

No. 11-1154

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IN THE  
**Supreme Court of the United States**

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RETRACTABLE TECHNOLOGIES, INC. AND  
THOMAS J. SHAW,

*Petitioners,*

*v.*

BECTON, DICKINSON AND COMPANY,

*Respondent.*

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ON PETITION FOR A WRIT OF CERTIORARI TO THE  
UNITED STATES COURT OF APPEALS  
FOR THE FEDERAL CIRCUIT

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**BRIEF IN OPPOSITION**

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## QUESTIONS PRESENTED

1. Whether the Court should abandon the well-established rule that a patent's claims must be interpreted in light of the description of the invention in the patent's specification in favor of a rule of interpretation divorced from the specification, based upon the incorrect premise that the claim term "body" in this case has a clear and unambiguous meaning that can be understood without reference to the patent's specification.

2. Whether the Court should abandon the de novo standard of appellate review for issues of patent claim construction, even though Petitioners urged de novo review before the Federal Circuit and the claim construction ruling in this case did not rest on any factual findings that could receive deference.

## **CORPORATE DISCLOSURE STATEMENT**

Respondent and Cross-Petitioner Becton, Dickinson and Company (“BD”) has no parent corporation and no publicly held company owns 10% or more of its stock.

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**BRIEF IN OPPOSITION**

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**INTRODUCTION**

Petitioners Retractable Technologies, Inc. and Thomas J. Shaw (collectively “RTI”) attempted to expand their patent rights beyond the scope of their claims as understood in light of the description of the invention set forth in their patents. Nothing in the Federal Circuit’s case-specific rejection of that attempt warrants review.

RTI was not the first to invent a retractable safety syringe, and it accordingly described its invention narrowly to avoid claiming the work others had previously done. Among other things, RTI’s patents described the invention as a syringe having a one-piece hollow outer body, unlike those having multi-piece bodies that others

had previously patented. A192 1:55-57, 2:1-2; A193 3:10-18.<sup>1</sup> Consistent with this description, the Federal Circuit correctly interpreted the claim term “body” to exclude syringes that, like BD’s 3mL Integra syringe, have multi-piece bodies in which the needle assembly is housed in a separate piece that screws onto the syringe barrel.

Contrary to RTI’s assertion, this case is not part of a larger split on the proper *approach* to claim construction. There is broad agreement on the Federal Circuit that patent claims should not be read in isolation but rather should be given their ordinary meaning as understood by a person of ordinary skill in the art who reads the claims in the context of the specification and prosecution history.<sup>2</sup> Indeed, the Federal Circuit resolved this issue in *Phillips v. AWH Corp.*, 415 F.3d 1303 (Fed. Cir. 2005) (en banc), *cert. denied*, 546 U.S. 1170 (2006)—a case RTI previously praised for providing “certainty and consistency in claim construction.” RTI Reh’g Pet. 6.

The cases RTI cites as evidence of a supposed “split” in authority (Pet. 13-16) are simply case-specific examples of disagreements as to the *application* of these generally accepted principles. This case is at most another example of a disagreement as to the result, not a dispute as to general principles of claim construction.

Regardless, this case is not a good vehicle to consider the question that RTI purports to present. The

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<sup>1</sup> “A\_\_\_\_\_” refers to the Court of Appeals Appendix.

<sup>2</sup> A patent’s specification includes both the written description of the invention and the claims. To maintain consistency with RTI’s petition, BD follows the common practice of using the terms “specification” and “written description” interchangeably. Pet. 9 n.4.

premise of RTI’s petition is that the term “body” has a clear and unambiguous meaning that can be discerned without reference to the specification. Pet. 21. But as BD argued below, “body” is at best ambiguous; it is a general, imprecise word that can have different meanings depending on context and thus cannot be interpreted in isolation. BD Reh’g Opp. 1-2, 6. The Federal Circuit was accordingly correct to look to the specification for guidance on the term’s meaning. App. 18a.<sup>3</sup> Indeed, RTI’s own amicus agrees that the specification should be consulted to interpret an ambiguous claim term. Ctr. for Intellectual Prop. Research Amicus Br. 11. And RTI itself successfully urged the Federal Circuit to construe several related claim terms on grounds that cannot be reconciled with the interpretative approach RTI now advocates as to the term “body.” See Conditional Cross-Pet. for Cert. 23-38, No. 11-1278 (“BD Cond. Cross-Pet.”).

Perhaps recognizing that the Federal Circuit correctly applied uncontroversial principles of claim construction to the term “body,” RTI challenges for the first time the standard of appellate review of claim construction rulings. Not only did RTI waive the issue by failing to raise it below, it expressly urged the Federal Circuit to apply *de novo* review. RTI C.A. Br. 27.

Even ignoring RTI’s waiver, its challenge to the standard of review can have no effect on the outcome of this case. The district court made no credibility determination or other factual finding that could be entitled to deference. As a result, this case is not a proper vehicle for addressing RTI’s late-raised challenge to the standard of review. The petition should be denied.

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<sup>3</sup> “App.” refers to the appendix to RTI’s petition.

## STATEMENT

### A. Factual Background

BD is a global leader in the design and manufacture of retractable safety syringes and owns several patents reflecting pioneering work in this field. RTI also manufactures retractable syringes and holds several patents concerning the technology. RTI's patents include detailed descriptions and claims to distinguish them from the work that others had previously done, including the prior art on which BD based the design of the syringes at issue in this case. *See* BD Cond. Cross-Pet. 3-5.

#### 1. RTI's patents

This case involves three of RTI's patents: U.S. Patent Nos. 5,632,733 ("the '733 patent"), 7,351,224 ("the '224 patent"), and 6,090,077 ("the '077 patent"). These patents share a common specification. BD's conditional cross-petition discusses in detail the retractable syringes described and claimed in RTI's patents. BD Cond. Cross-Pet. 5-11.

RTI's patented syringes claim to be different from the prior art because they have a one-piece hollow outer body design. The patents specifically criticize prior art designs having multi-piece syringe bodies. A192 1:55-57, 2:1-2. According to RTI's patents, the prior art had not recognized that retractable syringes could be "molded as a one piece outer body," with the internal parts being placed into the syringe from behind. A192 2:27-39. RTI's "Summary of the Invention" thus describe its own invention as follows:

The invention is a reliable retractable tamperproof syringe .... The syringe structure features a one piece hollow outer body ....



A193 3:10-18. Consistent with this description of the invention, every embodiment described in RTI's patents features a one-piece body (A195 7:1-3; A197 11:34-35), and RTI attributed their ease of manufacture to their one-piece design (A200 17:43-48).

