United States District Court,
M.D. Florida, Fort Myers Division.

ARTHREX, INC., a Delaware corporation,
Plaintiff.
v.
DEPUY MITEK, INC., a Massachusetts corporation,
Defendant.

No. 2:04-cv-328-FtM-34DNF

Sept. 22, 2008.

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ORDER

MARCIA MORALES HOWARD**, District Judge.**

THIS CAUSE is before the Court on the Honorable Douglas N. Frazier's Supplemental Report and Recommendation (Dkt. No. 176; Supplemental Report). Plaintiff has filed objections to the Supplemental Report, *see* Plaintiff Arthrex, Inc.'s Objections to the Supplemental Report and Recommendation Issued by Magistrate Judge Frazier (Dkt. No. 177; Plaintiff's Objections to Supplemental Report), and Defendant has responded to those Objections, *see* Defendant DePuy Mitek, Inc.'s Opposition to Plaintiff Arthrex, Inc.'s Objections to the Supplemental Report and Recommendation Issued by Magistrate Judge Frazier (Dkt. No. 178; Response to Plaintiff's Objections to Supplemental Report).

I. Procedural History

The protracted procedural history of this case is complicated, but nonetheless it is essential to understanding the issues currently before the Court. This action was initiated on June 18, 2004, by the filing of a Complaint (Dkt. No. 1), alleging patent infringement. Specifically, Plaintiff alleged that Defendant infringed its patent, U.S. Patent No. 6,733,529 ('529 patent), which was issued on May 11, 2004. *See* Complaint at 2. On October 15, 2004, Defendant filed its Amended Answer and Counterclaim (Dkt. No. 23; Answer), denying the allegations in the Complaint and seeking entry of a judgment declaring that the patent was not infringed or, alternatively, that the patent is invalid or unenforceable. *See* Answer at 12-13. Thereafter, both parties filed motions requesting a claim construction hearing pursuant to Markman v. Westview Instruments, Inc., 517 U.S. 370, 116 S.Ct. 1384, 134 L.Ed.2d 577 (1996). *See* DePuy Mitek's Motion for a *Markman* Hearing and Ruling (Dkt. No. 79); Plaintiff Arthrex, Inc.'s Motion for Claim Construction (Dkt. No. 86).

On January 25, 2006, with leave of Court, Plaintiff filed an Amended Complaint (Dkt. No. 125), adding a claim for infringement of U.S. Patent No. 6,974,477 ('477 patent), a continuation of the '529 patent which was issued on December 13, 2005. FN1 *See* Amended Complaint at 4-6. In response to the Amended Complaint, Defendant asserted a counterclaim for declaratory judgment seeking a determination that it did not infringe either patent or that both patents are invalid or unenforceable. *See* Answer and Counterclaim to Amended Complaint (Dkt. No. 127) at 22-24. As a result of the filing of the Amended Complaint, the Court denied all of the pending motions as moot, including the motions requesting a claim construction hearing. *See* Order (Dkt. No. 126). Thus, on April 21, 2006, the parties renewed their request for a claim construction hearing. *See* Jointly Proposed Modification to Scheduling Order (Dkt. No. 131) at 1. The Court granted this request on May 25, 2006, removed the case from the trial calendar, and referred the matter to the Magistrate Judge to conduct a *Markman* hearing and issue a report and recommendation regarding the claim constructions issues. *See* Order (Dkt. No. 135) at 1-2.

FN1. Although there is some difference in the claim language between the '529 patent and the '477 patent, the claim language currently at issue is identical in both patents. *See* Amended Complaint Exs. A & C. Additionally, as the '477 patent is a continuation of the '529 patent, the specification is also identical. *See* Transcript of Status Conference (Dkt. No. 193) at 13, 39. Indeed, the parties have not identified any language in the '477 patent that differs materially from the '529 patent regarding the issues currently before the Court. *See, e.g.,* Plaintiff Arthrex, Inc.'s Response to DePuy Mitek's Objections to the Magistrate's Report & Recommendation (Dkt. No. 161) at 14; Arthrex, Inc.'s Opposition to DePuy Mitek's Claim Construction Memorandum (Dkt. No. 143) at 17; Defendant DePuy Mitek, Inc.'s Opposition to Plaintiff Arthrex, Inc.'s Objections to Report & Recommendation on Claim Construction (Dkt. No. 160) at 2. Accordingly, for ease of reference in resolving the outstanding issues, the Court cites to the language of the '529 patent.

In accordance with the Court's Order, the parties briefed the claim construction issues and filed a joint statement identifying the claim construction issues in the case. *See* Plaintiff Arthrex, Inc.'s Opening Brief on Claim Construction (Dkt. No. 141; Plaintiff's Opening Brief); DePuy Mitek's Response to Arthrex's Opening Brief on Claim Construction (Dkt. No. 142; Response to Plaintiff's Opposition Brief); DePuy Mitek's Claim Construction Memorandum (Dkt. No. 140; Defendant's Opening Brief); Arthrex, Inc.'s Opposition to DePuy Mitek's Claim Construction Memorandum (Dkt. No. 143); Joint Claim Construction Statement (Dkt. No. 147; Joint Statement). The parties identified, in pertinent part, that the following language of claim 1 in both patents was at issue:

Claim Language	**Arthrex's Proposed Claim Construction**	**Mitek's Proposed Claim Construction**
securing the graft in the opening by advancing an implant transversely into the opening and under the graft	securing the graft in the opening by advancing an implant transverse to and into the opening and under the graft	"*securing the graft in the opening by advancing*" means "to make the graft fast by impacting"

Joint Statement at 3, 5. Additionally, with regard to this language, which is still at issue, Plaintiff asserted in its Opening Brief that, in this step, the patent is not limited to the manner of advancing the implant under the graft by impaction into the bone, but that impaction is only one method identified in the specification. *See* Plaintiff's Opening Brief at 17.

Thereafter, on June 30, 2006, the Magistrate Judge held a claim construction hearing and entered the Report and Recommendation (Dkt. No. 154; Report). *See* Report at 1. The Magistrate Judge concluded that "the term 'securing the graft by advancing an implant transversely' should be construed as by impaction and not by securing the graft by rotating a screw-in type implant." *Id*. at 22. Additionally, he found that "the language disavows the use of the screw-in type implant as possibly causing the graft to become wrapped around the implant when rotated." *Id*. at 22-23. As a result, the Magistrate Judge recommended that the Court construe the terms " 'securing the graft into the opening by advancing an implant transversely into the opening and under the graft,' to mean to secure the graft by impacting and not by rotating a screw-in type implant." *Id*. at 23; *see also id*. at 24 (finding "[i]n favor of Mitek as to the term " 'securing' " to mean to secure the graft by impacting and not by rotating a screw-in type implant").

