

United States District Court  
For the Northern District of California

1  
2  
3  
4  
5  
6  
7  
8  
9  
10  
11  
12  
13  
14  
15  
16  
17  
18  
19  
20  
21  
22  
23  
24  
25  
26  
27  
28

IN THE UNITED STATES DISTRICT COURT  
FOR THE NORTHERN DISTRICT OF CALIFORNIA

MEDTRONIC, INC., et al.,  
Plaintiffs,  
v.  
AGA MEDICAL CORPORATION,  
Defendant.

No. C-07-0567 MMC

**ORDER DENYING DEFENDANT’S  
MOTION FOR SUMMARY JUDGMENT  
OF INVALIDITY; DENYING PLAINTIFFS’  
MOTION FOR SUMMARY JUDGMENT  
RE: PRIOR ART AND ANTICIPATION**

Before the Court are defendant AGA Medical Corporation’s (“AGA”) “Motion (#2) for Summary Judgment of Invalidity under 35 U.S.C. §§ 101 (‘Double Patenting’), 102(a) (‘Prior Use’) and 103 (‘Obviousness’),” filed February 28, 2009, and plaintiffs Medtronic, Inc., Medtronic USA, Inc., and Medtronic Vascular, Inc.’s (collectively, “Medtronic”) “Motion that the Cragg Filter Experiments Are Not Prior Art under 35 U.S.C. § 102 or § 103 and that the Cragg II Paper Is Not Anticipating under § 102,” filed February 27, 2009. With respect to each motion, an opposition and a reply have been filed. Having read and considered the papers filed in support of and in opposition to the motions, the Court rules as follows.

**A. Anticipation**

Under 35 U.S.C. § 102(a), a person shall be entitled to a patent unless “the invention was known or used by others in this country . . . before the invention thereof by the applicant for patent.” See 35 U.S.C. § 102(a). “Anticipation requires that each element of

1 the claim at issue is found, either expressly described or under the principles of inherency,  
2 in a single prior art reference or that the claimed invention was previously known or  
3 embodied in a single prior art device or practice.” See In re Omeprazole Patent Litig., 483  
4 F.3d 1364, 1377 (Fed. Cir. 2007).

5 **1. AGA’s Motion**

6 In its motion, AGA argues that all of the asserted independent claims of the three  
7 patents-in-suit, United States Patens Numbers 5,067,967 (“957 patent”), 5,190,546 (“546  
8 patent”), and 6,306,141 (“141 patent”), are invalid, on the ground that such claims were  
9 practiced by Dr. Andrew Cragg (“Cragg”) and Dr. Kurt Amplatz (“Amplatz”) prior to the  
10 filing, on October 14, 1983, of the application that ultimately resulted in the issuance of the  
11 patents-in-suit. In particular, AGA asserts that Cragg and Amplatz practiced the asserted  
12 claims during experiments undertaken in 1982 and 1983 (“Cragg/Amplatz experiments”),  
13 which experiments were “memorialized” (see Mot. at 2:16) in an article published in  
14 September 1983, specifically, Andrew Cragg et al., A New Percutaneous Vena Cava Filter,  
15 141 Am. J. Roentgenology 601 (Sept. 1983) (“Cragg II”). (See Decl. Steven D. Hemminger  
16 (“Hemminger Decl.”) Ex. 24.) As set forth below, the Court finds AGA has failed to show it  
17 is entitled to summary judgment of invalidity on the ground of anticipation on the basis of  
18 the Cragg/Amplatz experiments.

