United States Court of Appeals for the Federal Circuit

IN RE: NUVASIVE, INC.,
Appellant

2015-1670

Appeal from the United States Patent and Trademark Office, Patent Trial and Appeal Board in No. IPR2013-00506.

Decided: December 7, 2016

MICHAEL T. ROSATO, Wilson, Sonsini, Goodrich & Rosati, PC, Seattle, WA, argued for appellant. Also represented by ANDREW SWANSON BROWN; RICHARD TORCZON, Washington, DC; GRACE J. PAK, PAUL DAVID TRIPODI II, Los Angeles, CA.

JOSEPH MATAL, Office of the Solicitor, United States Patent and Trademark Office, Alexandria, VA, argued for intervenor Michelle K. Lee. Also represented by NATHAN K. KELLEY, SCOTT WEIDENFELLER.

Before MOORE, WALLACH, and TARANTO, *Circuit Judges*.

WALLACH, *Circuit Judge*.

Appellant NuVasive, Inc. ("NuVasive") appeals the final written decision of the U.S. Patent and Trademark

Office's ("USPTO") Patent Trial and Appeal Board ("PTAB"), finding claims 1–14, 19–20, and 23–27 of U.S. Patent No. 8,361,156 ("the '156 patent") invalid as obvious. *See Medtronic, Inc. v. NuVasive, Inc.*, No. IPR2013-00506, 2015 WL 996352, at *2 (P.T.A.B. Feb. 11, 2015). We have jurisdiction pursuant to 28 U.S.C. § 1295(a)(4)(A) (2012). We vacate and remand.

BACKGROUND

NuVasive is the assignee of the '156 patent, which generally relates to "[a] system and method for spinal fusion comprising a spinal fusion implant of non-bone construction releasably coupled to an insertion instrument dimensioned to introduce the spinal fusion implant into any of a variety of spinal target sites." '156 patent, Abstract. The '156 patent includes one independent claim (claim 1) and 26 dependent claims (claims 2–27). Illustrative claim 1 recites in relevant part:

> A spinal fusion implant of non-bone construction positionable within an interbody space between a first vertebra and a second vertebra, said implant comprising:
>
> . . .
>
> at least *first and second radiopaque markers* oriented generally parallel to a height of the implant, wherein said first radiopaque marker extends into said first sidewall at a position *proximate to said medial plane*, and said second radiopaque marker extends into said second sidewall at a position *proximate to said medial plane*.

Id. col. 12 ll. 32–67 (emphases added).

In response to Medtronic, Inc.'s ("Medtronic") petition,[1] the PTAB instituted the subject inter partes review to determine whether claims 1–14, 19–20, and 23–27 would have been obvious over, inter alia, a Synthes Vertebral Spacer-PR brochure ("SVS-PR brochure") (J.A. 769–70), a Telamon Verte-Stack PEEK Vertebral Body Spacer brochure ("Telamon brochure") (J.A. 771–72), a Telamon Posterior Impacted Fusion Devices guide ("Telamon guide") (J.A. 773–82), and U.S. Patent Application Publication No. 2003/0028249 ("Baccelli") (J.A. 744–51). *See Medtronic, Inc. v. NuVasive, Inc.*, No. IPR2013-00506, 2014 WL 1253040, at *11–12 (P.T.A.B. Feb. 13, 2014). The PTAB later issued the Final Written Decision concluding the claims would have been obvious over various combinations of, inter alia, the SVS-PR brochure, the Telamon brochure and Telamon guide (collectively, "the Telamon references"), and Baccelli. *See Medtronic*, 2015 WL 996352, at *14.

DISCUSSION

NuVasive argues that the PTAB's Final Written Decision should be reversed for two reasons: (1) "the [PTAB] erred in concluding that the SVS-PR brochure and Telamon references are printed publication prior art"; and (2) "the [PTAB] erred in concluding it would have been obvious to include radiopaque markers proximate to the medial plane." Appellant's Br. 22, 26 (capitalization omitted). After articulating the applicable standard of review, we address these arguments in turn.

