United States District Court,
N.D. California.

**BOSTON SCIENTIFIC CORP., et al,**
Plaintiffs.
v.
**JOHNSON & JOHNSON and Cordis Corporation,**
Defendants.
**and Related Counter-Clai,**
and Related Counter-Claim.

No. C 02-00790 SI

**Sept. 19, 2006.**

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## ORDER GRANTING PLAINTIFFS' MOTION FOR RECONSIDERATION OF CLAIM CONSTRUCTION AND DECLARING NO INTERFERENCE-IN-FACT

SUSAN ILLSTON**, District Judge.**

Plaintiffs' motion for reconsideration of claim 7 of U.S. Patent No. 5,820,594 ("the '594 patent") and renewed request for declaration of no interference-in-fact. After carefully considering the pleadings and the arguments presented, and for good cause shown, the Court hereby GRANTS plaintiffs' motion.

## BACKGROUND

In 2002, plaintiffs Boston Scientific Corp., Boston Scientific Scimed, Inc., Scimed Life Systems, Inc. and Schneider (Europe) GmbH (collectively "BSC") brought suit against defendants Johnson & Johnson and Cordis Corporation for patent infringement. Four of the six patents that BSC asserted-the "Kastenhofer patents"-are relevant to the instant motion. FN1 These patents are directed to a bilayered catheter tube design for balloon angioplasty catheters. Cordis later filed a counterclaim against BSC, alleging that BSC was infringing three Cordis-owned patents that were also director towards bilayered catheters. The parties

refer to these three patents as the "Fontirroche patents." FN2

FN1. The Kastenhofer patents bear U.S. Patent Nos. 5,843,032 ("the '032 patent"), 5,961,765 ("the '765 patent"), 6,027,477 ("the ' 477 patent"), and 6,471,673 ("the '673 patent").

FN2. The Fontirroche patents bear U.S. Patent Nos. 5,538,510 ("the '510 patent"), 5,820,594 ("the '594 patent"), and 5,824,173 ("the '173 patent").

In August 2004, BSC moved for a judgment of non-interference between the Kastenhofer patents and the Fontirroche patents. Cordis later responded with its own motion for a declaration of an interference. On February 22, 2005, the Court issued an order finding an interference between the Fontirroche '594 patent and three of the Kastenhofer patents.FN3 Specifically at issue was the term "bonded" in claim 7 of the ' 594 patent. BSC argued that the term should be limited to chemical bonding, while Cordis argued that the term encompassed other types of bonding, such as physical bonding. The Court agreed with Cordis, concluding that the term "bonded" in claim 7 of the ' 594 patent encompassed more than just chemical bonding, and therefore found that an interference existed.

FN3. The Court found an interference between claim 7 of the '594 patent and claim 9 of the '032 patent, claim 10 of the '477 patent, and claim 7 of the '674 patent.

The Court held a bench trial between December 5 and December 8, 2005 to decide which patent had the earliest priority date in relation to the interference-in-fact. In light of testimony presented at the trial, BSC requested leave to file a motion for reconsideration of the Court's construction of the term "bonding" and "bonded" in the '594 patent. Leave was granted on January 18, 2006. Now before the Court is BSC's motion for reconsideration. For the following reasons, the Court GRANTS BSC's motion for reconsideration.

## LEGAL STANDARD

### I. Claim Construction

Claim construction is a matter of law. Markman v. Westview Instr., Inc., 517 U.S. 370, 372, 116 S.Ct. 1384, 134 L.Ed.2d 577(1996). Terms contained in claims are "generally given their ordinary and customary meaning." Phillips v. AWH Corp., 415 F.3d 1303, 1312 (Fed.Cir.2005). "[T]he ordinary and customary meaning of a claim term is the meaning that the term would have to a person of ordinary skill in the art in question at the time of the invention." *Id*. In determining the proper construction of a claim, a court begins with the intrinsic evidence of record, consisting of the claim language, the patent specification, and, if in evidence, the prosecution history. *Id* at 1313. "The appropriate starting point ... is always with the language of the asserted claim itself." Comark Communications, Inc. v. Harris Corp., 156 F.3d 1182, 1186 (Fed.Cir.1998). "[T]he language of the claim frames and ultimately resolves all issues of claim interpretation." Abtox, Inc. v. Exitron Corp., 122 F.3d 1019, 1023 (Fed.Cir.1997). In the absence of an express intent to impart a novel meaning to claim terms, an inventor's claim terms take on their ordinary meaning. However, claims are always read in view of the written description. *See* Vitronics Corp. v. Conceptronic, Inc., 90 F.3d 1576, 1582 (Fed.Cir.1996).

