

Using Method Claims to Protect a Device¹

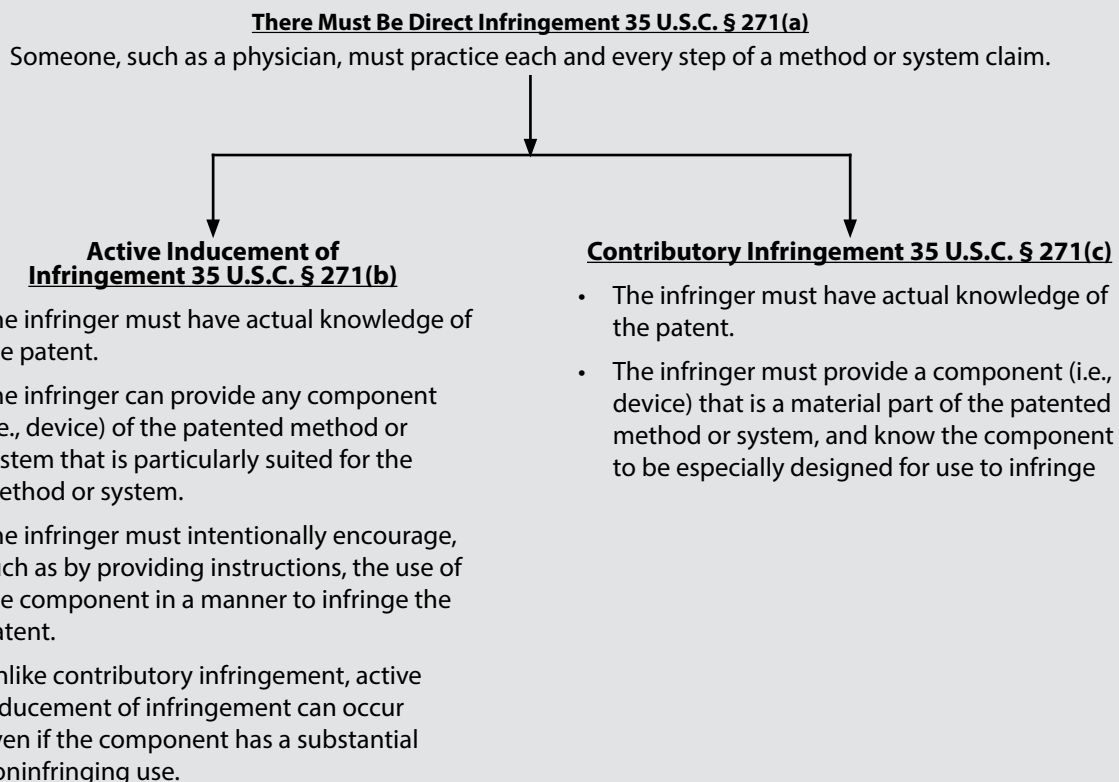
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I. Introduction.

Using *method* claims to protect a *device* is often overlooked because conventional thinking equates device protection with only device claims. A device can, however, be protected by method claims, because a device can *indirectly* infringe method claims by inducement of infringement or contributory infringement. This is true even for medical or surgical method claims, which are not enforceable against direct infringers such as hospitals or doctors. 35 U.S.C. § 287(c). In fact, method claims can potentially provide *broader* protection for a device because they may not require a detailed device structure.

II. Indirect Patent Infringement.

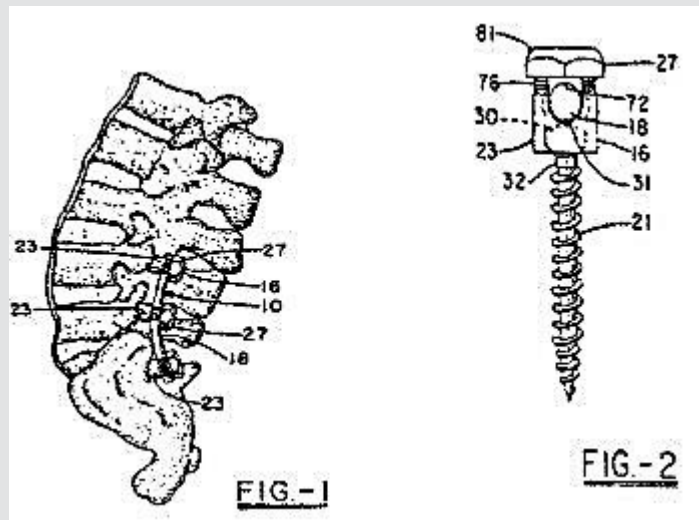
The following diagram outlines factors for the two most common types of indirect patent infringement, active inducement of infringement and contributory infringement.



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III. Example of a Narrow Device Claim Versus a Broad Method Claim for the Same Invention.

