

**Boston Scientific Scimed, Inc. v. Cordis Corp.**

No. 08-1073, Fed. Cir. (Lourie,\* Rader, Prost)

***Combining two embodiments disclosed adjacent to each other in a prior art patent does not require a leap of inventiveness.***

On January 15, 2009, the Federal Circuit reversed the district court's denial of Cordis' motion for a new trial and judgment as a matter of law following a jury verdict that Cordis infringed U.S. Patent 6,120,536, which related to a drug-eluting expandable stent with a coating that has a non-thrombogenic surface. The Federal Circuit stated:

We agree with Cordis that Wolff [(U.S. Patent 5,545,208)] alone renders claim 8 of the '536 patent obvious and therefore invalid. . . . While a jury may render a decision on a question of obviousness when it is considering any underlying fact questions, obviousness is ultimately a question of law that this court reviews de novo. When we consider that, even in light of a jury's findings of fact, the references demonstrate an invention to have been obvious, we may reverse its obviousness determination. That is the case here.

[C]laim 8 recites a metallic stent with an open lattice structure. The stent includes an undercoat and a topcoat. The undercoat contains a drug, and the topcoat is drug-free and non-thrombogenic. Boston Scientific admits that Wolff contains most of the limitations of claim 8. Wolff discloses a metallic stent with an open lattice structure. In figures 2 and 4, where figure 4 is an enlargement of the embodiment shown in figure 2, Wolff discloses a metallic stent with an open lattice structure. Wolff also discloses a stent including an undercoat and a topcoat, where the undercoat contains a drug. In figure 3B, there is shown a "layer 14," made of polymer covered by a "second layer of polymer 15." Moreover, the specification describes that the stent shown in figure 3B "may be made from one or several layers of polymer." Thus, even though figure 3B shows only two layers of polymer, the stent itself and a single coating, the specification clearly contemplates the use of several, or more than two, layers of polymer, meaning it contemplates at least two coatings. Wolff also discloses that the topcoat is drug-free, as layer 15 in figure 3B "may be a simple barrier which limits diffusion of drugs" and "could be as simple as a silicone or polyurethane."

Wolff also discloses that the topcoat is non-thrombogenic. In figure 3B, the "barrier coating 15 could be as simple as a silicone or polyurethane," two materials that are generally non-thrombogenic. Even if, as Boston Scientific contends, silicone and polyurethane are not inherently non-thrombogenic, Wolff clearly contemplates that the topcoat will be non-thrombogenic. . . . Wolff contemplates using the design of the stent, which may contain a silicone or polyurethane topcoat, to reduce thrombogenesis, in addition to using the elution of a thrombolytic drug to reduce thrombogenesis. Thus, the record did not contain substantial evidence for the jury to conclude that Wolff does not teach a non-thrombogenic topcoat. Boston Scientific argues that Wolff fails to recognize the additional non-thrombogenic benefits of a topcoat that is substantially drug-

free over a topcoat that contains drug, but Wolff need not have recognized the additional benefit of one embodiment to have rendered the claim obvious.

As we have explained, Wolff teaches all of the limitations of claim 8, and the record did not contain substantial evidence for the jury to conclude otherwise. The only qualification to this statement of fact is that all of the limitations are found in two separate embodiments pictured side by side in the patent, not in one embodiment. However, “[i]f a person of ordinary skill can implement a predictable variation, § 103 likely bars its patentability.” We agree with Cordis that one of ordinary skill in the art would have been motivated to combine the embodiment in figure 3B of Wolff with the embodiment in figure 4 of Wolff to arrive at a metal stent with two coating layers. Combining two embodiments disclosed adjacent to each other in a prior art patent does not require a leap of inventiveness. As shown in Cordis’s drawing and described in the specification of Wolff, figure depicts a metal stent with a drug-eluting polymer coating, the coating represented by numeral 14. Figure 3B, which is located directly below figure 4 in the patent, shows a drug-eluting polymer stent, also represented by numeral 14, coated with “a second layer of polymer 15.” One of ordinary skill would have been motivated to coat the metal stent of figure 4, including its layer 14 of drug-containing polymer, with a second layer of polymer, like layer 15 depicted in figure 3B, that is substantially free of an elutable material. Just as the stent in figure 3B benefits from the two layers, one containing a drug and the other limiting diffusion of the drug, so would the stent in figure 4 benefit from the same two coating layers. A metal stent coated with a drug-eluting polymer and a second layer of drug-free polymer, as shown in figures 3B and 4, is what constitutes claim 8.

We also agree with Cordis that the weak secondary considerations of nonobviousness do not overcome the strong prima facie showing that Wolff renders claim 8 of the ’536 patent obvious. Even though Medtronic owned the Wolff patent and two other prior art patents that Cordis relies on and failed to develop a drug-eluting stent, Cordis presented evidence that the failure was due to difficulty in finding a suitable drug, rather than an inability to conceive of a drug-containing undercoat combined with a drug-free topcoat. Moreover, “given the strength of the prima facie obviousness showing, the evidence on secondary considerations was inadequate to overcome a final conclusion that [the claim] would have been obvious.”

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