

UNITED STATES DISTRICT COURT  
FOR THE DISTRICT OF COLUMBIA

SCIMED LIFE SYSTEMS, INC., )  
)  
Plaintiff and Counterclaim-Defendant , )  
)  
v. )  
)  
)  
MEDTRONIC VASCULAR, INC., )  
)  
Defendant and Counterclaim-Plaintiff, )  
)  
)  
and )  
)  
ERIC C. MARTIN, )  
)  
Defendant and Counterclaim-Defendant. )

Civil Case No. 01-2015 (RJL)

**st**  
MEMORANDUM OPINION  
(March 31, 2006) [# 76, 100, 102, 103]

Plaintiff, Scimed Life Systems, Inc. ("Scimed"), brought this action against defendants, Medtronic Vascular, Inc. ("Medtronic") and Eric C. Martin, under Title 35 of the United States Code Section 146, challenging the Final Decision and Judgment of the Board of Patent Appeals and Interferences (the "Board") of the United States Patent and Trademark Office ("USPTO") regarding Patent Interference No. 104,192 between certain patent applications for an apparatus for reinforcing a bifurcated lumen. Presently before the Court are Medtronic's Motion for Summary Judgment, Scimed's First and Second Motions for Summary Judgment, and Medtronic's Motion to Compel Production of Documents and

Things. After due consideration of the parties' submissions, the relevant law and the entire record herein, the Court finds that the Board did not erroneously affirm its Grant of the Fogarty *et al.* United States Patent Application Serial No. 08/463,836 (now owned by Medtronic) Motion 12 in its July 27, 2001 Final Decision and Judgment. Accordingly, this Court affirms the Board's Final Decision and Judgment and, therefore, GRANTS Medtronic's Motion for Summary Judgment, DENIES Scimed's First and Second Motions for Summary Judgment, and DENIES AS MOOT Medtronic's Motion to Compel Production of Documents and Things.

## **I. BACKGROUND**

Plaintiff Scimed and defendant/counterclaimant Medtronic are each assignees of record of two different patent applications for a bifurcated lumen invention.<sup>1</sup> Andrew Cragg and Michael Dake (collectively referred to as party "Cragg" in the underlying proceedings at the USPTO) filed an application with the USPTO regarding the bifurcated lumen apparatus on June 5, 1995. The application was assigned the serial number 08/461,402 (the "402 application"). Cragg and Dake assigned all rights in the '402 application to Boston Scientific Technology, Inc., which later merged into plaintiff Scimed. Scimed is now the present legal owner of the '402 application. Medtronic was assigned its rights in a patent application for the same invention by Thomas J. Fogarty, Timothy J. Ryan, and Kirsten Freislinger (collectively referred to as party "Fogarty" in the underlying proceedings at the

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<sup>1</sup> The "Background" section of this Memorandum Opinion has been partially adapted from this Court's earlier Memorandum Opinion in *Scimed Life Systems, Inc. v. Medtronic Ave Inc.*, 297 F. Supp. 2d 4 (D.D.C. 2003).

USPTO). That application was also filed with the USPTO on June 5, 1995, and assigned the serial number 08/463,836 (the “836 application”). Party Fogarty assigned its rights in the '836 application to Medtronic Aneurx, Inc., which merged into Medtronic AVE, Inc. which later became the defendant/counterclaimant Medtronic. Medtronic is now the legal owner of the '836 application. Defendant/counterclaim-defendant Eric Martin owns patent No. 5,575,817 (the “Martin” or “817 patent”), based on application 08/293,541, filed on August 19, 2004.

On April 23, 1998, the USPTO Board declared an interference between Scimed's patent application (the “Cragg” or “402 application”), Medtronic's patent application (the “Fogarty” or “836 application”) and the Martin patent. This interference proceeding was assigned Interference No. 104,192, and is referred to as the “192 interference.”<sup>2</sup> On July 2, 1998, the Board set the following as the sole “count”<sup>3</sup>:

An apparatus for reinforcing a bifurcated lumen comprising:  
 a first section, configured to be positioned within the lumen, comprising:  
 an upper limb, configured to fit within the lumen upstream of the bifurcation;  
 a first lower limb, configured to extend into the first leg of said bifurcation  
 when said first section is positioned in the lumen, and

<sup>2</sup> “The purpose of an interference proceeding is to resolve the question of priority of invention when more than one applicant seeks a patent on substantially the same invention.” 3A-10 Donald S. Chisum, *Chisum on Patents* § 10.09[1][a] (2006). This action was brought in federal Court pursuant to 35 U.S.C. § 146, which allows a party dissatisfied with the decision of the Board in an interference to bring a civil action as long as the Board's decision is not being appealed to the United States Court of Appeals for the Federal Circuit “and such appeal is pending or has been decided.” *See* 35 U.S.C. § 146.

