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UNITED STATES DISTRICT COURT
SOUTHERN DISTRICT OF CALIFORNIA

NUVASIVE, INC.,
Plaintiff,
v.
ALPHATEC HOLDINGS, INC., and
ALPHATEC SPINE, INC.,
Defendants.

Case No.: 18-CV-347-CAB-MDD
**ORDER RE MOTION TO DISMISS
COUNTS VII AND VIII**
[Doc. No. 32]

Defendants Alphatec Holdings, Inc., and Alphatec Spine, Inc. (together, “Alphatec”) have filed a motion to dismiss the seventh and eighth claims in the Plaintiff NuVasive, Inc.’s complaint for failure to state a claim under Federal Rule of Civil Procedure 12(b)(6). The motion as been fully briefed and the Court deems it suitable for submission without oral argument. For the following reasons, the motion is granted.

I. Allegations in the Complaint

NuVasive is a medical device company that invented and developed a spinal fusion surgical procedure called eXtreme Lateral Interbody Fusion, or “XLIF.” [Doc. No. 1 at ¶ 10.] XLIF was “the first spinal surgery using a lateral, transpsoas approach to the spine.”

1 [Id.] NuVasive invented both the XLIF procedure itself and the devices for performing
2 lateral spinal surgery. [Id. at ¶ 11.]

3 In 2016 or 2017, Alphatec launched the Battalion™ Lateral System, which, like
4 XLIF, is a lateral spinal fusion surgical procedure. [Id. at ¶¶ 42-43.] The 121-page
5 complaint alleges that the Battalion Lateral System copies the XLIF system and that
6 Alphatec is liable for willful infringement of six utility patents and two design patents
7 related to the XLIF procedure or the devices used to perform it. Alphatec moves to dismiss
8 only the two design patent infringement claims.


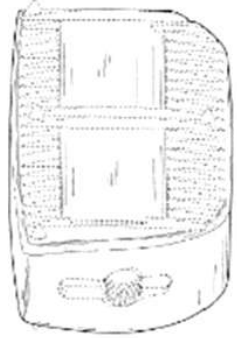

9 **A. Claim VII – Infringement of Design Patent No. D750,252**

10 NuVasive is the owner by assignment of all right, title, and interest in United States
11 Design Patent Number D750,252 (the “‘252 Patent”) for an “Intervertebral Implant.” [Doc.
12 No. 1 at ¶ 500.] NuVasive calls the implants it makes pursuant to this patent “CoRoent®”.
13 The CoRoent® line of implants are specially designed for lateral insertion spinal fusion
14 surgery. [Id. at ¶ 11.] These implants are “sized to span the entire width of the vertebral
15 body to provide maximum vertebral body support. In comparison, implants inserted
16 through non-lateral spinal fusion surgeries have a much smaller footprint and therefore
17 provide weaker intervertebral support.” [Id. at ¶ 21.]

18 The complaint alleges that Alphatec “directly infringes the ‘252 Patent by making,
19 using, selling, offering for sale, and/or importing into the United States products and
20 systems including, but not limited to the Battalion Lateral Spacer which is a component of
21 the Battalion Lateral System, without the permission of NuVasive.” [Id. at ¶ 505.] The
22 complaint includes the following comparison of the ‘252 Patent and the Battalion Lateral
23 Spacer:

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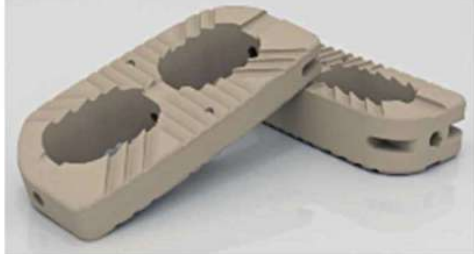
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'252 Patent	Battalion™ Lateral Spacer
 <p data-bbox="527 535 584 567">FIG. 5</p>  <p data-bbox="527 945 584 976">FIG. 7</p>	 <p data-bbox="1039 640 1193 682">Ex. V at 1.</p>

[*Id.* at page 116.] Notably, the broken lines in the '252 Patent illustrations “form[] no part of the claimed design.” [Doc. No. 1-16 at 2.] Thus, the patent does not claim the ridges on the top, the two apertures and connecting bridge, and the opening on the end reflected in figure 7 above.

The complaint also includes a comparison of the CoRoent® XLIF implant and the Battalion™ Lateral Spacer:

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<p style="text-align: center;">NuVasive’s CoRoent[®] XLIF Implant</p>	<p style="text-align: center;">Alphatec’s Battalion[™] Lateral Spacer</p>
<div style="text-align: center;">  <p>Ex. B (XLIF Patient Education Brochure) at 6.</p> </div>	<div style="text-align: center;">  <p>Ex. V (Alphatec’s webpage advertising the Battalion[™] Lateral Spacer)</p> </div>

[*Id.* at ¶ 110.]

