United States District Court,
S.D. Ohio, Eastern Division.

William P. YOUNG,
Plaintiff.
v.
LUMENIS, INC,
Defendant.

No. 2:03-cv-655

Nov. 1, 2005.

Jason H. Foster, Kremblas Foster Phillips & Pollick, Reynoldsburg, OH, Richard W. Hoffmann, Reising, Ethington, Barnes, Kisselle, PC, Troy, MI, for Plaintiff.

C. Craig Woods, Squire Sanders & Dempsey, Columbus, OH, A. Jason Mirabito, Dean G. Bostock, George W. Price, Paul J. Hayes, Mintz, Levin, Cohn, Ferris, Glovsky and Popeo, P.C., Boston, MA, Michael J. Pospis, Moses & Singer LLP, New York, NY, P. Brian See, Chicago, IL, for Defendant.

OPINION AND ORDER

ALGENON L. MARBLEY**, District Judge.**

I. INTRODUCTION

This matter comes to this Court on simultaneous briefs filed by the parties in preparation for a *Markman* hearing. Defendant asks this Court to find the patent-in-suit indefinite as a matter of law under 35 U.S.C. s. 112 para. 2, arguing that the disputed terms are insolubly ambiguous. Based on the evidence presented at the hearing and the applicable law, the Court **GRANTS in part** and **DENIES in part** Defendant's request.

II. FACTS AND PROCEDURAL HISTORY

Plaintiff, a veterinarian, has obtained a patent for a cat declaw method using a laser. On January 7, 2003 The United States Patent and Trademark Office ("PTO") awarded Plaintiff U.S. Patent No. 6,502,579 (the "'579 patent"), entitled "Laser Onychectomy by Resection of the Redundant Epithelium of the Ungual Crest." According to Plaintiff, the patented procedure is unique because it leaves a substantial portion of tissue to cover the exposed tip of the second phalanx, thereby eliminating the need for surgical closure, decreasing risk of infection and facilitating the healing process.

In a Complaint filed on July 23, 2003, Plaintiff sought preliminary and permanent injunctions, damages, and attorney's fees based on Defendant, Lumenis Inc.'s, alleged infringement of the '579 patent. Defendant is an international manufacturer, seller, and distributor of, among other things, surgical laser instruments, which may be used to perform Plaintiff's patented surgical procedure. According to Plaintiff, Lumenis had been

teaching veterinarians to perform the patented procedure in connection with its sales efforts.

By Opinion and Order dated January 26, 2004, the Court granted Plaintiff's Motion for a Preliminary Injunction. Finding that Defendant had not raised a substantial question as to the patent's validity and that Plaintiff had a reasonable likelihood of success on the merits of his infringement claim, the Court enjoined Defendant and anyone acting in concert with Defendant from teaching, performing, or practicing the patented procedure and from distributing any materials that teach or illustrate the procedure.

On October 19, 2004, this Court found that neither Young nor his attorney, Jason Foster, engaged in any inequitable conduct before the PTO. The parties then filed briefs for a *Markman* hearing, which this Court held on March 1, 2005. Both in the papers and at oral argument, the parties focused extensively on Defendant's claim that the '579 patent is invalid for indefiniteness. The parties have filed post-hearing briefs and the matter is now ripe for disposition.

III. STANDARD OF REVIEW

Patent infringement analysis involves two steps. First, the court determines the patent claims' proper construction "to define the scope of the patented invention." Vitronics Corp. v. Conceptronic, Inc., 90 F.3d 1576, 1582 (Fed.Cir.1996). Then, the trier of fact compares the properly construed claims to the allegedly infringing action to determine if infringement occurred. Markman v. Westview Instruments, Inc., 52 F.3d 967, 976 (Fed.Cir.1995) (en banc), *aff'd,* 517 U.S. 370, 384-85, 116 S.Ct. 1384, 134 L.Ed.2d 577 (1996).

