

Paper No. ____
Filed: March 23, 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 IPR2019-00362
Patent 8,361,156

**PATENT OWNER'S REPLY IN SUPPORT OF
MOTION TO EXCLUDE EVIDENCE**

NuVasive moved to exclude Exhibits 1053-1056, 1059-1062, 1064, and 1065. Paper 38. Petitioner makes no opposition for Exhibits 1060 and 1062. Paper 44. For the remaining exhibits, Petitioner fails to show they are admissible.

I. Exhibits 1053 and 1054

NuVasive moved to exclude Exhibits 1053 and 1054 because they are irrelevant and disconnected from the original obviousness theories in the Petition and/or an untimely attempt to cure identified deficiencies in the Petition. Paper 38, 1-4. *Intelligent Bio-Sys., Inc. v. Illumina Cambridge Ltd.*, 821 F.3d 1359, 1369 (Fed. Cir. 2016) (“the expedited nature of IPRs bring with it an obligation for petitioners to make their case in their petition”); *see also Henny Penny Corp. v. Frymaster LLC*, 938 F.3d 1324, 1329-31 (Fed. Cir. 2019); *Ariosa Diagnostics v. Verinata Health, Inc.*, 805 F.3d 1359, 1367 (Fed. Cir. 2015). Petitioner argues in response that these exhibits “fairly respond[] only to arguments made in Patent Owner’s expert’s declaration and Patent Owner’s response.” Paper 44, 1-2. Petitioner does not contest that it could have presented them with the Petition. Petitioner’s belated reliance on these exhibits leaves its improper new attorney arguments completely unsupported by expert testimony.

Petitioner concedes it is improper in reply to rely on a new rationale to combine the prior art references and thus disclaims any reliance on Exhibits 1053-1054 to provide a new rationale to combine or a new *prima facie* case of

obviousness. Paper 44, 1-2. Exhibits 1053 and 1054 thus should be excluded under F.R.E. 401-403 because Petitioner fails to demonstrate their relevance to the *prima facie* case asserted in the Petition.

Essentially abandoning pretext to its untimely pivot, Petitioner now argues Exhibits 1053 and 1054 show that “hollow, threaded perforated cylinders,” as opposed to the originally cited modular block assembly of Michelson, “may be used individually or inserted across the disc space in side-by-side pairs.” Paper 44, 2. But the Petition relied on the modularity concept of Michelson (EX1032) Figs. 18-19 to supply the alleged motivation to modify the primary reference (*i.e.*, Brantigan), not using multiple cylindrical implants. *E.g.*, Pet. 14, 69-70, 72-75.

Further abandoning pretext to its belated attempt to replace its faulty reliance on Baccelli, Petitioner argues that Exhibit 1054 is relevant because it allegedly confirms “POAs appreciated the benefits of ‘aligning markers with the spinous process and the lateral ends of the vertebrae[.]’” Paper 44, 3. But Petitioner still fails to demonstrate that Exhibit 1054 supports its Petition case that ***Baccelli*** instructs using the claimed marker configuration. Paper 38, 2-3.

Petitioner argues “‘a skilled artisan would have known about’ the teachings of Michelson ’770 and McAfee” (Paper 44, 4), as if mere existence of the references somehow permits their untimely introduction here. This is not the law, nor does it establish a motivation to combine their teachings with the asserted

grounds. Petitioner bears the unshifting burden of proving obviousness, including motivation to combine the asserted teachings of the asserted prior art references. *In re Magnum Oil Tools Int'l, Ltd.*, 829 F.3d 1364, 1375 (Fed. Cir. 2016). Petitioner fails to tie these improper new references to the grounds references and obviousness theory asserted in the Petition.

Petitioner argues that *Koninklijke Philips N.V. v. Google LLC*, 948 F.3d 1330, 1337 (Fed. Cir. 2020) “requires an assessment of” its improper new references to illustrate the “background knowledge possessed by a person having ordinary skill in the art.” Paper 44, 3-4. But where a petitioner wishes to rely on “the general knowledge” of a POSA to supply a claim limitation or motivation to modify or combine, it must do so expressly in the petition and must include in the petition the evidence corroborating the assertion. *See Google*, 948 F.3d at 1335-38 (Fed. Cir. 2020) (“it is the petition, not the Board’s ‘discretion,’ that defines the metes and bounds of an inter partes review”).

Google simply does not support Petitioner’s argument. In *Google*, the petition proposed modifying the primary reference in light of the “general knowledge” of the POSA and specifically cited the Hua reference to corroborate the expert’s testimony about this general knowledge. *Id.* at 1334. In contrast, here, the Petition relied on Baccelli to “instruct” a POSA to use the claimed radiopaque marker configuration and did not assert it was within the “general knowledge” of a

POSA to align radiopaque markers with the spinous process. *See, e.g.*, Pet. 31. No expert testimony supports Petitioner’s attorney argument that aligning radiopaque markers with the spinous process was generally known to a POSA.

Indeed, Petitioner has still failed to point to even a single prior art reference disclosing alignment of radiopaque markers with the spinous process. Contrary to Petitioner’s unsupported assertions, Exhibit 1054 does not confirm that “POSAs appreciated [or, more pertinently, that Baccelli teaches] the benefits of ‘aligning markers with the spinous process[.]’” Paper 44, 3. To the contrary, the image Petitioner relies on is a post-operative image that was not used to position an implant, does not depict radiopaque markers, and does not depict alignment with the spinous process. EX1054, 3 (Fig. 1 “radiographs were obtained after the procedure”). For the reasons discussed above and in NuVasive’s motion, each of Exhibits 1053 and 1054 should be excluded or at least granted no weight.

II. Exhibit 1055

NuVasive objected to Exhibit 1055 as being cited in Petitioner’s reply with no substantive discussion. Paper 38, 4. Petitioner responded by improperly attempting to back-fill arguments regarding Exhibit 1055. Paper 44, 5-6. The Board should disregard these belated and non-responsive arguments.

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