The written description can provide guidance as to the meaning of the claims, thereby dictating the manner

in which the claims are to be construed, even if the guidance is not provided in explicit definitional format. SciMed Life Systems, Inc. v. Advanced Cardiovascular Systems, Inc., 242 F.3d 1337, 1344 (Fed.Cir.2001). In other words, the specification may define claim terms "by implication" such that the meaning may be "found in or ascertained by a reading of the patent documents." Vitronics, 90 F.3d at 1584 n. 6. Although claims are interpreted in light of the specification, this "does not mean that everything expressed in the specification must be read into all the claims." Raytheon Co. v. Roper Corp., 724 F.2d 951, 957 (Fed.Cir.1983). For instance, limitations from a preferred embodiment described in the specification generally should not be read into the claim language. *See* Comark, 156 F.3d at 1187. However, it is a fundamental rule that "claims must be construed so as to be consistent with the specification." Phillips, 415 F.3d at 1316. Therefore, if the specification reveals an intentional disclaimer or disavowal of claim scope, the claims must be read consistent with that limitation. *Id*.

Although not as persuasive as intrinsic evidence, a court may also rely on extrinsic evidence, which "consists of all evidence external to the patent and prosecution history, including expert and inventor testimony, dictionaries, and learned treatises," to determine the meaning of claim language. Phillips, 415 F.3d at 1317. Extrinsic evidence should be evaluated in light of the intrinsic evidence. Id. at 1319.

**II. Patent Interference**

35 U.S.C. s. 291 provides for a civil action to determine an inference in fact:

The owner of an interfering patent may have relief against the owner of another by civil action, and the court may adjudge the question of the validity of any of the infringing patents, in whole or in part.

35 U.S.C. s. 291. A patent interference is designed to "determine whether two patent applications (or a patent application and an issued patent) are drawn to the same 'patentable invention' and, if so, which of the competing parties was first to invent the duplicative subject matter." Eli Lilly v. Bd. of Regents of the Univ. of Wash., 334 F.3d 1264, 1267 (Fed.Cir.2003). If interference is claimed between two issued patents, it must be adjudicated in district court under s. 291, rather than by the PTO. "[I]n order to provoke an interference in district court under s. 291, the interfering patents must have the same or substantially the same subject matter in similar form as that required by the PTO pursuant to 35 U.S.C. s. 135." Slip Track Systems, Inc. v. Metal-Lite, Inc., 304 F.3d 1256, 1263 (Fed.Cir.2002).

In order to determine if potentially infringing patents contain the same or substantially the same subject matter, courts utilize a two-way test. *See* Medichem, S.A. v. Rolabo, S.L., 353 F.3d 928, 934 (Fed.Cir.2003) Under the two-way test, "the claimed invention of Party A is presumed to be prior art vis-a-vis Party B and vice versa. The claimed invention of Party A must anticipate or render obvious the claimed invention of Party B and the claimed invention of Party B must anticipate or render obvious the claimed invention of Party A." *Id*. (quoting Winter v. Fujita, 53 U.S.P.Q.2d 1234, 1243 (B.P.A.I.. 1999)). The test incorporates the standards for anticipation and obviousness, under 35 U.S.C. s. 102 and 35 U.S.C. s. 103, to determine whether an interference exists. *Id*.

Anticipation occurs when "one skilled in the art would reasonably understand or infer from the [prior art reference's] teaching that every claim element was disclosed in that single reference." Dayco Prods., Inc. v. Total Containment, Inc., 329 F.3d 1358, 1368 (Fed.Cir.2003). Anticipation is a question of fact. Eaton Corp. v. Rockwell International Corp., 323 F.3d 1332, 1343 (Fed.Cir.2003).