Where there is an allegation of indefiniteness, the court looks to the patent's claims to see whether they meet 35 U.S.C. 112 para. 2, which reads: "The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention." *Id*. The "purpose of the definiteness requirement is to ensure that the claims delineate the scope of the invention using language that adequately notifies the public of the patentee's right to exclude." Datamize, LLC v. Plumtree Software, Inc., 417 F.3d 1342, 1347 (Fed.Cir.2005) (citing Honeywell Int'l, Inc. v. Int'l Trade Comm'n, 341 F.3d 1332, 1338 (Fed.Cir.2003)). The definiteness requirement "does not compel absolute clarity." Datamize, 417 F.3d at 1347. Indeed, an issued patent is presumed to be valid and "the evidentiary burden to show facts supporting a conclusion of invalidity is clear and convincing evidence." Oakley, Inc. v. Sunglass Hut Int'l., 316 F.3d 1331, 1339 (Fed.Cir.2003) (citing WMS Gaming Inc. v. Int'l Game Tech., 184 F.3d 1339, 1355 (Fed.Cir.1999)). A claim is only indefinite if it is "not amenable to construction" or "insolubly ambiguous." Honeywell Int'l, 341 F.3d at 1338; *see also* Exxon Research & Eng'g Co. v. United States, 265 F.3d 1371, 1375 (Fed.Cir.2001). Thus, "[i]f the meaning of the claim is discernible, even though the task may be formidable and the conclusion may be one over which reasonable persons will disagree, we have held the claim sufficiently clear to avoid invalidity on indefiniteness grounds." Exxon Research, 265 F.3d at 1375.

When considering an allegation of indefiniteness, "general principles of claim construction apply." Datamize, 417 F.3d at 1348; *see also* Oakley, Inc., 316 F.3d at 1340 (finding a determination of indefiniteness "requires a construction of the claims according to the familiar canons of claim construction"). In construing claims, words "are generally given their ordinary and customary meaning." Vitronics Corp., 90 F.3d at 1582. Ordinary and customary meaning "is the meaning that the term would have to a person of ordinary skill in the art in question at the time of the invention." *See* Innova/Pure Water, Inc. v. Safari Water Filtration Sys., Inc., 381 F.3d 1111, 1116 (Fed.Cir.2004). The Federal Circuit recently clarified the preferred way to determine how a person of ordinary skill in the art understands a claim term.

See Phillips v. AWH Corp., 415 F.2d 1303 (Fed.Cir.2005) (en banc). In *Phillips,* the court disapproved of what it characterized as an over-reliance on dictionaries and other extrinsic evidence. *Id.* at 1319-21. Rather, the court suggested that the proper approach to construing claims requires courts to turn first to the intrinsic evidence. *Id.* at 1314-15. Specifically, the *Phillips* court looked to the claims themselves, including the language used therein and the context in which the word in question appeared. *Id.* Then, the court analyzed the specification, which is a written description of the claims, emphasizing that the specification is "the single best guide to the meaning of a disputed term." *Id.* at 1315. Finally, the court recommended turning to the prosecution history, if any, for guidance on claim construction. *Id.*

In voicing its preference for intrinsic as opposed to extrinsic evidence, such as dictionaries, treatises and expert testimony, the court questioned the reliability of the extrinsic evidence because it was not created at the time of the patent, it may have been generated for litigation purposes only, and its use leaves the court "with the considerable task of filtering the useful extrinsic evidence from the fluff." *Id.* at 1318. The court, however, took pains to preserve the district court's ability to rely on extrinsic evidence, noting, that such evidence may be helpful in certain situations: "[E]xtrinsic evidence can help educate the court regarding the field of the invention and can help the court determine what a person of ordinary skill in the art would understand claim terms to mean." *Id.* at 1319. A district court, however, in exercising its discretion to use extrinsic evidence must "keep in mind the flaws inherent in each type of evidence and assess that evidence accordingly." *Id.*

IV. ANALYSIS

The patent consists of two independent claims: Claims 1 and 6. Claims 2 through 5 are dependent on Claim 1.

A. Claim 1

Claim 1 reads as follows:

A feline onychectomy surgical method using a laser cutting instrument, the method comprising:

(a) forming a first circumferential incision in the epidermis near the edge of the ungual crest of the claw, thereby severing at least some of the epidermis from the ungual crest;

(b) applying cranial traction to the epidermis severed from the ungual crest to displace the distal edge of the epithelium cranially;

(c) incising the extensor tendon near its insertion on the ungual crest;

(d) incising the synovium of the PII-PIII joint;

(e) applying traction to the claw in the palmar direction for disarticulating the PII-PIII joint;

(f) ablating the medial and lateral collateral ligaments;

(g) incising the digital flexor tendon; and

(h) incising the subcutaneous tissues of the pad of the second phalanx.

