

IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF DELAWARE

CORDIS CORP.,)
)
Plaintiff,)
v.) Civ. No. 97-550-SLR
)
MEDTRONIC AVE, INC.,)
BOSTON SCIENTIFIC CORP.)
and SCIMED LIFE SYSTEMS,)
INC.)
)
Defendants.)
_____)
)
MEDTRONIC AVE, INC.,)
)
Plaintiff,)
v.) Civ. No. 97-700-SLR
)
CORDIS CORP., et al.)
)
Defendants.)
_____)
)
BOSTON SCIENTIFIC CORP.,)
)
Plaintiff,)
v.) Civ. No. 98-019-SLR
)
ETHICON, INC., et al.)
)
Defendants.)
_____)
)
CORDIS CORP.,)
)
Plaintiff,)
v.) Civ. No. 98-197-SLR
)
BOSTON SCIENTIFIC CORP.,)
et al.,)
)
Defendants.)

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MEMORANDUM OPINION

Dated: January 27, 2005
Wilmington, Delaware

ROBINSON, Chief Judge

I. INTRODUCTION

These cases have a long and complicated history, only the relevant parts of which will be discussed here. In the fall of 2000, a jury trial was held to decide issues of infringement and damages. The jury found that Medtronic's stents infringed, under the doctrine of equivalents, the asserted claims of United States Patent Nos. 4,739,762 ("the '762 patent") and 5,195,984 ("the '984 patent"). The district court granted JMOL of noninfringement, finding that Cordis was estopped from asserting infringement under the doctrine of equivalents. Cordis appealed the JMOL decisions to the Federal Circuit. The Federal Circuit reversed this court's original claim construction and remanded the case for further proceedings. Cordis Corp. v. Medtronic AVE, Inc., 339 F.3d 1352 (Fed. Cir. 2003). On February 17, 2004, this court reconstrued the relevant limitations of the asserted claims. (D.I. 1201)

Before the court is Cordis' motion for summary judgment that defendants waived arguments regarding the obviousness of these patents. (D.I. 1258) For the reasons stated, this motion is denied.

II. BACKGROUND

At the time of the previous trials, the court had construed the "slots formed therein" limitation to mean that the slots be formed in the wall surface of a tubular member, as by the removal of material. (D.I. 790) The "substantially uniform thickness" limitation of the asserted claims was construed to require that the thickness of the stent's wall surface not vary by 0.001 inch or more. (Id.)

In response to the Federal Circuit's opinion reversing certain parts of the claim construction, the court reconstrued the "plurality of slots formed therein" limitation as meaning that "the stent is constructed to contain a plurality of slots in its wall surface." (D.I. 1201 at 5) The "substantially uniform thickness" limitation was reconstrued to mean that the walls "must be of largely or approximately uniform thickness." (D.I. 1251 at 2 n.1)

III. STANDARD OF REVIEW

A court shall grant summary judgment only if "the pleadings, depositions, answers to interrogatories, and admissions on file, together with the affidavits, if any, show that there is no genuine issue as to any material fact and that the moving party is entitled to judgment as a matter of law." Fed. R. Civ. P. 56(c). The moving party bears the burden of proving that no genuine issue of material fact exists. See Matsushita Elec.

Indus. Co. v. Zenith Radio Corp., 475 U.S. 574, 586 n.10 (1986). "Facts that could alter the outcome are 'material,' and disputes are 'genuine' if evidence exists from which a rational person could conclude that the position of the person with the burden of proof on the disputed issue is correct." Horowitz v. Fed. Kemper Life Assurance Co., 57 F.3d 300, 302 n.1 (3d Cir. 1995) (internal citations omitted). If the moving party has demonstrated an absence of material fact, the nonmoving party then "must come forward with 'specific facts showing that there is a genuine issue for trial.'" Matsushita, 475 U.S. at 587 (quoting Fed. R. Civ. P. 56(e)). The court will "view the underlying facts and all reasonable inferences therefrom in the light most favorable to the party opposing the motion." Pa. Coal Ass'n v. Babbitt, 63 F.3d 231, 236 (3d Cir. 1995). The mere existence of some evidence in support of the nonmoving party, however, will not be sufficient for denial of a motion for summary judgment; there must be enough evidence to enable a jury reasonably to find for the nonmoving party on that issue. See Anderson v. Liberty Lobby, Inc., 477 U.S. 242, 249 (1986). If the nonmoving party fails to make a sufficient showing on an essential element of its case with respect to which it has the burden of proof, the moving party is entitled to judgment as a matter of law. See Celotex Corp. v. Catrett, 477 U.S. 317, 322 (1986).

