

Paper No. _____
Filed: March 2, 2020

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ALPHATEC HOLDINGS, INC. and ALPHATEC SPINE, INC.,
Petitioners,

v.

NUVASIVE, INC.,
Patent Owner.

Case No. IPR2019-00362
Patent No. 8,361,156

PATENT OWNER'S SUR-REPLY

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I. INTRODUCTION

Petitioner has no response for the numerous fatal flaws that NuVasive and the Board identified in the petition. Because the claimed implant is unlike those of the prior art, Petitioner seeks to create confusion to distract from deficiencies of its case-in-chief.

The petition relied on Baccelli for the claimed radiopaque marker configuration. In Reply, Petitioner concedes that Baccelli does not teach the radiopaque marker configuration recited by all challenged claims, but then argues that it did not rely on Baccelli for this claim element.

As motivation to modify Brantigan to include radiopaque markers, the petition parroted the same rationale that the Federal Circuit determined was hindsight. Petitioner does not dispute this, but pivots to a new reference that has no relevance to radiopaque markers.

Petitioner proposed that the reason for modifying Brantigan according to the modular embodiment of Michelson was make the implant safer and less invasive. NuVasive noted that this argument was wholly unsubstantiated and that there were many reasons a multipiece modular combination would decrease safety and increase invasiveness. The Reply fails to substantiate the petition's proposed motivation and does not dispute that sequential insertion would be more invasive because, for example, it would involve "chewing up the endplate" or using

multiple surgical pathways. The Reply states that Petitioner “never” argued for sequential insertion of modular pieces and then pivots to new references and new arguments that were not included with the petition.

Petitioner’s remaining reply arguments are likewise improper and unpersuasive. The Board should hold Petitioner failed to prove its case for each challenged claim.

II. PETITIONER FAILS TO MEET ITS BURDEN ON CLAIM CONSTRUCTION

Petitioner bears the burden of establishing “how the challenged claim is to be construed.” 37 C.F.R. § 42.104(b)(4); *see also In re Magnum Oil Tools Int’l, Ltd.*, 829 F.3d 1364, 1375 (Fed. Cir. 2016). The petition however, is devoid of analysis as to the conventional meaning of the claim terms. Petitioner merely professes that the “plain and ordinary meaning” should be applied and cites *Phillips*. Pet. 26.

Petitioner’s expert witness, Dr. Branch, did not apply the plain and ordinary meaning to the challenged claims—that is, the meaning that the ordinary artisan would apply after reading the entire patent. *Phillips v. AWH Corp.*, 415 F.3d 1303, 1321 (Fed. Cir. 2005). In particular, Dr. Branch adopted a personal “convention” for the term “longitudinal length” which he described as meaning whatever dimension is between the proximal and distal ends, even if it is the shorter

dimension of the implant. EX2022, 52:5-56:9, 116:4-15, 114:3-19 (“my convention”), 117:2 (“If I am going to stick to my convention”).

Nevertheless, and despite not bearing the burden, NuVasive provided a detailed explanation of how the challenged claims should be construed. POR 4-8. For example, NuVasive relied on the specification of the ’156 patent, the prior art references, medical dictionaries, and the testimony of Drs. Youssef and McMillin to establish that the ordinary meaning of “longitudinal” is the longest dimension of the object. POR 4-8. NuVasive also showed that based on the specification of the ’156 patent, dictionaries, and the testimony of Drs. Youssef and McMillin that the “medial plane” and “medial support” are located approximately at the midpoint of the longitudinal length of the implant. POR 8-9.

Petitioner offers no rebuttal. Consequently, NuVasive’s evidence as to the plain and ordinary meaning of “longitudinal length,” “medial plane,” and “medial support” is conclusive. The Board may confirm the patentability of the challenged claims on this basis alone.

III. PETITIONER CONCEDES THAT BACCELLI DOES NOT TEACH THE CLAIMED MARKER CONFIGURATION

The petition relies on Baccelli for teaching a first and second radiopaque marker proximate the medial plane, as required by all challenged claims. Pet. 49-52. Petitioner pointed to spikes 24 of Baccelli and argued that these spikes are located in the medial plane. Pet. 50-51 (annotated figures reproduced below).

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