Defendant argues that Claim 1 is invalid for indefiniteness because it is indistinguishable from the prior art and thus, cannot apprise one skilled in the relevant field of the scope of the invention. Specifically, Defendant argues that Step (a), which instructs the surgeon to form the "first circumferential incision in the epidermis near the edge of the ungual crest of the claw," contains a word of degree, "near," which the specification leaves unexplained. Defendant asserts that a surgeon attempting to begin a declaw procedure using any dissection method would be unable to avoid infringement because dissection procedures, long before Plaintiff received his patent, began the first incision "near" the ungual crest.

It is well-settled law that words of degree are permissible "when serving reasonably to describe the claimed subject matter to those of skill in the field of the invention" and when they "distinguish the claimed subject matter from the prior art." *Andrew Corp.,* 847 F.2d at 822; *see also* Hybritech Inc. v. Monoclonal Antibodies, Inc., 802 F.2d 1367, 1385 (Fed.Cir.1986) ("[T]he claims, read in light of the specification, reasonably apprise those skilled in the art and are as precise as the subject matter permits. As a matter of law, no court can demand more.") (citing Shatterproof Glass Corp. v. Libbey-Owens Ford Co., 758 F.2d 613, 624 (Fed.Cir.1985)). In Amgen, Inc. v. Chugai Pharm. Co., Ltd., 927 F.2d 1200, 1218 (Fed.Cir.1991), the court found a claim indefinite because the following words of degree failed to inform the public of the patent's bounds:

4. Homogeneous erythropoietin characterized by a molecular weight of about 34,000 daltons on SDS PAGE, movement as a single peak on reverse phase high performance liquid chromatography and a specific activity of at least *about 160, 000 IU* [international units] per absorbance unit at 280 nanometers. FN1

FN1. Erythropoietin (EPO) is a protein consisting of 165 amino acids that is used to stimulate the production of red blood cells. Medical professionals use it to treat anemias or blood disorders characterized by low red blood cell counts. Amgen, Inc. v. Chugai Pharm. Co., Ltd., 927 F.2d 1200, 1203 (Fed.Cir.1991). EPO is created "through the concentration and purification of urine from both healthy individuals and those exhibiting high EPO levels." *Id.*

Id. at 1203 (emphasis added). The court found the phrase "about 160,000 IU" indefinite because the range of measurement encompassed by the term "about" anticipated a measurement of as low as 120,000 IU, which had already been described in the prior art. The court explained that such wording "served neither to distinguish the invention over close prior art ... nor ... permit [ted] one to know what specific activity values below 160,000, if any, might constitute infringement." *Id.* at 1217. Moreover, a physician-inventor behind the patent was unable to define "about" 160,000, stating only that he had not "given a lot of direct considerations to that." *Id.* The court held: "When the meaning of the claims is in doubt, especially when, as is the case here, there is close prior art, they are properly declared invalid." *Id.* (citing Standard Oil Co. v. American Cyanamid Co., 774 F.2d 448, 453 (Fed.Cir.1985)).

Applying *Amgen* to Claim 1, Step (a), the Court finds the word "near" indefinite, pursuant to 35 U.S.C. s. 112 para. 2, for failing to distinguish the claimed subject matter from the prior art. Defendant has convinced this Court, by clear and convincing evidence, that a veterinary surgeon attempting to avoid infringement would be unable to do so because "near" fails to distinguish Plaintiff's patent from prior art. Plaintiff's attempts to distinguish the phrase "forming a first circumferential incision in the epidermis near the edge of the ungual crest of the claw" from the prior art are without merit. He argues that all prior art instructs surgeons to cut straight through the PII-PIII articulation, which means the point at which the two joints

meet, rather than making the first incision at a point near the edge of the ungual crest. For example, during his February 15, 2005 deposition, Dr. Young testified that his procedure was distinguishable from that outlined in a well-established textbook. *See* THERESA WELCH FOSSUM ET AL., SMALL ANIMAL SURGERY 145-47 (1997) (hereinafter the "Fossum Reference"). In response to defense counsel's questions, Dr. Young testified as follows:

Q: And in your opinion, these previous techniques [referencing use of a scalpel, nail clippers, scissors, or electrocautery] did the incision at the PII-PIII joint?