In response to this Report, both parties filed objections; however, only Plaintiff objected to the Magistrate Judge's construction of the "securing" clause. *See* DePuy Mitek's Objections to the Magistrate's Report & Recommendation (Dkt. No. 157); Plaintiff Arthrex, Inc.'s Response to DePuy Mitek's Objections to the Magistrate's Report & Recommendation (Dkt. No. 161; Response to Defendant's Objections to Report); Plaintiff Arthrex, Inc.'s Objections to Report and Recommendation on Claim Construction (Dkt. No. 158; Plaintiff's Objections to Report); Defendant DePuy Mitek, Inc.'s Opposition to Plaintiff Arthrex, Inc.'s Objections to Report & Recommendation on Claim Construction (Dkt. No. 160; Response to Plaintiff's Objections to Report). Upon review of the objections and responses, the Court concluded that this matter needed to be recommitted to the Magistrate Judge for the entry of a supplemental report and recommendation regarding the construction of the terms, "securing the graft in the opening." Order (Dkt. No. 162) at 8-9. Thereafter, on February 21, 2007, this case was reassigned to the undersigned.

As a result of the Court's Order (Dkt. No. 162), the Magistrate Judge directed the parties to provide further briefing regarding the necessity for construing the terms, "securing the graft in the opening," and the appropriate construction for that phrase. *See* Order (Dkt. No. 165). In compliance with this Order, the parties filed initial and responsive briefs. *See* Plaintiff Arthrex, Inc.'s Initial Brief on the Necessity of Construing the Term "Securing the Graft in the Opening" and on the Proper Construction of that Term (Dkt. No. 168; Plaintiff's Supplemental Brief); Defendant DePuy Mitek, Inc.'s Opposition to Plaintiff Arthrex, Inc.'s Initial Brief on the Necessity of Construing the Term "Securing the Graft in the Opening" and on the Proper Construction of that Term (Dkt. No. 173; Response to Plaintiff's Supplemental Brief); Defendant DePuy Mitek, Inc.'s Memorandum on the Issue of Whether the Term "Securing the Graft in the Opening" Needs to be Construed, and If So Its Proper Construction (Dkt. No. 169; Defendant's Supplement Brief); Plaintiff Arthrex, Inc.'s Response to Defendant DePuy Mitek, Inc.'s Memorandum on the Issue of Whether the Term "Securing the Graft in the Opening" Needs to be Construed, and If So Its Proper Construction (Dkt. No. 172; Response to Defendant's Supplemental Brief).

On May 14, 2007, the Magistrate Judge entered the Supplemental Report. In the Supplemental Report, the Magistrate Judge concluded "that the graft is not secured when it is advanced but rather becomes secure in the opening when the implant is impacted." Supplemental Report at 8. He explained that "the graft cannot be secure unless or until the implant is secure" and that the language of the patent confirms "that the graft becomes secure when the implant is secured by impaction." *Id*. at 9. Therefore, the Magistrate Judge recommended that the Court construe the language "securing the graft in the opening" to mean "that the graft is secured by impaction of the implant in the knee." *Id*. Additionally, the Magistrate Judge declined to construe the phrase "securing the implant in the knee" in claim 3 of the patent. *See id*.

Plaintiff then objected to the Magistrate Judge's recommended construction of the phrase "securing the graft in the opening," *see* Plaintiff's Objections to Supplemental Report, and Defendant responded to those objections, *see* Response to Objections to Supplemental Report. The Court heard oral argument on the objections at the status conference held on May 16, 2008. *See* Transcript of Status Conference (Dkt. No. 193; Tr.). In light of the foregoing, the only remaining claim construction issue is the meaning of the phrase "securing the graft in the opening," which appears in the last clause in claim 1 of both patents. This issue has been extensively briefed and argued by the parties and is ripe for the Court's resolution.

II. The Parties' Respective Positions Regarding Claim Construction

Plaintiff contends that claim 1 provides the method for loading the tendons into the knee, but does not include the step of "securing the implant in the knee." Plaintiff's Supplemental Brief at 4-5. Indeed, Plaintiff maintains that claim 1 only describes a part of the ACL repair process-loading the graft into the knee. *See* Plaintiff's Supplemental Brief at 5. It ends with the step of advancing the implant into the knee and under the graft, which prevents the graft from slipping or falling back down the opening. *See* Plaintiff's Supplemental Brief at 5; Tr. at 64-68. Plaintiff contends that claim 1 is broader than claim 3 in that it does not provide the step of securing the implant in the knee and, as a result, does not limit the method in which the implant is secured. *See* Plaintiff's Objections to Supplemental Report at 5-6; Plaintiff's Objections to Report at 3-4, 7. It further asserts that the Magistrate Judge's construction fails to recognize the difference in claim language in claims 1 and 3 and renders claim 3 superfluous. *See* Plaintiff's Objections to Supplemental Report at 6. Additionally, Plaintiff argues there is no limitation in claim 1 as to how the implant is advanced into the opening and the references to impaction in the patent relate to a preferred manner for securing the implant in the knee. *See* Plaintiff's Objections to Supplemental Report at 5, 10; Plaintiff's Supplemental Brief at 6, 8; Plaintiff's Opening Brief at 17; Tr. at 29-32.

On the other hand, Defendant contends that claim 1 provides for the entire process of loading the tendons into the knee and securing the graft. *See* Tr. at 58; Response to Plaintiff's Objections to Report at 1, 14; Tr. at 59-64. It asserts that the graft is not secure unless the implant is secure, because it is the implant that secures the graft. *See* Response to Plaintiff's Supplemental Brief at 1, 8; Response to Plaintiff's Objections to Report at 1, 2, 12. It further contends that, if the implant is merely placed under the graft, then it could fall out of the knee and the graft would not be secure. *See* Response to Plaintiff's Objections to Report at 13; Response to Plaintiff's Objections to Supplemental Report at 14. Additionally, Defendant maintains that Plaintiff disavowed the method of advancing the implant by rotation and the use of a screw-in type implant. *See* Response to Plaintiff's Opening Brief at 17-18; Response to Plaintiff's Objections to Supplemental Report at 3, 7-9. Indeed, Defendant asserts that Plaintiff has limited the patent to the use of an impact implant and the method of impaction is the only method for securing the graft. *See* Response to Plaintiff's Opening Brief at 18-19; Response to Plaintiff's Objections to Supplemental Report at 11-12.

III. Discussion

A. Effect of the Court's Previous Order and the Magistrate Judge's Previous Recommendations

As set forth above, significant judicial resources, as well as resources of the parties, have been expended on the issue at hand. The Magistrate Judge has issued two report and recommendations relating to this clause, the Court has entered an order addressing this issue, and multiple hearings have been held. Nonetheless, despite Defendant's arguments to the contrary, *see* Response to Plaintiff's Objections to Report at 15; Response to Plaintiff's Supplemental Brief at 2-3; Response to Plaintiff's Objections to Supplemental Report at 1, 6-7, there has been no definitive ruling on the construction of the phrase "securing the graft in the

opening" or the meaning of this clause. That is the issue currently before the Court.

Although Defendant understandably argues, based on the language of the Court's previous Order (Dkt. No. 165), that the Court adopted a construction for the term "securing," it is apparent from a review of the procedural history in this case, as well as the Report and the Order, that the Court has not yet provided a construction for that term or the "securing" clause. In the Report, the Magistrate Judge recommended a construction for the phrase "securing the graft in the opening by advancing an implant transversely into the opening and under the graft" and specifically the term "securing." *See* Report at 23-24. While some language in the Court's previous Order (Dkt. No. 165) indicates the Court had accepted the Magistrate Judge's interpretation, the Court ultimately did not accept this definition, as it recommitted the matter to the Magistrate Judge and instructed him to provide a recommendation as to the construction of the phrase "securing the graft in the opening." *See* Order at 8-9. If the Court had accepted, as definitive, the Magistrate Judge's initial construction, it would have had no reason to recommit the matter to the Magistrate Judge for the issuance of a supplemental report and recommendation on the construction of the same language. This conclusion is further supported by the fact that the Court did not expressly overrule Plaintiff's Objections to Report. *See id*.

