

Design Patent Case Digest

[Medtronic, Inc. v. NuVasive, Inc.](#)



Decision Date: March 21, 2014

Court: Patent Trial and Appeal Board

Patents: [D652,922](#)

Holding: Petition to Institute *Inter Partes* Review DENIED

Opinion:

Medtronic, Inc. filed a petition requesting *inter partes* review of U.S. Design Patent No. D652,922 ("the '922 Patent"), entitled "Dilator." NuVasive, Inc. owns the '922 Patent, which claims "[t]he ornamental design for a dilator, as shown and described" in the sole figure of the '922 Patent. The '922 Patent is interestingly a continuation of a utility patent application that has resulted in two utility patents (U.S. Patent Nos. [7,582,058](#) and [7,935,051](#)). The sole figure in the design patent is Figure 3 in these utility patents. Medtronic's petition challenged the sole claim of the '922 Patent on anticipation and obviousness grounds. Specifically, Medtronic argued that U.S. Patent No. [6,159,179](#) ("Simonson") and U.S. Patent No. [5,171,279](#) ("Mathews") each anticipated the '922 Patent and that various combinations of Simonson, Mathews, U.S. Patent No. [6,228,052](#) ("Pohndorf"), WIPO Publication No. [WO 00/38574](#) ("Marino"), and U.S. Patent No. [6,719,692](#) ("Kleffner") rendered the '922 Patent obvious.

An *inter partes* review may not be instituted unless the Patent Trial and Appeal Board ("the Board") determines that the petitioner has shown that there is a reasonable likelihood that the petitioner will prevail with respect to at least one of the challenged claims. When undertaking a claim validity analysis, the Board employs the broadest reasonable construction of the claim. In the context of a design patent, the claim is defined by the accompanying figures.

Medtronic described the dilator as having three elements: the cylindrical main body, the tapered section, and the surface indicia on the tapered section. The surface indicia is "in the shape of a rectangle, with one side of the rectangle being coextensive with the distal edge of the Tapered Section." It allows a user to detect and avoid nerves during a surgical procedure.

Medtronic first claimed that the tapered section and the surface indicia were functional elements that should not be considered for purposes of anticipation or obviousness. NuVasive countered noting that several other varieties exist including triangular-shaped electrodes that are spaced away from the distal edge of the dilator. The Board accepted NuVasive's argument noting that the tapered section and the surface indicia on the dilator can be made in substantially different shapes and orientations and, therefore, substantially different ornamental appearances.

Having determined that the claimed design was not purely functional, the Board looked at whether Simonson or Mathews anticipated the '922 Patent. The test for anticipation in a design patent case is the ordinary observer test. Using the ordinary observer test, the prior art is compared to the

patented design. If an ordinary observer would have bought a product with the patented design believing it to be the product of the prior art, then the prior art anticipates the patented design.

Both Simonson and Mathews disclose dilators with beveled ends on the distal side of a tubular body. The Board noted, however, that neither design shows the surface indicia in the shape of a rectangle, with one side of the rectangle being coextensive with the distal edge of the tapered section. The Board held that because this is a required element of the '922 Patent, neither Simonson nor Mathews anticipated the '922 Patent.

The Board turned its attention to obviousness. The ultimate inquiry in an obvious analysis is whether the claimed design would have been obvious to a designer of ordinary skill in the art. To complete this analysis, the Board must find a single primary reference that has the same basic design characteristics as the claimed design. Then, the Board may use other references to modify the primary reference to create a design with the same overall visual appearance as the claimed design. The secondary references must be "so related" to the primary reference that the appearance of features in one reference would suggest the application of those features to the other reference.

Medtronic presented ten different combinations of primary and secondary references that it claimed rendered the '922 Patent obvious. Medtronic argued that the secondary references, including Pohndorf, Marino, and Kleffner, disclose the surface indicia missing from Simonson and Mathews. Pohndorf shows an oval-shaped hole used to inject contrast media located in the center of its tapered section. Marino shows nerve surveillance probes with two teardrop-shaped surface indicia. Kleffner shows a surgical drill bit with a rectangular ultrasonic transducer on its tapered section.

The Board held that none of these references, when combined with Simonson or Mathews, would have the same overall appearance as the '922 Patent. Pohndorf and Marino did not show surface indicia in the shape of a rectangle. Even Kleffner, which did show a rectangle, did not have a side of the rectangle being coextensive with the distal edge of the tapered section. This difference persuaded the Board to hold that the '922 Patent was not rendered obvious by the ten proposed combinations of Simonson, Mathews, Pohndorf, Marino, and Kleffner. The Board also rejected Kleffner because it was not "so related" to the analogous art of the dilators.

Having considered all of Medtronic's arguments, the Board declined to institute *inter partes* review.

If you have any questions or would like additional information on this topic, please contact:

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Special thanks to Associate Steve A. Merrill for his role as a contributing author of this digest.

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