A: Without fail.

* * *

Q: And in your view, scalpel technique [taught in Fossum] is different than the laser technique?

A: Yes

Q: Why is that?

A: In my laser technique, they're a lot different.

Q: Okay. Tell me.

A: In Fossum's scalpel technique?

Q: Sure.

A: Fossum's scalpel technique is a straight PII-PIII amputation.

Young Dep. II. at 30-32. FN2

FN2. Dr. Young testified similarly during the September 7-8, 2004 Inequitable Conduct Hearing: [E]very incision in Fossum, every incision in Slatter, ever incision in the Luxar reference is done in the plane of the PII-PIII joint. They may attack it from different angles, they may come through this way, they may come through that way, but in essence they only cut through PII-PIII. There is no cut at any time made outside the plane in that joint.

Inequitable Conduct Hearing Transcript at II-74 (hereinafter "Inequitable Conduct Tr.").
Defendant, however, proved by clear and convincing evidence that the Fossum Reference instructs a surgeon to make the incision at essentially the same point described in the '579 patent. The Fossum Reference, in a chapter written by Dr. Cheryl S. Hedlund, Ph.D., reads: "Circumferentially incise the hairless, cuticle-like skin away from the claw near the articulation between the second and third phalanx." Id. at 146. Dr. Hedlund testified that she has always instructed her students, both in veterinary school and in her textbook chapter, to make the first incision circumferentially "at the most distal aspect of the nonhaired skin." Hedlund Dep. at 20. Specifically, Dr. Hedlund stated: "I insert the Number 11 scalpel blade parallel with the claw where the cuticle like skin attaches to the claw. So it goes around at that point. That's where

the ... circumferential incision is made when I direct the declaw." Id. at 64. FN3

FN3. Although the Fossum Reference mentions a scalpel as opposed to a laser, the Court finds the difference nominal. Dennis Olsen, DVM, a veterinarian who testified on behalf of Defendant, testified that the declaw process was "essentially identical" whether a surgeon uses a laser or a scalpel. Inequitable Conduct Tr. at I-72. He also explained that the increased use of lasers is a reflection of their decline in price over time. *Olsen Supp. Decl.* at para. 23. ("When the price of lasers dropped in the late 1980's and early 1990's, veterinarians began to use them to perform surgery ....").

In light of this strikingly similar prior art, the Court does not see how the first step in Claim 1 of the '579 patent adequately delineates the scope of the invention. Even Dr. Young, on cross-examination, admitted that he was unable to discern what constituted "near the most distal edge of the ungual crest." *Markman* Hearing Transcript at 86 (hereinafter "Mkmn. Tr.").

Alternatively, Dr. Young asserts that his patent is distinguishable from the prior art if the surgeon intends to, or does, save enough skin to cover the wound. FN4 This argument fails, however, because infringement cannot depend on another's intent; rather, a patent's claims must be clear enough so that an objective person skilled in the art would be able to determine the patent's scope. *See* Hilton Davis Chem. Co. v. Warner-Jenkinson Co. ., Inc. 62 F.3d 1512, 1519 (Fed.Cir.1995) (en banc), *rev'd on other grounds,* 520 U.S. 17, 117 S.Ct. 1040, 137 L.Ed.2d 146 (1997) ("This question [of infringement] is one irrespective of motive. The defendant may have infringed without intending, or even knowing it; but he is not, on that account, the less an infringer.... [T]he immediate question is the simple one, has he infringed?") (citation omitted). Thus, Claim 1, Step (a) is invalid for indefiniteness because Defendant has proved by clear and convincing evidence that it would be impossible for someone skilled in the art to determine the meaning of "near: so as to avoid infringement. FN5

FN4. Dr. Young testified as follows during his February 15, 2005 deposition:
Q: Your view is that your claims are infringed if a person intends to use the tissue to cover the surgical site for a feline declaw as long as the incision is not make through the joint?
A: And it's sufficient, it is of sufficient nature to cover the declaw site, I think that is pretty clear.

Young Dep. II. at 332.
FN5. Defendant's papers contain extensive and persuasive arguments that Claim 1's remaining steps are indistinguishable from the prior art and thus, not valid. This argument, however, concerns the obviousness of the patent, not the construction of its claims. Because the patent's obviousness has been neither fully briefed nor argued in this Court, the Court will not now resolve that issue.

