# FEDERAL CIRCUIT PATENT LAW CASE UPDATE

Norian Corp. v. Stryker Corp., 05-1172 (Fed. Cir. Dec. 6, 2005) (Bryson, J.)

In a suit where Norian asserted its patent related to rapidly setting calcium phosphate compositions used in dentistry, the court affirmed the district court summary judgment that the patent was not infringed. There was no infringement because a claim to a "kit" was "closed" by use of the transition phrase "consisting of." That same claim recited "a sodium phosphate" which, in light of the closed nature of the claim, meant a single sodium phosphate was used to make the composition.

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Norian owns U.S. Pat. No. 6,002,065.

> The '065 patent is for a kit containing the ingredients that are combined to produce the rapidly setting calcium phosphate composition.

The primary claim term at issue was "a sodium phosphate" in a claim with the transition phrase "consisting of."

The district court construed this combination to mean that Stryker's accused product did not infringe because it did not use only a single type of sodium phosphate when it was made. The court agreed with this approach.

> [T]his court has interpreted the word "a" in its singular sense when, as in this case, it has been used in conjunction with the closed transitional phrase "consisting of." . . . That interpretation is consistent with the specification, as the district court ruled. In particular, example 3 of the specification includes a chart listing the different setting times that are associated with different solutions. Each of the listed solutions contains a single solute, which is either a type of sodium phosphate or a type of sodium carbonate. While the scope of a claim is not necessarily limited to the examples disclosed in the specification, nothing in the '065 patent specification points away from the district court's construction limiting claim 8 to single-solute solutions. . . . The district court was also correct to rely on the prosecution history, which reflects a series of patentability rejections, followed by narrowing amendments and clarifying explanations from the prosecuting attorney. The prosecution history shows that through the series of amendments, Norian surrendered significant scope for what became claim 8. In response to one series of rejections, Norian narrowed the claim by changing the transitional phrase in the claim's preamble from "comprising" to "consisting essentially of" and then ultimately to "consisting of."

The court rejected Norian's argument that the claim construction too aggressively narrowed the claim scope based on the prosecution history.

> The problem with that argument is that there is no principle of patent law that the scope of a surrender of subject matter during prosecution is limited to what is absolutely necessary to avoid a prior art reference that was the basis for an examiner's rejection.

Due to the claim amendments during prosecution, the court also disagreed that the DOE should apply. There was claim scope surrender, and Norian did "not suggest that this case falls within one of the exceptions to the rule of prosecution history estoppel."



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