A determination of obviousness under s. 103 is a question of law based on underlying findings of fact. Oakley, Inc. v. Sunglass Hut Intern., 316 F.3d 1331, 1339 (Fed.Cir.2003). Obviousness is based on whether a "hypothetical person having ordinary skill in the art" with all prior art references would regard the subject matter of the invention as obvious. Standard Oil Co. v. American Cyanamid, 774 F.2d 448, 453-4 (Fed.Cir.1985).

## DISCUSSION

Claim 7 of the '594 patent claims in part:

An intravascular balloon catheter, comprising:

a first flexible plastic tube defining a guidewire lumen, said first tube being coextruded of an outer plastic layer and an inner plastic layer, the plastic materials of said outer and inner plastic layers being different *and bonded to each other ....*

'594 Patent, 8:44-52 (emphasis added). The question presented by BSC's motion for reconsideration is whether "bonded" as used in this excerpt is limited to chemical bonding or if it also encompasses physical bonding. In its previous order, the Court found that "bonded" carried a broader meaning than "chemically bonded" and therefore interpreted the term to mean "the secure joining of two items to one another." The Court revisits that conclusion here.

### I. Construction of "Bonded"

BSC has convinced the Court that the unique circumstances of this case warrant reconsideration of its prior construction of "bonded." The Court has now had the benefit of trial, which included insightful testimony regarding how one skilled in the art would understand the '594 patent. Further, the Court also has the benefit of the Federal Circuit's *Phillips* decision, which clarified the importance of a patent's specification to the process of claim construction. Having considered its prior claim construction order in light of these new factors, the Court is now convinced that a person of ordinary skill in the art would have read claim 7 of the '594 patent to cover only chemical bonding.

### A. Specification

The starting point for understanding the meaning of a patent's claims is its specification. *See* Phillips, 415 F.3d at 1315 ("[T]he specification '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.' ") (citing Vitronics, 90 F.3d at 1582). A review of the '594 patent's specification reveals that the patent is directed towards chemical bonding. Indeed, from the first time the patent begins to discuss the manner in which it improves upon the prior art, it speaks in terms of chemical bonding. For example, in setting forth the benefits the invention provides, the patent states "[a]n alternative to a coating is a separate inner tube, usually made of performed polytetrafluoroethylene [PTFE].... As is well known, PTFE bonds only with great difficulty to most other plastic materials. As a result, PTFE does not bond in any significant way to the ... outer catheter shaft." '594 patent, 2:1-16.FN4 The use of "bond" as a verb in this sentence indicates that the invention seeks to actively bond the inner tuber with the outer tube, suggesting a chemical bond in which the materials are reacting rather than a more passive physical bond.FN5

FN4. *See also* '594 patent, abstract ("The plastic materials of the outer tube and inner layers are different,

and they may be chemically bonded to each other.").

FN5. Indeed, the only time the patent refers to a physical bond, it uses "physical bond" as a noun. '594 patent, 6:18-20. This also confirms that the patent, as discussed below, uses the terms "bond" and "chemical bond" interchangeably.

The patent continues in a key passage: "the material of the inner plastic layer may be a selected vinylic polymer having functional groups bonded to the material of the outer plastic layer.... Typically, known resins manufactured and sold ... under the trademark Plexar may be used for the inner plastic layer." Id. at 2:56-64. This passage is important for two reasons. First, it is undisputed that "functional groups" enable chemical bonding, and that "Plexar" is a material used to form a chemical bond with other plastics. Thus, the patent describes in significant detail how to achieve a bilayered catheter through use of a chemical bond.FN6 Second, the passage uses the word "bonded" to refer to the chemical bond between the vinylic polymer and the functional groups. This is consistent with other areas of the ' 594 patent in which "bond," standing alone, refers to a chemical bond. *See, e.g.,* ' 594 patent, 3:2, 3:11, 3:16, 7:6.

FN6. Again, this is a stark contrast with the single, conclusory sentence that Cordis argues discloses the use of a physical bond between the two tubes in its bilayered catheter. *See* '594 patent, 6:18-20.

