



Source: Patent, Trademark & Copyright Law Daily: News Archive > 2011 > July > 07/11/2011 > Lead Report > Patents: Fed. Cir. Split for 2nd Time in 2011 on Use Of Patent Specification in Claim Construction

Patents

Fed. Cir. Split for 2nd Time in 2011 on Use Of Patent Specification in Claim Construction

- **Case Summary:** *Becton, Dickinson & Co. is given some relief as an infringement ruling as to one of two of its retractable Integra syringes is reversed.*
- **Key Takeaway:** *The disagreement within the Federal Circuit on the extent to which judges may look to the patent specification to interpret claims continues in another 2-1 decision, with the result the reverse of a February decision on the same topic.*

The split between at least two judges on the U.S. Court of Appeals for the Federal Circuit on claim construction standards was evident once again in a July 8 ruling (*Retractable Technologies Inc. v. Becton, Dickinson & Co.*, Fed. Cir., No. 2010-1402, 7/8/11).

Reversing a lower court's finding of infringement by one of two syringes made by Becton, Dickinson & Co., the 2-1 majority held that use of the phrase "hollow body" in the claims was limited to a one-piece structure based on the disclosure in the asserted patents' specification. The dissent characterized that decision as improperly importing a limitation from the specification.

The judges involved were the same two that split on the same issue—with the decision coming out the other way—earlier this year in *Arlington v. Bridgeport*.

Both Judge Alan D. Lourie and Chief Judge Randall R. Rader, writing the majority and dissenting opinions, respectively, in the instant case, relied on the court's *Phillips* ruling, indicating that contested questions on proper claim construction remain despite that en banc opinion.

The third judge in the *Arlington* case, Judge Kimberly Ann Moore, agreed with Rader's concern for overreliance on the specification. Senior Judge S. Jay Plager, concurring in the instant case, lauded the "fundamental point" made by Lourie not to "allow the claim language to become divorced from what the specification conveys is the invention."

Patents on Retractable Syringes

Becton and Retractable Technologies Inc. compete in the retractable syringe market. The products, which have been marketed since the early 1990s, feature a needle that retracts into the syringe body after use, avoiding accidental sticking by contaminated needles.

Thomas J. Shaw filed an application in 1995 that ultimately led to three patents (5,632,733, 6,090,077, and 7,351,224) now assigned to Retractable. The patents claim a specific retractable syringe. The summary of the invention includes the following description: "The syringe structure features a one piece hollow outer body having a longitudinally extending wall which is stepped. The wall comprises an elongated barrel and nose with a transition zone connecting the barrel and nose."

Retractable sued Becton in the U.S. District Court for the Eastern District of Texas alleging infringement by Becton's Integra syringes. Judge David J. Folsom construed the claims such that, among other findings, the word "body" was not limited to a one-piece structure. Becton's 3 milliliter Integra syringe indisputably does not feature a one-piece body while its 1 milliliter syringe does.

A jury found that the patents were not invalid for anticipation or obviousness and that both Becton syringes infringed.

Becton appealed an evidentiary ruling, the denial of its post-trial motions as to infringement and validity, and the claim construction decisions.

Do Not Divorce Claims From Specification

Judge Alan D. Lourie agreed with the lower court's judgments on all but the construction of the word "body" in the claims. In concluding that the claimed body only applied to one-piece structures, Lourie and Plager reversed the infringement judgment as to the 3 milliliter Integra syringe only.

The court first affirmed the lower court's claim construction decision that a "needle holder" and "retainer member" listed in the claims need not be separately molded pieces, based on a reading of the specification and Shaw's arguments in prosecuting the patents.

However, Lourie said that, while the asserted claims "can be read to imply that a 'body' is not limited to a one-piece structure, that implication is not a strong one," and "none of the claims expressly recite a body that contains multiple pieces."

Lourie then said that the court's latest en banc ruling on claim construction held, "Claim language must always be read in view of the written description." *Phillips v. AWH Corp.*, 415 F.3d 1303, 1315, 75 USPQ2d 1321 (Fed. Cir. 2005) (en banc).

Lourie enhanced that view by reference to a second case decided two weeks prior to *Phillips*. "[A]ny presumption created by the doctrine of claim differentiation 'will be overcome by a contrary construction dictated by the written description or prosecution history,'" quoting *Seachange International Inc. v. C-COR Inc.*, 413 F.3d 1361, 1369, 75 USPQ2d 1385 (Fed. Cir. 2005).

After reviewing the text in the summary section, the detailed description, and the figures, Lourie said, "the specifications do not disclose a body that consists of multiple pieces or indicate that the body is anything other than a one-piece body."

Though he acknowledged "a fine line between construing the claims in light of the specification and improperly importing a limitation from the specification into the claim," Lourie nevertheless characterized *Phillips* as follows: "In reviewing the intrinsic record to construe the claims, we strive to capture the scope of the actual invention, rather than strictly limit the scope of claims to disclosed embodiments or allow the claim language to become divorced from what the specification conveys is the invention."

