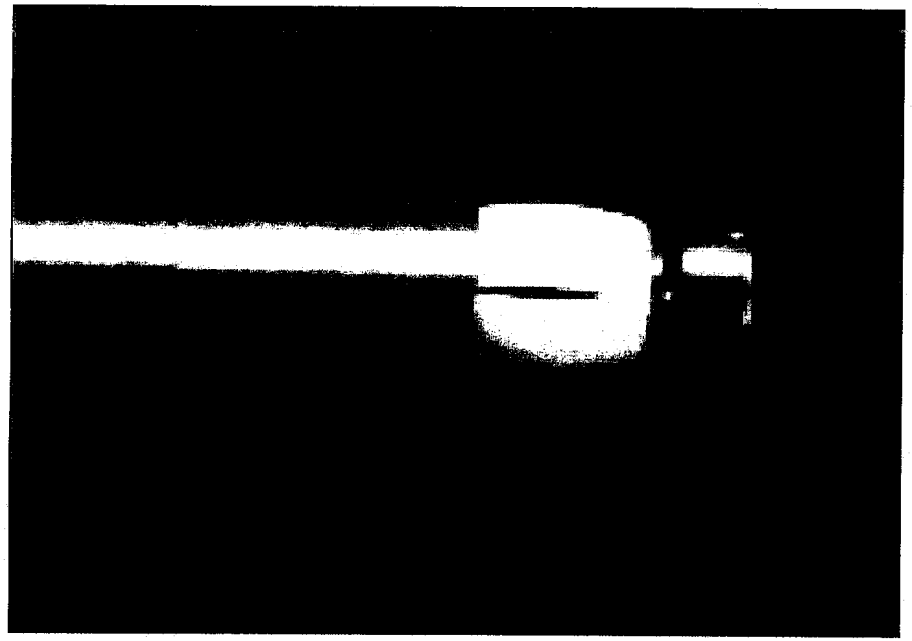
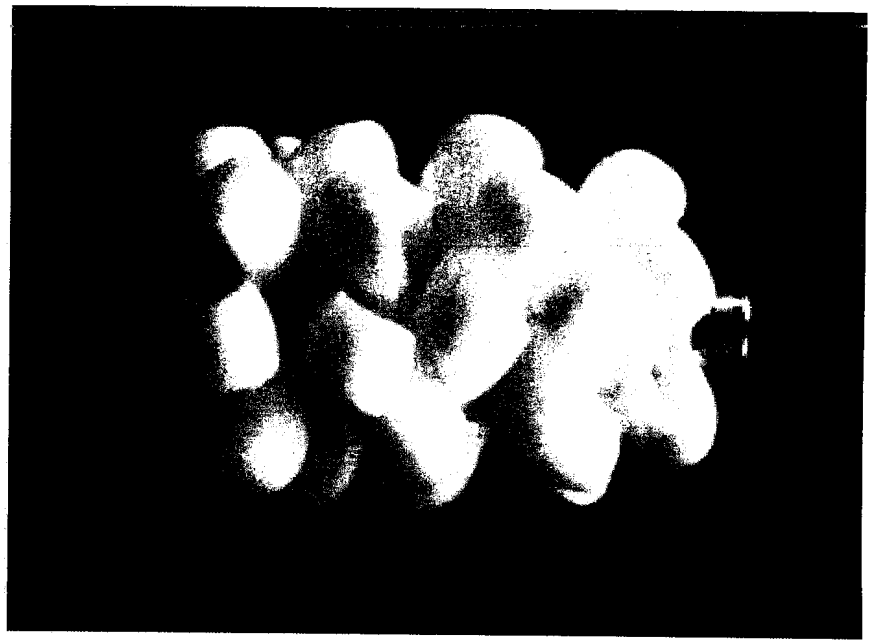
# THE SKy DEVICE



