United States District Court,
S.D. California.

ABBOTT LABORATORIES, an Illinois corporation,
Plaintiff.
v.
SYNTRON BIORESEARCH INC., a California corporation,
Defendant.

No. 98-CV-2359 H(POR)

Sept. 28, 2000.

Order GRANTING In Part and DENYING In Part Motion for Reconsideration and Clarification of the Court's Order Granting Abbott's Motion for Summary Judgment on Infringement; GRANTING In Part, and DENYING In Part Request for *Markman* Hearing; and DENYING Request for Certification of Appeal

HUFF**, Chief J.**

And related cross-claims

On December 30, 1998, plaintiff and counter-defendant Abbott Laboratories ("Abbott"), an Illinois Corporation, filed a complaint for patent infringement against defendant and counter-claimant Syntron Bioresearch, Inc. ("Syntron"), a California corporation. On February 22, 1999, Syntron filed their answer and counterclaims against Abbott for declaratory relief that Syntron did not infringe Abbott's patents, that Abbott's patents are invalid and that Abbott's patents are unenforceable.

On March 22, 2000, Abbott filed a motion for summary judgment against Syntron. Syntron, in turn, filed three separate summary judgment motions for non-infringement, for the invalidity of Abbott's patents pursuant to 35 U.S.C. section 102, and for the invalidity of Abbott's patents pursuant to 35 U.S.C. section 112. The Court held oral argument for all four of the motions on May 9, 2000 and held a full day *Markman* hearing on the construction of the claims. On May 23, 2000, the parties each submitted a summary of their oral arguments pursuant to the Court's request.

On August 2, 2000 the Court issued an Amended Order (1) Denying Syntron's motion for summary judgment under 35 U.S.C. section 102; (2) Denying Syntron's motion for summary judgment under 35 U.S.C. section 112; (3) Denying Syntron's motion for summary judgment for non-infringement; and (4) Granting Abbott's motion for summary judgment for infringement.

On August 7, 2000 Syntron filed a motion for reconsideration and clarification of the Court's order granting Abbott's motion for summary judgment on infringement; request for a *Markman* Hearing; and, in the alternative request for certification of appeal. Abbott filed an opposition to the motion on August 28, 2000.

That same day the Court held a pre-trial conference with the parties. On September 1, 2000 Syntron filed a reply in support of its motion. The Court held oral argument on the motions on September 15, 2000 and conducted an additional *Markman* hearing to construe the claims.

I. Motion for Reconsideration

A motion for reconsideration is "appropriate if the district court (1) is presented with newly discovered evidence, (2) committed clear error or the initial decision was manifestly unjust, or (3) if there is an intervening change in controlling law." *See* School Dist. No. 1J. Multnomah County v. ACandS, Inc., 5 F.3d 1255, 1263 (9th Cir.1993).

Syntron bases its motion for reconsideration on clear error and manifest injustice. Abbott argues that Syntron has failed to show clear error or manifest injustice given the ample time and opportunity it had to prepare its arguments in the case. In addition, Abbott argues that a motion for reconsideration is improper because Syntron has not shown "what new or different facts and circumstances are claimed to exist which did not exist, or were not shown, upon such prior application" as required by Civil Local Rule 7.1(i). However, when defendants bring a motion based on clear error and manifest injustice, they need not present evidence of new facts. Parker v. United States, 1996 WL 756966, (S.D.Cal., 1996) ("As plaintiffs here present no new facts and do not claim that there were any intervening changes in the existing law, the court interprets their claim to be that the Order ... was one of clear error and/or manifestly unjust."). The Court will review Syntron's motion for reconsideration based on the grounds of clear error and manifest injustice.

II. Claim Construction

Syntron argues that the Court's interpretation of the meaning of Claim 22 and reliance on the declaration of Dr. Harlow during the summary judgment proceedings was both erroneous and unjust. Abbott contends that the Court followed proper standards for claim construction. The Court agrees with Abbott.

When construing the terms of a patent, the Court must first turn to "intrinsic evidence." Intrinsic evidence includes the claim itself, the specification, and the prosecution history of the patent. Vitronics Corp. v. Conceptronic, Inc., 90 F.3d 1576, 1582 (Fed.Cir.1996). Established rules of claim interpretation require that the Court first consider the words of the claims themselves, "both asserted and unasserted, to define the scope of the patented invention." Id. at 1582. The words are generally given their customary and ordinary meaning. *Id.;* Hoechst Celanese Corp. v. BP Chemicals, Ltd., 78 F.3d 1575, 1578 (Fed.Cir.1996) (stating that in defining technical terms, the Court should interpret it "as having the meaning it would be given by persons experienced in the field of the invention"). However, the Court must follow the definition of terms intended by the patentee if his or her special definition is clearly delineated in the specification or file history. Vitronics Corp., 90 F.3d at 1583; Hoechst Celanese Corp., 78 F.3d at 1578.