As the phrase "securing the graft in the opening" and this clause of claim 1 has not been construed, the undersigned is left with determining the proper construction of this phrase, based on the parties' extensive briefing of this issue as well as the recommended construction in the Supplemental Report. Thus, the Court rejects Defendant's contention that this issue has been decided and that there is no need for the undersigned to construe this phrase. At a minimum, given the procedural posture of the case and the obvious confusion regarding the Court's construction of these terms, the undersigned is obligated to resolve the issue. Therefore, the undersigned will construe the phrase "securing the graft in the opening" and no prior construction of this clause in claim 1, if any, shall apply in this case.

B. Claim Construction Principles

The Court of Appeals for the Federal Circuit FN2 has recognized certain principles that guide the Court in construing the claims. However, that court also has cautioned that, although a court may utilize these principles in construing claims, the principles are not hard and fast rules. *See* Phillips v. AWH Corp., 415 F.3d 1303, 1324 (Fed.Cir.2005) (en banc) ("[T]here is no magic formula or catechism for conducting claim construction."). Ultimately, the Court's construction must be guided by the language of the claim in context of the entire patent. *See* Nystrom v. Trex Co., 424 F.3d 1136, 1142 (Fed.Cir.2005) (acknowledging that "[t]he construction that stays true to the claim language and most naturally aligns with the patent's description of the invention will be, in the end, the correct construction"); Phillips, 415 F.3d at 1312 (recognizing that the claims are of primary importance in determining what is covered by the patent). Indeed, "[i]t is a 'bedrock principle' of patent law that 'the claims of a patent define the invention to which the patentee is entitled the right to exclude,' " and it would be error " 'to construe it in a manner different from the plain import of its terms.' " Phillips, 415 F.3d at 1312. Although the Court's construction is guided by the claim language, the Court cannot rewrite claims, even when the only reasonable interpretation results in a nonsensical claim. *See* Chef America, Inc. v. Lamb-Weston, Inc., 358 F.3d 1371, 1374 (Fed.Cir.2004). Thus, when the claim is unambiguous and there is only one reasonable construction of the claim language, the Court must give the claim that construction. *See id*.

FN2. The Federal Circuit has exclusive jurisdiction over appeals of final decisions relating to patents. *See* 28 U.S.C. s. 1295(a) (1).

The Court begins the claim construction analysis by reviewing the claim language from the perspective of an ordinary person skilled in the art and giving those terms their ordinary and customary meaning. *See* Phillips, 415 F.3d at 1313; *see also* Nystrom, 424 F.3d at 1142. Additionally, the disputed claim terms are not viewed in a vacuum, but in context of the claim language and the entire intrinsic record, which include the claims, specification, and prosecution history. *See* Nystrom, 424 F.3d at 1142; Phillips, 415 F.3d at 1313-15; *see also* Free Motion Fitness, Inc. v. Cybex Int'l, Inc., 423 F.3d 1343, 1348 (Fed.Cir.2005). The Federal Circuit recognized that "the context in which a term is used in the asserted claim can be highly instructive." Phillips, 415 F.3d at 1314; *see also* Brookhill-Wilk 1, LLC v. Intuitive Surgical, Inc., 334 F.3d 1294, 1299 (Fed.Cir.2003) ("While certain terms may be at the center of the claim construction debate, the context of the surrounding words of the claim also must be considered in determining the ordinary and customary meaning of those terms."); Black & Decker, Inc. v. Robert Bosch Tool Corp., 260 F. App'x 284, 287 (Fed.Cir.2008). In addition to the actual language of the disputed claim term, the Court also can look to the language of other claims in determining the proper construction of a particular term. *See* Phillips, 415 F.3d at 1314 (finding that "[o]ther claims of the patent in question, both asserted and unasserted, can also be valuable sources of enlightenment as to the meaning of a claim term"). Indeed, the use of same term in different claims or the differences among the claims can be useful in determining the proper meaning to given term. *See* id. at 1314-15.

In addition to reviewing the disputed terms in the context of the claim language, the Court must also review those terms in the context of the entire patent, including the specification. *See* id . at 1315; Nystrom, 424 F.3d at 1145-46 (concluding that the court could not construe a term beyond its ordinary meaning without support for that interpretation in the intrinsic record); *see also* MBO Labs., Inc. v. Becton, Dickinson & Co., 474 F.3d 1323, 1329 (Fed.Cir.2007) (finding that the specification and prosecution history give meaning and scope to the words in the claims). The Federal Circuit has described the specification as highly relevant, usually dispositive, and " 'the single best guide to the meaning of a disputed term.' " Phillips, 415 F.3d at 1315. The specification serves to instruct and enable those skilled in the art to use the invention as well as to provide a best mode for practicing the invention. *See* id. at 1323. It may also "show that 'the patentee has disclaimed subject matter or has otherwise limited the scope of the claims.' " Computer Docking Station Corp. v. Dell, Inc., 519 F.3d 1366, 1374 (Fed.Cir.2008). It is not improper for the Court to rely heavily on the specification for guidance on interpreting the claim.FN3 *See* Phillips, 415 F.3d at 1323. The claims, however, may cover only a portion of the procedure or a part of the invention disclosed in the specification. *See* id. at 1327; Ventana Med. Sys., Inc. v. BioGenex Labs. Inc., 473 F.3d 1173, 1181 (Fed.Cir.2006) ("When the claim addresses only some of the features disclosed in the specification, it is improper to limit the claim to other, unclaimed features."); *see also* Allvoice Computing PLC v. Nuance Comms., Inc., 504 F.3d 1236, 1247-48 (Fed.Cir.2007).

FN3. In addition to the claim language and specification, the Court can also review the prosecution history for the patent, if in evidence, as part of the intrinsic record. *See* Phillips, 415 F.3d at 1317; *see also* Ventana Med. Sys., Inc. v. BioGenex Labs. Inc., 473 F.3d 1173, 1181 (Fed.Cir.2006). In this case, neither party has cited to the prosecution history as support for its respective position. *See* Tr. at 59-79.

Notwithstanding, the Federal Circuit has cautioned that a Court generally is not permitted to import a limitation from the specification into the claim or confine the claims to the preferred embodiments. *See* Phillips, 415 F.3d at 1323; *see also* Ventana Med. Sys., Inc., 473 F.3d at 1181; Varco, L.P. v. Pason Sys.

USA Corp., 436 F.3d 1368, 1373 (Fed.Cir.2006). It has acknowledged that "the distinction between using the specification to interpret the meaning of a claim and importing limitations from the specification into the claim can be a difficult one to apply in practice." Phillips, 415 F.3d at 1323; *see also* Liebel-Flarsheim Co. v. Medrad, Inc., 358 F.3d 898, 904-05 (Fed.Cir.2004). Yet, it suggested that the application of these principles could be applied with reasonable certainty if the court focused on "understanding how a person of ordinary skill in the art would understand the claim terms." Phillips, 415 F.3d at 1323.

