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TECHNOLOGY LAW UPDATE

A report of the latest Federal Circuit updates brought to you by Preston Gates.

Utah Med. Prods., Inc. v. Graphic Controls Corp.

No. 03-1081 (Fed. Cir. Dec. 4, 2003).

“Structure disclosed in the specification is ‘corresponding’ structure only if the specification or prosecution history clearly links or associates that structure to the function recited in the claim.”

On December 4, 2003, the Federal Circuit affirmed the district court’s judgment entering the jury verdict that Graphic Controls infringed U.S. Patent No. 4,785,822, which related to a device for measuring the pressure within a body cavity, as well as the jury’s award of \$20 million in damages. The Federal Circuit also affirmed the district court’s judgment following a bench trial that the ‘822 patent was not invalid for indefiniteness. On the issue of indefiniteness, the Federal Circuit stated:

This court reviews indefiniteness under 35 U.S.C. § 112, paragraph 2, as a question of law without deference. “If the claims read in light of the specification reasonably apprise those skilled in the art of the scope of the invention, § 112 demands no more.” . . .

Even though paragraph six of section 112 allows the use of means-plus-function language in a claim, “one is still subject to the requirement that a claim ‘particularly point out and distinctly claim’ the invention found in the second paragraph of section 112.” The statute permits claims in the abbreviated language of means-plus-function terminology. With regard to that claim format, this court has stated: “Structure disclosed in the specification is ‘corresponding’ structure only if the specification or prosecution history clearly links or associates that structure to the function recited in the claim. This duty to link or associate structure to function is the quid pro quo for the convenience of employing § 112, ¶ 6.”

Graphic Controls asserts, both in the context of claim construction and in the context of invalidity, that because the ‘822 patent specification does not expressly link the function of stiffening to the plastic cable cover, any claim allowing the plastic cable cover to perform that function is indefinite. Graphic Controls argues that the ‘822 patent clearly discloses a plastic cable cover, but does not link that cover to the stiffening function. Therefore, in Graphic Controls’ view, allowing the claims to cover the Softrans® device, which uses the plastic cover to stiffen the device, renders the claim invalid as indefinite, because the patent fails to apprise one of ordinary skill that the plastic cover could serve that function.

The district court properly rejected Graphic Controls’ argument on this issue. The ‘822 patent discloses a plastic cable cover. The ‘822 patent does not disclose the structure utilized by the Softrans® device to provide rigidity -- a hard plastic, dual-lumen cable cover. The district court did not construe claim 1 of the ‘822 patent to allow a structure disclosed in the specification, but not linked to the function at issue, to perform the stiffening function. The simple plastic cover disclosed in the patent was not the equivalent to the steel stylet. Rather, the equivalent found by the jury featured a hardened plastic extruded in a specific geometry. The jury determined that this specific structure, not merely a simple plastic cable cover, performed the stiffening function. In other words, the cable cover of Graphic Controls’ accused device contains additional structure beyond the cable cover disclosed in the ‘822 patent. Therefore, the district court correctly discerned that the patent adequately informs one of skill in this art that a separate, permanent component of the electrical cable means, namely a hardened plastic in a specific rigid geometry, could perform the stiffening function. This court affirms the district court’s holding that claim 1 of the ‘822 patent is not invalid for indefiniteness.