Retractable Technologies, Inc. v. Becton, Dickinson & Co.: The Federal Circuit’s Debate over Claim Construction Methodology and Deference Rages On

John J. Molenda
Megan T. Levine

This article first appeared in a slightly different form in NYIPLA Bulletin October/November 2011.

Introduction
In an October 31, 2011 order rife with heated dissents, the Federal Circuit denied en banc rehearing in Retractable Technologies, Inc. v. Becton, Dickinson & Co., a case presenting a seemingly ideal opportunity for the court to review key aspects of its claim construction precedent. Judge Moore (joined by Chief Judge Rader) and Judge O’Malley issued dissenting opinions which together focused on two highly contentious claim construction issues at the Federal Circuit: (i) the proper use of the specification in interpreting patent claims and (ii) the amount of deference, if any, that the Federal Circuit should afford to a district court’s claim interpretation. Although the court refused to grant rehearing in this case, the dissenting voices have provided compelling arguments for the court to consider a serious reevaluation of its claim construction jurisprudence.

Background
The technology at issue in Retractable Technologies involved medical syringes with needles that retracted into the body of the syringe following use. The needle retraction feature served as a safety measure to prevent accidental needle pricks by unhygienic needles. Retractable Technologies, Inc. (“RTI”) sued Becton, Dickinson & Co. (“BD”) in the Eastern District of Texas, asserting that several models of BD’s Integra syringe infringed certain claims of U.S. Patent Nos. 5,632,733, 6,090,077, and 7,351,224 (collectively the “patents-in-suit”). The parties disputed the construction of several claim terms, one of which is the focus of the present discussion: whether the “body” limitation of the claimed syringe should be limited to covering a one-piece syringe body, or whether that term should also cover a multi-piece syringe body.
district court construed the “body” limitation to mean a “hollow outer structure that houses the syringe components,” and further interpreted the term to encompass both one-piece and multi-piece syringe bodies. As a consequence of this construction, the jury ultimately found that BD’s 3 mL Integra product, which possessed a multi-piece body, infringed the pertinent asserted patent claims. Subsequently, the district court denied BD’s various post-trial motions, including BD’s motion for judgment as a matter of law of non-infringement.

Federal Circuit Opinions

THREE-JUDGE PANEL OPINIONS
On appeal, BD argued that the claim term “body” should be limited to a one-piece body. BD asserted that the specification notably characterized the invention as being a syringe with a one-piece body, but also criticized prior art syringes having two-piece bodies. RTI responded that the ordinary meaning of “body” is not limited to a one-piece body but also includes a multi-piece body. RTI argued that the doctrine of claim differentiation supports this construction, as some claims recited “body” while others recited the term “one piece body.” Additionally, RTI argued that the preferred embodiment, a syringe with a one-piece body, was intended to illustrate manufacturing benefits, not limit claim scope.

MAJORITY OPINION
The majority disagreed with the district court’s claim construction holding that the disclosure in the specification dictated that the term “body” should be limited to a one-piece structure. Judge Lourie’s majority opinion rejected RTI’s claim differentiation argument in view of the disclosure in the specification and the fact that no claims expressly recited a multi-piece body. In addition, the majority cited the Summary of the Invention, which stated that the “invention is a retractable tamperproof syringe . . . featuring a one piece hollow body.” The majority also referenced the fact that all disclosed embodiments had a one-piece body and that the specification taught that the prior art had failed to appreciate a one-piece syringe body. While acknowledging the tension between competing claim construction doctrines instructing judges to interpret claims in light of the specification on the one hand, but not import limitations into claims from the specification on the other hand, Judge Lourie appeared comfortable with erring on the side of disregarding the latter rule. He wrote, “In reviewing the intrinsic record to construe the claims, we strive to capture the scope of the actual invention, rather than . . . allow the claim language to become divorced from what the specification conveys is the invention.”