Because Claims 2 through 5 are dependent on Claim 1, they are similarly invalid for indefiniteness. Datamize, LLC, 417 F.3d at 1347 ("Since claim 1 is the '137 patent's sole independent claim, the court's grant of summary judgment of indefiniteness as to claim 1 invalidated each claim in the '137 patent."). The Court now turns Claim 6, the only remaining independent claim.

B. CLAIM 6

Claim 6 reads:

A feline onychectomy surgical method using a laser cutting instrument, the method comprising:

(a) forming a first circumferential incision with the laser in the epidermis at the edge of the ungual crest of the feline's claw, thereby severing at least some of the epidermis from the ungual crest; and then

(b) applying cranial traction to the epidermis severed from the ungual crest to displace the distal edge of the epidermis cranially; and then

(c) Forming a second circumferential incision in the epidermis about 3 millimeters cranial to the first circumferential incision, thereby severing at least some of the subcutaneous fascia from the ungual crest; and then

(d) Incising the extensor tendon near its insertion on the ungual crest by directing the laser beam in a substantially palmar direction from a laser beam source positioned substantially dorsally of the extensor tendon; and then

(e) incising the synovium of the PII-PIII joint; and then

(f) applying traction to the claw in the palmar direction for disarticulating the PII-PIII joint; and then

(g) ablating the medial and lateral collateral ligaments by directing the laser beam in a substantially palmar direction from the source positioned substantially dorsally of the ligaments; and then

(h) incising the digital flexor tendon by directing the laser beam in a substantially palmar direction from the source positioned substantially dorsally of the flexor tendon; and then

(i) incising the subcutaneous tissues of the pad of the second phalanx by directing the laser beam in a substantially palmar direction from the source positioned substantially dorsally of the flexor tendon; and then

(j) applying palmar traction to the epidermis severed from the ungual crest for covering the onychectomy site.

1. Claim 6, Step (a)

Defendant asserts that Step (a) must fail because "at the edge of the ungual crest" is indefinite in light of the prior art. The Court disagrees. Claim 6 requires the first incision to be made "*at* the edge of the ungual crest," not "*near* the edge of the ungual crest." It was the indefiniteness of word "near" in Claim 1(a) that failed to differentiate the '579 patent from prior art. Unlike the word "near," the word "at" is certainly as definite as the subject matter permits as it instructs the surgeon to incise at one point only: *at* the edge of the ungual crest.

Defendant then argues that the phrase "at the edge of the ungual crest" is indefinite because the ungual crest is not visible to the surgeon. Defendant's proffered evidence on this point is not ultimately persuasive. At oral argument, Plaintiff credibly testified that one skilled in the art of veterinary surgery would be able to

discern the edge of the ungual crest by touch. In light of this testimony and Defendant's failure to prove conclusively otherwise, the Court finds Claim 6, Step (a) not indefinite for its use of the word "at."

2. Claim 6, Step (b)

Claim 6, Step (b) reads: "applying cranial traction to the epidermis severed from the ungual crest to displace the distal edge of the epidermis cranially ...." Defendant argues that the words "cranial" and "cranially" render this step indefinite. Although both parties agree that the definition of "cranial" is "towards the animal's head," Defendant asserts that the word can only be used to describe any action occurring *above* a cat's carpus, which is the group of joints in each leg of a cat that allows the cat to walk with its paws flexed. FN6 Here, Defendant argues, the word describes actions occurring *below* the cat's carpus; thereby rendering Step (b) insolubly ambiguous because one skilled in the relevant art would not understand in which direction to pull the incised skin. Plaintiff counters that Defendant's expert, while disagreeing with the way in which the ' 579 patent uses the word "cranial," had no trouble understanding its meaning. Moreover, Plaintiff notes that the word's meaning is made clear by Figure 2, which uses an arrow, labeled T, to depict the "cranial" direction in which the surgeon must pull the skin.

FN6. It is often analogized to the human wrist. *Olsen Decl*. at para. 16.

