

## Federal Circuit Patent Bulletin: *Howmedica Osteonics Corp. v. Zimmer, Inc.*

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May 12, 2016

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On May 12, 2016, in *Howmedica Osteonics Corp. v. Zimmer, Inc.*, the U.S. Court of Appeals for the Federal Circuit (O’Malley, Plager,\* Wallach) affirmed the district court’s judgment that Zimmer did not infringe U.S. Patent No. 6,475,243, which related to a socket assembly used in prosthetic hip implants. The Federal Circuit stated:

Generally, a claim term is given its ordinary and customary meaning—the meaning that a “term would have to a person of ordinary skill in the art in question at the time of the invention.” However, a skilled artisan reads a claim term not only in the context of the claim at issue, but also in the context of the entire patent, including the written description and prosecution history, as well as relevant extrinsic evidence. Indeed, “the [written description] ‘is always highly relevant to the claim construction analysis. Usually, it is dispositive; it is the single best guide to the meaning of a disputed term.’” Nevertheless, we have observed that there is a fine line between reading a claim in light of the written description and reading a limitation into the claim from the written description. . . .

Stryker asks that we focus on the plain language of the claims and offers a number of dictionary definitions for the terms “juxtaposed with” and “in juxtaposition with” to mean that the recess and taper are “positioned nearby” one another. But focusing on a particular term’s plain and ordinary meaning may be inadequate, when relying on that meaning does not resolve the parties’ dispute. That is the case here. By focusing on the specific juxtaposition terms, Stryker ignores the other claim language at issue (*e.g.*, effectiveness) and fails to resolve the parties’ dispute as to how the recess and taper are to be located relative to each other to satisfy the entirety of the claim language at issue.

This problem is only resolved by examining the written description—*i.e.*, reading the claims in context. Construing the claims in this manner is not only consistent with our precedent, but also necessary in light of the claim language at issue. We have previously construed such relative location terms in a similar manner by relying upon the written description. Here, we must understand how the recess and taper are to be “juxtaposed” or in “juxtaposition” with one another, and “placed at relative locations such that the

effectiveness” of each is “maintained while in the presence of the other.” The meaning of these terms is not facially clear, and a skilled artisan would naturally look to the written description for a full understanding of the claims. We do the same and adopt the district court’s construction. . . .

Stryker also argues that the district court’s construction violates the doctrine of claim differentiation, since dependent claims are presumed to be of narrower scope than the independent claims from which they depend. . . . However, claim differentiation is a rebuttable presumption that may be overcome by a contrary construction dictated by the written description or prosecution history. In this instance, that presumption has been rebutted. The written description reveals only instances in which the claim language is satisfied by the placement of the recess “essentially midway” along the taper. The prosecution history reveals that the same language from the written description was added in conjunction with the similar claim language at issue—as well as the “essentially midway” language in dependent claims 25 and 32. The natural and correct result of reviewing the intrinsic evidence was the district court’s construction. Claim differentiation is not conclusive; it is a guide, not a rigid rule. Although it is a useful tool, claim differentiation does not require that the “dependent claim tail . . . wag the independent claim dog” in this case. . . .

Second, we examine whether the district court abused its discretion in applying its local rules to preclude Stryker from arguing infringement under the doctrine of equivalents (DOE). We affirm decisions in which the district court enforced its own local rules, unless it is “clearly unreasonable, arbitrary, or fanciful; based on erroneous conclusions of law; clearly erroneous; or unsupported by any evidence.” In light of this highly deferential review standard, we are not able to conclude that the district court abused its discretion.

The district court determined that Stryker could not assert any DOE theory of infringement because Stryker failed to comply with the court’s Local Patent Rules (LPR). LPR 3.1(e) requires that a patentee’s infringement contentions state “whether each limitation of each asserted claim is alleged to be literally present or present under the doctrine of equivalents in the Accused Instrumentality,” unless a design patent is at issue. The district court noted that Stryker failed to set forth specifically any DOE theory in its original infringement contentions nor did it allege DOE in later amended contentions. Indeed, Stryker never sought to amend its infringement contentions to include the DOE. And the court also determined that Stryker’s reserving its right to assert the DOE did not satisfy LPR 3.1(e). . . .

Stryker never sought to amend its infringement contentions to include the DOE, so it cannot demonstrate that it satisfied the LPR requirements. Although the result may seem harsh, we find no abuse of discretion in the district court applying its rather clearly stated rule. . . .

[Stryker] argues that it had no need to allege a DOE theory of infringement until after claim construction. This may have been true, but it still does not excuse Stryker’s failure to follow the local rules. Even if Stryker had no reason to amend until after claim construction, Stryker could have sought amendment after the Markman order. Stryker asserts that a litigant cannot be forced to foresee and incorporate all possible claim constructions into its initial infringement contentions. This may be true, but the local rules provide for opportunity to seek amendment of its contentions for this very reason.