

**UNITED STATES DISTRICT COURT
SOUTHERN DISTRICT OF OHIO
WESTERN DIVISION**

THE PROCTER & GAMBLE COMPANY, :	:	Case No. 1:12-cv-552
	:	
Plaintiff,	:	Judge Timothy S. Black
	:	
vs.	:	
	:	
TEAM TECHNOLOGIES, INC., <i>et al.</i> ,	:	
	:	
Defendants.	:	

ORDER ON CLAIM CONSTRUCTION

The parties have submitted briefs in support of their proposed claim constructions. (Docs. 66, 67, 68, and 69). Additionally, the Court held a *Markman* hearing on November 19, 2013.

I. THE PATENTS AT ISSUE

A. The ‘453 Patent

The ‘453 Patent, filed in 1998, relates to a tooth whitening delivery system in the form of strips of flexible material that deliver a tooth whitening substance to a plurality of adjacent teeth. According to the specification, the invention of the ‘453 Patent is an improvement over the prior art in that the strips conform to the user’s teeth, but without permanent deformation, and because there is a substance which causes the strip to adhere to the tooth while simultaneously containing and delivering the tooth whitening agent. Another important aspect of the ‘453 Patent is that the strips are “substantially unnoticeable when worn.” (Doc. 65-1 at 3-13). Claims 1-3, 6-8, 9, 11, 18-19 and 21 are asserted. Claims 1, 19, and 21 are independent. (Doc. 67 at 1).

B. The '017 Patent

The '017 Patent, filed in 1997, is another in the same family of patent applications that resulted in the '453 Patent. The '453 and '017 Patents share a common specification, and the file histories of the two patents are nearly identical – several of the office actions and responses are common to both files, with the differing prosecution history coming only in the latter stages of the prosecution. The primary difference in the claims of the '017 Patent is that the independent claims require that the strip of material have a particular flexural stiffness as measured using the ASTM test method (these requirements are part of dependent claims in the '453 Patent). Additionally, the independent claims of the '017 Patent are directed to delivery of “an oral care substance” rather than a “tooth whitening substance.” (Doc. 65-1 at 14-20). Claims 1-3, 7, 8-9 and 12 are asserted. Claims 1 and 8 are independent. (Doc. 67 at 2).

C. The '199 Patent

The '199 Patent, filed in 2005, claims priority through a number of continuations and continuations-in-part to the '453 Patent and its parent application. The '199 Patent is also directed to a tooth whitening strip, but its specification and claims depart from the subject matter of the '453 and '017 Patents in that the '199 Patent focuses on the shape of the tooth whitening strip. The asserted claims of the '199 Patent are directed to a strip that is applied specifically to the facial surfaces (front or outward facing surfaces) of a plurality of adjacent teeth, folding the strip “about the incisal edges” of the teeth onto the

lingual surface (surfaces facing the tongue). The claims also deal with the length of time the strips are worn – *i.e.*, for between 5 and 120 minutes and repeated for about 7 days.

(Doc. 65-1 at 21-33). Claims 17, 20, 23-26 and 28-30 are asserted. Claim 17 is independent. (Doc. 67 at 2).

II. THE CLAIM TERMS AT ISSUE

Disputed Terms, Phrases or Clauses	Patent(s)	Claim(s)
“without permanent deformation”	‘453	1, 19, 21
	‘017	1, 8
“tooth whitening substance/tooth bleaching composition/tooth bleaching substance”	‘453	1, 6-7, 8, 11, 19, 21
	‘199	17, 23, 29
“contacts said surface/contacts the facial surfaces”	‘453	1, 19, 21
	‘017	1, 8
	‘199	17
“almost unnoticeable when worn/substantially unnoticeable when worn”	‘453	1
	‘017	1, 8
“strip of material/strip of flexible material/confor[m]able strip of material”	‘453	1, 2-3, 7, 9, 11, 19, 21
	‘017	1, 3, 7, 8, 12
	‘199	17, 29, 30
“folding a second portion of the strip of material and tooth bleaching composition about the incisal edges of the plurality of adjacent teeth”	‘199	17
“gel”	‘453	6
	‘017	2, 9

III. STANDARD OF REVIEW

Claim construction is a matter of law to be decided exclusively by the court.

