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Medical Device Under Judicial Microscope: DePuy Spine, Inc. v. Medtronic Sofamor Danek, Inc.

Johnson & Johnson subsidiary DePuy Spine, Inc. (DePuy) was recently involved in a \$20 million (plus) patent infringement case regarding polyaxial screw spinal implant devices. The case was litigated to a jury yielding a verdict of \$20 million in favor of DePuy Spine. On appeal, the Federal Circuit upheld DePuy Spine's \$20 million verdict as to one product manufactured by Medtronic Sofamor Danek, Inc. (Medtronic), and reversed a summary-judgment ruling as to the infringement by another Medtronic product. Furthermore, the court ordered an infringement trial to determine whether a third Medtronic product infringed on the DePuy patent.

A few different models for surgical type screws were at the heart of this patent litigation case between the two leading companies involved in medical technologies. The screws manufactured, distributed, and sold by the respective parties are used in surgical procedures involving the spine- utilized to hold the spine in place while the procedure is being performed. DePuy owns the rights to patent No. 5,207,678 (patent '678) which claims a device for stabilizing spinal column segments, comprising.... "an inner hollow spherically shaped portion for receiving the head" [of a screw].

An interesting focus of the litigation revolved around whether the infringing screws designed by Medtronic (their Vertex® model) contained a spherically-shaped portion- a limitation of patent '678. Naturally, Medtronic denied such accusation and pointed out that their device in fact comprises a conically-shaped element.

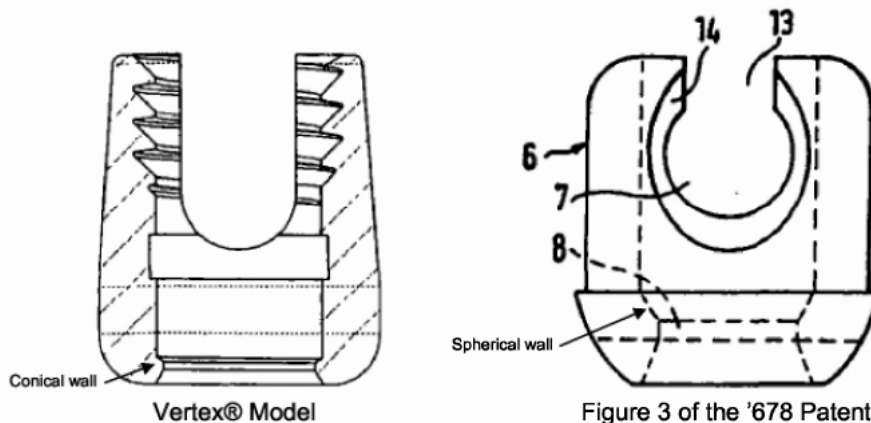


Diagram from published opinion

DePuy proposed an interesting argument with respect to Medtronic's assertions that their inner wall is conical rather than spherically-shaped. DePuy proposed that Medtronic's Vertex® model had edges that only looked conical but where in fact spherical, comparing that model's inner wall to a thin slice of a sphere which creates a profile that appears conical. The court didn't buy that argument and affirmed the district court's finding of

literal infringement, noting the comparison only highlights the fact that at “varying degrees of magnification or abstraction a curved surface can appear angular.”

However, the court moved on to discuss district court’s summary judgment of non-infringement under the doctrine of equivalents with respect to the Vertex ® model. After applying the “all elements rule,” the U.S. Court of Appeals for the Federal Circuit found that there was a question of fact as to whether a cylindrical conical shape could be equivalent to a spherically-shaped element claimed in a patent for surgical screws, reversing the lower court’s summary judgment of non-infringement under the doctrine of equivalents.

Turning to what was referred to as the “bottom-loaded screws” the court concluded that the model’s lacked a limitation in the claims of patent ‘678 as a matter of law, thus affirming the district court’s grant of summary judgment of non-infringement for that model. As to a third model the opinion referred to as the MAS model- the court affirmed the jury verdict awarding damages and costs to DePuy.

Although an apparent victory for DePuy (even though their battle isn’t quite over) Medtronic managed to save some of their largest selling spinal products which Medtronic will continue to distribute to their customers.

By: Saul Acherman

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