RTI's patented syringes also use a specific needle retraction mechanism. Rather than cutting or breaking internal parts to trigger the needle's retraction into the syringe body, RTI's patents use frictional force to hold the needle in place until it is released by depressing the plunger. A195 8:16-23; A196 9:43-10:27; *see also* BD Cond. Cross-Pet. 7-9. RTI again criticized prior art syringes that retract the needle by "flexing or breaking of internal parts" or requiring a diaphragm at the end of the plunger to be "penetrated." A192 1:57-61. According to RTI, such prior art designs pose "serious quality control and assembly problems." A192 1:61-64.

## 2. BD's accused devices

BD has made several safety syringes, including the 3mL and 1mL Integra,<sup>4</sup> that operate in fundamentally different ways from those described in RTI's patents. For example, BD's 3mL Integra, which is the subject of RTI's petition, features a two-piece syringe body. *See* BD Cond. Cross-Pet. 12-14. Moreover, unlike the frictional release mechanism described in RTI's patents (*see id.* 7-9), BD's 3mL Integra and the smaller 1mL Integra use a circular knife to cut the internal parts of the syringe and trigger the needle's retraction into the syringe body (*see id.* 13, 15).

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<sup>4</sup> BD no longer sells the 1mL Integra. BD C.A. Br. 44 n.4.

Despite these critical differences, RTI accused BD's 3mL Integra of infringing the '224 and '077 patents and BD's 1mL Integra of infringing the '733 and '224 patents.

### **B. District Court Proceedings**

Before trial, the district court construed several claim terms concerning the design and operation of RTI's patented syringes. App. 50a-84a. The *Markman* hearing consisted only of oral argument; the parties offered no fact or expert witness declarations and called no witnesses to testify. The district court made no credibility determinations or other factual findings relating to claim construction.

RTI's petition focuses exclusively on the court's construction of the term "body." This term had been previously construed in another case in the same district involving a different defendant, New Medical Technologies.<sup>5</sup> A704. The *New Medical* construction predated the Federal Circuit's decision in *Phillips* and, without the benefit of that decision, improperly interpreted the term "body" based upon a dictionary definition to include structures "that may be one or more pieces" (A704), despite acknowledging that the "intrinsic evidence strongly suggests that the inventor contemplated a one piece body" (A703). The district court here nevertheless found, without analysis, "no reason to deviate" from the *New Medical* construction and interpreted "body" to mean "a hollow outer structure that houses the syringe's components." App. 52a.

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<sup>5</sup> BD was not a party to that case, which settled prior to trial. See Tr. of Claim Constr. Hrg. 44, 48, Dkt. 118 (E.D. Tex. Dec. 4, 2008).

Based on this construction, as well as several others favorable to RTI (*see* BD Cond. Cross-Pet. 16-17), a jury found RTI's patents infringed and not invalid, but determined that BD's infringement was not willful and awarded RTI \$5 million in damages. A2529-2534. The district court issued a permanent injunction, which it stayed pending appeal. A12-19.

### C. Federal Circuit Proceedings

BD appealed several of the district court's erroneous claim constructions, including its interpretation of the term "body." BD argued that, in the context of RTI's patents, the term "body" excluded multi-piece structures. BD C.A. Br. 57-62. The Federal Circuit agreed (App. 18a) and, based on that construction, reversed the finding of infringement as to BD's 3mL Integra (*id.* 20a.).

The Federal Circuit ruled for RTI on the remaining issues that it addressed. In several instances, the Federal Circuit, at RTI's urging, construed claim terms in light of the patents' common specification. BD Cond. Cross-Pet. 20-21.

Chief Judge Rader dissented solely on the construction of the term "body." App. 32a-36a. He agreed with the basic principles applied by the panel, including that "the claims do not stand alone and must be read in light of the specification[]." *Id.* 33a. However, he disagreed that the term "body" as used in RTI's patents excludes multiple pieces. *Id.* 35a.

RTI petitioned for panel rehearing and rehearing en banc with respect to the court's construction of the term "body." The Federal Circuit denied rehearing, with three judges dissenting. App. 90a. Judge Moore, joined by Chief Judge Rader, acknowledged that

“claims are to be construed in the context of the entire patent, including the specification,” but argued that the panel’s application of that legal principle to this case conflicted with *Phillips*. App. 94a. Judge Moore also would have granted review to consider the standard of appellate review for issues of claim construction, an issue not raised by RTI’s petition. *Id.* 98a. Judge O’Malley separately supported revisiting the standard of appellate review, but did not “criticize the panel majority for its legal analysis” of claim construction, which she acknowledged “adhered to the broad principles of claim construction set forth in *Phillips*.” *Id.* 103a.

## REASONS FOR DENYING THE PETITION

### I. RTI’S CHALLENGE TO THE INTERPRETATION OF “BODY” IS FACTBOUND AND DOES NOT WARRANT REVIEW

#### A. There Is No Intra-Circuit Disagreement Concerning Principles Of Claim Construction

RTI’s petition is no different from many others this Court has previously denied, in which the party that loses on a case-specific issue of claim construction attempts to assert a general question regarding claim construction principles. Sometimes the petitioner argues, as RTI does here, that the Federal Circuit improperly narrowed claims by importing limitations from the specification.<sup>6</sup> Other times the petitioner argues the opposite, asserting that the Federal Circuit

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<sup>6</sup> *E.g.*, *Zimmerman v. Flagstar Bancorp*, No. 11-1112; *Akeva L.L.C. v. Adidas Am., Inc.*, No. 06-1364; *Stryker Corp. v. Pioneer Labs., Inc.*, No. 06-941; *On Demand Machine Corp. v. Ingram Industries, Inc.*, No. 06-449; *Arlaine & Gina Rockey, Inc. v. Cordis Corp.*, No. 06-353; *Izumi Prods. Co. v. Koninklijke Philips Elecs. N.V.*, No. 05-961; *Nystrom v. TREX Co.*, No. 05-950; *Gaus v. Conair Corp.*, No. 04-196; *Alloc, Inc. v. ITC*, No. 03-1187.

improperly broadened claims by failing to interpret them in light of the specification.<sup>7</sup> This Court should deny RTI’s petition just as it denied the others.

Despite RTI’s attempt to manufacture an intra-circuit conflict, the Federal Circuit resolved the issues underlying RTI’s petition in *Phillips*. Indeed, RTI previously praised *Phillips* as providing “certainty and consistency in claim construction.” RTI Reh’g Pet. 6. RTI’s about-face—which includes relabeling *Phillips* as “an unsuccessful attempt” to give guidance on claim construction issues (Pet. 12)—is not a reason for this Court to grant review.

