

IN THE UNITED STATES DISTRICT COURT  
FOR THE DISTRICT OF DELAWARE

MEDTRONIC VASCULAR, INC. and )  
MEDTRONIC USA, INC, )  
 )  
Plaintiffs, )  
 )  
v. ) Civ. No. 98-80-SLR  
 )  
ADVANCED CARDIOVASCULAR )  
SYSTEMS, INC. and GUIDANT )  
SALES CORP., )  
 )  
Defendants. )

**MEMORANDUM ORDER**

At Wilmington this 2d day of February, 2005, having reviewed Medtronic's motions for reconsideration of the court's opinions and orders dated January 5, 2005 (D.I. 557, 558, 559) and the papers submitted in connection therewith;

IT IS ORDERED that:

1. Medtronic's motion for reconsideration of the court's order and opinion that its state law claims are time-barred (D.I. 558) is denied. The evidence of record demonstrates that, by 1994, Medtronic had constructive notice of the confidentiality agreement executed on August 21, 1989, between a predecessor in interest and ACS.<sup>1</sup> At the time Medtronic's predecessor in

---

<sup>1</sup>In the court's view, Medtronic cannot claim the benefits of this agreement through its acquisition of the Boneau technology and concomitantly disclaim knowledge of it.

interest acquired the Boneau technology, reasonable diligence would have called for inquiry into circumstances under which the technology had been disclosed to others.<sup>2</sup> Medtronic had actual notice of both the Lau and Boneau technologies by 1994.<sup>3</sup> Therefore, the three-year statute of limitations had run prior to commencement of this case in 1998.<sup>4</sup>

2. Medtronic's motion for reconsideration of the court's order and opinion that Mr. Boneau is not a joint inventor of the Lau patents (D.I. 559) is denied. The court has concluded, based on the evidence of record, that a reasonable jury could not find that Mr. Boneau offered any information other than what was

---

<sup>2</sup>See Black's Law Dictionary 457 (6<sup>th</sup> ed. 1991) (defining "reasonable diligence" as "[a] fair, proper and due degree of care and activity, measured with reference to the particular circumstances . . .").

<sup>3</sup>The Lau European patent issued and was received by AVE in 1993. In 1994, ACS went public with its Multi-Link stent and Boneau's '331 patent issued.

<sup>4</sup>In addition to the facts of record that support this conclusion, the law is in accord. More specifically, when a patent is published containing a trade secret, it destroys the trade secret. Patents serve to "put the world on notice" with respect to what the patentee claims to own; thus, any trade secret in a patent is no longer secret. Once a trade secret is destroyed, the statute of limitations begins to run because the misappropriation of that trade secret is no longer a continuing tort. See Prescott v. Morton Int'l, Inc., 769 F. Supp. 404 (D. Mass. 1990); M & T Chems., Inc. v. Int'l Bus. Mach. Corp., 403 F. Supp. 1145 (S.D.N.Y. 1975); Milgrim on Trade Secrets § 13.04[2] (2001). Based on this analysis, any trade secrets disclosed by Mr. Boneau were either destroyed in 1993 (when the Lau European patent issued) or in 1994 (when Mr. Boneau's patent issued), and the statute of limitations would have run in 1996 or 1997, respectively.

already in the prior art.

3. Medtronic's motion for reconsideration of the court's order and opinion finding that Medtronic's S7 and Driver stents infringe claim 1 of the '133 patent (D.I. 557) is granted. The court concludes that there is a material issue of fact with respect to whether the accused devices meet the "cylindrical element" limitation as construed by the court. The court construed "cylindrical element" as "a radially expandable segment of a stent having a longitudinal length less than its diameter with a circumferential undulating pattern" and construed "undulating pattern" as "any combination of U-shaped, W-shaped or Y-shaped members." (D.I. 542) Based on the common definition of "combination," this construction requires that there be at least two of the three letter shaped elements. See American Heritage Dictionary 295 (1982) (defining "combination" as "resulting from combining two or more things").

The S7 and Driver stents have circular bands, comprised of an undulating pattern, that are connected by welds located on some, but not all, of the undulating bends. (D.I. 436, Ex. 4 at 100-101) Whether or not the welds that connect the circular bands of the S7 and Driver stents form Y-shaped members and, thus, the S7 and Driver stents have U-shaped and Y-shaped members, is a disputed question of fact. Therefore, infringement of claim 1 of the '133 patent by the S7 and Driver stents is an

issue to be decided by the jury.

Sue L. Robinson  
United States District Judge