Consider an example of an orthopedic device for maintaining spinal alignment.² For the purpose of this example, the device is positioned in the spine of a patient using a series of bone screws 21, each having an anchor seat 23. A stabilization rod 18 is then positioned in the channels 51, 52 of the anchor seats. Surgeons then secure the stabilization rod 18 to the anchor seats 23 with top-tightening nuts 27. By connecting the stabilization rod 18 to the anchor seats 23 on adjacent spinal bones, the position of the patient's spine may be fixed as desired. Figures 1-2 of the exemplary invention follow:



A. The Exemplary Device Claim Is Narrow.

In this example, the device claims must include numerous structural limitations to distinguish over the prior art:

Exemplary independent device claim 1: A device for maintaining the alignment of two or more bone segments of the spine, the device comprising:

- (a) at least two anchors and an elongated stabilizer comprising a rod having a diameter and a longitudinal axis, said anchors each comprising anchoring means which secure said anchors to one of the two or more bone segments, and an anchor seat means which has a lower bone interface operatively joined to that bone segment, and an anchor seat portion spaced apart from said bone interface including a channel to receive said rod; and
- (b) securing means which cooperate with each of said anchor seat portions spaced apart from said bone interface and exterior to the bone relative to said elongated rod, said seat means including a vertical axis and first threads which extend in the direction of said vertical axis toward said lower bone interface to a depth below the diameter of the rod when it is in the rod receiving channel, and said securing means including second threads which cooperate with the first threads of the seat means to cause said rod to bear against said channel through the application of substantially equal compressive forces by said securing means in the direction of the vertical axis and applied on either side along said longitudinal axis of said channel.

² This example is based in part on the structure and claim at issue in *Cross Medical Prods., Inc. v. Medtronic Sofamor Danek, Inc.*, 424 F. 3d 1293, 1298-99 (Fed. Cir. 2005).

B. The Exemplary Method Claim Provides Broader Protection for the Device.

In this example, the method of maintaining spinal alignment is unique, so the device *as recited in the method claim* does not require the same detailed structural limitations as are in exemplary independent device claim 1:

Exemplary independent method claim 1: A method for maintaining the alignment of two or more bone segments of the spine, the method comprising the steps of:

- (a) exposing at least two bone segments of the spine;
- (b) connecting an alignment device to each of the at least two bone segments using a first bone screw that is received in a first opening of the alignment device and fastened to one of the two or more bone segments, and a second bone screw that is received in a second opening of the alignment device and fastened to another of the at two or more bone segments, wherein the first bone screw has a first anchor and the second bone screw has a second anchor; and
- (c) securing a stabilization rod to the first anchor and to the second anchor.

C. The Method Claim Could Be Infringed by a Device that Would Not Infringe the Device Claim.

1. A Device that Could Indirectly Infringe Method Claim 1 is not Limited to the Structure of Device Claim 1.

Below, limitations of exemplary independent device claim 1 that are entirely missing from exemplary method claim 1 are shown in bold italics. Therefore, a device that does not include those limitations could still infringe exemplary independent method claim 1.

Exemplary independent device claim 1: A device for maintaining the alignment of one or more bone segments of the spine, the device comprising:

(a) at least two anchors and ***an elongated stabilizer*** comprising a rod having a diameter and a longitudinal axis, said anchors each comprising ***anchoring means*** which secure said anchors to said bone segment and an ***anchor seat means*** which has ***a lower bone interface*** operatively joined to said bone segment and an ***anchor seat portion spaced apart from said bone interface*** including ***a channel*** to receive said rod; and

(b) ***securing means*** which cooperate with each of said ***anchor seat portions*** spaced apart from said bone interface and exterior to the bone relative to said elongated rod, said seat means including a ***vertical axis and first threads*** which ***extend in the direction of said vertical axis*** toward said lower bone interface ***to a depth below the diameter of the rod*** when it is in the rod ***receiving channel***, and said ***securing means*** including ***second threads*** which cooperate with the ***first threads*** of the ***seat means*** to cause said rod to bear against ***said channel*** through the application of ***substantially equal compressive forces*** by said ***securing means*** in the direction of the ***vertical axis*** and ***applied on either side along said longitudinal axis of said channel***.

2. Active Inducement of Infringement of Method Claim 1.

If a company (a) produced or sold a device with the structure recited in exemplary independent method claim 1 knowing of the patented method, and (b) the company promoted the device for use in exemplary method claim 1, the company could be liable for active inducement of infringement. Promotion of the device may be in the form of advertising, written instructions, or having consultants or sales representatives advise physicians to use the device in the patented method.

3. **Contributory Infringement of Method Claim 1.**

If (a) a company produced or sold a device with the structure recited in exemplary independent method claim 1 knowing of the patented method, (b) the device is particularly suited to be used in exemplary method claim 1, and (c) the device has no substantial non-infringing use, the company could be liable for contributory infringement.

IV. **Conclusion.**

Do not overlook using method claims to protect devices, such as medical devices. Method claims often provide broader protection for a device than device claims.



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Dave Rogers is a registered patent attorney with over 20 years of experience. He practices patent, trademark, trade secret and unfair competition law, including: litigation and arbitration; trademark oppositions, cancellations and domain name disputes; preparing manufacturing and technology contracts; and patent and trademark preparation and prosecution.