

IN THE UNITED STATES DISTRICT COURT  
FOR THE DISTRICT OF DELAWARE

CORDIS CORPORATION, )  
)  
Plaintiff, )  
)  
v. ) Civ. No. 97-550-SLR  
)  
MEDTRONIC VASCULAR, )  
INC., BOSTON SCIENTIFIC )  
CORPORATION and SCIMED )  
LIFE SYSTEMS, INC. )  
)  
Defendants. )  
\_\_\_\_\_ )  
)  
MEDTRONIC VASCULAR, )  
INC., )  
)  
Plaintiff, )  
)  
v. ) Civ. No. 97-700-SLR  
)  
)  
CORDIS CORPORATION, )  
JOHNSON & JOHNSON )  
and EXPANDABLE GRAFTS )  
PARTNERSHIP, )  
)  
Defendants. )  
\_\_\_\_\_ )  
)  
BOSTON SCIENTIFIC )  
CORPORATION, )  
)  
Plaintiff, )  
)  
v. ) Civ. No. 98-019-SLR  
)  
)  
ETHICON, INC., CORDIS )  
CORPORATION, JOHNSON & )  
JOHNSON INTERVENTIONAL )  
SYSTEMS, INC. )  
)  
Defendants. )

REVISED MEMORANDUM ORDER

At Wilmington this 28th day of February, 2005, having reviewed the various pending matters in this case in the context of the complex record developed in these and related proceedings; and consistent with the parties' email highlighting several errors in the February 23, 2005 memorandum order;

IT IS ORDERED that:

1. **JMOL.** Medtronic has renewed its motion for JMOL as it relates to the jury's finding of literal infringement of the "flexibly connect" limitation of the '984 patent. To prevail on a renewed motion for judgment as a matter of law following a jury trial under Federal Rule of Civil Procedure 50(b), the moving party "must show that the jury's findings, presumed or express, are not supported by substantial evidence or, if they were, that the legal conclusions implied [by] the jury's verdict cannot in law be supported by those findings.'" Pannu v. Iolab Corp., 155 F.3d 1344, 1348 (Fed. Cir. 1998) (quoting Perkin-Elmer Corp. v. Computervision Corp., 732 F.2d 888, 893 (Fed. Cir. 1984)).

"Substantial' evidence is such relevant evidence from the record taken as a whole as might be acceptable by a reasonable mind as adequate to support the finding under review." Perkin-Elmer Corp., 732 F.2d at 893. In assessing the sufficiency of the evidence, the court must give the non-moving party, "as [the] verdict winner, the benefit of all logical inferences that could be drawn from the evidence presented, resolve all conflicts in

the evidence in his favor, and in general, view the record in the light most favorable to him." Williamson v. Consol. Rail Corp., 926 F.2d 1344, 1348 (3d Cir. 1991); Perkin-Elmer Corp., 732 F.2d at 893. The court may not determine the credibility of the witnesses, or substitute its resolution of conflicting evidence for that of the jury. See GNB Battery Technologies, Inc. v. Exide Corp., 876 F. Supp. 582, 597 (D. Del. 1995), aff'd, 78 F.3d 605 (Fed. Cir. 1996). In summary, the court must determine whether the evidence reasonably supports the jury's verdict. See Dawn Equip. Co. v. Kentucky Farms Inc., 140 F.3d 1009, 1014 (Fed. Cir. 1998).

2. The court construed the claim limitation "flexibly connect" as follows:

To connect in such a way as to allow turning, bending or twisting without breaking. Websters Third New International Dictionary 869 (1993). As stated previously, the connector member must provide flexibility, whether or not the adjacent tubular members themselves are flexible.

(D.I. 793 at 3; D.I. 966 at 2333:19-23)

3. Medtronic argues in support of its motion that its "weld sites cannot meet the 'flexibly connect' limitation of the asserted '984 claims because they are rigid." (D.I. 1064) Even assuming that the court's claim construction should be interpreted as narrowly as Medtronic asserts, Cordis provided substantial evidence to the contrary, i.e., that the weld sites

(the connector members) are themselves flexible.<sup>1</sup> (D.I. 960 at 657-663; D.I. 962 at 1142-1152, 1159-1166, 1285; PX 2981-C; PX 3657; PX 1317; PX 64; PX 3468) Although Medtronic presented opposing evidence, the jury found Cordis' evidence more persuasive. Therefore, Medtronic's renewed motion for JMOL is denied.

