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**UNITED STATES DISTRICT COURT  
SOUTHERN DISTRICT OF CALIFORNIA**

NUVASIVE, INC., a Delaware corporation,

Plaintiff,

v.

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

Defendants.

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

**ORDER DENYING MOTION  
TO STRIKE INVALIDITY  
CONTENTIONS**

[Doc. No. 296]

Before the Court is plaintiff NuVasive Inc.’s motion to strike the invalidity contentions of defendants Alphatec Holdings, Inc. and Alphatec Spine, Inc. (jointly “Alphatec”). [Doc. No. 296.] NuVasive alleges Alphatec infringes U.S. Patent No. 8,187,334 (“the ‘334 patent”) and its continuation U.S. Patent No. 8,361,156 (“the ‘156 patent”), directed at spinal implants. At the onset of this litigation, Alphatec moved for a stay of the proceedings regarding these patents and submitted them to the Patent and Trademark Office (“PTO”) for inter partes review (“IPR”). The PTO’s final written decision found that Alphatec did not establish its invalidity challenges. [Doc. No. 288]

The stay in the litigation was lifted and Alphatec served updated invalidity contentions in accordance with the Court’s scheduling order. In those contentions,

1 Alphatec challenges the validity of the ‘334 patent and ‘156 patent based on 35  
2 U.S.C. § 102(b), asserting the claimed invention was on sale in the United States  
3 more than a year before the patents’ earliest filing date.<sup>1</sup> Alphatec also challenges  
4 the validity of these patents based on 35 U.S.C. § 112 assertions of indefiniteness.

5 NuVasive moves to strike these invalidity contentions on the grounds that  
6 Alphatec is statutorily estopped from pursuing these invalidity challenges, as they  
7 could have been brought before the PTO in the IPR. See 35 U.S.C. § 315(e)  
8 (petitioner may not assert that the claim is invalid on any ground that the petitioner  
9 raised or reasonably could have raised during the inter partes review.)

10 Regarding the section 102(b) contention, NuVasive argues that a NuVasive  
11 marketing document identified in Alphatec’s contentions [Doc. No. 296-4] as part  
12 of its evidence of on-sale bar was easily discoverable and therefore could have been  
13 included Alphatec’s petition for IPR challenging the validity of these patents.  
14 Therefore, NuVasive asserts that Alphatec should be estopped from raising this  
15 defense in this litigation.

16 This assertion evoking an equitable right is tainted by NuVasive’s own  
17 conduct in this litigation. This District’s patent local rules required NuVasive to  
18 produce with its first preliminary infringement contentions any documents that  
19 evidence offers to sell or sale of the claimed invention prior to the application date  
20 for the patents in suit. Patent L.R. 3.2(a). This “easily discoverable” document from  
21 NuVasive’s own archival website [Doc. No. 296-1, at 13] allegedly evidencing sales  
22 of the invention more than a year before the patent filing date was not produced by  
23 NuVasive in this litigation until the close of fact discovery. NuVasive claims that it  
24 had no institutional knowledge of these earlier sales and therefore never performed  
25 the simple search that resulted in discovery of this document. But NuVasive argues  
26 a diligent search by Alphatec would have discovered it before Alphatec filed for IPR

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28 <sup>1</sup> The parties agree these patents are subject to pre-AIA provisions.

1 and therefore Alphatec should be barred now from raising an on-sale bar defense in  
2 this litigation. The Court is not persuaded that NuVasive is excused from the same  
3 level of diligent inquiry regarding first sales of its invention that it seeks to impose  
4 on Alphatec when NuVasive repeatedly verified that the first sales occurred after the  
5 filing date but now concedes that evidence of its earlier sales was easily  
6 discoverable.

7       Regardless of whether Alphatec could have discovered NuVasive's marketing  
8 materials that support its evidence of sales one year prior to the patents' filing date,  
9 NuVasive's argument fails. IPR is limited to section 102 anticipation and section  
10 103 obviousness challenges based prior art consisting of patents or printed  
11 publications. 35 U.S.C. § 311(b). Challenges based on the on-sale bar, patent-  
12 ineligible subject matter, or on grounds of indefiniteness are properly raised in the  
13 district court. *See Synopsys, Inc. v. Mentor Graphics Corp.*, 814 F.3d 1309, 1316  
14 (Fed. Cir. 2016). The cases cited by NuVasive regarding printed publications  
15 disclosing prior art products or systems for purposes of anticipation or obviousness  
16 challenges that were or could have been offered in an IPR subsequently estopping  
17 those invalidity challenges when a party seeks to substitute the product in lieu of the  
18 publication at trial are not on point. NuVasive as provided no authority that Alphatec  
19 could have raised an on-sale bar challenge or an indefiniteness challenge to the  
20 patents in IPR.

21       Statutory estoppel does not apply to either the on-sale bar or indefiniteness  
22 challenges asserted by Alphatec. The motion is DENIED.

23       It is **SO ORDERED**.

24       Dated: April 13, 2021



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26       Hon. Cathy Ann Bencivengo  
27       United States District Judge  
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