Markman v. Westview Instruments, Inc., 52 F.3d 967, 970-71 (Fed. Cir. 1995) (*en banc*), *aff'd*, 517 U.S. 370.

“The appropriate starting point [...] is always with the language of the asserted claim itself.” *Comark Comm, Inv. v. Harris Corp.*, 156 F.3d 1186 (Fed. Cir. 1998).

“[T]he claims of a patent define the invention to which the patentee is entitled the right to exclude.” *Innova/Pure Water, Inc. v. Safari Water Filtration Sys., Inc.*, 381 F.3d 1111, 1115 (Fed. Cir. 2004).

Claim terms are “generally given their ordinary and customary meaning.” *Phillips v. AWH Corp.*, 415 F.3d 1303, 1312 (Fed. Cir. 2005). “The ordinary and customary meaning of a claim term is the meaning that the term would have to a person of ordinary skill in the art in question at the time of the invention, i.e., as of the effective date of the patent application.” *Id.* at 1313.

In the event of ambiguity regarding claim terms, courts must first look to the intrinsic evidence (*i.e.*, the claim itself, the specifications, the prosecution history, and prior art cited in the patent) to resolve any ambiguities. *Vitronics Corp. v. Conceptoronic, Inc.*, 90 F.3d 1576, 1582 (Fed. Cir. 1996).

“The specification is always highly relevant to the claim construction analysis. Usually, it is dispositive; it is the single best guide to the meaning of a disputed term.”

Id. Indeed, “[w]hen the specification explains and defines a term used in the claims, without ambiguity or incompleteness, there is no need to search further for the meaning of the term.” *Multiform Desiccants, Inc. v. Medzam Ltd.*, 133 F.3d 1473, 1478 (Fed. Cir. 1998).

The court may also consider “the prosecution history of the patent, if in evidence.” *Vitronics*, 90 F.3d at 1582. The prosecution history limits the interpretation of claim terms so as to exclude any interpretation that was disclaimed during prosecution. *Southwall Techs., Inc. v. Cardinal IG Co.*, 54 F.3d 1570, 1576 (Fed. Cir. 1995).

In most circumstances, analysis of the intrinsic evidence alone will resolve claim construction disputes. *See Vitronics*, 90 F.3d at 1583. However, if the intrinsic evidence does not resolve ambiguities, extrinsic evidence may be considered. Extrinsic evidence “can shed light on the relevant art,’ but is less significant than the intrinsic record in determining the ‘legally operative meaning of disputed claim language.’” *C.R. Bard, Inc. v. United States Surgical Corp.*, 388 F.3d 858, 862 (Fed. Cir. 2004) (*quoting Vanderlande Indus. Nederland BV v. Int’l Trade Comm’n*, 366 F.3d 1311, 1318 (Fed. Cir. 2004)).

IV. THE COURT’S CONSTRUCTION OF THE CLAIMS

A. “without permanent deformation”

Plaintiff’s proposed construction	Defendants’ proposed construction
without permanently conforming to the shape of the teeth	without irreversible alteration in shape, structure, or integrity and can recover its original shape

This term describes the properties and shape of the claimed tooth whitening strip when placed onto the teeth and when removed from them. The parties’ disagreement stems from the question of whether the intended focus of this claim term is whether the strip loses the shape of the user’s teeth when removed or whether it returns to its original shape when removed.

Plaintiff argues that its proposed construction properly limits this term to the shape changes that occur when the strip is placed against the teeth. (Doc. 66 at 26). Plaintiff alleges that the intrinsic record unambiguously shows that the deformation limitation applies only “to a shape of a tooth.” (*Id.*) In the language of the claims, the invention seeks to avoid the strip being permanently deformed to “a shape of a tooth and its adjoining soft tissue.” (*Id.*) When a user applies the claimed delivery system to the teeth, the strip of material is not permanently molded into the shape of the surface of the teeth being treated, like a strip made of wax or putty might be. (*Id.* at 26-27). Plaintiff argues that the ‘017 patent explains that the purpose of this limitation was to distinguish the invention from prior moldable devices, such as wax- or putty-based systems, that required pressure to permanently deform the strip into the shape of the teeth. (*Id.* at 27).

