

Keywords: infringement; claim construction; recapture rule; reissue; 35 U.S.C. §251

General: Essential element of an invention cannot be read into claims without a textual reference for support; Recapture rule is a separate issue from claim construction and should not be used to rewrite claim language to preserve validity

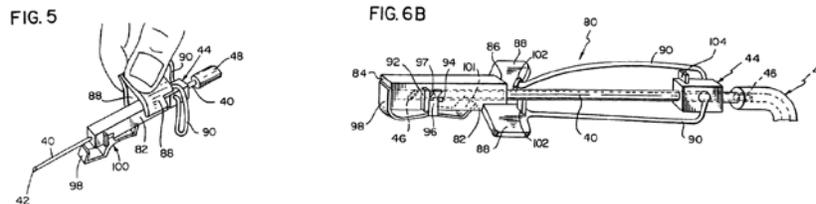
MBO Laboratories, Inc. v. Becton Dickinson & Company

__ F.3d __ (Fed. Cir. 2007)

Decided January 27, 2007

I. Facts

MBO filed suit against Becton, asserting infringement of claims 13, 19, 20, 27, 28, 32 and 33 of U.S. Patent No. RE 36,885 (the '885 patent). Claims 27, 28, 32, and 33 were added during the reissue procedure. The '885 patent relates to an design for a hypodermic safety syringe to ensure that health care workers are not inadvertently stuck with the needle after drawing blood or injection. The '885 patent has the needle or cannula of the syringe mounted inside a guard sleeve. After the needle is removed, the health care worker slides the needle back and a blocking flange on the guard moves vertically down in relation to the guard and covers the tip of the needle.

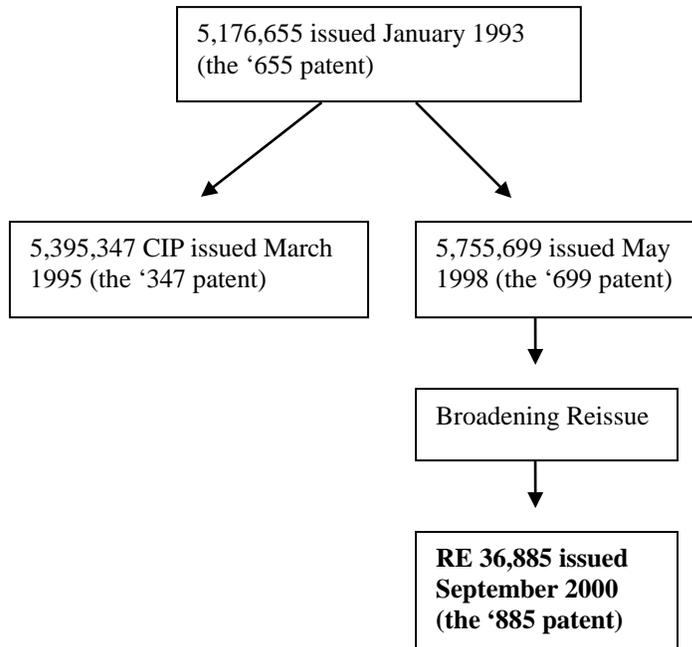


The district court conducted a Markman hearing in which the parties disputed a number of terms that appeared in some or all of the claims. The disputed claim terms were “immediately,” “relative movement,” “slidably receiving,” “adjacent,” “proximity,” and “mounted on said body.” The term “immediately” appears only in the preamble of claims 13, 19, and 20. The district court construed the claim terms as follows:

- “immediately” – “simultaneously with the needle’s withdrawal from the donor”; the district court applied this limitation to claims 32 and 33, even though this term does not appear in those claims
- “relatively moved” and “slidably received” – the needle must move backward relative to a stationary guard (as opposed to the guard moving relative to a stationary needle)
- “adjacent” – the flange must be “contiguous or connected with the front surface of the body”
- “proximity and immediate proximity” – the needle tip must be “flush with” the front of the body when the blocking flange is released
- “mounted on said body” – the flange must be “attached to the exterior surface of the body”

Based on the district court’s claim construction, MBO agreed that there would be no infringement and did not contest Becton’s SJ motion. MBO appealed the claim construction by the district court.