The Court also considers the specification to determine whether the inventor has employed any terms or words in a manner that is inconsistent with their plain and ordinary meaning. Vitronics, 90 F.3d at 1582. However, the claims, not the specification, define the invention so "not everything expressed in the specification must be read into all the claims." Sjolund v. Musland, 847 F.2d 1573, 1581-82 (Fed.Cir.1988) (quoting Raytheon Co. v. Roper Corp ., 724 F.2d 951, 957 (Fed.Cir.1983)).

The Court also may review the prosecution history of the patent, if admitted into evidence. Vitronics, 90 F.3d at 1582. This history is "the complete record of all the proceedings before the Patent and Trademark Office, including any express representations made by the applicant regarding the scope of the claims." *Id*. It

also includes prior art which is cited in the file history. *Id*. at 1583.

The Court may resort to extrinsic evidence only if the intrinsic evidence is considered and there still remains some ambiguity as to the scope or meaning of the claim. *Id*. at 1583. This extrinsic evidence can include any evidence outside the patent and prosecution history such as prior art documents, dictionaries, technical treatises, articles, expert testimony, and inventor testimony. *Id*. at 1584. However, "extrinsic evidence in general, and expert testimony in particular, may be used only to help the court come to the proper understanding of the claims; it may not be used to vary or contradict the claim language." *Id*.

The Court set out the following standard in its August 2, 2000 Order:

In ascertaining the meaning of the patent claims, the Court must consider the claims, the specification, and the prosecution history. *See* Eastman Kodak Company v. Goodyear Tire & Rubber Company, 114 F.3d 1547, 1552 (Fed.Cir.1997). A Court may also look to expert testimony for such evidence as determining "how those skilled in the art would interpret the claims." *Id*. (quoting Markman v. Westview Instruments, Inc., 52 F.3d 967, 979 (Fed.Cir.1995) (en banc)); Aqua-Aerobic System, Inc. v. Aerators, Inc., 211 F.3d 1241, 1244 (Fed.Cir.2000).

Aqua-Aerobic makes clear that "[e]xpert testimony is often useful to clarify the patented technology and to explain its meaning through the eyes of experience, but it may not correct errors or erase limitations or otherwise diverge from the description of the invention as contained in the patent documents." *Aqua-Aerobic,* 311 F.3d at 1245 (citing Markman 52 F.3d at 981) ("Extrinsic evidence is to be used for the court's understanding of the patent, not for the purpose of varying or contradicting the terms of the claims.") Therefore, the Court followed proper standards during claim construction.

A. Interpretation of Claim 22

Syntron argues that the Court relied on Dr. Harlow's declaration without first exhausting the intrinsic evidence or making a finding that the claims were ambiguous in light of the intrinsic evidence. The Court disagrees. Syntron notes, "when the intrinsic evidence is unambiguous, it is improper for a court to rely on extrinsic evidence such as expert testimony when construing disputed claim limitations." CAE Screenplates, Inc. v. Heinrich Fiedler GmbH & Co.K.G., 2000 WL 1199247, (Fed.Cir.) (citing Vitronics, 90 F.3d at 1583). In addition, Syntron asserts that by applying the proper rules of claim construction each of the elements of Claim 22 can be construed without resort to extrinsic evidence in such a manner that would preclude a finding of infringement by Syntron as a matter of law.

Abbott correctly contends that the Court followed proper claim construction procedure by first examining intrinsic evidence including the patents themselves and the prosecution history, and only citing to Dr. Harlow to confirm the Court's reading of the claims and bolster its understanding of the technology as viewed by those skilled in the art. As the Court followed proper claim construction, the Court denies the motion for reconsideration on this ground. The Court also denies Syntron's request for another *Markman* hearing. The Court has held two full day *Markman* claim construction hearings in this case. At each hearing, the Court considered the claim language, specifications, and prosecution history of both the '484 and '162 patents. Expert witnesses were not present at either hearing. Under the circumstances, another *Markman* hearing is unnecessary for construction of Claim 22.

In its motion for reconsideration, Syntron argues that the Court improperly held that the Abbott patents

cover both quantitative and qualitative assays. Syntron also argues that the Court misconstrued three terms from Claim 22: predetermined amount; zone; and diffusively bound labeled antibody. The Court will address each of Syntron's claim construction arguments.

