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

CONCEPTUS, INC.,  
Plaintiff,

No. C 09-02280 WHA

v.

HOLOGIC, INC.,  
Defendant.

**ORDER GRANTING  
PARTIAL SUMMARY  
JUDGMENT AND DENYING  
MOTIONS TO STRIKE AND  
LIMIT TRIAL TESTIMONY**

**INTRODUCTION**

In this patent infringement action involving intrafallopian contraceptive devices, the parties each move for summary judgment. Plaintiff Conceptus, Inc. requests summary adjudication of the following:

1. That defendant Hologic, Inc. has contributed to the direct infringement of method claims 37 and 38 of U.S. Patent No. 6,634,361 through the sale of its Adiana Permanent Contraception System since July 6, 2009;
2. That Conceptus’s Essure procedure practices method claims 37 and 38 of the ’361 patent;
3. That there were no acceptable and available non-infringing alternatives to the claimed inventions during the relevant damages period; and
4. That for the purposes of a reasonable royalty assessment, the hypothetical negotiation would have occurred in mid-2009.

1 Defendant Hologic, on the other hand, requests summary adjudication that claims  
2 8, 37, and 38 of the '361 patent are not infringed and are invalid. Additionally,  
3 each party moves to strike a portion of its opponent's submissions and to limit  
4 trial testimony.

5 For the reasons stated below, both motions are **GRANTED IN PART** and **DENIED IN PART**.  
6 The motions to strike are **DENIED AS MOOT**. The motions to limit trial testimony are  
7 **DENIED WITHOUT PREJUDICE**. This order follows full briefing and a hearing on the motions.

8 **STATEMENT**

9 Plaintiff Conceptus sells a transcervically introduced permanent contraceptive product  
10 called Essure. It received FDA approval in 2002 and is Conceptus's only marketed product at  
11 present. Unlike tubal ligation, the Essure system allegedly requires no incisions and is  
12 minimally invasive. According to Conceptus, Essure can be placed within a woman's fallopian  
13 tubes by way of the cervix in a ten-minute, non-surgical procedure that can be performed in a  
14 doctor's office without general anesthesia. Essure's contraceptive efficacy is supposedly  
15 achieved through occlusion (*i.e.*, blocking) of the fallopian tube.

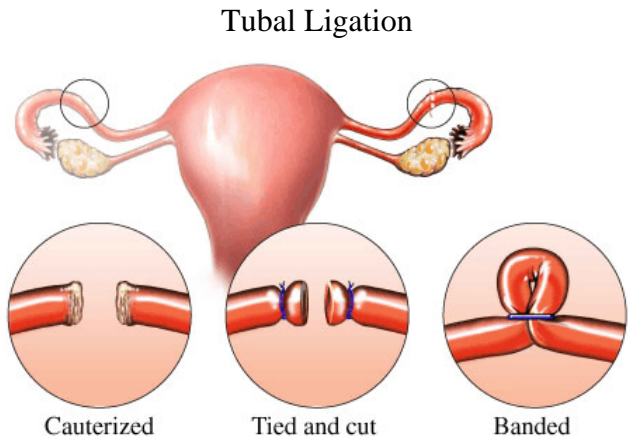
16 Defendant Hologic owns and markets the accused Adiana contraceptive system. The  
17 Adiana system, like the Essure system, supposedly involves the minimally invasive transcervical  
18 placement of a contraceptive device (referred to by Hologic as a "matrix") into a woman's  
19 fallopian tubes. Combined with the use of radiofrequency energy, the Adiana matrix — much  
20 like the Essure system — is intended to produce intrafallopian occlusion, which either prevents  
21 conception from occurring or blocks the passage of a fertilized ovum to the uterus. Adiana  
22 received FDA approval in July 2009.

23 Targeting the fallopian tubes is a well-known approach to permanent contraception.  
24 Under the basics of reproductive biology, sperm enter the fallopian tubes by way of the uterus.  
25 Ova, on the other hand, travel in the opposite direction *toward* the uterus from the ovaries.  
26 Thus, blocking the fallopian tubes is a sensible way to prevent sperm from meeting and  
27 fertilizing an ovum.

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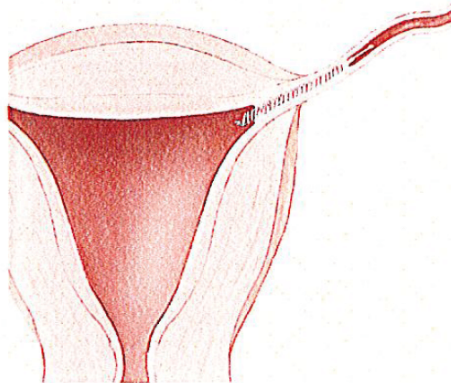
Tubal ligation, a longstanding but highly invasive procedure for permanent female sterilization, works similarly to the invention in the asserted patent; it physically prevents the meeting of sperm and ova. Tubal ligation can be performed in a variety of ways, including by clipping the fallopian tubes, cutting and tying the fallopian tubes, banding the fallopian tubes, or cauterizing the fallopian tubes. An illustration of some of these techniques for tubal ligation is shown below (Compl. ¶ 7):



Unlike tubal ligation, the asserted patent covers an intrafallopian contraceptive system in which a contraceptive device is placed within the reproductive system via the cervix using specially adapted tools. No cutting, banding, or cauterizing is supposedly necessary. Rather than blocking the fallopian tubes using external mechanical methods (as done in tubal ligation),