Plaintiff's argument is well-taken. It is well-established that only claims "not amenable to construction" or "insolubly ambiguous" are indefinite. *See* Novo Indus., L.P. v. Micro Molds Corp., 350 F.3d 1348, 1353 (Fed.Cir.2003); Honeywell Int'l, 341 F.3d at 1338. Here, Defendant's experts Dennis Olsen, DMV, although intending to disagree with Plaintiff's use of the word, ultimately demonstrated the ease with which it can be construed by noting, in his declaration, that "[c]ranial means towards the animal's head." *See Olsen Decl*. at para. 15. *See* Rosemount, Inc. v. Beckman Instruments, Inc., 727 F.2d 1540, 1547 (Fed.Cir.1984) (finding an indefiniteness argument undermined by the defendant's "own ease in applying "close proximity" ... in its briefs here, [and] its own witness' statement that he had no trouble understanding the claims of the '525 patent ..."). In sum, the Court finds that one skilled in the art would understand the meaning of the word "cranial" when read in light of the specification. *Id*. FN7

FN7. With regard to Defendant's objection to Plaintiff's use of the word "cranial" in Claim 6(c), the Court reaches the same conclusion.

3. Claim 6, Step (c)

Step (c) reads: "Forming a second circumferential incision in the epidermis about 3 millimeters cranial to the first circumferential incision, thereby severing at least some of the subcutaneous fascia from the ungual crest ...." Defendant argues that Step (c) is invalid for indefiniteness in two ways.

First, Defendant asserts that the phrase "about three millimeters" provides no instruction to those skilled in the art and is thus indefinite. Defendant relies primarily on In re Oetiker, 23 U.S.P.Q.2d 1641 (Bd.Pat.App.1990) (finding indefinite the phrase "length on the order of 5 mm" to describe leg portions of a patent), and In re Brummer, 12 U.S.P.Q.2d 1653, at (Bd.Pat.App.1989) (holding patent claims to a bicycle seat indefinite because the seat's measurements were based on a percentage of the rider's height and weight, reasoning "the same bicycle might fall within this language ... when ridden by a rider or one combination of weight and build, but not when ridden by a rider of another"). Plaintiff, pointing to the specification, argues

that this terminology has a clear meaning. The specification explains: "The position of the second incision 3 millimeters cranial of the first incision is based upon the average size of the household cat. For smaller animals the distance will be smaller, and for larger animals the distance will be larger." *Id*.

As stated above, when a "word of degree" is used in a claim, a court "must determine whether the patent's specification provides some standard for measuring that degree." Datamize, LLC, 417 F.3d at 1349. In *In re Oetiker,* the court held "have a length of the order of 5 mm" indefinite because "there are no guidelines in appellant's specification to enable one skilled in the art to determine whether or not a given leg portion has a length of the order of 5 mm." *Id*. at * 15. In contrast, the '579 patent's intrinsic evidence provides at least some guidance as to the second incision's location and purpose. The specification, which is accompanied by Figure 2, explains:

The traction in the direction T causes the epithelium to release from its distal attachment and permits a second circumferential incision of the redundant epithelium approximately 3 millimeters cranial from the first incision along the line B-B. This second incision allows slightly deeper subcutaneous fascia to be moved cranially over the ungual crest as well.

The position of the second incision 3 millimeters cranial of the first incision is based upon the average size of the household cat. For smaller animals the distance will be smaller, and for larger animals the distance will be larger.

The Federal Circuit, considering similar allegations of indefiniteness, has permitted approximate measurements if the words used are "as accurate as the subject matter permits." *See* Orthokinetics v. Safety Travel Chairs, Inc., 806 F.2d 1565, 1576 (Fed.Cir.1986). In *Orthokinetics,* the court found valid the term "so dimensioned," which the patent used to describe the measurements of a pediatric wheelchair that helped disabled children in and out of cars:

In a wheel chair having a seat portion, a front leg portion, and a rear wheel assembly, the improvement wherein said front leg portion is *so dimensioned* as to be insertable through the space between the doorframe of an automobile and one of the seats thereof whereby said front leg is placed in support relation to the automobile and will support the seat portion from the automobile in the course of subsequent movement of the wheel chair into the automobile ....

