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UNITED STATES DISTRICT COURT  
SOUTHERN DISTRICT OF CALIFORNIA

WARSAW ORTHOPEDIC, INC.,  
MEDTRONIC SOFAMOR DANEK  
U.S.A., INC., MEDTRONIC PUERTO  
RICO OPERATIONS CO., and  
OSTEOTECH, INC.,  
  
Plaintiffs,  
  
v.  
  
NUVASIVE, INC.,  
  
Defendant.  
  
AND RELATED COUNTERCLAIMS.

Case No.: 12-cv-2738-CAB (MDD)

**ORDER GRANTING  
COUNTERDEFENDANTS’ MOTION  
FOR SUMMARY JUDGMENT OF  
NON-INFRINGEMENT OF U.S.  
DESIGN PATENT NO. 652,922**

Before the Court is the motion for Summary Judgment of Non-Infringement of U.S. Design Patent No. 652,922<sup>1</sup> (“the ‘922 patent”) brought by plaintiffs/counterdefendants,<sup>2</sup> collectively “Warsaw”. [Doc. No. 207, 246 (sealed).] The motion was opposed by defendant/counterclaimant NuVasive, Inc. [Doc. No. 248 (sealed).] Warsaw filed a reply.

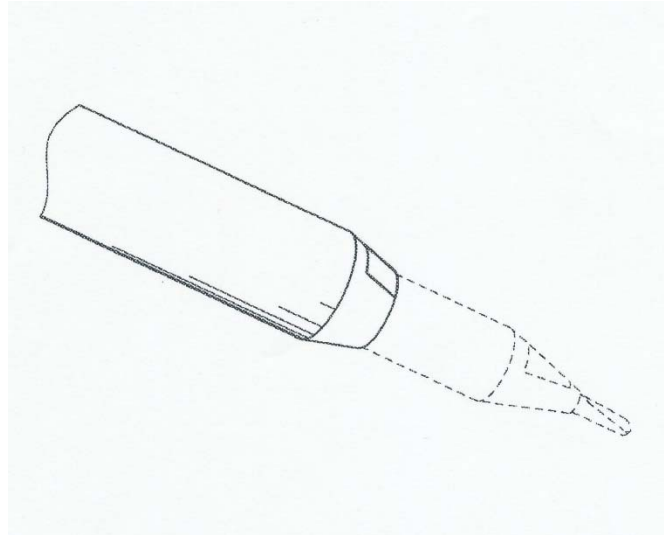
<sup>1</sup> A copy of the patent is attached as Exhibit G to the Second Amended Counterclaim. [Doc. No. 85-7.]  
<sup>2</sup> The Plaintiffs/Counterdefendants are Warsaw Orthopedic, Inc., Medtronic Sofamor Danek U.S.A., Inc., Medtronic Puerto Rico Operations Co., Osteotech, Inc., Medtronic, Inc., Medtronic Sofamor Danek Deggendorf, GmbH, Medtronic Logistics, LLC, Medtronic Xomed, Inc., and Spinalgraft Technologies, LLC.

1 [Doc. No. 251 (sealed).] The Court held a hearing on the motion and, having considered  
2 the submissions of the parties and the arguments of counsel, the motion is GRANTED.

3 **I. Background**

4 Design patents protect new, original, and ornamental designs for an article of  
5 manufacture. 35 U.S.C. § 171; *Richardson v. Stanley Works, Inc.*, 597 F.3d 1288, 1293  
6 (Fed. Cir. 2010) (a design patent, unlike a utility patent, limits protection to the ornamental  
7 design of the article). NuVasive is the assignee of the ‘922 patent for an ornamental design  
8 for a dilator. [Doc. No. 85-7, Claim.] The dilator is a tube used to gradually dilate tissue  
9 to create initial access into a patient for performing surgical procedures. NuVasive asserts  
10 that Warsaw’s 16mm NIM-Eclipse Direct Lateral Dilator infringes the ‘922 patent.

11 The sole figure of the ‘922 patent is reproduced below:



21 The figure shows a perspective view of a dilator. The patent description explains  
22 that:

23 The broken lines illustrate part of the distal portion that forms no part of the  
24 claimed design. The dilator is circular as seen from the end. The break line  
25 is shown at the wide end to indicate that only the distal portion of the dilator  
26 is illustrated. Only one view of the article is shown in the drawing or  
27 described in the specification. It is understood that the appearance of any part  
28 of the article not shown in the drawing or described in the specification forms  
no part of the claimed design.

1 [Id., Description.] The figure includes a cylindrical main body, a tapered section, and a  
2 rectangular surface indicium on the tapered section of the cylindrical main body at the  
3 distal edge. This indicium corresponds to the edges of an electrode that allows a user to  
4 detect and avoid nerves when employing the dilator in a surgical procedure. [Doc. No. 239,  
5 ¶5.]

6 On October 16, 2013, Warsaw filed a petition requesting *inter partes* review of the  
7 ‘922 patent, arguing the patent was invalid under 35 U.S.C. §§ 102 and 103. Warsaw  
8 challenged the patentability of the ‘922 patent, in part, on the basis that its features are  
9 purely functional. *See Richardson*, 597 F.3d at 1293-94 (if a patented design is primarily  
10 functional rather than ornamental, the patent is invalid). “When the design also contains  
11 ornamental aspects, it is entitled to a design patent whose scope is limited to those aspects  
12 alone and does not extend to any functional elements of the claimed article.” *Id.* at 1294.