The patent continues to discuss chemical bonding further: "Plexar or the like may be used as typically the inner layer of a multiple layer catheter tubing, taking advantage of that material's relatively good chemical bonding characteristic. Preferably the functional plastic material is not used to bond two dissimilar layers together, but rather making use of the material in its own right for its desired characteristics ... [H]igh density polyethylenes which have been copolymerized with a minor amount of functional groups ... may be used to provide a firm bond with an outer layer of nylon, PET, or polyurethane." Id. at 3:7-18; *see also* id. at 3:27-33 ("That innermost layer will preferably become chemically bonded during the coextrusion to an outer plastic layer which is made of a different material. Thus, normally incompatible plastic materials may be bonded together in the catheter tubing of the present invention to provide both a firm bond and the desired characteristics of the respective materials selected ."). The alternative embodiments mentioned in the description of the invention do not discuss any other bonding besides chemical bonding. *See* id. at 3:45-4:27.

The descriptions of the preferred embodiments of the invention likewise focus on chemical bonding. *See* id. at 4:10-12 ("Preferably, a chemical bond of the covalent type is formed between the outer an dinner plastic layers of the catheter shaft tubing."); id. at 5:30-32 ("The plastic materials of the outer and inner layers ... are made of different materials that are chemically bonded to each other."); id. at 6:27-28 ("The functional groups which are found on the vinylic polymers used in this invention to promote a chemical bond between the outer and inner plastic layers may include ... other pendant reactive groups as may be desired to permit the formation of a chemical bond between two plastic materials."); id. at 6:45-47 ("Such reactions may take place during co-extrusion of the two layers, to form a covalent bond between the outer and inner plastic layers of the catheter tube ...."); id. at 6:67-7:6 ("During this process, the reactive moieties of the plastic formulation which includes inner layer 34 forms chemical bonds with the plastic outer layer 32 ... [forming] a strong bond between the layers."). As is evident from these passages, the patent is not only focused on chemical bonding, it frequently uses the words "bond" and "chemical bond" interchangeably. In fact, a non-

chemical bond is mentioned only in one sentence of the patent: "[N]onreactive materials may be used for the inner layer ... when coextrusion provides a physical bond of adequate strength with [the outer] layer ." Id. at 6:18-20.

Indeed, the patent's description of the "high density polyethylene," which is explicitly required by claim 7, is illustrative of the patent's focus. The patent provides: "High density polyethylene is generally understood by those skilled in the art to have a density of at least about 0.94 g/cc. For purposes of this invention a polyethylene containing reactive groups and being of this density or greater is defined to be 'high density polyethylene.' " '594 patent, 7:9-13. While the parties dispute whether this passage is an express definition of "high density polyethylene," the passage is significant even if the inventors were not acting as their own lexicographers. This disclosure supports-strongly in the Court's opinion-the conclusion that the ' 594 patent is directed only at chemical bonding.

The Federal Circuit has held that the "focus of [a] patent" may bear on the proper construction of the claim terms. For example, in *On* Demand Mach. Corp. v. Ingram Indus., Inc., 442 F.3d 1331 (Fed.Cir.2006), the Federal Circuit considered a patent for an "on-demand" book manufacturing system. Id. at 1334-35. The invention used a customer kiosk that allowed customers to browse promotional sales information about books. *Id*. When the customer purchased a book, the book would be printed on-site from data stored in the kiosk. *Id*. Thus, the patent was described as enabling "the high speed manufacture of a single copy of a selected book on the immediate premises while the customer waits for a very short time." *Id*. at 1334. The patent holder sued a book printing company for infringement of this patent, even though that company did not sell directly to the general public. *Id*. at 1335.

Claim 8 of the patent described the steps of "providing means for a customer to visually review said sales information," and "commanding a computer to print the text of a selected one of said books in response to a customer's selection." *Id*. at 1336. The district court construed "customer" to mean anyone "who buys goods or services," rejecting the defendant's contention that "customer" should be limited to retail customers. *Id*. at 1339. The Federal Circuit reversed. Despite the fact that the patentee had not explicitly disavowed the standard dictionary definition of "customer," the Federal Circuit found that "customer" should be construed as "retail customer" because "[t]he ... specification repeatedly reinforces its usage of the term 'customer' as the retail consumer." *Id*. at 1340. "Although we agree with the district court that the Ross invention does not concern itself with whether the 'customer' reads the book or obtains it for resale, the focus of the Ross patent is immediate single-copy printing and binding initiated by the customer and conducted at the customer's site. The district court's definition of 'customer' cannot eliminate these constraints in order to embrace the remote large-scale production of books for publishers and retailers." *Id*. at 1340; *see also* Phillips, 415 F.3d at 1316 ("In light of the statutory directive that the inventor provide a 'full' and 'exact' description of the claimed invention, the specification necessarily informs the proper construction of the claims.").

