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UNITED STATES DISTRICT COURT

SOUTHERN DISTRICT OF CALIFORNIA

SAN DIEGO DIVISION

NUVASIVE, INC., a Delaware corporation, Plaintiff, v. ALPHATEC HOLDINGS, INC., a Delaware corporation, and ALPHATEC SPINE, INC., a California corporation, Defendants.	CASE NO.: 18-cv-00347-CAB-MDD **NUVASIVE, INC.'S BENCH MEMORANDUM REGARDING PRIORITY DATE** Judge: Hon. Cathy Ann Bencivengo Magistrate Judge: Mitchell D. Dembin

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1 At the April 8, 2021 telephonic status conference in this case, the Court asked
2 the parties to submit bench memoranda, not to exceed five pages, on whether
3 determining the appropriate priority date for the Implant Patents presents a question
4 of law or of fact. NuVasive submits this bench memorandum to address this issue.
5 While entitlement to a priority date depends on the factual question of whether
6 the priority document adequately discloses the claimed invention, where there is no
7 genuine dispute of fact that the priority document discloses the claimed invention, the
8 inquiry is a legal one and appropriate for resolution by the Court at summary
9 judgment. That is the case here.
10 It is Federal Circuit law that "[d]etermination of a priority date is purely a
11 question of law if the facts underlying that determination are undisputed." *Bradford*
12 *Co. v. Conteyor N. Am., Inc.*, 603 F.3d 1262, 1268 (Fed. Cir. 2010); *see also Nat. Alts.*
13 *Int'l, Inc. v. Iancu*, 904 F.3d 1375, 1379 (Fed. Cir. 2018) ("Entitlement to priority
14 under § 120 is a legal determination based on underlying fact findings. When the
15 underlying facts are undisputed, priority date determination is purely a legal
16 question." (cleaned up)); *PowerOasis, Inc. v. T-Mobile USA, Inc.*, 522 F.3d 1299,
17 1307 (Fed. Cir. 2008) ("Compliance with the written description requirement is a
18 question of fact but is amenable to summary judgment in cases where no reasonable
19 fact finder could return a verdict for the non-moving party.").
20 As detailed in NuVasive's Memorandum of Points and Authorities In Support
21 of NuVasive's Partial Motion for Summary Judgment (Doc. No. 303-1), the Implant
22 Patents are entitled to the March 29, 2004 priority date because the provisional
23 application "reasonably conveys to those skilled in the art that the inventor had
24 possession of the claimed subject matter as of the filing date." *Ariad Pharm., Inc. v.*
25 *Eli Lilly & Co.*, 598 F.3d 1336, 1351 (Fed. Cir. 2010). Indeed, it is undisputed that
26 the provisional application discloses the exact same implant claimed in the Implant
27 Patents. This is shown at least by the fact that the implant depicted in Figures 1
28

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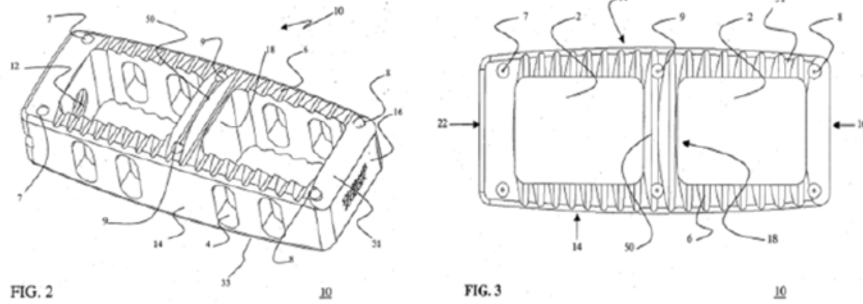
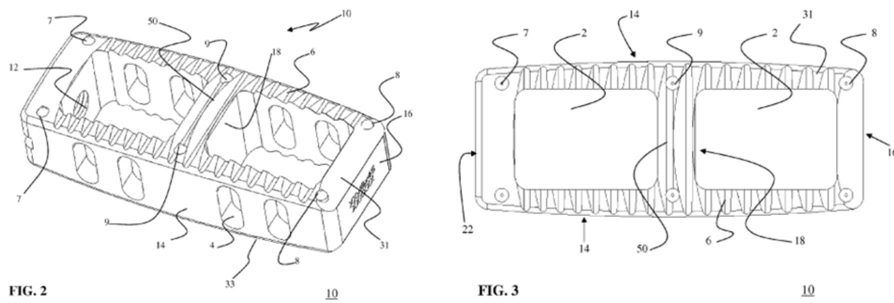
through 6 of the Implant Patents (which Alphatec admits is an embodiment of the claimed implant) is *identical* to the implant depicted in Figures 1 through 6 of the provisional application:

<u>Figs. 2 and 3 from Provisional Application (Doc. No. 296-3, Ex. A at 33-34)</u>



<u>Figs. 2 and 3 from Implant Patents (Doc. Nos. 110-38, 110-48 at 6-7)</u>



The provisional and the Implant Patents also describe the claimed implant in nearly identical terms. For example, both the provisional and the Implant Patents refer to the elements labeled as 7, 8, and 9 in the figures above as "radiopaque" "spike elements." These radiopaque spike elements are positioned precisely where the claims require: in the "distal wall," the "proximal wall," and the "central region." Doc. No. 110-48 at 30-31 (12:65-13:4). And as Alphatec concedes, the sole purpose for making the spike elements radiopaque is to facilitate radiographic visualization. Doc. No. 303-1 at 40-41 (noting opinions in Dr. Sachs' expert report acknowledging that making spike elements radiopaque allows for radiographic visualization after implantation). Additionally, both the provisional and the Implant Patents indisputably disclose an implant with a proximal-to-distal dimension that is longer than its sidewall-to-sidewall dimension. This is enough for the Court to conclude as a matter

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1 of law that the Implant Patents are entitled to a priority date of March 29, 2004.
2 *Cooper Cameron Corp. v. Kvaerner Oilfield Prods., Inc.*, 291 F.3d 1317, 1322-23
3 (Fed. Cir. 2002) (relying on figure from priority document, also found in later patent
4 application, to conclude that "[the figure] clearly provides a written description" of
5 the claimed invention).

6 Analogous Federal Circuit precedent supports this result. For example, in *Yeda*
7 *Rsch. & Dev. Co. Ltd. v. Abbott GmbH & Co. KG*, 837 F.3d 1341, 1344 (Fed. Cir.
8 2016), the Federal Circuit upheld the district court's grant of summary judgment in
9 favor of the patentee on the priority date issue even though the later patent disclosed
10 more information than was explicitly contained in the priority application. *Id.* at 1346.
11 As the Court explained, "when a specification describes an invention that has certain
12 undisclosed yet inherent properties, that specification serves as adequate written
13 description to support a subsequent patent application that explicitly recites the
14 invention's inherent properties." *Id.* at 1345. It was undisputed that the elements of
15 the claimed invention were necessarily and inherently part of the invention disclosed
16 in the priority application, thus the patentee was entitled to the earlier priority date **as**
17 **a matter of law**. *Id.* So too here. As noted above, Alphatec concedes that a
18 radiopaque spike inherently serves as a radiopaque marker used for radiographic
19 visualization. Doc. No. 303-1 at 40-41. Thus, NuVasive's provisional application
20 disclosed an implant with radiopaque markers in the claimed configuration on an
21 implant with the claimed dimensions.

22 Alphatec's attempts to gin up a factual dispute to avoid summary judgment
23 regarding the priority date should be rejected. For instance, Alphatec relies heavily
24 on extrinsic evidence (*e.g.*, a NuVasive premarket submission to FDA). This is
25 irrelevant to the priority date analysis. *Ariad Pharm.*, 598 F.3d at 1351 ("[T]he
26 [written description] test requires an objective inquiry into ***the four corners of the***
27 ***specification*** from the perspective of a person of ordinary skill in the art." (emphasis
28 added)); *Allergan, Inc. v. Sandoz Inc.*, 796 F.3d 1293, 1309 (Fed. Cir. 2015)

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(concluding that district court erred by relying on evidence extrinsic to the patent specification, and holding that such extrinsic evidence "should not form the basis of the written description inquiry").

It is similarly irrelevant that the non-provisional applications leading to the Implant Patents added some details in the written description regarding the purpose of the radiopaque markers disclosed in the provisional application. *Star Sci., Inc. v. R.J. Reynolds Tobacco Co.*, 655 F.3d 1364, 1372 (Fed. Cir. 2011) (faulting district court's conclusion that information added to later-filed application prevented application of priority date of provisional application). Disputes over *irrelevant* facts do not require a jury. *Anderson v. Liberty Lobby, Inc.*, 477 U.S. 242, 248 (1986).

This is a case where no relevant facts are in dispute. Therefore, determining the proper priority date of the Implant Patents is "purely a legal question" for the Court to resolve. *Iancu*, 904 F.3d at 1379.

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