19 To prevail on its motion, AGA must show the Cragg/Amplatz experiments, as  
20 memorialized in the Cragg II article, employed a shape memory alloy that “displays” stress-  
21 induced martensite. The “display” of stress-induced martensite is a limitation of each of the  
22 asserted claims of the patents-in-suit. (See Order Construing Claims, filed Feb. 6, 2008, at  
23 2:3-10.) In support of its argument that Cragg II describes such an alloy, AGA points to the  
24 following statement therein: “If the position of the filter was not optimal, it could be  
25 withdrawn into the catheter and positioned again.” (See Cragg II at 602.) Thomas W.  
26 Duerig (“Duerig”), AGA’s expert, opines that because such withdrawal occurred at a  
27 temperature above the temperature at which the filter’s transformation from its martensitic  
28 to its austenitic state was complete, if martensite was displayed during such withdrawal, it

1 had to have been induced by stress rather than by a change in temperature. (See Decl.  
2 Dr. Thomas W. Duerig in Supp. AGA’s Opp’n (“Duerig Opp’n Decl.”) ¶ 6.) Additionally,  
3 Kaushik Bhattacharya, another of AGA’s experts, “rules out ordinary elasticity” as a  
4 “deformation mechanism,” for the reason that, in Bhattacharya’s opinion, the filter used by  
5 Cragg and Amplatz suffered strains in the range of 2.3% to 4.4%, as compared with the  
6 ordinary elasticity of austenite generally, which “can accommodate strains of at most 0.5%  
7 to about 1%.” (See Duerig Opp’n Decl. Ex. B (“Expert Report of Prof. Kaushik  
8 Bhattacharya”) ¶¶ 26-27, 30-31.)

9 As Medtronic’s expert, Robert Sinclair (“Sinclair”), notes, however, Cragg II does not  
10 disclose the chemical composition of the alloy used by Cragg and Amplatz, or whether the  
11 filters at issue “fully deployed” or “achieved body temperature” before being retracted. (See  
12 Decl. Dr. Robert Sinclair, PhD (“Sinclair Decl.”) ¶¶ 161.) According to Sinclair “there is  
13 insufficient evidence to determine,” under such circumstances, whether the filters changed  
14 shape due to the presence of stress-induced martensite or were merely “plastically or  
15 elastically deformed.” (See *id.* ¶ 166.)<sup>1</sup> Further, as Medtronic points out, Cragg II never  
16 uses the term “stress-induced martensite” and, instead, is focused exclusively on the use of  
17 an alloy with a “heat-sensitive memory.” (See Cragg II at 601.)

18 A review of the Cragg II reference reveals that the display of stress-induced  
19 martensite is not expressly disclosed therein. AGA, although arguing to the contrary, also  
20 asserts, in essence, that stress-induced martensite was “necessarily present, or inherent,”  
21 in the alloy used in the experiments. See Schering Corp. v. Geneva Pharms., Inc., 339  
22 F.3d 1373, 1377 (Fed. Cir. 2003) (holding “a prior art reference may anticipate without  
23 disclosing a feature of the claimed invention if that missing characteristic is necessarily  
24 present, or inherent, in the single anticipating reference”) (internal citation omitted). The  
25 above-discussed evidence submitted by Medtronic is sufficient, however, to raise a triable  
26

---

27 <sup>1</sup>Although AGA has challenged, under Daubert v. Merrell Dow Pharms., Inc., 509  
28 U.S. 579 (1993), certain of Sinclair’s opinions, that challenge is not made with respect to  
the opinions referenced above.

1 issue with respect to the inherency of stress-induced martensite in the alloy used by Cragg  
2 and Amplatz.<sup>2</sup>

3 Accordingly, to the extent AGA seeks summary judgment of invalidity on the ground  
4 of anticipation, AGA's motion will be denied.

## 5 **2. Medtronic's Motion**

6 In its motion, Medtronic argues that the Cragg/Amplatz experiments do not  
7 constitute either prior art or an invalidating prior use and that the Cragg II article does not  
8 anticipate any of the asserted claims of the patents-in-suit. As set forth below, the Court  
9 finds Medtronic is not entitled to summary judgment with respect to either the  
10 Cragg/Amplatz experiments or the Cragg II article.