1. Qualitative vs. Qualitative Assay

Syntron argues that its products do not infringe Abbott's patents because they are qualitative, measuring whether an analyte is simply present in a test liquid, rather than quantitative, measuring the amount of analyte present in the sample. Syntron claims that the claim language, specification, and prosecution history prove that the patents are limited to quantitative assays.

a. ***Claim Language:***

Syntron argues that the claim language make clear that Abbott's patents cover only quantitative assays because the requirement of a "predetermined amount" of reactant is necessary for quantitative assays. Syntron also argues that Claim 22 can only cover quantitative assays, because the patent defines "analyte" to mean "any chemical moiety which is to be measured quantitatively." ('162 patent, Col. 3, Ins. 19-21). Substituting this definition into Claim 22, the preamble to Claim 22 reads, "a device for detecting the presence of a chemical moiety which is to be measured quantitatively in a carrier liquid ..." Finally, Syntron claimed in oral argument that the term "presence" as used throughout the patent is used in a quantitative context, rather than qualitative.

Abbott contends that the plain reading of the claim language indicates that it is meant to cover qualitative analysis since it is designed to detect "the presence of an analyte." (See, e.g. '162 patent, col.2, ln. 43, col. 2, lns. 52-53, col. 8, ln. 26). Specifically, Claim 22 describes a device for "detecting the presence of an analyte." (*Id.,* col. 17, ln. 16). In addition, Abbott notes that if the inventors wished to limit the claims to quantitative assays they would have done so, since they did in Claim 20 of the '484 patent. The plain and ordinary meaning of the words would suggest that "method for quantitative analysis of an analyte" (from Claim 20) means something different than "detecting the presence" (from Claim 22). The plain language of the claim demonstrates that Claim 22 covers devices that indicate the presence of an analyte as well as those that give a quantitative reading. Therefore, the patent covers qualitative and quantitative devices.

b. ***Specifications:***

Syntron cites to five places in the specifications that refer to "quantitative" analysis. For example, the Field of Invention says that the invention "is in the field of quantitative chemical analysis, and is particularly useful in the detection and analysis of small amounts of chemical substance." ('162 patent, col. 1, lns. 10-13). However, this sentence incorporates qualitative assays since it also refers to the detection of a chemical substance. The specifications note that the patents and publications referenced in the patent cover tests for both the quantity and presence of an analyte. ('162 patent, col. 8, lns. 18-22).

As noted above, "not everything expressed in the specification must be read into all the claims." Sjolund v. Musland, 847 F.2d 1573, 1581-82 (Fed.Cir.1988) (quoting Raytheon Co. v. Roper Corp ., 724 F.2d 951, 957 (Fed.Cir.1983)). Since Claim 22 does not specifically refer to "a quantitative analysis," it is not necessary to read this limitation into the claim.

c. ***Prosecution History:***

Syntron argues that the prosecution history of the '484 patent shows that the applicants repeatedly argued that the assays for the invention are quantitative to overcome prior art cited by the Examiner. Abbott contends that the Court properly considered the prosecution history in the construction of the claims.

Arguments made during the prosecution history of the '484 patent limit the interpretation of the claim terms to exclude any interpretation that was disclaimed during prosecution. Southwall Techs., Inc. v. Cardinal IG Co., 54 F.3d 1570, 1576 (Fed.Cir.1995). Prosecution history serves an estoppel function when claim language is changed or amended to distinguish the patent. *Id*. Arguments made in the prosecution of the '484 patent also limit the scope for the claims in the '162 patent. "When multiple patents derive from the same initial application, the prosecution history regarding a claim limitation in any patent that has issued applies with equal force to subsequently issued patents that contain the same claim limitation." Elkay Mfg. Co. v. Ebco Mfg. Co., 192 F.3d 973, 980 (Fed.Cir.1999); *See also,* Jonsson v. The Stanley Works, 903 F.2d 812, 817-818 (Fed.Cir.1990) (holding that when two patents issued from continuation-in-part applications derived from one original application, the prosecution history of a claim limitation in the first patent to issue was properly applied to the same claim limitation in the second patent to issue).

The prosecution history indicates that Abbott distinguished the Deutsch Patent, U.S. Patent No. 4,094,647 on the grounds that Deutsch only had a single zone provided to determine the presence of an analyte and required an extra detection step. (Prosecution History of '484 patent at 390). In addition, Abbott distinguished the Bauman patent, U.S. Patent No. 4,425,438, on the grounds that it was a two-step device rather than the proposed single step device. Abbott also noted, "the instant invention provide[s] the unique method of quantitatively determining the amount of an analyte utilizing a reaction that occurs along the length of a column or other possible, solid medium." (Prosecution History of '484 patent at 421).