4. **Cordis' motions in limine.**

a. Cordis' motion in limine to define the issues that are, and are not, in dispute, and to preclude defendants from re-litigating issues unaffected by the remand that already have been decided (Civ. No. 97-550-SLR, D.I. 1292-1; Civ. No. 97-700-SLR, D.I. 248-1; Civ. No. 98-019-SLR, D.I. 157-1) is **granted** to the following extent:

(1) As to Medtronic, the following issues remain in dispute: (a) Whether the accused Medtronic stents literally infringe the "substantially uniform thickness" limitation under the revised claim construction; and (b) whether claims 23, 51 and 54 of the '762 patent and claims 1 and 3 of the '984 patent are invalid as obvious under the new claim construction.

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<sup>1</sup>Cordis also provided substantial evidence that the tubular segments of the Medtronic stents are connected in such a way as to allow turning, bending or twisting without breaking, and that the connector members provide flexibility. (D.I. 960 at 661-662, 682-683, 703-715; 962 at 1277-1295; PX 3257)

(2) As to BSC, the following issues remain in dispute: (a) Whether the accused BSC stents literally infringe the "substantially uniform thickness" limitation under the revised claim construction; and (b) whether claim 23 of the '764 patent is invalid as obvious under the new claim construction. On the record at bar, there can be no finding of literal infringement of claim 23 (see D.I. 1302 at 7 ("[G]iven the general verdict form, it is not clear whether the jury found [the 'wall surface' and 'smooth surface'] limitations to be met literally or by equivalents"). Therefore, the reverse doctrine of equivalents is inapplicable.

b. Cordis' motion in limine to bar expert witnesses from offering their interpretations of the Federal Circuit's decision or alluding to that decision in their testimony (Civ. No. 97-550-SLR, D.I. 1292-2; Civ. No. 97-700-SLR, D.I. 248-2; Civ. No. 98-019-SLR, D.I. 157-2) is **granted**. In their testimony, expert witnesses cannot mention or discuss their impressions of the Federal Circuit's opinion in Cordis Corp. v. Medtronic AVE, Inc. et al., 339 F.3d 1352 (Fed. Cir. 2003). The appropriate test for measuring the thickness of the wall surface at a strut's crowns is a question of fact for the jury, not a matter of law determined by the Federal Circuit. More specifically, the Federal Circuit's discussion with respect to measuring the thickness of a strut does not amount to a holding that one of

ordinary skill would only measure thickness a certain way, as the Federal Circuit's statements were made in the context of infringement, not claim construction. Therefore, each party can present evidence with respect to how one of ordinary skill in the art would measure the thickness of the wall surface.

c. Cordis' motion in limine to preclude Medtronic from asserting that the patents in suit do not cover stents with round struts (Civ. No. 97-550-SLR, D.I. 1292-3; Civ. No. 97-700-SLR, D.I. 248-3; Civ. No. 98-019-SLR, D.I. 157-3) is unopposed and, therefore, **moot**.

d. Cordis' motion in limine to preclude BSC from asserting that a "tubular member" must be capable of functioning independently to support a vessel (Civ. No. 97-550-SLR, D.I. 1292-4; Civ. No. 97-700-SLR, D.I. 248-4; Civ. No. 98-019-SLR, D.I. 157-4) is unopposed and, therefore, **moot**.

e. Cordis' motion in limine to preclude BSC from denying that the NIR stent can fairly be characterized as having rings and connectors (Civ. No. 97-550-SLR, D.I. 1292-5; Civ. No. 97-700-SLR, D.I. 248-5; Civ. No. 98-019-SLR, D.I. 157-5) is unopposed and, therefore, **moot**. (See Pre-trial Conference Tr. at 35: 17-19 (Feb. 10, 2004))

f. Cordis' motion in limine to preclude references to the initial trials and verdicts (Civ. No. 97-550-SLR, D.I. 1292-6; Civ. No. 97-700-SLR, D.I. 248-6; Civ. No. 98-019-SLR,