11 Medtronic first argues that, even assuming the filters at issue exhibited stress-  
12 induced martensite, the Cragg/Amplatz experiments cannot constitute prior art or an  
13 invalidating prior use because Cragg did not appreciate what he assertedly had discovered.  
14 The Court disagrees. In particular, in the context of prior use under § 102(a), "it is  
15 irrelevant that those using the invention may not have appreciated the results." See W.L.  
16 Gore & Assocs., Inc. v. Garlock, Inc., 721 F.2d 1540, 1548 (Fed. Cir. 1983). As AGA  
17 points out, the cases cited by Medtronic in support of its argument to the contrary are  
18 distinguishable. Most of those cases deal either with prior invention under § 102(g) or an  
19 earlier statute,<sup>3</sup> see Coffin v. Ogden, 85 U.S. 120, 124-25 (1873); Invitrogen Corp. v.  
20 Clontech Labs., 429 F.3d 1052, 1063 (Fed. Cir. 2005); Mycogen Plant Sci., Inc. v.  
21 Monsanto Co., 243 F.3d 1316, 1331 (Fed. Cir. 2001); Int'l Glass Co. v. United States, 408  
22 F.2d 395, 402 (Ct. Cl. 1969), or with prior knowledge, see In re Borst, 345 F.2d 851, 853  
23 (C.C.P.A. 1965); In re Schlitter, 234 F.2d 882, 884 (C.C.P.A. 1956), rather than prior use.

---

24  
25 <sup>2</sup>In light of such finding, the Court does not reach Medtronic's argument that a triable  
26 issue exists as to whether the Cragg/Amplatz experiments were publicly accessible. See  
27 Minn. Min. & Mfg. Co. v. Chemque, Inc., 303 F.3d 1294, 1306 (Fed. Cir. 2002) ("For  
purposes of anticipation, a use must be accessible to the public").

28 <sup>3</sup>AGA "is not asserting an invalidity defense based on prior invention by Dr. Cragg  
and others." (See Def.'s Opp'n at 8:13-15.)

1 Although one case, Eibel Process Co. v. Minn. & Ontario Paper Co., 261 U.S. 45, 66  
2 (1923), discusses what the Federal Circuit has called “‘accidental, unwitting, and  
3 unappreciated’ anticipation,” see Schering Corp., 339 F.3d at 1378, even Eibel, according  
4 to the Federal Circuit, “do[es] not show that inherency requires recognition,” see id.<sup>4</sup>

5 Medtronic next argues that AGA has no evidence Cragg II “enable[s]” any asserted  
6 claim of the patents-in-suit. “In order to be anticipating, a prior art reference must be  
7 enabling so that the claimed subject matter may be made or used by one skilled in the art.”  
8 See Impax Labs., Inc. v. Aventis Pharms. Inc., 468 F.3d 1366, 1381 (Fed. Cir. 2006). “In  
9 order to enable, the prior art reference must teach one of ordinary skill in the art to make or  
10 carry out the claimed invention without undue experimentation.” See Minn. Min. & Mfg.  
11 Co., 303 F.3d at 1306.

12 Here, AGA has presented evidence that Cragg II discloses “the size of nitinol wire  
13 used, the annealing time, temperature and method, the size of the catheter used, the A<sub>f</sub>  
14 temperature, and experimental results” and that, consequently, the article “includes all the  
15 information that is required to enable one of ordinary skill in the art to duplicate what Dr.  
16 Cragg and his team did . . . without undue experimentation.” (See Duerig Opp’n Decl. ¶ 7.)  
17 Medtronic has failed to show anything more is required in order to raise a triable issue as to  
18 enablement. Cf. Amgen, Inc. v. Hoescht Marion Roussel, Inc., 314 F.3d 1313, 1355 & n.22  
19 (Fed. Cir. 2003) (holding “an accused infringer should be . . . entitled to have the district  
20 court presume the enablement of unclaimed (and claimed) material in a prior art patent  
21 defendant asserts against a plaintiff”; noting “by logical extension, our reasoning here might  
22 also apply to prior art printed publications as well”).