SKy Device Prior To Deployment

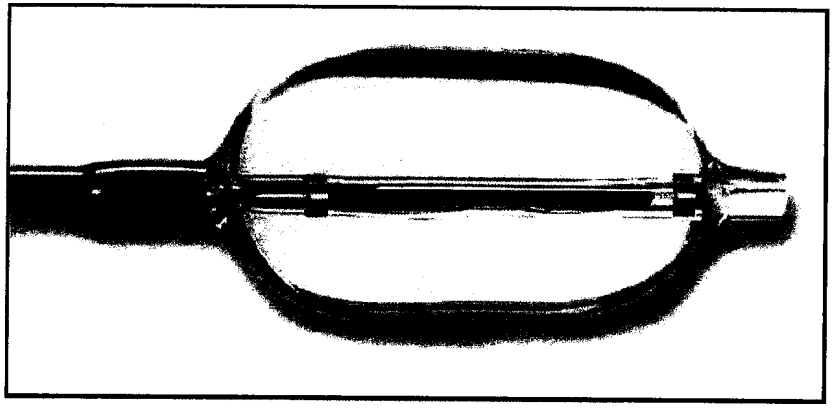


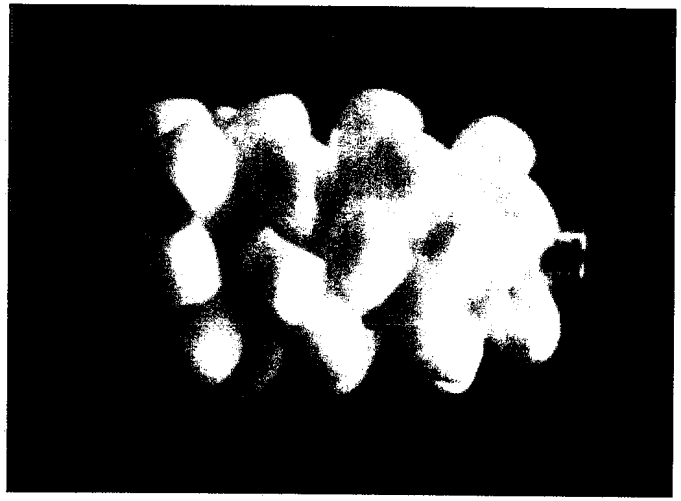
SKy Device After Deployment



Case 1:04-cv-00204-JJF Document 196-11 Filed 04/27/2005 Page 1 of 10

# Kyphon's Balloon vs. Disc-O-Tech's SKy Device







Case 1:04-cv-00204-JJF Document 196-11 Filed 04/27/2005 Page 2 of 10

# The SKy Device Does Not Infringe Kyphon's Patents Under the Doctrine of Equivalents

Because each element is material to defining the scope of the patented invention, a doctrine of equivalents analysis must be applied to individual claim limitations, not to the invention as a whole.

See Warner Jenkinson Co. v. Hilton Davis Chem. Co., 520 U.S. 17, 40 (1997).

One way of determining whether the differences are "insubstantial," is whether the accused product performs substantially the same function as the claim limitation in substantially the same way to achieve substantially the same result.

See Ethicon Endo-Surgery, Inc. v. U.S. Surgical Corp., 149 F.3d 1309, 1315 (Fed. Cir. 1998).



Case 1:04-cv-00204-JJF Document 196-11 Filed 04/27/2005 Page 3 of 10

# Uniform Jury Instructions For Patent Cases In the United States District Court for the District of Delaware

## 3.9 Doctrine of Equivalents

"Application of the doctrine of equivalents is the exception, however, not the rule. Patent claims must be clear enough so that the public has fair notice of what was patented. Notice permits other parties to avoid actions which infringe the patent and to design around the patent. . . ."

See Uniform Jury Instructions for Patent Cases In the United States District Court for the District of Delaware, March 1993 at p. 22



Case 1:04-cv-00204-JJF Document 196-11 Filed 04/27/2005 Page 4 of 10

# SKy Device Does Not Perform Substantially The Same Function With Respect To "Compacting"

- As discussed above, the function of the compacting step of the '888 and '404 Patents is to compact substantially all of the bone marrow away from the central portion of the interior bone volume
- The SKy Device does not perform substantially the same function because of its petal-like structure, which interdigitates with the bone marrow to create a void in bone, but does not "compact" it as recited in the claims



Case 1:04-cv-00204-JJF Document 196-11 Filed 04/27/2005 Page 5 of 10

# The SKy Device Does Not "increase the passage" In Substantially The Same Way As A Balloon

- Critical Differences Under DOE
  - Balloon is Hydraulic; SKy Device is Mechanical
  - Balloon is Compliant and Elastic; SKy Device is Rigid and Non-Compliant
  - Balloon Creates Egg-Shell Void; SKy Device Interdigitates
- Balloon Can Burst; SKy Device Cannot



Case 1:04-cv-00204-JJF Document 196-11 Filed 04/27/2005 Page 6 of 10

Redacted

Redacted

Redacted

Redacted