

United States District Court,
D. Massachusetts.

PALOMAR MEDICAL TECHNOLOGIES, INC. and,
v.
CANDELA CORPORATION.

Civil Action No. 06-11400-RWZ

Nov. 8, 2007.

Katie Marie Saxton, Lawrence P. Cogswell, III, Nicole Silvestri, Vinita Ferrera, Wayne L. Stoner, WilmerHale LLP, Boston, MA, for Palomar Medical Technologies, Inc. and The General Hospital Corp.

Gasper J. Larosa, Howard Suh, Leora Ben-Ami, Richard G. Greco, Thomas F. Fleming, Kaye Scholer LLP, New York, NY, Joan M. Griffin, McDermott, Will & Emery LLP, Boston, MA, for Candela Corporation.

MEMORANDUM OF DECISION AND ORDER

ZOBEL, D.J.

I. Introduction

Once again this court finds itself faced with the hairy problem of interpreting the claims of a patent for hair removal. Plaintiffs Palomar Medical Technologies, Inc., and the General Hospital Corporation (collectively "Palomar") allege that defendant Candela Corporation ("Candela") has infringed United States Patent Nos. 5,595,568 ("the '568 patent"), "Permanent Hair Removal Using Optical Pulses" and 5,735,844 ("the '844 patent"), "Hair Removal Using Optical Pulses." The parties dispute the construction of six terms from claims 1, 3, 12, 17, 27, 28 and 32 of the '844 patent and one term from claim 8 of the '568 patent.

II. Legal Standard

The construction of patent claims is a matter of law for this court to decide. *Markman v. Westview Instruments, Inc.*, 517 U.S. 370, 388-89, 116 S.Ct. 1384, 134 L.Ed.2d 577 (1996). Normally, "the words of a claim are given their ordinary and customary meaning," that 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." *Phillips v. AWH Corp.*, 415 F.3d 1303, 1312-13 (Fed.Cir.2005) (internal quotation marks and citations omitted). "[T]he person of ordinary skill in the art is deemed to read the claim term not only in the context of the particular claim in which the disputed term appears, but in the context of the entire patent, including the specification." *Id.* at 1314.

The presumption that words are given their ordinary meaning may be overcome if the patent specification or prosecution history "clearly and deliberately set [s] forth" a different meaning. *K-2 Corp. v. Salomon S.A.*, 191 F.3d 1356, 1363 (Fed.Cir.1999); *accord* *Boehringer Ingelheim Vetmedica, Inc. v. Schering-Plough Corp.*, 320 F.3d 1339, 1346 (Fed.Cir.2003). Such a circumstance arises where "the patentee has chosen to be

his or her own lexicographer by clearly setting forth an explicit definition for a claim term" or "where the term or terms chosen by the patentee so deprive the claim of clarity that there is no means by which the scope of the claim may be ascertained from the language used." *Johnson Worldwide Assoc., Inc. v. Zebco Corp.*, 175 F.3d 985, 990 (Fed.Cir.1999).

If the intrinsic evidence fails to resolve ambiguity in the claim language, evidence extrinsic to the patent file and history such as expert and inventor testimony, dictionaries, and technical treatises and articles may be considered "to help the court come to the proper understanding of the claims; it may not be used to vary or contradict the claim language." *Vitronics Corp. v. Conceptoronic, Inc.*, 90 F.3d 1576, 1584 (Fed.Cir.1996); *see also Phillips*, 415 F.3d at 1317 ("[Extrinsic evidence] is less significant than the intrinsic record in determining the legally operative meaning of claim language.") (internal quotation marks and citations omitted).

III. Discussion

A. The '844 Patent

1. Previously Construed Terms

I construed the six terms at issue FN1 from the '844 Patent in an earlier case, *Palomar Med. Tech., Inc. v. Altus Medical, Inc.*, No. Civ. A. 02-10258-RWZ, 2004 WL 367720 (D.Mass. Feb.24, 2004).FN2 Candela argues that for all six terms, a more limiting construction is correct. Palomar continues to assert that my earlier construction of the term "element" is excessively limiting. After considering the parties' written submissions as well as argument of counsel at a hearing, I conclude that my earlier construction of the disputed terms was, and is, in accordance with the applicable legal standard. Accordingly, I adopt it here as well.

FN1. Five of the six terms at issue in the instant case are identical to those construed in the earlier case. One term construed in the earlier case appears here with additional words. I discuss the construction of the additions *infra* Part III.A.2 and Part III.A.3.