Although Abbott noted the quantitative applications of its device during patent prosecution, Abbott distinguished the prior art by comparing its one step detection process with the two step detection explained in the Deutsch and Bauman patents. Abbott did not change or amend its claim language in response to prior art references by the Patent Examiner. Consequently, prosecution history estoppel does not apply. Therefore, the prosecution history does not support Syntron's interpretation of the claim language at issue.

d. ***Extrinsic Evidence:***

Syntron argues that use of extrinsic evidence is improper since the intrinsic record makes clear that Claim 22 only includes quantitative assays. This is factually incorrect. The intrinsic evidence makes references to "detecting the presence of an analyte." (See, e.g., '162 patent, col. 17, ln. 16, col. 2, ln. 43, col. 2, lns. 52-53, col. 8, ln. 26). However, extrinsic evidence can not be used to contradict or vary claim terms but only to clarify ambiguity. In the Order under reconsideration, the Court noted that Dr. Harlow agreed with the proposition that any test which examines the quantity of a substance must necessarily indicate the presence of the substance. (Order at 17). The Court did not rely on Dr. Harlow's testimony to contradict or vary claim terms. Rather, the Court noted that the understanding of one of ordinary skill in the field confirmed its reading of the claim wording.

In conclusion, the Court followed proper claim construction in its original order. After engaging in a thorough re-analysis of the issue, the Court concludes that Claim 22 covers both qualitative and quantitative assays.

2. "*Predetermined amount*"

As part of its argument that the Abbott patents are directed to quantitative assays only, Syntron raises a claim construction issue as to the proper meaning of "predetermined amount." The Court found that the ordinary meaning of "predetermined" is determined beforehand or settled in advance. (Order at 20). Syntron asserts that the Court improperly relied on extrinsic evidence, namely a dictionary definition, in reaching this conclusion. The Court disagrees.

The Court considered the words of the claim, "predetermined amount," and gave them their customary and ordinary meaning. The Court only noted the dictionary definition from Webster's New International Dictionary to confirm the plain language reading of the claim term, not to contradict or vary the claim terms. The Court properly construed the ordinary meaning of "predetermined amount" as an amount determined beforehand. Therefore, the Court denies the motion for reconsideration on claim construction of this term.

3. Multiple Zones and Identical Reactant in Each Zone

Syntron contends that the Court erred in two ways when interpreting the word "zone" in Claim 22:(1) it limited the term "zone" to include only "reactive zones" and (2) it limited the term "reactive zone" to exclude "control zones."

a. *Claim Language:*

The language of Claim 22 with respect to "zones" reads: "one or more zones spaced along said flow path, each zone having a predetermined amount of reactant bound to it which is specific for either the analyte or a chemical moiety which is itself the reaction product of the analyte with another chemical moiety." The Court incorrectly added the word "reaction" in brackets in front of "zone" in its Order. (Order at 18). The Court grants Syntron's motion for reconsideration on this term and construes the word "zone" as it appears in Claim 22.

In its motion for reconsideration on the "zone" issue, Syntron mixes its claim construction arguments and its infringement arguments. First, Syntron argues that its "control zone" is a "zone" for purposes of Claim 22. Next, Syntron claims that its "control zone" is a "reaction zone." Finally, Syntron notes that devices with multiple reaction zones must have identical reactant in each. Syntron argues that its devices do not infringe Abbott's patents because its "control zone" does not contain the same reactant as its "test zone."

At the hearing on this motion, Syntron presented another argument, namely that Court's previous construction of "zone" failed to take into account the qualifier "each." Syntron cited K-2 Corp. v. Salomon S.A, 191 F.3d 1356, 1363 (Fed.Cir.1999) for the proposition that the functional language that comes after a term is an additional limitation in the claim, not the sole definition of the term.

The plain language of the Claim 22 indicates that to be infringing, a "zone" must be spaced along the flow path, with a predetermined amount of reactant bound to it that is specific to the analyte. The Court agrees with Syntron that the word "zone" has some meaning in addition to its functional limitations. The plain language meaning of "zone" is a specific place distinct from the surrounding areas.

Syntron argues that "zone" includes both reaction zones and control zones. Neither the specification nor the prosecution history support this contention. Both sides have taken the position, at some point in these proceedings, that "zone" meant "reaction zone." (Mtn. for Sum. Judgment of Noninfringement at 12-13; Opp. Mtn. for Sum. Judgment of Noninfringement at 16-17). Syntron has argued that its "control zone" is also a "reaction zone." The Court does not find support for this argument.

b. ***Specification:***

The specification uses the word "zone" interchangeably with "reaction zone." (See, e.g. '162 patent, Col. 2, lns. 4-5, 39-44, 61-62). The specifications also disclose that each "zone" or "reaction zone" contain identical reactant. However, the specification does not clarify whether Syntron's "control zones" are "zones" for the purposes of Claim 22.

c. ***Prosecution History:***

The prosecution history indicates that "reaction zones" each contain identical reactant. (Prosecution History of '484 patent at 463). Syntron argues that the prosecution history also indicates that a "control zone" is a "reaction zone." "Each reactive zone contains bound reactant. A clear distinction can be made, however, between those reactive zones that serve as true detecting zones (where the presence of color indicates the presence of analyte) and those that serve a purpose other than the detection of analyte (e.g. as controls, or as sites for competitive reaction.)" (Syntron's Lodgments, Ex. 5, Prosecution History of '162 patent, at 179).