23 Medtronic next argues that the Cragg/Amplatz experiments did not employ a shape  
24 memory alloy that displays stress-induced martensite and that the Cragg II article does not

---

25  
26 <sup>4</sup>Medtronic also relies on Medtronic, Inc. v. Daig Corp., 611 F. Supp. 1498 (D. Minn.  
27 1985), in which the court stated: “When a party asserts that a prior use anticipates a patent  
28 claim under § 102(a) or (b), that party must also establish that such a use was of a  
complete invention, i.e., conceived and reduced to practice, and public,” see id. at 1508. In  
support of this statement, however, the district court relied on Coffin and Int’l Glass Co.,  
both of which, as noted, deal with prior invention rather than prior use.

1 disclose such an alloy. As discussed above, however, a triable issue exists as to whether  
2 the experiments, as described in the article, employed an alloy that necessarily displayed  
3 stress-induced martensite.

4 Accordingly, to the extent Medtronic seeks summary judgment on AGA's defense of  
5 invalidity on the basis of anticipation, Medtronic's motion will be denied.

## 6 **B. Obviousness**

7 Under 35 U.S.C. § 103, a patent is invalid "when the differences between the subject  
8 matter sought to be patented and the prior art are such that the subject matter as a whole  
9 would have been obvious at the time the invention was made to a person having ordinary  
10 skill in the art to which said subject matter pertains." See KSR Int'l Co. v. Teleflex Inc., 127  
11 S. Ct. 1727, 1734 (2007) (internal quotation and citation omitted); see also 35 U.S.C.  
12 § 103.

### 13 **1. AGA's Motion**

14 AGA argues that all of the asserted claims of the patents-in-suit that are not  
15 anticipated by the Cragg/Amplatz experiments or the Cragg II article are obvious variants of  
16 asserted claims that are anticipated by such experiments or such article. As discussed  
17 above, however, the Court has found a triable issue exists as to whether any of the  
18 asserted independent claims is anticipated, and, consequently, AGA's argument  
19 necessarily fails.

20 AGA next argues that the asserted claims are rendered obvious by a combination of  
21 three prior art references, specifically, (1) Andrew Cragg, et al., Nonsurgical Placement of  
22 Arterial Endoprostheses: A New Technique Using Nitinol Wire, 147 Radiology 261 (Apr.  
23 1983) ("Cragg I"), (2) Japanese Patent Application No. S56-144326 (Sept. 12, 1981)  
24 ("Miyauchi"), and (3) United States Patent Number 4,490,112 (Sept. 2, 1982) ("Tanaka").  
25 (See Hemminger Decl. Exs. 10, 16, 24.) Although a party seeking to demonstrate  
26 obviousness on the basis of a combination of prior art references need not show that  
27 "some motivation or suggestion to combine the prior art teachings can be found in the prior  
28 art, the nature of the problem, or the knowledge of a person having ordinary skill in the art,"

1 see KSR, 127 S. Ct. at 1734 (internal quotation and citation omitted), such party  
2 nevertheless must show there was “an apparent reason to combine the known elements in  
3 the fashion claimed by the patent at issue,” see id. at 1740-41.

4 Here, AGA argues that “one of ordinary skill in the art would have been motivated to  
5 combine these references to address the problem stated in the application [for the patents-  
6 in-suit], i.e., avoiding the need for controlling the temperature of [a shape memory alloy]  
7 medical device when implanting it in a body.” (See Def.’s Mot. at 12:25-27); see also KSR,  
8 127 S. Ct. at 1742 (“[A]ny need or problem known in the field of endeavor at the time of  
9 invention and addressed by the patent can provide a reason for combining elements in the  
10 manner claimed.”). As Medtronic points out, however, AGA has failed to present any  
11 evidence in support of this assertion, nor has AGA presented any evidence suggesting the  
12 above-referenced “problem” was “known” in the field at the time of the application for the  
13 patents-in-suit. Consequently, AGA has failed to demonstrate a reason to combine the  
14 references at issue existed.<sup>5</sup>

15 Accordingly, to the extent AGA seeks summary judgment of invalidity on the basis of  
16 obviousness, AGA’s motion will be denied.

