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17

18 **UNITED STATES DISTRICT COURT**

19 **SOUTHERN DISTRICT OF CALIFORNIA - SAN DIEGO DIVISION**

20 NUVASIVE, INC., a Delaware
corporation,

21 Plaintiff,

22 v.

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

26 Defendants.
27
28

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

**MEMORANDUM OF POINTS AND
AUTHORITIES IN SUPPORT OF
DEFENDANTS' MOTION FOR
SUMMARY JUDGMENT**

Judge: Hon. Cathy Ann Bencivengo
Courtroom: 4C

**PER CHAMBERS RULES, NO ORAL
ARGUMENT UNLESS SEPARATELY
ORDERED BY THE COURT**

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1 **I. INTRODUCTION**

2 Alphatec moves for summary judgment that the asserted claims of U.S. Patent
3 Nos. 8,187,334 and 8,361,156 are invalid as indefinite.

4 The '334 and '156 patents are related and share the same specification. Both
5 patents claim a spinal fusion implant having certain dimensions and radiopaque markers
6 placed in certain locations in the implant. Alphatec challenges the definiteness of three
7 terms. First, all asserted claims of the '156 patent require radiopaque markers that
8 extend into the sidewalls of the implant “at a position proximate to said medial plane.”
9 Second, all asserted claims of the '334 patent require radiopaque markers that are
10 positioned in the “central region” which is “generally centrally” located in the implant.
11 Third, one asserted claim of the '334 patent additionally requires the implant be
12 “approximately 18 mm” wide.

13 As confirmed by the testimony of NuVasive’s expert, Dr. Youssef, all asserted
14 claims are indefinite as a matter of law because none “inform, with reasonable certainty,
15 those skilled in the art about the scope of the invention.” *Nautilus, Inc. v. Biosig*
16 *Instruments, Inc.*, 572 U.S. 898, 901 (2014). Dr. Youssef—a surgeon who claims to be
17 the most knowledgeable person remaining at NuVasive and who has submitted
18 thousands of pages of testimony regarding these patents in this proceeding and before
19 the Patent Trial & Appeal Board (“PTAB”)—confirmed under oath that determining
20 whether each of the three challenged terms is met in the context of these patents and for
21 purposes of infringement is a “subjective analysis” that will vary from surgeon to
22 surgeon. Ex. 12¹ (Youssef Dep. Tr.) at 102:3–12 (“I don’t think there is an objective
23 boundary.”) (“at a position proximate to said medial plane” term); Ex. 13 (Youssef Dep.
24 Tr.) at 79:7–80:20 (“So I don’t know that there is objective. It’s more subjective; right?
25 . . . I think you have to be somewhat subjective in recognizing that that is truly within
26 the scope of claim language”) (“central region” term); Ex. 14 (Youssef Dep. Tr.)

27 _____
28 ¹ All exhibits are to the Declaration of Brian J. Nisbet In Support of Defendants’ Motion
for Summary Judgment filed concurrently herewith.

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