

CASE LAW UPDATE

January 11, 2006

CASE	Norian Corporation v. Stryker Corporation (Federal Circuit, Decided December 6, 2005)
MAIN ISSUE(S)	Should the phrase "consisting of a sodium phosphate" be limited to a solution prepared from only a single sodium phosphate?
EXECUTIVE SUMMARY	Plaintiff's patent is directed to kits for preparing calcium phosphate compositions to be used as "bone cements." The District Court concluded that the claim term "a solution consisting of water and a sodium phosphate" required that the sodium phosphate solution be made from <u>only</u> a single sodium phosphate. Defendant's competing kit was based on a solution prepared from more than one sodium phosphate. The Federal Circuit agreed with the District Court and held that the reference to "a sodium phosphate" in the context of the claim was most naturally understood as a reference to one of the different sodium phosphates. The word "a" was best interpreted in its singular sense because it had been used in conjunction with the closed transitional phrase "consisting of." Moreover, this interpretation was consistent with the prosecution history.
KEY TERM(S)	Consisting, Comprising, Infringement
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PROCEDURAL POSTURE	Norian sued Stryker in 2001 in the U.S. District Court for the Northern District of California for infringement of U.S. Pat. No. 6,002,065. The District Court held that the patent was not infringed. On appeal, the Court of Appeals for the Federal Circuit reversed the District Court's grant of summary judgment of non infringement, which they held was based on an unduly restrictive claim construction. On remand, the District Court again entered summary judgment of non infringement based on its construction of a different claim limitation. Norian appealed to the Federal Circuit for the second time.
FACTS	Norian's patent '065 is directed to a kit for preparing calcium phosphate compositions to be used as "bone cements." Claim 8 of the '065 patent is directed to a "kit for preparing a calcium phosphate mineral consisting of a solution <u>consisting of</u> water and <u>a sodium phosphate</u> ." During prosecution, claim 8 was amended from "a sodium phosphate solution" to "a solution consisting of water and a sodium phosphate" in view of a prior art reference. The amendment was made in response to a prior art patent, which disclosed a colloidal setting solution, rather than a pure solution containing no suspended particles. Stryker's competing kit was based on a solution prepared from more than one sodium phosphate.
HOLDING	The Federal Circuit affirmed the district court's grant of summary judgment.
COURT'S REASONING	The court noted that the phrase "consisting of" is restrictive. In that context, the court explained that the term "a" must be interpreted to mean that the solution consists of water and a single solute, i.e. a single type of sodium phosphate. The court found support for that interpretation in the specification, which contains repeated references to solutions made from a single sodium phosphate, but contains no reference to making the solution from more than one sodium phosphate. In addition, the court noted that claim 8 uses the phrase "at least one" in the first limitation, which refers to sources of calcium or phosphoric acid, but does not use that phrase in the second limitation, which refers to the ingredients of the solution. Finally, the court noted that the prosecution history of the '065 patent shows that the patentee surrendered the claim scope that was encompassed by the phrase "a sodium phosphate solution" when the patentee amended that language to read "a solution <u>consisting of</u> water and a sodium phosphate." Even though the above mentioned prior art reference did not disclose a solution made from more than a single solute, the court held Norian to the scope of what was ultimately claimed, citing <i>Elkay Mfg. Co.</i> , 192 F.3d 979.
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