



TECHNOLOGY LAW UPDATE

Norian Corp.
v.
Stryker Corp.

No. 05-1172

Federal Circuit
Dec. 6, 2005

[T]here is no principle of patent law that the scope of a surrender of subject matter during prosecution is limited to what is absolutely necessary to avoid a prior art reference that was the basis for an examiner's rejection.

**Schwartz
Sung &
Webster**

*an intellectual property
law firm*

On December 6, 2005, the Federal Circuit affirmed the district court's summary judgment that Stryker did not infringe U.S. Patent No. 6,002,065, which related to calcium phosphate compositions used as bone cements in medical or dental procedures. The Federal Circuit stated:

Norian argues that its claims read on any solution made from a single sodium phosphate as well as any solution made from a combination of different sodium phosphates [because] after any sodium phosphate salt goes into solution, [it] dissolves into dissociated sodium ions and phosphate ions in water. Therefore, according to Norian, the reference to "a sodium phosphate" in a water solution can only mean a solution containing sodium ions and phosphate ions, which solution will be produced when any one or more types of sodium phosphates are added to water. The problem with that argument is that it runs afoul of the language and the prosecution history of the '065 patent. In the claim language, the specification, and the prosecution history, the patentee described the claimed solution by reference to the substances used to make it – solutes that include a variety of different types of sodium phosphates. The patentee could have chosen to claim the solution as "a sodium phosphate solution," [or] as a solution consisting of "at least one sodium phosphate." Instead, the patentee departed from those formulations and chose to recite a solution consisting of water and "a sodium phosphate."

[N]orian's second argument is that the prosecution history cannot be read as broadly as the district court read it. Norian explains that the amendment in question (i.e., amending the language from "a sodium phosphate solution" to "a solution consisting of water and a sodium phosphate") was made in response to a prior art patent to Iwamoto, which disclosed a colloidal setting solution, rather than a pure solution containing no suspended particles. Because the sole purpose of the amendment was to avoid the effect of the Iwamoto reference, Norian argues, the prosecution history should not be interpreted as disclaiming pure solutions that are made from more than a single solute. [But there] is no principle of patent law that the scope of a surrender of subject matter during prosecution is limited to what is absolutely necessary to avoid a prior art reference that was the basis for an examiner's rejection. To the contrary, it frequently happens that patentees surrender more through amendment than may have been absolutely necessary to avoid particular prior art. [N]orian surrendered all sodium phosphate solutions made from more than a single solute, i.e., a single type of sodium phosphate.

Norian's third argument is that by defining the solution of the asserted claims in terms of the ingredients used to make the solution, rather than in terms of the ions found in the solution after it was made, the court has improperly converted what was meant to be a product claim into a product-by-process claim, without applying the legal principles applicable to such claims. We disagree. All that the district court has done is to conclude that the patentee characterized the solution in terms of the components put into it, which the evidence before the court (including the specification) showed to be a conventional means of describing a solution. Because the patentee chose to describe the solution in that fashion, the claims remained product claims, but their scope was limited to the designated ingredients from which the claimed solution was made.