UNITED STATES DISTRICT COURT

FOR THE DISTRICT OF RHODE ISLAND

DAVOL, INC.

v. C.A. No. 03-200-T

STRYKER CORPORATION

MEMORANDUM AND ORDER

ERNEST C. TORRES, Chief Judge.

Pursuant to the Declaratory Judgment Act, 28 U.S.C. § 2201, Davol, Inc., ("Davol") brought this action ("Davol II"), for a declaratory judgment that a laparoscopic surgical irrigation device that it manufactures does not infringe a patent held by Stryker Corporation ("Stryker").

Stryker has moved to dismiss on the ground that there is no case or controversy cognizable under the Declaratory Judgment Act because Davol has no reasonable apprehension of an infringement suit by Stryker; or, in the alternative, that this Court should exercise its discretion to decline jurisdiction.

Davol has countered with a motion to stay this case until the claim construction issues in another pending case brought by Davol against Stryker, Davol, Inc. v. Stryker Corp., C.A. No 01-388-T, ("Davol I") have been resolved.

For the reasons hereinafter stated, both motions are denied.

Background

Davol and Stryker are competing manufacturers of laparoscopic surgical irrigation devices. On August 16, 2001, Davol brought suit against Stryker, in this Court (Davol I), seeking a declaratory judgment that Davol's Hydro-Surg® Plus with Conjoined Tubing device ("HSP/CT") did not infringe a patent held by Stryker (the "'970 Patent").[1]

Stryker moved to dismiss Davol I on the ground that subject matter jurisdiction was lacking inasmuch as Davol had failed to demonstrate any reasonable apprehension of a suit for infringement. This Court denied that motion and Stryker promptly confirmed the reasonableness of Davol's apprehension by filing a counterclaim for infringement of its '970 Patent. Davol's counterclaim is based on claims 27, 33, 34 and 43 of that patent.

One week after Stryker's motion to dismiss was denied, Davol came out with a new model suction irrigator which it called the 2003 Model Hydro-Surg® Plus (the "2003 Model") and Davol moved to "supplement" its complaint by adding a request for a declaratory judgment that the 2003 Model did not infringe the '970 Patent either.

In opposing the motion to supplement Stryker argued that Davol could not reasonably fear an infringement suit with respect to the

[1]That action was preceded by a suit by Stryker against Davol in the Western District of Michigan alleging patent infringement by another suction irrigator manufactured by Davol.

2003 Model because the 2003 Model was substantively different from the HSP/CT at issue in Davol I, and because Stryker had not even seen the 2003 Model due to the fact that it was not yet on the market. Although Davol conceded that there were some differences between the two models, it argued that the 2003 Model had features similar to the features of the HSP/CT that Stryker alleges infringe claims 33 and 34 of its '970 Patent.

This Court did not reach the question of whether the two models shared allegedly infringing features because it appeared that, in any event, the motion to supplement should be denied. More specifically, this Court decided that if there were no differences between the relevant features of the two models, the proposed supplemental complaint would have been superfluous because resolution of the infringement claims with respect to the HSP/CT would resolve any infringement claims with respect to the 2003 Model and the proposed supplementation would have created confusion and delayed the case. On the other hand, if there were material differences in the two models, the proposed supplementation would inject infringement issues that were separate and distinct from those relating to the HSP/CT.

Analysis

I. Stryker's Motion to Dismiss

Immediately after Davol's motion to supplement was denied, Davol brought this action (Davol II) seeking a declaratory judgment

that the 2003 Model does not infringe the '970 Patent. In moving to dismiss, Stryker, again, argues that it has done nothing to instill in Davol any reasonable apprehension of an infringement suit. Stryker contends that its counterclaim in Davol I is insufficient to have created any such apprehension because it was filed only because Stryker was "left with no other legal alternative when the Court denied its motion to dismiss." Def. Mem. in Supp. of Mot. to Dismiss, at 7. Davol argues that Stryker's counterclaim did create a reasonable apprehension of suit because it is based on claims 33 and 34 of the '970 Patent, which relate to design features common to both the 2003 Model and the HSP/CT.

Stryker's reason for filing a counterclaim in Davol I is immaterial. The only question here is whether that counterclaim or any other action by Stryker gave Davol a reasonable apprehension that it would be sued for infringing Stryker's '970 Patent.

The answer to that question turns on whether the allegedly infringing features of the HSP/CT have been incorporated into the 2003 Model. That is a question of fact that cannot be decided from the record as it presently exists. Moreover, unless and until this question can be answered in the negative, there is no reason for the Court to decline exercising its jurisdiction under the Declaratory Judgment Act.

Therefore, Stryker's motion to dismiss is denied.

II. Davol's Motion to Stay

Davol argues that staying this case until the claim construction issues in Davol I have been resolved will promote judicial economy because resolution of those issues will resolve many of the issues in this case. That argument is somewhat incongruous for at least two reasons.

First, Davol, itself, brought this suit and this suit was prompted by Davol's unilateral action in introducing a new model of the challenged device. Generally, it is inappropriate for a plaintiff to bring a suit unless the plaintiff is prepared to prosecute it. Furthermore, a defendant is entitled to a prompt resolution of the claims made against it.

In addition, Davol's contention that resolution of the issues in Davol I will resolve the issues in this case is inconsistent with the argument that Davol made in moving to supplement its complaint in Davol I. That argument implicitly rested on the premise that issues of infringement with respect to the HSP/CT and the 2003 Model could and should be tried together as part of the same case.

In any event, a stay of Davol II would do nothing to promote judicial economy. To the extent that the two models share common features that are material to Stryker's infringement claims in Davol I, there would be no need for duplicative discovery because the discovery conducted in Davol I could be utilized in Davol II.

If necessary, the Court could consolidate the two cases for discovery purposes. On the other hand, to the extent that the two models raise different infringement issues, resolution of the issues in Davol I will not resolve the issues in this case. In either event a stay would merely delay resolution of this case. Therefore, Davol's motion for a stay is denied.

IT IS SO ORDERED,

Ernest C. Torres
Chief Judge
Date: , 2004