Prosecution History:



In the broadening reissue, the patentee argued that they were entitled to cover a system having “any relative movement between the needle and the body,” not just the needle moving towards the safety device.

II. Issues

Was the district court’s claim construction correct?

III. Discussion

Yes, with regard to “immediately” as applied to those claims in which “immediately” appeared in the preamble. No, as to all other claim terms. The Federal Circuit reiterated that claim construction is reviewed *de novo*, and went through a Phillips analysis of the evidence available for claim construction, noting that the most relevant source is the patent specification, followed by the prosecution history, and finally extrinsic evidence which may be “helpful” but is less important than the intrinsic record.

“Immediately” – The Federal Circuit agreed with the district court’s construction of the term “immediately,” but disagreed with the application to those claims that do not include the term. Looking to the Summary of the Invention in the specification for the construction, the court determined that nowhere in specification does the patent support making the needle safe at any time other than when removed the patient. The court also looked to the prosecution of the ‘347 patent and the patentee’s argument over prior art that stressed that the needle is made instantly safe upon removal from the patient.

With regard to application of the term “immediately” to claims 32 and 33 (which do not contain the term “immediately”), the court found that although simultaneously making the needle safe upon removal from the patient was an essential element of the invention, **they cannot endorse a construction analysis that does not identify “textual reference in the actual language of the claim with which to associate a**

proffered claim construction.” The court noted that they lack the power to construe those terms not disputed by the parties, and also did not limit claims 32 and 33 to the “simultaneous-safety” requirement.

“Relative Movement” and Slidably Receiving” – As these terms were added during the broadening reissue, the Federal Circuit began with a discussion of the recapture rule. The recapture rule prevents material which has been surrendered from being reclaimed during the reissue proceeding. The court noted that the recapture rule and prosecution history estoppel both operate to prevent a patentee from reclaiming territory that has already been surrendered to the public.

In applying the recapture rule, the Federal Circuit stated that “[i]n operation, the recapture rule excludes earlier deliberate withdrawals and amendments from the allowable scope of a reissue patent.” The court also stepped through the recapture analysis: (1) “the original and reissued claims are construed to ascertain ‘whether and in what aspect the reissue claims are broader than the patent claims’; and (2) “if the reissue claims are broader in some way, the court must determine ‘whether the broader aspects of the reissue claims relate to the surrendered subject matter.’”

The court found that the district court erred in application of the recapture rule to rewrite the claims. The court stated that “validity construction should be used as a last resort, not a first principle...Construction of the claims here is not so difficult a problem as to require resort to the validity maxim.” As MBO’s intent was to broaden the claim and cover the expanded claim terms, the claims should be given that construction. The court noted that “[w]hether those broadened claims are invalidated by the recapture rule is an issue separate from construction. In the narrowly limited appellate posture of this case, only the question of infringement, not validity, is before us.” In footnote 3, the court also noted that the recapture rule may play a part in claim construction in those situations in which the only way to resolve two multiple interpretations of a reissue claim is to select the interpretation not barred by the recapture rule.

Finally, looking to the figures for further support, the Federal Circuit disagreed with the district court’s claim construction and found that “relatively moved” and slidably receiving” allows the needle and guard to slide “in any manner.”

“Adjacent” – The Federal Circuit found that the district court’s claim construction would exclude two preferred embodiments from the scope of the claim, and such a construction is “rarely, if ever correct.” Thus, the court found the proper construction of “adjacent” is “next to.”

“Proximity” – The Federal Circuit found the district court’s construction of this term too narrow, as it would also exclude some embodiments depicted in the patent. The court ruled the proper construction of the term is “near.”

“Mounted on Said Body” – The Federal Circuit found that the district incorrectly limited the patent’s scope to those depictions in the figures, wherein the flange must be attached to the “exterior” of the body. This construction incorrectly imports limitations from the specification into the claim, and “limiting claims from the specification is generally not permitted absent a clear disclosure that the patentee intended the claims to be limited as shown.” Therefore, the court ruled the proper construction of “Mounted on Said Body” is “attached to said body.”

The Court affirmed the district court’s construction of “immediately” except for claims 32 and 33, which it reversed, reversed the claim construction of the other disputed terms, vacated the judgment, and remanded for further proceedings consistent with the opinion.