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IP NEWSLETTER

TAKE CARE IN USING A TERM IN A CLAIM AND SUBSEQUENTLY NARROWING THE SCOPE

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While a term such as “bonded” in a claim can include many types of adhesive connection, the term can be specifically narrowed to the use of a particular adhesive means depending on the patent specification and prosecution.

The U.S. Court of Appeals for the Federal Circuit, in *Marctec, L.L.C. v. Johnson & Johnson and Cordis Corporation* affirmed a District Court decision which constructed the term “bonded” in U.S. 7,128,753 and U.S. 7,217,290 to mean “bonded by the application of heat.”

The accused product, which the District Court found did not infringe U.S. 7,128,753 and U.S. 7,217,290, was a stent for implantation into patients, where the stent has a slotted metal tube bonded to a matrix comprised of two polymers, where, during the manufacturing process called “solution casting” the polymer and drugs are dissolved in a volatile solvent, and the resulting solution is sprayed onto the stents and dried to leave the polymer/drug coating “bonded” to the stents. The solution coating process is done at room temperature, with no heat applied.

The District Court construed the claim as requiring the application of heat and found, in summary judgement, that the patents were not infringed.

The ‘753 broad claim is to an implantable surgical device where a polymer material is “bonded” to the implant, the polymeric material being non-flowable and non-adherent at room temperature and becomes flowable, tacky, and “adherent upon the application of heat.” The ‘290 broad claim is also to an implant where a first component is “bonded” to a tubular member and formed of a “heat bondable material” which is non-flowable and non-adherent at room temperature, and becomes flowable, tacky, and “adherent upon the application of heat.”

Marctec argued that because dependent claim 8 of the '753 patent required a device "wherein the polymeric material is bonded to the implant by the application of heat," the doctrine of claim differentiation undermines the construction the District Court gave to the term "bonded" in the broad claim. The Court found that even if the construction of the broad claim rendered the dependent claim superfluous, the doctrine of claim differentiation cannot broaden claims over and above the specification, prosecution history and relevant extrinsic evidence.

The Court referred to the discussion of bonding in the specification, arguments made during prosecution, and claim amendments, and the District Court's finding that the prosecution record shows heat bonding as a condition of patentability, and not merely a preferred method of bonding, and held that prosecution estoppel prevents Marctec from recovering claim scope that includes bonding without the application of heat.

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