## 17 **2. Medtronic’s Motion**

18 Medtronic argues that the Cragg/Amplatz experiments cannot render the asserted  
19 claims of the patents-in-suit obvious, on the ground that the experiments do not qualify as  
20 prior art under § 102. As discussed above, however, the Court has found a triable issue  
21 exists as to whether the experiments constitute prior art, and, consequently, Medtronic’s  
22 argument necessarily fails.

23 Accordingly, to the extent Medtronic seeks summary judgment on AGA’s defense of  
24 invalidity on the basis of obviousness, Medtronic’s motion will be denied.

---

25  
26 <sup>5</sup>In light of such finding, the Court does not reach Medtronic’s argument (a) that  
27 there is a triable issue as to the ordinary level of skill in the art in 1983, (b) that there is a  
28 triable issue as to whether the combination of the three references discloses every  
limitation of any asserted claim of the patents-in-suit, and (c) that objective indicia of  
nonobviousness preclude summary judgment in favor of AGA.

1 **C. Obviousness Type Double Patenting**

2 Obviousness type double patenting (“OTDP”) is “a judicially created doctrine  
3 grounded in public policy,” the purpose of which “is to prevent the extension of the term of a  
4 patent, even where an express statutory basis for [ ] rejection is missing, by prohibiting the  
5 issuance of the claims in a second patent not patentably distinct from the claims of the first  
6 patent.” See In re Longi, 759 F.2d 887, 892 (Fed. Cir. 1985).<sup>6</sup> The doctrine “preclude[s] a  
7 second patent on an invention which would have been obvious from the subject matter of  
8 the claims in the first patent, in light of the prior art.” See Ortho Pharm. Corp. v. Smith, 959  
9 F.2d 936, 940 (Fed. Cir. 1992) (internal quotation and citation omitted).

10 The “common-place situation” where a “broader claim ‘embraces’ or ‘encompasses’  
11 the subject matter defined by [a] narrower claim,” however, “is not, per se, double  
12 patenting.” See In re Kaplan, 789 F.2d 1574, 1577-78 (Fed. Cir. 1986). Instead, to  
13 establish an OTDP defense, “there must be some clear evidence to establish why the  
14 variation [between the two claims] would have been obvious which can properly qualify as  
15 ‘prior art.’” See id. at 1580.

16 Here, AGA argues that the asserted claims of the ‘141 patent are invalid on the  
17 basis of OTDP in light of United States Patent Number 5,597,378 (“‘378 patent”).<sup>7</sup> In  
18 particular, AGA argues that any differences between the asserted claims of the ‘141 patent  
19 and certain claims of the ‘378 patent are “not [ ] patentable difference[s].” (See, e.g., Def.’s  
20 Mot. at 18:1.) As to some of these differences, AGA has presented evidence of prior art  
21 that, AGA asserts, renders the difference not patentable. For example, although claim 11  
22 of the ‘141 patent uses the term “stent,” whereas claim 9 of the ‘378 patent uses the term  
23 “memory allow element” (see ‘141 patent col. 11, l. 66; ‘378 patent col. 11, l. 14), AGA has

---

24  
25 <sup>6</sup>Although, as Medtronic points out, AGA’s obviousness type double patenting  
26 defense was not pled at the time AGA filed its motion for summary judgment of invalidity,  
27 the Court, on April 21, 2009, afforded AGA leave to amend its Answer and Counterclaims  
to assert such defense.

28 <sup>7</sup>In light of the very recent amendment to add an OTDP defense, Medtronic has not  
moved for summary judgment thereon.