*Phillips* reaffirmed the importance of reading claim terms in context as part of a balanced approach to claim construction. The court stressed that, in giving claims their ordinary and customary meaning as understood by a person of ordinary skill in the art, the “claims ‘must be read in view of the specification, of which they are a part.’” 415 F.3d at 1315 (quoting *Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 978 (Fed. Cir. 1995) (en banc), *aff’d*, 517 U.S. 370 (1996)); *see also id.* at 1313 (“We cannot look at the ordinary meaning of the term ... in a vacuum. Rather, we must look at the ordinary meaning in the context of the written description and the prosecution history.” (quoting *Medrad, Inc. v. MRI Devices Corp.*, 401 F.3d 1313, 1319 (Fed. Cir. 2005))); *id.* at 1316 (“In light of the statutory directive that the inventor provide a ‘full’ and ‘exact’ description of the claimed invention, the specification nec-

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<sup>7</sup> *E.g.*, *Hynix Semiconductor Inc. v. Rambus, Inc.*, No. 11-549; *Stryker Corp. v. Acumed LLC*, No. 07-304; *Medrad, Inc. v. Liebel-Flarsheim Co.*, No. 04-32; *Raritan Computer, Inc. v. Apex, Inc.*, No. 03-326; *Infineon Techs. AG v. Rambus, Inc.*, No. 03-37.

essarily informs the proper construction of the claims.”). The court thus rejected the practice of giving greater weight to the abstract meaning of claim terms, acknowledging that interpreting claims without reference to the specification would merely encourage the parties to select litigation-driven definitions that bear no resemblance to the inventor’s description of the invention. *Id.* at 1322.

*Phillips*’s emphasis on the patent’s specification as an interpretative tool is neither new nor controversial. This Court has long required such use of a patent’s specification when interpreting its claims. *E.g.*, *United States v. Adams*, 383 U.S. 39, 49 (1966) (“[I]t is fundamental that claims are to be construed in light of the specifications and both are to be read with a view to ascertaining the invention.”); *Schriber-Schroth Co. v. Cleveland Trust Co.*, 311 U.S. 211, 217 (1940) (“The claims of a patent are always to be read or interpreted in light of its specifications[.]”); *Am. Fruit Growers, Inc. v. Brogdex Co.*, 283 U.S. 1, 6 (1931) (“The claim of a patent must always be explained by and read in connection with the specification.” (quoting *Carnegie Steel Co. v. Cambria Iron Co.*, 185 U.S. 403, 432 (1902))); *Brooks v. Fiske*, 56 U.S. (15 How.) 212, 215 (1853) (“The claim, or summing up, however, is not to be taken alone, but in connection with the specification and drawings; the whole instrument is to be construed together.”); *Hogg v. Emerson*, 47 U.S. (6 How.) 437, 482 (1848) (the specification is a “component part of the patent” and “is as much to be considered with the [letters patent] in construing them, as any paper referred to in a deed or other contract”).

Even the decisions RTI cites in its petition (Pet. 18-20) recognize and apply this basic principle.<sup>8</sup> See *Smith v. Snow*, 294 U.S. 1, 14 (1935) (interpreting claim language in light of “the particular form in which the petitioner reduced the claim to practice as described in the specification[.]”); *Motion Picture Patents Co. v. Universal Film Mfg. Co.*, 243 U.S. 502, 510 (1917) (“The scope of every patent is limited to the invention described in the claims contained in it, *read in the light of the specification.*” (emphasis added)); *Cimiotti Unhairing Co. v. Am. Fur Ref. Co.*, 198 U.S. 399, 410 (1905) (courts may construe the claims “in view of the specification[.]”); *White v. Dunbar*, 119 U.S. 47, 51 (1886) (specification is appropriately consulted “for the purpose of better understanding the meaning of the claim”). Thus, RTI’s assertion that the Federal Circuit’s approach conflicts with this Court’s precedent is without merit.

*Phillips* also recognized the equally uncontroversial proposition that courts should not import limitations from the specification into the claims. 415 F.3d at 1323. Although the boundary between properly *interpreting* the claims in light of the specification and impermissibly *importing* limitations from the specification’s examples may at times be a “fine line,” it is one that *Phillips* recognized “can be discerned with reason-

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<sup>8</sup> Of course, this Court’s cases—including those RTI cites—reflect the equally uncontroversial principle that it is improper to import limitations from the specification into the claims. *E.g.*, *McCarty v. Lehigh Valley R.R. Co.*, 160 U.S. 110, 116 (1895) (refusing to import limitations from the examples in the specification to the claims). But those cases do not suggest that it is improper to interpret the claims in light of the specification. To the contrary, exercising care to avoid importing limitations from the specification is necessary precisely *because* a patent’s claims are to be read in light of its specification.

able certainty and predictability if the court’s focus remains on understanding how a person of ordinary skill in the art would understand the claim terms.” *Id.*

There is no disagreement on the Federal Circuit as to the correctness of these fundamental principles of claim construction. Even the cases RTI cites as evidence of a supposed “split” in Federal Circuit authority (Pet. 13-15) articulate and apply these same principles.<sup>9</sup> The dissenting opinions in those cases do not indicate any disagreement of *principle*, but merely a disagreement with the majority’s *application* of it to the particular claims at issue. *E.g.*, *Arlington Indus., Inc. v. Bridgeport Fittings, Inc.*, 632 F.3d 1246, 1257 (Fed. Cir. 2011) (Lourie, J., concurring in part and dissenting in part) (“[T]he basic mandate is for claims to be interpreted in light of the specification of which they are a part because the specification describes what the inventors invented.”); *Alloc, Inc. v. ITC*, 342 F.3d 1361,

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<sup>9</sup> *Arlington Indus., Inc. v. Bridgeport Fittings, Inc.*, 632 F.3d 1246, 1255 (Fed. Cir. 2011) (“This court has often acknowledged the fine line between reading a claim in light of the specification and importing a limitation from the specification into the claim.”); *Decisioning.com, Inc. v. Federated Dep’t Stores, Inc.*, 527 F.3d 1300, 1307-08 (Fed. Cir. 2008) (“[W]e acknowledge that ‘there is sometimes a fine line between reading a claim in light of the specification, and reading a limitation into the claim from the specification.’” (quoting *Comark Commc’ns, Inc. v. Harris Corp.*, 156 F.3d 1182, 1186 (Fed. Cir. 1998))); *Microsoft Corp. v. Multi-Tech Sys., Inc.*, 357 F.3d 1340, 1346 (Fed. Cir. 2004) (“Although it is improper to read a limitation from the specification into the claims, [c]laims must be read in view of the specification, of which they are a part[.]” (first alteration in original; citation omitted) (quoting *Markman*, 52 F.3d at 979)); *Alloc, Inc. v. ITC*, 342 F.3d 1361, 1370 (Fed. Cir. 2003) (“[T]his court recognizes that it must interpret the claims in light of the specification, yet avoid impermissibly importing limitations from the specification.” (citation omitted)).



1376 (Fed. Cir. 2003) (Schall, J., dissenting) (“Claim interpretation begins with the intrinsic evidence, i.e., the claims themselves, *the written description*, and, if in evidence, the prosecution history.” (emphasis added)).