According to NuVasive:

An ordinary observer, familiar with the prior art, giving such attention as a purchaser usually gives, would be deceived by the resemblance and substantial similarity of the design of the Battalion[™] Lateral Spacer and the claimed design in the '252 patent, and would thus be induced to purchase one supposing it to be the other, taking into account that the scope of a design patent claim does not cover functional features, that broken lines form no part of the claimed design, and unclaimed features are irrelevant.

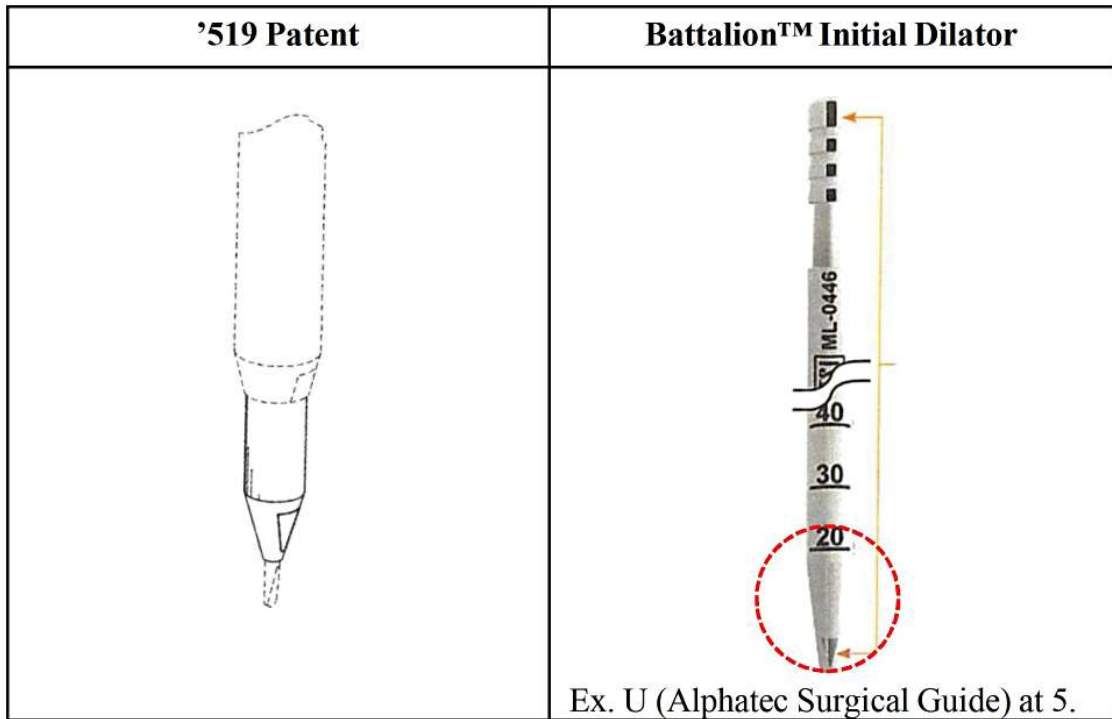
[*Id.* at ¶ 509.]

B. Claim VIII – Infringement of Design Patent No. D652,519

NuVasive is also the owner by assignment of all right, title, and interest in and to United States Design Patent Number D652,519 (the “‘519 Patent”) for a “Dilator.” [*Id.* at ¶¶ 515, 516.] The XLIF surgical procedure uses sequential dilators, “which are a series of successively larger dilators used to create and then incrementally widen an opening to the spine.” [*Id.* at ¶ 19.] “The sequential dilators include directional electrodes at their distal ends which electrically stimulate nerves in the psoas muscle.” [*Id.*]

The complaint alleges that “Alphatec directly infringes the ‘519 Patent, by making using, selling, offering for sale, and/or importing into the United States products and systems including, but not limited to, the Initial Dilator which is a component of the

1 Battalion™ Lateral System (the ‘Battalion™ Initial Dilator’), without the permission of
 2 NuVasive.” [Id. at ¶ 527.] The complaint includes the following comparison of the ‘519
 3 Patent and the Battalion™ Initial Dilator:



17 [Id. at page 116.] As with the ‘252 Patent, the “broken lines . . . form[] no part of the
 18 claimed design.” [Doc. No. 1-17 at 2.]

19 According to NuVasive:

20 An ordinary observer, familiar with the prior art, giving such attention as a
 21 purchaser usually gives, would be deceived by the resemblance and
 22 substantial similarity of the design of the Battalion™ Initial Dilator and the
 23 claimed design in the ‘519 patent, and would thus be induced to purchase one
 24 supposing it to be the other, taking into account that the scope of a design
 patent claim does not cover functional features, that broken lines form no part
 of the claimed design, and unclaimed features are irrelevant.

25 [Id. at ¶ 531.]

26 **II. Legal Standard on Motions to Dismiss**

27 To survive a motion to dismiss under Rule 12(b)(6), “a complaint must contain
 28 sufficient factual matter, accepted as true, to ‘state a claim to relief that is plausible on its

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