

**EXHIBIT E**  
**TO DASHE DECLARATION**

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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  
SPINE, INC., a California corporation,

25 Defendants.  
26  
27  
28

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

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

**DEFENDANTS’ SUPPLEMENTAL  
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’ SUPPLEMENTAL FINAL INVALIDITY CONTENTIONS**  
2                           **FOR 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 Supplemental Final Invalidation Contentions for the  
6           following patents and claims asserted by plaintiff NuVasive, Inc. (“NuVasive” or  
7           “Plaintiff”) in its Final Infringement Contentions served on November 6, 2020  
8           (“Infringement Contentions”):

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

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

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

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

1 in response to any of Plaintiff's arguments, and/or to address any additional patents or  
2 claims that are asserted hereafter.

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

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

## 16 **II. PRIORITY DATE**

### 17 **A. Priority Date of the '156 Patent**

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

25 Plaintiff is not entitled to a priority date of March 29, 2004 at least because the  
26 Provisional Application fails to disclose or provide support for the following, as claimed  
27 by the '156 patent: "at least first and second radiopaque markers oriented generally  
28 parallel to a height of the implant, wherein said first radiopaque marker extends into

1 said first sidewall at a position proximate to said medial plane, and said second  
2 radiopaque marker extends into said second sidewall at a position proximate to said  
3 medial plane” as recited in claim 1. Plaintiff asserts that the following portions of the  
4 Provisional Application provide support for the priority date for these claim limitations:  
5 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,  
6 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-  
7 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.  
8 (NuVasive’s Third Supplemental Response to Interrogatory No. 9 (2020-09-18).)  
9 Plaintiff is wrong. While the Provisional Application describes using “spike elements”  
10 as “anti-migration features” (*see, e.g.*, Provisional Application at 5:16-6:3, 14:1-21,  
11 Figs. 2-5), it contains no description of “radiopaque markers” as the term would have  
12 been understood by a person of ordinary skill in the art. This understanding of a person  
13 of ordinary skill in the art is corroborated by contemporaneous evidence produced by  
14 NuVasive. *See, e.g.*, NUVA\_ATEC0251803-38 ( [REDACTED]  
15 [REDACTED]  
16 [REDACTED] ). For instance, the Provisional Application provides no support  
17 for using “anti-migration features” as “markers” used for visualization of the implant.  
18 Notably, the Provisional Application describes using other features of the implant for  
19 visualization (*see, e.g.*, Provisional Application at 12:19-13:9), but not the “spike  
20 elements” which are instead only described as being used for anti-migration purposes.  
21 The concept of “radiopaque markers” was first added on March 29, 2005 as part of non-  
22 provisional U.S. Patent Application No. 11/093,409, which has the same specification  
23 as the ’156 patent and to which the ’156 patent claims priority. Importantly, the ’156  
24 specification (as a result of the additions to non-provisional U.S. Patent Application No.  
25 11/093,409) includes myriad disclosures which are not included in the Provisional  
26 Application, of which the following disclose the use of radiopaque markers as visual  
27 enhancement aids: 2:53-3:10, 6:49-56, 9:62-10:9, 11:48-12:11, and Figs. 18-23. None  
28 of these disclosures are in the Provisional Application. A highlighted copy of the ’156

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