This case is no different. The panel majority and dissent agreed on the basic principle that the claims must be interpreted in light of the specification. *Compare* App. 16a (“It is axiomatic that the claim construction process entails more than viewing the claim language in isolation. Claim language must always be read in view of the written description[.]”), *with id.* 33a (Rader, C.J., dissenting in part) (“Certainly, the claims do not stand alone and must be read in light of the specifications.”). They also agreed that such interpretation should not cross the line into importing limitations from the specification. *Compare id.* 17a (courts must avoid “improperly importing a limitation from the specification into the claims”), *with id.* 34a-35a (Rader, C.J., dissenting in part) (“It is improper to import limitations from the specification into the claims.”). Even the opinions dissenting from the denial of rehearing en banc echoed these fundamental principles. *Id.* 94a (Moore, J.) (“Of course the claims are to be construed in the context of the entire patent, including the specification.”); *id.* 103a (O’Malley, J.) (“I do not criticize the panel majority for its legal analysis. The majority adhered to the broad principles of claim construction set forth in *Phillips*[.]”).

RTI’s faulting of the panel majority’s use of the specification to interpret the term “body” rings hollow given that RTI itself argued that “[t]he court must always read the claims in view of the full specification.” RTI C.A. Br. 32 (quoting *SanDisk Corp. v. Memorex Prods., Inc.*, 415 F.3d 1278, 1285 (Fed. Cir. 2005)). It makes the same concession in its petition. Pet. 9 (“pa-

tent claims are construed in light of the specification”). Indeed, at RTI’s urging, the Federal Circuit used the specification to adopt several of RTI’s proposed constructions of other claim terms. App. 13a, 19a; BD Cond. Cross-Pet. 27-29.<sup>10</sup>

Nor does the Federal Circuit’s decision in this case reflect, as RTI suggests (Pet. 10-11), a growing trend of narrowing patent claims based on the specification. In fact, the Federal Circuit interpreted the ’224 and ’733 patents broadly to cover syringes that work by cutting because, in its view, the specification’s disclaimer of cutting did not amount to an “expression[] of manifest exclusion or restriction, representing a clear disavowal of claim scope.” App. 19a (quoting *Epistar Corp. v. ITC*, 566 F.3d 1321, 1335 (Fed. Cir. 2009)); *see also* BD Cond. Cross-Pet 29. RTI’s petition ignores the Federal Circuit’s balanced approach to the use of the specification in interpreting the claims, as demonstrated both in this case and by the court’s recent and repeated refusals to adopt narrow claim constructions based upon statements in the specification. *E.g.*, *Digital-Vending Servs. Int’l, LLC v. Univ. of Phoenix, Inc.*, 672 F.3d 1270, 1275-1277 (Fed. Cir. 2012); *Thorner v. Sony Computer Entm’t Am. LLC*, 669 F.3d 1362, 1368 (Fed. Cir. 2012); *Dealertrack, Inc. v. Huber*, 674 F.3d 1315, 1322

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<sup>10</sup> As set forth in BD’s conditional cross-petition, BD disagrees with the Federal Circuit’s specific conclusions with respect to these other claim terms because BD’s proposed constructions found much greater support in the claims and specification than RTI’s proposed constructions did. Those issues, like the one RTI’s petition presents, are case-specific, and none warrants review. However, if the Court considers RTI’s granular arguments concerning the term “body,” it should likewise consider BD’s arguments concerning the several claim terms on which RTI prevailed.

(Fed. Cir. 2012); *Markem-Image Corp. v. Zipher Ltd.*, 657 F.3d 1293, 1300-1301 (Fed. Cir. 2011) (per curiam).

RTI accordingly has not identified any actual disagreement in principle that extends beyond the facts of any particular case. At most, it has shown that claim construction can produce instances where reasonable judges can disagree. But this Court's review of a case-specific claim construction dispute in this case will not and cannot alter that.

**B. This Case Is A Poor Vehicle For Review Of The Role Of The Specification In Claim Construction**

**1. RTI's petition incorrectly assumes that the term "body" is unambiguous**

Even if RTI were correct that this Court should consider whether it is proper to use the specification to "alter the meaning of clear terms in the patent claim" (Pet. 9), that question is actually not presented here. RTI's entire argument depends upon the false premise that the term "body" has a clear, unambiguous meaning that can be understood without reference to the patent's specification. But contrary to RTI's assertion that neither party disputed that "body" has a single "plain meaning" (Pet. 21<sup>11</sup>), BD argued below that "body" is ambiguous and requires reference to the specification to interpret. BD Reh'g Opp. 1 ("RTI's argument that the specification can be ignored is based on the incorrect premise that 'body' has a plain and unambiguous meaning that encompasses multi-piece structures."). If anything, it was RTI that failed to assert

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<sup>11</sup> RTI's only citation for its assertion is Judge Moore's dissent from denial of rehearing en banc, which cites nothing at all. App. 96a.

before the Federal Circuit panel that the term has a clear and unambiguous meaning, instead relying heavily on other arguments in support of its proposed interpretation. RTI C.A. Br. 48-52.

This Court has long held that the patent’s specification may be consulted to construe ambiguous claim terms. *E.g.*, *Graver Tank & Mfg. Co. v. Linde Air Prods. Co.*, 336 U.S. 271, 277 (1949) (ambiguity in claim language justifies “resort to the specifications” to aid claim construction); *Bates v. Coe*, 98 U.S. 31, 38 (1878) (“[I]n case of doubt or ambiguity it is proper in all cases to refer back to the descriptive portions of the specification to aid in solving the doubt or in ascertaining the true intent and meaning of the language employed in the claims.”). And RTI’s own amicus recognizes that the specification may aid in claim construction where such ambiguity exists. Ctr. for Intellectual Prop. Research Amicus Br. 11 (acknowledging proper use of the specification in claim construction where “the ordinary meaning of claim language is ambiguous or where there is more than one ordinary meaning”).

Accordingly, the question on which RTI seeks review—whether a court may use the specification to “depart from the plain and ordinary meaning of a term in a patent claim” (Pet. i)—is not even presented in this case. The term “body,” standing alone, is imprecise and at best ambiguous. It has usages as varied as the human body, the body of a car, a body of water, the body of an essay, or the body politic. Nor is it clear that a “syringe body”—particularly one with “a front end *portion* and a back end *portion*” (A202 22:38-39 (emphasis added))—refers to more than one piece. The term accordingly cannot be understood without reference to the relevant context, including the patents’ common specification. Were the Court to grant review, it could

not even reach the question on which RTI petitions without first deciding the threshold question *whether* the claim term “body” is ambiguous—a question that even RTI does not contend is worthy of review.

**2. Even if RTI prevailed as to the construction of “body,” the ultimate result in this case would be the same**

This case’s weakness as a vehicle for review is reinforced by the fact that, even if RTI were correct in its approach to the term “body” (though it is not, *see infra* pp. 19-21), RTI has taken inconsistent positions with respect to three related claim terms on which it prevailed. Even-handed application of RTI’s proposed rule would result in judgment for BD on other grounds.

