



## TECHNOLOGY LAW UPDATE

*Cross Med. Prods.,  
Inc.*  
v.  
*Medtronic Sofamor  
Danek, Inc.*

No. 05-1043

Federal Circuit  
Sept. 30, 2005

*[T]o succeed on a claim of contributory infringement, in addition to proving an act of direct infringement, plaintiff must show that defendant “knew that the combination for which its components were especially made was both patented and infringing” and that defendant’s components have “no substantial non-infringing uses.”*

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On September 30, 2005, the Federal Circuit *inter alia* vacated the district court’s permanent injunction enjoining Medtronic from infringing claim 5 of U.S. Patent No. 5,474,555, which related to orthopedic surgical implants used to stabilize and align the bones of a patient’s spine. The Federal Circuit stated:

Under § 271(b), “[w]hoever actively induces infringement of a patent shall be liable as an infringer.” “[T]o succeed on a claim of inducement, the patentee must show, first that there has been direct infringement,’ and ‘second, that the alleged infringer knowingly induced infringement and possessed specific intent to encourage another’s infringement.’” Under § 271(c), “[w]hoever offers to sell or sells within the United States . . . a component of a patented machine, manufacture, combination or composition . . . constituting a material part of the invention, knowing the same to be especially made or especially adapted for use in an infringement of such patent, and not a staple article or commodity of commerce suitable for substantial noninfringing use, shall be liable as a contributory infringer.” [T]o succeed on a claim of contributory infringement, in addition to proving an act of direct infringement, plaintiff must show that defendant “knew that the combination for which its components were especially made was both patented and infringing” and that defendant’s components have “no substantial non-infringing uses.” . . .

As to inducement, there is a genuine issue of material fact both as to whether Medtronic “knowingly induced infringement” and as to whether Medtronic “possessed specific intent to encourage [the surgeons’] infringement.” On the one hand, in the record are Medtronic’s “Field Bulletins” instructing surgeons that the proper technique for installation of the Medtronic device is with the receiver member not in contact with the bone. Medtronic asserts that these materials [show] that it had no specific intent to encourage infringement. On the other hand, Cross Medical points to [evidence] that Medtronic anticipated that surgeons would contact bone and intended that the device function when in contact with bone. Drawing inferences in favor of Medtronic, a reasonable juror could find that Medtronic did not know that surgeons make the claimed apparatus and, moreover, did not specifically intend for surgeons to contact bone with the anchor seat. Drawing inferences in favor of Cross Medical, a reasonable juror could find that Medtronic designed its device to function when the anchor seat contacted bone, anticipated that surgeons would contact the anchor seat to bone, and thus intended for the surgeon to make or use the apparatus as claimed.

As to contributory infringement, there is a genuine issue of material fact as to whether there are substantial non-infringing uses of Medtronic’s devices, specifically, uses of the devices with no receiver member-to-bone contact. Drawing inferences in favor of Medtronic, a reasonable juror could conclude [that] a substantial number of surgeries occur in which the claimed apparatus is not made or used, as surgeons are able to avoid contact between the seat and bone. Drawing inferences in favor of Cross Medical, a reasonable juror might also conclude that in almost every surgery, the claimed apparatus is made or used, as some contact between the receiver member and the bone is incidental.

[T]he district court erred in ruling [that] no genuine issues of material fact [existed] as to infringement and that Medtronic infringed as a matter of law.