Defendants argue that the claims use the terms “conform” and “deform” to mean different things. (Doc. 67 at 5). For example, claim 1 of the ‘453 Patent reads (in part): “said strip of material being readily conformable to tooth surfaces and to interstitial tooth spaces without permanent deformation when said delivery system is placed thereagainst.” (Doc. 65-1 at 12). Defendants argue that a strip that is “conformable” is one that forms to the shape of the teeth when pressed against the teeth. (Doc. 67-1 at ¶ 42). By contrast, Defendants argue that “permanent deformation” refers to a permanent and irreversible deformation to the shape of the strip, such as by altering the shape or the structural integrity of the strip. (*Id.* at ¶¶ 32, 42-43.)

The Court agrees with Plaintiff. Defendants’ proposal ignores the claim language and imports extraneous limitations to require that the strip undergo no irreversible alterations. Even when the appropriate distinction in meaning is made between the words “conform” and “deform,” the claim language merely requires that the strip not permanently deform *to the shape of the teeth*, not that it not permanently deform at all. Defendants’ construction is contrary to the specification’s teaching that the strip will not return to its substantially flat shape and ignores, and potentially excludes, a preferred embodiment that requires a fresh strip with each application. (Doc. 66 at 27-30). A claim construction that excludes a preferred embodiment “is rarely, if ever, correct” because it is unlikely that an inventor would define the invention in a way that excludes a preferred embodiment. *Vitronics*, 90 F.3d at 1583-84. Finally, Defendants’ expert, Dr.

Gaffar, admitted that Defendants’ construction is not supported by any actual language in the intrinsic record, but only by an inference that he drew from it. (Doc. 66 at 28).

Therefore, the Court adopts Plaintiff’s construction, which is faithful to both the language of the claims and the intrinsic record as a whole.

B. “tooth whitening substance/tooth bleaching composition/tooth bleaching substance”

Plaintiff’s proposed construction	Defendants’ proposed construction
one or more materials that separately or collectively provide a bleaching active and adhesive attachment to the teeth	a single, high viscosity liquid, paste, gel, or solution that has tooth whitening properties

The crux of the parties’ disagreement regarding the construction of this term is the question of whether or not the substance on the disclosed strip containing whitening properties can encompass multiple components.

Plaintiff argues that its proposed construction respects the teaching of the specifications that the tooth whitening substance provides both a bleaching active and adhesive attachment. (Doc. 66 at 19). Plaintiff argues that the claims explain that the tooth whitening substance serves both the functions of providing the active and providing adhesion. (Doc. 65-1 at 12, 19). Plaintiff argues that the specification reinforces the point that the tooth whitening substance performs both the function of whitening the teeth and of adhering the delivery system to the teeth during use. (*Id.* at 17). Finally, Plaintiff points out that the specification teaches that the tooth whitening substance may be one or more materials, contained in one or more layers. (*Id.* at 3, 8, 14, 18).

Defendants argue that Plaintiff's proposed construction ignores the claims, specification, and prosecution history when it proposes that a tooth whitening substance can be "one or materials" that work separately or collectively to serve both the active and adhesive functions. (Doc. 67 at 18). Defendants argue that the patents are clear that there is a single material that provides both of these functions at once and that there cannot be "one or more" as Plaintiff proposes. (*Id.*) Defendants argue that "[i]n light of the clear teachings of the patent specification and claims," a person of skill in the art would not adopt a construction that allows "one or more materials" to work "separately or collectively" to provide the active and the adhesive, and that the term should be construed to refer solely to the bleaching active described in the patent specifications. (Doc. 67-1 at ¶107).