*First*, at RTI’s urging, the Federal Circuit narrowed the term “retainer member” based on the specification. *See* BD Cond. Cross-Pet. 31-36. The claims of the ’224 and ’733 patents list the “retainer member” and “needle holder” as separate elements of the invention, giving rise to the implication that they constitute separate pieces. *See Becton, Dickinson & Co. v. Tyco Healthcare Grp., LP*, 616 F.3d 1249, 1254 (Fed. Cir. 2010) (“Where a claim lists elements separately, ‘the clear implication of the claim language’ is that those elements are ‘distinct component[s]’ of the patented invention.” (quoting *Gaus v. Conair Corp.*, 363 F.3d 1284, 1288 (Fed. Cir. 2004))). Nevertheless, adopting RTI’s arguments based on statements in the specification, the Federal Circuit held that the “retainer member” can be part of the same piece as the separately identified “needle holder.” App. 14a. Application of RTI’s strict emphasis on “plain and ordinary meaning” to the “retainer member” limitation would result in a judgment for BD.

*Second*, RTI successfully urged the Federal Circuit to interpret the “lodging” limitation in claim 25 of the ’077 patent in a manner inconsistent with the term’s plain meaning. BD Cond. Cross-Pet. 25-28. In particular, RTI affirmatively relied on statements in the specification to alter the plain meaning of “lodging” to avoid invalidating prior art. *Id.* 27-28. If the principles RTI advocates in its petition are applied to the “lodging” limitation, BD would still be entitled to judgment of non-infringement for the ’077 patent.

*Third*, RTI’s petition is in tension with the Federal Circuit’s ruling for RTI on whether the ’224 and ’773 patents cover syringes that operate by “cutting.” *Id.* 36-38. RTI alleges that, with respect to “body,” the Federal Circuit improperly relied on the specification in the absence of “explicit re-definition or disclaimer.” Pet. 11. But if there was error, it was not in the court’s construction of the ambiguous term “body” in light of the specification’s clear definition of “[t]he invention” as a syringe that “features a one piece hollow outer body.” A193 3:12, 16-17. Rather, it was in the court’s reticence to recognize the clear disavowal on the “cutting” issue. BD Cond. Cross-Pet. 37-38. A correct interpretation of the ’224 and ’773 patents to exclude devices that work by “cutting” would also lead to judgment of non-infringement.

RTI cannot prevail if the Court were to address these claim limitations consistently with the approach outlined in RTI’s petition. As a result, this case is a poor vehicle for review: if RTI’s approach were consist-

ently applied, the ultimate outcome of this case would be the same.<sup>12</sup>

**C. The Federal Circuit Construed “Body” Correctly**

**1. In context, the term “body” does not include multiple pieces**

The Court should deny RTI’s petition for the further reason that the Federal Circuit’s claim construction decision is correct. The term “body,” as used in RTI’s patents, is limited to single-piece structures. The common specification of the three patents criticizes the design of prior art syringes containing multi-piece bodies and distinguishes RTI’s invention on the basis that it contains a supposedly superior one-piece body. A192 1:55-57, 2:1-2, 2:27-39. Moreover, RTI’s “Summary of the Invention” expressly defines “the invention” as a syringe structure featuring “a one piece hollow outer body.” Thus, a syringe containing a one-piece hollow outer body is not merely an embodiment of RTI’s claimed invention; it is *the invention*.<sup>13</sup> Cf. *Astrazeneca AB v. Mutual Pharm. Co.*, 384 F.3d 1333, 1340 (Fed. Cir. 2004) (interpreting claim in light of summary of the invention); *SciMed Life Sys., Inc. v. Advanced Cardiovascular Sys., Inc.*, 242 F.3d 1337, 1343 (Fed. Cir. 2001) (same). As a result, a person of ordinary skill in the art reading RTI’s patents would not reasonably under-

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<sup>12</sup> Indeed, not only would the ultimate judgment on the 3mL Integra still stand, but the judgment of infringement on the 1mL Integra (which the Federal Circuit left intact) would need to be reversed. BD Cond. Cross-Pet. 29 n.5.

<sup>13</sup> Consistent with RTI’s description of its invention, all of the examples described in the specification contain one-piece bodies. A195 7:1-3; A197 11:34-35.

stand that the “hollow outer body” in the asserted claims refers to anything other than a one-piece body.

As discussed above, RTI’s petition simply assumes that “body” has a clear and unambiguous meaning that matches RTI’s litigation position. Pet. 21. Previously, however, RTI did not rely on a clear and unambiguous meaning of “body,” but rather on the doctrine of claim differentiation—*i.e.*, the presumption that claims should be interpreted to avoid giving identical scope to different claims. RTI C.A. Br. 49-50; RTI Opening Claim Constr. Br. 20, Dkt. 111 (Oct. 15, 2008). The Federal Circuit rightly rejected that argument, and that decision does not warrant review.

As the Federal Circuit recognized, claim differentiation is not a rigid rule and may be overcome by contrary evidence in the specification. App. 16a (quoting *Seachange Int’l, Inc. v. C-COR, Inc.*, 413 F.3d 1361, 1369 (Fed. Cir. 2005)). Here, the presumption of claim differentiation is especially weak given that RTI sought to differentiate the asserted claims from claims of an unasserted patent that are otherwise very different in scope. *See Andersen Corp. v. Fiber Composites, LLC*, 474 F.3d 1361, 1370 (Fed. Cir. 2007) (refusing to apply claim differentiation where the claims “are not otherwise identical”). Moreover, the only other language on which RTI could base its claim differentiation argument was added *after* BD’s 3mL Integra came to market, *see* A2767 (launch of 3mL Integra in March 2002); A4230-4246 (patent amendment dated April 2002); A3537-3551 (patent amendment dated June 2007), thereby all but eliminating the presumption. *ICU Med., Inc. v. Alaris Med. Sys., Inc.*, 558 F.3d 1368, 1375-1376 (Fed. Cir. 2009) (rejecting claim differentiation argument where supposedly differentiated claim was added late in prosecution and after introduction of



the allegedly infringing product). The Federal Circuit thus correctly rejected RTI’s claim differentiation argument and interpreted the term “body” as excluding multi-piece structures.<sup>14</sup>

## 2. RTI’s policy arguments fail

Putting aside the case-specific question of the proper interpretation of the term “body,” RTI’s policy argument that consideration of the specification in claim construction creates uncertainty (Pet. 16-18) is unfounded. RTI ignores the fact that the entire public patent record—including the specification and prosecution history—serves an important public notice function. See *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 535 U.S. 722, 727 (2002) (“[t]o reduce the uncertainty” concerning a patent’s scope, “competitors may rely on the prosecution history, the public record of the patent proceedings”); *Bates*, 98 U.S. at 39 (“Accurate description of the invention is required by law ... [t]hat other inventors may know what part of the field of invention is unoccupied.”); cf. *PSC Computer Prods., Inc. v. Foxconn Int’l*, 355 F.3d 1353, 1359 (Fed. Cir. 2004) (“In essence, the written description can, at times, assist the public in understanding the notice given in the claims by explaining which portions of the rel-

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<sup>14</sup> As described in BD’s conditional cross-petition, the Federal Circuit erroneously rejected BD’s stronger claim differentiation argument concerning the “lodging” limitation in claim 25 of the ’077 patent, even though the claim differentiation was based on claims from the same patent and nothing in the specification or prosecution history rebuts the presumption. BD Cond. Cross-Pet. 26-27. If the Court considers RTI’s case-specific arguments concerning construction of the term “body,” it should also address BD’s far stronger claim differentiation argument concerning the “lodging” limitation.

evant art the patent *does not* cover.”). RTI’s exclusive focus on the abstract meaning of claim terms eliminates the important notice function that the entire public patent record performs.