However, unlike Syntron's "control zone," where no reaction with the analyte takes place, the reaction zone that works as a control, referenced in the passage above, reacts with an analyte derivative. Thus, the "control zone" mentioned in the prosecution history contains the same reactant as the other "reaction zones" and functions in the same way as a "reaction zone." The parenthetical reference to a control is not evidence that what Syntron calls its "control zone" is a "zone."

d. ***Extrinsic Evidence:***

The intrinsic evidence on the word "zone" makes clear that a control zone is not a reaction zone. In addition, the Court notes that Syntron's expert, Dr. David testified that, "[a] control zone is not a reaction zone ... if you require ... that it bind the analyte ... then it is not considered a reaction zone." (David Depo. at 138-139).

Therefore, the Court concludes that the proper claim construction of "zone" is a place, distinct from the surrounding area. In addition, the term "zone" is further limited by the functional language that follows the term: "each zone having a predetermined amount of a reactant bound to it which is specific for either the analyte or a chemical moiety which is itself the reaction product of the analyte with another chemical moiety." K-2 Corp. 191 F.3d at 1363. Thus, a "zone" is a specific place which is spaced along the flow path, with a predetermined amount of reactant bound to it that is specific to the analyte. Syntron's test zone fits this description.

4. "Diffusively Bound Labeled Antibody"

Syntron contends that the court misinterpreted the phrase "diffusively bound" when it found that the term does not require that the labeled antibody mix with the analyte solution on a molecular level but rather that the labeled antibody be capable of separating from the solid medium and flowing through the remaining portion of the medium. In response, Abbott contends that this term received extensive consideration in both the prior hearing and motions and that the Court did not commit clear error.

If "diffusively bound" is construed as requiring combination at the molecular level, Syntron argues that its colloidal gold labels would not meet this definition. The colloidal gold particulate labels do not dissolve into the test solution, but rather are suspended in the liquid and pushed "downstream" to the reaction zone by the

physical force of the liquid. Labels that are dissolved in the solution move "downstream" to the reaction zone because there is a lower concentration of dissolved labeled antibodies in the reaction zone.

The Court, in reaching its previous determination, looked at the language of the claim, the prosecution history and then verified its reading with expert testimony.

a. ***Claim Language:***

Syntron argues that the plain language of the claim makes clear that "diffusively bound" can not merely mean "being capable of flow along the flow path" because that is a separate limitation of the term. ('162 patent, Claim 22, col. 17, lns. 21-24, "a diffusively bound labeled antibody specific for the analyte or a chemical moiety which is itself the reaction product of the analyte with another chemical moiety, said antibody being capable of flow along the flow path").

The Court noted in its Order that "the patent history of the '162 patent indicates that 'diffusively bound' does not only mean 'capable of flow along the flow path." ' (Order at 12). Instead, the Court found that "diffusively bound" includes the concept of starting on the test strip, being capable of detaching from the solid medium, and being capable of flow along the remaining portions of the test strip. (*Id*. at 14). Therefore, the Court followed proper claim construction principles.

Syntron argues that "diffusively" is an adverb modifying "bound" and thus describes how a labeled antibody is bound to the solid medium. Syntron contends that the plain meaning of diffusing is dissolving or otherwise combining on molecular level. Syntron also notes that antibodies with particulate labels, like colloidal gold, do not dissolve into the solution "but are rather suspended-analogous to pebbles being washed down a stream."

Abbott agrees that diffusively modifies bound, rather than flow. Abbott argues that the distinctions Syntron draws between movement of the labeled antibodies by diffusion and movement by the physical force of water pushing may be relevant in a discussion of flow but not of "bound." Abbott contends that the ordinary meaning of diffusion means "spread out" or "movement."

The Court is not persuaded that "diffusively bound" means bound in such a way that the labeled antibody dissolves and combines at the molecular level with the test liquid as it is lifted from the solid medium. The Court finds that the better construction of "diffusively bound" is bound to the solid medium in such a way that the labeled antibody is capable of detaching from the medium, spreading out and moving along the test strip.

b. ***Specifications:***

Syntron notes that the specifications provide several examples of reactants dissolved in the solution before it is added to the device or it is placed or dried on part of the device and then dissolved by the test liquid. ('162 patent, col. 12, lns. 6-25, col. 13, lns. 6-15, col. 14, lns. 51-63). The language in each of these descriptions illustrates the idea of a reactant, attached to a solid medium before the test begins, that detaches when it comes into contact with the test liquid and flows along the test strip.

c. ***Prosecution History:***

The Patent Examiner suggested the term "diffusively bound" to distinguish Abbott's patent from prior art.

