

## What's a Poor "Body" to Do? Invention by Embodiment

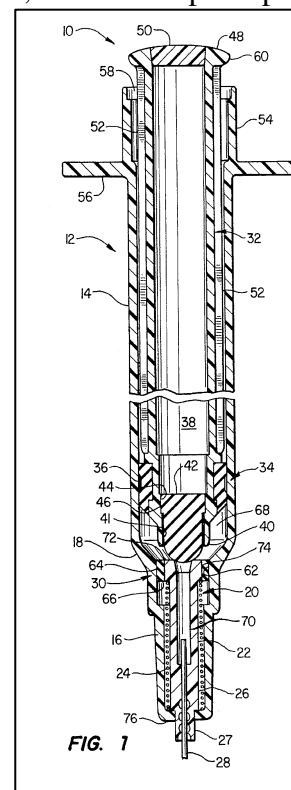
Paul E. Rossler, [GableGotwals](#)

*"They don't think it be like it is, but it do."*

– Oscar Gamble<sup>1</sup>

When applying for a patent, an inventor must (1) describe the invention in enough detail so as to “enable” a person of ordinary skill in the art to make and practice the invention without having to resort to an unreasonable amount of trial-and-error experimentation, (2) disclose in that written description the inventor’s “best [known] mode” or embodiment of the invention at the time of applying for the patent, and (3) particularly point out or “claim” what the inventor considers to be the invention.<sup>2</sup> Because the best known embodiment disclosed (as well as any other preferred embodiment) is not necessarily every possible embodiment of the invention, a “bedrock principle of patent law” is that the claims, not the written description, define the patented invention.<sup>3</sup> That bedrock, which lately has been showing signs of cracking,<sup>4</sup> might now have a tamperproof retractable syringe permanently lodged in the crack.<sup>5</sup>

Retractable syringes were around long before the Federal Circuit Court of Appeals decided a case, *Phillips*, in which it laid out the ground rules for interpreting claim language.<sup>6</sup> The *Phillips* rules stated that (1) the written description or specification is the best source for understanding the meaning of a claim; (2) a claim term must be given its “ordinary and customary” meaning — that is, the technical meaning it would have to a “person of ordinary skill in the art” — unless the inventor defined it otherwise; (3) differences among the claims are a “useful guide” in understanding the meaning of particular terms; and (4) “importing limitations” from the specification into a claim should be avoided unless it is clear that the inventor meant to limit the invention to one or more of the specific embodiments described in the specification.<sup>7</sup> These rules seem to have given way to a much simpler one, namely, the invention is whatever is disclosed in the specification. Such was the case in Retractable Technologies, Inc.’s (“RTI”) legal battle with Becton,



<sup>1</sup> Gamble, a former New York Yankees outfielder, gave this answer when asked by a reporter to comment on the chaos which often resulted whenever owner George Steinbrenner and manager Billy Martin interacted with one another.

<sup>2</sup> 35 U.S.C. § 112 ¶¶ 1 & 2

<sup>3</sup> *Phillips v. AWH Corp.*, 415 F.3d 1303, 1312 (Fed.Cir.2005).

<sup>4</sup> See Joseph Root, *The Disclosure Revolution: It's a WYDWYG World*, *Landslide* 20 (Jul–Aug 2011).

<sup>5</sup> *Retractable Technologies, Inc. v. Becton, Dickinson and Co.*, \_\_\_F.3d \_\_\_, 2011 WL 2652448 (Fed. Cir. Jul. 8, 2011).

<sup>6</sup> *Phillips*, 415 F.3d 1303.

<sup>7</sup> See *id.* at 1312–16 & 1323.

