IN THE UNITED STATES DISTRICT COURT

FOR THE DISTRICT OF DELAWARE

C. R. BARD, INC.,	)	
	)	
Plaintiff,	)	
	)	
v.	)	Civil Action No. 96-589-SLR
	)	
MEDTRONIC, INC.,	)	
	)	
Defendant.	)	

MEMORANDUM ORDER

At Wilmington this 31st day of January, 2001, having reviewed the complete prosecution history of U.S. patent No. 5,484,474 and the parties' submissions regarding such;

IT IS ORDERED that plaintiff is barred from asserting infringement of the claim element "a housing defining a substantially toroidal flow path," for the reasons that follow:

1. The United States Court of Appeals for the Federal Circuit construed the claim language at issue "as requiring that the housing itself be toroidally shaped." C.R. Bard Inc. v. Medtronic, Inc., No. 99-1475, 2000 U.S. App. LEXIS 15316 at *8 (Fed. Cir. June 29, 2000).

2. Clearly, the accused product does not have a housing that is itself toroidally shaped. Therefore, there can be no literal infringement.

3. The court further finds that, consistent with the Federal Circuit's decision in Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co., 234 F.3d 558 (Fed. Cir. 2000) (en banc) and, e.g., KJC Corp. v. Kinetic Concepts, Inc., 223 F.3d 1351 (Fed. Cir. 2000) and Bayer AG v. Elan Pharm. Research Corp., 212 F.3d 1241 (Fed. Cir. 2000), plaintiff is estopped from asserting infringement of this claim element under the doctrine of equivalents.

4. In the prosecution history of the '474 patent, the examiner opined that the Siposs reference showed a "toroidal flow path." (Office Action dated July 26, 1994 at 3) Plaintiff, in its response, acknowledged that "blood tangentially entering Siposs' circular chamber 54 may well flow in a circular path along the peripheral wall of the circular chamber 54." (Response to July 26, 1994 Office Action, dated November 22, 1994 at 11) Nonetheless, plaintiff argued that:

> Siposs does not appear to have expressly recognized a "toroidal flow path" occurring within the "circular" chamber 54, much less any benefit of enhancing such "toroidal flow path." (Siposs does not appear to mention the term "toroidal.") Siposs teaches a conical cap interior with a central apex defining the highest elevation for channeling gas to the central vent 48. A central indentation in the cap would destroy Siposs' intended operation of congregating gas in the center of the chamber. . . . Thus, Siposs provides no suggestion of (and teaches away from) a central indentation and a laterally offset gas vent as claimed.

(Response to July 22, 1994 Office Action, dated November 22, 1994

at 13)

5. Having distinguished the prior art with reference to structure (the central indentation in the cap), it cannot now claim the benefits of its invention in the absence of said structure. See, e.g., KJC, 223 F.3d at 1359-60.

IT IS FURTHER ORDERED that plaintiff may proceed to trial on the issue of literal infringement of the filter element support limitation, for the reasons that follow:

1. The Federal Circuit described the accused filter element as follows:

> The filter element of the Medtronic filter sits on the bottom of the filter housing, and is affixed to the bottom with potting material, a type of adhesive. The top of the filter element is affixed with potting material to a filter cap. The filter cap is largely disc-shaped, with a lip that extends down over the top edge of the filter element. The filter cap is not attached to the housing cap. The space between the filter cap and the housing cap is empty. Fluid entering the filter housing passes over the filter cap, and flows down in the space between the edge of the filter cap and the filter housing wall, passing through the filter element into the interior portion of the filter, and then exiting through the fluid outlet.

C.R. Bard, 2000 U.S. App. LEXIS 15316 at *3-4.

2. The Federal Circuit construed the claim language "filter element support located within the housing and centrally disposed with respect to the toroidal flow path" as requiring "a structural support for the filter element (not just potting

material) that is centrally disposed with respect to the toroidal flow path, at the top of the filter element." Id. at *14-15

3. In its discussion, the Federal Circuit further explained that

> [t]he prosecution history surrounding the addition of this limitation to the claims indicates that the support must be in the toroidal flow path, which is at the top of the filter element. During prosecution of the patent, the claims were rejected over Siposs, alone and in combination with another patent. The examiner indicated that the claims would be allowable if amended to include, among other limitations, a "filter element support means centrally located in the toroidal flow path." In response to this suggestion, Bard amended the claims to include the filter element support limitation. Although Bard chose language somewhat different from that proposed by the examiner, it indicated in its amendment that it had amended the claims "in the manner suggested by the examiner." The language used by the examiner, "filter element support means centrally located in the toroidal flow path" (emphasis added), clearly requires a support that is located in the center of the toroidal flow path. The language used in the claim, "filter element support . . . centrally disposed with respect to the toroidal flow path," also indicates that the support is located in the center of the toroidal flow path. Because the toroidal flow path exists at the top of the filter element, in the space between the filter cap and the ceiling of the housing cap, in order to be located in the center of the toroidal flow path the support must be at the top of the filter element.

Id. at *13-14. (See Office Action dated January 13, 1995; Response to January 13, 1995 Office Action, dated April 12, 1995

at 9)

4. In construing the filter element support limitation, then, the Federal Circuit has required that the support element be a structure separate from the filter element and that said structure be located at the top of the filter element in the toroidal flow path.

5. Because the filter element support limitation was not litigated in this context, plaintiff is entitled to try the issue of whether the accused device literally infringes the filter element support limitation.

6. Under the reasoning of Festo, 234 F.3d at 568-78, however, plaintiff is precluded from asserting infringement under the doctrine of equivalents because it amended its filter element support limitation to distinguish its invention from the prior art.

a. The claim language as originally proposed called for "a filter element supported within the filter element chamber by the central indentation of the housing." (Application Serial No. 08/052,787, filed April 23, 1993, at 18)

b. The claim language was amended in March 1994 to read "a filter element supported within the filter element chamber of the housing." (Request for Filing a Continuation Application dated March 8, 1994, at 2)

c. The claims were rejected as unpatentable over the prior art. In connection with the claim limitation at issue,

the examiner opined that the Reeder reference taught the use of "potting material." (Office Action dated July 26, 1994, at 5)

d. Plaintiff did not amend the claim language in response. Nevertheless, plaintiff distinguished Siposs as follows:

> Siposs employs a center cone 26 extending upward from the bottom of the filtered chamber to hold end plates 34 and 28. The filter element is, therefore, fully supported by the center cone 26 and need not be supported by a central indentation in the cap.

(Response to July 26, 1994 Office Action, dated November 22, 1994, at 13)

e. The claims again were rejected. (Office Action dated January 13, 1995)

f. After a telephonic interview on February 8, 1995, the examiner indicated, as noted above,

> that he would reconsider rejection and claim 25 would be allowable if amended to include limitations in claims 26 and 27 and filter element support means centrally located in the toroidal flow path.

(Examiner Interview Summary Record, dated February 10, 1995)

g. In response, plaintiff amended the claim language to read "a filter element support located within the housing and centrally disposed with respect to the toroidal flow path." (Response to January 13, 1995 Office Action, dated April 12, 1995, at 2)

h. The amended claim language was allowed by

Office Action dated May 3, 1995.

i. Clearly, the claim language was amended for a substantial reason related to patentability. Therefore, said claim amendment creates prosecution history estoppel.

United States District Judge