

Ethicon Escapes Covidien Patent Claims In Device Case

By **Brian Dowling**

Law360 (April 24, 2020, 3:12 PM EDT) -- Ethicon did not infringe patents held by its medical device rival Covidien when it developed a competing surgical tool, a federal judge in Massachusetts said Friday following a bench trial that capped a four-year legal battle.

U.S. District Judge Leo T. Sorokin said Medtronic unit Covidien LP didn't prove Johnson & Johnson's Ethicon Endo-Surgery Inc. violated its patents with a competing device for cutting and sealing blood vessels called the Enseal X1 — the finding of non-infringement that Ethicon sought when it filed the suit in 2016.

However, the court ruled Ethicon came up short in arguing that Covidien's patents were invalid because they contained nothing that hadn't been in earlier inventions.

Judge Sorokin concluded "that Ethicon has failed to establish invalidity and that Covidien has failed to establish infringement."

The court ordered both companies to file proposed judgments in light of the decision. But without an infringement finding, those bids will not include the type of costly royalties that could have reached the \$10.9 million figure proposed by Covidien during the bench trial.

The two companies are familiar courtroom foes, having squared off in at least 10 cases since 2011 before the Patent Trial and Appeal Board, in federal district courts in Ohio, Massachusetts and Connecticut, and in appeals at the Federal Circuit and Second Circuit. Their legal rivalry is so ingrained that many of their briefs in the Enseal X1 case referenced earlier iterations of Covidien v. Ethicon.

The current case focused on Ethicon's attempt to develop a product to compete with Covidien's Ligasure Impact, an effort given the code name "Project Brick."

The Ligasure and Enseal are gun-shaped devices with a fixed handle and long trigger that opens and closes two small jaws at the end of a long barrel. When the jaws close, electrodes on the jaws heat up to seal off tissue. Then a knife can be extended through the barrel and jaws to cut the tissue, which the device has already cauterized to reduce bleeding.

Covidien claimed Ethicon's development efforts failed, so it instead copied the Ligasure's handle and aspects of its cutting and cauterizing tip.

Before Ethicon released the Enseal X1 in 2017, the company filed suit seeking a court order stating the product did not infringe any of Covidien's patents. Covidien disagreed and responded with infringement claims, two of which were the subject of the 10-day bench trial over the course of September to January. Covidien tried unsuccessfully to get the court to block sales of the Enseal while the case was being heard.

Judge Sorokin's decision Friday found that aspects of Ethicon's Enseal device — including a "shepherd crook" handle, reinforcing ribs and the jaw that closes to seal tissue and blood vessels — do not infringe Covidien's patents.

The decision also said Covidien's two patents were more than just slight modifications to earlier, similar patents, and not obvious from prior patents.

A spokeswoman for Ethicon said the company is pleased with the ruling that its product doesn't infringe Covidien's patents.

Covidien's attorney Richard Mulloy of DLA Piper LLP said in a statement the company is "assessing its options to appeal" the decision and "believes strongly in protecting its intellectual property."

The patents-in-suit are U.S. Patent Nos. 9,241,759; and 8,823,310.

Covidien is represented by Mark D. Fowler, Richard T. Mulloy, Matthew Ganas and Joel C. Lin of DLA Piper, as well as David J. Apfel and Samuel E. Sherry of Goodwin Procter LLP.

Ethicon is represented by Jeffrey S. Ginsberg, William F. Cavanaugh Jr., Abhishek Bapna, Zhiqiang Liu, Nathan Monroe-Yavneh and George Soussou of Patterson Belknap Webb & Tyler LLP, as well as Peter E. Gelhaar and Peter K. Levitt of Donnelly Conroy & Gelhaar LLP.

The case is Ethicon Endo-Surgery Inc. v. Covidien LP et al., case number 1:16-cv-12556, in the U.S. District Court for the District of Massachusetts.

--Editing by Marygrace Murphy.