The Court agrees with Plaintiff. Defendants' attempt to narrow the scope of the claim by requiring the "tooth whitening substance" to be a single layer is contrary to the intrinsic record. First, Defendants' construction omits the adhesive component of the tooth whitening substance, a component Defendants themselves highlight in their arguments regarding this very claim term. (Doc. 67 at 18). Secondly, the specification clearly states that the tooth whitening substance may be comprised of one or more configurations, including layers. (Doc. 65-1 at 3, 8, 14, 18). Finally, if adopted, Defendants' construction would limit the claim to a preferred embodiment in which in substance is "homogenous, uniformly and continuously coated on [the] strip of

material[.]” (Doc. 65-1 at 8). Defendants’ citations refer to embodiments prefaced by the word “preferably.” Preferred embodiments should not be read into claims when the claim language is broader. *Electro Med. Sys., S.A., v. Cooper Life Sciences, Inc.*, 34 F.3d 1048, 1054 (Fed. Cir. 1994); see also *Phillips*, 415 F.3d at 1320 (labeling the mistake of “reading a limitation from the written description into the claims” as “one of the cardinal sins of patent law”). As a general proposition, the Court sees no inherent problem with a single “substance” being made up of multiple layers or components, and, according to the intrinsic record, this is, in fact, exactly what the patents disclose.

Therefore, the Court adopts Plaintiff’s construction, which is again faithful to both the language of the claims and the intrinsic record as a whole.

C. “contacts said surface/contacts the facial surfaces”

Plaintiff’s proposed construction	Defendants’ proposed construction
contacts the surface of the teeth at any time while the delivery system is worn	directly contacts the surface upon application of the strip

The parties’ disagreement regarding the construction of this claim term is a temporal question about when the contact between the tooth whitening substance and the teeth actually occurs.

Plaintiff argues that its proposed construction stays true to the language of the claims, which only require that the tooth whitening substance be in contact with the teeth for some amount of time while the delivery system is worn. (Doc. 66 at 35). Plaintiff argues that because the claimed system is designed to be worn for up to around 120

minutes, the active in the substance may be delivered by contacting the teeth at any point during that time. (*Id.* at 37). Plaintiff argues that Defendants’ proposed construction builds on its flawed construction of “tooth whitening substance,” which requires that the substance be a single layer, to further require that the substance also be a homogenous single layer such that the active contacts the tooth immediately upon application of the system. (*Id.* at 36). In Plaintiff’s view, Dr. Gaffar’s opinion that a delay of even 30 seconds before the active contacts the tooth falls outside the claim scope is contrary to the patent disclosures, which explain that the claimed delivery system is designed to whiten teeth over a period of time. (*Id.* at 37).

Defendants argue that the patents describe a system in which the active layer and the adhesive layer are intermixed so that the active ingredient (usually peroxide) contacts the surface of the teeth immediately upon application of the strip. (Doc. 67-1 at ¶47). Defendants argue that the claims of the patents make it very clear that there is just one substance that contains both the adhesive and the active and which directly contacts the surface of the tooth. Defendants argue that Plaintiff claims to combine the adhesive and active into a single layer, which means that the active would be immediately in contact with the tooth surface from the first moment the strip is applied. (Doc. 67 at 9). Defendants allege that this benefit is described in the patent specification when it touts the need for a strip that is in contact with the surface of the teeth “for rapid delivery of an active.” (Doc. 65-1 at 7).

The Court again agrees with Plaintiff, in part based on its conclusion that a construction of the prior claim term “tooth whitening substance” that contemplates multiple layers is appropriate. As established, the patents explain that the adhesive and active collectively make up the “tooth whitening substance,” which may be comprised of multiple layers. The claim provides for “a tooth whitening substance applied to said strip of material such that when said delivery system is placed on a surface of said teeth, said substance contacts said surface providing an active onto said surface,” and if Defendants’ construction of “contacts said surface” is adopted, would indicate that the active component also contacts the teeth immediately. In the case of a multi-layered substance, however, although some part of the substance will “directly contact the surface upon application of the strip” per Defendant’s proposed construction, the substance will *not* necessarily contact the surface *and* “provid[e] an active onto said surface” immediately upon contact. It will only contact the teeth *and* provide the active onto them at some point during the wearing of the strip, per Plaintiff’s construction. Moreover, contrary to Defendants’ arguments, “rapid delivery of an active” is not the same as *immediate* delivery of an active.

