

HOWMEDICA OSTEONICS CORP. v. ZIMMER, INC., Appeal No. 2015-1232, -1234, -1239 (Fed. Cir. May 12, 2016). Before O'Malley, Plager and Wallach. Appealed from D.N.J. (Judge Wigenton).

Background:

Howmedica sued Zimmer for literal infringement of several claims of its patent, which concerns a socket assembly shell used in prosthetic hip implants. Howmedica's contentions did not assert a doctrine of equivalents ("DOE") theory of infringement, but attempted to reserve the right to argue the same.

The patented socket assembly shell accommodates two different types of securement elements: a recess and a tapered surface. The key issue was a claim limitation indicating the positioning of the two securement elements as "juxtaposed" with or in "juxtaposition" to one another to *ensure effectiveness* of each of the recess and the tapered surface while in the presence of each other. During claim construction, the court construed the claim term such that the recess was positioned "*essentially midway*" along the tapered surface to *ensure effectiveness* of each. As a result of the claim construction, Howmedica could no longer prove literal infringement.

Instead of amending the infringement contentions, Howmedica, in its summary judgment brief, argued that Zimmer infringed the "*essentially midway*" construction under the DOE. In granting summary judgment of non-infringement, the district court asserted Howmedica's failure to amend its infringement contentions to include a DOE theory precluded assertion of that theory at the summary judgment stage. Howmedica appealed the adverse claim construction and the prohibition of first arguing DOE infringement at the summary judgment stage.

Issues/Holdings:

Did the district court err in its claim construction? Did the district court err in precluding Howmedica from first pursuing DOE infringement at summary judgment? No, affirmed.

Discussion:

In affirming the district court's claim construction, the Federal Circuit rejected both Howmedica's request to look at dictionary definitions, and two arguments including that the "*essentially midway*" limitation is merely a preferred embodiment, and that the claim construction is improper under the doctrine of claim differentiation. Instead, the Federal Circuit focusing exclusively on the patent specification reasoned that, based on only two instances of the specification describing how to effectively place the two securement elements with respect to each other, the recess is placed "*essentially midway*" along the taper. Thus, the taper is divided into two roughly equal segments, which results in the effectiveness of the taper not being compromised by the presence of the recess. Thus, the Federal Circuit reasoned that every description and every figure in the patent places the recess "*essentially midway*" along the taper.

The district court's local patent rules (LPR) require specifically asserting whether each limitation is allegedly literally infringed or infringed under the DOE. Because Howmedica failed to follow the LPR, the Federal Circuit held that the district court did not abuse its discretion by enforcing LPR prohibiting a new summary judgment DOE infringement allegation, and Howmedica's reservation of right to assert DOE was not a cure. Thus, the Federal Circuit affirmed the denial of new summary judgment DOE arguments based on LPR.