United States District Court,
D. Utah, Central Division.

UTAH MEDICAL PRODUCTS, INC., a Utah corporation,
Plaintiff.
v.
GRAPHIC CONTROLS CORP., a New York corporation, and Does 1 through 10,
Defendants.

No. 2:97CV427C

Sept. 11, 2000.

ORDER

CAMPBELL**, J.**

This case arose when Plaintiff Utah Medical Products, Inc.'s ("Utah Medical's") sued Defendant Graphic Controls Corporation ("Graphic Controls") on the grounds that Graphic Controls' accused device, the Softrans IUP, infringes claims 1-5, 7-16, 18 and 21 of U .S. Patent No. 4,785,822 ("the '822 patent") held by Utah Medical. FN1 In this motion, Graphic Controls argues that it is entitled to summary judgment because (1) no reasonable jury could find that the Softrans IUP infringes the claims of the '822 patent and (2) Utah Medical is guilty of false marking because Utah Medical's Intran Plus product, marked with the '822 patent number, does not practice the '822 patent.

FN1. The history and background of this case are set forth in the court's order of January 19, 2000, and will not be repeated here except as necessary.

Discussion

Summary judgment is appropriate only if there is no genuine issue as to any material fact and the moving party is entitled to judgment as a matter of law. *See* Fed.R.Civ.P. 56(c). The evidence must be viewed in a light most favorable to the party opposing summary judgment, and all reasonable inferences must be drawn in favor of that party. *See* Ethicon Endo-Surgery, Inc. v. United States Surgical Corp., 149 F.3d 1309, 1314 (Fed.Cir.1998). Summary judgment may be granted when no "reasonable jury could return a verdict for the nonmoving party." Anderson v. Liberty Lobby, Inc., 477 U.S. 242, 248 (1986).

Literal Infringement FN2

FN2. Infringement analysis requires two steps: First, the asserted claims must be construed to determine their scope and meaning; second, the claim, as construed, must be compared to the accused device. *See* Ethicon, 149 F.3d at 1314. The court has previously construed the asserted claims of the '822 patent. (*See* Order dated Jan. 19, 2000.)

"A claim limitation written in means-plus function form, reciting a function to be performed rather than definite structure, is subject to the requirements of 35 U.S.C. s. 112, para. 6." Odetics, Inc. v. Storage Tech. Corp., 185 F.3d 1259, 1266 (Fed.Cir.1999). _____

Literal infringement of a s. 112, para. 6 limitation requires that the relevant structure in the accused device perform the identical function recited in the claim and be identical or equivalent to the corresponding structure in the specification.... Functional identity and either structural identity or equivalence are both necessary.

Id. (internal citations omitted).

The dispositive question raised in this motion is whether a reasonable jury could find that the Softrans plastic cable is equivalent to the stylet disclosed by the '822 patent as the stiffener means. FN3 Graphic Controls argues that it is entitled to summary judgment because the plastic cable in its device is not a separate component from the electrical cable means but is, in fact, the same structure as the electrical cable means. FN4 According to Graphic Controls, then, no reasonable jury could find that the plastic cable is equivalent to the stiffener means of the '822 patent.

FN3. In the January 19, 2000 Markman Order, this court construed stiffener means as a "stylet, or its equivalent structure, is a separate component *from* the cable means but must be permanently encased within the cable means." (Order dated Jan. 19, 2000 at 9) (emphasis added.) That construction is amended to change the word "from" to "of."

FN4. There is no genuine dispute that the stiffener means of the '822 patent and the Softrans IUP perform the identical function, that is, "imparting a desired degree of rigidity to said electrical cable means to facilitate intracompartmental insertion of said transducer using said electrical cable means." (Order dated Jan. 19, 2000 at 3.)

In response, Utah Medical has offered evidence, primarily the affidavit of its expert, Robert W. Hitchcock, that the plastic cable of the Softrans IUP is structurally equivalent to the stylet of the '822 patent. According to Hitchcock, the plastic of the Softrans cable has been made sufficiently stiff so it can be inserted without a guide tube. In addition, Hitchcock stated that at the time the '822 patent was issued, a person of ordinary skill in the medical device field would have known that this method of stiffening was interchangeable with the use of a stylet. Finally, Hitchcock expressed his opinion that the method used for stiffening the Softrans IUP was an insubstantial change from the stiffener means of the '822 patent and performs the exact function in substantially the same way to achieve substantially the same result.

Graphic Controls relies, in part, on Dolly, Inc. v. Spalding & Evenflo Cos., 16 F.3d 394 (Fed.Cir.1994) in support of its argument that the stiffener means must be a separate structure from the electrical cable means. The holding and language in *Dolly* do seem to favor Graphic Controls' position. In *Dolly,* the patent was directed to a child's booster chair and recited a rigid frame, separate from the back, seat and side panels. The Federal Circuit held that the accused device, the "Snack & Play" child's chair, which did not have a separate rigid frame, could not infringe under the doctrine of equivalents. According to the Federal Circuit

Court,

This court cannot "convert a multi-limitation claim to one of [fewer] limitations to support a finding of equivalency." *Perkin-Elmer Corp.*, 822 Fed. at 1532. The Snack & Play stable rigid frame assembled from the panels is not the equivalent of the claimed stable rigid frame which specifically excludes the seat and back panels.

Id. at 398 (quoting Perkin-Elmer Corp. v. Westinghouse Elec. Corp., 822 F.2d 1528, 1532 (Fed.Cir.1987)).

However, a later decision by the Federal Circuit limits *Dolly* to the specific facts of that case. In *Ethicon Endo-Surgery,* the Federal Circuit stated that *Dolly,* and certain other cases, "simply explained that on the facts presented, no reasonable finder of fact could have found infringement by equivalents because the differences between the allegedly infringing devices and the claimed inventions were plainly not insubstantial." 149 F.3d at 1318.

In light of the evidence presented by Utah Medical of the insubstantiality of the differences between the plastic electrical cable of the Softrans IUP and the stylet in the context of the '822 patent, the court concludes that there are genuine issues of material fact on the issue of whether the Softrans IUP infringes the '822 patent, literally or under the doctrine of equivalents. *See* IMS Tech., Inc. v. Haas Automation, Inc., 206 F.3d 1422, 1436 (Fed.Cir.2000) (noting that "the similarities in analysis of equivalence under s. 112, para. 6 and the doctrine of equivalents" raised factual issues regarding infringement under both theories). Therefore, Graphic Controls is not entitled to summary judgment on the infringement claim.

Because Graphic Controls' claim of false marking by Utah Medical raises the same issues as those discussed above, summary judgment is also not appropriate on that claim.

Graphic Controls' Motion for Partial Summary Judgment is DENIED.

D.Utah,2000.
Utah Medical Products, Inc. v. Graphic Controls Corp.