

United States District Court,
S.D. Indiana, Indianapolis Division.

ADVANCED CARDIOVASCULAR SYSTEMS, INC., and Guidant Sales Corporation,
Plaintiff.

v.
SCIMED LIFE SYSTEMS, INC., and Boston Scientific Corporation,
Defendants.

No. IP 98-1108-C H/G

Feb. 9, 2000.

ENTRY ON DEFENDANTS' MOTION FOR SUPPLEMENTAL CLAIM CONSTRUCTION

HAMILTON, J.

On October 15, 1999, the court issued its Entry on Claim Construction Issues following the scheduled briefing and a hearing on such issues. On November 19, 1999, defendants Scimed Life Systems, Inc. and Boston Scientific Corporation filed a motion for additional findings on claim construction issues and reconsideration on one issue.

Defendants first assert that the term "connecting element" in the Lau patents should be limited to "a straight connector that is generally parallel to the longitudinal axis of the stent." Defendants contend this definition is justified by the court's approach to other terms in the patent claims, in which the court relied on the patent specifications and prosecution history to narrow certain key terms in the claims. In fact, the court took this approach with the term "connecting element," limiting its meaning, as plaintiffs argued, to "an element of the stent that connects adjacent cylindrical elements." Defendants now seek to add two additional limitations to the term "connecting element:" (1) that the connecting element be straight, and (2) that it be generally parallel to the stent's longitudinal axis.

Plaintiffs object first and most vehemently to the timing of the motion, arguing that it comes far too late and that it disrupts the orderly schedule established by the parties and by the court for dealing with contested claims construction issues well before trial. The court will not rely on that basis for deciding the motion.

FN1

FN1. Both sides have sought occasional relief from a fairly ambitious schedule to bring the case to trial promptly. For example, plaintiffs have recently filed a motion for leave to file a belated motion *in limine*.

Defendants have based their motion primarily on the argument that the court should apply a consistent methodology in resolving arguments that pit the doctrine of claim differentiation against the details set forth in the specifications or prosecution history of the patents. Defendants believe the court erred by rejecting

their claim differentiation arguments on two important issues. In the new motion, defendants contend in essence that, because the court was willing to find that the principle of claim differentiation had been overcome by the specifications on several points argued by plaintiffs, the court should take the same approach and add some limitations proposed by defendants to narrow broader claim language.

Plaintiffs, in turn, rely on the principle of claim differentiation to oppose defendants' proposed additional limitations on the term "connecting element." In the '955 patent, the term "connecting element" appears without the limitations proposed by defendants. In the '158 patent, dependent Claim 3 limits the term "connecting element" to the "stent of claim 2 wherein said connecting elements are generally straight." In the '154 patent, Claim 12 refers to "generally parallel connecting elements." The same limitation appears in Claim 4 of the '158 patent. These efforts at differentiation between claims tend to weigh against imposing the limitations on the term where it was used without the limitations imposed in some of the claims. However, based on the prosecution history of the '154 patent, the court has construed the "generally parallel" language in Claim 12 of the '154 patent to mean generally parallel both to each other and to the longitudinal axis of the stent. Entry on Claims Construction Issues at 27.

The issue now is whether this limitation of being generally parallel both to each other and to the longitudinal axis of the stent should apply to all uses of "connecting elements" in the Lau patents, including those that do not refer specifically to "generally parallel" connecting elements. Plaintiffs contend the prosecution history the court used to limit the term in Claim 12 of the '154 patent is limited to that claim. The court disagrees.

To overcome the principle of claim differentiation, a party must make a persuasive showing, based ordinarily on the patent's specification and/or prosecution history, that no other interpretation is viable. See, e.g., *Laitram Corp. v. Rexnord, Inc.*, 939 F.2d 1533, 1538 (Fed.Cir.1991); *O.I. Corp. v. Tekmar Co., Inc.*, 115 F.3d 1576, 1582 (Fed.Cir.1997).

A patent's specification often provides the strongest source for construing claim language, including narrowing the construction of claim language. Defendants have not pointed to language in the patents' specifications showing that the "connecting elements" must be straight or that they must be generally parallel to the longitudinal axis of the stent. Defendants also have not shown that the connecting elements in the Lau patents must be straight and must be generally parallel to the longitudinal axis to function and to provide the claimed benefits of the Lau invention.

However, a patent's prosecution history also provides evidence for claim construction. In the court's initial claim construction decision, the court interpreted the language in Claim 12 of the '154 patent that referred to "a plurality of generally parallel connecting elements for interconnecting said cylindrical elements...." The court construed the phrase "generally parallel" to mean that the connecting elements must be generally parallel to each other and to the longitudinal axis of the stent. Entry at 25-27. This construction resulted from the prosecution history, in which the '417 Palmaz patent was distinguished on the basis that it had connecting elements in a "non-parallel relationship with respect to the longitudinal axis." See Entry at 26, citing Ex. 7 at 0018-19.

Such efforts to distinguish prior art in the prosecution history provide powerful evidence in construing a claim. In light of the '417 Palmaz patent, the court sees no reason that the requirement that connecting elements be generally parallel to the longitudinal axis of the stent should not apply to any use of the term "connecting elements" in the Lau patents. Otherwise, the connecting elements would not be distinguishable

from the non-parallel elements in the '417 Palmaz patent. The court therefore concludes that the term "connecting element" in the Lau patents should be interpreted to mean connecting elements that are generally parallel to the longitudinal axis of the stent. Defendants have not shown from the specifications or prosecution histories, however, that there are similarly powerful reasons to add the qualification that the connecting elements must be "straight." FN2

FN2. As explained in the court's separate entry on defendants' motion for summary judgment, however, the court finds that the undisputed facts show that the curved "connecting elements" in the defendants' NIR stent are not and cannot be "generally parallel" as the term is used in the Lau patents. Also, if the connecting elements claimed in the Lau patents must all be generally parallel to the longitudinal axis, they should all be generally parallel to each other.

Defendants have also asked the court to declare that a "cylindrical element" in the Lau stents is "an individual structure in a stent," rather than a "segment of a stent," which defendants contend is ambiguous. The court sees no ambiguity here. Defendants' proposal to refer to "an individual structure in a stent," especially when the stent is cut out of one continuous piece of tubing, is only an invitation for more ambiguity and confusion. Defendants' request on this point is denied.

Defendants also ask the court to reconsider its interpretation of the term "cylindrical element" in the Lau patents as excluding a wire loop closed by a knot or hitch, as disclosed in the MacGregor stent patent. Without rehashing all the details of the issue, the court sees no persuasive basis for defendants' proposed interpretation, which would disregard the prosecution history. Defendants' interpretation also would apply to the claims in the Lau patents an interpretation far broader than the Patent & Trademark Office could have relied upon in issuing the patents. Defendants' interpretation would also be far broader than other inventors could reasonably have relied upon in developing their own inventions.

Accordingly, defendants' motion for supplemental claim construction is denied, except that the term "connecting element" in all the Lau patents will be construed to mean connecting elements that are generally parallel to the longitudinal axis of the stent.

So ordered.

S.D.Ind.,2000.

Advanced Cardiovascular Systems, Inc. v. Scimed Life Systems, Inc.

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