The Federal Circuit further instructs that, from a close review of the specification, a court will be able to determine whether the specification is merely setting out examples for the use and implementation of the invention or whether it is limiting the scope of the patent to those embodiments. *See id*. For example, it may be clear from the language in the specification that the inventor did not envision any alternative embodiment other than the one described in the patent. *See id.; see also* Honeywell Int'l, Inc. v. ITT Indus., Inc., 452 F.3d 1312, 1318 (Fed.Cir.2006) (finding that the disputed term was limited to a specific embodiment because the specification repeatedly defined the invention as that embodiment). A review of the specification may also reveal that the feature at issue is a critical element of the invention and not merely a part of the preferred embodiment. *See* Andersen Corp. v. Fiber Composites, LLC, 474 F.3d 1361, 1367 (Fed.Cir.2007). Additionally, the specification may limit the definition of a disputed term by consistently using the term with reference to a specific definition and not the broader definition now alleged or by repeated and definitive remarks limiting the claim to a particular structure or feature. *See* Nystrom, 424 F.3d at 1145; Computer Docking Station Corp., 519 F.3d at 1374. On the other hand, "when the specification describes the invention in broad terms, accompanied by specific examples or embodiments, the claims are generally not restricted to the specific examples or the preferred embodiments unless that scope was limited during prosecution." Kinik Co. v. Int'l Trade Comm'n, 362 F.3d 1359, 1364 (Fed.Cir.2004).

Unlike intrinsic evidence, which consists of the claim language, specification, and prosecution history, *see* Phillips, 415 F.3d at 1317, extrinsic evidence, such as expert opinions, witness testimony, dictionaries, and treatises, is less significant in determining the meaning of disputed claim language, *see id.;* MBO Labs., Inc., 474 F.3d at 1329. Nonetheless, the Federal Circuit has acknowledged that, within the class of extrinsic evidence, dictionaries and treatises may be helpful to the Court in determining the true meaning of the language, as they can be used to understand the technology and construe the claim terms as long as that construction is not inconsistent with the patent documents. *See* Phillips, 415 F.3d at 1318, 1322-23. Finally, the Federal Circuit has recognized that " 'claims should be so construed, if possible, as to sustain their validity," but that this maxim only applies after the court has applied all of the other tools of claim construction and the claim is still ambiguous. *See* id. at 1327; *see also* Liebel-Flarsheim, 358 F.3d at 911.

C. Whether Claim 1 Requires the Implant to Be Secured in the Knee or Limits the Manner in Which the Implant Is Advanced

The parties' dispute over the construction of the terms "securing the graft in the opening" appears to be centered on whether, in securing the graft in the opening, claim 1 requires that the implant be secured in the knee. *See* Defendant's Supplemental Brief at 1; Response to Defendant's Supplemental Brief at 1. If claim 1 does require the implant to be secured in the knee, then the parties further dispute whether the patent limits the manner for securing the implant to impaction. Lastly, the parties dispute whether the patent limits the manner in which the implant is advanced into the opening in claim 1.

Defendant contends that the graft is not secure in the opening until the implant is secured in the knee. *See* Response to Plaintiff's Objections to Supplemental Report at 19. It alleges that the term "securing" means to

make fast or tie down and that the graft is not secured in the opening until the implant is secured in the knee. *See* Defendant's Opening Brief at 18; Response to Plaintiff's Supplemental Brief at 5-7. It contends that merely sliding an implant under the graft does not secure it because the implant could fall out of the knee. *See* Response to Plaintiff's Objections to Report at 13. Additionally, Defendant contends that the patent limits the manner in which the implant is advanced into the opening to advancing the implant by impaction. *See* Response to Plaintiff's Opposition Brief at 17; Response to Plaintiff's Objections to Supplemental Report at 7-9.

Plaintiff, on the other hand, alleges that the securing step in claim 1 does not require the implant to be secured in the knee, but merely advanced into the opening and under the graft. *See* Response to Defendant's Objections to Report at 13; Plaintiff's Supplemental Brief at 5-6. The graft is secured by the implant because it will not fall back down the opening. *See* Tr. at 29-30. Moreover, Plaintiff contends that the patent does not limit the manner in which the implant is advanced into the opening. *See* Plaintiff's Opening Brief at 16.

1. The Claim Language

The Court's construction of the disputed terms must begin with the claim language. In this case, claim 1 of the patent states, in pertinent part: "What is claimed is: [ ] A method of anterior cruciate reconstruction surgery of the knee, comprising the steps of: ... securing the graft in the opening by advancing an implant transversely into the opening and under the graft." Amended Complaint Ex. A at col. 6. The terms at issue are "securing the graft in the opening."

The phrase "securing the graft in the opening" cannot be interpreted alone. These terms must be viewed in context of the surrounding claim language. *See* Brookhill-Wilk, 334 F.3d at 1299. The claim language instructs that the implant is advanced "transversely into the opening and under the graft." *See* Amended Complaint Ex. A at col. 6. The claim language does not specifically require or mention that the implant is secured in the knee nor does the claim language limit how the implant is advanced into the opening. *See id*. As a result, the ordinary meaning of the claim language at issue supports Plaintiff's proposed construction: the graft is secured by advancing the implant into the opening and under the graft; the implant is not required to be advanced in a particular manner and there is no requirement that the implant be secured in the knee. *See* Ventana Med. Sys., Inc., 473 F.3d at 1180 (finding that, when the claim language failed to contain any words of limitation regarding the meaning of the term "dispensing," the ordinary meaning of that term did not include any limitation on the type of dispensing); *see also* Purdue Pharma, L.P. v. Endo Pharma., Inc., 438 F.3d 1123, 1136 (Fed.Cir.2006) (noting that "the claims contain no limitations relating to effectiveness of dosages in controlling pain in patients, and it is the claims ultimately that define the invention"); Varco, L.P., 436 F.3d at 1375.

2. The Specification

As the claim language does not require that the implant be secured in the knee in order to secure the graft in the opening and does not limit the manner in which the implant is advanced, the Court next considers the specification and patent as a whole to determine whether the patentee intended to limit the scope of the claim terms.

The abstract defines the invention as "[a] surgical method for ***loading ligament grafts*** into a joint." Amended Complaint Ex. A at 1 (emphasis added). It further provides that "[t]he graft is fixed in the socket using a transverse implant." *Id*. Thus, the abstract does not describe the invention as a method for securing the graft, other than *using* a transverse implant. Indeed, while it states that the graft is fixed using a

transverse implant, there is no limitation on the manner in which the transverse implant is used to fix the graft nor is there any mention of the fixation of the implant.