1 pointed to prior art that discloses the use a “stent” made from an alloy with “shape-memory  
2 properties” (see Hemminger Decl. Ex. 24 (Charles T. Dotter, et al., Transluminal  
3 Expandable Nitinol Coil Stent Grafting: Preliminary Report, 147 Radiology 259 (Apr. 1983)  
4 (“Dotter”))). Similarly, although claim 1 of the ‘141 patent requires a “guide wire,” whereas  
5 claim 34 of the ‘378 patent does not (see ‘141 patent col. 11, l. 5; ‘378 patent col. 14, ll. 39-  
6 69), AGA has pointed to prior art that discloses the use of a “guiding wire” to place an  
7 “endovascular prosthesis” in the body of a mammal (see Cragg I at 261).

8 Each of the three asserted independent claims of the ‘141 patent, i.e., claims 1, 11,  
9 and 18, however, contains at least one term that is narrower than the corresponding term in  
10 the ‘378 patent and that AGA has failed to address other than by the conclusory statement  
11 of its expert that the difference between such terms is a “design choice” or a “distinction  
12 without a difference.”<sup>8</sup> (See Decl. Dr. Thomas W. Duerig in Supp. AGA’s Mot. (“Duerig  
13 Decl.”) ¶ 52 (stating “[t]he specific shapes of ‘relatively straightened’ and ‘relatively coiled’  
14 in claim 11 of the ‘141 patent are design choices of the more generic ‘shape’ claimed in the  
15 ‘378 patent”); id. ¶ 57 (stating “[t]he terms ‘easily inserted shape’ and ‘deformed shape’  
16 [used in claim 18 of the ‘141 patent] merely describe the shape of the memory alloy in the  
17 stressed shape and are design choices of the more generic ‘shape’ claimed in the ‘378  
18 patent”); id. ¶ 61 (stating “[t]he language ‘hollow tubular restraining member’ of claim 34 of  
19 the ‘378 patent versus the language ‘hollow placement device’ of claim 1 of the ‘141 patent  
20 is a distinction without a difference when considered in light of the entire claim [of] the  
21 function of those elements”).) Such statements are insufficient to carry AGA’s burden on  
22 summary judgment with respect to the issue of OTDP. See Kaplan, 789 F.2d at 1580; see

---

23  
24 <sup>8</sup>The Court finds unpersuasive AGA’s argument that Medtronic is estopped from  
25 asserting there are any patentable differences between the ‘141 patent and the ‘378 patent,  
26 on the ground that Medtronic, according to AGA, represented to the United States Patent  
27 and Trademark Office (“PTO”) that the only “invention” in either patent was the “use of the  
28 stress-induced martensite [ ] properties of the shape memory alloy at body temperature.”  
(See Def.’s Mot. at 14:19-23.) In particular, AGA has failed to present any evidence  
suggesting Medtronic’s “assertions in favor of patentability” before the PTO “evinced a  
clear and unmistakable surrender of subject matter” other than the use of stress-induced  
martensite at body temperature. See Pharmacia & Upjohn Co. v. Mylan Pharms., Inc., 170  
F.3d 1373, 1377 (Fed. Cir. 1999).

1 also Pfizer, Inc. v. Apotex, Inc., 480 F.3d 1348, 1359 (Fed. Cir. 2007) (holding “the patent  
2 challenger bears the burden of proving the factual elements of invalidity by clear and  
3 convincing evidence”; noting “[t]hat burden of proof never shifts to the patentee to prove  
4 validity”).<sup>9</sup>

5 Accordingly, to the extent AGA seeks summary judgment of invalidity of the ‘141  
6 patent on the basis of obviousness type double patenting, AGA’s motion will be denied.

7 **CONCLUSION**

8 For the reasons stated above, each party’s motion is hereby DENIED.

9 **IT IS SO ORDERED.**

10  
11 Dated: April 28, 2009

  
MAXINE M. CHESNEY  
United States District Judge

12  
13  
14  
15  
16  
17  
18  
19  
20  
21  
22  
23  
24  
25  
26  
27 \_\_\_\_\_  
28 <sup>9</sup>In light of the above, the Court does not reach Medtronic’s argument that AGA’s  
OTDP defense is precluded by “the ‘safe harbor’ provision” (see Pls.’ Opp’n at 17:7-8) of 35  
U.S.C. § 121.