Id. at 1568 (emphasis added). The court acknowledged that "one desiring to build and use a travel chair must measure the space between the selected automobile's doorframe and its seat and then dimension the front legs of the travel chair so they will fit in that particular space in that particular automobile," but found that "the claims were intended to cover the use of the invention with various types of automobiles" and that the phrase was "as accurate as the subject matter permits, automobiles being of various sizes." *Id*. at 1576. The court emphasized that "patent law does not require that all possible lengths corresponding to the spaces in hundreds of different automobiles be listed in the patent, let alone that they be listed in the claims." *Id; see also* Andrew Corp. v. Gabriel Elecs., 847 F.2d 819 (Fed.Cir.1988) (finding the words "approach each other," "close to," "substantially equal to" and "closely approximate," which described the configuration of a horn reflector microwave antenna used in long distance telephone and data networks, specific enough because "it became very clear during trial ... that curves showing RPEs for horn antennas will never be identical."); Rosemount, Inc., 727 F.2d at 1547 (Fed.Cir.1984) (finding the phrase "close proximity," which described the distance between a mounted transistor and high impedance material, acceptable because the description was "as precise as the subject matter permits").

In light of *Orthokinetics, Andrew Corp.* and *Rosemount,* the Court finds that Defendant has not proved by clear and convincing evidence the phrase "about three millimeters" is indefinite. The claim could be more definite, but in light of the specification, Figure 2 and the variation inherent in cat sizes, the Court finds that one skilled in the art would know where to make the second incision. FN8

FN8. At oral argument, Defendant presented an exhibit depicting five photographs of post-operative cat claws. Dr. Young testified that he believed the cat claws numbered 3 and 5 were larger-than-average; yet, when defense counsel measured the distance between the striation marks of the first and second incisions, it was less than 3 millimeters. Defendant argues that this in-court exercise demonstrates the indefiniteness of the 3 millimeter estimate and the specification's statement that "for smaller animals the distance will be smaller, and for larger animals the distance will be larger." Although the specification contains the preferred embodiment, which states that the distance between incisions correlates to the size of the cat, the Court will not narrow Claim 6, step (c) accordingly. While the phrase "about three millimeters" is not as precise as possible, the claim avoids indefiniteness because it is not "insolubly ambiguous." Honeywell Int'l, 341 F.3d at 1338; *see also* Exxon Research & Eng'g Co. v. United States, 265 F.3d 1371, 1375 (Fed.Cir.2001).

Second, Defendant contends that Step (c)'s use of the word "epidermis" renders it indefinite. Defendant queries how the epidermis, which it defines as "the surface layer of the skin," can be incised in Step (c) if the epidermis has already been incised in Step (a) ("forming a first circumferential incision ... in the epidermis ..."), FN9 noting that the top layer of skin cannot be incised twice. The specification only adds to the confusion, Defendant asserts, because it instructs the surgeon to make a "second circumferential incision of the redundant *epithelium* approximately 3 millimeters cranial from the first incision." Defendant notes that a medical dictionary defines epithelium as "the covering of internal and external surfaces of the body." *See* DORLAND'S ILLUSTRATED MEDICAL DICTIONARY 400 (26th ed.1981). In other words, Defendant argues that the definitions of epidermis and epithelium are mutually exclusive because cutting into the epithelium requires cutting through the epidermis *and* the underlying layers; thus, both terms cannot be used to describe the skin to be incised in Step (c). Plaintiff counters that "epithelium" and "epidermis" can be used interchangeably when referring to a feline's claw.

FN9. Because of its use of the words "and then" between all steps, Claim 6 requires the surgeon to have completed Steps (a) and (b) before moving to Step (c).

A word will not render a claim invalid if it can be given any reasonable meaning: "If the meaning of the claim is discernible, even though the task may be formidable and the conclusion may be one over which reasonable persons will disagree, we have held the claim sufficiently clear to avoid invalidity on indefiniteness grounds." Datamize, LLC v. Plumtree Software, Inc., 417 F.3d 1342, 1347 (Fed.Cir.2005) (citing Exxon Research & Eng'g, 265 F.3d 1371, 1375 (Fed.Cir.2001)). In this case, the '579 patent's subject matter, the other steps in Claim 6, the specification's language, and Figure 2, all taken together, adequately instruct a person skilled in the art that the word epidermis, as used throughout Claim 6, simply means "skin," and does not refer only to the skin's top layer. FN10 The patent's intrinsic evidence conveys that the second incision must occur after the first incision during which some skin will have already been retracted. The intrinsic evidence also makes clear that the second incision's purpose is to retract more skin for covering the post-operative wound. Although the claim is certainly not an example of clear drafting, a person skilled in the art would be able to discern the meaning of the word "epidermis" as used in Step (c). Thus, the word

does not render the claim indefinite.