I. Standard of Review

[1] Medtronic initially opposed NuVasive's appeal, but later withdrew as Appellee. The USPTO intervened pursuant to 35 U.S.C. § 143 (2012) and, although it did not file a brief, participated at oral argument.

We review the PTAB's factual determinations for substantial evidence and its legal determinations de novo. *See In re Gartside*, 203 F.3d 1305, 1316 (Fed. Cir. 2000). "Substantial evidence is something less than the weight of the evidence but more than a mere scintilla of evidence." *In re Kotzab*, 217 F.3d 1365, 1369 (Fed. Cir. 2000) (citation omitted). It is "such relevant evidence as a reasonable mind might accept as adequate to support a conclu-conclusion." *In re Applied Materials, Inc.*, 692 F.3d 1289, 1294 (Fed. Cir. 2012) (internal quotation marks and citation omitted).

II. NuVasive Waived Its Arguments as to the PTAB's Treatment of the Prior Art References as Printed Publications

As an initial matter, the court must consider whether the SVS-PR brochure and Telamon references were publicly accessible such that they qualify as printed publications pursuant to 35 U.S.C. § 311(b)[2] and 35 U.S.C. § 102 (2006).[3] Pursuant to § 311(b), "[a] petitioner in an inter partes review may request to cancel as unpatentable [one] or more claims of a patent only on a ground that could be

---

[2] Congress amended § 311 when it enacted the Leahy-Smith America Invents Act ("AIA"). Pub. L. No. 112-29, § 6(a), 125 Stat. 284, 299 (2011). Although the amendments to § 311 did not take effect until September 16, 2012, the amendments "apply to any patent issued before, on, or after th[e] effective date" and, thus, apply to the '156 patent. *See id.* § 6(c)(2)(A), 125 Stat. at 304.

[3] Congress amended § 102 when it enacted the AIA. Pub. L. No. 112-29, § 3(b)(1), 125 Stat. at 285–87. However, because the application that led to the '156 patent was filed before March 16, 2013, the pre-AIA § 102 applies. *See id.* § 3(n)(1), 125 Stat. at 293.

raised under [§] 102 or [§] 103 and only on the basis of prior art consisting of patents or printed publications." 35 U.S.C. § 311(b). Section 102 provides that prior art includes "printed publication[s]" describing the invention either "before the invention thereof" or "more than one year prior to the date of the [patent] application . . . ." 35 U.S.C. § 102(a), (b).

We first must determine whether NuVasive preserved its public accessibility arguments for appeal. In appeals from the PTAB, "we have before us a comprehensive record that contains the arguments and evidence presented by the parties and our review of the [PTAB]'s decision is confined to the four corners of that record." *In re Watts*, 354 F.3d 1362, 1367 (Fed. Cir. 2004) (internal quotation marks and citation omitted). While the court "retains case-by-case discretion over whether to apply waiver," *Harris Corp. v. Ericsson Inc.*, 417 F.3d 1241, 1251 (Fed. Cir. 2005) (citations omitted), we have held that a party waives an argument that it "failed to present to the [PTAB]" because it deprives the court of "the benefit of the [PTAB]'s informed judgment," *Watts*, 354 F.3d at 1367–68.

NuVasive waived its public accessibility arguments before the PTAB and may not raise them on appeal. NuVasive challenged the public accessibility of the prior art references during the preliminary proceedings of the inter partes review, J.A. 159–63 (section of NuVasive's Preliminary Response that addresses public accessibility), but failed to challenge public accessibility during the trial phase, J.A. 227–93 (NuVasive's Trial Response that fails to address public accessibility). In fact, during oral argument before the PTAB, NuVasive explicitly declined to make further arguments as to public accessibility of the Telamon references:

> [PTAB Judge]: I take it you no longer are disputing the public availability of the Telamon reference[s]?

DOCKET ALARM

Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

Real-Time Litigation Alerts

Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

Advanced Docket Research

With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

Analytics At Your Fingertips

Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

LAW FIRMS
Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

FINANCIAL INSTITUTIONS
Litigation and bankruptcy checks for companies and debtors.

E-DISCOVERY AND LEGAL VENDORS
Sync your system to PACER to automate legal marketing.