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18 Attorneys for Defendants
 19 ALPHATEC HOLDINGS, INC. AND ALPHATEC SPINE, INC.

20 **UNITED STATES DISTRICT COURT**

21 **SOUTHERN DISTRICT OF CALIFORNIA – SAN DIEGO DIVISION**

22 NUVASIVE, INC., a Delaware
 23 corporation,
 Plaintiff,
 24
 v.
 25 ALPHATEC HOLDINGS, INC., a
 26 Delaware corporation and
 27 ALPHATEC SPINE, INC., a
 California corporation,
 28 Defendants.

Case No. 18-CV-00347-CAB-MDD
DEFENDANTS’ OBJECTION TO
NUVASIVE’S BENCH
MEMORANDUM REGARDING
PRIORITY DATE RAISING NEW
SUMMARY JUDGMENT
ARGUMENTS
Judge: Hon. Cathy Ann Bencivengo
Courtroom: 4C

1 In its memorandum to the Court, NuVasive introduced a new theory in support
2 of its motion for summary judgment—that the provisional application “inherently”
3 discloses adequate written description to support the claimed inventions of the implant
4 patents. Doc. No. 321 at 4. NuVasive also raised new case law on the merits of
5 summary judgment. Because these arguments are new, Alphatec respectfully requests
6 the Court strike NuVasive’s new argument and case law for the following reasons.

7 First, NuVasive did not raise this new theory on summary judgment, and it is
8 therefore now waived. Second, NuVasive’s new theory, rooted in “*undisclosed* yet
9 inherent properties” contained in the provisional application, *id.*, contradicts its old
10 argument that “the provisional application discloses the claimed implant.” Doc. No.
11 303-1 at 36–37. Third, NuVasive’s new theory is inconsistent with NuVasive’s
12 statements to the patent office, which Alphatec outlined at Doc. No. 306 at 31–32.
13 Fourth, Alphatec has never conceded that the “radiopaque markers” claimed in the
14 implant patents are disclosed the provisional application. Doc. No. 306 at 29–30.

15 Nor do NuVasive’s newly cited cases compel summary judgment here. For
16 example, in *Yeda Rsch. & Dev. Co. v. Abbott GMBH & Co. KG*, 837 F.3d 1341 (Fed.
17 Cir. 2016), unlike here, the Board of Patent Appeals and Interferences resolved factual
18 disputes as the trier of fact in an interference proceeding, which were reviewed for
19 substantial evidence and affirmed on appeal. *Id.* at 1344, 1346. Critically, in *Yeda*, the
20 parties did not dispute that the claimed protein was the “*only* protein” that could have
21 the partial amino acid sequence and additional traits disclosed in the earlier application.
22 *Id.* at 1345. Finally, the Court held that the undisclosed but inherent limitations were
23 not material to patentability. *Id.* This is not analogous because, as set out in Alphatec’s
24 opposition, the provisional application discloses the opposite implant dimensions as
25 ultimately claimed and does not at all disclose radiopaque markers. *See* Doc. No. 306
26 at 25–32.¹

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28 ¹ NuVasive’s remaining cases are similarly inapposite. *Cooper Cameron Corp. v.*

1 In sum, the Court should strike and disregard NuVasive’s new theory and added
2 case law in support of its motion for summary judgment.

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4 Dated: April 28, 2021 WINSTON & STRAWN LLP

5
6 By: /s/ Nimalka R. Wickramasekera
NIMALKA R. WICKRAMASEKERA

7 Attorneys for Defendants
8 ALPHATEC HOLDINGS, INC. AND
9 ALPHATEC SPINE, INC.

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26 *Kvaerner Oilfield Prods., Inc.*, 291 F.3d 1317, 1320, 1322–23 (Fed. Cir. 2002) (earlier
27 application shared “identical written description” with patent); *Allergan, Inc. v. Sandoz*
28 *Inc.*, 796 F.3d 1293, 1302–03, 1309 (Fed. Cir. 2015) (extrinsic clinical protocol could
not be used to show inventors had “possession of the claimed invention” before filing
date); *Star Sci., Inc. v. R.J. Reynolds Tobacco Co.*, 655 F.3d 1364, 1372 (Fed. Cir. 2011)
(district court improperly “narrowed the scope of the provisional application based on
an added example in the later-filed non-provisional application”).

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CERTIFICATE OF SERVICE

I hereby certify that the foregoing document was filed with the Court's CM/ECF system which will provide notice to all counsel deemed to have consented to electronic service. All other counsel of record not deemed to have consented to electronic service were served with a true and correct copy of the foregoing document by mail on this day.

I declare under penalty of perjury under the Laws of the United States of America that the above is true and correct. Executed this 28th day of April 2021 at Los Angeles, California.

Dated: April 28, 2021

WINSTON& STRAWN LLP

By: /s/ Nimalka R. Wickramasekera
NIMALKA R. WICKRAMASEKERA