/557,536 ("Provisional Application"). Plaintiff bears the
18 burden of proving, on a claim-by-claim basis, that the Provisional Application provides
19 written description support for each and every limitation of the Asserted Claims.
20 Plaintiff has not met this burden. Defendants reserve their right to challenge the priority
21 date claimed by Plaintiff for the '156 patent.

22 Plaintiff is not entitled to a priority date of March 29, 2004 at least because the
23 Provisional Application fails to disclose or provide support for the following, as claimed
24 by the '156 patent: "at least first and second radiopaque markers oriented generally
25 parallel to a height of the implant, wherein said first radiopaque marker extends into
26 said first sidewall at a position proximate to said medial plane, and said second
27 radiopaque marker extends into said second sidewall at a position proximate to said
28 medial plane" as recited in claim 1. Plaintiff asserts that the following portions of the

1 Provisional Application provide support for the priority date for these claim limitations:
2 p. 2, ll. 6-9; p. 4, ll. 4-7, 9-12, 14-21; p. 5, ll. 4-7, 16-21; p. 6, ll. 1-3; p. 7, ll. 1-21; p. 8,
3 ll. 1-2; p. 10, ll. 13-21; p. 11, ll. 1-3, 5-14, 19-21; p. 12, ll. 1-7, 21; p. 13, ll. 1, 8-9, 11-
4 20; p. 14, ll. 1-4, 6-21; p. 15, ll. 1-7; p. 27, ll. 1-16; p. 28, ll. 2-4; and Figs. 1-6.
5 (NuVasive’s Third Supplemental Response to Interrogatory No. 9 (2020-09-18).)
6 Plaintiff is wrong. While the Provisional Application describes using “spike elements”
7 as “anti-migration features” (*see, e.g.*, Provisional Application at 5:16-6:3, 14:1-21,
8 Figs. 2-5), it contains no description of “radiopaque markers” as the term would have
9 been understood by a person of ordinary skill in the art. This understanding of a person
10 of ordinary skill in the art is corroborated by contemporaneous evidence produced by
11 NuVasive. *See, e.g.*, NUVA_ATEC0251803-38 [REDACTED]

12 [REDACTED]
13 [REDACTED]. For instance, the Provisional Application provides no support
14 for using “anti-migration features” as “markers” used for visualization of the implant.
15 Notably, the Provisional Application describes using other features of the implant for
16 visualization (*see, e.g.*, Provisional Application at 12:19-13:9), but not the “spike
17 elements” which are instead only described as being used for anti-migration purposes.
18 The concept of “radiopaque markers” was first added on March 29, 2005 as part of non-
19 provisional U.S. Patent Application No. 11/093,409, which has the same specification
20 as the ’156 patent and to which the ’156 patent claims priority. Importantly, the ’156
21 specification (as a result of the additions to non-provisional U.S. Patent Application No.
22 11/093,409) includes myriad disclosures which are not included in the Provisional
23 Application, of which the following disclose the use of radiopaque markers as visual
24 enhancement aids: 2:53-3:10, 6:49-56, 9:62-10:9, 11:48-12:11, and Figs. 18-23. None
25 of these disclosures are in the Provisional Application. A highlighted copy of the ’156
26 patent showing the changes from the Provisional Application is attached hereto as
27 Exhibit A. For instance, among the added descriptions and figures over the Provisional
28 Application, the ’156 specification provides: “The spinal fusion implant of the present

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