Therefore, the Court adopts Plaintiff’s construction, which accurately reflects the language of the claims and is logically consistent with the Court’s previously adopted constructions.

D. “almost unnoticeable when worn/substantially unnoticeable when worn”

Plaintiff’s proposed construction	Defendants’ proposed construction
not readily apparent to others when worn	not easily visually detected by another person when worn

There is no genuine dispute over the construction of this term. Both parties’ proposed constructions are similar, but Defendants’ construction focuses solely on the likelihood that the strip will be detected visually when worn. Plaintiff argues that the specification explains that the invention is designed to “permit the wearer to use the system during social discourse without interfering with the wearer’s speech or appearance.” (Doc. 65-1 at 16). Defendants merely emphasize 1) that the almost unnoticeable nature of the strip is based on perceptions of someone other than the wearer and 2) that “almost unnoticeable” refers to another’s perception of the strip while it is being worn, not how it is seen while still on the backing tape or when first being applied to the mouth. (Doc. 67 at 11). Defendants believe either proposed construction is therefore appropriate. (*Id.*)

Given that Defendants’ have accepted Plaintiff’s proposed construction, and the specification refers to either visual or audio detection, the Court adopts Plaintiff’s construction.

E. “strip of material/strip of flexible material/comfor[m]able strip of material”

Plaintiff’s proposed construction	Defendants’ proposed construction
strip of any material suitable for use in the oral cavity	a strip of polyolefin material that can be measured according to the standard found in the patent

The sole dispute over the meaning of this claim term centers on the type of “material” that must be used for the strip.

Plaintiff argues that its proposed construction is consistent with the patents, which claim a strip of “material” generally, not a specific type of material. (Doc. 66 at 39). The specification discloses many options for the strip material – polymers, natural and synthetic wovens, non-wovens, foil, paper, rubber, etc. (*Id.*) Plaintiff points out that when the inventors intended to claim a specific material or limit the claims to a type of polyolefin, they expressly did so, as several claims require that the strip of material is made of polyethylene, a type of polyolefin. (Doc. 65-1 at 12-13). Plaintiff further argues that the patents teach that suitable materials will satisfy certain flexural stiffness requirements when measured using a Handle-O-Meter. (Doc. 66 at 39). When using a Handle-O-Meter, one may employ ASTM standard D2923-95, which provides procedures to overcome the spurious effects of static electricity that may skew the Handle-O-Meter results for certain materials. (*Id.* at 40). Plaintiff claims that Defendants latch onto discussion of this ASTM standard to limit the material used solely to polyolefin. (*Id.*) Plaintiff argues that not only is this construction contrary to the patent specifications, it is based on Dr. Gaffar’s flawed assertion that non-polyolefin materials

cannot be accurately measured by a Handle-O-Meter using the relevant ASTM standard. (*Id.* at 40-41). Plaintiff asserts that Dr. Gaffar admitted in his deposition that this premise is wrong.

Defendants argue that the claims require a very specific type of material to be used: “a strip of material having a flexural stiffness less than about 50 grams/centimeter as measured on a Handle-O-Meter per ASTM test method D2923-95.” (Doc. 67 at 12). Defendants allege that even where the claims do not explicitly recite measurement using ASTM test method D2923-95, that standard is nevertheless recited as a requirement for qualifying the strip of material to be used “in the present invention.” (*Id.*) Defendants argue that the ASTM D2923-95 standard is only applicable to polyolefin films, and therefore the claim must be limited to them. (*Id.* at 12-13).