D.I. 157-6) is **granted**. The jury will be informed, as needed, that certain issues are not in dispute; any references to prior testimony shall be referred to as "prior testimony under oath."

g. Cordis' motion in limine (1) under Daubert, to preclude Dr. Ersek from testifying as an expert; (2) to bar Dr. Ersek from testifying as a fact witness because he is receiving compensation that is impermissible for a fact witness; and (3) in the alternative, to limit any testimony Dr. Ersek may be permitted to offer (Civ. No. 97-550-SLR, D.I. 1292-7; Civ. No. 97-700-SLR, D.I. 248-7; Civ. No. 98-019-SLR, D.I. 157-7) is **granted** to the following extent: Dr. Ersek currently is not a qualified expert in the relevant art. To the extent he has factual knowledge about his device, that knowledge is irrelevant unless disclosed in his patent. Therefore, he may not testify as a fact witness absent a proffer that his proposed testimony is consistent with his patent. Moreover, he may not refer to the Andros declaration. If he testifies, his compensation and professional experience are relevant fodder for cross examination. The evidence relating to the "fee" conversations shall not be admitted.

h. Cordis' motion in limine to exclude improper product-to-product comparisons (Civ. No. 97-550-SLR, D.I. 1292-8; Civ. No. 97-700-SLR, D.I. 248-8; Civ. No. 98-019-SLR, D.I. 157-8) is **granted** to the extent that product-by-product comparisons (as

well as product-by-preferred embodiment comparisons) may **not** be introduced for purposes of an infringement analysis. However, such comparisons may be appropriate in the context of validity and/or damages analyses.

i. Cordis' motion in limine to exclude assertions that defendants' accused stents are superior to the claimed invention (Civ. No. 97-550-SLR, D.I. 1292-9; Civ. No. 97-700-SLR, D.I. 248-9; Civ. No. 98-019-SLR, D.I. 157-9) is **granted**, consistent with paragraph 4.h.

j. Cordis' motion in limine to exclude testimony and argument relating to the safety of the patented devices (Civ. No. 97-550-SLR, D.I. 1292-10; Civ. No. 97-700-SLR, D.I. 248-10; Civ. No. 98-019-SLR, D.I. 157-10) is **granted**.

k. Cordis' motion in limine to preclude Medtronic from playing a misleading, edited version of the "breathe-Spence-breathe" videotape (Civ. No. 97-550-SLR, D.I. 1292-11; Civ. No. 97-700-SLR, D.I. 248-11; Civ. No. 98-019-SLR, D.I. 157-11) is **granted**. Either the entire tape shall be played (both parties sharing the time), or no part of the tape shall be played.

l. Cordis' motion in limine to exclude evidence of defendants' patents on their accused stents (Civ. No. 97-550-SLR, D.I. 1292-12; Civ. No. 97-700-SLR, D.I. 248-12; Civ. No. 98-019-SLR, D.I. 157-12) is **granted**, unless Cordis is accusing any party of copying. If copying is an issue, the patents may be relevant



to a validity analysis; the patents are not relevant to an infringement analysis.

m. Cordis' motion in limine to exclude evidence relating to "Project Galaxy" and "Project Olive" (Civ. No. 97-550-SLR, D.I. 1292-13; Civ. No. 97-700-SLR, D.I. 248-13; Civ. No. 98-019-SLR, D.I. 157-13) is **granted**.

n. Cordis' motion in limine to preclude defendants from raising the issue of inequitable conduct (Civ. No. 97-550-SLR, D.I. 1292-14; Civ. No. 97-200, D.I. 248-14; Civ. No. 98-019-SLR, D.I. 157-14) is **granted** to the extent that other witnesses may not characterize Dr. Andros' subjective intent or knowledge vis a vis his declaration. If Dr. Andros takes the stand, he may be cross examined on the accuracy of his declaration.

o. Cordis' motion in limine to preclude defendants from questioning Dr. Timothy Fischell to any inequitable conduct in connection with prosecution of the '312 and '370 patents (Civ. No. 97-550-SLR, D.I. 1292-15; Civ. No. 97-700-SLR, D.I. 248-15; Civ. No. 98-019-SLR, D.I. 157-15) is **granted**, except that Dr. Fischell's credibility may be explored if he testifies about secondary considerations of nonobviousness.