IV. DISCUSSION

A. Waiver

Cordis contends that Medtronic and BSC waived any arguments that the '762 and '984 patents are obviousness in light of the prior art because they failed to assert this argument at trial with respect to the '762 patent and because the jury found the '984 patent nonobvious. Cordis' argument is based on its view that the differences between the claim construction at trial and the revised claim construction are not substantive. Medtronic and BSC contend that the trial should not have any preclusive effect with respect to their arguments under the new claim construction.

The consideration of obviousness changed as a result of the revised claim construction. See, e.g., TI Group Automotive, Sys. v. VDO N. Am., LLC, 375 F.3d 1126, 1139-40 (Fed. Cir. 2004). The elimination of the requirements that slots be formed by removing material and that the stents be uniformly thick within .001 inches, broadens the claims and increases the number of pertinent prior art references. (D.I. 1275 at 5-6; D.I. 1277, Ex. A at ¶¶ 13-19, Ex. G at ¶ 9, Ex. I at 159, Ex. J at 411, 530). These prior art references were not relevant in the context of the previous, narrower constructions and, therefore, defendants were not required to assert them in the previous trials.

Cordis also contends that Medtronic had the opportunity to argue that the claims, as currently construed, were obvious as a noninfringement defense under Wilson Sporting Goods Co. v. David Geoffrey & Associates, 904 F.2d 677, 685 (Fed. Cir. 1990). In Wilson Sporting Goods, the alleged infringer argued that its accused products were not different from the prior art, thus, they could not be considered infringing products under the doctrine of equivalents (i.e., "practicing the prior art defense"). Id. The Federal Circuit agreed, finding that prior art can be used as a defense to infringement under the doctrine of equivalents because the doctrine cannot be used to encompass prior art within asserted claims. Id. at 683-85.

The Federal Circuit has taken a narrow view of Wilson Sporting Goods and refused to extend it to claims of literal infringement, explaining that "[p]rior art is relevant to literal infringement only to the extent that it affects the construction of ambiguous claims." Tate Access Floors, Inc. v. Interface Architectural Res., Inc., 279 F.3d 1357, 1367 (Fed. Cir. 2002). In Tate Access Floors, the Federal Circuit reasoned that infringers could not use "practicing prior art" as a defense to literal infringement because they "are not free to flout the requirement of proving invalidity by clear and convincing evidence by asserting a 'practicing prior art' defense to literal

infringement under the less stringent preponderance of the evidence standard.” Id.

In the original trial against Medtronic, Cordis argued that Medtronic infringed the '762 and '984 patents under the doctrine of equivalents. Pursuant to Wilson Sporting Goods, Medtronic could have asserted a “practicing prior art” defense. This does not mean, however, that because it did not assert such a defense it has waived its ability to bring an invalidity argument. With respect to invalidity, “it is the prior art and its relationship to the claim language that matters.” Tate Access Floors, 279 F.3d at 1367. In this case, in order to assert the Wilson Sporting Goods defense in the prior trial, Medtronic would have had to present to the jury a broader claim construction than that ordered by the court. Both the court and Cordis, one suspects, would have objected on the grounds, inter alia, of jury confusion. Therefore, it is unrealistic to have expected Medtronic to present invalidity arguments in the original trial if it thought such arguments were futile based on the narrower claim construction at issue. See Exxon Chem. Patents, Inc. v. Lubrizol Corp., 137 F.3d 1475, 1479 (Fed. Cir. 1998). It would be unfair to hold Medtronic to this broader claim construction now.

B. Costs And Fees

Medtronic requested that the court award it the costs and fees associated with responding to Cordis' motion for summary judgment. On September 22, 2004, the court stated that Cordis would pay the costs of briefing if the court found that there were genuine issues of disputed facts with respect to Cordis' summary judgment motions. (D.I. 1253 at 17) Having now found genuine issues of fact in dispute, the court awards the costs of briefing to Medtronic.

V. CONCLUSION

For the reasons stated, Cordis' motion for summary judgment that Medtronic and BSC waived their obviousness defenses (D.I. 1258) is denied. As directed by the court, Cordis shall pay the reasonable costs of briefing incurred by Medtronic. An order consistent with this memorandum opinion shall issue.