As with the patent at issue in *On Demand,* the '594 patent is focused on chemical bonding.FN7 As set forth above, the patent's entire specification discusses chemically bonded catheter tubes. While Cordis seizes upon the single time the patent mentions "physical bond" to argue that the patent is not so limited, the Court does not find that this lone sentence is sufficient to expand the patent's scope. Indeed, as the extrinsic evidence confirms, it is highly doubtful that the passing reference to a "physical bond" is enough to cause one of ordinary skill in the art to understand that the invention reaches physical bonding between the two layers of the catheter.

FN7. In fact, as discussed below, the case for finding the'594 to be limited to chemical bonding is even

stronger than in *On Demand*, because while the invention in *On Demand* was broader than the patent's claims, the invention in this case only involves chemical bonding and is therefore narrower than Cordis's interpretation of the patent. *See On* Demand, 442 F.3d at 1340.

Cordis also argues that "bonded" in claim 7 of the '594 patent should not be limited to "chemically bonded" because claim 1 of the patent explicitly refers to "chemically bonded" layers. "When different words or phrases are used in separate claims, a difference in meaning is presumed." Nystrom v. Trex Co., Inc., 424 F.3d 1136, 1143 (Fed.Cir.2005). This presumption is not absolute, however. "Different terms or phrases in separate claims may be construed to cover the same subject matter where the written description and prosecution history indicate that such a reading of the terms or phrases is proper." *Id*. Here, the written description and the extrinsic evidence confirm that "bonded" and "chemically bonded" were used interchangeably in the '594 patent.

**B. Extrinsic Evidence**

There is substantial extrinsic evidence in the record confirming the focus of the specification, and leading to the conclusion that a person of ordinary skill in the art would have understood "bonding" as used in claim 7 of the ' 594 patent to indicate only chemical bonding. Most convincing to the Court is the evidence stemming from Thomas Trotta, one of the inventors of the ' 594 patent. Both Trotta's testimony and the circumstances in which he was added as an inventor to the '594 patent support the Court's conclusion that the '594 patent is limited to chemical bonding.

**1. Thomas Trotta**

Trotta was a Cordis employee who supervised Fontirroche and Querns, the two originally identified inventors of the '594 patent. In May 1993, Fontirroche and Querns submitted a Cordis invention disclosure form to Trotta, describing a catheter with a two-layer inner member. The form explicitly stated that "the bond between the two layers is chemical, and they cannot be separated." DTX 59 at COR 25498. The form also provided that the "[n]ovel feature of this device is the utilization of a tie-layer (or adhesive) resin as the innermost layer of the laminate structure.... The tie-layer material bonds chemically to the more rigid overcoat." Id. at COR 25499. Trotta understood the invention to describe a catheter that utilized chemical bonding. Tr. Trans. at 757. Indeed, Cordis never successfully made a catheter that utilized physical bonding. Tr. Trans. at 944.

Fontirroche and Querns submitted a patent application based upon this invention disclosure form. That application later issued as the '510 patent, which claimed only dual-layer catheters in which the inner and outer layers were chemically bonded to each other. '510 patent, col. 6-8. The inventors later filed a continuation application that eventually issued as the '594 patent.

Trotta was not originally named as an inventor on either the '510 patent or the '594 patent. At trial, Trotta explained that he understood the patents to be limited to chemical bonding; since he played no part in the chemical bonding facet of the patents, he was not named as an inventor. Spanbauer Decl., Exh. A at 25. After this Court issued its interference order in February 2005, however, interpreting the '594 patent to reach physical bonding between the catheter's two layers in addition to chemical bonding, Cordis moved to amend the patent to add Trotta as an inventor. *See* id. at 29; Tr. Trans. at 944. This amendment was based on the fact that Trotta had conceived of a physically bonded catheter in July 1991. *See* DTX 39.

