United States District Court,
E.D. Pennsylvania.

PRECIMED, S.A,
v.
ORTHOGENESIS, INC.

Sept. 18, 2006.

Gerard P. Norton, Jonathan R. Lagarenne, John P. Blasko, Fox Rothschild LLP, Lawrenceville, NJ, for Precimed, S.A., et al.

Frederick A. Tecce, McShea Tecce PC, Philadelphia, PA, for Orthogenesis, Inc.

MEMORANDUM RE: CLAIM CONSTRUCTION

BAYLSON**, District Judge.**

This claim for patent infringement was filed on April 28, 2004. Defendant's Motion to Dismiss for Lack of Personal Jurisdiction and Motion to Dismiss for Improper Venue were denied. Following several discovery disputes, the parties have filed cross motions for claim construction pursuant to Markman v. Westview Instruments, Inc., 52 F.3d 967 (Fed.Cir.1995) (en banc), *aff'd* 517 U.S. 370, 116 S.Ct. 1384, 134 L.Ed.2d 577 (1996).

I. Legal Standard

The general standard for a claim construction begins with the language of the claims themselves. Victronics Corp. v. Conceptronic, Inc., 90 F.3d 1576, 1582 (Fed.Cir.1996). This is because the patentee used that language to describe the subject matter which the patentee regards as his invention. *See* Interactive Gift Express, Inc. v. Compuserve, Inc., 256 F.3d 1323 (Fed.Cir.2001). In addition to the claims, the Court should examine the other intrinsic evidence; first the rest of the specification, and then the prosecution history, if in evidence. Id. at 1331. However, if the claim is clear on its face, "consideration of the rest of the intrinsic evidence is restricted to determining if a deviation from the clear language of the claims is specified." *Id*. If the intrinsic evidence is unambiguous, there is no need for the Court to consult or rely on extrinsic evidence. Victronics, 90 F.3d at 1582-83 (Fed.Cir.1996).

II. *Factual Background*

Plaintiffs Precimed S.A. and Precimed, Inc. (collectively "Precimed") act as designer, manufacturer and supplier of surgical tools used in orthopedic procedures, including a device known as a reamer used in hip replacement surgery. The reamer is used during the hip replacement surgery to assist the surgeon in removing tissues as part of the hip replacement procedure.

Precimed describes the function of the reamer in its brief as follows:

The function of the reamer assembly is to remove tissue, including bone tissue, and otherwise shape the acetabular cavity to allow insertion of the artificial cup. The reamer has a head which, when rotated, essentially mills the tissue to be removed, and the head is attached to a shaft-spindle. During the operation, the reamer is attached to a power source to drive the rotation of the head, but the power source is not considered part of the reamer. Given the force necessary and the tight tolerances, the reamer assembly undergoes significant stress during the operation. Therefore, the reamer must be a high quality instrument manufactured to tight tolerances. Moreover, because of the wear of the head, the different sizes of hips and the need to size the cup socket as precisely as possible, the reamer head is frequently replaced during the course of use of the reamer.

Following the completion of extensive briefing, the Court held oral argument on July 18, 2006.

III. Claim Construction Regarding the '290 Patent

The first claim for which Precimed asserts infringement by Defendant is the ' 290 Patent which Precimed asserts was a significant improvement over the prior art in two respects as follows:

1. The reamer head allowed tissue to pass through the head, thereby avoiding plugging of the cutting surface, which plugging can cause the reamer to plane and damage the bone. ('290 patent col. 1, Ins. 54-58); and

2. The reamer spindle head could accept reamer heads of multiple sizes, thereby eliminating the need for multiple sterilized reamer spindles and reducing the time to change reamer heads during surgery. ('290 patent, col. 2, Ins. 20-23).

