

EXHIBIT 12

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10 **UNITED STATES DISTRICT COURT**
11 **SOUTHERN DISTRICT OF CALIFORNIA**
12 **SAN DIEGO DIVISION**

14 NUVASIVE, INC., a Delaware
corporation,

15 Plaintiff,

16 v.

17 ALPHATEC HOLDINGS, INC., a
18 Delaware corporation and ALPHATEC
SPINE, INC., a California corporation,

19 Defendants.
20
21
22

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

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

**DEFENDANTS’ AMENDED
INVALIDITY CONTENTIONS FOR
U.S. PATENT NOS. 9,924,859;
9,974,531; AND 8,187,334**

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

Jury Trial Demanded

DEFENDANTS’ AMENDED INVALIDITY CONTENTIONS FOR U.S. PATENT NOS. 9,924,859; 9,974,531; AND 8,187,334

In accordance with the applicable rules of this Court, Defendants Alphatec Holdings, Inc. and Alphatec Spine, Inc. (collectively, “Alphatec”) hereby provide the following Amended Invalidity Contentions for the following patents asserted by Plaintiff NuVasive, Inc. (“NuVasive”) in its Disclosure of Asserted Claims and Infringement Contentions served on November 9, 2018 (“Infringement Contentions”) and its Amended Complaint (Doc. No. 110):

- Claims 1-26 and 28-36 of U.S. Patent No. 9,924,859 (the “’859 patent”);
- Claims 1-39 of U.S. Patent No. 9,974,531 (the “’531 patent”); and
- Claims 6-9, 16, and 18 of U.S. Patent No. 8,187,334 (the “’334 patent”) (collectively, the “asserted claims” of the “Asserted Patents”).

Defendants’ Amended Invalidity Contentions for Asserted Patents specifically address the above-listed patents and claims. Defendants contend that each of the asserted claims is invalid as demonstrated herein. Defendants expressly reserve the right to disclose invalidity contentions with respect to other claims of these patents and/or other patents, and to respond to or rebut NuVasive’s arguments for claims asserted or arguments made following its Infringement Contentions.

I. GENERAL STATEMENT AND RESERVATION OF RIGHTS

These invalidity contentions are preliminary, and based upon information available to Defendants at an early state of litigation, prior to claim construction, completion of fact discovery, or expert discovery, in light of the volume of asserted claims, including asserted claims with very long chains of dependency, and in light of the fact that NuVasive has not meaningfully responded to Alphatec’s interrogatory concerning NuVasive’s positions regarding validity. Therefore, Defendants reserve the right to amend or supplement these Amended Invalidity Contentions or any charts appended hereto, including pursuant to the Court’s Case Management Order (Doc. Nos. 101 and 109) and should NuVasive provide any positions regarding validity in response

1 a second longitudinally extending receptacle adjacent a second edge of the second
2 blade,” as recited in claim 36. Defendants reserve their right to challenge the priority
3 date claimed by Plaintiff for the ’531 patent.

4 **3. Priority Date of the ’334 Patent**

5 In its Infringement Contentions, Plaintiff contends that the ’334 patent is entitled
6 to a priority date at least as early as March 29, 2004, which is the filing date of U.S.
7 Provisional Application No. 60/557,536. Plaintiff bears the burden of proving, on a
8 claim-by-claim basis, that the provisional application provides written description
9 support for each and every limitation of the asserted claims. Plaintiff has not met this
10 burden. Plaintiff is not entitled to a priority date of March 29, 2004, at least because
11 the Provisional Application fails to disclose or provide support for the following, as
12 claimed by the ’334 patent: “wherein said implant has a longitudinal length greater than
13 40 mm extending from a proximal end of said proximal wall to a distal end of said distal
14 wall,” “wherein said longitudinal length is at least two and half times greater than said
15 maximum lateral width,” and “at least three radiopaque markers; wherein a first of the
16 at least three radiopaque markers is at least partially positioned in said distal wall, a
17 second of said at least three radiopaque markers is at least partially positioned in said
18 proximal wall, and a third of said at least three radiopaque markers is at least partially
19 positioned in said central region” as recited in claim 1, as well as “further comprising a
20 fourth radiopaque marker situated within said implant, said fourth radiopaque marker
21 positioned in said central region at a position spaced apart from said third radiopaque
22 marker,” as recited in claim 16, and “wherein said maximum lateral width of said
23 implant is approximately 18 mm,” as recited in claim 18. Defendants reserve their right
24 to challenge the priority date claimed by Plaintiff for the ’334 patent.

25 **B. Identification of Prior Art**

26 The asserted claims are anticipated or rendered obvious by the prior art identified
27 herein. Specifically, Defendants may rely on any or all of the prior art references
28 disclosed in the below non-exhaustive list, either alone or in combination, under 35

1 *Approach (LETRA): A New Technique for Accessing the Lumbar Spine*, L. Pimenta
2 (published March 17, 2004).

3 Other inventors include the inventors and/or authors of the prior art references
4 listed above, and the circumstances of invention are as described in those references
5 and/or identified in the claim charts accompanying these Amended Invalidity
6 Contentions.

7 **A. On-Sale Bar and Prior Public Use**

8 The asserted claims are subject to the on-sale bar under 35 U.S.C. § 102(b) and/or
9 35 U.S.C. § 102(a)(1) (AIA). For at least the reasons explained above, Plaintiff has not
10 met its burden to show that it is entitled to any priority date earlier than the filing date
11 of each of the asserted patents. Each of the devices discussed below were sold by
12 Plaintiff, NuVasive, Inc. and are subject to the on-sale bar for the reasons described
13 below. Each of these instruments (and publicly available materials describing them)
14 may also qualify as prior art under one or more sections of 35 U.S.C. § 102.

15 With respect to the '859 patent, Plaintiff has contended that each of the asserted
16 claims is practiced by the MaXcess III and/or MaXcess IV Retractors, as well as one or
17 more of the K-wire, Dilators, 4th blade/anterior Retractor, 4th Blade Attachment,
18 Anterior Crossbar, and/or Access Driver Handles. (NuVasive Disclosure of Asserted
19 Claims and Infringement Contentions served on June 29, 2018 at 29.) Further, as stated
20 by Plaintiff, NuVasive “launched aspects of XLIF in October 2003 at the North
21 American Spine Society (NASS) Annual Meeting, including its MaXcess access
22 system.” (NuVasive’s Resp. to Alphatec’s Interrogatory No. 3 at 17; *see also*,
23 NuVasive’s Suppl. Resp. to Alphatec’s Interrogatory No. 3 at 22-23 (“Based on a
24 reasonable investigation of information from the personal knowledge of those relevant
25 persons still at or employed by NuVasive to date, NuVasive has not identified a
26 disclosure earlier than those provided in its prior response.”).) The “MaXcess III
27 launched on September 12, 2006.” (*Id.*) The MaXcess IV was publically available and
28 sold at least as of October 3, 2013, when NuVasive described in a press release that its

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