

NOVEMBER 20, 2006

## DePuy Spine, Inc. v. Medtronic Sofamor Danek, Inc.

Nos. 05-1311, -1335, Federal Circuit (Newman, Linn, Prost)

*[W]hen we have held that the doctrine of equivalents cannot be applied to an accused device because it “vitiates” a claim limitation, it was not to hold that the doctrine is always foreclosed whenever a claim limitation does not literally read on an element of an accused device; such an interpretation of the “all elements” rule would swallow the doctrine of equivalents entirely.*

On November 20, 2006, the Federal Circuit, inter alia, affirmed the district court’s denial of Medtronic’s motion for judgment as a matter of law notwithstanding the jury verdict that Medtronic infringed, under the doctrine of equivalents, U.S. Patent No. 5,207,678, which related to pedicle screws and receiver members used in spinal surgeries. The Federal Circuit stated:

Under the doctrine of equivalents, “a product or process that does not literally infringe upon the express terms of a patent claim may nonetheless be found to infringe if there is ‘equivalence’ between the elements of the accused product or process and the claimed elements of the patented invention.”... One limit on the doctrine of equivalents is the “all elements” rule. The “all elements” rule attempts to balance the doctrine of equivalents with the basic patent law principle that claim language defines the scope of an invention and every limitation is material.... Thus, as a practical matter, the “all elements” rule informs a doctrine of equivalents analysis by requiring that equivalence be assessed on a limitation-by-limitation basis, rather than from the perspective of the invention as a whole, and that no limitation be read completely out of the claim.

[I]n certain instances, the “all elements” rule forecloses resort to the doctrine of equivalents because, on the facts or theories presented in a case, a limitation would be read completely out of the claim—i.e., the limitation would be effectively removed or “vitated.” For instance, we have concluded that in some cases, the evidence was such that no reasonable jury could determine a proffered equivalent to be insubstantially different from the claimed limitation. We have also concluded that in some cases, the patentee’s theory of equivalence was legally insufficient because, rather than demonstrate an insubstantial difference between



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a limitation and an element in the accused device, the theory effectively eliminated a limitation in its entirety. Thus, the “all elements” rule generally is not met—and therefore a claim limitation can be said to be vitiated—if the theory or evidence of equivalence is legally incapable of establishing that the differences between the limitation in the claim and the accused device are insubstantial; i.e., if the theory or evidence is so legally insufficient as to warrant a holding of non-infringement as a matter of law....

[W]hen we have held that the doctrine of equivalents cannot be applied to an accused device because it “vitiates” a claim limitation, it was not to hold that the doctrine is always foreclosed whenever a claim limitation does not literally read on an element of an accused device; such an interpretation of the “all elements” rule would swallow the doctrine of equivalents entirely. “[A]ny analysis of infringement under the doctrine of equivalents necessarily deals with subject matter that is ‘beyond,’ ‘ignored’ by, and not included in the literal scope of a claim.” A holding that the doctrine of equivalents cannot be applied to an accused device because it “vitiates” a claim limitation is nothing more than a conclusion that the evidence is such that no reasonable jury could conclude that an element of an accused device is equivalent to an element called for in the claim, or that the theory of equivalence to support the conclusion of infringement otherwise lacks legal sufficiency....

We [disagree with] the district court’s conclusion that applying the doctrine of equivalents would vitiate or read out the “spherically-shaped” limitation.... DePuy did not propose that any shape would meet the “spherically-shaped” limitation. Rather, DePuy’s expert presented particularized declarations demonstrating its theory that a specific element of the accused device—the hollow conically-shaped portion of the receiver member—was insubstantially different from the corresponding “spherically-shaped” limitation because it supported the screw head, allowed for flexible movement, and—when the compression member is engaged—creates a rigid lock between the screw head and the receiver. Indeed, the expert expressly identified certain shapes that were different from the accused device but would not be capable of supporting the screw head, allowing flexible movement, and creating a rigid lock when the compression member is engaged....

Because DePuy’s theory of equivalence is not legally insufficient, and because we find that a question of fact exists as to whether the difference between the “spherically-shaped” limitation and the alleged equivalent is substantial, we hold that the district court erred in granting summary judgment of non-infringement under the doctrine of equivalents for the Vertex® model.

For more information on these issues or other intellectual property law matters, please contact **Lawrence M. Sung, Ph.D.** at [lsung@nixonpeabody.com](mailto:lsung@nixonpeabody.com) or 202-585-8221.

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