The dispute concerning claim construction in this case centers on the description of the reamer spindle and reamer. The first claim of Patent '290 reads as follows:

I. Reamer spindle and reamer which are intended for surgery, comprising, on the one hand, a shank (3) to which there is fixed a reamer spindle head (5) which is equipped with a securing device of the bayonet type (10) equipped with locking means (6, 11), and, on the other hand, a cap-shaped reamer (1) which is equipped with radial rods (2) which are distributed uniformly, are integral with the inside edge of the reamer and are intended to come into engagement in catches (10) of the bayonet, characterized in that the radial rods (2) are at least three in number and join up at the center of the cap which they are integral.

The precise dispute between the parties concerning claim 1 centers on the phrase "securing device of the bayonet type." At the oral argument, the Court reviewed the dictionary definition of bayonet. The first definition refers to a knife-type blade attached to the muzzle end of a rifle which is obviously not the applicable definition in this case. The second definition is "a pin that plays in and out of holes made to receive it and serving to engage or disengage parts, (as of machinery)." Both counsel generally agreed that this was an accepted dictionary definition. However, the application of the word "bayonet" in this case has been the focus of the claim construction on '290 Patent.

There is a dispute in this case, which was articulated at the oral argument as to the definition of the term "bayonet." The parties do not adhere strictly to the dictionary definition, which the Court quoted at oral

argument and repeated above, but Precimed in claim 2 described the bayonet as "in the form of a collar whose center is recessed to a certain thickness in order to be able to receive the radial rods of the reamer." Precimed asserts that the phrase "securing device of the bayonet type" refers to any bayonet into which a rod, stud, or pin of the reamer head slides and is secured. The "bayonet" is the flange and/or collar of the reamer spindle.

The Defendant asserts that the drawings submitted by Precimed with the '290 Patent illustrate a device for securing the reamer head to the reamer handle, with the reamer head having rods that are received by L-shaped slots in a structure that is referred to as the bayonet. The Defendant asserts that the proper claim construction of the phrase "a securing device of the bayonet type" in the '290 Patent is construed as a "securing device which interlocks two parts through the use of a rod and L-shaped receiving slots." Defendant argues that this analysis is appropriate because of the specification and also looking at the prosecution history. The specification of the patent does state, in referring to the collar, as follows: "formed in this collar are four L-shaped bayonet catches which are intended to receive the rods of the reamer."

The Court rejects the Defendant's construction that the claim must be construed as including a reference to "L-shaped receiving slots." Although this phrase is used in the specification, as an explanation, the Court does not find that a limitation of the claim to a "L-shaped" locking device is appropriate. One reason for this conclusion is the Court rejects Defendant's assertion that in the Wiegand Patent, attached to the Defendant's exhibits and reviewed extensively at oral argument, the drawing attached to the Wiegand Patent shows a L-shaped locking device. Although defense counsel ably argued that the Court should view this diagram as constituting a L-shaped locking device, the Court cannot make such a conclusion. *See* Wiegand Patent at p. 25, Figure 3, document no. 2281095, attached to Defendant's Memorandum as Exhibit C. Rather, Figure 3 shows a rod inserted into a flange with an indentation, but the Court cannot conclude that it is L-shaped.

There is also a dispute about the phrase "engagement in catches of the bayonet" which is used in claim 1 cited above. Precimed asserts that the phrase "catches of the bayonet" includes any slot or notch in a bayonet into which the retaining rods slide and against which the rod rests or are engaged.

At oral argument, counsel strongly argued that the principal difference between them was whether the locking device, which is an inherent part of the reamer and spindle assembly, must be described as L-shaped. The Court finds that the phrase "a securing device of the bayonet type" would include any bayonet as defined in the specification, i.e., a collar or flange, that is used to secure something. In order the effectuate the securing function, the bayonet must have "catches" which could be a slot or a notch that holds the item secured. The Court agrees with Precimed that the phrase "engagement in the catches of the bayonet" means an item, which in this case are the rods of the reamer head, which rests in, lays on, or is otherwise engaged.

