

ETHICON ENDO-SURGERY, INC. v. COVIDIEN, INC., Appeal No. 2014-1370 (Fed. Cir. August 7, 2015). Before Lourie, Bryson and Chen. Appealed from S.D. Ohio (Judge Black).

Background:

Ethicon sued Covidien for alleged infringement of several utility and design patents related to ultrasonic devices. The design patents are directed to ultrasonic devices having a "U"-shaped trigger, a rounded activation button, and a rounded and fluted torque knob. Covidien moved for summary judgment that the design patents are invalid as functional, and in the alternative, not infringed. The district court agreed, and entered a final judgment in favor of Covidien. Ethicon appealed to the Federal Circuit.

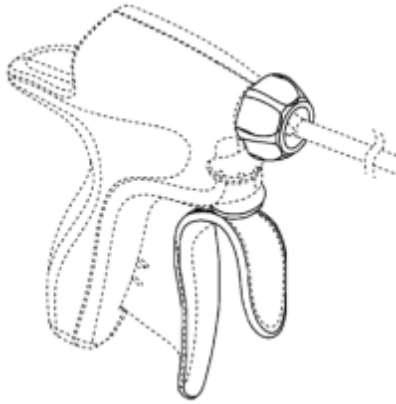
Issues/Holdings:

Was the district court correct in finding that the design patents were invalid based on functionality? No, reversed. Was the district court correct in granting summary judgment of non-infringement of the design patents? Yes, affirmed.

Discussion:

The Federal Circuit first pointed out if a particular design is essential to the use of an article, it cannot be the subject of a design patent, and is therefore invalid. Designs are essential to the use of an article when the claimed design is "dictated by" the use or purpose of the article. Although the Federal Circuit acknowledged that it has not mandated any particular test to determine whether a claimed design is dictated by its function, the availability of alternative designs is an important, if not dispositive, factor in evaluating the legal functionality of a claimed design. Here, the Federal Circuit found that the district court appeared to discount Ethicon's evidence of the availability and existence of alternative designs in determining whether the claimed designs are "primarily functional." Referencing the *Hupp* case, the court pointed out that for functionality purposes, "it is relevant whether functional considerations demand only this particular design, or whether other designs could be used, such that the choice of design is made for primarily aesthetic, non-functional purposes." Thus, because the open trigger, torque knob and activation button in Ethicon's design patents are not dictated purely by function, they are ornamental and not invalid.

After finding that the design patents are not invalid, the Federal Circuit then discussed whether the district court correctly granted summary judgment of non-infringement to Covidien, beginning with a claim construction analysis. At trial, the district court found that because the claimed trigger, torque knob and activation button were based on functional considerations, each claim of the design patents was construed to encompass "nothing," factoring out and removing every element from the scope of the claimed designs. In other words, because the scope of a design claim is limited only to the ornamental aspects of the design (and not the functional aspects), the functional aspects are typically not taken into consideration during claim construction. Although the Federal Circuit agreed that the trigger, torque knob and activation button have functional aspects, they found that there is no evidence in the record that the ornamental designs adorning those articles are essential to the use of the article. Thus, the ornamental designs of those articles must be considered in a claim construction analysis. However, the Federal Circuit still agreed the design patents are not infringed, finding that there are plain dissimilarities between the claimed and accused design such that an ordinary observer would not be deceived.



D'804 patent, Fig. 1



Covidien's accused product