1 the devices in the asserted patent serve their intended purposes by blocking the fallopian tubes  
2 *from within*. The illustration below illustrates the concept of intrafallopian contraception  
3 (Compl. ¶ 12):

4 Intrafallopian Contraception



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12 Conceptus asserted five patents in its initial complaint, which was filed in May 2009 (Dkt.  
13 No. 1). Of these five patents, a single claim — claim 94 of U.S. Patent No. 7,428,904 — formed  
14 the basis for an unsuccessful preliminary injunction motion (Dkt. Nos. 91, 131). Before the claim  
15 construction hearing, the parties stipulated to eliminating three of the five asserted patents  
16 (including the '904 patent) from the dispute, which left only two patents and five claims (Dkt.  
17 No. 140). After the claim construction order issued, the parties stipulated to eliminating  
18 additional patent claims from the dispute. The only asserted patent claims that now remain in this  
19 action are claims 8, 37, and 38 of the '361 patent (Dkt. No. 219). Additionally, claims and  
20 counterclaims regarding unfair competition have been raised and dropped by the parties (Dkt.  
21 No. 241). The Court thanks counsel for streamlining the case.

22 The '361 patent, entitled “Contraceptive Transcervical Fallopian Tube Occlusion Devices  
23 And Methods,” was issued on October 21, 2003. Conceptus is the assignee of the '361 patent.  
24 Of the three claims from this patent that are asserted in this litigation, one (claim 8) is an  
25 independent claim, and two (claims 37 and 38) are dependent claims that depend from an  
26 independent claim (claim 36) that is not asserted here. Five of the six disputed terms and  
27 phrases that were construed in the claim construction order came from these three patent claims.  
28 The construed terms and phrases are italicized in the claims below.

1 Claim 8 covers a contraceptive device:

2 8. A tissue ingrowth contraceptive device for use in a  
3 fallopian tube, the contraceptive device comprising:

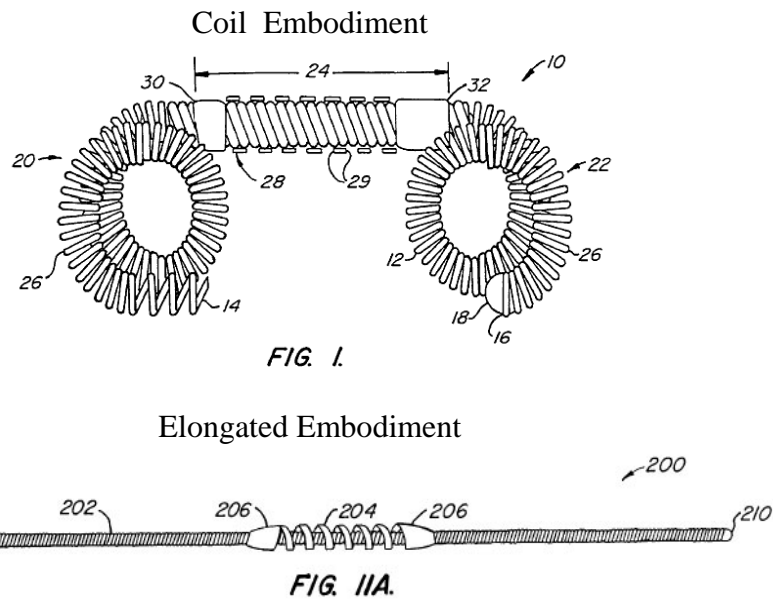
4 *a resilient elongate body* having a proximal end and a distal end and  
5 defining an axis therebetween;

6 a retention structure disposed along the resilient body, the retention  
7 structure adapted to restrain the resilient body within the fallopian tube;

8 *a bond affixing the retention structure to the resilient body*;

9 wherein at least one of the resilient body, the retention structure, and the  
10 bond comprises a microporous material which promotes tissue ingrowth  
11 therein.

12 (col. 20:21–33). To provide a visual reference, two embodiments of the invention (a coil  
13 embodiment and an elongated embodiment) are depicted below:



29 Claims 37 and 38 (as well as independent claim 36, which they reference) cover a  
30 contraceptive method:

31 36. An intrafallopian contraceptive method comprising:

32 transcervically introducing a *pre-formed resilient structure* into a target  
33 region of a fallopian tube;

34 imposing an anchoring force against a tubal wall of the fallopian tube by  
35 resiliently engaging in inner surface of the tubal wall with the resilient  
36 structure; and

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*permanently affixing the resilient structure within the fallopian tube with a lumen-traversing region of the resilient structure so that at least a portion of the fallopian tube is open.*

37. A method as claimed in claim 36, wherein the affixing step comprises promoting tissue ingrowth of the tubal wall surrounding the resilient structure.

38. A method as claimed in claim 37, wherein the tissue ingrowth occludes the fallopian tube to inhibit contraception.

(col. 23:38–53).

