

IN RE NUVASIVE, INC., Appeal No. 2015-1670 (Fed. Cir. December 7, 2016). Before Moore, Wallach, and Taranto. Appealed from Patent Trial and Appeal Board.

Background:

NuVasive is the assignee of a patent directed to a spinal fusion implant. In an inter partes review challenging several claims of the patent, the Patent Trial and Appeal Board found that the disputed claims were obvious over combinations of several references, including one patent application publication and three non-patent references. NuVasive appealed.

Issues/Holdings:

Did the PTAB err in finding that the non-patent references are printed publication prior art? No. Did the PTAB err in finding that the claims would have been obvious over the applied references? Yes, vacated and remanded.

Discussion:

NuVasive argued that the PTAB's decision should be reversed because (1) the PTAB should not have found the non-patent references to be printed publication prior art; and (2) the PTAB erred in concluding that it would have been obvious to include radiopaque markers that are proximate to the medial plane of the implant, as required in the challenged claims.

The Federal Circuit held that NuVasive had waived its arguments regarding the availability of the non-patent references as prior art. The court noted that, although NuVasive challenged the public accessibility of the non-patent references during the preliminary proceedings of the inter partes review, it did not address this issue during the trial phase. During the trial arguments, NuVasive explicitly stated that it would focus on its obviousness positions without addressing the public availability of the non-patent references despite the fact that the PTAB had indicated in a scheduling order that this would result in a waiver. Thus, the court concluded that NuVasive waived these arguments and could not raise them on appeal.

The court also held that the PTAB erred in finding NuVasive's patent obvious over the applied combinations of references because the PTAB failed to articulate any motivation for combining the references. The court noted that the PTAB merely stated that it would have been obvious to combine the references to place radiopaque markers on the medial plane of an implant because the modification would provide "additional information." However, the court found that the PTAB never actually articulated any finding that the evidence affirmatively proved that a person of ordinary skill in the art would have sought this additional information. For example, the PTAB never explained why the additional information would benefit a person of skill when implanting a posterior lumbar interbody fusion implant, such as those disclosed in the references. The PTAB also failed to explain the type of additional information that would be obtained, or how a person of ordinary skill would use that information. The court therefore concluded that it could not "reasonably discern" the PTAB's reasoning as to the motivation to combine the references, and it vacated and remanded the case for additional PTAB findings and explanations regarding the motivation to combine the references.