In some cases actions speak louder than words. Here, the actions of the inventors of the '594 patent reveal that not a single one of them believed claim 7 of the '594 patent covered physical bonding until this Court erroneously construed "bonded" in February 2005. Indeed, it took over nine years from the time the patent application was filed, over seven years from issuance of the patent, and a favorable claim construction order, before anyone who had a duty to disclose to the patent office Trotta's identity as inventor of the '594 patent actually did so. This mistake is not trivial given that patents cannot be issued when the named inventors did not invent the subject matter that the patent claims. 35 U.S.C. 102(f). The Court takes this substantial delay as strong evidence that the inventors did not-and that a person of ordinary skill in the art therefore would not-understand their invention to reach other forms of bonding besides chemical bonding. *Cf.* Bristol-Myers Squibb Co. v. Teva Pharms. USA, Inc., 288 F.Supp.2d 562, 585 (S.D.N.Y.2003) ("Testimony against a patentee's own interest ... is perhaps the 'most persuasive extrinsic evidence.' ").

This interpretation of the inventors' behavior is confirmed to a large degree by Trotta's testimony. As a co-inventor of the patent, Trotta is one of ordinary skill in the art and his testimony is allowable extrinsic evidence in determining the meaning of claim language. Phillips, 415 F.3d at 1317. Trotta testified that the word "bonded" as generally used in the catheter industry requires some type of chemical interaction. *See* Spanbauer Decl., Exh. A at 19-20 ("In, you know, just a frictional ability to join something with friction, I would not have considered-I do not think I would have discussed that as a bond."). With specific reference to the '594 patent, Trotta also testified that his understanding of the '594 patent before 2002 was that it "was limited to chemical bonding." Tr. Trans. at 789. Although Trotta had not thoroughly read the '594 patent prior to 2002, he had reviewed it and was clear that he believed it was limited to chemical bonding. Id.

Cordis argues that BSC has mischaracterized Trotta's testimony. It points to Trotta's testimony that his "present understanding of the term bonded in the context of the '594 patent" as "that it's joined securely, doesn't necessarily have to be a chemical bond." Spanbauer Decl., Exh. A at 18. Trotta also testified, however, that his "present understanding" stems from this Court's claim construction order. *See* id. at 20, 26-27. The Court does not find this particularly probative.

Thus, both the testimony and behavior of Trotta and the other inventors in this case strongly supports this Court's reading of the '594 patent's specification.

**2. Patent Examiner**

In addition to Trotta's testimony and the circumstances under which he was added as an inventor of the '594 patent, the patent examiner's interpretation of the '594 patent also suggests that one of ordinary skill in the art would believe that the '594 patent was limited to chemical bonding. Two actions by the patent examiner are relevant. First, the patent examiner initially rejected the '594 patent, finding it was obvious in light of the '510 patent. Second, the patent examiner found that there was no interference-in-fact between the Fontirroche patents and the Kastenhofer patents.

**a. Obviousness Rejection**

As mentioned above, the '594 patent was a continuation-in-part of the ' 510 patent application. In the background section of the specification of the '510 patent, the invention is described as "having tubing with inner and outer tubular layers which are bonded to each other for firm retention." ' 510 Patent, 1:58-59. The description elucidates several times that the nature of this bond is that of a covalent bond, a type of chemical bond, only. *Id.* at 1:67-2:3, 2:22-23, 2:41-48. In addition, the background describes how the invention is different than prior art catheters, which had layers that did "not bond in any significant way" or did "not

form a significant bond." *Id*. at 1:3-35, 1:41-46.

When the patent examiner initially reviewed the '594 patent application, he rejected it for obviousness-type double patenting, concluding that "the claims of both the patent and the application require the same material, *i.e*., Plexar." Noonan Decl., Exh. E at 3. Thus, another person of ordinary skill in the art believed that the claims within the '594 patent application required chemical bonding.FN8 *Cf*. Salazar v. Proctor & Gamble, 414 F.3d 1342, 1347 (Fed.Cir.2005) ("Statements about a claim term made by an examiner during prosecution of an application may be evidence of how one of skill in the art understood the term at the time the application was filed."); In re Lee, 277 F.3d 1338, 1345 (Fed.Cir.2002) ("In finding the relevant facts, in assessing the significance of the prior art, and in making the ultimate determination of the issue of obviousness, the examiner and the Board are presumed to act from th[e] viewpoint of [a person having ordinary skill in the art].")