CONCURRING OPINION
In his concurring opinion, Judge Plager wholeheartedly agreed with Judge Lourie’s view that the court should seek to construe claims in accordance with what the patentee actually invented instead of severing the claims from the invention disclosed in the specification. He stated, “However much desired by the claim drafters, who want claims that serve as business weapons and litigation threats, the claims cannot go beyond the actual invention that entitles the inventor to a patent.” Acknowledging the fundamental quid pro quo of the patent system, Judge Plager noted that inventors should “make full disclosure of what is actually invented, and . . . claim that and nothing more.”

DISSENTING OPINION
Chief Judge Rader dissented in part, arguing that the claim language makes clear that the “body” limitation should not be limited to a “one-piece body,” and that it is improper to import limitations from the specification
into the claims. He noted that under *Phillips v. AWH Corp.*, claim language is to be given its “ordinary and customary meaning.” Chief Judge Rader continued that, in this case, there was no reason to depart from the claim term’s ordinary and customary meaning, as no party had alleged that “body” had a special technical meaning in the field of art, and the specification did not include an express disclaimer of claim scope by merely describing a “one piece hollow outer body” in certain passages. Chief Judge Rader further argued that the majority improperly ignored the doctrine of claim differentiation. Quoting *Phillips*, he explained that claim differentiation “gives rise to a presumption that the limitation in question is not present in the independent claim,” and that this “strong presumption” was not rebutted here. To conclude, Chief Judge Rader again chastised the majority for improperly importing the “one-piece” limitation from the specification into the claims.

Petition for Rehearing

RTI subsequently sought rehearing *en banc* of the panel’s decision. While the court denied RTI’s petition, three Federal Circuit judges dissented from this denial in two separate opinions. Judge Moore’s dissenting opinion vocalized two chief concerns: (i) the court’s apparently inconsistent use of the specification in interpreting patent claims and (ii) the Federal Circuit’s lack of deference to district court claim constructions. Judge O’Malley’s dissent focused exclusively on the issue of deference.

**JUDGE MOORE’S DISSenting OPInION**

Judge Moore’s dissent, with which Chief Judge Rader joined, first addressed her concern that Federal Circuit panels employ the specification inconsistently when interpreting patent claims. Judge Moore asserted that the process of claim construction should not be confused with a validity determination, and that claim terms should be given their plain and ordinary meaning unless “the inventor acted as his own lexicographer” or expressly disavowed claim scope. Because neither exception applied in this case, Judge Moore argued that the majority’s decision to depart from the plain and ordinary meaning in *Retractable Technologies* cannot be reconciled with the Federal Circuit’s *en banc* precedent set in *Phillips*.

In further criticism of the majority’s reasoning, Judge Moore asserted that the panel erred in rewriting the claims in accordance with the panel’s own perception of what the invention “is.” Judge Moore also reiterated a point made by Chief Judge Rader’s dissent, namely that claim differentiation strongly militated against reading the “one-piece” limitation into the claims, and she viewed the majority’s decision not to apply that doctrine as yet another way in which this case conflicted with *Phillips*. Finally, to underscore what she perceived to be conflicts in the court’s claim construction methodology, Judge Moore pointed to the differing outcomes reached in several cases, including this one, despite the apparent similarity in fact patterns in the cases.

With respect to her second concern, Judge Moore stated that *en banc* review should have been granted to address the issue of deference to district court claim construction determinations. Judge Moore asserted that it is a “fallacy” to view claim construction as a pure question of law. Rather, she argued that claim construction is a question of law with underlying facts, and the Federal Circuit should give deference to those factual determinations.

**JUDGE O’MALLEY’S DISSenting OPInION**

Judge O’Malley’s dissent focused on the issue of deference, including her desire that the Federal Circuit reverse its decision in *Cybor Corp. v. FAS Techs., Inc.* which held that claim construction determinations are purely legal and should be...
reviewed *de novo*. Judge O’Malley argued that in *Cybor*, the Federal Circuit misinterpreted the Supreme Court’s decision in *Markman v. Westview Instruments, Inc.*, which held that claim construction is an issue of law for the court, not the jury, to decide. Noting that the Supreme Court in *Markman* characterized claim construction as a “mongrel practice,” Judge O’Malley contended that a correct reading of the decision is that claim construction is a mixed question of law and fact and that deference should be given to a district court’s factual findings. Judge O’Malley pointed to several reasons why she viewed such deference appropriate, including district court judges’ resources and training, as well as their capacity to hear live testimony in hearings that, in some cases, last for several days. She further noted that the lack of agreement among panel members on the claim construction issues in this case underscored the shortcomings of the Federal Circuit’s *de novo* approach. Lastly, Judge O’Malley argued that in cases such as this one, where “there is fair debate about the scope of the invention after application of Phillips’s principles, we should defer to reasoned district court choices.”

