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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

DEFENDANTS' MEMORANDUM ON PRIORITY DATE DETERMINATION

Judge: Hon. Cathy Ann Bencivengo
Courtroom: 4C

At the April 8, 2021 status conference, the Court invited the parties to submit a bench memorandum on whether the priority date of the implant patents, U.S. Patent Nos. 8,187,334 and 8,361,156, is a factual matter for the jury to decide at trial, or whether it is a legal question that can be answered in advance by the Court (like claim construction). Status Conf. Tr., 7:17–8:14, Apr. 8, 2021. Alphatec submits that, according to Federal Circuit authority, factual disputes regarding priority are to be resolved by a jury at trial.

"[A] patent application is entitled to the benefit of the filing date of an earlier filed application only if the disclosure of the earlier application provides support for the claims of the later application, as required by 35 U.S.C. § 112." *PowerOasis, Inc. v. T-Mobile USA, Inc.*, 522 F.3d 1299, 1306 (Fed. Cir. 2008); *New Railhead Mfg., L.L.C. v. Vermeer Mfg. Co.*, 298 F.3d 1290, 1294 (Fed. Cir. 2002) (finding that to claim priority to a provisional application, "the specification of the provisional must contain a written description of the invention and the manner and process of making and using it, in such full, clear, concise, and exact terms, to enable an ordinarily skilled artisan to practice the invention claimed in the non-provisional application"). Compliance with the written description requirement in the context of a determination of priority is a question of fact properly resolved by the jury at trial. *E.g., Cordis Corp. v. Bos. Sci. Corp.*, 561 F.3d 1319, 1331–32 (Fed. Cir. 2009) (in assessing the jury's determination of priority, the Court wrote "[t]he written description requirement of 35 U.S.C. § 112 ¶ 1 is a question of fact, and we review a jury's findings of fact relating to the written description requirement for substantial evidence"); *Viasat, Inc. v. Space Sys./Loral, Inc.*, No. 312CV00260HWVG, 2014 WL 11865305, at *5 (S.D. Cal. Aug. 8, 2014) (finding that "[w]hether a description in an earlier filing teaches sufficient information to a person of ordinary skill in the art such that the priority date of the earlier filing should apply is a question of fact" and that "[a]fter hearing evidence from both parties' experts, the jury determined that ViaSat could rely on the earlier filing date").

At least two district court cases have directly addressed this same issue and

confirmed that determining the priority date is a question of fact for a jury. For example, in *Rivera v. Remington Designs LLC*, the court stated as follows:

> "At the hearing, Defendants continued to assert that the question of patent priority date is a matter of law that should be decided prior to trial. This argument is unpersuasive. *See, e.g.*, *Uniloc USA, Inc. v. Sega of Am., Inc.*, No. 2016-2000, 2017 WL 4772565, at *3 (Fed. Cir. Oct. 23, 2017) (Patent Trial and Appeal Board acted as law and fact finder in conducting priority analysis and Federal Circuit concluded the Board's determination was supported by substantial evidence); *Ariad Pharm., Inc. v. Eli Lilly & Co.*, 598 F.3d 1336, 1355 (Fed. Cir. 2010) (where the parties disputed the priority date on the basis of lack of written description, 'in a detailed and well-crafted special verdict form, the jury was asked to choose between the two possible dates.'); *Tech. Licensing Corp. v. Videotek, Inc.*, 545 F.3d 1316, 1331–32 (Fed. Cir. 2008) ('the prior application must 'convey with reasonable clarity to those skilled in the art that, as of the filing date sought, [the inventor] was in possession of the invention.' Compliance with the written description requirement is a question of fact, which, following a bench trial, we review for clear error.' (internal citations omitted).); *PowerOasis, Inc. v. T-Mobile USA, Inc.*, 522 F.3d 1299, 1307 (Fed. Cir. 2008) (analyzing written description in the context of priority applications and concluding '[c]ompliance with the written description requirement is a question of fact but is amenable to summary judgment in cases where no reasonable fact finder could return a verdict for the non-moving party.')."