FN8. As discussed above, Plexar is a trade name for high density polyethylene with reactive groups, which allow it to chemically bond with other materials.

**b. Finding of No Intervention-in-Fact**

As discussed in the Court's February 2005 order, the fact that the PTO did not declare an interference between the Kastenhofer and Fontirroche patents during prosecution is also evidence that no interference-in-fact exists. *See* Advanced Transformer Co. v. Levinson, 837 F.2d 1081, 1084 (Fed.Cir.1988) (fact that PTO had not declared an interference "may be considered as evidence of an absence of identity of the claimed inventions"). Indeed, The Manual of Patent Examining Procedure ("MPEP") s. 2301.01 requires examiners to use "the greatest care ... in the search for interfering applications and in determining whether an interference should be declared." The examiner uses the same two-way test as the Court, but must incorporate the "broadest interpretation which [the claims] reasonably will support." MPEP s. 2301.01. Additionally, MPEP s. 1302.08 requires that the examiner make an interference search when the application is ready for issue. This is done "in order to ascertain whether any other applicant is claiming substantially the same subject matter as is being allowed in the case at hand." *Id*.

Accordingly, the patent examiner's determination that no interference existed between the '594 patent and the Kastenhofer patents also supports this Court's revised claim construction.

**3. Other Extrinsic Evidence**

Cordis points to two pieces of extrinsic evidence that run counter to BSC's contention that "bonded" means chemically bonded to one of ordinary skill in the art. First, Cordis points to Trotta's testimony regarding his present understanding of the word "bonded" in the '594 patent. As discussed above, however, the Court finds this evidence far less persuasive than Trotta's admission the he generally understands "bonded" to mean chemically bonded, and that he understood the invention disclosed by the '594 patent to be limited to chemical bonding for almost ten years. Spanbauer Decl., Exh. A at 19, 20, 28; Tr. Trans. at 757, 944.

Cordis also points to the fact that several other patents involving the same technology use the word "bonded" to refer to non-chemical bonds. For example, BSC's '477 patent uses the term "bonded" and describes it as "welded or otherwise securely bonded ." *See* '477 Patent, 1:39-43, 1:67-2:2, 2:53-59. While Cordis's testimony tends to rebut the Court's view of the meaning of the word "bonded," the Court does not find the isolated statements that Cordis cites as persuasive as the direct admission of Trotta that he

understands "bonded" to mean "chemically bonded."

**C. Conclusion**

Based on the focus of the specification and the substantial evidence concerning how one skilled in the art would read the '594 patent, the Court finds that "bonded" in claim 7 of the '594 patent should be construed as "chemically bonded."

**II. Interference-in-Fact Analysis**

As the Court has found that "bonded" in claim 7 under the '594 patent is limited to "chemically bonded," the Court must reconsider its previous finding of an interference-in-fact between claim 7 of the '594 patent and the Kastenhofer patents. Using the two-way test described above and applied in the previous order, the '594 patent does not anticipate or render obvious any of the Kastenhofer product patents if it is assumed that the '594 patent is prior art to the Kastenhofer patents. *See* Medichem, S.A., 353 F.3d at 934. The Kastenhofer patents are not anticipated by the '594 patent because the Kastenhofer patents do not require the claim element "chemically bonded." In addition, the Kastenhofer patents are not rendered obvious by the '594 patent because there is no evidence that a "hypothetical person having ordinary skill in the art" would regard Kastenhofer patents as obvious in light of the ' 594 patent. Accordingly, the Court holds that there is no interference-in-fact between the '594 patent and the Kastenhofer product patents.

**CONCLUSION**

For the foregoing reasons and for good cause shown, the Court GRANTS BSC's motion for reconsideration and hereby construes the term "bonded" in claim 7 of the '594 patent to mean "chemically bonded." As a result of this construction the Court finds that there is no interference-in-fact between claim 7 of the Fontirroche '594 patent and the Kastenhofer patents. [Docket # 415]

**IT IS SO ORDERED.**

N.D.Cal.,2006.
Boston Scientific Corp. v. Johnson & Johnson