

SYNTHES USA, LLC v. SPINAL KINETICS, INC., Appeal No. 2013-1047, -1059 (Fed. Cir. October 29, 2013). Before Prost, O'Malley, and Taranto. Appealed from N.D. Cal. (Judge Whyte).

Background:

Synthes sued Spinal Kinetics (SK) asserting that SK's intervertebral implants infringe claims of Synthes' patent. The recitation of "a plate including a plurality of openings" in the asserted claims was particularly important. The specification of Synthes' patent only describes grooves on the circumference of the cover plate. SK devices do not employ peripheral grooves, but instead used slots, or openings, on the cover plates. The jury concluded that SK's device did not infringe the asserted claims and that SK proved by clear and convincing evidence that the asserted claims were invalid for a lack of written description. Synthes moved for judgment as a matter of law arguing that SK failed to produce substantial evidence that supported the jury verdict that the recitation "plate including a plurality of openings" lacks written description support. The district court affirmed the jury verdict. Synthes appealed.

Issue/Holding:

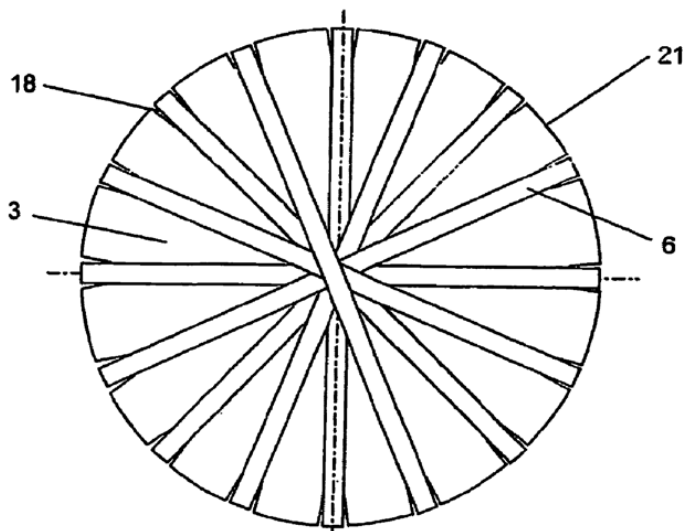
Did the district court err in finding that substantial evidence supported the jury verdict that the term "plate including a plurality of openings" lacked written description support, rendering the asserted claims invalid? No, affirmed.

Discussion:

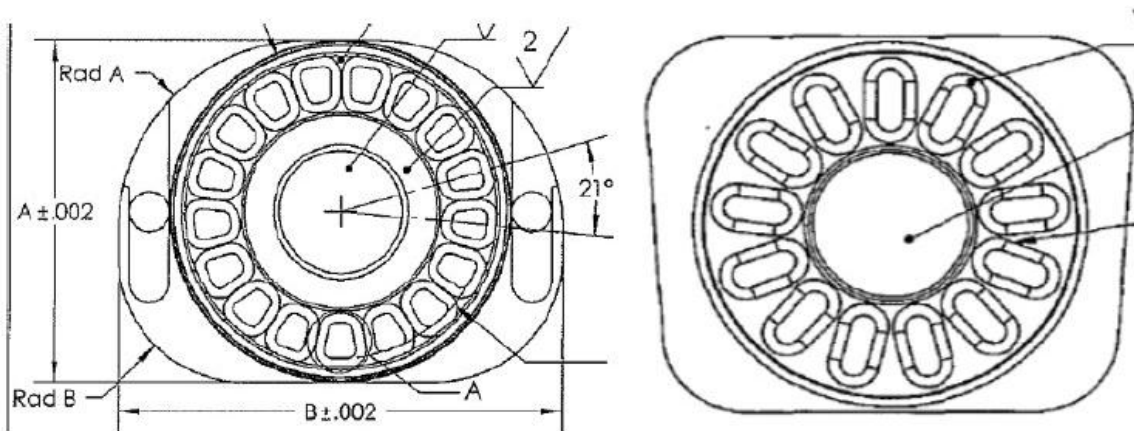
The Federal Circuit stated that the test for sufficiency of written description is whether the disclosure of the application relied upon reasonably conveys to those skilled in the art that the inventor had possession of the claimed subject matter as of the filing date.

In view of the above standard, the Federal Circuit, with all reasonable inferences being drawn in favor of the jury verdict, affirmed the decision of the jury that the written disclosure of "grooves" did not reasonably convey to a skilled artisan that the inventor had possession of an intervertebral implant that could use *any sort of opening located anywhere* on the cover plates, because the specification never disclosed anything broader than using grooves to anchor the fiber system to the cover plates.

The Federal Circuit based its decision on the expert testimony of SK's expert who testified that (1) the written disclosure of peripheral grooves would not disclose openings located anywhere on the plates; (2) there are significant biomechanical property differences between using peripheral grooves and interior slots; and (3) by using interior openings, the distance of the fibers to the central axis can be reduced. SK's research and development manager testified that SK rejected early prototypes that used peripheral grooves and that SK's development process from peripheral grooves to interior slots took months of time. He further testified that the shape of the slots on the cover plates reduced wear on the device. The Federal Circuit held that the testimony of SK's research and development manager coupled with the expert testimony on the "plurality of openings" limitation provided ample evidence for the jury to conclude that the written description did not support the broad claim limitations in the asserted claims.



Synthes Patent



Lumbar

Cervical

Spinal Kinetics Products