The Court construed these disputed terms and phrases to have the following meanings:

DISPUTED TERM OR PHRASE	CONSTRUED MEANING
<i>Claim 8: “a resilient elongate body”</i>	<i>Claim 8: “a resilient elongate intrafallopian device”</i>
<i>Claims 37 and 38: “pre-formed resilient structure”</i>	<i>Claims 37 and 38: “pre-formed resilient intrafallopian device”</i>
<i>Claim 8: “a bond affixing the retention structure to the resilient body”</i>	<i>Claim 8: “a bond affixing the retention structure to the resilient body, where without the bond, the retention structure and resilient body would be unaffixed components”</i>
<i>Claims 37 and 38: “permanently affixing the resilient structure within the fallopian tube”</i>	<i>Claims 37 and 38: “permanently affixing the resilient structure within the fallopian tube” (plain and ordinary meaning)</i>
<i>Claims 37 and 38: “lumen-traversing region of the resilient structure”</i>	<i>Claims 37 and 38: “region of the resilient structure that interacts with the wall of the fallopian tube lumen to permanently affix the resilient structure within the fallopian tube lumen”</i>
<i>Claims 37 and 38: “so that at least a portion of the fallopian tube is open”</i>	<i>Claims 37 and 38: “so that at least a portion of the fallopian tube is not completely occluded”</i>

(Dkt. No. 189). With this background in place, this order now turns to the instant summary judgment motions.

**ANALYSIS**

“One of the principal purposes of the summary judgment rule is to isolate and dispose of factually unsupported claims or defenses.” *Celotex Corp. v. Catrett*, 477 U.S. 317, 323–24

1 (1986). Summary judgment is proper when “there is no genuine dispute as to any material fact  
2 and the movant is entitled to judgment as a matter of law.” Fed. R. Civ. P. 56(a). A dispute  
3 is “genuine” only if there is sufficient evidence for a reasonable fact finder to find for the  
4 non-moving party, and “material” only if the fact may affect the outcome of the case.  
5 *Anderson v. Liberty Lobby, Inc.*, 477 U.S. 242, 248–49 (1986). In this analysis, all reasonable  
6 inferences must be drawn in the light most favorable to the non-moving party. *Johnson v. Racnho*  
7 *Santiago Cmty. Coll. Dist.*, 623 F.3d 1011, 1018 (9th Cir. 2010). Unsupported conjecture or  
8 conclusory statements, however, cannot defeat summary judgment. *Surrell v. Cal. Water Serv.*  
9 *Co.*, 518 F.3d 1097, 1103 (9th Cir. 2008).

10 “Summary judgment is as appropriate in a patent case as in any other.” *Barmag Barmer*  
11 *Maschinenfabrik AG v. Murata Machinery, Ltd.*, 731 F.2d 831, 835 (Fed. Cir. 1984).

12 Although the determination of patent infringement usually is a fact-intensive issue, “comparison  
13 of a properly interpreted claim with a stipulated or uncontested description of an accused device  
14 or process would reflect such an absence of material fact issue as to warrant summary judgment  
15 of infringement or noninfringement.” *D.M.I., Inc. v. Deere & Co.*, 755 F.2d 1570, 1573  
16 (Fed. Cir. 1985).

17 **1. Requirements of Claim 36.**

18 Before proceeding to the summary judgment motions, a matter of claim interpretation  
19 that arose in the summary judgment briefs must be addressed. Courts must determine the  
20 meaning of disputed claim terms from the perspective of one of ordinary skill in the pertinent art  
21 at the time the patent was filed. *Chamberlain Group, Inc. v. Lear Corp.*, 516 F.3d 1331, 1335  
22 (Fed. Cir. 2008). While claim terms “are generally given their ordinary and customary meaning,”  
23 the “claims themselves provide substantial guidance as to the meaning of particular claim terms.”  
24 *Phillips v. AWH Corp.*, 415 F.3d 1303, 1312, 1314 (Fed. Cir. 2005) (en banc) (quoting *Vitronics*  
25 *Corp. v. Conceptronic, Inc.*, 90 F.3d 1576, 1582 (Fed. Cir. 1996)). As such, other claims of the  
26 patent can be “valuable sources of enlightenment as to the meaning of a claim term.” *Phillips*,  
27 415 F.3d at 1314. Additionally, a patent’s specification “is always highly relevant to the claim  
28 construction analysis.” *Id.* at 1315 (quoting *Vitronics*, 90 F.3d at 1582). Indeed, claims “must

1 be read in view of the specification, of which they are a part.” *Markman v. Westview Instruments,*  
2 *Inc.*, 52 F.3d 967, 979 (Fed. Cir. 1995) (en banc), *aff’d*, 517 U.S. 370 (1996). Finally, courts also  
3 should consider the patent’s prosecution history, which “can often inform the meaning of the  
4 claim language by demonstrating how the inventor understood the invention and whether the  
5 inventor limited the invention in the course of prosecution, making the claim scope narrower than  
6 it would otherwise be.” *Phillips*, 415 F.3d at 1317 (citations omitted). These components of the  
7 intrinsic record are the primary resources in properly construing claim terms. *Id.* at 1312–18.<sup>1</sup>

8 *First*, much of the briefing and hearing concerned Hologic’s position that independent  
9 method claim 36 of the ’361 patent (from which asserted method claims 37 and 38 depend)  
10 requires permanent affixation of the resilient structure within the fallopian tube *while* at least a  
11 portion of the fallopian tube is open. During the hearing, however, Conceptus explicitly and  
12 repeatedly conceded that claim 36 does in fact require permanent affixation while the fallopian  
13 tube remains at least partially open (Dkt. No. 355 at 8:18–19). Given the plain language of the  
14 claim and its prosecution history, the Court is convinced that claim 36 does require permanent  
15 affixation while the tube is at least partially open, but since Conceptus no longer is arguing the  
16 contrary, this order need not further address the issue.