**Conclusion**

While the Federal Circuit did not deem *Retractable Technologies* to be an appropriate vehicle through which to reassess the issues of claim construction methodology and deference, these issues may not remain dormant for long. As Judge O’Malley referenced in her dissent, five of the ten currently active judges on the court agreed in *Amen Inc. v. Hoechst Marion Roussel, Inc.* that the Federal Circuit should revisit its ruling in *Cybor*. Five years after *Amen*, the dissenting opinions in this case renew that call and additionally seek reexamination of the court’s claim construction methodology. With one newly confirmed nominee and another nominee about to embark on the confirmation process, it would not be surprising if the court decides to revisit these issues in the near future.

---

**For more information about this topic, please contact the following authors.**

**John J. Molenda**  
New York  
+1 212 506 2266  
jmolenda@mayerbrown.com

**Megan T. Levine**  
New York  
+1 212 506 2776  
mlevine@mayerbrown.com

**Endnotes**

2. See id.
4. Id.
5. The patents-in-suit share a common specification for the issues discussed in this case so for simplicity we refer only to the specification of U.S. Patent No. 5,632,733 throughout this article. See id. at 1298, 1300 n.1.
6. See id. at 1304–05.
8. See id. at 1298.
9. Id.
10. Id. at 1304.
11. Id.
12. Id.
13. Id. at 1304–05.
14. See id. at 1305.
Mayer Brown is a global legal services organization advising many of the world’s largest companies, including a significant portion of the Fortune 100, FTSE 100, DAX and Hang Seng Index companies and more than half of the world’s largest banks. Our legal services include banking and finance; corporate and securities; litigation and dispute resolution; antitrust and competition; US Supreme Court and appellate matters; employment and benefits; environmental; financial services regulatory & enforcement; government and global trade; intellectual property; real estate; tax; restructuring, bankruptcy and insolvency; and wealth management.

Please visit our web site for comprehensive contact information for all Mayer Brown offices. www.mayerbrown.com

IRS CIRCULAR 230 NOTICE. Any advice expressed herein as to tax matters was neither written nor intended by Mayer Brown LLP to be used and cannot be used by any taxpayer for the purpose of avoiding tax penalties that may be imposed under US tax law. If any person uses or refers to any such tax advice in promoting, marketing or recommending a partnership or other entity, investment plan or arrangement to any taxpayer, then (i) the advice was written to support the promotion or marketing (by a person other than Mayer Brown LLP) of that transaction or matter, and (ii) such taxpayer should seek advice based on the taxpayer’s particular circumstances from an independent tax advisor.

Mayer Brown is a global legal services organization comprising legal practices that are separate entities (the Mayer Brown Practices). The Mayer Brown Practices are: Mayer Brown LLP, a limited liability partnership established in the United States; Mayer Brown International LLP, a limited liability partnership incorporated in England and Wales; Mayer Brown JSM, a Hong Kong partnership, and its associated entities in Asia; and Tauil & Chequer Advogados, a Brazilian law partnership with which Mayer Brown is associated. “Mayer Brown” and the Mayer Brown logo are the trademarks of the Mayer Brown Practices in their respective jurisdictions.

This Mayer Brown publication provides information and comments on legal issues and developments of interest to our clients and friends. The foregoing is not a comprehensive treatment of the subject matter covered and is not intended to provide legal advice. Readers should seek specific legal advice before taking any action with respect to the matters discussed herein.

© 2011. The Mayer Brown Practices. All rights reserved.