



UNIVERSITY OF  
MARYLAND  
SCHOOL OF LAW

**PATENT LAW  
UPDATE**

***Smith &  
Nephew, Inc.***  
v.  
***Ethicon, Inc.***

No. 00-1160  
Federal Circuit  
Dec. 12, 2001

***“A claim is not defective when it states fewer than all of the steps that may be performed in practice of an invention.”***

On December 12, 2001, the Federal Circuit vacated the district court’s summary judgment that Ethicon did not infringe, induce infringement, or contribute to infringement of U.S. Patent No. 5,601,557. The patented technology related to a method of affixing a suture within a bone by inserting a suture anchor having resilient legs into a hole drilled into the bone. The Federal Circuit held that the patent claims neither exclude nor require a surgeon’s tug to assure that the anchor is set within the cancellous bone, and do not preclude a small movement as a result of that tug noted. In so holding, the Federal Circuit disagreed with Ethicon’s assertion that since a pulling step (sometimes called a “tensioning” step) is “necessary” to set the Ethicon anchor, the step of pulling on the anchor must be included in the ‘557 claims in order for the claims to be infringed. Regarding the proper claim construction here, the Federal Circuit noted:

The signal that additional steps may be performed in carrying out a claimed method is the word “comprising.” Our esteemed colleague in dissent criticizes use of the signal “comprising,” calling it a “weasel word” to somehow avoid precision in claiming. This signal nonetheless appears in the vast majority of patent claims, for it implements the principle that claims are intended to provide a concise statement of the claimed invention as distinguished from what has gone before; a claim is not a handbook for practice of the invention. Dr. Hayhurst’s testimony and instructions that any prudent surgeon would test the anchor to assure that it is lodged beneath the cortical layer was not included in any claim. Nor was it required to be claimed. It is neither a “shortcoming” nor a “weaseling” to use “comprising” to recognize that inventions may be practiced with steps in addition to those listed in the claims.

A claim is not defective when it states fewer than all of the steps that may be performed in practice of an invention. Infringement arises when all of the steps of a claimed method are performed, whether or not the infringer also performs additional steps. This court did not hold in *Maxwell v. J. Baker, Inc.*, 86 F.3d 1098, 39 USPQ2d 1001 (Fed. Cir. 1996) that unless all disclosed procedures are included in the claim, the patentee has “dedicated to the public” not only the unclaimed procedures but the entire claimed process. Our colleague in dissent, finding the disputed fact that Ethicon’s method “indisputably requires the ‘tensioning’ step,” proposes that Maxwell requires that by not including the tensioning step in the claims, S&N dedicated to the public any procedure in which that step is included. However, Maxwell does not treat such a situation. The issue in Maxwell was whether equivalent subject matter that was disclosed in the specification but not claimed can be reached under the doctrine of equivalents. There was no issue in Maxwell of literal infringement when every step of the claimed method is in fact practiced by the accused infringer. In Maxwell the accused equivalent subject matter was disclosed in the patent but was plainly outside the scope of the claims. Such a situation is not here presented.