No. LACV1604676JAKSSX, 2018 WL 8693814, at *12 (C.D. Cal. Aug. 28, 2018).

Similarly, in *Riddell, Inc. v. Kranos Corp.*, after identifying a dispute of material fact as to the whether the provisional application disclosed the claimed features of the asserted patent, the court stated that "[s]hould the parties proceed to trial, the applicable priority date will be decided by the jury." No. 16 C 4496, 2017 WL 2349714, at *5 (N.D. Ill. May 30, 2017) (citing *Leader Techs., Inc. v. Facebook, Inc.*, 678 F.3d 1300 (Fed. Cir. 2012) (noting a jury had determined patent's priority date which was not challenged on appeal), *Martek Biosciences Corp. v. Nutrinova, Inc.*, 579 F.3d 1363 (Fed. Cir. 2009) (reviewing a jury's determination of a patent's priority date), *Cordis Corp. v. Boston Sci. Corp.*, 561 F.3d 1319, 1331–32 (Fed. Cir. 2009) (noting that the written description requirement is a question of fact for the jury), *Synthes USA, LLC v. Spinal Kinetics, Inc.*, 734 F.3d 1332, 1341 (Fed. Cir. 2013) (reviewing a jury's determination of invalidity for lack of adequate written description)).

NuVasive, in its motion for summary judgment, recognized that the priority date

determination is normally a question of fact to be resolved by the jury. Doc. No. 303-1 at 13 (quoting *ScriptPro LLC v. Innovation Assocs., Inc.*, 833 F.3d 1336, 1340 (Fed. Cir. 2016)) ("Compliance with the written description requirement is a question of fact but is amenable to summary judgment in cases where no reasonable fact finder could return a verdict for the non-moving party."). In that submission, NuVasive argued the Court could decide the issue because there are no factual disputes concerning whether the written description of the provisional application adequately supports the inventions of the implant patents and "no reasonable fact finder could return a verdict for [Alphatec.]" *Id.* at 13, 35–36. Alphatec opposed, pointing to numerous factual disputes, Doc. No. 306 at 24–32, as evidenced by the parties' experts presenting conflicting opinions as to whether the provisional application adequately supports the invention of the implant patents. *See Viasat, Inc. v. Space Sys./loral, Inc.*, No. 3:12-CV-00260-H(WVG), 2013 WL 12061802, at *3 (S.D. Cal. Oct. 29, 2013) (denying summary judgment on priority date "because the parties present conflicting expert testimony on issues of fact material to this motion"); *Odyssey Wireless, Inc. v. Apple Inc.*, No. 15-CV-01735-H-RBB, 2016 WL 7634450, at *5–6 (S.D. Cal. Sept. 13, 2016) (denying summary judgment when competing expert opinions created factual dispute on whether provisional application disclosed claimed limitations).

Because the facts regarding NuVasive's entitlement to the priority date of the provisional application are hotly disputed between the parties, they should be resolved by a jury at trial. *See In re Katz Interactive Call Processing Pat. Litig.*, No. 07ML01816BRGKFFMX, 2008 WL 11333692, at *7 (C.D. Cal. Aug. 4, 2008) ("[T]his Court finds that there are factual issues for a jury to decide regarding the priority date of claim 57."); *Riddell*, 2017 WL 2349714, at *5 (stating "[s]hould the parties proceed to trial, the applicable priority date will be decided by the jury" after concluding a genuine dispute of fact exists "regarding whether the asserted offset band claims were disclosed by the provisional application"); *see also Rivera*, 2018 WL 8693814, at *12 (refusing to decide priority before trial as it was not a "matter of law").

Dated: April 22, 2021

WINSTON & STRAWN LLP

By: /s/ *Nimalka R. Wickramasekera*
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