p. Cordis' motion in limine to bar defendants from presenting testimony by Dr. Stanley Carson (Civ. No. 97-550-SLR, D.I. 1292-16; Civ. No. 97-700-SLR, D.I. 248-16; Civ. No. 98-019-SLR, D.I. 157-16) is **granted**.

q. Cordis' motion in limine to limit the cross-examination of Dr. Palmaz (Civ. No. 97-550-SLR, D.I. 1292-17; Civ. No. 97-700-SLR, D.I. 248-17; Civ. No. 98-019-SLR, D.I. 157-17) is **denied**. However, Cordis' right to object to the cross-examination is preserved, should such become redundant, irrelevant or otherwise abusive.

r. Cordis' motion in limine to preclude defendants from disputing that ACS's Multilink stents infringe claim 23 of the '762 patent (Civ. No. 97-550-SLR, D.I. 1292-18; Civ. No. 97-700-SLR, D.I. 248-18; Civ. No. 98-019-SLR, D.I. 157-18) is **denied**.

s. Cordis' motion in limine to deem certain in limine rulings from 2000 applicable to the upcoming trials (Civ. No. 97-550-SLR, D.I. 1292-19; Civ. No. 97-700-SLR, D.I. 248-19; Civ. No. 98-019-SLR, D.I. 157-19) is **granted**.

##### **5. Medtronic's motions in limine.**

a. Medtronic's motion in limine to preclude Cordis from referring to rulings, verdicts, and attorney arguments from prior proceedings in this and other cases (Civ. No. 97-550-SLR, D.I. 1290-1; Civ. No. 97-700-SLR, D.I. 246-1) is **granted**, consistent with paragraph 4.f.

b. Medtronic's motion in limine to preclude Cordis from offering evidence or argument that "substantially uniform thickness" has a range of equivalents (Civ. No. 97-550-SLR, D.I.

1290-2; Civ. No. 97-700-SLR, D.I. 246-2) is unopposed and, therefore, **moot**.

c. Medtronic's motion in limine to preclude Cordis from offering testimony, evidence, or argument concerning license or settlement agreements for the patents in suit (Civ. No. 97-550-SLR, D.I. 1290-3; Civ. No. 97-700-SLR, D.I. 246-3) is **granted** as to the ACS arbitration settlement, **moot** as to the ACS license agreement, and **denied** as to the Abbott & Jomed licenses.

d. Medtronic's motion in limine to exclude irrelevant information, improper character evidence, inadmissible hearsay, and unfairly prejudicial information concerning Medtronic's expert witness Dr. Robert Ersek (Civ. No. 97-550-SLR, D.I. 1290-4; Civ. No. 97-700-SLR, D.I. 246-4) is **denied**, consistent with paragraph 4.g.

e. Medtronic's motion in limine to preclude Cordis from referencing the "essence of the invention" or comparing the accused devices to the patent abstract (Civ. No. 97-550-SLR, D.I. 1290-5; Civ. No. 97-700-SLR, D.I. 246-5) is unopposed and, therefore, **moot**. (See D.I. 1325)

f. Medtronic's motion in limine to preclude Cordis from referring to the commercial success of stents not proven to be embodiments of the patents in suit (Civ. No. 97-550-SLR, D.I. 1290-6; Civ. No. 97-700-SLR, D.I. 246-6) is **denied** as to Cordis' BX Velocity and Cypher stents.

g. Medtronic's motion in limine to preclude evidence and argument regarding the IP Worldwide Article (Civ. No. 97-550-SLR, D.I. 1290-7; Civ. No. 97-700-SLR, D.I. 246-7) is **denied**.

h. Medtronic's motion in limine to preclude Cordis from offering evidence, argument, or testimony as to whether any witness thought of the apparatus claimed in the Cordis patents (Civ. No. 97-550-SLR, D.I. 1290-8; Civ. No. 97-700-SLR, D.I. 246-8) is **granted**.

i. Medtronic's motion in limine to preclude evidence and argument about the reexamination of U.S. Patent No. 4,733,665 (Civ. No. 97-550-SLR, D.I. 1290-9; Civ. No. 97-700-SLR, D.I. 246-9) is **granted**.

j. Medtronic's motion in limine to preclude Cordis from referring to the attempted sale of Vastent, Inc. (Civ. No. 97-550-SLR, D.I. 1290-10; Civ. No. 97-700-SLR, D.I. 246-10) is **granted**.