It is well accepted that a patentee can give its own definition to a word different from a word's ordinary or customary meaning. *See* CCS Fitness, Inc. v. Brunswick Corp., 288 F.3d 1359, 1366-67 (Fed.Cir.2001). The patentee can act as its own lexicographer and clearly set forth a definition of the disputed claim term in the specification or prosecution history. In Athletic Alternatives, Inc. v. Prince Manufacturing, Inc., 73 F.3d 1573, 1578-79 (Fed.Cir.1996), the court stated that when no ordinary meaning is apparent from the claims, one must look to the specification and prosecution history. The Court finds that Precimed has appropriately acted as its own lexicographer in defining the term "bayonet."

The Court concludes that there is no need to consult extrinsic evidence. *See* Interactive Gift Express, Inc.,

256 F.3d at 1332 ("If the meaning of the claim limitation is apparent from the totality of the intrinsic evidence, then the claim has been construed.")

The Court rejects Defendant's position that the securing device must be an L-shaped slot or that catches of the bayonet must also be L-shaped. The Court agrees with Precimed that Defendant's construction improperly reads into the claim limitations that are not present and therefore should not be part of claim construction.

IV. ***The Claim Construction Concerning the '221 Patent***

The parties also disagree about the claim construction of a different patent concerning the reamer and associated equipment referred to as the '221 Patent, entitled "Connector for Domed Cutting Tool." In claim 1, found at column 12 of the patent, the rotary reamer assembly comprises "a retaining member extending diametrically across the base including a central embossed portion, for retaining the shaft and the reamer body in a fixed relative position." Precimed asserts that the term "embossed" in the '221 Patent is construed as protruding in any direction, whereas Defendant asserts that the claim should be construed with the term "embossed" as meaning "raised, standing out in relief in the axial direction." At oral argument, counsel agreed that the dictionary definition of the term "embossed" means "standing out in relief."

In response to the Court's question as to why, when the retaining member pictured in Diagram Figure 25 (at sheet 11 of 15 and in sheet 9 of 15) is rounded, the claim must be construed with the term "embossment." Precimed's counsel stated that the member did not have to be rounded, and that claim 1 refers to a "central embossment." Precimed's counsel said the term "embossment" had its ordinary meaning and disclaimed any contention that the patentee acted as a lexicographer, which is different from the claim made for the definition of the '290 Patent discussed above. Precimed disputes that the embossment has to be in one direction, i.e. on an axial basis.

Defense counsel made a valid point at oral argument that the term "embossment" constitutes a raised surface, but inherent in that is a raised surface parallel to the underlying surface. Precimed asserts that something can be embossed and be raised on a vertical plane to the underlying surface. The Court rejects Precimed's definition as inherently unacceptable and contrary to the plain dictionary definition and the English language concept of the term "embossed." As discussed at the oral argument, a monogram on a shirt or a napkin is commonly said to constitute an "embossment," and the raised surface is specifically parallel to the underlying surface. The Court concludes that ordinary use of the word "embossment," would not include an extension that runs on a vertical plane to the underlying surface.

As with the construction of the '290 Patent, the Court concludes that consideration of intrinsic evidence and the normal definition of a common English term, i.e., "embossed," provides the appropriate claim construction without consideration of extrinsic evidence. The Court agrees with defense counsel's explanation why the definition should include the term "axial." (See p. 86 of the transcript of oral arguments).

Now that the Court has ruled on claim construction, the parties shall complete their briefing on all summary judgment issues within fourteen (14) days. The Court will then have oral argument.

An appropriate Order follows.

ORDER

AND NOW, this 18th day of September, 2006, following consideration of the briefs and oral argument, and based on the foregoing Memorandum, it is hereby ORDERED as follows:

1. As to the '290 Patent, the phrase "securing device of the bayonet type" is construed "as a flange and/or collar of the reamer spindle into which a rod, stud or pin of the reamer head slides and is secured."

2. As to the '221 Patent, the word "embossed" is construed as meaning "raised, standing out in relief in the axial direction."

3. The parties shall complete briefing on summary judgment within twenty (20) days.

4. The Court will hold oral argument on all outstanding motions on Monday, October 30, 2006 at 4:00 p.m. in Courtroom 3A.

E.D.Pa.,2006.
Precimed, S.A. v. Orthogenesis, Inc.

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