

## **Design Patent Case Digest: Ethicon Endo-Surgery, Inc. v. Covidien, Inc.**

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**Decision Date:** August 7, 2015

**Court:** U.S. Court of Appeals for the Federal Circuit

**Patent:** D661,801; D661,802; D661,803; D661,804

**Holding:** Summary judgment of invalidity REVERSED; claim construction VACATED; summary judgment of noninfringement AFFIRMED.

### **Opinion:**

Ethicon Endo-Surgery, Inc. and Ethicon Endo-Surgery, LLC sued Covidien, Inc. and Covidien LP for, among other things, infringement of U.S. Design Patent Nos. D661,801, D661,802, D661,803, and D661,804, each entitled “User Interface for a Surgical Instrument.” The design patents relate to a handheld, ultrasonic surgical device and cover ornamental features of the device’s trigger, torque knob, and activation button. The district court entered summary judgment in favor of Covidien finding that the design patents are invalid as functional and not infringed by Covidien’s [accused product](#). Ethicon appealed both findings to the Federal Circuit.

According to the Federal Circuit, the district court’s grant of summary judgment as to invalidity was improper for two reasons: (1) the finding of functionality was unsupported by the evidence; and (2) the district court used “too high of a level of abstraction” in evaluating functionality. First, while there was evidence of alternative designs, the district court appeared to discount their existence and availability. For example, the district court’s finding that alternative designs did not work “equally well” focused on surgeons’ preferences—such as activation buttons on the front of the device—rather than differences in functionality. In addition, a design needs to only provide the same or similar functional capabilities to be an alternative; and there was no dispute that an ultrasonic surgical device would function in the same manner even with different shapes and locations for the device’s trigger,

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activation button, and torque knob.

Second, the district court used “too high of a level of abstraction” in evaluating functionality by “focusing on the general concepts of an open trigger, torque knob, and activation button rather than the ornamental designs adorning those elements.” Although the district court relied on Ethicon’s advertisements praising product benefits and Ethicon’s utility patents having figures similar to those in the design patents, the advertisements and utility patents did not support a finding of functionality because they note the functional benefits of the general concept of an open trigger, a rounded button, and a fluted torque knob—not specific ornamental conceptions of these features covered by the claimed designs. Thus, the court reversed the district court’s grant of summary judgment of invalidity of the design patents for functionality.

In addressing the district court’s grant of summary judgment as to noninfringement, the Federal Circuit first vacated the district court’s claim construction. Because the district court found the claimed design elements to be based on functional considerations, the district court factored out every element from the claims and construed the claims to cover “nothing.” Similar to the district court’s error with respect to invalidity, this approach focused on the functionality of the underlying articles rather than their ornamental designs. Thus, although the “U”-shaped trigger, torque knob, and rounded button have functional aspects, the claimed designs still protect the ornamental aspects of these elements. According to the Federal Circuit, the district court ignored the particular curved design of the trigger, the flat-front shape of the torque knob, and rounded appearance of the activation button. Thus, the court vacated the district court’s construction that the design patents cover nothing.

While the Federal Circuit disagreed with the district court’s claim construction, the Federal Circuit did agree with the district court’s finding of noninfringement. The district court identified several plain dissimilarities between the claimed and accused designs. While the claimed design had an overall contoured shape, a curved and tapered trigger handle, a football-shaped activation button, and a torque knob with unevenly-tapered flutes and a flat front-face with a circular recess, the accused design had an overall linear shape, a parallel trigger handle of constant width, a rectangular activation button, and a torque knob with evenly-tapered flutes and a rounded-front face with no recess. The Federal Circuit found no error with the district court’s finding of plain dissimilarities when comparing the ornamental features.

Ethicon did not challenge these specific findings but did contend that the district court should have considered the frame of reference provided by the prior art. The Federal Circuit disagreed because considering the prior art is not required when the claimed and accused designs are plainly dissimilar. *Egyptian Goddess, Inc. v. Swisa, Inc.*, 543 F.3d 678 (Fed. Cir. 2008) (en banc) Ethicon also contended that the district court erred in determining that the ordinary observer was a sophisticated entity who managed the complex medical device purchasing process. Ethicon’s argument that the ordinary observer is actually the surgeon was unsuccessful because the Federal Circuit found that the differences would be plainly dissimilar to even one less discerning than the ordinary observer and would only be more evident to a more sophisticated observer, whether a purchasing entity or a surgeon. Thus, the Federal Circuit affirmed the district court’s grant of summary judgment of noninfringement of the design patents because the ornamental features, as a whole, are plainly dissimilar.

Accordingly, the Federal Circuit reversed the grant of summary judgment of invalidity, vacated the claim construction, and affirmed the grant of summary judgment of noninfringement.

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