17 *Second*, much of the briefing and hearing also concerned Hologic’s position that claim 36  
18 requires contraception to occur *while* at least a portion of the fallopian tube is open. In fact, the  
19 first point Hologic briefed in support of its noninfringement argument is “the Adiana device does  
20 not provide for contraception while ‘at least a portion of the fallopian tube is open,’” and  
21 Conceptus countered that “claim 36 does not require contraception prior to occlusion” (Hologic  
22 Br. 10; Conceptus Opp. 1). At the hearing, Hologic clarified its position. Hologic conceded that  
23 claim 36 does not require a contraceptive effect *immediately* upon permanent affixation of the  
24 resilient structure (disavowing that position as a straw man set up by Conceptus) but maintained  
25 that claim 36 does require the fallopian tube to be at least partially open when contraception takes  
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27 <sup>1</sup> As with the constructions set forth in the claim construction order in this action (Dkt. No. 189), the  
28 Court reserves the authority to modify the interpretations set forth herein if further evidence warrants such a  
modification. Again, however, the parties should be aware that they are not invited to ask for reconsideration  
outside the applicable rules of procedure.



1 effect (Dkt. No. 355 at 18:7–20:1; 26:6–8; 31:3–19). This order therefore turns to the question of  
2 whether claim 36 of the ’361 patent requires a contraceptive effect to be provided while at least a  
3 portion of the fallopian tube is open.

4 **A. Plain Language**

5 As an initial matter, the plain language of the claim compels this interpretation. Claim 36  
6 claims “[a]n intrafallopian contraceptive method,” the last step of which is “permanently affixing  
7 the resilient structure within the fallopian tube with a lumen-traversing region of the resilient  
8 structure so that at least a portion of the fallopian tube is open” (col. 23:38–47). The last step  
9 of the method is the only place in the claim that the limitation “so that at least a portion of the  
10 fallopian tube is open” appears. Grammatically, this description modifies the act of permanently  
11 affixing the resilient structure — meaning that permanent affixation must happen *while* the tube  
12 is open — but there is no indication that it applies to the other method steps, or indeed to the  
13 preamble of the claim.

14 Hologic uses the word “while” to join phrases from the preamble (“contraceptive  
15 method”) and final method step (“at least a portion of the fallopian tube is open”) without  
16 providing any reason why doing so might be appropriate (Hologic Reply Br. 3). Conceptus does  
17 not dispute that the preamble of claim 36 (“[a]n intrafallopian contraceptive method  
18 comprising:”) is a limitation of the claim (Hologic Opp. 3). On the contrary, Conceptus addresses  
19 the preamble as a distinct element of the claim in its infringement contentions (*e.g.*, Dkt. No. 277-  
20 1, Scott Corrected Exh. J at 3). Thus, this order finds that the method claimed in claim 36 must,  
21 of course, provide contraceptive effect at some point, but it need no do so while the fallopian tube  
22 is still open.

23 **B. Patent Claims and Specification**

24 The context of the other claims and specification of the ’361 patent supports this reading  
25 of claim 36 as well. The four dependent claims that depend from claim 36 add limitations  
26 relating, for example, to “promoting tissue ingrowth” (claim 37) that “occludes the fallopian tube  
27 to inhibit conception” (claim 38). This specific means of inhibiting contraception provides an  
28 example of how an embodiment of claim 36 might provide contraception only after long-term

1 tissue growth has closed the fallopian tube. Hologic argues that this analysis improperly imports  
2 the limitations of dependent claims into the independent claim from which they depend (Hologic  
3 Reply Br. 3). Not so. The logic of this analysis is not that claim 36 *requires* tissue ingrowth that  
4 occludes the fallopian tube to inhibit contraception, but rather that one possible embodiment of  
5 the invention claimed in claim 36 involves tissue ingrowth that occludes the fallopian tube to  
6 inhibit contraception.

7           Moreover, the specification of the '361 patent does not limit the claimed invention to  
8 only those devices and methods that provide contraception while the fallopian tube remains open.  
9 For example, it states: “The intrafallopian contraceptive methods and devices of the present  
10 invention can provide highly effective contraception even when the contraceptive device does not  
11 totally occlude the lumen of the fallopian tube.” (col. 11:19–22). This characterization recognizes  
12 that embodiments of the invention *may* provide contraception while the fallopian tube remains  
13 open, but it does not dictate that they *must* do so. Other passages throughout the specification  
14 take this same approach, singling out embodiments that provide contraception while the fallopian  
15 tube is open as the exception rather than the rule (*see* col. 4:30–34 (“In many embodiments, the  
16 presence of the contraceptive device in combination with the tissue reaction can provide effective  
17 contraception without having to rely on total occlusion of the fallopian tube.”); col. 5:11–14  
18 (“Such tubular devices will often effect contraception by disrupting the architecture and/or  
19 transport mechanisms of the tubal tissues, rather than relying entirely on total blockage of the  
20 tube.”)). This specification language implies that at least some embodiments of the invention  
21 do rely entirely on total occlusion of the fallopian tube for contraception.

### 22           **C. Prosecution History**

23           Amendments to claim 36 made during prosecution also support this construction.  
24 Originally, the claim did not include the limitation “so that least a portion of the fallopian tube is  
25 open.” Rather, this limitation was added in an amendment made after the claim was rejected as  
26 anticipated (Dkt. No. 275-9, Scott Exh. I at CON00028921). The applicant argued that the  
27 supposedly anticipating reference did not predate the effective priority date for this claim, but the  
28 amendment nonetheless was made (*ibid.* at CON00028916). By adding this limitation to the final

1 step of claim 36 — and *only* to the final step of the claim — the applicant narrowed the claim to  
2 encompass only contraceptive methods in which “at least a portion of the fallopian tube is open”  
3 *when* the final method step of “permanently affixing the resilient structure” is performed.