Moreover, as a practical matter, RTI’s proposal to interpret claim language without reference to the specification is simply not workable given the inherent imprecision of language. *See Festo*, 535 U.S. at 731 (“Unfortunately, the nature of language makes it impossible to capture the essence of a thing in a patent application.”). That very concern motivated the Federal Circuit to reject methods of claim construction that elevate the abstract meaning of claim language over its meaning in context as determined by reference to the specification. *Phillips*, 415 F.3d at 1321. Indeed, even the scholarship that RTI cites favors reliance on the specification, rather than the claims alone, to define the scope of the invention.<sup>15</sup>

At most, RTI’s proposed rule would merely shift the claim construction battleground away from the specification and toward the abstract meaning of claim terms. Whether words have a “plain and ordinary meaning” (Pet. i)—and what that “meaning” is—will be just as

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<sup>15</sup> *See* Dan L. Burk & Mark A. Lemley, *Fence Posts or Sign Posts? Rethinking Patent Claim Construction?*, 157 U. Pa. L. Rev. 1743, 1795 (2009) (“The indeterminacy of peripheral claiming is not something that can be fixed; it is inherent in the disjunction between what is to be described and the language that describes it.”); *see also id.* at 1747 (“[W]e could pay more attention to the patentee’s actual description of the invention and less to the words of the claims themselves in deciding the patent’s importance and coverage, thus avoiding abuse of the litigation process by patentees who invent one thing and later claim to own something else entirely.”).

subject to reasonable debate as how those words are to be interpreted in light of the specification. RTI's proposed rule would simply place off-limits an important source of interpretative guidance—the inventor's own description of the invention—without providing either the clarity or certainty that RTI purports to seek.

## **II. RTI'S NEWLY-MINTED REQUEST FOR DEFERENCE TO THE DISTRICT COURT'S CLAIM CONSTRUCTION DOES NOT WARRANT REVIEW**

The Court should also decline to review RTI's second question concerning the standard of appellate review for issues of claim construction—an issue on which RTI took the opposite position before the Federal Circuit and that ultimately can have no effect on the outcome of this case. This Court has denied no fewer than fifteen petitions raising this very issue.<sup>16</sup> The reasons for denying RTI's petition are even stronger.

### **A. RTI Has Not Preserved A Challenge To The Standard Of Review**

The Federal Circuit's overwhelming vote in this case against revisiting the *de novo* standard of review

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<sup>16</sup> *SMC Corp. v. Norgren, Inc.*, No. 09-412; *800 Adept, Inc. v. Murex Sec., Ltd.*, No. 08-859; *Rattler Tools, Inc. v. Bilco Tools, Inc.*, No. 08-394; *EML Techs., LLC v. DESA IP, LLC*, No. 06-1455; *Amgen Inc. v. Hoechst Marion Roussel, Inc.*, No. 06-1291; *Nystrom v. TREX Co.*, No. 05-950; *AWH Corp. v. Phillips*, No. 05-602; *Memorex Prods., Inc. v. SanDisk Corp.*, No. 05-456; *Merck & Co. v. Teva Pharms. USA, Inc.*, No. 05-236; *Am. Axle & Mfg., Inc. v. Dana Corp.*, No. 04-717; *Waner v. Ford Motor Co.*, No. 03-563; *Symantec Corp. v. Hilgraeve Corp.*, No. 01-1140; *Tegal Corp. v. Tokyo Electron Am., Inc.*, No. 01-962; *Manchak v. Severson Envtl. Servs., Inc.*, No. 99-1784; *Seagate Tech, Inc. v. Rodime PLC*, No. 99-573.

for claim construction is hardly surprising. RTI never raised the issue below and has waived its right to seek review of it now. Indeed, contrary to the arguments in its petition, RTI expressly urged the Federal Circuit to apply *de novo* review:

While the Court will review issues of claim construction *de novo*, it will not review any claim construction issues that were waived or not properly preserved for appeal.

RTI C.A. Br. 27. RTI’s affirmative advocacy of *de novo* review before the Federal Circuit is particularly telling because, as the appellee, RTI was under no obligation to brief the issue in the first place. *See* Fed. R. App. P. 28(b)(5) (appellee need not brief the standard of review “unless the appellee is dissatisfied with the appellant’s statement”). Even in its petition for rehearing *en banc*, RTI did not suggest that the panel’s use of *de novo* review was error.

This Court will not grant certiorari to address an issue where, as here, it was “not pressed or passed upon below.” *Youakim v. Miller*, 425 U.S. 231, 234 (1976) (*per curiam*). This general principle applies with equal force to questions involving the standard of review that are not properly presented.<sup>17</sup> *See, e.g., Byrd v. Workman*, 645 F.3d 1159, 1167 n.8 (10th Cir. 2011) (rejecting challenge to standard of review as waived when first presented in reply brief); *United States v. Williams*, 641 F.3d 758, 764 (6th Cir. 2011) (“[B]ecause the United

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<sup>17</sup> This case accordingly differs from cases where the appellant simply “failed to raise” the standard of review below. *E.g., Brown v. Smith*, 551 F.3d 424, 428 n.2 (6th Cir. 2008) (cited at Pet. 23 n.8). Because RTI *affirmatively advocated* for the *de novo* standard it now claims was error, the waiver is conclusive.

States failed to request that we apply plain-error review, it has forfeited any argument that we should apply that standard, and we will review Williams’s claim de novo.”); *United States v. Tapia-Escalera*, 356 F.3d 181, 183 (1st Cir. 2004) (refusing to apply clear error review where the government failed to argue that a deferential standard of review should apply); *see also Mastrobuono v. Shearson Lehman Hutton, Inc.*, 514 U.S. 52, 64 n.1 (1995) (Thomas, J., dissenting) (“[P]etitioners waived the argument that a deferential standard of review was appropriate.”); *cf. id.* at 52 n.1 (majority opinion) (refusing to consider petitioners’ argument in favor of a deferential standard of review where petitioners failed to present it in their petition).