<sup>3</sup> “A count defines the interfering subject matter. In *In re Van Geuns* (1993), the Federal Circuit noted that (1) ‘[a]lthough claims of one or more of the parties may be identical to the count of an interference, the count is not a claim to an invention,’ and (2) ‘[t]he count of an interference is merely the vehicle for contesting the priority of invention and determining what evidence is relevant to the issue of priority.’” 3A-10 Donald S. Chisum, *Chisum on Patents* § 10.09[3] (2006).

a second lower limb, shorter than said first lower limb, and configured so that when said first section is positioned in the lumen, said second lower limb does not extend into a second leg of said bifurcation, and further comprising a second section configured to be positioned separately within the lumen and joined to said second lower limb of the first section, effectively extending said second lower limb into said second leg of said bifurcation.

*Cragg et al. v. Martin v. Fogarty et al.*, Patent Interference No. 104,192, Paper No. 187, Final Decision and Judgment at 5-6 (United States Patent and Trademark Office, Board of Patent Appeals and Inferences July 21, 2001)(“Board’s Final Judgment”). The purpose of the ‘192 Interference was for the Board to determine who among the three parties had priority of inventorship, and was, therefore, entitled to the invention defined by the count.

At the time of declaration of the interference, party Cragg was accorded by the USPTO the benefit of the filing dates of two European patent applications (i.e. February 9 and June 10, 1994), which had been filed by a French Company known as Mintec SARL. At the time of declaration of the interference, party Fogarty, on the other hand, was accorded by the USPTO the benefit of the earlier filing date of U.S. patent application 08/255,681: i.e. on June 8, 1994. Thus, at the start of the interference, party Cragg was designated the “senior party,”<sup>4</sup> on the basis of the accorded benefit date of February 9, 1994. On March 13, 2000, party Fogarty filed a preliminary motion attacking the benefit accorded party Cragg to

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<sup>4</sup> “In an interference proceeding, the first party to file is designated as the ‘senior party’ and all other parties as ‘junior.’ The junior party bears the burden of going forward with evidence as to actual reduction to practice prior to the senior party’s filing date or conception prior to the senior party’s filing date plus continuous and reasonable diligence during the critical period. If the senior party desires to show a date of conception or reduction to practice prior to his filing date, he bears the burden of going forward with evidence.” 3A-10 Donald S. Chisum, *Chisum on Patents* § 10.03[1][c][ii] (2006).

the filing dates of the two European applications and sought to be made the senior party in the interference. On April 7, 2000, the Board granted party Fogarty's preliminary motion 12, declaring party Fogarty the senior party in the interference and party Cragg and party Martin as junior parties in the interference. *Cragg et al. v. Martin v. Fogarty et al.*, Patent Interference No. 104,192, Paper No. 130, Decision on Party Cragg's Motion to Correct the Preliminary Statement and on Party Fogarty's Preliminary Motion No. 12 at 7 (United States Patent and Trademark Office, Board of Patent Appeals and Inferences April 24, 2000)("Decision on Preliminary Motion No. 12"). In that same opinion, the Board denied party Cragg's motion to amend its preliminary statement to name Michael D. Dake and Andrew H. Cragg as co-inventors of the party Cragg invention. *Id.* at 7. Party Cragg requested reconsideration of that decision claiming that the Board had erred in its ruling and claimed that Mintec filed the European applications as assignees of both Dake and Cragg, the co-inventors of the subject matter of the patent application.

On April 24, 2000, the Board issued a Decision on Reconsideration denying the request for reconsideration on the basis that Dake's assignment of his rights in the patent application came after the filing of the European application and that 35 U.S.C. § 119 could not be interpreted to allow Mintec the benefit of priority with this subsequent assignment of rights. *Cragg et al. v. Martin v. Fogarty et al.*, Patent Interference No. 104,192, Paper No. 138, Decision on Reconsideration (United States Patent and Trademark Office, Board of Patent Appeals and Inferences April 24, 2000)("Board's Decision on Reconsideration"). In

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