4 \* \* \*

5 Having considered the plain language of independent claim 36, the context of its  
6 dependent claims and the ’361 patent specification, the prosecution history, and Hologic’s  
7 counterarguments, this order finds that claim 36 does not require provision of any contraception  
8 *while* the fallopian tube is open — so long, of course, as contraception is the eventual result of  
9 the procedure.

10 **2. Infringement or Noninfringement of Claims 8, 37, and 38 of the ’361 Patent.**

11 The parties’ motions regarding infringement and noninfringement will be analyzed  
12 concurrently, on a claim-by-claim basis.

13 **A. Method Claims 37 and 38**

14 Conceptus moves for summary adjudication that “Hologic contributes to the direct  
15 infringement of claims 37 and 38 of the ’361 patent” (Conceptus Br. 25). Hologic moves for  
16 summary adjudication that claims 37 and 38 of the ’361 patent are not infringed (Hologic Br. 25).  
17 Both motions are **DENIED**.

18 “[W]hen simultaneous cross-motions for summary judgment on the same claim are before  
19 the court, the court must consider the appropriate evidentiary material identified and submitted in  
20 support of both motions, and in opposition to both motions, before ruling on each of them.”

21 *Fair Housing Council of Riverside County, Inc. v. Riverside Two*, 249 F.3d 1132, 1134 (9th Cir.  
22 2001). Having considered all of the briefs and supporting materials submitted by Conceptus and  
23 Hologic in relation to the cross-motions for summary judgment and the motions to strike, this  
24 order will address the summary judgment motions in turn.

25 **(1) Direct Infringement**

26 Conceptus moves for summary judgment of infringement. Granting this motion would  
27 require finding that no reasonable juror, when drawing all reasonable inferences in favor of  
28 Hologic, could return a verdict of no infringement. That finding is not warranted on this record.

1 For its part, Hologic moves for summary judgment of noninfringement. Granting this motion  
2 would require finding that no reasonable juror, when drawing all reasonable inferences in favor of  
3 Conceptus, could return a verdict of infringement. Again, such a finding is not warranted.

4 The crux of the argument is on the facts, and the question of whether the Adiana  
5 procedure satisfies the requirements of the asserted method claims is a fact issue for the jury to  
6 decide. Specifically, the question of when the Adiana matrix becomes “permanently affixed” is  
7 one on which reasonable jurors could disagree. By way of simple analogy, if one were to  
8 permanently affix two foot-long steel bars to each other by welding them together lengthwise,  
9 reasonable jurors could disagree as to how much of the foot-long weld joint must be completed  
10 before the bars are permanently affixed. So too here; reasonable jurors could disagree as to how  
11 much (if any) tissue ingrowth must take place before the Adiana matrix is permanently affixed  
12 within the fallopian tube. Because the parties disagree as to this question of medical fact, both  
13 summary judgment motions fail, and the question of direct infringement of method claims 37 and  
14 38 will go to the jury.

15 (2) **Indirect (Induced and Contributory) Infringement**

16 A finding of direct infringement is a prerequisite to a finding of indirect infringement.  
17 *Epcon Gas Sys., Inc. v. Bauer Compressors, Inc.*, 279 F.3d 1022, 1033 (Fed. Cir. 2002).  
18 Since summary judgment regarding direct infringement is not appropriate on the current record,  
19 summary judgment regarding indirect infringement is not appropriate either.

20 **B. Device Claim 8**

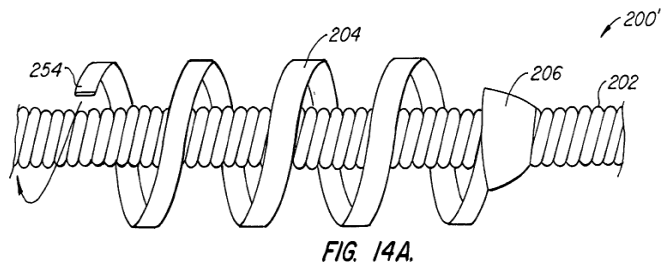
21 Hologic moves for summary adjudication that device claim 8 is “not infringed” (Hologic  
22 Br. 25). A patent claim may be infringed literally — *i.e.*, by practicing every limitation of the  
23 claim — or under the doctrine of equivalents, which “allows the patentee to claim those  
24 insubstantial alterations that were not captured in drafting the original patent claim but which  
25 could be created through trivial changes.” *Honeywell Int’l Inc. v. Hamilton Sndstrand Corp.*,  
26 370 F.3d 1131, 1139 (Fed. Cir. 2004). Hologic’s motion is **GRANTED**.

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(1) **Literal Infringement**

As explained in the claim construction order, claim 8 separately lists three distinct components of the invention: “a resilient elongate body,” “a retention structure,” and “a bond affixing the retention structure to the resilient body” (col. 20:21–33). To provide a visual example, FIG. 14A from the ’361 patent is reproduced below. This figure shows a “bond” (206) affixing “a retention structure” (204) to a “resilient body” (202) in a particular embodiment of the ’361 patent’s invention:

Embodiment from FIG. 14A of the ’361 Patent



Given this language, the claim construction order found that the patentee would not have called out “a bond affixing the retention structure to the resilient body” if the resilient elongate body and retention structure were already one and the same. The order therefore construed “a bond affixing the retention structure to the resilient body” as meaning “a bond affixing the retention structure to the resilient body, where without the bond, the retention structure and resilient body would be unaffixed components.” This construction responded in part to Hologic’s concern that the term “bond” could be stretched to encompass bonds on a molecular level, and that using such a construction, a unitary device having no disparate parts that have ever been joined together could still be argued to the jury as meeting the “bond” limitation (Dkt. No. 189 at 11–12).

