MEDTRONIC COREVALVE, LLC. v. EDWARDS LIFESCIENCES CORP., Appeal No. 2013-1117 (Fed. Cir. January 22, 2014). Before Prost, Plager, and Taranto. Appealed from C.D. Cal. (Judge Selna).

Background:

Medtronic sued Edwards for infringement of several claims of US 7,892,281, the application of which claimed a priority date of October 31, 2000 via a series of patent applications including a 1st French application, a 2nd PCT application, and 3rd, 4th, and 5th US applications before US '281 itself. Edwards moved for partial summary judgment that the priority chain failed to comply with 35 U.S.C. §§ 119 and 120, because the 3rd, 4th and 5th applications in the priority chain did not contain a specific reference to the 1st application, but only to the 2nd application; and because the 4th and 5th applications incorrectly claimed priority to the 2nd application. Edwards argued that these defects limited the priority date to April 10, 2003, the date of the 3rd application. As a result, Edwards moved to invalidate US '281 on summary judgment under 35 U.S.C. § 102 as being anticipated by the publication of the 1st and 2nd applications. The district court granted Edward's motion. Medtronic appealed.

Issue/Holding:

Did the district court err in holding that US '281 could not claim the benefit of the earlier priority filing date for failure to comply with 35 U.S.C. §§ 119 and 120? No, affirmed.

Discussion:

The Federal Circuit agreed with the district court that the priority chain of US '281 is flawed and that no benefit to the 1st or 2nd applications could be claimed. The 4th and 5th applications both repeated the priority statement of the 3rd application, reciting "this application is also a continuation-in-part of [the 2nd International application]", thereby leaving out reference to the intervening 3rd application, and in the case of the 5th application, the 4th application as well. Medtronic asserted that the district court incorrectly adopted a plain language meaning of the phrase "this application", and instead argued that it referred to the 3rd application, regardless of whether it was used in the 4th or 5th applications. The Federal Circuit disagreed, saying that Medtronics' argument made little sense, and that the plain language meaning of the phrase is the accepted meaning in the courts, to the USPTO and among patent practitioners.

Medtronic then argued that the meaning of "this application" should be based on the "reasonable person" standard, and that anyone of ordinary skill in the art would understand that "this application" referred to the 3rd application, not the 4th or 5th applications. Medtronic also urged that the test for determining whether a priority claim contains the specific reference is whether a reasonable person would be able to determine the relationship between the priority applications, and that the language of a priority claim should not exist in isolation, but rather, be interpreted by an interested reader who discerns the context. The Federal Circuit declined to adopt the test proposed by Medtronic, holding that the patentee is the person best suited to understand the genealogy of her applications, and a requirement for her to clearly disclose this information should present no hardship. Further, the Federal Circuit held that the reasonable person test improperly places the burden of deciphering a priority claim on the reader.