Dickson and Co.’s (“Becton”) over the meaning of the term, “body.”<sup>8</sup>

### To be One Piece or Not, That Is the Question

RTI owned a family of patents relating to retractable syringes.<sup>9</sup> As the product’s name suggests, a retractable syringe retracts the needle into the syringe body after the syringe is used, thereby reducing the risk of an accidental needle stick to a medical worker after that worker has used the syringe on a patient. The RTI patents included a number of claims, but a generally representative claim claimed a “syringe assembly having a retractable needle” which included

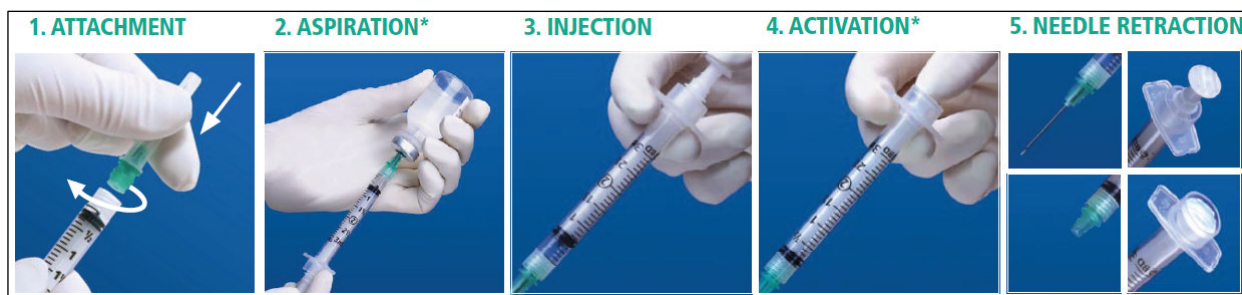
a hollow syringe body [12] comprising a barrel [14] and having a front end portion and a back end portion, the back end portion further comprising at least one radially extending member providing finger grips [56] for the syringe body.<sup>10</sup>

The claim also required other elements of the syringe assembly (see figure above),<sup>11</sup> including a retraction mechanism [20] located in the front end portion of the body [12] which contained a needle holder [22] and a retainer member [66] that surrounded the inner head [72] of the needle holder.<sup>12</sup> In support of the claims, the RTI patents contained a “detailed structural disclosure of a particular retractable syringe assembly.”<sup>13</sup>

Becton made a line of retractable syringes marketed under its Integra™ syringe product line. The Integra™ syringe, which is illustrated below,<sup>14</sup>

[c]ontains two pieces, a syringe body and a needle assembly that screws into the body. The needle assembly contains an inner hub and an outer hub that are connected to each other. The inner hub contains the needle and a spring compressed against the surface of the inner hub. . . .

The plunger . . . contains a cutter. When the needle assembly is screwed in and the plunger is fully extended in the barrel, additional force on the plunger causes the cutter to cut a portion of the inner hub of the needle assembly, allowing the spring to expand and retract the needle into the syringe body.<sup>15</sup>



8 RTI and Becton argued over other claim terms, including “retainer member.” See *Retractable Technologies*, 2011 WL 2652448 at \*\*5–6.

9 U.S. Pat. Nos. 5,632,733; 6,090,077; and 7,351,224.

10 Claim 43 of U.S. Pat. No. 7,351,224 (element numbers added).

11 U.S. Pat. No. 5,632,733 at FIG. 1.

12 *Retractable Technologies*, 2011 WL 2652448 at \* 2.

13 *Id.*

14 Becton, BD Integra™ Syringe 3ml In-service Poster, [http://www.bd.com/safety/pdfs/BD\\_Integra\\_3ml\\_Syringe\\_Inservice\\_poster\\_0475.pdf](http://www.bd.com/safety/pdfs/BD_Integra_3ml_Syringe_Inservice_poster_0475.pdf) (accessed Aug. 10, 2010).

15 *Retractable Technologies*, 2011 WL 2652448 at \*3.