While, the prosecution history does not make reference to the specific definition of "diffusively bound," the Patent Examiner was concerned about when and where the labeled antibody was placed on the test strip, not the chemical or molecular way in which the antibody flowed along the strip. (Abbott's Lodgements, Ex. FF, Prosecution history of '162 at 616.) FN1

FN1. The Court notes that it attributed a statement to the Examiner in its Order that was made by Abbott in response to the Examiner's rejection of the claims. (Order at 12). In response to the Examiner's objections, Abbott argued that, "[t]he diffusively bound antibody of the present claims is already positioned *along the flow path* at the time of use. The 'order' in which the analyte and the diffusively bound antibody are provided is therefore clear." (emphasis in original). Abbott's statement addresses the Examiner's concern of when and where the labeled antibody is placed on the test strip.

d. ***Extrinsic Evidence:***

In support of its contention that "diffusively bound" means capable of dissolving or otherwise combining on a molecular level with the carrier liquid, Syntron points to the testimony of Drs. David and Harlow. Both experts testified that "diffusion" occurs at the molecular level. (Harlow Depo. at 69, David Decl. In Opposition to Abbott's Motion for Summary Judgment of Infringement at 5).

In addition, Syntron notes a technical dictionary definition of diffusion: "the natural tendency of molecules to move out of areas of high concentration into areas of low concentration until a solution or gas has a uniform concentration of the molecules." (Biotech Life Science Dictionary, Comer Decl. Ex. 2).

The Court notes that the term diffusion can mean the movement of molecules from areas of high concentration to areas of low concentration. However, the first definition of diffusion in the Webester's Third New International Dictionary is "the action of diffusing ... spreading, dispersion." (Webster's New International Dictionary 631 (3d ed.1981) (unabridged).FN2 The verb diffuse means to "spread out, pour out, scatter" (*Id.*).

FN2. The term "diffusively" is listed in the dictionary as the adverb of "diffusive." The word "diffusive" has three definitions-"having the quality of diffusing," "tending to diffuse," and "characterized by diffusion." (Order at 14).

In its motion for reconsideration, Syntron noted the existence of the Campbell patent, U.S. Patent No. 4,703,017, which covers a test using particulate labels like colloidal gold. Syntron has a license on the Campbell patent. However, a patent on an improvement carries no right to practice the invention in violation of the rights of the owner of the patent on the basic invention. Fiskars, Inc. v. Hunt Manufacturing Co., 221 F.3d 1318, 1324 (Fed.Cir.2000) (citing Atlas Powder Co. v. E.I. du Pont De Nemours & Co., 750 F.2d 1569, 1580 (Fed.Cir.1984) ("[W]here defendant has appropriated the material features of the patent in suit, infringement will be found 'even when those features have been supplemented and modified to such an extent that the defendant may be entitled to a patent for the improvement" ') (citations omitted)).

The Court concludes that the ordinary and plain meaning of "diffusively" is having the ability to spread out and move freely. Accordingly, the colloidal gold labeled antibodies are "diffusively bound labeled antibodies specific for the analyte ... said antibody being capable of flow along the flow path."

Syntron has failed to show clear error or manifest injustice with respect to claim construction. After considering the motion for reconsideration, the Court concludes: (1) Abbott's patents cover qualitative assays; (2) "predetermined amount" means amount determined beforehand; (3) "zone" means specific place distinct from the surrounding area with the further limitation that it must be spaced along the flow path, with a predetermined amount of reactant bound to it which is specific for the analyte; (4) "diffusively bound labeled antibody" means a labeled antibody bound to the solid medium in such a way that it is capable of detaching from the medium, spreading out, and moving along the test strip. Therefore, the Court denies the motion for reconsideration of the claim construction.