Additionally, in the Background of Invention section, the patentee describes the prior art and other fixation techniques. *See* Amended Complaint Ex. A at cols. 1-2. In doing so, the patentee specifically notes, "[v]arious endoscopic techniques and instruments relating to graft fixation are known in the prior art and can be used in the practice of the present invention." *Id*. at col. 2, lns. 12-14. It also specifically recognized that a rotational transverse implant has been an instrument used in a prior art fixation technique. *See id*. at col. 1, lns. 53-65 & col. 2, lns. 15-19. Furthermore, this section does not describe the present invention as including the step of securing the transverse implant in the knee nor does it describe the invention as providing a specific manner for securing the graft, other than using a transverse implant. *See id*. at cols. 1 & 2. When identifying the areas left open or the problems created by the prior art, there is no mention of a specific method for advancing the transverse implant or fixating the transverse implant in the knee. *See id*. Instead, the patentee states:

The need exists for fixation techniques that utilize narrower femoral/tibial tunnels, to prevent wiping, and that do not require the insertion of bone plugs. Also, the need exists for graft ligament loading techniques that can accommodate closed-looped grafts, that do not require specialized insertion tools to load the graft into the knee, and that can be indicated in certain revision procedures.

Id. at col. 2, lns. 19-25.

Furthermore, a review of the Summary of Invention section reveals that it likewise does not provide a specific manner for utilizing a transverse implant in securing the graft or require the implant to be secured in the knee. *See id*. at cols. 2 & 3. The patentee describes the invention as "providing a surgical method for loading tendon grafts into a joint and fixating the grafts using a transverse, intraosseous implant." *Id*. at col. 2, lns. 31-33. Although the patent indicates that it eliminates the need for certain graft fixation techniques used in the prior art, such as the use of interference screws in the femur, larger femoral tunnels, and bone plugs, there is no indication that it delineates (or excludes) a specific manner for advancing the transverse implant or utilizing the transverse implant in the ACL repair procedure. *See id*. at cols. 1-2. Indeed, in the Summary, the patentee explains that "the technique **can be implemented** using a transverse implant that is advanced by impaction into the bone." *Id*. at col. 2, lns. 37-38. This language does not require that the implant be impacted into the bone as part of the technique and suggests that there are other methods for securing the implant into the knee that can be used in conjunction with this technique. The use of this language further indicates that the technique or invention does not include the manner in which the implant is secured in the knee, but that the invention can be used *in conjunction with* other techniques for doing so.

Additionally, the Summary provides:

The cannulated implant is placed over the wire and driven into the femur. The implant preferably is formed with back-biting threads. Accordingly, the implant easily can be impact driven into the repair site, and yet can be removed if necessary by rotation. The cannulated implant passes over the strand and under the tendon, thus securing the graft in the femoral socket.

Id. at col. 3, lns. 5-11. The interpretation of these sentences is subject to much dispute. Defendant contends that these sentences establish that the invention requires that the implant be impact driven into the femur in order to secure the graft in the opening. *See* Response to Plaintiff's Objections to Report at 13. However, the

Court finds that this construction is inconsistent with the above language. The wire referred to in the first part of the first sentence is a wire that extends from under the graft, which has been loaded into the femoral socket at this point in the procedure, into and out of the femoral shaft. *See id*. at cols. 2-3. The strand and the wire refer to the same thing. *See id*. The second and third sentences both relate to a preferred embodiment. The second sentence explains that there is a preference for using an implant with back-biting threads and the third sentence explains the reason for that preference, i.e. that the implant can be impact driven. The last sentence does not relate to the previous two sentences, but instead explains what secures the graft in the opening. The Summary provides that the graft is secure when the implant passes over the strand and under the tendon (i.e. the graft). *See id*. at col. 3, lns. 9-11. There is no mention in this sentence of the implant being secure in the knee, the manner in which the implant is to be secured in the knee, or any reference to impaction. *See id*. While the Summary states that the implant is "driven into the femur," there is no instruction as to the specific manner in which the implant is to be driven into the femur. *See id*. at col. 3, lns. 5-6.

Even if the Court were to conclude that the language in the Summary establishes that the invention includes the step of securing the implant in the knee, that conclusion does not establish that claim 1 includes that feature. A claim is not required to include all of the features identified in the specification. *See* Ventana Med. Sys., Inc., 473 F.3d at 1181. Defendant does not seem to dispute this claim construction maxim, but instead argues that it does not have any application in this case, because the patent does not distinguish between securing the graft in the opening and securing the implant in the knee. *See* Response to Plaintiff's Objections to Supplemental Report at 19. According to Defendant, the specification only describes the graft as secure when the implant is secured. *See* Response to Plaintiff's Supplemental Brief at 9-10. However, there is support in the specification for the conclusion that claim 1 does not require the act of securing the implant in the knee.

In the Summary, the patentee describes the graft as secure in the opening when the implant passes over the strand and under the tendon-there is no reference to the securing the implant in the femur. *See* Amended Complaint Ex. A at cols. 2-3. Additionally, in the description of the preferred embodiments, the patentee explains that the implant is first advanced by hand into the opening and under the graft. *See id*. at col. 6, lns. 5-7. The implant is then secured in the knee. *See id*. at col. 6, lns. 7-10. Furthermore, the patentee explains that the implant advances along the wire and under the graft "to provide cross-pin support of tendons [ ]." *Id*. at col. 6, lns. 14-15. Again, there is no mention of the implant being secured in the knee.FN4 *See id*. Thus, if securing the implant in the knee is a feature of this invention, the foregoing supports the finding that it is not a feature included in claim 1.

FN4. Defendant suggests that the lack of a figure or diagram depicting the placement of the implant apart from securing the implant in the knee is further support for its construction. *See* Response to Plaintiff's Objections to Supplemental Report at 14; Response to Plaintiff's Supplemental Brief at 9-10. However, the drawings are part of the description of the preferred embodiments and the lack of a figure or diagram of a specific feature or step of the invention does not render the construction of that feature or step erroneous. MBO Labs., Inc., 474 F.3d at 1334 (finding that the determination of "patent coverage is not necessarily limited to inventions that look like the ones in the figures").

Finally, the Detailed Description of the Preferred Embodiments also supports the conclusion that claim 1 does not limit the manner in which the graft is secured. *See id*. at cols. 4-6. While the Detailed Description provides a preferred method for advancing the implant and then securing the implant in the knee, it

specifically provides "[a]lthough the present invention has been described in relation to particular embodiments thereof, many other variations and modifications and other uses will become apparent to those skilled in the art. Therefore, the present invention is to be limited not by the specific disclosure herein, but only by the appended claims." *Id.* at col. 6, lns. 24-30. Thus, it is apparent from a review of the Detailed Description that the specification is not limited to one embodiment, but that the Detailed Description only describes one example of an embodiment of the invention. As a result, it would be erroneous to limit the construction of the claims to this embodiment. *See* Kinik Co., 362 F.3d at 1364.

Defendant suggests that the patent should be limited to this embodiment because no other embodiment is described in the patent and the patent does not describe the use of screw-in or rotational implant in conjunction with the invented process, *see* Response to Plaintiff's Objections to Supplemental Report at 12; Response to Plaintiff's Supplemental Brief at 4-5; yet that lack of description is not sufficient to warrant so limiting the construction of the claims. Indeed, such a construction would violate the Federal Circuit's express instruction not to import a limitation from the specification into the claims. From a review of the entire specification, the Court concludes that this is not an instance where the patent is intentionally limiting the claims to one embodiment, but that this embodiment is merely an example of a particular embodiment of the invented process. *See* Purdue Pharma, L.P., 438 F.3d at 1136; Kinik Co., 362 F.3d at 1364.