The Court again agrees with Plaintiff. First, as Plaintiff points out, the disputed claims do not recite any specific material and the inventors did refer to specific materials, including polyolefin, when they intended to do so. (Doc. 65-1 at 12-13, 19-20). Moreover, the specification expressly teaches that the strip may be made of any number of materials. (*Id.* at 9, 18, 29). Some embodiments of the claimed inventions require that the strip satisfy certain flexural stiffness requirements that can be measured using the Handle-O-Meter and ASTM standard in question. Defendants’ expert admitted, however, that the Handle-O-Meter can be used to measure the flexural stiffness of non-polyolefin materials and that as long as the machine is properly calibrated, a non-

polyolefin can be measured using the specified ASTM standard and a valid result can be obtained. (Doc. 66-2 at 20, 23-24).

Therefore, the Court adopts Plaintiff’s construction, which is faithful to the specifications and does not attempt to incorporate limitations into the claims absent sufficient basis to do so.

F. “folding a second portion of the strip of material and tooth bleaching composition about the incisal edges of the plurality of adjacent teeth”

Plaintiff’s proposed construction	Defendants’ proposed construction
plain and ordinary meaning (no construction necessary)	folding . . . in order not to cover up the tips of the canine teeth

The dispute around this term is whether or not construction is necessary at all.

Plaintiff submits that this claim term is clear on its face. Defendants have also not asked the Court to construe any of the words in the claim, but rather propose an addition to the claim language: “in order not to cover the tips of the canine teeth.” Plaintiff argues, however, that the specification discloses multiple embodiments, one that could cover the tips of the canine teeth, and others that do not. (Doc. 66 at 43). Plaintiff argues that Defendants ignore the embodiment that would cover the tips of the canine teeth. (*Id.*) Plaintiff points out that when the ellipsis Defendants include in their construction is replaced with the omitted language from the claim, it becomes clear that Defendants simply accept the disputed claim language in its entirety (demonstrating that it is clear and unambiguous on its face), and then import an additional limitation at the end that does not appear in the claim and is not supported by the specification. (*Id.* at 42-43).

Plaintiff argues that while a strip that does not cover the tips of the canine teeth may be a preferred embodiment, as established, such embodiments are not read into claims absent specific direction. Finally, Plaintiff argues that Defendants' construction renders an embodiment found in dependent claim 22 superfluous, as this claim recites a strip with "stair-stepped" sides to allow the tips of the canine teeth to be exposed, violating the doctrine of claim differentiation. *Tandon Corp. v. U.S. Int'l Trade Comm'n*, 831 F.2d 1017, 1023 (Fed. Cir. 1987).

Defendants argue that the unique aspect of the '199 Patent and its ancestor patents is that it adds a long discussion regarding the particular shape of the tooth whitening strips to be used. (Doc. 67 at 15). Defendants claim that in that discussion, the inventors specifically stated repeatedly that the whitening strips must never be folded over the canine teeth. (*Id.*) Defendants argue that in the context of the patent specification, a person of ordinary skill in the art would readily understand the claim to mean that it folds only over the incisal edges of the teeth and not over the tips, edges, or upper surfaces of the canine teeth, pre-molars, or molars. (Doc. 67-1 at ¶92). Defendants argue that Plaintiff's proposal that no construction is necessary is too simplistic and renders the term ambiguous. Finally, Defendants argue that canine teeth cannot have an incisal edge, because canine teeth are not incisors.

The Court once again agrees with Plaintiff. If the claim language Defendants are directly incorporating into their construction is unambiguous and does not require further

explanation in and of itself, then Plaintiff is correct and construction is unnecessary. Despite Defendants’ claims that the inventors specified that the strips *never* fold over the canine teeth, there is no patent language to this effect. Discussions of specific embodiments that do not fold over the canines do not amount to a mandate that in no embodiment must the strip ever do so. Moreover, Plaintiff has pointed to an embodiment in the specification which appears to cover the tips of the canine teeth to some degree. (Doc. 66 at 44-45). As stated, adopting Defendants’ construction would violate the doctrine of claim differentiation by rendering an embodiment found in a dependent claim superfluous. Finally, as Plaintiffs point out, incisal edges are indeed found on canine teeth according to the Oxford English Dictionary. (Doc. 70-2 at 27).