FN2. *Altus Medical, Inc.* is now known as *Cultera, Inc.*

2. The "Adapted to be" Limitation

The parties dispute the meaning of the additional words "adapted to be" preceding the previously construed term "in pressure contact with a portion of the skin surface" in claim 27 of the '844 Patent. Candela insists that it limits the invention to applicators which are "fit for (i.e., constructed for)" pressing down on the skin, while Palomar argues that it includes all applicators which are "capable" of pressing down on the skin, even if not specifically designed for that purpose. (*Compare* Docket # 45, 15-17, with Docket # 35, 17-18.) While this phrase is commonly used in patent claims, guidance from the Federal Circuit on its meaning is rather sparse.FN3

FN3. Both parties rely on unpublished decisions of the Federal Circuit to support their respective

constructions. Those decisions, however, specifically disallow their use as precedent.

Palomar's construction effectively reads the phrase out of the claim as a limitation without first examining it in light of the specification. *See Phillips*, 415 F.3d at 1312-13; *see also Manual of Patent Examining Procedure* s. 2111.04 (8th ed., rev.5, Aug. 2006) ("The determination of whether [the clause 'adapted to'] is a limitation in a claim depends on the specific facts of the case."). Almost any applicator shape is "capable" of being in pressure contact with the skin. The specification, however, describes the applicator in one embodiment as having "a convex surface in contact with the skin surface," while another describes it as "designed to form a fold of the skin." ('844 Patent, col. 2 ll.47-51.) The design of the applicator is important to provide "efficient compression of the skin," "uniform displacement of blood," "allow [] optical radiation to be coupled into and out of the epidermis," and, in an alternative embodiment, to apply pressure "to the skin on both sides." (*Id.* at col.6 ll.50-51, col.7 ll.1-3, 14-15, col.15 ll.10-11.) Therefore, the specification supports an interpretation of "adapted for" that requires some deliberate design or construction of the applicator that relates to the function of its being "in pressure contact with the skin." Other courts have come to similar conclusions. *See Boston Scientific Corp. v. Cordis Corp.*, No. C 02-10474 JW, 2006 U.S. Dist. LEXIS 94329, at *7, 2006 WL 3782840 (N.D.Cal. Dec. 20, 2006) (unpublished) (concluding that "adapted to" requires "the concept of a device intentionally and specifically made to act in a certain way"). Therefore, I conclude that the phrase "adapted to be" requires that the applicator be designed to be in pressure contact with the skin.

3. "Said Skin Region"

Unlike the earlier case, the parties here also include the words "in said skin region" as part of the term disputed in the first limitation of claim 27. I adopt the same construction of "said skin region" as previously determined in the third limitation of claim 27: "skin from which a plurality of hairs is to be simultaneously removed."

B. The '586 Patent

The only claim in this patent that requires elucidation is claim 8, and the only terms in issue the are "wavelength of the optical radiation" to be "selectively absorbed by the follicles." ('586 Patent, claim 8.) The '586 Patent specification describes a preferred embodiment of the hair-removal system which allows the operator to control, inter alia, the wavelength of the irradiating optical field. The wavelength is selected to be resonant with the natural pigment in the target site, but "relatively transmitted by both hemoglobin and water." (*Id.* at col.7 ll.9-11, 24-25.) In particular, the goal is to "maximize the amount of light-induced heat deposited in the hair follicles, while reducing the degree of injury to the surrounding skin." ('586 Patent, col.4 ll.7-9.) Candela's proposed construction captures this goal by its use of the word "effectively," while Palomar's construction merely requires a difference in the rates of absorption.

IV. Conclusion

Accordingly, the court construes the disputed claim terms as follows:

'844 Patent Term	Court's Construction
Applicator (claims 1, 3, 12, 17, 27, 28)	A device for applying optical radiation
Applying optical radiation ... through said applicator to said skin region (claims 1, 12,	Applying optical radiation through the applicator that is in contact with the skin surface to the area of skin from which a

17)	plurality of hairs is to be simultaneously removed
Pressure being applied to the applicator ... so as to cause the applicator to deform the skin region thereunder (claim 12)	Pressure being applied to the applicator so as to cause the applicator to compress the area of the skin under it
Adapted to be in pressure contact with a portion of the skin surface ... in said skin region (claim 27)	Designed to be touching with pressure a portion of the skin surface ... in the area of skin from which a plurality of hairs is to be simultaneously removed
The optical radiation being passed through the applicator to said skin region (claim 27)	Optical radiation going by way of an applicator to the area of skin from which a plurality of hairs is to be simultaneously removed

Element (claim 32)	A device or component of a device for converging optical radiation
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568 Patent Term	Court's Construction
Wavelength ... is selectively absorbed by the follicles (claim 8)	A wavelength that is absorbed effectively by the hair follicles but not by the compounds contained in the surrounding skin

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