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TECHNOLOGY LAW UPDATE

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

C.R. Bard, Inc. v. United States Surgical Corp.

No. 04-1135 (Fed. Cir. Oct. 29, 2004)

“[M]erely rephrasing or paraphrasing the plain language of a claim by substituting synonyms does not represent genuine claim construction.”

On October 29, 2004, the Federal Circuit affirmed the district court’s judgment following a jury trial that U.S. Surgical did not infringe U.S. Patent No. 5,356,432, which related to hernia repair. The Federal Circuit stated:

[T]he intrinsic record is the primary source for determining claim meaning. The intrinsic record includes the specification and the prosecution history. Under this approach to claim construction, evidence extrinsic to the patent document “can shed useful light on the relevant art,” but is less significant than the intrinsic record in determining the “legally operative meaning of disputed claim language.” [E]xtrinsic evidence cannot alter any claim meaning discernible from intrinsic evidence. [Some recent cases, however, have suggested] that the intrinsic record, except for the claims, should be consulted only after the ordinary and customary meaning of claim terms to persons skilled in the pertinent art is determined. The language in these cases emphasizes technical and general-usage dictionaries in determining the ordinary meaning. Under this approach, where the ordinary meaning of a claim term is thus evident, the inventor’s written description of the invention, for example, is relevant and controlling insofar as it provides clear lexicography or disavowal of the ordinary meaning. [But these cases] do not require, or even allow, the Court to disregard the intrinsic record. Instead, these cases merely suggest a methodology that emphasizes the use of dictionaries and claim that if courts adopt this methodology, claim terms “will be more accurately determined” and improperly narrow constructions “will be more easily avoided.”

[W]e conclude that the district court’s claim construction must be affirmed under either methodology offered by the parties Bard argues that the ordinary and customary meanings of the terms “conformable” and “pliable” do not require pleating. Bard proffers general-usage dictionary definitions for the terms “conformable” and “pliable.” One representative definition of the term “conformable” is “corresponding; similar.” A definition from the same dictionary for the term “pliable” is “easily bent,” with synonyms including “flexible” and “supple.” Bard’s dictionary definitions are largely unhelpful. [T]he ordinary and customary meaning of a term does not govern if the intrinsic record contains clear lexicography or disavowal of claim scope. Because we conclude below that the intrinsic record demonstrates that the plug in claim 20 must be pleated, the ordinary and customary definitions of “conformable” and “pliable” are not controlling. Second, because claim scope in this case turns most directly on the term “plug,” the proffered dictionary definitions of “conformable” and “pliable” are largely inapposite. Finally, we question the need to consult a dictionary to determine the meaning of such well-known terms. [Courts] regularly forgo detailed dictionary analyses if the term is as commonplace as “conformable” or “pliable.” Indeed, Bard itself “submits that merely rephrasing or paraphrasing the plain language of a claim by substituting synonyms does not represent genuine claim construction.” . . .

Although the statements in the specification suffice by themselves to demonstrate that the plug in claim 20 must be pleated, we also consider the prosecution history of the ‘432 patent, which confirms the analysis of the specification. . . . Bard made a number of arguments distinguishing the prior art on the basis that the prior art did not disclose a pleated plug. . . . But in the only response in which claims 19 and 20 alone were considered, Bard made a clear statement to the examiner that “the surface of the inventive plug is pleated.” . . . Accordingly, the prosecution history provides an independent ground for construing claim 20 as requiring a plug with a pleated surface.