As Defendants have incorporated the entirety of the claim language into their proposed construction, the parties agree that this language is unambiguous, and, therefore, the Court finds that this claim term is clear on its face and does not require construction.

G. “gel”

Plaintiff’s proposed construction	Defendants’ proposed construction
a material ranging from near-liquid to near-solid that resists flow in the steady state	a single gel with a viscosity between 200 to 1,000,000 cP at low shear rates and which has a tacky feeling and provides both the tooth whitening active and the adhesive attachment between the strip of material and the teeth

The parties’ dispute over this term again focuses on whether specific limitations are appropriately read into the claim.

Plaintiff argues that its construction reflects the plain and ordinary meaning of “gel.” (Doc. 66 at 46-47). The patents teach that a wide range of substances having a wide range of viscosities may be suitable for use with the claimed inventions. The patents further teach that the substance is preferably a “gel.” (*Id.* at 46). Plaintiff argues that Defendants ignore these broad disclosures and, instead, try to limit the meaning of “gel” to a very specific embodiment based upon preferred properties disclosed in the patents and additional limitations of Defendants’ own creation. (*Id.* at 47). Plaintiff argues that Defendants are attempting to limit the scope of the term “gel” by importing a specific, preferred embodiment from the specification into the definition and adding four specific limitations not required by the claims. (*Id.*) Finally, Plaintiff points out that Defendants include the disputed term “gel” itself in their proposed construction. (*Id.*)

Defendants argue that it is clear from the patent specification and claims that when the whitening substance takes the form of a gel, it must be a single gel that provides both the active and the adhesive. (Doc. 67 at 19). Defendants argue that their construction also clarifies the meaning of a “gel” as defined in the specification of the patents. (*Id.*) With regard to Plaintiff’s proposed construction, Defendants argue that there is no way for a person of skill in the art to understand what a “near liquid” or a “near-solid” is, or how to determine whether a substance “resists flow in the steady state.” (*Id.* at 20). The viscosity measurement of the Defendants’ construction comes from the passage of the ‘453 Patent specification that describes the properties of “the substance of the present

invention.” (Doc. 65-1 at 10). In the ‘017 Patent, the specification states that the “preferred gel has a viscosity of between 200 and 1,000,000 cPs at low shear rates.” (*Id.* at 18). Defendants argue that from this, a person of ordinary skill in the art would understand that the substance can take many forms, including liquids, pastes, gel, or other solutions, but that the preferred embodiment is a gel. (Doc. 67 at ¶111). Thus, Defendants argue that because claims 2 and 9 specifically narrow the claimed substance to a gel, the patent’s description of the viscosity and shear rate must also apply.

The Court again agrees with Plaintiff. The inclusion of the claim term itself in Defendants’ proposed construction is unhelpful to understanding what the term means. Defendants’ inclusion of “single” is also precluded by the Court’s previous conclusion that the substance can be composed of multiple layers. Defendants’ expert admitted that he has heard of the terms “near-liquid” and “near-solid” and that he did not review any prior art before making the statement that “the art is silent” regarding those terms. (Doc. 68 at 22). The specific viscosity measurement cited refers to the “*preferred gel*” and is thus merely a preferred embodiment. As previously established, preferred embodiments are not appropriately used to limit claims.

Based on the foregoing, the Court adopts Plaintiff’s construction, which does not repeat the claim term itself or include inappropriate claim limitations.

V. CONCLUSION

“The construction that stays true to the claim language and most naturally aligns with the patent’s description of the invention will be, in the end, the correct construction.” *Phillips*, 415 F.3d at 1316 (quoting *Renishaw PLC v. Marposs Societa per Azioni*, 158 F.3d 1243, 1250 (Fed. Cir. 1998)). Therefore, the parties shall construe the contested terminology of the patents in suit as set forth in this Order.

IT IS SO ORDERED.

Date: 11/22/13

/s/ Timothy S. Black
Timothy S. Black
United States District Judge