**B. This Case Is Not An Appropriate Vehicle To Address RTI’s Argument For Deference To The District Court**

Even ignoring RTI’s waiver, this case is not a proper vehicle for considering whether a court of appeals should defer to a district court’s factual findings in claim construction, for the simple reason that the district court here made no factual findings to which an appellate court could defer. As a result, even if RTI were to prevail with respect to the standard of review of factual matters, it would not affect the claim construction in this case.

The district court confined its claim construction analysis regarding “body” to a review of a paper record, which consisted entirely of the patent claims, specification, and a prior construction of the term by a different district judge. App. 50a-52a (citing *Retractable Techs., Inc. v. New Med. Techs., Inc.*, No. 02-34, Dkt. 110 (E.D. Tex. Mar. 8, 2004)). Neither party submitted fact or expert witness declarations in connection with

claim construction, and the district court heard no live witness testimony at the claim construction hearing.

The situation was the same in the prior *New Medical* case, which formed the entire basis for the district court’s construction of “body” (App. 52a): the parties offered no witness declarations or live witness testimony in connection with claim construction. The *New Medical* construction was again based entirely on the district court’s review of the claims, specification, and a dictionary definition. A701-704.

The materials considered in this case and in *New Medical* required no credibility determinations or other “factual” findings to interpret, and neither RTI nor its amicus points to any particular materials considered as part of claim construction that would warrant deference. The Federal Circuit was equally capable of considering any issues of claim construction de novo. Indeed, RTI’s own amicus concedes that de novo review is appropriate where, as here, the district court made no credibility determinations or other factual findings in deciding issues of claim construction. Ctr. for Intellectual Prop. Research Amicus Br. 13-14.

Notably, this Court has declined to review the standard of appellate review for issues of claim construction even in cases involving extensive factual findings and credibility determinations, where the standard of review could have influenced the outcome. *See, e.g., Amgen Inc. v. Hoechst Marion Roussel, Inc.*, 469 F.3d 1039, 1044 (Fed. Cir. 2006) (Rader, J., dissenting from denial of rehearing en banc) (“[T]he trial court held a nine-day trial, including testimony of artisans informed of the meaning of ‘therapeutically effective amount’ at the time of invention.”), *cert. denied*, 550 U.S. 953

(2007). Without any hope of affecting the outcome here, the reasons for denying review are even stronger.

Even putting aside the absence of any underlying “factual” findings, this case is a poor vehicle because the district court’s construction was based entirely on a legally-flawed prior construction from *New Medical*. Without the benefit of *Phillips*, the *New Medical* district court began its analysis with a “heavy presumption” in favor of a dictionary definition of “body.” A703. Applying that “heavy presumption,” the *New Medical* court rejected a one-piece construction, even though it acknowledged that the “intrinsic evidence strongly suggests that the inventor contemplated a one piece body” and the “patentee considered a one piece body to be an important design consideration, and possibly part of the patent itself.” *Id.* *Phillips* later rejected such a preference for dictionary definitions over the intrinsic patent record. The district court here, however, found “no reason to deviate” from the *New Medical* construction and adopted it without analysis. App. 52a. The Federal Circuit rightly reassessed the claim construction, rather than simply deferring to the district court’s erroneous approach.

### **C. The Federal Circuit Applied The Correct Standard Of Review**

RTI’s waiver and the fact that a change in the standard of review would not affect the outcome of this case provide ample reason to deny review. If more were needed, the substance of RTI’s proposed rule of deference also lacks merit.

This Court’s decision in *Markman* fully supports the de novo standard of review adopted in *Cybor Corp. v. FAS Technologies, Inc.*, 138 F.3d 1448 (Fed. Cir.

1998) (en banc). RTI quotes *Markman* selectively, but ignores this Court’s discussion of the need for uniformity in matters of claim construction, which would be best served through de novo appellate review. *E.g.*, 517 U.S. at 391 (“[T]reating interpretive issues as purely legal will promote (though it will not guarantee) intra-jurisdictional certainty through the application of *stare decisis* on those questions not yet subject to interjurisdictional uniformity under the authority of the single appeals court.”). As *Markman* recognized, “[i]t was just for the sake of such desirable uniformity that Congress created the Court of Appeals for the Federal Circuit as an exclusive appellate court for patent cases” in the first place. *Id.* at 390.

RTI’s proposed rule of deference would frustrate *Markman*’s goals of “intra-jurisdictional certainty” and “interjurisdictional uniformity.”<sup>18</sup> In particular, such a rule would make it difficult to reconcile disparate results in different cases interpreting the same patent if those results were based on supposed “factual” findings entitled to deference. Two district courts, based on the records before them, could conceivably reach opposing constructions of the same patent that—under a deferential standard of review—the Federal Circuit would be powerless to reconcile. The only way to carry out the Federal Circuit’s legislatively-mandated role of producing uniformity in interpretation of patents is through de novo review of claim construction, as *Markman* indicated. Indeed, given the possibility of different results based upon where the case is filed, a

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<sup>18</sup> Before the district court, RTI touted those same principles in urging the adoption of the construction of several terms from the prior *New Medical* case. RTI Opening Claim Constr. Br. 17, Dkt. 111 (Oct. 15, 2008).



deferential standard of review would invite the very type of forum shopping that Congress created the Federal Circuit to eliminate. *See* S. Rep. No. 97-275, at 5, *reprinted in* 1982 U.S.C.C.A.N. 11, 15 (“The creation of the Court of Appeals for the Federal Circuit will produce desirable uniformity in this area of the law. Such uniformity will reduce the forum-shopping that is common to patent litigation.”).

Nor are issues of claim construction matters of simple “historical” fact to which deference would be appropriate. As this Court recognized in *Markman*, claim construction “falls somewhere between a pristine legal standard and a simple historical fact.” 517 U.S. at 388 (quoting *Miller v. Fenton*, 474 U.S. 104, 114 (1985)). The primary issue to be resolved through claim construction is not “what happened” but rather “what does the patent mean,” which “is one of those things that judges often do” when they construe any written instrument. *Id.* As a result, it is “doubtful” that credibility determinations will ordinarily play any role in that analysis, *id.* at 389, and such questions are generally reviewed de novo on appeal, even if they involve fact-intensive questions of interpretation. *See, e.g., Cooper Indus., Inc. v. Leatherman Tool Group, Inc.*, 532 U.S. 424, 437 (2001) (applying de novo review to the “fact-sensitive undertaking” of evaluating the excessiveness of punitive damage awards because such determinations do not invoke questions of “historical or predictive fact”); *Thompson v. Keohane*, 516 U.S. 99, 111-112 (1995) (applying de novo review to questions having a “uniquely legal dimension” that require interpretation of historical facts). Tellingly, even the cases that RTI cites (Pet. 35) apply de novo review to such heavily factbound legal issues. *United States v. Bajakajian*, 524 U.S. 321, 337 n.10 (1998) (rejecting petitioner’s re-

quest to defer to a district court’s interpretation of excessiveness under the Eighth Amendment); *Ornelas v. United States*, 517 U.S. 690, 699 (1996) (applying de novo review to the weighing of historical facts in the context of probable cause determinations).