Based on the evidence that has come forth, no reasonable trier of fact could now find that the Adiana matrix includes all three distinct components of claim 8. *Hologic has presented sworn testimony that the Adiana matrix is a single unitary device made of the same material throughout, and Conceptus has not challenged this evidence.* Hologic’s evidence shows that the Adiana

1 matrix is formed through an injection molding process that involves a single injection of a liquid  
2 silicone rubber material into a mold that creates a unitary structure (Martin Decl. ¶¶ 7–12).  
3 The shape of this molded structure is defined by a “solid core through the center” and a “porous  
4 architecture which surrounds the center core” (Williams Exh. 7 at HOL-CON 0004788).  
5 Because the Aadiana matrix is, according to Hologic’s evidence, a single unitary device, it cannot  
6 literally infringe a claim that requires three separate components, one of which bonds the other  
7 two together.

8         Despite its best efforts, Conceptus has not identified any admissible evidence that would  
9 permit a reasonable trier of fact to read the limitations of claim 8 onto the Aadiana matrix.  
10 *First*, Conceptus attempts to map the claim limitations onto the Aadiana matrix by identifying the  
11 matrix’s “solid core” as the resilient elongate body, its “microporous architecture” as the retention  
12 structure, and “bonds between them” as the required bond (Conceptus Opp. 5). There are at least  
13 two problems with this attempt. One is that “microporous architecture” is a style description, not  
14 a component. Just as a Gothic cathedral *is* Gothic, the Aadiana matrix *is* microporous. A specified  
15 architectural style is a modifier of the structure to which it is applied, not a separate structure.  
16 The other problem is that any “bonds” between the inner (solid) and outer (microporous) regions  
17 of the Aadiana matrix would be akin to the nominal molecular bonds that the claim term “bond”  
18 was construed to avoid. Calling out “bonds between them” as the bond element is a vague,  
19 conclusory statement — not evidence. These two problems cripple Conceptus’s further  
20 arguments on the subject.

21         *Second*, Conceptus cites evidence that when the Aadiana matrix is formed in the mold, the  
22 microporous portion solidifies first, followed later by the solid core, and that as the matrix  
23 solidifies, “bonds form between the microporous architecture and the matrix core” (Conceptus  
24 Opp. 6). Even if a trier of fact interpreted this sequential solidification to create two separate  
25 components, however, there still is no evidence to support a finding that the “bonds” between  
26 them are a separate, third component as required by the claim. *Third*, Conceptus emphasizes  
27 what the claim limitations and claim constructions do not require — such as that the components  
28 be separately manufactured or made from different materials (Conceptus Opp. 5–6). But the

1 point is rather what the claim limitations and claim construction *do* require — three separate  
2 components. Conceptus’s exclusionary analysis does not cite any evidence that would enable a  
3 reasonable trier of fact to identify the three components required by the elements of claim 8 and a  
4 bond of the nature required by the claim construction. Accordingly, summary judgment of no  
5 literal infringement of claim 8 is appropriate.

6 **(2) Doctrine of Equivalents**

7 “[I]f two devices do the same work in substantially the same way, and accomplish  
8 substantially the same result, they are the same, even though they differ in name, form, or shape.”  
9 *Graver Tank & Mfg. Co. v. Linde Air Prods. Co.*, 339 U.S. 605, 608 (1950). To determine the  
10 question of infringement under the doctrine of equivalents, “[t]he trier of fact, applying the claims  
11 as construed, finds whether the accused device, element by element, is equivalent to that which  
12 has been patented.” *Multiform Desiccants, Inc. v. Medzam, Ltd.*, 133 F.3d 1473, 1480 (Fed. Cir.  
13 1998). “An equivalent must be found for every limitation of the claim somewhere in an accused  
14 device, but not necessarily in a corresponding component, although that is generally the case.”  
15 *Corning Glass Works v. Sumitomo Electric U.S.A., Inc.*, 868 F.2d 1251, 1259 (Fed. Cir. 1989).

16 No reasonable trier of fact could identify an equivalent to the “bond” element of claim 8  
17 anywhere in the Adiana product. The “bonds” Conceptus identifies between the inner and outer  
18 portions of the Adiana matrix are simply molecular bonds of the sort the claim construction order  
19 sought to exclude by identifying the bond as a third distinct component of the invention (Dkt.  
20 No. 189 at 12). Conceptus attempts to avoid this problem through deposition testimony  
21 characterizing these “bonds” as “a sufficient aggregation of chemical bonds that it rises to the  
22 level of a physical bond,” but this testimony is unavailing (Williams Exh. 5 at 270:24–271:4).  
23 Once the Adiana matrix is divided into its solid inner core (the supposed equivalent to “a resilient  
24 elongate body”) and its microporous outer region (the supposed equivalent to “a retention  
25 structure”), there simply is nothing left for a trier of fact to point to as a bond between them.  
26 Allowing a fact finder to infer “bonds between them” out of nothing would impermissibly vitiate  
27 the bond element of claim 8. *See Warner-Jenkinson Co. v. Hilton Davis Chem. Co.*, 520 U.S. 17,  
28 29–30 (1997). Summary judgment of noninfringement is therefore appropriate.