Additionally, Defendant's construction of the terms at issue would render the preferred embodiment outside of the patent. Defendant contends that the "securing" clause of claim 1 instructs that the implant is advanced into the opening and under the graft by impaction. *See* Defendant's Opening Brief at 18; Response to Plaintiff's Opening Brief at 18; Response to Plaintiff's Objections to Report at 13. That interpretation, however, is inconsistent with the Detailed Description. If claim 1 requires that the implant be advanced under the graft by impaction, then the process in the Detailed Description could not be used. The Detailed Description instructs that the implant is placed over the wire "and advanced by hand until the threaded section 44 contacts the femur." Amended Complaint Ex. A at col. 6, lns. 6-7. Then, according to the Detailed Description, "[t]he head of the implant 40 is engaged and a mallet is used to drive the implant into the femur." *Id.* at col. 6, lns. 8-9. Defendant's construction of the claim language would not allow for these steps. As the Federal Circuit has specifically recognized that the correct construction of the claim language will rarely, if ever, exclude the preferred embodiment, the Detailed Description does not support Defendant's construction. *See* Ventana Med. Sys., Inc., 473 F.3d at 1180; *see also* Smith & Nephew, Inc. v. Ethicon, Inc., 276 F.3d 1304, 1309-10 (Fed.Cir.2001).

Accordingly, the Court concludes that the specification, like the claim language, supports Plaintiff's construction of the phrase "securing the graft in the opening" and does not require the act of securing the implant in the knee or limit the manner for advancing to impaction. *See* Allvoice Computing PLC, 504 F.3d at 1248.

3. Claim Differentiation Doctrine

In addition to the language of the claim, the language surrounding the claim, and the specification, the doctrine of claim differentiation also supports Plaintiff's construction of the phrase "securing the graft in the opening." The Federal Circuit has recognized that, generally, claim terms are used consistently throughout a patent; thus, "the usage of a term in one claim can often illuminate the meaning of the same term in other claims." Phillips, 415 F.3d at 1314. Likewise, "[d]ifferences among claims can also be a useful guide in understanding the meaning of a particular claim terms." *Id.* Indeed, " '[t]here is presumed to be a difference in meaning and scope when different words or phrases are used in separate claims.' " Transonic Sys., Inc. v.

Non-invasive Medical Techs. Corp., 143 F. App'x 320, 326 (Fed.Cir.2005) (quoting Tandon Corp. v. United States Int'l Trade Comm'n, 831 F.2d 1017, 1023 (Fed.Cir.1987). For example, when a dependent claim contains an additional limitation, there is a presumption that limitation is not present in the independent claim. *See* Phillips, 415 F.3d at 1314; *see also* Free Motion Fitness, Inc., 423 F.3d at 1351. The presumption of claim differentiation is at its strongest when the limitation to be interpreted into an independent claim already appears in a dependent claim. *See* Liebel-Flarsheim Co., 358 F.3d at 910. It is also significant when a construction which fails to recognize the difference in meaning and scope of the claims renders a claim superfluous. *See* Transonic Sys., Inc., 143 F. App'x at 326.

However, the presumption can be rebutted when "the circumstances suggest a different explanation, or if the evidence favoring a different claim construction is strong." Liebel-Flarsheim Co., 358 F.3d at 910; *see also* Transonic Sys., Inc., 143 F. App'x at 326; Nystrom, 424 F.3d at 1143. Indeed, the Federal Circuit has held that " 'the written description and prosecution history overcome any presumption arising from the doctrine of claim differentiation.' " Andersen Corp., 474 F.3d at 1370. Additionally, construing different claim terms to have the same definition does not always result in redundancy and does not necessarily warrant the application of the doctrine of claim differentiation. *See id.*

In this case, application of the doctrine of claim differentiation further supports the conclusion that the phrase "securing the graft in the opening" does not include the act of securing the implant in the knee. Defendant's construction of this phrase would render claim 3 superfluous, and the language in the specification fails to provide a basis for rebutting this presumption. First, the term "securing' in claims 1 and 3 are modified by different terms. In the claim 1, the phrase is "securing the graft in the opening" and in claim 3, the phrase is "securing the implant in the knee." *See* Amended Complaint Ex. A at col. 6. Thus, despite Defendant's argument to the contrary, *see* Tr. at 78-79, there is no basis for giving the two phrases the same definition in both claims. Next, Defendant's suggestion that claim 1 includes the act of securing the implant in the knee would render claim 3 redundant. Specifically, claim 3 provides:

The method of claim 1, wherein the implant has a threaded back end, the method **further comprising the step** of securing the implant in the knee by engaging a wall of the transverse hole with the threaded back end of the implant.

Amended Complaint Ex. A at col. 6, lns. 62-65 (emphasis added). Therefore, if the Court were to construe claim 1 as requiring the implant to be secured in the knee, then claim 3 would be superfluous. There would be no need to provide a *step* for securing the implant in the knee. Thus, this construction would render the terms "further comprising the step of" completely meaningless.

While Defendant argues that claim differentiation doctrine is not applicable because claim 3 contains a further limitation of requiring the use of a specific type of implant with a threaded back end, *see* Tr. at 59-64, the Court finds this argument unavailing. Claim 3, as a dependent claim, contains additional limitations. It only applies to a specific type of implant and then directs the addition of the step of securing the implant in the knee. The fact that it only applies to a specific type of implant does not render it any less redundant by Defendant's construction of claim 1. Thus, the addition of the limitation regarding the type of implant does not make the claim differentiation doctrine inapplicable. As Defendant has failed to point to any evidence that rebuts the presumption of the claim differentiation doctrine, the Court finds that this doctrine further supports the construction that claim 1 does not require the implant to be secured in the knee. *See* Allvoice Computing, PLC, 504 F.3d at 1248 (finding that the claim differentiation doctrine supported the conclusion that certain functions were not part of the process because that construction would render other claims

superfluous). Unlike the district court in *Black & Decker, Inc.*, this construction is not dependent solely on the doctrine of claim differentiation. *See* 260 F. App'x at 287. Instead, it is based on the entire intrinsic record.

4. Dictionary Definition

Defendant's construction of the "securing" clause as requiring the implant to be secured in the knee presumes that this clause is construed using the dictionary definition of the word "securing." *See* Response to Plaintiff's Supplemental Brief at 8; Tr. at 42. Indeed, its assertion that Plaintiff's construction is nonsensical is based on the assumption of the term "securing" means permanent fixation. *See* Tr. at 42. In particular, Defendant suggests that Plaintiff's construction is nonsensical because, if the implant is not secured in the knee, then it will fall out and the graft will fall out of the opening. *See* Response to Plaintiff's Objection to Supplemental Report at 5.