In this regard, interpretation of a patent through claim construction is no different from interpretation of any other legal document, which is subject to de novo appellate review. *E.g.*, *United States v. Havelock*, 664 F.3d 1284, 1289 (9th Cir. 2012) (“We review matters of statutory interpretation de novo.”); *First Annapolis Bancorp, Inc. v. United States*, 644 F.3d 1367, 1373 (Fed. Cir. 2011) (“Contract interpretation is a question of law, reviewed *de novo*.”); *United States v. Hester*, 589 F.3d 86, 90 (2d Cir. 2009) (“[W]e review questions of constitutional interpretation *de novo*.”). Indeed, claim construction is even less “fact”-intensive than contract interpretation, the prototypical example of construction of a legal document.<sup>19</sup> Unlike questions of contract interpretation, which may involve factual issues concerning the parties’ intent, patent claim construction is governed by an objective standard, and the inventor’s intent is entirely irrelevant. *See Cordis Corp. v. Boston Scientific Corp.*, 561 F.3d 1319, 1338 (Fed. Cir. 2009) (“[I]nventor testimony as to the inventor’s subjective intent is irrelevant to the issue of claim construction.” (alteration in original; internal quotation marks omitted)).

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<sup>19</sup> RTI’s amicus echoes the analogy to contract interpretation and acknowledges that such determinations are “freely reviewable” on appeal where they do not consider extrinsic sources to determine the parties’ intent. Ctr. for Intellectual Prop. Research Amicus Br. 13.

Contrary to RTI’s suggestion (Pet. 34-35), there is no conflict between the de novo standard of review for claim construction and the deferential review of factual issues underlying determinations of patent validity, such as obviousness or enablement. When evaluating validity, the primary questions are of historical fact—what others did before the patent’s priority date, whether a skilled artisan could practice the invention without undue experimentation—which are precisely the type of issues for which deference is appropriate. Even the district court owes deference to the Patent Office on these issues. *See Microsoft Corp. v. i4i Ltd. P’ship*, 131 S. Ct. 2238, 2242 (2011); *see also* 35 U.S.C. § 282. However, these principles of deference do not apply in the context of claim construction, which as *Markman* recognized falls within the core interpretative function of judges. *See* 517 U.S. at 388-389.

Likewise, outside the patent context, a de novo standard of review applies in many situations where the district court must interpret facts, often aided by expert testimony. For example, issues of foreign law receive de novo review, even if the district court must weigh competing expert testimony on the subject.<sup>20</sup> District court rulings on issues of “legislative” fact—that is, facts underlying the lawmaking process that are not specific to the adjudicative facts of the case, *see* Fed. R. Evid. 201, Advisory Committee Notes—do not

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<sup>20</sup> *See* Fed. R. Civ. P. 44.1 (“In determining foreign law, the court may consider any relevant material or source, including testimony, whether or not submitted by a party or admissible under the Federal Rules of Evidence. The court’s determination must be treated as a ruling on a question of law.”); *see also* Fed. R. Crim. P. 26.1 (same).

receive deference on appeal.<sup>21</sup> Moreover, findings of constitutional violations are routinely reviewed de novo, even if the analysis involves interpretation of complex factual situations.<sup>22</sup> Because de novo review of fact-heavy issues having a “uniquely legal dimension,” *Thompson*, 516 U.S. at 112, is commonplace, it is appropriate to apply the same de novo standard of review to issues of claim construction.

The policy arguments that RTI advances are also unpersuasive. RTI’s concerns regarding the Federal Circuit’s reversal rate on issues of claim construction (Pet. 24) are overblown. Despite commentators’ past

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<sup>21</sup> See *Lockhart v. McCree*, 476 U.S. 162, 169 n.3 (1986) (expressing skepticism that legislative facts are subject to deference); *Dunagin v. City of Oxford*, 718 F.2d 738, 748 n.8 (5th Cir. 1983) (rejecting deferential standard of review for issues of legislative fact); cf. *Brown v. Entertainment Merch. Ass’n*, 131 S. Ct. 2729, 2739 (2011) (reviewing and rejecting as “not compelling” expert testimony concerning studies involving the effect of violence in video games on children).

<sup>22</sup> See *Randall v. Sorrell*, 548 U.S. 230, 249 (2006) (de novo review of record to evaluate whether campaign finance law violated First Amendment); *Cooper Indus.*, 532 U.S. at 437 (de novo review of the “fact-sensitive undertaking” of evaluating the excessiveness of punitive damage awards under the Due Process Clause); *Bajakajian*, 524 U.S. at 337 n.10 (de novo review of excessiveness of fines under the Eighth Amendment); *Ornelas*, 517 U.S. at 699 (de novo review of evidence supporting probable cause and reasonable suspicion determinations under the Fourth Amendment); *Thompson*, 516 U.S. at 112 (de novo review of evidence supporting “in custody” determination for purposes of custodial interrogation); *Bose Corp. v. Consumers Union of U.S., Inc.*, 466 U.S. 485, 511 (1984) (de novo review of factual record on appeal when applying “actual malice” standard for libel); *Jenkins v. Georgia*, 418 U.S. 153, 159-161 (1974) (de novo review of factual record when applying standard for obscenity).

criticisms of de novo review, recent scholarship suggests that the Federal Circuit’s reversal rate on issues of claim construction is greatly skewed by the high rate of settlement in clear cases. See Richard S. Gruner, *How High Is Too High?: Reflections on the Sources of Claim Construction Reversal Rates at the Federal Circuit*, 43 Loy. L.A. L. Rev. 981, 985 (2010).

RTI’s related assertion that de novo review produces litigation inefficiencies (Pet. 24-25) is also unavailing. Numerous mechanisms already exist to minimize wasted efforts in cases where issues of claim construction are outcome-determinative, including stipulations of infringement or invalidity that reserve the right to appeal, immediately-appealable partial judgments under Federal Rule of Civil Procedure 54(b), or interlocutory appeals under 28 U.S.C. § 1292(b). *E.g.*, *Regents of Univ. of Cal. v. DakoCytomation Cal., Inc.*, 517 F.3d 1364, 1371 (Fed. Cir. 2007); *Lava Trading, Inc. v. Sonic Trading Mgmt., LLC*, 445 F.3d 1348, 1353-1354 (Fed. Cir. 2006). There is no reason to adopt RTI’s ill-advised rule of deference where several alternative procedures already exist to address RTI’s purported concerns.

## CONCLUSION

RTI’s petition for a writ of certiorari should be denied.

Respectfully submitted.

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