RTI had brought suit against Becton alleging the Integra™ syringes infringed the RTI patents.<sup>16</sup> At the district (trial) court level, the court interpreted “body” as “a hollow outer structure that houses the syringe components, and concluded that the term ‘body’ was not limited to a one piece structure.”<sup>17</sup> The jury found that Becton had infringed the RTI patents and Becton appealed to the Federal Circuit.<sup>18</sup>

One of the issues that Becton raised on appeal was the meaning of the term, “body.” In its view, RTI restricted “body” to mean a one-piece structure because “the specifications describe ‘the invention’ as including a one-piece body while criticizing prior art syringes that contain a two-piece body.”<sup>19</sup> RTI responded that the “ordinary meaning of the term ‘body’ is not limited to a one-piece body . . . , [that] some claims recite a ‘body’ and other claims recite a ‘one piece body’ . . . , and while the preferred embodiments disclose a syringe with a one-piece body, that disclosure is directed to manufacturing benefits” and not other benefits of the invention.<sup>20</sup>

### WYDIWYG<sup>21</sup>

A majority of the Federal Circuit’s three-judge panel sided with Becton. The court acknowledged that some of the claims recited a “body” and other claims recited a “one-piece body,” but noted that none of the claims recited a “body that contains multiple pieces.”<sup>22</sup> Further, the specification criticized prior art retractable syringes as not being “molded as a one piece outer body,” summarized the invention as “featur[ing] a one piece hollow body,” and described and illustrated each embodiment as including a one-piece body.<sup>23</sup> “While the claims [left] open the possibility that the recited ‘body’ may encompass a syringe body composed of more than one piece, the specifications [told] us otherwise.”<sup>24</sup> Therefore, the disclosed embodiments defined the invention as having a one-piece body and because RTI had disclaimed any body other than a one-piece body, it could not argue that a two-piece body was an equivalent structure.<sup>25</sup>

In a concurring opinion, one of the judges, Judge Plager, emphasized that “you should get what you disclose”<sup>26</sup> and noted that “[h]owever 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. For that we look to the written description.”<sup>27</sup> And by “look to the written description,” he may mean more than just look:

I understand how a perfectly competent trial judge can be persuaded by the siren song of litigation counsel to give the jury wide scope regarding what is claimed. But it is a song to which courts should turn a deaf ear if patents are to serve the purposes for which they exist, including the

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16 *Id.*

17 *Id.* at \*4 (citing the district court’s Claim Construction Opinion) (internal quotes omitted).

18 *Id.*

19 *Id.* at \*7.

20 *Retractable Technologies*, 2011 WL 2652448 at \*7.

21 What you disclose is what you get. *See Root, supra*, n. 4.

22 *Retractable Technologies*, 2011 WL 2652448 at \*7.

23 *Id.*

24 *Id.* at \*8.

25 *Id.* at \*9.

26 *Id.* at \* 13 (Plager J., concurring) (quoting *Arlington Industries, Inc. v. Bridgeport Fittings, Inc.*, 632 F.3d 1246, 1252 (Fed. Cir. 2011) (Lourie, J., concurring/dissenting)).

27 *Retractable Technologies*, 2011 WL 2652448 at \* 13 (Plager, J., concurring) (citations omitted).

obligation to make full disclosure of what is actually invented, and to claim that and nothing more.<sup>28</sup>

### **Don't Throw the Body Out with the Bedrock**

Not all of the judges agreed that “body” meant a one-piece structure. In a dissenting opinion, Chief Judge Rader applied the *Phillips* rules — namely, the claims and not the specification define the invention, claim terms are given their ordinary and customary meaning, different claims mean differing things, and limitations from the specification should not be imported into the claims. Relying upon the rule that claim language should be given its ordinary and customary meaning as understood by a person of ordinary skill in the art, he pointed out that neither RTI or Becton argued that “body” has a special, technical meaning and, absent any special meaning, the ordinary and customary meaning of “body” did not limit the term to a one-piece structure.<sup>29</sup> Further, he noted that some of the claims did limit the body to a one-piece structure whereas others simply claimed a body. The presumption is that those claims mean different things and there was nothing written in the specification that could convince one that the claims were “completely superfluous” with one another.<sup>30</sup> For example, the inventor never explicitly excluded a two-piece body and the modifier “one piece” or “one-piece” was consistently used whenever the inventor intended to describe a syringe with a one-piece body.<sup>31</sup>