1           **3.       Validity or Invalidity of Claims 8, 37, and 38 of the '361 Patent.**

2           Hologic moves for summary adjudication that “claims 8, 37, and 38 of U.S. Patent No.  
3 6,634,351 . . . are invalid” (Hologic Br. 25). This motion is **DENIED**. Hologic advances three  
4 grounds on which the asserted claims are allegedly invalid: inadequate written description, lack  
5 of enablement, and anticipation by prior art. Hologic is not entitled to summary judgment of  
6 invalidity on any of these theories, but it may present evidence of invalidity to the jury at trial.

7                   **A.       Inadequate Written Description**

8           A patent specification must include “a written description of the invention, and of the  
9 manner and process of making and using it, in such full, clear, concise and exact terms as to  
10 enable any person skilled in the art to which it pertains, or with which it is most nearly connected,  
11 to make and use the same.” 35 U.S.C. 112 ¶ 1. “[A] patent can be held invalid for failure to meet  
12 the written description requirement, based solely on the language of the patent specification.”  
13 *Univ. of Rochester v. G.D. Searle & Co.*, 358 F.3d 916, 927 (Fed. Cir. 2004). If no reasonable  
14 juror could find that a patentee’s disclosure was sufficiently detailed to enable one of skill in the  
15 art to recognize that the patentee invented what the patent claimed, then a grant of summary  
16 judgment of invalidity is appropriate. *Ibid.* Such is not the case here. Accordingly, summary  
17 judgment of invalidity is not appropriate on the grounds of inadequate written description.

18                   **B.       Enablement**

19           “To be enabling, the specification of a patent must teach those skilled in the art how to  
20 make and use the full scope of the claimed invention without ‘undue experimentation.’”  
21 *ALZA Corp. v. Andrx Pharms., LLC*, 603 F.3d 935, 940 (Fed. Cir. 2010). Enablement is a  
22 question of law, but it is based on underlying factual inquiries. “[W]hether undue  
23 experimentation is needed is not a single, simple factual determination, but rather is a conclusion  
24 reached by weighing many factual considerations.” *Ibid.* Conceptus has identified admissible  
25 evidence in the record that at least creates a genuine issue of material fact as to whether the ‘361  
26 patent is sufficiently enabled. As such, summary judgment of lack of enablement would be  
27 inappropriate.

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**C. Anticipation and Obviousness**

Hologic argues that only claim 8 of the '361 patent “is also invalid as anticipated and/or obvious as a matter of law in light of U.S. Patent No. 3,687,129” (Hologic Br. 16). Because this invalidity argument is limited to claim 8 and because this order already found that the Adiana product does not infringe claim 8 as a matter of law, this order need not reach the anticipation/obviousness portion of Hologic’s invalidity defense.

**4. Whether Essure Practices Claims 37 and 38 of the '361 Patent.**

Conceptus moves for summary adjudication that “Conceptus’ own Essure procedure practices claims 37 and 38 of the '361 patent” (Conceptus Br. 25). Conceptus represented at the hearing that this determination would be relevant to its reasonable royalty analysis of damages. This motion is **DENIED**. The question of whether Essure practices claims 37 and 38 of the '361 patent is a question of fact appropriate for the jury on the well-developed instant record.

**5. Whether Alternatives to the Claimed Invention Existed**

Conceptus moves for summary adjudication that “there were no acceptable and available, non-infringing alternatives to the claimed inventions during the relevant damages period” (Conceptus Br. 25). This motion is **GRANTED**.

“When an alleged alternative is not on the market during the accounting period, a trial court may reasonably infer that it was not available as a noninfringing substitute at that time.” *Grain Processing Corp. v. Am. Maize-Prods. Co.*, 185 F.3d 1341, 1353 (Fed. Cir. 1999). In such cases, the burden shifts to the infringer to show that a substitute nonetheless was “available” during this period, for example based on alternative actions the infringer reasonably could have taken to avoid infringement. *DePuy Spine, Inc. v. Medtronic Sofamor Danek, Inc.*, 567 F.3d 1314, 1331 (Fed. Cir. 2009). Having the necessary materials, equipment, know-how, and experience to make an alternative product during the relevant time frame may render that product “available.” *Grain Processing Corp.*, 185 F.3d at 1353–55. But “[m]ere speculation or conclusory assertions will not suffice to overcome the inference. . . . [T]he trial court must proceed with caution in assessing proof of the availability of substitutes not actually sold during the period of infringement.” *Ibid.* at 1353.

1 In this action, Hologic does not dispute the fact that Conceptus’s Essure product and  
2 Hologic’s Adiana product were the only two transcervical intrafallopian contraception methods  
3 on the U.S. market during the relevant time period (Hologic Opp. 22–24; Glasser Decl. ¶ 98).  
4 Hologic — the alleged infringer — therefore bears the burden of proving the availability of some  
5 other acceptable noninfringing alternative. Hologic, however, has not proffered *any* admissible  
6 evidence to rebut the inference that no acceptable noninfringing substitutes were available.  
7 Hologic argues that two specific alternatives were available because Adiana, Inc. (Hologic’s  
8 predecessor) designed them and had the materials, equipment, and know-how to “implement”  
9 them during the period of alleged infringement (Hologic Opp. 23). But the only support Hologic  
10 cites for this argument is a portion of the unsworn report of its own expert that relies exclusively  
11 on private conversations with Hologic personnel (Hologic Opp. 22–24; Ascolese Exh. 7 at  
12 ¶¶ 42–47). As Conceptus cogently notes, that is not evidence; it is double hearsay. Hologic does  
13 not point to any research-and-development documentation, deposition testimony, or sworn  
14 declarations that might demonstrate Hologic’s capacity to “implement” noninfringing alternatives  
15 during the period of alleged infringement. Accordingly, Conceptus is entitled to judgment as a  
16 matter of law on this point.