III. Infringement

Summary judgment is appropriate in a patent infringement case. Warner-Jenkinson Co. Inc. v. Hilton Davis Chemical Co., 520 U.S. 17, 39 (1997); Avia Group Int'l, Inc. v. L.A. Gear California, Inc ., 853 F.2d 1557, 1561 (Fed.Cir.1988). A motion for summary judgment shall be granted where "there is no genuine issue as to any material fact and ... the moving party is entitled to judgment as a matter of law." Fed.R.Civ.P. 56(c); *see also* British Airways Bd. v. Boeing Co., 585 F.2d 946, 951 (9th Cir.1978), *cert. den.,* 440 U.S. 981 (1979). A fact is "material" only if its resolution will affect the outcome of the lawsuit. Anderson v. Liberty Lobby, Inc., 477 U.S. 242, 248 (1986). A dispute about a material fact is "genuine" only if "the evidence is such that a reasonable jury could return a verdict for the nonmoving party." *Id.*

The moving party has the initial burden of demonstrating that summary judgment is proper. Adickes v. S.H. Kress & Co., 398 U.S. 144, 157 (1970). If the moving party meets this initial burden of production, then the burden shifts to the nonmoving party to show that summary judgment is not appropriate. Celotex Corp. v. Catrett, 477 U.S. 317, 324 (1986). The inferences to be drawn from the underlying facts must be viewed in the light most favorable to the nonmoving party. Anderson, 477 U.S. at 255.

In its previous Order, the Court granted summary judgment to Abbott on infringement and denied summary judgment to Syntron on noninfringement. In its motion for reconsideration, Syntron argues that the Court improperly granted summary judgment on infringement because its devices do not infringe each limitation of claim 22. Specifically, Syntron argues that its devices do not contain "a liquid permeable solid medium" as construed by the Court during claim construction.

The Court construed the phrase "a liquid permeable solid medium" to mean liquid permeable unitary solid medium. (Order at 22). Syntron argues that its devices do not have a "unitary solid medium" and that the Court incorrectly applied the doctrine of equivalents to find infringement of this requirement. Ordinarily, determination of infringement, whether literal or under the doctrine of equivalents, is a question of fact for the jury. Tate Access Floors, Inc. v. Maxcess Tech., Inc., 222 F.3d 958 (Fed.Cir.2000). Summary judgment is proper "if the pleadings, depositions, answers to interrogatories, and admissions on file, together with the affidavits, if any, show that there is no genuine issue as to any material fact and that the moving party is entitled to a judgment as a matter of law." Fed.R.Civ.P. 56(c); Voice Techs. Group. Inc. v. VMC Sys., Inc., 164 F.3d 605, 612 (Fed.Cir.1999); Bai v. L & L Wings, Inc., 160 F.3d 1350, 1353 (Fed.Cir.1998). "Thus, a literal infringement issue is properly decided upon summary judgment when no genuine issue of material fact exists, in particular, when no reasonable jury could find that every limitation recited in the properly construed claim either is or is not found in the accused device." *Id.* In addition, a claim of infringement under the doctrine of equivalents may be decided on summary judgment. *Id.*

The Court noted in its Order that Syntron presented no evidence explaining its use of a two media device but found that Syntron's device works in the same manner as the device described in the Abbott patents. (Order at 23). The Court found literal infringement based on the testimony of Syntron's president, Dr. Lee. (*Id*.) The Court acknowledges, however, that the reference to the doctrine of equivalents should be clarified.

In its motion for reconsideration, Syntron has submitted declarations from Dr. David and Dr. Lee that describe more fully the construction and operation of Syntron's devices and how they are distinguishable from Abbott's patent. (David Decl. In Support of Motion for Reconsideration, para.para. 8-10; Lee Decl. In Support of Motion for Reconsideration, para.para. 7-11). Syntron uses two media in its device. The colloidal gold antibody is placed on a glass fiber fabric and the unlabeled antibody is placed on a nitrocellulose strip. The two media have different physical properties. (*Id*.) During testing, Syntron found that the colloidal gold labeled antibody cannot be resuspended and cannot migrate from the labeled zone to the test zone to generate a detectable signal on a single medium. Thus, the company developed the dual media design. (Lee Decl. para. 7). "Literal infringement of a claim requires that every limitation recited in the claim appear in the accused device, i.e., that the properly construed claim reads on the accused device exactly." Amhil Enters., Ltd. v. Wawa, Inc., 81 F.3d 1554, 1562 (Fed.Cir.1996). On reconsideration, the Court concludes that Syntron has raised a triable issue of fact for the jury on literal infringement and under the doctrine of equivalents.

Syntron argues that its dual media device does not infringe under the doctrine of equivalents. "[A]pplication of the doctrine of equivalents rests on the substantiality of the differences between the claimed and accused products or processes, assessed according to an objective standard. In applying the doctrine of equivalents, it is often enough to assess whether the claimed and accused products or processes include substantially the same function, way, and result." Hilton Davis Chemical Co. v. Warner-Jenkinson Co., Inc., 62 F.3d 1512, 1518 (Fed.Cir.1995). Typically the trier of fact makes such an assessment, but infringement by equivalence may be found on summary judgment. Bai, 160 F.3d at 1353.

