FEDERAL CIRCUIT PATENT LAW CASE UPDATE

Cross Med. Prods. v. Medtronic Sofamor Danek, 05-1043 (Fed. Cir. Sept. 30, 2005) (Linn, J.)

Revising parts of the claim construction below, and thus vacating the district court's permanent injunction, the court reversed the partial summary judgment that Medtronic's spine-stabilizing devices infringed the Cross patent for such devices. Medtronic did not meet, as a direct infringer, a claim limitation requiring an anchor seat means to be operatively joined to the bone segment, but there were genuine issues as to contributory infringement and inducement, and as to obviousness on the invalidity issues raised for Cross's patent.

Cross owns U.S. Pat. No. 5,474,555, relating to "orthopedic surgical implants used to stabilize and align the bones of a patient's spine." Claim 5 was at issue. It recited structure, including an anchor with "anchoring means" and "anchor seat means," to stabilize the spine with a rod that would span across vertebrae. The rest of the recited structure related to a "securing means" and how it interfaced with a channel in the anchor seat means and the rod. Also, the "anchor seat means" has a lower bone interface "operatively joined" to the bone segment.

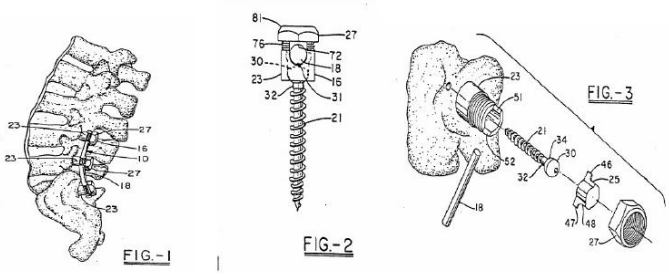
Cross sued Medtronic based on claim 5, and the district court issued a permanent injunction after ruling on validity and infringement summary judgment motions in favor of Cross.

After putting aside Cross's objection to its jurisdiction, the court revised some of the claim constructions below.

> [W]e affirm the district court's construction of the "anchoring means," "securing means," and "bear against said channel" limitations, but modify the district court's construction of the "anchor seat means" and "operatively joined" limitations.

The court found sufficient claimed structure so that "anchor seat means" was not a § 112, ¶6 limitation, but its characterization as such was harmless error.

> The claim does not state explicitly whether the "bone interface" and the "bone segment" must be in contact [to



> be "operatively joined"]. However, . . . [t]he term "joined" describes the relationship between the "bone interface" and the "bone segment." . . . The written description confirms that the interface must contact the bone. The screw is separate from the anchor seat, which prevents the direct transfer of load from the rod to the "bone-screw interface," and decreases the chance of failure of the "bone-screw interface." . . . As to "operatively," the term is often used descriptively in patent drafting to mean "effectively" in describing the functional relationship between claimed components. . . . Therefore, from the context of the written description, it is clear that one of ordinary skill in the art would have understood "operatively" to mean effective to produce posterior stabilization. The district court erred in construing "operatively" to mean "surgically." Because the only way a "fixation device" can provide "posterior stabilization" is through a surgical procedure, construing "operatively" to

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> mean "surgically" renders the word superfluous, as used in the claim.

The Medtronic device interposed a crown between its channel and the rod, effectively converting a unitary component in the claimed structure to multiple components.

> [T]he district court correctly concluded that the "bear against said channel" language of claim 5 does not exclude an "anchor seat portion" composed of multiple components.

Against these claim construction rulings, the court reversed the infringement determination. Neither Medtronic nor its device could possibly meet the "operatively joined" limitation until the device was used in surgery.

> Here, the claim does not require that the interface be merely "capable" of contacting bone; the claim has a structural limitation that the anchor seat be in contact with bone. . . . Cross Medical has not proven that Medtronic makes an apparatus with an anchor seat in contact with bone. . . . The anchor seat of the device does not contact bone until the surgeon implants it.

Inducement and contributory infringement presented a closer case. The court reversed the judgment of infringement as a matter of law, finding issues of material fact for remand.

In relation to the "securing means" term, the court also decided that Medtronic was not estopped from arguing that a set screw and external nut were not equivalent merely by having argued that they were equivalent in another case. In the other case the function of the screw or nut was somewhat different.

> [W]e conclude that there is a genuine issue of material fact with respect to whether a set screw is equivalent to an external nut. Thus, the district court erred in deciding equivalents as a matter of law.

On the last limitation, Medtronic's crown also necessitated vacating the district court's infringement determination.

> There is a genuine issue of material fact as to whether the "bear against [the] channel" limitation is met by the accused products.

While affirming several invalidity determinations, the court found a genuine issue for trial under the obviousness criteria.

> The district court erred in discounting the clinical investigators' recognition of the problem. "It has long been the law that the motivation to combine need not be found in prior art references, but equally can be found 'in the knowledge generally available to one of ordinary skill in the art.'" . . . Evidence of a motivation to combine references need not be in the form of prior art. . . . Evidence that a person of ordinary skill in the art recognized the same problem to be solved as the inventor and suggested a solution is, at the least, probative of a person of ordinary skill in the art's willingness to search the prior art in the same field for a suggestion on how to solve that problem.

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