

EXHIBIT 9

TO THE DECLARATION OF BRIAN J.
NISBET IN SUPPORT OF DEFENDANTS'
OPPOSITION TO NUVASIVE'S MOTION
FOR PARTIAL SUMMARY JUDGMENT
AND MOTION TO EXCLUDE

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6 *Attorneys of record continued on next page*

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

12 NUVASIVE, INC., a Delaware
13 corporation

14 Plaintiff,

15 v.

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

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

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

[Magistrate: Hon. Mitchell D. Dembin]

**HIGHLY CONFIDENTIAL –
ATTORNEYS’ EYES ONLY**

SUBJECT TO PROTECTIVE ORDER

**OPENING REPORT OF BARTON L.
SACHS, M.D., M.B.A., F.A.C.P.E.,
F.A.C.H.E.**

Complaint Filed: February 13, 2018
Jury Trial Demanded

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OPENING EXPERT REPORT OF BARTON L. SACHS, M.D., M.B.A.,
F.A.C.P.E. F.A.C.H.E.

1 provisional application; and (4) the later-filed non-provisional application contains a
2 reference to the provisional application.

3 50. I understand that to comply with the written description requirement of 35
4 U.S.C. § 112(a), the provisional application must contain a written description that
5 includes the manner and process of making and using each invention claimed in the non-
6 provisional application in full, clear, and exact terms, to allow an ordinarily skilled
7 artisan to practice the invention claimed in the non-provisional application:

8 The specification shall contain a written description of the invention, and
9 of the manner and process of making and using it, in such full, clear,
10 concise, and exact terms as to enable any person skilled in the art to which
11 it pertains, or with which it is most nearly connected, to make and use the
12 same, and shall set forth the best mode contemplated by the inventor or
joint inventor of carrying out his invention.

13 (35 U.S.C. § 112(a).)

14 51. I understand that the written description requirement can be met by figures,
15 diagrams, or drawings. I understand, however, that a person of ordinary skill in the art
16 must be able to derive the claimed dimensions of the invention from the written
17 description.

18 52. I also understand that the provisional application must describe each
19 invention claimed in the non-provisional application sufficiently to convey to a person
20 of ordinary skill in the art that the applicant possessed the claimed invention at the time
21 the provisional application was filed. In other words, the provisional application must
22 demonstrate that the applicant invented what is claimed in the non-provisional
23 application on a claim-by-claim basis.

24 53. Further, I understand while the provisional application need not provide
25 verbatim support for the claims in the non-provisional application, one skilled in the art
26 reading the earlier application must be able to immediately discern the limitations in the
27 claims as of the date of the provisional application.

“entitled to a priority date at least as early as March 29, 2004, which is the filing date of U.S. Provisional Application No. 60/557,536.” (Infringement Contentions dated June 29, 2018 at 36.)

150. I disagree. None of the asserted claims of the '334 patent is entitled to March 29, 2004, as a priority date based on the disclosures in the Provisional Application.

151. In my opinion, the Provisional Application does not provide sufficient written description support for at least the following limitations:

Radiopaque Marker Limitations Not Supported by Provisional Application	
Claim Limitation	Claim
“... at least three radiopaque markers; wherein a first of the at least three radiopaque markers is at least partially positioned in said distal wall, a second of said at least three radiopaque markers is at least partially positioned in said proximal wall, and a third of said at least three radiopaque markers is at least partially positioned in said central region.”	Claim 1 (from which claims 16 and 18 depend)
“... further comprising a fourth radiopaque marker situated within said implant, said fourth radiopaque marker positioned in said central region at a position spaced apart from said third radiopaque marker.”	Claim 16

152. I refer to these limitations as the “radiopaque marker limitations.”

153. Additionally, it is my opinion that the asserted claims of the '334 patent are not entitled to a priority date of March 29, 2004, because the Provisional Application does not provide sufficient written description support for at least the following limitations:

Dimension Limitations Not Supported by Provisional Application	
Claim Limitation	Claim
"... wherein said implant has a longitudinal length greater than 40 mm extending from a proximal end of said proximal wall to a distal end of said distal wall ..."	Claim 1 (from which claims 16 and 18 depend)
"... wherein said longitudinal length is at least two and half times greater than said maximum lateral width ..."	Claim 1 (from which claims 16 and 18 depend)
"... wherein said maximum lateral width of said implant is approximately 18 mm."	Claim 18

154. Collectively, I refer to these limitations as the "dimension" limitations.

(a) The asserted claims are not entitled to a March 29, 2004 because the Provisional Application does not support the "radiopaque marker" limitations

155. As noted above, there is nothing in the Provisional Application that discloses the radiopaque marker limitations in the claimed spinal implants.

156. Rather, support for the "radiopaque markers" limitations did not appear until March 29, 2005 when applicants filed U.S. Patent Application Serial No. 11/093,409 (the "'409 application") (NUVA_ATEC0020856-910), which ultimately issued as U.S. Patent No. 7,918,891 (the "'891 patent"). The '334 patent is a continuation of the '891 patent, and these patents substantively share the same specification, aside from minor changes describing related applications. (*See, e.g.*, '334 patent at cover page, 1:4-13.)

157. In the '409 application filed on March 29, 2005, the applicants added several paragraphs and statements that were not part of the Provisional Application, including multiple passages and figures describing how radiopaque markers could be

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