Chief Judge Rader also thought it wrong that the other judges focused solely on the specification’s criticism of prior art syringes as not being “molded as a one piece outer body.” Ease of manufacturing and assembly (a problem which a one-piece body helps to solve) was only one of several objectives disclosed in the RTI patents. Other objectives included “creating a retractable syringe that does not require breaking of internal parts, is not temperature sensitive, will not prematurely retract, requires relatively low thumb pressure to activate, has a high blowout pressure, and prevents reuse.”<sup>32</sup> As he correctly pointed out, when a patent identifies a number of objectives that the invention purportedly achieves, each claim does not need to be interpreted as being capable of achieving all of those objectives.<sup>33</sup> Therefore, the fact that a one-piece body would achieve one of the objectives does not mean that that objective should be read into every claim.<sup>34</sup>

### **Long Ago and Far Away**

Before there were retractable syringes, courts recognized that if the specification defined the invention, there would be no need for claims:

[T]hat claims are interpreted in light of the specification does not mean that everything expressed in the specification must be read into all the claims. If everything in the specification were required to be read into the claims, or if structural claims were to be limited to devices operated precisely as a specification-described embodiment is operated, there would be no need for claims. Nor could an applicant, regardless of the prior art, claim more broadly than that embodiment. Nor would a basis remain for the statutory necessity that an applicant conclude his specification with “claims particularly pointing out and distinctly claiming the subject matter which the applicant

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28 *Id.*

29 *Id.* at \* 14 (Rader, J., dissenting in part).

30 *Id.* (citing the doctrine of claim differentiation).

31 *Id.*

32 *Retractable Technologies*, 2011 WL 2652448 at \* 15 (Rader, J., dissenting in part).

33 *Id.*

34 *Id.*

regards as his invention.”<sup>35</sup>

The *Phillips* rules seem to be giving way to a “what you disclose is what you get” rule. If that is the case, then embodiment by way of example becomes invention by way of embodiment and the intended audience for the patent is no longer persons of ordinary skill but judges who are likely to look at the patent’s drawing figures in deciding what the invention really is.<sup>36</sup> On the one hand, disclose-and-get may give the public a clearer, more exact understanding of the invention. On the other hand, it may give that same public a much easier way to design around and avoid a patent, thereby eroding at least some of the value of having a patent. From an inventor’s perspective, there seems no way out other than recognizing that the scope of the claims may be limited to the disclosed embodiments (regardless of the inventor’s intent) and then drafting the specification accordingly. This may require not only using a crystal ball but providing additional disclosure beyond what the *Phillips* rules would require. To paraphrase Oscar Gamble, it should not “be like it is, but it do.”

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### About the Author

**Paul E. Rossler** has an extensive background in intellectual property and engineering. In 1984 he received his bachelor of science in industrial engineering from the GMI Engineering & Management Institute (formerly General Motors Institute). He went on to receive his master’s degree and Ph.D. in industrial engineering from Virginia Tech before completing his juris doctorate at the University of Tulsa, where he graduated with highest honors. Prior to practicing law, Paul served on the engineering faculty at Kettering University and Oklahoma State University. At Oklahoma State, he taught in and directed the graduate degree program in Engineering & Technology Management, a program intended for practicing engineers, scientists and technologists. He continues to teach engineering law and engineering management courses at Oklahoma State University as an adjunct faculty member. Paul is a member of the Oklahoma Bar, is admitted to practice before the U.S. Patent and Trademark Office, and is a registered professional engineer in Michigan and Oklahoma. He can be reached by email at [prossler@gablelaw.com](mailto:prossler@gablelaw.com).

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<sup>35</sup> *SRI International v. Matsushita Electric Corp. of Am.*, 775 F.2d 1107, 1121 (Fed. Cir. 1985).

<sup>36</sup> See Paul E. Rossler & Craig A. Fitzgerald, *WhatsUpinIP.com, Honest Mom, I Read It for the Articles, Not the Pictures* (May 11, 2011).