

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ALPHATEC HOLDINGS, INC. and ALPHATEC SPINE, INC.,
Petitioner,

v.

NUVASIVE, INC.,
Patent Owner.

IPR2019-00361 (Patent 8,187,334 B2)
IPR2019-00362 (Patent 8,361,156 B2)
IPR2019-00546 (Patent 8,187,334 B2)¹

Before DENISE M. POTHIER, HYUN J. JUNG, and
SHEILA F. McSHANE, *Administrative Patent Judges*.

JUNG, *Administrative Patent Judge*.

ORDER
Conduct of the Proceeding
37 C.F.R. § 42.5

In a February 14, 2020 email to the Board, Nuvasive, Inc. (“Patent Owner”) contended that Alphatec Holdings, Inc. and Alphatec Spine, Inc.

¹ We exercise our discretion to issue one Order to be entered in each proceeding. The parties are not authorized to use a multiple-case caption.

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(collectively, “Petitioner”) included new exhibits and theories in Petitioner’s Replies (Papers 35²). In particular, Patent Owner identified Exhibits 1053 and 1054 and pages 1–2 and 10–11 of Petitioner’s Reply in IPR2019-00361. Patent Owner requested (1) authorization to file a motion to strike in each of the above-listed proceedings; (2) authorization to add 1,500 words for each of its sur-replies to address the new references and arguments; and (3) an extension of the due date for the sur-replies from February 24, 2020 to March 2, 2020.

In a February 16, 2020 email, Petitioner opposed any motion to strike because, in Petitioner’s view, Exhibits 1053 and 1054 clarified the state of the art, which Patent Owner raised as an issue in its Responses. In a further February 21, 2020 email, the parties indicated that they agreed to a one week extension of time for filing Patent Owner’s sur-replies,³ provided that they are not accompanied by new declarations.

Turning to the filings at issue, Exhibit 1053 is U.S. Patent No. 6,241,770 B1 to Michelson, issued June 5, 2001, and Exhibit 1054 is McAfee *et al.*, “Minimally Invasive Anterior Retroperitoneal Approach to the Lumbar Spine Emphasis on the Lateral BAK,” 23 SPINE, 1476–1484 (1998). The filed versions of Exhibits 1053 and 1054 are the same for all these proceedings. In Petitioner’s Reply, in an apparent response to Patent

² For purposes of expediency, unless otherwise indicated, we cite to papers filed in IPR2019-00361. Petitioner also filed replies in IPR2019-00362 (Paper 34) and IPR2019-00546 (Paper 35).

³ As discussed in the Scheduling Order, the parties may stipulate to a different due date for Patent Owner’s sur-reply, but a notice of the stipulation should be promptly filed. *See* Paper 20, 6–7.

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Owner's contention that implementing a marker configuration to allow surgeons to align markers with the spinous process and lateral ends of a vertebrae was a benefit realized *after* the priority date of U.S. Patent 8,187,334, Petitioner refers to Exhibit 1054 as evidence to attempt to support its allegation that it was already known in the art that "BAK cage emit[] stronger signals at its center and lateral ends (thereby serving as markers)." Paper 35 ("Pet. Reply"), 1–3 (quoting Paper 28 ("PO Resp."), 55) (citing Ex. 1054, 2, 5, 6, 9, Figs. 1, 4, 5). Similar arguments are made in Petitioner's replies for IPR2019-00362 (Paper 34, 1–3) and IPR2019-00546 (Paper 35, 1–3).

In an apparent response to Patent Owner's argument that "Michelson does not disclose sequential insertion of modular members into the disc space but instead teaches assembly prior to insertion," Petitioner refers to both Exhibit 1032 and Exhibit 1053. Pet. Reply 10–11 (quoting PO Resp. 43) (citing Ex. 1032, 3:62–64, 5:34–39, 10:52, 10:56–59, Ex. 1053, 10:10–16, Figs. 13B, 14B). Exhibit 1032 was filed with the Petition. *See* Paper 2, vii (Petitioner's exhibit list). Petitioner argues that Exhibit 1053 shows, for example, that it was known that implants can be side-by-side for insertion generally laterally or anterolaterally into a spine. *See* Pet. Reply 10–11. A similar argument is presented in Petitioner's reply in IPR2019-00362 (Paper 34, 12–13). In IPR2019-00546, responding to Patent Owner's argument that "interbody implants available in the late-1990's were allograft bone and non-bone interbody spinal fusion implants were uncommon in 2003," Petitioner refers to Exhibits 1053 and 1054 (Paper 35, 4 (citing Ex. 1053, 2:20–37; Ex. 1054, 2, 9)).

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Under 37 C.F.R. § 42.23(b), a “reply may only respond to arguments raised in the corresponding opposition, patent owner preliminary response, or patent owner response.” The panel is capable of identifying new issues or belatedly presented evidence when weighing the evidence at the close of trial, and disregarding any new issues or belatedly presented evidence that exceeds the proper scope of a reply. Based on our review of the records at this stage, however, we determine that additional briefing may be helpful.

Thus, we authorize Patent Owner to file a separate supplemental sur-reply to succinctly address why the identified portions of Petitioner’s reply and related exhibits are not properly responsive and, in the event that it is determined that the arguments and evidence are properly responsive, to also address the identified arguments and evidence in each of the above-listed proceedings in accordance with the conditions listed below in the Order. Petitioner is also authorized to file a supplemental sur-sur-reply limited to a discussion of the alleged new arguments and belated presented evidence that is responsive to Patent Owner’s supplemental sur-reply.

To the extent possible, the parties should prepare their supplemental briefs so that issues related to allegedly new arguments and belatedly presented evidence can be distinguished from what the parties believe are properly presented arguments and evidence. For example, Patent Owner should consider addressing only arguments and evidence that Patent Owner believes are properly responsive in its sur-reply authorized by the Scheduling Order, while addressing the allegedly new arguments and evidence in its supplemental sur-reply.

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ORDER

It is hereby:

ORDERED that Patent Owner is authorized to file a supplemental sur-reply to address only the issues identified above, limited to seven (7) pages and filed no later than March 2, 2020;

FURTHER ORDERED that Petitioner is authorized to file a supplemental sur-sur-reply, to address only the issues identified above, limited to seven (7) pages and filed no later than March 9, 2020;

FURTHER ORDERED that no additional evidence, including declarations, or any other briefing associated with the issues above shall be filed;

FURTHER ORDERED that the parties may agree to different due dates for the supplemental sur-reply and supplemental sur-sur-reply by filing promptly a notice of stipulation; and

FURTHER ORDERED that the parties must file a notice of stipulation for the parties' agreed upon extension of time for Patent Owner's sur-replies.

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