However, the term "securing" cannot simply be given its dictionary definition. Instead, the term is defined by viewing it in context of the other terms in the claim. *See* Phillips, 415 F.3d at 1314 (acknowledging that there are "numerous similar examples in which the use of a term within the claim provides a firm basis for construing the term"); *see also* Free Motion Fitness, Inc., 423 F.3d at 1348-49. Therefore, the construction of a term may differ from its pure dictionary definition or common usage when the claim language and/or the specification ascribes a different definition. *See* Phillips, 415 F.3d at 1316 (finding that "the specification may reveal a special definition given to a claim term by the patentee that differs from the meaning it would otherwise possess").

In this case, the term "securing" is defined by the context of the claim. The graft is "secured" by advancing the implant into the opening and under the graft. The graft is as "secure" as that act or step would make it. As explained *supra,* neither the claim language nor the specification requires that the implant be secured in the knee in order to accomplish this step. Additionally, there is no requirement in the specification or the claim language that the implant be advanced in any specific manner. Thus, while the Court's construction of the term "securing" may not seem to fit the precise dictionary definition or how that term is ordinarily defined in common everyday usage, its construction is nonetheless correct, as it is the interpretation required by the intrinsic record-the claim language and the specification. *See* id. at 1322 (holding that " 'a general-usage dictionary cannot overcome art-specific evidence of the meaning' of a claim term"); *see also* Free Motion Fitness, Inc., 423 F.3d at 1348-49. The Court is of the view that this construction is correct despite Defendant's assertion that it results in a nonsensical procedure and is contrary to the reality of how the surgery is conducted.FN5 *See* Response to Plaintiff's Objections to Supplemental Report at 19; Response to Plaintiff's Supplemental Brief at 5-7. Defendant contends that the graft cannot be secured, as directed in claim 1, "when the implant has been merely advanced, but not impacted, under the graft." Response to Plaintiff's Objections to Supplemental Report at 20. However, that is precisely what the claim language states, and the specification does not require a more limited construction. Although Defendant contends that this construction is nonsensical or contrary to the "technical reality," it is the construction demanded by the intrinsic record and therefore Defendant's arguments are unavailing. *See* Chef America, Inc., 358 F.3d at 1374.

FN5. Although Defendant definitively states that this construction is nonsensical because the implant would "fall out" and it is contrary to the reality of how such surgery is conducted, it is unclear what basis Defendant is relying on for such conclusions as Defendant has not cited any authority or evidence in support of these conclusions. *See* Response to Plaintiff's Objections to Supplemental Report at 19; Response to

Plaintiff's Supplemental Brief at 5-7 Indeed, these arguments appear to be based solely on extrinsic evidence, which is less probative than the intrinsic record. Even if these contentions are accurate and persuasive, the Federal Circuit has recognized that the invention may be for part of a process. *See* Smith & Nephew, Inc., 276 F.3d at 1311. Therefore, the fact that this construction does not render the surgery or ACL repair complete is not sufficient to invalidate it.

5. Disavowal

Defendant also argues that the construction mechanism of disavowal supports its construction that the phrase "securing the graft in the opening" is limited to advancing the implant by impaction.FN6 *See* Response to Plaintiff's Opening Brief at 17-18; Response to Plaintiff's Objections to Supplemental Report at 7-9. Specifically, Defendant suggests that, in the patent, Plaintiff has limited the manner for advancing the implant under the graft to impacting the implant and has disavowed any other manner for advancing the implant. *See id.*

FN6. Upon review of all of its briefs, it appears that Defendant makes three arguments regarding disavowal. Two of those arguments are not presently applicable. First, Defendant asserts that, in the patent, Plaintiff disavowed the use of rotational or screw-in implant in this invention. *See* Response to Plaintiff's Opening Brief at 17-18. However, neither party has requested, at any time, that the Court construe the term "implant" as it appears in the claim language. *See generally* Joint Statement. If there is a genuine dispute regarding this term and construction of the term is necessary in order to resolve this case, then the parties need to file the appropriate motion. The Court, at this point, will not determine this issue, *sua sponte,* without briefing by both parties on this issue. Additionally, Defendant argues that the Court has disavowed the method of securing the implant to the knee by rotation. *See* Response to Plaintiff's Opening Brief at 17-18. However, the Court has concluded that the claim 1 does not require that the implant be secured in the knee. Thus, whether Plaintiff has disavowed a specific method for securing the implant in the knee or whether Plaintiff has disclaimed the use of the specific type of implant are not issues currently before the Court. *See* MBO Labs., Inc., 474 F.3d at 1330-31.

The specification may reveal an intentional disclaimer or disavowal of the scope of the patent. *See* Phillips, 415 F.3d at 1316. When the patentee has dictated a specific scope for the claims in the patent, the patentee's intention, as evidenced by that disclaimer or disavowal, controls. *See id.* Likewise, "[w]hen the specification 'makes clear that the invention does not include a particular feature, that feature is deemed to be outside the reach of the claims of the patent, even though the language of the claims, read without reference to the specification, might be considered broad enough to encompass the feature in question.' " Microsoft Corp. v. Multi-Tech Sys., Inc., 357 F.3d 1340, 1347 (Fed.Cir.2004) (quoting SciMed Life Sys., Inc. v. Advanced Cardiovascular Sys., Inc., 242 F.3d 1337, 1341 (Fed.Cir.2001)); *see also* Kinik Co., 362 F.3d at 1365 (concluding that when the patent has distinguished prior art in the specification, the court cannot construe the patent as encompassing that prior art). The language in the specification must go beyond expressing a preference for a particular type of material, such as containing repeatedly derogatory statements regarding a particular material, in order to constitute a disavowal. *See* Honeywell Int'l, Inc., 452 F.3d at 1320. Additionally, when the specification describes a particular feature of the invention and criticizes other inventions that do not have that feature, then these statements evidence a clear disavowal. *See* Astrazeneca AB v. Mutual Pharmaceutical Co., 384 F.3d 1333, 1340 (Fed.Cir.2004). Disavowal also can be suggested by the absence of a criticized feature from the description of the preferred embodiments. *See* id. at 1340-41.

However, the fact that the inventor anticipated that the invention would only be used in specific manner does not limit the scope of the patent to that narrow embodiment, unless there is a clear disclaimer in the text of particular use. *See* Brookhill-Wilk 1, LLC, 334 F.3d at 1301; Liebel-Flarsheim Co., 358 F.3d at 906 ("Even when the specification describes only a single embodiment, the claims of the patent will not be read restrictively unless the patentee has demonstrated a clear intention to limit the claim scope using 'words or expressions of manifest exclusion or restriction' "). Additionally, the absence of a reference in the patent to the specific embodiment at issue in the case does not equal a disclaimer of that embodiment. *See* Liebel-Flarsheim Co., 358 F.3d at 907. Further, general statements regarding the prior art and the invention's intention to improve on prior art does not evidence a clear disavowal. *See* Ventana Med. Sys., Inc., 473 F.3d at 1181. The disavowal must be clear and cannot be ambiguous. *See* Computer Docking Station Corp., 519 F.3d at 1375, 1378 (recognizing that there would not be a disavowal when the patentee merely described the feature of the prior art and does not distinguish the current invention based on those same features). Thus, when a written description does not express a restriction on a claim term and the specification, as a whole, supports a broader construction, the ordinary meaning of the claim terms must not be limited. *See* Brookhill-Wilk 1, LLC, 334 F.3d at 1301-02.