Concluding that "the specifications tell us" that the claims are limited to one-body structures, he concluded that the district court erred in its construction otherwise.

One Other Construction Affirmed

The majority continued on to a third claim construction challenge, but affirmed the lower court's decision on that judgment.

The question involved whether, in engaging a spring that retracts the needle, Retractable had disclaimed devices that operate by "cutting" a bridge between the needle holder and the retaining member. Becton argued that the specification criticized and distinguished devices that operate by any method other than friction, but the court said, "In general, statements about the difficulties and failures in the prior art, without more, do not act to disclaim claim scope," citing *Spine Solutions Inc. v. Medtronic Sofamor Danek USA Inc.*, 620 F.3d 1305, 1315, 96 USPQ2d 1640 (Fed. Cir. 2010).

Since the specification included an embodiment whereby the bridge portion could be "ruptured, fractured or otherwise separated," the court concluded that "at least some forms of 'cutting' fall within the scope of the invention."

One Becton Syringe Does Not Infringe

The majority then turned from the claim construction issues to the infringement analysis. Since it was undisputed that the 3 milliliter Integra syringe was not a one-piece structure, the majority concluded that it could not directly infringe the patents under the new construction of the word "body." The court said that Retractable could not claim in the alternative infringement under the doctrine of equivalents because the same

parts of specification seen to limit the scope to a one-piece body "expressly distinguished the invention from the prior art based on this feature."

The court therefore reversed the lower court's judgment as to infringement by the 3 milliliter Integra syringe. However, the 1 milliliter syringe included a one-piece body and, since the court affirmed claim construction decisions on all other contested issues, the court also affirmed the infringement judgment as to that syringe.

The court then disposed of Becton's appeal of the evidentiary ruling readily. The issue involved an exclusion of evidence that would have inevitably raised an issue as to Retractable's prior litigation of the patents, and the court concluded that the lower court's decision was not arbitrary or clearly erroneous.

Finally, the court addressed Becton's challenge to the validity of the patents for anticipation or obviousness and again affirmed the lower court. Both analyses turned on contrary expert testimony as to the prior art, and the court ruled that "substantial evidence supports the jury's presumed findings on the factual issues" underlying the validity verdict.

Concurrence Lauds Lourie

In a short concurring opinion, Plager repeated the text from the majority opinion on not divorcing the claims from the specification, and further praised Lourie for his dissent in *Arlington Industries Inc. v. Bridgeport Fittings Inc.*, 632 F.3d 1246, 97 USPQ2d 1811 (Fed. Cir. 2011).

Quoting Lourie's *Arlington* dissent, Plager said, "The specification is the heart of the patent. In colloquial terms, you should get what you disclosed."

"I understand how a perfectly competent trial judge can be persuaded by the siren song of litigation counsel to give the jury wide scope regarding what is claimed," Plager said in conclusion. "But it is a song to which courts should turn a deaf ear if patents are to serve the purposes for which they exist, including the obligation to make full disclosure of what is actually invented, and to claim that and nothing more."

Dissent Looks to Specification in Different Way

In dissent, Rader cited *Phillips* for a different proposition, in which "this court recognized as 'a bedrock principle of patent law' that the claims themselves, not the written description portion of the specification, define the patented invention."

Looking first at the claims only, he said, "The ordinary and customary meaning of 'body' does not inherently contain a one-piece structural limitation."

Rader then applied the doctrine of claim differentiation in noting, for example, that Claim 1 of the '224 patent does not use the "one piece" limitation while dependent Claim 14 reads, "The syringe of claim 1 comprising a one-piece barrel." Essentially determining that "body" and "barrel" were referring to equivalent structures, he concluded that only the "one-piece" limitation was added to the dependent claim, so reading it into the independent claim was improper.

As to the specification, in contrast to the majority's approach, Rader looked for and did not find a "special definition" of the word "body," nor did he find "an intentional disclaimer or disavowal of claim scope by the inventor."

Further, he said, "the inventor's consistent use of the modifier 'one piece' (or 'one-piece') both in the claims and in the written description when he intended to describe a syringe with a one-piece body strongly implies that 'body,' standing alone, does not inherently contain a one-piece structural limitation."

Accordingly, Rader would affirm the lower court on all claim construction decisions and thus affirm as well the 3 mL Integra syringe infringement judgment.

Roy W. Hardin of Lock, Lord, Bissell & Liddell, represented Retractable. Becton was represented by William F. Lee of Wilmer, Cutler, Pickering, Hale, & Dorr, Boston.

By Tony Dutra

Opinion at <http://pub.bna.com/ptcj/101402Jul8.pdf>

Contact us at <http://www.bna.com/contact/index.html> or call 1-800-372-1033

ISSN 1535-1610

Copyright © 2011, The Bureau of National Affairs, Inc.. Reproduction or redistribution, in whole or in part, and in any form, without express written permission, is prohibited except as permitted by the BNA Copyright Policy.

<http://www.bna.com/corp/index.html#V>