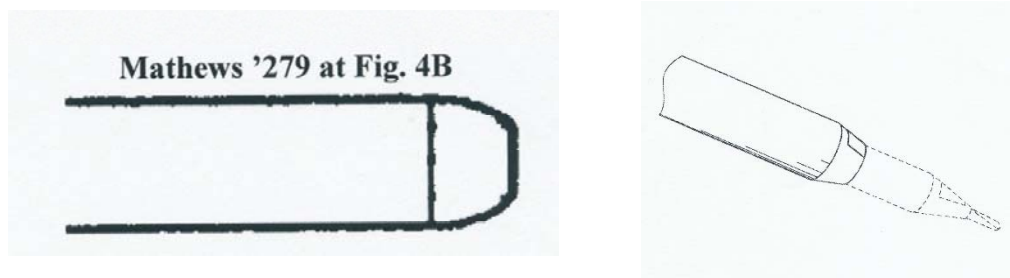
13 The Patent Trial and Appeal Board of the Patent and Trademark Office (“PTAB”)  
14 construed the claim of the ‘922 patent to separate its functional and ornamental aspects.  
15 *See OddzOn Prods., Inc. v. Just Toys, Inc.*, 122 F.3d 1396, 1405 (Fed. Cir 1997) (where a  
16 design contains both functional and non-functional elements, the scope of the claim must  
17 be construed in order to identify the non-functional aspects of the design as shown in the  
18 patent). The PTAB construed “the claim of the ‘922 patent to be the ornamental design of  
19 a dilator, including, as seen in the figure, a Cylindrical Main Body, a Tapered Section  
20 extending from the distal end of the Cylindrical Main Body, and Surface Indicia/Electrode  
21 on the Tapered Section in the shape of a rectangle, with one side of the rectangle being  
22 extensive with the distal edge of the Tapered Section.” [Doc. No. 174-6, at 8-9.]<sup>3</sup>

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<sup>3</sup> Page references are to the docketed CM/ECF assigned page numbers of a document.

1 The PTAB rejected Warsaw's contention that the design was primarily functional  
2 and found that the tapered section and the surface indicia/electrode are not purely  
3 functional elements of the claimed design. The PTAB determined that the function of the  
4 tapered section, to aid in tissue penetration of the surgical dilator, could be accomplished  
5 by tapering shapes having different ornamental appearances. The Administrative Patent  
6 Judge ("APJ"), by way of example, found that the "more rounded shape of tapering" used  
7 in a prior art dilator tube depicted in U.S. Patent No. 5,171,279, Fig. 4B, "differs noticeably  
8 from the frustoconical tapered section of the dilator claimed in the '922 patent." [Doc.  
9 No. 174-6, at 7.]



15

16 Similarly, with regard to the nerve detection function of an electrode on the tapered  
17 section of the dilator, the PTAB determined that that function could be accomplished using  
18 electrodes that have substantially different shapes and orientations, and therefore  
19 substantially different ornamental appearances. [*Id.*] Again by way of example, the APJ  
20 compared the triangular-shaped electrode employed on NuVasive's currently available  
21 dilator with the rectangular-shaped electrode of the design. [*Id.*, at 6-7.] The PTAB  
22 declined to institute *inter partes* review.

23 Following the PTAB decision, the parties briefed the issue of claim construction for  
24 this Court's consideration. The Court adopted the PTAB's construction for the purpose of  
25 identifying the non-functional aspects of the design as shown in the patent. [Doc. No. 183,  
26 Transcript of Hr'g., at 66-69.] Warsaw now moves for summary judgment of non-  
27 infringement on the basis that the design features of the accused dilator and the '922 patent  
28

1 are sufficiently distinct and plainly dissimilar, such that NuVasive cannot prove  
2 infringement as a matter of law.

## 3 II. Legal Framework

4 Pursuant to Fed. R. Civ. P. 56(a), summary judgment is appropriate when “there is  
5 no genuine issue as to any material fact and the moving party is entitled to judgment as a  
6 matter of law.” Material facts are those that may affect the outcome of the case. *See*  
7 *Anderson v. Liberty Lobby, Inc.*, 477 U.S. 242, 248 (1986). A dispute as to a material fact  
8 is genuine if there is sufficient evidence for a reasonable jury to return a verdict for the  
9 non-moving party.

10 The moving party bears the burden to show that no genuine issue of material fact  
11 exists. *See Celotex Corp. v. Caltrett*, 477 U.S. 317, 323-24 (1986). If this burden is met,  
12 the burden shifts to the non-moving party to set forth affirmative evidence from which a  
13 jury might return a verdict in its favor. All evidence must be viewed in the light most  
14 favorable to the non-moving party. At this stage, a court does not assess the credibility or  
15 weigh the evidence, but simply determines whether there is a genuine factual issue for trial.  
16 *Anderson*, 477 U.S. at 249.

17 A design patent is infringed “[i]f, in the eye of an ordinary observer, giving such  
18 attention as a purchaser usually gives, two designs are substantially the same, if the  
19 resemblance is such as to deceive such an observer, inducing him to purchase one  
20 supposing it to be the other.” *Egyptian Goddess, Inc. v. Swisa, Inc.*, 543 F.3d 665, 670  
21 (Fed. Cir. 2008), *citing Gorham Co. v. White*, 81 U.S. 511, 528 (1871). The patentee must  
22 prove by a preponderance of the evidence that an ordinary observer, familiar with the prior  
23 art designs, would be deceived into believing that the accused product is the same as the  
24 patented design. *Richardson*, 597 F.3d at 1295.

25 Where the claimed and accused designs are “sufficiently distinct” and “plainly  
26 dissimilar,” the patentee fails to meet its burden of proving infringement as a matter of law.  
27 *Egyptian Goddess*, 543 F.3d at 678. If the claimed and accused designs are not plainly  
28 dissimilar, the inquiry may benefit from comparing the claimed and accused designs with

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