Defendant contends that the following language in the specification evidences a clear disavowal:

A fixation technique which provides strong attachment of a semitendinosus graft in the femoral tunnel, using a transverse implant, is disclosed in U.S. Pat. No. 5,601,562, of common assignment with the present application, and incorporated herein by reference. The transverse implant is inserted through a loop in a tendon graft. A threaded portion of the implant screws into the bone as the implant is advanced with rotation into the repair site. The technique is disadvantageous, however, because the graft can become wrapped around the implant as it is rotated.

Amended Complaint Ex. A at col. 1, lns. 53-64. However, the undersigned finds that this statement does not evidence a clear disavowal or limitation on the manner in which the implant is advanced into the opening. First, this paragraph provides that the "implant is inserted through a loop in a tendon graft." *Id*. at col. 1, lns. 57-58. There is no limitation on the manner in which the implant is inserted under the graft. This language appears to describe the same action set forth in claim 1 as advancing the implant into the opening and under the graft. Thus, the portion of the paragraph regarding advancing the implant by rotation relates to the manner in which the implant is secured in the knee and not an explanation of how the implant is placed under the graft. As explained *supra,* the Court finds that the "securing" clause does not require the implant to be secured in the knee. Thus, this language allegedly evidencing a disavowal does not relate to the act of advancing the implant into the opening and under the graft.FN7

FN7. Even if this language could be interpreted as relating to the act of advancing the implant, the Court would not be inclined to find it sufficient to warrant a finding of clear disavowal. *See* Ventana Med. Sys., Inc., 473 F.3d at 1181 (concluding that general statements by an inventor "indicating that the invention is intended to improve upon prior art" will not result in a disavowal or disclaimer of every feature of the prior art).

Additionally, there is no other language in the specification that would support the conclusion that the patentee has disavowed or limited the manner for advancing the implant to impaction. Indeed, while in the Summary of the Invention, the patentee suggested that the implant could be advanced by impaction, the

language of the patent establishes that these are mere examples of the ways in which the technique could be implemented. *See* Amended Complaint Ex. A at col. 2, lns. 37-38 & col. 3, lns. 7-8 (indicating that "the technique ***can be implemented*** using a transverse implant that is advanced by impaction into the bone" and "the implant easily ***can be*** impact driven into the repair site"); *see also* Purdue Pharma, L.P., 438 F.3d at 1136 (concluding that there was no disclaimer when the specification presented the limitation at issue was not presented as a necessary feature of the invention); Kinik Co., 362 F.3d at 1364. As a result, it would be improper to limit the patent to these examples. Finally, as noted *supra,* if the Court were to construe the claim language as limiting the manner of advancing to impacting, this construction would exclude the method described in the preferred embodiment in which the implant is "advanced by hand." Amended Complaint Ex. A at col. 6, ln. 6; *see also* Ventana Med. Sys., Inc., 473 F.3d at 1180 (refusing to construe a claim in a manner which would disavow coverage of the preferred embodiment).

In light of the foregoing, the undersigned finds that the patentee did not disavow or disclaim all methods, other than impaction, for advancing the implant into the opening and under the graft. Thus, there is no basis for construing the phrase "securing the graft in the opening" in a more restrictive manner the definition suggested by the ordinary meaning of those terms.

6. Extrinsic Evidence

Although both parties have cited and provided the Court with extensive materials constituting extrinsic evidence, *see, e.g.,* Response to Plaintiff's Objections to Supplemental Report at 19; Response to Plaintiff's Supplemental Brief at 5-7; Plaintiff's Objections to Supplemental Report at 9, 11, the Court need not consider those materials in construing the claim language at issue in this case because the plain language of the claims as well as the specification resolves any ambiguity in the disputed claim terms and fully supports the Court's construction. *See* Brookhill-Wilk 1, LLC, 334 F.3d at 1304.

IV. Conclusion

The construction of the phrase "securing the graft in the opening" has been a cumbersome task. However, upon consideration of the claim language as well as the patent as a whole, the undersigned concludes that the ordinary and customary meaning of the phrase "securing the graft in the opening" is to advance the implant into the opening and under the graft. It does not require the transverse implant to be secured in the knee and the manner of advancing the implant is not limited to impaction.FN8

FN8. This conclusion does not foreclose the possibility that a commercial embodiment of this patent may advance the implant, by impaction or another method, under the graft, and result in securing the implant in the knee. *See* Kinik Co., 362 F.3d at 1366; Free Motion Fitness, Inc., 423 F.3d at 1347 (finding that "[t]he addition of unclaimed elements does not typically defeat infringement when a patent uses an open transitional phrase such as 'comprising' "); *see also* Smith & Nephew, Inc., 276 F.3d at 1311. The Court simply concludes that the act of securing the implant in the knee is not covered by claim 1 and that there is no limitation on the manner in which the implant is advanced as long as the implant enters the opening and is placed under the graft. As the claim uses the term of art "comprising," the commercial embodiment may include additional acts or steps not mentioned in the claim. *See* Free Motion Fitness, Inc., 423 F.3d at 1347 (finding that "[t]he addition of unclaimed elements does not typically defeat infringement when a patent uses an open transitional phrase such as 'comprising' "); Cias, Inc. v. Alliance Gaming Corp., 504 F.3d 1356, 1360 (Fed.Cir.2007). That term means " 'including but not limited to' " and " 'is generally understood to signify that the claims do not exclude the presence in the accused device or method of factors in addition to those explicitly recited.' " Cias, Inc., 504 F.3d at 1360. As a result, the act of advancing the implant under

the graft and securing the implant in the knee may be performed in one step, as Defendant suggests, *see* Response to Plaintiff's Supplemental Brief at 6, but this claim language does not require it.

Based upon the undersigned's review of all of the intrinsic evidence as well as the extensive briefing on this issue, the undersigned concludes that the foregoing establishes the correct construction of the phrase "securing the graft in the opening" and satisfies the parties' request for the Court to construe the "securing" clause of claim 1. At this point, despite Plaintiff's suggestion to the contrary, there does not seem to be a genuine dispute regarding the construction of the terms "securing the implant" in claim 3. Consequently, the Court has construed all of the terms requested by the parties. As the undersigned's construction appears to be inconsistent with the Magistrate Judge's recommended construction of these terms, the Court has no choice but to respectfully reject the Magistrate Judge's recommendation in the Supplemental Report.

Accordingly, it is hereby **ORDERED:**

1. The phrase "securing the graft in the opening" means advancing an implant into the opening and under the graft. It does not require that the implant be secured in the knee and the manner for advancing the implant is not limited to impaction.

2. As a result of the foregoing claim construction, the Supplemental Report and Recommendation (Dkt. No. 176) is rejected and Plaintiff Arthrex, Inc.'s Objections to the Supplemental Report and Recommendation Issued by Magistrate Judge Frazier (Dkt. No. 177) are overruled, in part, and sustained, in part.

3. Given that all of the claim construction issues have been resolved, the parties shall have until **SEPTEMBER 30, 2008,** to confer and file a notice with the Court indicating how they intend to proceed in this action.

DONE AND ORDERED.

M.D.Fla.,2008.
Arthrex, Inc. v. Depuy Mitek, Inc.

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