FN10. Indeed, this more general definition has been used in at least one respected medical dictionary. *See* TABLER'S CYCLOPEDIC MEDICAL DICTIONARY (17th ed.1993) (defining "epidermis" as "skin").

4. Substantially Dorsally as Used in Claim 6, Steps (d), (g), (h) and (i).

Defendant argues that Claim 6, Steps (d), (g), (h) and (i), are invalid for their use of the phrase "substantially dorsally" to describe the position of the laser because "substantially" encompasses too wide a range of movement. The Federal Circuit, in Verve, LLC v. Crane Cams, Inc., 311 F.3d 1116 (Fed.Cir.2002), upheld the phrase "substantially constant wall thickness." Id. at 1119. There, the district court found the ambiguity of the term demonstrated "at the motion hearing by the plaintiff's willingness to include great variations in wall thickness within the parameters of 'substantially' constant wall thickness ...." *Id*. The appellate court reversed this finding, explaining as follows:

Expressions such as "substantially" are used in patent documents when warranted by the nature of the invention, in order to accommodate the minor variations that may be appropriate to secure the invention. Such usage may well satisfy the charge to "particularly point out and distinctly claim" the invention, 35 U.S.C. s. 112, and indeed may be necessary in order to provide the inventor with the benefit of his invention.

Id.; see also Ecolab Inc. v. Envirochem, Inc., 264 F.3d 1358, 1367 (Fed.Cir.2001) ("[L]ike the term 'about,' the term 'substantially' is a descriptive term commonly used in patent claims to 'avoid a strict numerical boundary to the specified parameter.' "); Seattle Box Co. v. Indus. Crating & Packing, Inc., 731 F.2d 818, 821, 826 (Fed.Cir.1984) (finding the size of blocks adequately described by the term "height substantially equal to the thickness of the tier of pipe lengths" because an expert would know the limitations of the claims and because "the specification clearly sets forth ... that the divider blocks are intended to absorb the weight of overheard loads").

The analysis set forth in *Verve, Ecolab* and *Seattle Box* holds firm when applied to the '579 patent. The '579 patent's specification adequately defines the word "substantially" such that one skilled in the art would understand the patent's limitations. The specification reads: "The laser source is positioned in a substantially dorsal position and pointed in a palmar direction. It will be apparent that momentary movement of the laser source from the dorsal position may be necessary to avoid directing the beam onto tissue that should not be cut." This paragraph makes clear that momentary deviations from the dorsal position are sometime required to complete the procedure properly. The word "substantially," when read in light of this explanation, is as specific as warranted by the nature of the invention.

Defendant also argues that the specification's language requires the laser to be in a substantially dorsal position at all times because of the following statement found in the specification: "However, all contemplated applications of the laser's beam are in a palmar direction from a dorsal position." Stated differently, Defendant asserts that if, at any time, a surgeon deviates from the "substantially dorsal" position, no infringement has occurred because the patent does not cover any non-substantially dorsal laser positions. Plaintiff counters that the '579 patent's claims are not to be unduly limited by the specification. The Court finds Plaintiff's argument well-taken. The phrases "substantially dorsal" or "substantially dorsally" apply only to those steps in Claim 6 in which they appear: Steps (d), (g), (h) and (i). To impute these terms to

every step in Claim 6 would violate the well-established rule that "[p]articular embodiments appearing in a specification will not be read into the claims when the claim language is broader than such embodiments." KIS v. Foto Fantasy, Inc., Nos. 02-1263, 02-1265, 2003 WL 722181, at (Fed.Cir. Feb.28, 2003). No word in Claim 6 of the '579 patent's indicates that each and every incision, including the circumferential incisions outlined in Steps (a) and (c), require a laser held in a substantially dorsal position.

V. CONCLUSION

The Court finds Claims 1-5 indefinite as a matter of law. Because the contested words in Claim 6 are not insolubly ambiguous, Claim 6 stands.

IT IS SO ORDERED.

S.D.Ohio,2005.
Young v. Lumenis, Inc.

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