17 **6. When the Hypothetical Negotiation Would Have Taken Place**

18 Conceptus moves for summary adjudication that “for the purposes of a reasonable royalty  
19 assessment, the hypothetical negotiation would have occurred in mid-2009”(Conceptus Br. 25).  
20 This motion is **GRANTED IN PART AND DENIED IN PART**. This order finds that the hypothetical  
21 negotiation would have occurred in July 2009.

22 “To determine a reasonable royalty, a jury must find the royalty that would have been  
23 agreed to in a hypothetical negotiation between a willing licensee and willing licensors at the time  
24 the infringement began.” *Fujifilm Corp. v. Benun*, 605 F.3d 1366, 1372 (Fed. Cir. 2010).  
25 Assuming the Adiana product is found to infringe the ’361 patent, Conceptus argues that  
26 infringement began when Adiana first was offered for sale in the U.S. — July 2009 (Conceptus  
27 Br. 24–25). Hologic does not dispute that Adiana was offered for sale in the U.S. for the first  
28 time in July 2009. Nor does Hologic dispute that, assuming the Adiana product is found to

1 infringe, the infringement began when Adiana first was offered for sale in the U.S. (Hologic Opp.  
2 24–25). Thus, if the Adiana product is found to infringe, and if a reasonable royalty must be  
3 determined, a negotiation in July 2009 shall be hypothesized for this purpose.

4 Hologic resists this conclusion on the grounds that the hypothetical negotiation must take  
5 place between willing parties, but by July 2009 Conceptus and Hologic were embroiled in  
6 litigation, with Hologic facing the likelihood of protracted costs and the possibility of a monetary  
7 judgement or injunction. According to Hologic, “[t]hese facts would certainly skew the results of  
8 the hypothetical negotiation, if it were deemed to occur in July 2009” (Hologic Opp. 25).  
9 Hologic’s argument completely misses the point of the counterfactual exercise. The Sixth Circuit  
10 has explained this principle with particularly colorful language:

11 Determination of a “reasonable royalty” after infringement, like  
12 many devices in the law, rests on a legal fiction. Created in an  
13 effort to “compensate” when profits are not provable, the  
14 “reasonable royalty” device conjures a “willing” licensor and  
licensee, who like Ghosts of Christmas Past, are dimly seen as  
“negotiating” a “license.” There is, of course, no actual willingness  
on either side, and no license to do anything . . . .

15 *Panduit Corp. v. Stahl Bros. Fire Works, Inc.*, 575 F.2d 1152, 1159 (6th Cir. 1978). In this  
16 instance, Conceptus and Hologic did not negotiate a license in July 2009. And, as Hologic  
17 suggests, they may very well have been unwilling to negotiate a license in July 2009. If the  
18 Adiana product is found to infringe the ’361 patent, however, then the infringement began in July  
19 2009, and a reasonable royalty rate would be the one hypothetically negotiated between  
20 hypothetically willing parties at that time. The jury will be asked to imagine that a negotiation  
21 took place *in lieu of* this litigation and to reconstruct how a royalty negotiation in July 2009  
22 would have gone.

### 23 CONCLUSION

24 For the reasons provided herein, Conceptus’s motion for summary judgment is **GRANTED**  
25 **IN PART AND DENIED IN PART**. Conceptus’s motion for summary adjudication that “Hologic  
26 contributes to the direct infringement of claims 37 and 38 of the ’361 patent” is **DENIED**.  
27 Conceptus’s motion for summary adjudication that “Conceptus’ Essure procedure practices  
28 claims 37 and 38 of the ’361 patent” is **DENIED**. Conceptus’s motion for summary adjudication

1 that “there were no acceptable and available, non-infringing alternatives to the claimed inventions  
2 during the relevant damages period” is **GRANTED**. Conceptus’s motion for summary adjudication  
3 that “for the purposes of a reasonable royalty assessment, the hypothetical negotiation would have  
4 occurred in mid-2009” is **GRANTED IN PART AND DENIED IN PART**. This order finds that for the  
5 purposes of a reasonable royalty assessment, the hypothetical negotiation would have occurred in  
6 July 2009.


7 For the reasons provided herein, Hologic’s motion for summary judgment is **GRANTED IN**  
8 **PART AND DENIED IN PART**. Hologic’s motion for summary adjudication that claim 8 of the ’361  
9 patent is not infringed is **GRANTED**. Hologic’s motion for summary adjudication that claims 37  
10 and 38 of the ’361 patent are not infringed is **DENIED**. Hologic’s motion for summary  
11 adjudication that claims 8, 37, and 38 of U.S. Patent No. 6,634,351 are invalid is **DENIED**.

12 Because this order does not rely on any of the material identified therein, Conceptus’s  
13 motion to strike and Hologic’s motion to strike are both **DENIED AS MOOT**.

14 The motions to limit trial testimony are **DENIED WITHOUT PREJUDICE**. The parties may  
15 renew such motions at the appropriate time.

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17 **IT IS SO ORDERED.**

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19 Dated: December 16, 2010.

  
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WILLIAM ALSUP  
UNITED STATES DISTRICT JUDGE

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