Syntron's dual media device clearly serves the same function as those described in Abbott's patents. The function of the medium in the patents is to provide a flow path for the test solution and a place for the reaction to occur. Syntron argues that the critical issue is whether Syntron's devices achieve the supporting function in the same "way." Syntron has presented evidence that its devices do not function in the same way as those in Abbott's patents. (Lee Decl. para. 8). The glass fiber fabric (which holds the colloidal gold labeled antibodies) and nitrocellulose strip (where the capture antibody is located) are separate media made of different materials that were chosen for their unique physical properties. Syntron also notes that the switch from a single medium to a dual media is significant because it simplifies the development and manufacture process and decreases the production costs of the immunoassay devices. (*Id*.)

Abbott argues that the record contains sufficient undisputed evidence to support a finding of infringement by equivalents. Abbott contends that the specification shows various equivalent ways the flow path can be defined, including ways that make use of different materials to form, in combination, a "liquid permeable solid medium ." Specifically, Abbott points to examples in the specifications which use alternating pieces of filter paper, a cotton wick and filter paper, and alternating pieces of chromatography paper and microcrystalline cellulose. ('162 patent, col. 11, Ins. 13-17, col. 5, lns. 33-36, col. 14, Ins. 15-28). Nevertheless, Syntron has raised a triable issue of fact on equivalence of their dual media device to the device disclosed in Abbott's patents.

Syntron has presented sufficient evidence to create a triable issue of fact with regard to infringement of "a

liquid permeable solid medium" of claim 22. Therefore, the Court grants Syntron's motion for reconsideration with respect to infringement and modifies its order accordingly.

IV. Request for Clarification

A. Validity

Syntron requests clarification of the Court's Summary Judgment Order on the issue of Validity under 35 U.S.C. section 102. Abbott contends that the Court's order "eliminates Syntron's validity challenge in holding that there are no material issues of fact and that Syntron has 'failed to satisfy its burden of showing the invalidity of Abbott's patents with clear and convincing evidence." ' Syntron contends that this misstates the Court's order and overstates Abbott's procedural status as to validity.

The Court did not *sua sponte* grant a motion that was not before the court, namely a motion by Abbott for summary judgment on the question of validity. By finding that Syntron was not entitled to summary judgment on invalidity, the Court did not find the converse, that Abbott is entitled to summary judgment on validity, when no motion was before the Court. *See,* Sohappy v. Hodel, 911 F.2d 1312, 1320 (9th Cir.1990) (declining to enter summary judgment in favor of opposing party when he has made no cross-motion under Rule 56).

B. Infringement

Syntron also requests clarification as to infringement. The Court found infringement of Claim 22. (Order at 25). However, the Court has now determined that there is a triable issue of fact with regard to infringement of a "liquid permeable solid medium." Therefore, the Court declines to adopt Abbott's assertion that "[t]he Court's order granting summary judgment of infringement eliminates from trial any questions of infringement as to all asserted claims." The Court notes that Abbott has filed a Motion for Summary Adjudication of Issues of Infringement and Patent Validity. The hearing on this motion is to be held on October 16, 2000. Consequently, this issue is premature.

V. Request for Certification of Appeal

In the alternative to reconsideration, Syntron requested certification for interlocutory appeal on the claim construction issues pursuant to 28 U.S.C. s. 1292(b). Section 1292(b) allows for an immediate appeal of a non-final order upon the consent of both the district court and the court of appeals. To certify the Order, the Court must find that it involves (i) a controlling question of law (ii) that involves a substantial ground for difference of opinion, (iii) the resolution of which by the court of appeals will materially advance the termination of the dispute. "While Congress did not specifically define what it meant by 'controlling,' the legislative history of 1292(b) indicates that this section was to be used only in exceptional situations in which allowing an interlocutory appeal would avoid protracted and expensive litigation ." In re Cement Antitrust Litigation, 673 F.2d 1020, 1026 (9th Cir.1982); Coopers & Lybrand v. Livesay, 437 U.S. 463, 475 (1972).

Claim construction is but one step in the infringement analysis. The Court has determined that there are material issues of fact sufficient to preclude a finding of summary judgement on infringement. Syntron has not presented evidence to show that claim construction in this case is a controlling question of law sufficient to justify the exceptional order of certification for interlocutory appeal. Therefore, the Court declines to certify for interlocutory appeal its Order denying Syntron's motions for summary judgment and granting

Abbott's motion for summary judgment.

Conclusion

The Court GRANTS in part, DENIES in part, Syntron's motion for reconsideration and clarification of the Court's order granting Abbott's motion for summary judgment on infringement.

The Court GRANTS in part, DENIES in part, Syntron's request for a *Markman* hearing. The Court DENIES Syntron's request for certification of appeal.

IT IS SO ORDERED.

S.D.Cal.,2000.
Abbott Laboratories v. Syntron Bioresearch Inc.