6. **BSC's motions in limine**.

a. BSC's motion in limine to preclude Cordis from introducing evidence about or referring to any prior proceedings, trials, verdicts, judgments, appeals, decisions or rulings in this litigation, apart from the current claim construction (Civ. No. 97-550, D.I. 1287-1) is **granted**, consistent with paragraph 4.f.

b. BSC's motion in limine to preclude Cordis from introducing evidence about or referring to any prior proceedings, trials, verdicts, judgments, decisions or rulings in any other stent litigation, arbitration or other proceeding, as well as any related settlement negotiations, agreements or licenses (Civ. No. 97-550, D.I. 1287-2) is **granted**, consistent with paragraphs 4.f and 5.c.

c. BSC's motion in limine to preclude Cordis from introducing evidence or telling the jury about Examiner Thaler's comments regarding the prior art, including the Palmaz abstract and Ersek patent, made during both of the reexaminations of the '665 patent (Civ. No. 97-550, D.I. 1287-3) is **granted**.

d. BSC's motion in limine to preclude Cordis from introducing evidence or arguing to the jury that it was hindsight for BSC's experts and its counsel to select the Palmaz abstract and the Ersek patent as prior art references for the obviousness analysis, or that it was hindsight for BSC's experts to have reviewed claims 23 of the '762 patent in advance of analyzing obviousness (Civ. No. 97-550, D.I. 1287-4) is **granted** in part and **denied** in part. Cordis may question the experts on how they came to review the particular prior art references upon which their opinions are based. Cordis may not argue, however, that it was impermissible hindsight as a matter of law to do so.

e. BSC's motion in limine to preclude Cordis from offering evidence relating to the issue of whether claim 44 of the '762 patent is invalid for obviousness under 35 U.S.C. § 103 (Civ. No. 97-550, D.I. 1287-5) is unopposed and, therefore, **moot**.

f. BSC's motion in limine to preclude Cordis from telling the jury that there has been any prior verdict or determination that a "C-region" of the NIR stent infringes the "tubular member" limitation of claim 23 of the '762 patent, and from introducing evidence or arguing to the jury that a "C-region" infringes the "tubular member" limitation under the doctrine of equivalents if it is not literally "elongated" (Civ. No. 97-550, D.I. 1287-6) is unopposed and, therefore, **moot**.

g. BSC's motion in limine for an order confirming the applicability of certain prior in limine rulings in Civil Action No. 97-550-SLR and in the BSC/Medinol litigation, Civil Action No. 99-904-SLR, alleging Cordis' BX Velocity, Crown and Corinthian stents infringed the Israel patents (Civ. No. 97-550, D.I. 1287-7) is **granted**.

**6. Order of trial presentation.**

a. **Cordis v. Medtronic case.** At Medtronic's request, the order of trial presentation shall be as follows:

(1) Cordis shall present its case in chief on infringement.

(2) Medtronic shall present its defense to infringement and its case in chief on invalidity.

(3) Cordis shall present its defense to invalidity.

(4) There shall be no rebuttal cases presented unless the parties can demonstrate true surprise.

(5) Closing arguments shall be presented as follows: Cordis (all issues); Medtronic (all issues); Cordis (very limited rebuttal on infringement).

b. **Cordis v. BSC case.** At the parties' request, the order of trial presentation shall be as follows:

(1) Cordis shall present all of its evidence on infringement and invalidity;

(2) BSC shall present all of its evidence on infringement and invalidity;

(3) There shall be no rebuttal cases presented unless the parties can demonstrate true surprise.

(4) Closing arguments shall proceed as follows: Cordis (all issues); BSC (all issues); and Cordis (very limited rebuttal on infringement).

Sue L. Robinson  
United States District Judge